

1 J. DAVID HADDEN (CSB No. 176148)  
dhadden@fenwick.com  
2 SAINA S. SHAMILOV (CSB No. 215636)  
sshamilov@fenwick.com  
3 RAVI R. RANGANATH (CSB No. 272981)  
rranganath@fenwick.com  
4 FENWICK & WEST LLP  
Silicon Valley Center  
5 801 California Street  
Mountain View, CA 94041  
6 Telephone: 650.988.8500  
Facsimile: 650.938.5200

7  
8 TODD R. GREGORIAN (CSB No. 236096)  
tgregorian@fenwick.com  
FENWICK & WEST LLP  
9 555 California Street  
San Francisco, CA 94104  
10 Telephone: 415.875.2300  
Facsimile: 415.281.1350

11 Attorneys for AMAZON.COM, INC.

12  
13 UNITED STATES DISTRICT COURT  
14 NORTHERN DISTRICT OF CALIFORNIA

15  
16 AMAZON.COM, INC.,  
17 Plaintiff,  
18 v.  
19 SONOHM LICENSING LLC,  
20 Defendant.

Case No.:  
**COMPLAINT FOR DECLARATORY  
JUDGMENT**  
**DEMAND FOR JURY TRIAL**

FENWICK & WEST LLP  
ATTORNEYS AT LAW

1 Plaintiff Amazon.com, Inc. (“Amazon”) files this complaint against Defendant Sonohtm Li-  
2 censing LLC (“Sonohtm”) and alleges:

### 3 NATURE OF THE ACTION

4 1. This is an action to protect Amazon’s customer Best Buy Co., Inc. (“Best Buy”),  
5 and potentially other customers, from meritless patent lawsuits. Sonohtm filed a lawsuit, *Sonohtm*  
6 *Licensing LLC v. Best Buy Co., Inc.*, Case No. 1:19-cv-01620-UNA (D. Del.), on August 29, 2019.  
7 (**Exhibit A.**) In it, Sonohtm accuses Best Buy of patent infringement based on allegations that Best  
8 Buy “uses” patented methods by offering Amazon products for sale, including Amazon Fire HD 8,  
9 Amazon Fire Kids Edition 7, Amazon Fire HD 10, Amazon Fire HD 10 Kids Edition, and Amazon  
10 Fire 7 (“Amazon Accused Products”).

11 2. Lawsuits like Sonohtm’s against Best Buy reflect a common strategy among patent  
12 assertion entities. A product’s manufacturer knows its technology inside and out and is therefore  
13 well-positioned to defend a baseless infringement claim. Downstream retailers generally lack such  
14 knowledge. By ignoring the manufacturer and suing retailers, a patent assertion entity can secure  
15 in terrorem settlements from retailers who decide they are ill-equipped to defend an unfamiliar  
16 technology and do not want their business relationships disrupted.

17 3. Any dispute about whether Amazon’s technology infringes Sonohtm’s purported pa-  
18 tented methods must be litigated in this case alone. Federal Circuit law could not be clearer. Rec-  
19 ognizing the problem caused by customer suits, it has held that the upstream manufacturer or sup-  
20 plier—here, Amazon—must be given the opportunity to defend its own technology. “[L]itiga-  
21 tion . . . brought by the manufacturer of infringing goods takes precedence over a suit by the patent  
22 owner against customers of the manufacturer,” and thus any customer cases—here, Sonohtm’s case  
23 against Best Buy—must be stayed or enjoined pending resolution of the manufacturer action. *See*  
24 *Katz v. Lear Siegler, Inc.*, 909 F.2d 1459, 1464 (Fed. Cir. 1990); *see also In re Google Inc.*, 588 F.  
25 App’x 988, 990 (Fed. Cir. 2014); *In re Nintendo of Am., Inc.*, 756 F.3d 1363, 1365 (Fed. Cir. 2014).  
26 To that end, the Federal Circuit has expressly empowered district courts presiding over a manufac-  
27 turers’ declaratory judgment action to enjoin collateral and duplicative customer suits. *Katz*, 909  
28 F.2d at 1463-64.



1 in the case against Best Buy. (**Exhibit A.**) Sonohm therefore has established the requisite minimum  
2 contacts with this district, and exercise of jurisdiction here would comport with traditional notions  
3 of substantial justice and fair play. *See, e.g., Avocent Huntsville Corp. v. Aten Int'l Co.*, 552 F.3d  
4 1324, 1336 (Fed. Cir. 2008); *Viam Corp. v. Iowa Export-Import Trading Co.*, 84 F.3d 424, 430 (Fed.  
5 Cir. 1996); *Kyocera Commc 'ns, Inc v. Potter Voice Techs. LLC*, No. 13-cv-0766-H(BGS), 2013 WL  
6 2456032, at \*3 (S.D. Cal. June 5, 2013).

7 9. Venue is proper in this court under 28 U.S.C. § 1391 because Sonohm is subject to  
8 personal jurisdiction in this district.

9 10. Amazon has numerous offices in this District. These offices employ a large number  
10 of employees. Among these employees are witnesses who may have knowledge relevant to the  
11 issues in this case. A significant portion of the design and development of the Amazon Accused  
12 Products occurred in this District.

#### 13 **INTRADISTRICT ASSIGNMENT**

14 11. Pursuant to Civil L.R. 3-2(c), divisional assignment is unnecessary because this is  
15 an intellectual property action.

#### 16 **FACTUAL BACKGROUND**

17 12. The Fire Series tablets are designed and engineered by Amazon, and are high per-  
18 formance tablets designed for entertainment at an affordable price. Amazon first offered its Fire  
19 Series tablet computers in 2011. Since this launch, Fire Series tablets have been popular among  
20 U.S. consumers.

21 13. Best Buy is one of the retailers of the Fire Series tablets. Best Buy did not participate  
22 in the design or development of the Fire Series tablets. Best Buy's sole role in connection with the  
23 Fire Series tablets is distributing the tablets via its retail stores and its website.

24 14. On August 29, 2019, Sonohm filed a lawsuit against Amazon's customer Best Buy  
25 in the District of Delaware, alleging infringement of the '207 Patent, the '705 Patent, and U.S.  
26 Patent No. 8,843,641. (**Exhibit A.**)

27 15. Sonohm purports to be the assignee of all right, title and interest in the '207 Patent  
28 (**Exhibit C**) and the '705 Patent (**Exhibit D**).

1           16.     The complaint alleges that Best Buy infringes the '207 Patent by using, *inter alia*,  
2 the Amazon Accused Products:

3                     Upon information and belief, Defendant has been directly infringing  
4 at least claim 11 of the '207 patent in Delaware, and elsewhere in  
5 the United States, by performing actions comprising at least using  
6 or performing the claimed method for improving voice quality in  
7 cordless communications by using Amazon Fire HD 8, Amazon Fire  
8 Kids Edition 7, Amazon Fire HD 10, Amazon Fire HD 10 Kids Edi-  
9 tion, Amazon Fire 7, ... ("Accused Instrumentality").

8     **(Exhibit A at 7.)**

9           17.     It also alleges that Best Buy infringes the '705 Patent by using, *inter alia*, the Ama-  
10 zon Accused Products:

11                    Upon information and belief, Defendant has been directly infringing  
12 at least claim 1 of the '705 patent in Delaware, and elsewhere in the  
13 United States, by performing actions comprising at least using or  
14 performing the claimed method by using Amazon Fire HD 8, Ama-  
15 zon Fire Kids Edition 7, Amazon Fire HD 10, Amazon Fire HD 10  
16 Kids Edition, Amazon Fire 7, ... ("Accused Instrumentality").

15     *(Id.* at 18.)

16           18.     The Amazon Accused Products do not infringe any claim of the '207 Patent or  
17 the '705 Patent, either directly or indirectly.

18           19.     Amazon has a direct and substantial interest in defeating any patent infringement  
19 claims relating to the Amazon Accused Products at issue in Sonohm's complaint against Best Buy.  
20 Sonohm's infringement allegations directly implicate Amazon and its technology and give rise to  
21 implied infringement claims against Amazon.

22           20.     Best Buy has requested indemnification in connection with the suit by Sonohm, and  
23 Amazon has agreed to indemnify Best Buy. Accordingly, Amazon has standing to assert claims for  
24 declaratory judgment against Sonohm. *See Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 904  
25 (Fed. Cir. 2014); *Arris Grp., Inc. v. British Telecomms. PLC*, 639 F.3d 1368, 1375 (Fed. Cir. 2011).

26           21.     This controversy is between parties having adverse legal interests and is of sufficient  
27 immediacy and reality to warrant issuance of a declaratory judgment under 28 U.S.C. § 2201(a) as  
28 to the alleged infringement of the patents in suit by Amazon customer using Amazon technology.

1           22.     On September 30, 2019, Sonohm filed a lawsuit against a third-party Arbor Solution,  
2 Inc. in the Northern District of California, alleging infringement of the same '207 and '705 Patents.  
3 **(Exhibit B.)** Pursuant to 28 U.S.C. §§ 1331 and 1338, and 28 U.S.C. §§ 2201 and 2202, Sonohm  
4 is subject to suit in the Northern District of California.

5           23.     Amazon has therefore brought this action here to obtain just and speedy resolution  
6 of this dispute, to relieve Amazon's customer of the unnecessary burden of litigating a meritless  
7 case that targets the Amazon Accused Products, and to once and for all remove the cloud of uncer-  
8 tainty that has been cast over the Amazon Accused Products. *Goodyear Tire & Rubber Co. v. Re-*  
9 *leasomers, Inc.*, 824 F.2d 953, 956 (Fed. Cir. 1987) ("the purpose of the Declaratory Judgment  
10 Act . . . in patent cases is to provide the allegedly infringing party relief from uncertainty and delay  
11 regarding its legal rights"); *Elecs. for Imaging, Inc. v. Coyle*, 394 F.3d 1341, 1347 (Fed. Cir. 2005)  
12 (where patentee's "forceful threats [against customers] created a cloud over [supplier's] business,  
13 shareholders, and customers, and [supplier's] potential liability increased as it continued to sell the  
14 allegedly infringing products," supplier "entitled under the Declaratory Judgment Act to seek a  
15 timely resolution of . . . threats of litigation and remove itself from 'the shadow of threatened in-  
16 fringement litigation'") (citation omitted).

17                   **FIRST CAUSE OF ACTION—DECLARATION OF NON-INFRINGEMENT**  
18                   **(U.S. PATENT NO. 6,651,207)**

19           24.     Amazon restates and incorporates by reference each of the allegations in the preced-  
20 ing paragraphs of this complaint.

21           25.     Sonohm has alleged and continues to allege that use or incorporation of Amazon's  
22 technology infringes claims of the '207 patent.

23           26.     Amazon has not and does not make, use, offer for sale, or import any product, ser-  
24 vice, or technology that infringes, induces, or contributes to any infringement of, any claim of the  
25 '207 patent either literally or under the doctrine of equivalents. Nor does Amazon's technology,  
26 including the Amazon Accused Products, infringe the '207 patent either literally or under the doc-  
27 trine of equivalents.

28           27.     The '207 patent is directed to a system and method for improving voice quality of

1 cordless communications. Claim 11, for example, recites: “A method for improving voice quality  
2 in cordless communications, comprising: selecting a unique carrier frequency over an individual  
3 communication link, the communication link operable to carry data between at least one mobile  
4 unit and a base station; monitoring the quality of the selected frequency during a first time period;  
5 selecting another frequency after the first time period to transmit and receive data over the commu-  
6 nication link; after selecting the another frequency, selecting, during a second time period, the fre-  
7 quency that was monitored during the first time period; and performing, during the second time  
8 period, error correction on the selected frequency in response to the monitored quality monitored  
9 during the first time period.”

10 28. Neither Amazon nor its technology, including the Amazon Accused Products, in-  
11 fringes the '207 patent directly or indirectly, literally or under the doctrine of equivalents, for at  
12 least the following reasons. For example, on information and belief, Bluetooth 4.0 (or later version)  
13 does not perform error correction on the selected frequency in response to the monitored quality  
14 monitored during the first time period. The Amazon Accused Products, therefore, do not meet at  
15 least the claim requirement of “performing, during the second time period, error correction on the  
16 selected frequency in response to the monitored quality monitored during the first time period” of  
17 claim 11 and similar claim limitations in the other claims of the '207 patent.

18 29. An actual and justiciable controversy exists between Amazon and Sonohm as to  
19 Amazon’s non-infringement of the '207 patent.

20 30. Pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201, et seq., Am-  
21 azon seeks a declaration that it does not infringe any claim of the '207 patent.

22 **SECOND CAUSE OF ACTION—DECLARATION OF NON-INFRINGEMENT**  
23 **(U.S. PATENT NO. 7,106,705)**

24 31. Amazon restates and incorporates by reference each of the allegations in the preced-  
25 ing paragraphs of this complaint.

26 32. Sonohm has alleged and continues to allege that use or incorporation of Amazon’s  
27 technology infringes claims of the '705 patent.

28



- 1 B. A declaration that Amazon does not infringe any claim of the '705 Patent;
- 2 C. An injunction against Sonohm, and all persons acting on its behalf or in concert with
- 3 it, restraining them from further prosecuting or instituting any action alleging that
- 4 any Amazon method, product, or technology, or others' use thereof, infringes any
- 5 claim of any of the '207 and '705 Patents;
- 6 D. An award of costs and attorneys' fees to Amazon; and
- 7 E. Such other and further relief as the Court deems just and reasonable.

**JURY TRIAL DEMAND**

8  
9 Pursuant to Fed. R. Civ. P. 38(b) and Local Rule 3-6, Plaintiff Amazon.com hereby demands  
10 a trial by jury of all issues so triable.

11 Respectfully submitted,

12  
13 November 13, 2019

FENWICK & WEST LLP

14 By: /s/ J. David Hadden

15 J. David Hadden  
16 Saina S. Shamilov  
17 Ravi R. Ranganath  
18 Todd R. Gregorian

*Counsel for Amazon.com, Inc.*

FENWICK & WEST LLP  
ATTORNEYS AT LAW

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