

1 Brandon Brown (SBN 266347)
KIRKLAND & ELLIS LLP
2 555 California Street
San Francisco, California 94104
3 Telephone: (415) 439-1400
Facsimile: (415) 439-1500
4 brandon.brown@kirkland.com

5 Gregory S. Arovas (*pro hac vice* pending)
Todd M. Friedman (*pro hac vice* pending)
6 KIRKLAND & ELLIS LLP
601 Lexington Avenue
7 New York, NY 10022
Telephone: (212) 446-4800
8 Facsimile: (212) 446-4900
Email: greg.arovas@kirkland.com
9 Email: todd.friedman@kirkland.com

10 David Rokach (*pro hac vice* pending)
G. William Foster (*pro hac vice* pending)
11 KIRKLAND & ELLIS LLP
300 N. LaSalle Avenue
12 Chicago, Illinois 60654
Telephone: (312) 862-2000
13 Facsimile: (312) 862-2200
Email: david.rokach@kirkland.com
14 Email: billy.foster@kirkland.com

15 *Attorneys for Plaintiffs*
Samsung Electronics Co., Ltd. and
16 *Samsung Electronics America, Inc.*

17
18 **UNITED STATES DISTRICT COURT**
NORTHERN DISTRICT OF CALIFORNIA

19
20 SAMSUNG ELECTRONICS CO., LTD and)
SAMSUNG ELECTRONICS AMERICA,)
21 INC.)
22 Plaintiffs,)
23 v.)
24 IXI MOBILE (R&D) LTD. and IXI IP,)
LLC,)
25 Defendants.)
26)
27)
28)

CASE NO. _____

**COMPLAINT FOR DECLARATORY
JUDGMENT OF PRECLUSION,
NONINFRINGEMENT, AND
INVALIDITY**

DEMAND FOR JURY TRIAL

1 Plaintiffs Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively,
2 “Samsung”) seek a declaratory judgment that res judicata¹ bars Defendants IXI Mobile (R&D), Ltd.
3 and IXI IP, LLC (collectively, “IXI”) from asserting U.S. Patent No. 7,039,033 (the “’033 Patent”)
4 against Samsung. In the alternative, Samsung seeks a declaratory judgment that (1) Samsung does not
5 infringe the ’033 Patent and (2) the ’033 Patent is invalid.

6 **NATURE OF THE ACTION**

7 1. This is an action for a declaratory judgment arising under the patent laws of the United
8 States, Title 35 of the United States Code. Samsung seeks a declaratory judgment that res judicata
9 bars IXI from asserting the ’033 Patent against Samsung. In the alternative, Samsung seeks a
10 declaratory judgment that Samsung does not infringe the ’033 Patent and that the ’033 Patent is invalid.
11

12 **PARTIES**

13 2. Samsung Electronics Corporation, Ltd. (“SEC”) is based in Seoul, South Korea. SEC
14 designs and manufactures a wide variety of products, including cellular mobile devices.

15 3. Samsung Electronics America, Inc. (“SEA”) is a New York corporation with its
16 principal place of business at 105 Challenger Road, Ridgefield Park, New Jersey 07660.

17 4. On information and belief, Defendant IXI Mobile (R&D) Ltd. (“IXI Mobile (R&D)”),
18 formerly known as IXI Mobile (Israel) Ltd., is a company incorporated and registered under the laws
19 of Israel with a registered address of 11 Moshe Levi Street Lezion 75658, Israel. On information and
20 belief, IXI Mobile (R&D) is a subsidiary of non-party IXI Mobile, Inc. On information and belief, at
21 the time the ’033 Patent was prosecuted, and until at least 2007, IXI Mobile, Inc. and its subsidiary
22 IXI Mobile (R&D) were based in Belmont, California. IXI Mobile (R&D) has alleged that it
23 previously owned the ’033 Patent, and that it now has an exclusive license to the ’033 Patent.
24
25
26
27

28 ¹ “Res judicata” is also commonly known as “claim preclusion.” To avoid confusion with patent
“claims,” Samsung uses the term res judicata in this Complaint.

1 5. On information and belief, Defendant IXI IP LLC (“IXI IP”) is a New York limited
2 liability company with its principal place of business at 405 Lexington Avenue, New York, New York
3 10174 and with a registered address for service of 1218 Central Avenue, Suite 100, Albany, New York
4 12205. IXI IP has alleged that it is the owner of the ’033 Patent and has exclusively licensed the ’033
5 Patent to IXI Mobile (R&D). On information and belief, IXI IP is a patent licensing entity formed in
6 April 2014 that produces no products, and instead exists solely to assert IXI’s patents.
7

8 **IXI, FOUNDED IN CALIFORNIA, DEVELOPS, PROSECUTES, ENFORCES, AND**
9 **LICENSES ITS PATENTS IN CALIFORNIA**

10 A. **IXI Was Founded in California and Used California Counsel to Prosecute and**
11 **Obtain the ’033 Patent**

12 6. On information and belief, IXI Mobile, Inc. was founded in 2000 and was
13 headquartered in Redwood City or in Belmont, California, both of which are within this District. On
14 information and belief, Defendant IXI Mobile (R&D), the alleged former owner and current exclusive
15 licensee of the ’033 Patent, was a subsidiary of IXI Mobile, Inc., and was also located in Redwood
16 City or in Belmont, California, within this District, until at least 2007. A true and correct copy of IXI
17 Mobile, Inc.’s SEC Form 8-K Report dated August 12, 2008, listing the location of IXI Mobile, Inc.’s
18 headquarters in Belmont, California, is attached hereto as Exhibit A (IXI Mobile, Inc., Current Report
19 (Form 8-k) (Aug. 13, 2008)). IXI has alleged that during the time in which IXI Mobile, Inc. was
20 headquartered in California, IXI Mobile, Inc. and its subsidiary IXI Mobile (R&D) designed,
21 developed, and commercialized products, including the IXI Ogo family of mobile devices that IXI
22 asserts practice the ’033 patent.
23

24 7. On information and belief, IXI retained patent prosecution counsel in California to
25 prosecute and secure the ’033 Patent. The ’033 Patent was prosecuted by the California law firm
26 Vierra Magen Marcus Harmon & DeNiro LLP, located in San Francisco, California.

27 8. The U.S. Patent and Trademark Office (“PTO”) issued the ’033 Patent, titled “System,
28 Device and Computer Readable Medium for Providing Networking Services on a Mobile Device,” on

1 November 13, 2007. A true and correct copy of the '033 Patent is attached as Exhibit B, which
2 includes an *Ex Parte* Reexamination Certificate, issued February 1, 2018, that issued new and
3 amended claims for the '033 Patent, and an *Inter Partes* Review Certificate, issued January 16, 2019,
4 that cancelled multiple claims of the '033 Patent. Exhibit B (U.S. Patent No. 7,039,033).

5 **B. IXI Sued Samsung For Infringing Originally Issued Claims Of The '033 Patent**
6 **In A Case That Was Transferred To And Currently Remains Pending In The**
7 **Northern District of California**

8 9. On June 17, 2014, IXI sued Samsung in the U.S. District Court for the Southern District
9 of New York, alleging that Samsung devices that include “Wireless Hotspot” functionality (the
10 “accused products”) infringe certain originally issued claims of the '033 Patent. *See* Complaint, *IXI*
11 *Mobile (R&D) Ltd. et al. v. Samsung Elecs. Co., Ltd. et al.*, No. 1:14-cv-7954-RJS (S.D.N.Y. June 17,
12 2014), Dkt. No. 1.

13 10. IXI similarly sued Apple Inc. (“Apple”) and BlackBerry Limited and BlackBerry
14 Corporation (collectively, “BlackBerry”), in the Southern District of New York for purportedly
15 infringing the same patents. *See IXI Mobile (R&D) Ltd. et al. v. Apple Inc.*, No. 1:14-cv-7954-RJS
16 (S.D.N.Y. Oct. 2, 2014); *IXI Mobile (R&D) Ltd. et al. v. Blackberry Ltd. et al.*, No. 1:14-cv-4428-RJS
17 (S.D.N.Y. filed Jun. 18, 2014). IXI’s lawsuits against Samsung, Apple, and BlackBerry (the “2014
18 Litigations”) were related, but not consolidated.

19 20 11. On February 3, 2015, Samsung, Apple, and BlackBerry moved to transfer the 2014
21 Litigations from the Southern District of New York to the Northern District of California. On August
22 6, 2015, the Southern District of New York granted the motions and transferred the cases to the
23 Northern District of California. *See* Opinion and Order, *IXI Mobile (R&D) Ltd. et al. v. Apple Inc.*,
24 No. 1:14-cv-7954-RJS (S.D.N.Y. Aug. 6, 2015), Dkt. No. 79. All of the cases were assigned to Judge
25 Gilliam. *See IXI Mobile (R&D) Ltd. et al. v. Apple Inc.*, No. 4:15-cv-3755-HSG (N.D. Cal. filed Aug.
26 17, 2015); *IXI Mobile (R&D) Ltd. et al. v. Samsung Elecs. Co. et al.*, No. 4:15-cv-3752-HSG (N.D.
27
28

1 Cal. filed Aug. 17, 2015); *IXI Mobile (R&D) Ltd. et al. v. Blackberry Ltd. et al.*, No. 4:15-cv-3754-
2 HSG (N.D. Cal. filed Aug. 17, 2015)

3 12. In the 2014 Litigations, Samsung, Apple, and BlackBerry deposed a California-based
4 co-inventor of the '532 and '033 Patents in Palo Alto, California, which is within this District, on July
5 1, 2015.

6
7 **C. Cancellation of IXI's Originally Asserted Claims of the '033 Patent**

8 13. On June 19, 2015, Samsung and Apple filed a petition for *inter partes* review ("IPR")
9 with the Patent Trial and Appeal Board ("PTAB") on all of the originally issued claims of the '033
10 Patent asserted in the 2014 Litigations. *Samsung Elecs. Co., Ltd. et al. v. IXI IP, LLC*, No. IPR 2015-
11 01444 (P.T.A.B. filed Jun. 19, 2015).

12 14. On December 30, 2015, the PTAB instituted review of all of the challenged claims of
13 the '033 Patent in the IPR petition filed by Samsung and Apple. The PTAB subsequently found that
14 all of the instituted claims were obvious.

15 15. IXI appealed the PTAB's final written decision regarding the '033 Patent to the Federal
16 Circuit. On September 10, 2018, the Federal Circuit affirmed the PTAB's decision. *IXI IP, LLC v.*
17 *Samsung Elecs. Co.*, 903 F.3d 1257 (Fed. Cir. 2018). The PTO issued an IPR certificate cancelling
18 the challenged claims of the '033 Patent on January 16, 2019. Ex. B. at 29-30.

19
20 **D. Ex Parte Reexamination of the '033 Patent and IXI's Accusations Against**
21 **Samsung for Infringement of Claims Involved in the Reexamination**

22 16. In March 2017, after the PTAB found all asserted claims of the '033 Patent obvious,
23 and during the pendency of IXI's appeal of that decision to the Federal Circuit, IXI filed a request for
24 *ex parte* reexamination of the '033 Patent.

25 17. On February 1, 2018, the *ex parte* reexamination of the '033 Patent concluded, resulting
26 in one amended claim (claim 56) and 68 new claims (claims 57 through 124) (collectively, the
27 "Reexam Claims"). Ex. B at 24-28.
28

1 18. On March 7, 2019, IXI filed a motion in the 2014 Litigations to amend its preliminary
2 infringement contentions to, *inter alia*, add unspecified Reexam Claims of the '033 Patent. Defendants
3 argued that IXI's motion should be barred by res judicata or, alternatively, that IXI's motion should
4 be denied for failure to show "good cause." IXI argued that res judicata does not preclude it from
5 asserting the Reexam Claims of the '033 Patent against Samsung and that IXI should be permitted to
6 amend its infringement contentions. The Court denied IXI's motion on October 11, 2019. The Court
7 determined that IXI had not met its burden to amend its infringement contentions because: (1) IXI did
8 not demonstrate sufficient diligence; and (2) Samsung would be unduly prejudiced by the amendment.
9 The Court did not decide whether IXI's new claims are barred by res judicata and stated that "[i]f
10 Plaintiffs want to enforce their newly-minted claims, they can try to do so in a new case." Therefore,
11 there is a real and justiciable controversy between Plaintiffs and Samsung regarding the enforceability
12 of the '033 Patent against Samsung.
13
14

JURISDICTIONAL STATEMENT

15 19. This action arises under the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, and
16 under the patent laws of the United States, Title 35 of the United States Code.
17

18 20. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1331,
19 1338(a), and 2201(a).
20

21 21. This Court has personal jurisdiction over IXI Mobile (R&D). Among other things, on
22 information and belief, IXI Mobile (R&D) was, at the time the '033 Patent was prosecuted, based in
23 this District and was a subsidiary of IXI Mobile, Inc., a California company. IXI Mobile (R&D) has
24 also taken steps, in this District, to assert the '033 Patent against Samsung.

25 22. This Court also has personal jurisdiction over IXI IP. Among other things, on
26 information and belief, IXI IP has purposefully directed development, prosecution, licensing, and
27
28

1 enforcement activities into California for its patents, including the '033 Patent, which it allegedly
2 exclusively licenses to IXI Mobile (R&D). *See supra* ¶¶ 3-8.

3 23. Furthermore, counsel for IXI Mobile (R&D) and IXI IP conceded at the pre-motion
4 conference on the motion to transfer that the Northern District of California was an “appropriate place”
5 for its suit:
6

7 THE COURT: Well, there’s no dispute that Northern District of California would be
8 an appropriate place, right?

9 [IXI’s COUNSEL]: There’s absolutely no dispute

10 *IXI Mobile (R&D) Ltd. v. Apple Inc.*, Case No. 4:15-cv-03755-HSG, Dkt. 30-01 at 99 (Exhibit S, Pre-
11 Motion Conference Transcript), at 5:13-15. IXI did not dispute that there was personal jurisdiction
12 over IXI Mobile (R&D) or IXI IP in the parties’ transfer briefing. *See, e.g., id.*, Dkt. 31 [IXI’s
13 Opposition]; *id.*, Dkt. 71 [Order Granting Motion to Transfer] at 3 (“The parties do not dispute that
14 these actions could have been brought in the Northern District of California”).
15

16 24. IXI has also taken steps, in this District, to assert the '033 Patent against Samsung. *See*
17 *IXI Mobile (R&D) Ltd. v. Samsung Elecs. Co. Ltd. et al*, Case No. 4:15-cv-03752-HSG Dkt. 166
18 (motion to amend infringement contentions to assert reexamined claims of the '033 Patent against
19 Samsung).
20

21 25. IXI has also previously litigated and is currently litigating offensive claims for
22 infringement of its patents in this District, further supporting personal jurisdiction over IXI. *See, e.g.,*
23 *IXI Mobile (R&D) Ltd. et al. v. Blackberry Ltd. et al.*, No. 3:15-cv-03754 (voluntarily dismissed
24 without prejudice in February 2019); *IXI Mobile (R&D) Ltd. et al. v. Lenovo Grp. Ltd. et al.*, No. 4:15-
25 cv-05439; *IXI Mobile (R&D) Ltd. et al. v. LG Corp. et al.*, No. 4:15-cv-05442; *IXI Mobile (R&D) Ltd.*
26 *et al. v. Samsung Elecs. Co., Ltd. et al.*, No. 4:15-cv-03752; and *IXI Mobile (R&D) Ltd. et al. v. Apple,*
27 *Inc.*, No. 3:15-cv-03755.
28

1 26. Venue is proper in this District under 28 U.S.C. §§ 1391(b)-(c) because a substantial
2 part of the events giving rise to Samsung’s claim occurred in this District, and because IXI is subject
3 to personal jurisdiction here.

4 27. An immediate, real, and justiciable controversy exists between IXI and Samsung as to
5 whether IXI is estopped from asserting the ’033 Patent against Samsung, whether Samsung is
6 infringing or has infringed the ’033 Patent, and whether the ’033 Patent is invalid. Because this action
7 presents an actual controversy with respect to the enforceability, the noninfringement, and the
8 invalidity of the ’033 Patent, the Court may grant the declaratory relief sought pursuant to 28 U.S.C.
9 § 2201 *et seq.*

10
11 **INTRADISTRICT ASSIGNMENT**

12 28. For purposes of intradistrict assignment under Civil Local Rules 3-2(c) and 3-5(b), this
13 Intellectual Property Action will be assigned on a district-wide basis.

14
15 **CLAIMS FOR RELIEF**

16 **FIRST CLAIM FOR RELIEF**

17 **(Declaratory Judgment That Res Judicata Bars IXI From Asserting U.S. Patent No. 7,039,033
Against Samsung)**

18 29. Samsung repeats and realleges each and every allegation contained in the paragraphs
19 above as if fully set forth herein.

20 30. The ongoing litigation between IXI and Samsung—*IXI Mobile (R&D) Ltd. et al. v.*
21 *Samsung Electronics Co., Ltd. et al.*, No. 4-15-cv-03752—involves the same parties, IXI and
22 Samsung.

23
24 31. In the prior litigation, the Federal Circuit affirmed the PTAB’s final written decision
25 finding the originally asserted claims of the ’033 Patent unpatentable, ultimately resulting in the
26 cancellation of those claims. All appeals have now been exhausted. Accordingly, the PTAB’s final
27 written decision and the Federal Circuit’s affirmance of the PTAB’s final written decision are final
28

1 judgments on the merits. *See XY, LLC v. Trans Ova Genetics, L.C.*, 890 F.3d 1282, 1294 (Fed. Cir.
2 2018) (“[T]he Patent Trial and Appeal Board of the U.S. Patent and Trademark Office (Board) held
3 that these claims are unpatentable in a final written decision from an *inter pares* review proceeding. .
4 . . . [W]e affirm the Board’s decision. . . . ***That affirmance renders final a judgment on the invalidity***
5 of the [asserted patent], and has an immediate issue-preclusive effect on any pending or co-pending
6 actions involving the patent.”) (emphasis added).
7

8 32. The prior litigation involved the same claim or cause of action—assertion of the ’033
9 Patent against Samsung and evaluation of invalidity of the ’033 Patent. *See Senju Pharm. Co. v.*
10 *Apotex Inc.*, 746 F.3d 1344, 1353 (Fed. Cir. 2014) (“[I]n the absence of a clear showing that such a
11 material difference in fact exists in a disputed patentable reexamination claim, it can be assumed that
12 the reexamined claims will be a subset of the original claims and that ***no new cause of action will be***
13 ***created***”) (emphasis added).
14

15 33. Accordingly, res judicata bars IXI from asserting the ’033 Patent against Samsung.

16 34. As a result of the acts described in the foregoing paragraphs, there exists a substantial
17 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

18 35. A judicial declaration is necessary and appropriate so that Samsung may ascertain its
19 rights regarding the ’033 Patent.

20 36. Samsung is entitled to a judicial declaration that res judicata bars IXI from asserting
21 the ’033 Patent against Samsung.
22

23 SECOND CLAIM FOR RELIEF

24 (Declaratory Judgment of Noninfringement of U.S. Patent No. 7,039,033)

25 37. Samsung repeats and realleges each and every allegation contained in the above
26 paragraphs as if fully set forth herein.
27
28

1 38. IXI has alleged and continues to allege that Samsung infringes the '033 Patent. As
 2 explained above, res judicata bars IXI's assertion of the '033 Patent against Samsung. Should the
 3 Court disagree, the Court should enter judgment declaring that Samsung does not infringe the '033
 4 Patent.

5 39. Exemplary claim 65 of the '033 Patent recites:

Limitation	Claim Language (emphasis added)
[P]	A system for providing access to the Internet, comprising:
[a]	a first wireless device, in a short distance wireless network, having a software component to access information from the Internet by communicating with a cellular network in response to a first short-range radio signal wherein the first wireless device communicates with the cellular network and receives the first short-range radio signal,
[b]	wherein the first wireless device comprises router software to establish the short distance wireless network, wherein the router software comprises a routing component for exchange of IP packets;
[c]	wherein the first wireless device includes a speaker, a microphone, and a touchscreen,
[d]	wherein the first wireless device includes software applications including a telephony application, a personal information manager application including emails, and a location application for providing a current location of the first wireless device; and,
[e]	a second wireless device, in the short distance wireless network, to provide the first short-range radio signal,
[f]	wherein the software component includes a <i>network address translator software component to translate between a first Internet Protocol ("IP") address provided to the first wireless device from the cellular network and a second address for the second wireless device provided by the first wireless device,</i>
[g]	wherein the software component includes <i>a service repository software component to identify a service provided by the second wireless device.</i>

26 40. Samsung has not infringed and does not infringe any valid and/or enforceable claim of
 27 the '033 Patent, directly or indirectly, literally or under the doctrine of equivalents, through the
 28

1 manufacture, use, sale, and/or offer for sale of Samsung's accused products. By way of example,
2 Samsung's accused products do not satisfy at least limitations 65[f] and 65[g] of exemplary claim 65.

3 41. First, Samsung's accused products do not include the "network address translator
4 software component" claimed in limitation 65[f] at least because Samsung's accused devices do not
5 include a "network address translator software component" that translates between a first IP address
6 provided to the Samsung device from a cellular network and a second IP address for a different accused
7 Samsung device that is provided by the first accused Samsung device, as claimed in limitation 65[f].
8 For example, Samsung's phones do not include the claimed "network address translator software
9 component" that translates between a first IP address provided to the phone from a cellular network
10 and a second IP address for a tablet connected to a phone via Wireless Hotspot functionality, as
11 claimed in limitation 65[f].
12

13 42. Second, Samsung's accused products do not include a "service repository software
14 component" as claimed in limitation 65[g] at least because Samsung's accused products do not store
15 information that allows applications on multiple devices to discover services.
16

17 43. Thus, Samsung's accused products do not satisfy at least limitations 65[f] and 65[g] of
18 exemplary claim 65. The remaining claims of the '033 Patent are not infringed for at least similar
19 reasons.
20

21 44. As a result of the acts described in the foregoing paragraphs, there exists a substantial
22 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

23 45. A judicial declaration is necessary and appropriate so that Samsung may ascertain its
24 rights regarding the '033 Patent.

25 46. Samsung is entitled to a judicial declaration that it has not infringed and does not
26 infringe the '033 Patent.
27

28 **THIRD CLAIM FOR RELIEF**

(Declaratory Judgment of Invalidity of U.S. Patent No. 7,039,033)

1
2
3 47. Samsung repeats and realleges each and every allegation contained in the paragraphs
4 above as if fully set forth herein.

5 48. As explained above, res judicata bars IXI's assertion of the '033 Patent against
6 Samsung. Should the Court disagree, the Court should enter judgment declaring that the '033 Patent
7 is invalid.

8 49. The '033 Patent is invalid under 35 U.S.C. §§ 102 and/or 103 because its claims are
9 anticipated and/or rendered obvious by prior art. By way of example, exemplary claim 65 is invalid
10 under 35 U.S.C. §§ 102 and/or 103 because it is anticipated and/or obvious in view of prior art.
11

12 50. As an example, claim 65 is invalid as obvious in view of International Publication No.
13 WO 2001/76154 A2 ("Marchand"), U.S. Patent No. 6,560,642 ("Nurmann"), and International
14 Publication No WO 1999/22338 ("Williams"). Claim 65 is identical to claim 1 of the '033 Patent
15 (which the PTAB found unpatentable over Marchand, Nurmann, and U.S. Patent No. 6,771,635
16 ("Vilander")), with the exception that claim 65 further includes (i) router software, (ii) a speaker,
17 microphone, and touch screen, and (iii) software for email and location services. Those additional
18 limitations were not novel or non-obvious in view of the prior art as of the purported May 2001 priority
19 date, including Williams. Claim 65 is therefore invalid.
20

21 51. Marchand discloses "an ad-hoc network ... established for a plurality of devices, and a
22 gateway that provides access through the ad-hoc network to external wireless IP networks." Marchand
23 at 4:15-19. Marchand also discussed mobile phones having multiple IP addresses and receiving IP
24 packets from a network through a "public IP address" and forwarding those packets to a "private IP
25 address" of a destination device. Marchand at 4:23-30; 7:12-17; 10:30-31. Nurmann discloses an IP
26 gateway that establishes local IP networks, performs IP address allocation for devices in a local IP
27 network, and manages routing of IP packets to and from the local IP network. Nurmann at 1:9-12;
28

1 2:54-60; 3:26-46. Williams describes a “portable computer,” such as a cellular telephone, that
2 implements a speaker, a microphone, and a touch screen display. Williams at 5:5-7; 10:24-25; 14:20-
3 22; 17:24-26. Williams discloses multiple functions of a “portable computer,” including email,
4 location functionality, and cellular telephone service. Williams at 14:20-22; 25:12-14; 15:1-2.
5

6 52. The preamble of claim 65 recites a “system for providing access to the Internet.” This
7 limitation is verbatim identical to the preamble of claim 1, which was previously found by the PTAB
8 to be taught by Marchand as supplemented by Nurmann and Vilander. Marchand discloses, or at a
9 minimum renders obvious, this limitation. For example, Marchand’s system includes a mobile phone
10 that operates as a gateway “between an external wireless Internet Protocol (IP) network and devices
11 in the ad-hoc network.” Marchand at 4:21-23. The gateway is “used to connect a plurality of devices
12 [in a Piconet/ad-hoc network] ... to an IP-based network such as the Internet.” Marchand at Fig. 3,
13 13:12-14.
14

15 53. Limitation 65[a] of claim 65 recites “a first wireless device, in a short distance wireless
16 network, having a software component to access information from the Internet by communicating with
17 a cellular network in response to a first short-range radio signal wherein the first wireless device
18 communicates with the cellular network and receives the first short-range radio signal.” This
19 limitation is verbatim identical to the first limitation of claim 1, which was previously found by the
20 PTAB to be taught by Marchand as supplemented by Nurmann and Vilander. Marchand discloses, or
21 at a minimum renders obvious, this limitation. For example, Marchand discloses a mobile phone that
22 is “simultaneously ... connected to a cellular network and to an ad-hoc Bluetooth Piconet.” Marchand
23 at 6:23-25. Devices in Marchand communicate with the mobile phone using a short-range radio link.
24 Marchand at 1:29-31; 7:9-11. During operation, the mobile phone receives IP packets from a public
25 network “through its public IP address, and forwards the received packets to the private IP address of
26 the destination device” in a local network. Marchand at 7:14-17. The mobile phone “also translates
27
28

1 in the other direction for data going out of” the local network to the external IP network. Marchand
2 at 7:14-17. In addition, Marchand discloses software, including a link layer, network transport layer,
3 operating system layer, Java technology layer, JINI technology layer, JINI call control client, and SIP
4 client, performing the functionality of the mobile phone.
5

6 54. Limitation 65[b] of claim 65 recites “wherein the first wireless device comprises router
7 software to establish the short distance wireless network, wherein the router software comprises a
8 routing component for exchange of IP packets.” Marchand and Nurmam render obvious this
9 limitation. For example, Marchand discloses that “[t]he H.323 and/or SIP clients in the mobile phone
10 are enhanced to behave as a server application in order for Bluetooth compliant devices to talk to other
11 device that contain a SIP and/or an H.323 client.” Marchand at 8:25-17. Marchand’s mobile gateway
12 utilizes various types of software components for exchange of IP packets between devices by
13 performing routing and communications over the cellular and local wireless networks, including
14 software components to implement a link layer, network transport layer, operating system layer, Java
15 technology layer, JINI technology layer, Bluetooth radio chipset, and “an interface/Application
16 Programming Interface (API) which is an abstraction of a SIP and/or H.323 call control client.
17 Marchand at 2:14-16; 2:27-31; 6:18-20; 6:27-30. For example, Marchand’s mobile phone includes
18 the protocol stack shown in Marchand’s Fig. 2. Furthermore, Nurmam performs IP address allocation
19 for devices in a local IP network and manages routing of IP packets to and from the local IP network.
20 Marchand at 1:9-12; 2:54-60; 3:26-46. It would have been obvious to implement Nurmam’s DHCP
21 server component on Marchand’s gateway, which, when active, allocates private IP addresses to
22 devices connected to a network. The DHCP server is router software that establishes the short distance
23 wireless network by allocating IP addresses, and it comprises a routing component for exchange of IP
24 packets. Nurmam at 1:20-53; 2:6-67; 3:39-50; 4:36-50.
25
26
27
28

1 55. Limitation 65[c] of claim 65 recites “wherein the first wireless device includes a
2 speaker, a microphone, and a touchscreen.” Marchand and Williams render obvious this limitation.
3 For example, Marchand explains that devices that “provide multimedia and telephony capabilities”
4 would include “microphones, speakers, and video cameras.” Marchand at 7:2-6. Williams discloses
5 that it was well-known to implement a speaker and microphone in a mobile phone and also describes
6 a touch screen. Williams at 5:5-7; 17:24-26. Implementing a speaker and a microphone, as disclosed
7 in Williams, as well as a touchscreen on a wireless device, such as Marchand’s mobile phone, was
8 well-known prior to the ’033 Patent.
9

10 56. Limitation 65[d] of claim 65 recites “wherein the first wireless device includes software
11 applications including a telephony application, a personal information manager application including
12 emails, and a location application for providing a current location of the first wireless device.”
13 Marchand and Williams render obvious this limitation. For example, Marchand’s mobile phone
14 “provides a call-control interface” by implementing “a cellular radio modem and a call control client.”
15 Marchand at 5:3-6; 7:20. In addition, Marchand’s call control client enables its mobile phone to place
16 telephone calls and send email on behalf of devices on the local wireless network. Marchand at 10:18-
17 23. From this disclosure, Marchand renders obvious software including a telephony application and
18 a personal information manager application including emails. Additionally, Williams discloses
19 software for a mobile device that includes “email mode” and an “address book and other applications.”
20 Williams at 1:6-8; 11:15-16; 15:8-17. Williams also discloses “GPS” functionality for a mobile
21 device. Williams at 15:1-2; 15:8-10. By using software with GPS functionality to provide location
22 stamped data, Williams renders obvious a location application for providing a current location of a
23 first wireless device.
24
25

26 57. Limitation 65[e] of claim 65 recites “a second wireless device, in the short distance
27 wireless network, to provide the first short-range radio signal.” This limitation is identical to
28

1 limitations of claim 1, which was previously found by the PTAB to be taught by Marchand as
2 supplemented by Nurmman and Vilander. Marchand discloses, or at a minimum renders obvious, this
3 limitation. For example, Marchand discloses various second devices (e.g., a laptop and printer) in a
4 Bluetooth network sending signals to the mobile phone over short-range radio links. Marchand at 7:9-
5 11; 7:18-21.

6
7 58. Limitation 65[f] of claim 65 recites “wherein the software component includes a
8 network address translator software component to translate between a first Internet Protocol (“IP”)
9 address provided to the first wireless device from the cellular network and a second address for the
10 second wireless device provided by the first wireless device.” This limitation is identical to limitations
11 of claim 1, which was previously found by the PTAB to be taught by Marchand as supplemented by
12 Nurmman and Vilander. Marchand discloses, or at a minimum renders obvious, this limitation. For
13 example, Marchand’s “mobile phone receives IP packets from the GPRS network through its public
14 IP address, and forwards the received packets to the private IP address of the destination in the
15 Piconet.” Marchand at 10:31-11:2. The mobile phone “also translates in the other direction for data
16 going out of the Piconet to the GPRS network.” Marchand at 7:14-17. That translation of a “public IP
17 address” of the mobile phone in an IP packet received from the GPRS network “to the private IP
18 address of the appropriate device” is performed by a network address translator software component
19 of the mobile phone.
20

21
22 59. Limitation 65[g] of claim 65 recites “wherein the software component includes a
23 service repository software component to identify a service provided by the second wireless device.”
24 This limitation is identical to limitations of claim 1, which was previously found by the PTAB to be
25 taught by Marchand as supplemented by Nurmman and Vilander. Marchand discloses, or at a
26 minimum renders obvious, this limitation. For example, Marchand’s devices in a Bluetooth network
27 can “discover, join, and download services” from a JINI Lookup Service. Marchand at 6:19-22; 7:23-
28

1 25; 8:11-28. The JINI Lookup Service is provided “for making services available to the plurality of
2 devices in the Piconet” and “contains a list of available services provided by other devices.” Marchand
3 at 3:11-12; 5:13-14. The JINI Lookup Service corresponds to the “service repository software
4 component” because it identifies and provides services from one device to another in a Bluetooth
5 network and is implemented using software.
6

7 60. In addition, the claims of the ’033 Patent are invalid under 35 U.S.C. §§ 102 and/or 103
8 in view of the prior art cited in Samsung’s Invalidation Contentions served in *IXI Mobile (R&D) Ltd. et*
9 *al. v. Samsung Electronics Co., Ltd. et al.*, No. 4:2015-cv-03752 and the 2014 Litigations.

10 61. In addition, the claims of the ’033 Patent are invalid under 35 U.S.C. §§ 102 and/or 103
11 in view of the prior art cited in Apple’s Invalidation Contentions served in *IXI Mobile (R&D) Ltd. et al.*
12 *v. Apple Inc.*, No. 3:2015-cv-03755 and the 2014 Litigations.
13

14 62. In addition, the claims of the ’033 Patent are invalid under 35 U.S.C. §§ 102 and/or 103
15 in view of the prior art cited in the petitions for *inter partes* review filed in Case Nos. IPR2019-00124,
16 IPR2019-00125, IPR2019-00139, IPR2019-00140, IPR2019-00141, and IPR2019-00181.

17 63. In addition, the claims of the ’033 Patent are invalid under 35 U.S.C. §§ 102 and/or 103
18 in view of the prior art cited in *Ex Parte* Re-Examination No. 90/014,330, currently pending in the
19 PTO.
20

21 64. As a result of the acts described in the foregoing paragraphs, there exists a substantial
22 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

23 65. A judicial declaration is necessary and appropriate so that Samsung may ascertain its
24 rights regarding the ’033 Patent.

25 66. Samsung is entitled to a judicial declaration that the ’033 Patent is invalid.
26
27
28

PRAYER FOR RELIEF

Samsung respectfully requests the following relief:

- A. That the Court enter a judgment declaring that res judicata bars IXI from asserting the '033 Patent against Samsung;
- B. That the Court enter a judgment declaring that Samsung has not infringed and does not infringe any valid and enforceable claim of the '033 Patent;
- C. That the Court enter a judgment declaring that the '033 Patent is invalid;
- D. That the Court declare that this case is exceptional under 35 U.S.C. § 285 and award Samsung its attorneys' fees, costs, and expenses incurred in this action;
- E. That the Court award Samsung any and all other relief to which Samsung may show itself to be entitled; and
- F. That the Court award Samsung any other relief as the Court may deem just, equitable, and proper.

JURY DEMAND

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

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

1 DATED: October 18, 2019

Respectfully submitted,

2 /s/ Brandon Brown

3 Brandon Brown (SBN 266347)
4 KIRKLAND & ELLIS LLP
5 555 California Street
6 San Francisco, California 94104
7 Telephone: (415) 439-1400
8 Facsimile: (415) 439-1500
9 brandon.brown@kirkland.com

7 Gregory S. Arovas (*pro hac vice* pending)
8 Todd M. Friedman (*pro hac vice* pending)
9 KIRKLAND & ELLIS LLP
10 601 Lexington Avenue
11 New York, NY 10022
12 Telephone: (212) 446-4800
13 Facsimile: (212) 446-4900
14 Email: greg.arovas@kirkland.com
15 Email: todd.friedman@kirkland.com

12 David Rokach (*pro hac vice* pending)
13 G. William Foster (*pro hac vice* pending)
14 KIRKLAND & ELLIS LLP
15 300 N. LaSalle Avenue
16 Chicago, Illinois 60654
17 Telephone: (312) 862-2000
18 Facsimile: (312) 862-2200
19 Email: david.rokach@kirkland.com
20 Email: billy.foster@kirkland.com

17 *Attorneys for Plaintiffs*
18 *Samsung Electronics Co., Ltd. and*
19 *Samsung Electronics America, Inc.*