

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

SIMPLISAFE, INC.,

Plaintiff,

v.

**SKYBELL TECHNOLOGIES, INC.,
SB IP HOLDINGS, LLC, AND
EYETALK365, LLC,**

Defendants.

Civil Action No.: 1:20-cv-12288

Hon. Judge Alison D. Burroughs

JURY TRIAL DEMANDED

AMENDED COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff SimpliSafe, Inc. for its amended complaint against Defendants SkyBell Technologies, Inc., SB IP Holdings, LLC, and Eyetalk365, LLC (collectively, “Defendants”), hereby alleges as follows:

NATURE OF THE ACTION

1. Pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, and the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, this is an action for declaratory judgment of non-infringement and invalidity of United States Patent Nos. 10,200,660 (“the ’660 patent”), 10,097,796 (“the ’796 patent”), 10,097,797 (“the ’797 patent”), 9,485,478 (“the ’478 patent”), 9,432,638 (“the ’638 patent”), 10,523,906 (“the ’906 patent”), and 10,674,120 (“the ’120 patent”) (collectively, the “Asserted Patents,” attached hereto as Exs. A-G), and for such other relief as the Court deems just and proper.

PARTIES

2. Plaintiff SimpliSafe, Inc. (“SimpliSafe”) is a Delaware corporation with its principal place of business at 294 Washington Street, 9th Floor, Boston, Massachusetts 02108. SimpliSafe was founded in 2006 by then-Harvard Business School students, Chad and Eleanor Laurans, after several friends in the Cambridge area experienced break-ins but could not find a security company that was designed to help renters. Since 2006, SimpliSafe has been providing premier security system services. In July 2020, CNET named SimpliSafe the best “do-it-yourself” alarm system, and in December 2020 U.S. News & World Report named SimpliSafe’s Home Security #1 in the categories of “Best Home Security Systems of 2020,” “Best DIY Home Security Systems of 2020,” “Best Self-Monitored Home Security Systems of 2020,” and “Best Wireless Home Security System 2020.” SimpliSafe has approximately 800 employees.

3. Upon information and belief, Defendant SkyBell Technologies Inc. (“SkyBell”) is a corporation organized and existing under the laws of the State of Nevada, having a principal place of business at 1 Jenner #100, Irvine, California 92618.

4. Upon information and belief, Defendant SB IP Holdings, LLC (“SB IP”) is a Delaware limited liability company formed in 2019. Upon information and belief, SkyBell is the sole member of SB IP, and SkyBell wholly owns SB IP.

5. Upon information and belief, Eyetalk365, LLC (“Eyetalk365”) is a limited liability corporation organized and existing under the laws of the state of North Carolina, having a principal place of business at 12213 Potts Plantation Circle, Cornelius, North Carolina 28031.

JURISDICTION AND VENUE

6. This action arises under the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, and under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*

7. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, 2202, and the patent laws of the United States, including 35 U.S.C. § 271 *et seq.*

8. SimpliSafe is an award-winning provider of home security products and services.

9. Among the products manufactured and sold by SimpliSafe are the Video Doorbell Pro doorbell and SimpliCam camera.

10. On December 16, 2020, Defendants sent SimpliSafe a letter accusing SimpliSafe's Video Doorbell Pro and SimpliCam of directly and/or indirectly infringing the Asserted Patents ("Defendants' December 2020 Letter"). Ex. H.

11. On December 18, 2020, Defendants filed a complaint with the International Trade Commission ("ITC") pursuant to Section 337 of the Tariff Act of 1930, as amended, seeking to exclude SimpliSafe's Video Doorbell Pro and SimpliCam from importation into the United States based on Simplisafe's alleged infringement of the Asserted Patents. *See* Ex. I (the "ITC Complaint").

12. In light of the foregoing, there is an actual dispute and controversy between the parties under the patent laws, 35 U.S.C. §§ 101 *et seq.*, regarding whether the Asserted Patents are invalid, unenforceable, and infringed.

13. Personal jurisdiction over Defendants in Massachusetts is proper because, as explained below, Defendants have directed and continue to direct acts to Massachusetts, including acts pertaining to the Asserted Patents. As a result, Defendants have, and have had, continuous and systematic contacts within Massachusetts, and have purposefully directed business activities into and in Massachusetts. In addition, a substantial part of the events giving rise to the claims

alleged in this Complaint occurred in Massachusetts, and Defendants are therefore subject to personal jurisdiction in this District.

14. The Court also has specific personal jurisdiction over all Defendants under the Massachusetts long-arm statute, Mass. Gen. Laws ch. 223A, § 3. Defendants' December 2020 Letter constitutes transacting business in Massachusetts because Defendants' December 2020 Letter was sent to SimpliSafe, a resident of Massachusetts, accusing SimpliSafe's Video Doorbell Pro and SimpliCam of infringing the Asserted Patents. Ex. H. SimpliSafe's declaratory judgment claims arise out of and relate to the December 2020 letter.

15. Defendants addressed the December 2020 Letter to SimpliSafe via SimpliSafe's registered agent for service in Delaware, knowing the letter would be transmitted to SimpliSafe's Boston, Massachusetts headquarters. Del. Code Ann. tit. 6, § 15-111(e)(3) ("Every registered agent shall [a]ccept service of process and other communications directed to the partnerships for which it serves as registered agent and forward same to the partnership to which the service or communication is directed[.]"). *See* Ex. H. Defendants therefore elected to transact business in Massachusetts and availed themselves of the privilege of conducting their business activities within Massachusetts.

16. Defendants have purposefully directed their activities at SimpliSafe, a resident of Massachusetts, and SimpliSafe's claim arises out of Defendants' activities with Massachusetts. Defendants' purposefully directed their activities at Massachusetts-resident SimpliSafe by sending the December 2020 Letter to SimpliSafe in Massachusetts. Defendants expected that litigation would result after sending this letter. In fact, two days later, Defendants filed a complaint in the ITC against SimpliSafe. Ex. I.

17. The filing of the ITC complaint against SimpliSafe, a resident of Massachusetts, seeking to exclude SimpliSafe's Video Doorbell Pro and SimpliCam from importation into the United States based on SimpliSafe's alleged infringement of the Asserted Patents further demonstrates that Defendants have purposefully directed their activities at SimpliSafe in Massachusetts. *See* Ex. I. SimpliSafe's declaratory judgment claims further arise out of and relate to this ITC Complaint.

18. Defendants have conducted or are planning on conducting business activity related to the Asserted Patents in Massachusetts. Defendants have also undertaken a licensing program, with both threats of litigation and the filings of litigation, directed to SimpliSafe for conducting business activity in Massachusetts. Litigating in this jurisdiction will not be unduly burdensome for Defendants.

19. Eyetalk365's sole business is to license the Asserted Patents, including through threats of and actual litigation. In November 2018, EyeTalk365 sent SimpliSafe a letter regarding a potential patent license, including to certain of the Asserted Patents. Ex. J. EyeTalk and SimpliSafe, through SimpliSafe's Boston counsel, engaged in discussions for approximately nine months before Eyetalk365 ended those discussions without explanation.

20. Eyetalk365 also asserts it licensed the Asserted Patents to SkyBell in October 2017. *See* Ex. I, ¶¶ 1.5-1.6, 4.2, 4.10, 4.18, 4.26, 4.34, 4.42, 4.50. SkyBell offers for sale or sells video doorbell products that alleged practice the Asserted Patents in Massachusetts directly and through its partnerships with business-to-business customers. For example, Wayne Alarm, located in Lynn, Massachusetts offers SkyBell video doorbells for sale. Ex. K. Alarm New England, located in Boston, Massachusetts and Cape Cod, also offers SkyBell video doorbells for sale. Exs. L-M.

Defendants allege that SkyBell's video doorbell products practice the Asserted Patents. Ex. I, ¶ 7.2.

21. According to Defendants, SB IP's sole business is to license the Asserted Patents, including through threats of and actual litigation. Defendants have further alleged that "Eyetalk and SB IP reached an agreement in December 2019, with provisions requiring scheduled payments before SB IP can officially own the Eyetalk patent portfolio, including the Asserted Patents. In the meantime, SB IP . . . has the right to assert the Asserted Patents in litigation, to grant licenses, and to exclude others from practicing the inventions in the Asserted Patents. During this time period, Eyetalk is contractually obligated to assist SkyBell in the assertion of the Eyetalk patent portfolio, including the Asserted Patents." Ex. I, ¶ 1.6. SB IP is allegedly a wholly owned subsidiary of SkyBell, and SkyBell is alleged to be SB IP's only member. *Id.* ¶¶ 1.6, 2.7.

22. As such, asserting personal jurisdiction over all of the Defendants, who are transacting business in Massachusetts and targeting a Massachusetts corporation, will comport with the traditional notions of fair play and substantial justice.

23. Venue is proper in this District under 28 U.S.C. §§ 1391(b) & (c) because Defendants are subject to personal jurisdiction here.

COUNT ONE

DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '660 PATENT

24. Paragraphs 1 through 23 are incorporated by reference as if fully stated herein.

25. Defendants claim to own all rights, title, and interest in the '660 patent.

26. In filing the ITC Complaint, Defendants accused SimpliSafe of "directly infring[ing] claim 9 of the '660 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . .

the SimpliSafe [Video] Doorbell Camera” and “directly infring[ing] claims 13, 14, 16, and 18 of the ’660 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . . the SimpliSafe SimpliCam.” Ex. I, ¶¶ 5.67, 5.69.

27. Defendants also accused SimpliSafe of “indirectly infring[ing] claim [9 of the ’660 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe [Video] Doorbell Camera and/or perform all or some of the steps recited in claim 9 of the ’660 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a patented process, when such material or apparatus is especially adapted for use in the infringement of the ’660 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use” and of “indirectly infring[ing] claim[s] [13, 14, 16, and 18 of the ’660 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe SimpliCam and/or perform all or some of the steps recited in claims 13, 14, 16, and 18 of the ’660 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a patented process, when such material or apparatus is especially adapted for use in the infringement of the ’660 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.” *Id.*

28. Contrary to Defendants’ assertions in the ITC Complaint, the SimpliSafe Video Doorbell Camera does not infringe—directly or indirectly—claim 9 of the ’660 patent, and the SimpliSafe SimpliCam does not infringe—directly or indirectly—claims 13, 14, 16, and 18 of the ’660 patent.

29. The SimpliSafe Video Doorbell Camera also does not perform substantially the same function, in substantially the way, to obtain substantially the same result as claim 9 of the '660 patent, and the SimpliSafe SimpliCam does not perform substantially the same function, in substantially the way, to obtain substantially the same result as claims 13, 14, 16, and 18 of the '660 patent.

30. Absent a declaration that any asserted claims of the '660 patent are not infringed, Defendants will continue to wrongfully assert the '660 patent against SimpliSafe, thereby causing SimpliSafe irreparable harm and injury.

31. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and SimpliSafe as to whether the claims of the '660 patent are infringed. A judicial declaration is necessary and appropriate so that SimpliSafe may ascertain its rights regarding the '660 patent.

32. Based on the foregoing, SimpliSafe hereby requests a declaration that the claims of the '660 patent are not infringed by the SimpliSafe Video Doorbell Camera and the SimpliSafe SimpliCam.

COUNT TWO

DECLARATORY JUDGMENT OF INVALIDITY OF THE '660 PATENT

33. Paragraphs 1 through 32 are incorporated by reference as if fully stated herein.

34. The '660 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 and/or under the doctrine of double patenting, at least because they attempt to claim the abstract idea of receiving and wirelessly communicating with a visitor at an entrance. The claims also recite well-known conventional off-the-shelf components that in combination do not provide

an inventive concept sufficient to transform this abstract idea into a patent-eligible application of the idea.

35. Moreover, detection, viewing, communication, and monitoring systems comprising at least the transmission, storage, and/or accessibility of related information or data was well-known in the prior art prior to the priority date of the '660 Patent. In particular, as explained below due to the break in co-pendency, the claims of the '660 Patent are invalid under 35 U.S.C. §§ 102 and 103 in view of U.S. Patent Application No. 13/453,100, U.S. Patent Application No. 11/929,464, U.S. Patent Application No. 11/618,615, U.S. Patent Application No. 10/682,185, U.S. Patent Publication No. US 2012/0262581, U.S. Patent Publication No. 2008/0117299, U.S. Patent Publication No. 2007/0103548, U.S. Patent Publication No. 2005/0285934, U.S. Patent No. 8,164,614, U.S. Patent No. 8,154,581, U.S. Patent No. 7,193,644 and U.S. Provisional Application No. 60/418,384 (collectively "the Priority Art"), attached hereto as Exs. T-X.

36. Additionally, the asserted claims of the '660 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 7,119,609 (Naidoo et al.); Published U.S. App. No. 2019/0058720 (Lindquist); U.S. Pat. No. 6,542,078 (Script et al.); U.S. Pat. No. 6,828,909 (Script et al.); U.S. Pat. No. 7,113,090 (Saylor et al.), Published United Kingdom App. GB2357387 (Golightly et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2002/0075307 (Alexander et al.); U.S. Pat. No. 5,861,804 (Fansa et al.); U.S. Pat. No. 6,069,655 (Seeley et al.); U.S. Pat. No. 6,385,772

(Courtney); U.S. Pat. No. 6,400,265 (Saylor et al.); U.S. Pat. No. 6,424,371 (Wen); U.S. Pat. No. 7,019,770 (Katz); U.S. Pat. No. 7,242,295 (Milinusic et al.); U.S. Pat. No. 7,277,010 (Joao); Korea Pat. No. KR100373449 (Son); U.S. Pat. No. 6,359,560 (Budge et al.); Published U.S. App. 2003/0046557 (Miller et al.); Published PCT App. WO99/006976 (Meyvis); X10 Wireless Technology, Inc.'s XCam2 (technical user manual http://www.electronicoscaldas.com/datasheet/XCam2-WideEye_X10.pdf).

37. Furthermore, the asserted claims of the '660 Patent are invalid as obvious under 35 U.S.C. § 103 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 9,300,921 (Naidoo et al.); Published U.S. App. 2003/0071724 (D'Amico); Duy Nguyen, "Mobile Home Security with GPRS" (2002); China Pat. No. CN2589640Y (Hudlin); U.S. Pat. No. 5,428,388 (von Bauer et al.); U.S. Pat. No. 5,717,379 (Peters); U.S. Pat. No. 6,064,303 (Klein et al.); U.S. Pat. No. 6,097,429 (Seeley et al.); U.S. Pat. No. 6,421,080 (Lambert); U.S. Pat. No. 5,151,945 (Lee et al.); U.S. Pat. No. 6,816,085 (Haynes et al.); U.S. Pat. No. 6,943,682 (Dowens et al.); U.S. Pat. No. 6,956,478 (Oyagi et al.); U.S. Pat. No. 7,012,523 (Stuart); U.S. Pat. No. 9,250,267 (Jackson et al.); Published U.S. App. 2002/0030583 (Jang et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2002/0147982 (Naidoo et al.); Published U.S. App. 2003/0095184 (Lin); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2003/0122514 (Mercier et al.); Published U.S. App. 2004/0080615 (Klein et al.); Published U.S. App. 2004/0080627 (Kroll et al.); Published U.S. App. 2005/0001717 (Bohbot et al.); Published U.S. App. 2005/0165612 (Van Rysselberghe); Published U.S. App. 2009/0224912 (Sobol); Published Germany App. DE10039263; France Pat.

No. FR2759804; Published United Kingdom App. GB2285365 (Yau et al.); Published United Kingdom App. GB2377582 (Hunter); Published Japan App. JPH09-107409 (Onozuka); Published Japan App. JPH11-224383 (Kumagai); Published Korea App. KR19980039422 (Kim et al.); Published Korea App. KR20010074212 (Shin); Published PCT App. WO2002/05220 (Bennett); Published PCT App. WO2003/028375 (Hong); U.S. Pat. No. 5,822,542 (Smith et al.); U.S. Pat. No. 5,878,283 (House et al.); U.S. Pat. No. 6,060,994 (Chen); U.S. Pat. No. 6,104,785 (Chen); U.S. Pat. No. 6,134,303 (Chen); U.S. Pat. No. 6,185,294 (Chornenky et al.); U.S. Pat. No. 6,323,897 (Kogane et al.); U.S. Pat. No. 6,476,858 (Diaz et al.); Published U.S. App. 2002/0016971 (Berezowski et al.); Published U.S. App. 2002/0067259 (Fufidio et al.); Published U.S. App. 2002/0071031 (Lord et al.); Published U.S. App. 2002/0076049 (Boykin et al.); Published U.S. App. 2002/0118283 (Guerrero); Published U.S. App. 2003/0061344 (Monroe); Published U.S. App. 2003/0062997 (Naidoo et al.); Published U.S. App. 2003/0075287 (Weik); Published U.S. App. 2003/0081747 (Ahlstrom et al.); Published U.S. App. 2003/0103138 (Assayag et al.); Published U.S. App. 2003/0171930 (Junqua); Published U.S. App. 2003/0206101 (Dixon et al.); Published U.S. App. 2004/0003051 (Krzyzanowski et al.); Published U.S. App. 2004/0036603 (Bingham); Published U.S. App. 2006/0095539 (Renkis); Published U.S. App. 2006/0171453 (Rohlfing et al.); Published U.S. App. 2006/0255931 (Hartsfield et al.); Published Canada App. CA2228679 (Heggie et al.); Published Germany App. DE20101205; Published Japan App. JP2001086486 (Kogane et al.); Japan Pat. No. JP2001167365 (Ishikawa et al.); Published Japan App. JPH11-112494 (Yamaguchi et al.); Published PCT App. WO01/027763 (Simerly et al.); Published PCT App. WO01/050731 (Noyman et al.); Published PCT App. WO01/097524 (Scaman et al.); Published PCT App. WO02/065420 (Vojtech et al.); Published Korea App. KR20010035246A (Lee); “Motion Activated Video Surveillance Using TI DSP,” Carnegie

Mellon University, August 4-6, 1999, available at <https://www.ti.com/sc/docs/general/dsp/fest99/avi/1paper.pdf>; “Video Surveillance Equipment Selection and Application Guide,” NIJ Guide 201-99, October 1999, available at <https://www.ojp.gov/pdffiles1/nij/179545.pdf>; “Nanny-Cam May Leave a Home Exposed,” New York Times, April 14, 2002, available at <https://www.nytimes.com/2002/04/14/business/nanny-cam-may-leave-a-home-exposed.html>; “Scalable Multimedia System for Interactive Surveillance and Video Communication Applications,” IEEE 10th European Signal Processing Conference, September 4-8, 2000, available at <https://ieeexplore.ieee.org/document/7075784>.

38. The asserted claims of the ’660 Patent are also invalid under 35 U.S.C. §§ 101 and 102(f) because the claimed invention was conceived by Emmanuel Ozoeneh and was communicated to Ronald Carter in a manner that was sufficient to enable him to construct and successfully operate the claimed invention.

39. The asserted claims of the ’660 Patent are also invalid under 35 U.S.C. § 112. By way of example and without limitation, at least the following terms, phrases, and limitations (and substantially similar phrases) in the Asserted Claims fail to satisfy the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112: “wherein the exterior device is capable of receiving the digital audio from a peripheral device after a person associated with the entrance has been detected”; “wherein the exterior device is capable of modifying the sensitivity of the motion detector upon receiving a request to do so”; “operating in at least one low light condition”; “a sensitivity of the motion detector”; “receiving audio at the interior device that was captured by a peripheral device, which is a cell phone”; “displaying an icon and the streaming video at the same time on the peripheral device”; “wherein the icon, when selected, allows a user to speak to the person”; “a person associated with the entrance” (claim 9); “wirelessly transmitting

streaming video from an interior device upon detection of a person”; “storing the streaming video and digital audio in a database and associating the interior device with the stored streaming video and digital audio”; “replicating at least a portion of the database on one or more computers”; “providing a storage hierarchy for the streaming video and digital audio stored in the database” (claims 13, 14, 16, and 18).

40. A judicial declaration that the ’660 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that SimpliSafe can ascertain its rights and duties with respect to the SimpliSafe Video Doorbell Camera and the SimpliSafe SimpliCam, which Defendants accuse of infringing the ’660 patent.

COUNT THREE

DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE ’796 PATENT

41. Paragraphs 1 through 40 are incorporated by reference as if fully stated herein.

42. Defendants claim to own all rights, title, and interest in the ’796 patent.

43. In filing the ITC Complaint, Defendants accused SimpliSafe of “directly infring[ing] claims 3 and 7 of the ’796 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . . the SimpliSafe [Video] Doorbell Camera.” Ex. I, ¶ 5.71.

44. Defendants also accused SimpliSafe of “indirectly infring[ing] claims 3 and 7 [of the ’796 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe [Video] Doorbell Camera and/or perform all or some of the steps recited in claims 3 and 7 of the ’796 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a

patented process, when such material or apparatus is especially adapted for use in the infringement of the '796 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.” *Id.*

45. Contrary to Defendants’ assertions in the ITC Complaint, the SimpliSafe Video Doorbell Pro does not infringe—directly or indirectly—claims 3 and 7 of the '796 patent.

46. The SimpliSafe Video Doorbell Pro also does not perform substantially the same function, in substantially the way, to obtain substantially the same result as claims 3 and 7 of the '796 patent.

47. Absent a declaration that any asserted claims of the '796 patent are not infringed, Defendants will continue to wrongfully assert the '796 patent against SimpliSafe, thereby causing SimpliSafe irreparable harm and injury.

48. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and SimpliSafe as to whether the claims of the '796 patent are infringed. A judicial declaration is necessary and appropriate so that SimpliSafe may ascertain its rights regarding the '796 patent.

49. Based on the foregoing, SimpliSafe hereby requests a declaration that the claims of the '796 patent are not infringed by the SimpliSafe Video Doorbell Pro.

COUNT FOUR

DECLARATORY JUDGMENT OF INVALIDITY OF THE '796 PATENT

50. Paragraphs 1 through 49 are incorporated by reference as if fully stated herein.

51. The '796 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 and/or under the doctrine of double patenting, at least because they attempt to claim the abstract idea of receiving and wirelessly communicating with a visitor at an entrance. The claims

also recite well-known conventional off-the-shelf components that in combination do not provide an inventive concept sufficient to transform this abstract idea into a patent-eligible application of the idea.

52. Moreover, detection, viewing, communication, and monitoring systems comprising at least the transmission, storage, and/or accessibility of related information or data was well-known in the prior art prior to the priority date of the '796 Patent. In particular, as explained below due to the break in co-dependency, the claims of the '796 patent are invalid under 35 U.S.C. §§ 102 and 103 in view of the Priority Art. *See* Exs. T-X.

53. Additionally, the asserted claims of the '796 patent are invalid as anticipated under 35 U.S.C. § 102 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 7,119,609 (Naidoo et al.); Published U.S. App. No. 2019/0058720 (Lindquist); U.S. Pat. No. 6,542,078 (Script et al.); U.S. Pat. No. 6,828,909 (Script et al.); U.S. Pat. No. 7,113,090 (Saylor et al.), Published United Kingdom App. GB2357387 (Golightly et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2002/0075307 (Alexander et al.); U.S. Pat. No. 5,861,804 (Fansa et al.); U.S. Pat. No. 6,069,655 (Seeley et al.); U.S. Pat. No. 6,385,772 (Courtney); U.S. Pat. No. 6,400,265 (Saylor et al.); U.S. Pat. No. 6,424,371 (Wen); U.S. Pat. No. 7,019,770 (Katz), U.S. Pat. No. 7,242,295 (Milinusic et al.); U.S. Pat. No. 7,277,010 (Joao); Korea Pat. No. KR100373449 (Son); U.S. Pat. No. 6,359,560 (Budge et al.); Published U.S. App. 2003/0046557 (Miller et al.); Published PCT App. WO99/006976 (Meyvis).

54. Furthermore, the asserted claims of the '796 are invalid as obvious under 35 U.S.C. § 103 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 9,300,921 (Naidoo et al.); Published U.S. App. 2003/0071724 (D'Amico); Duy Nguyen, "Mobile Home Security with GPRS" (2002); China Pat. No. CN2589640Y (Hudlin); U.S. Pat. No. 5,428,388 (von Bauer et al.); U.S. Pat. No. 5,717,379 (Peters); U.S. Pat. No. 6,064,303 (Klein et al.); U.S. Pat. No. 6,097,429 (Seeley et al.); U.S. Pat. No. 6,421,080 (Lambert); U.S. Pat. No. 5,151,945 (Lee et al.); U.S. Pat. No. 6,816,085 (Haynes et al.); U.S. Pat. No. 6,943,682 (Dowens et al.); U.S. Pat. No. 6,956,478 (Oyagi et al.); U.S. Pat. No. 7,012,523 (Stuart); U.S. Pat. No. 9,250,267 (Jackson et al.); Published U.S. App. 2002/0030583 (Jang et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2002/0147982 (Naidoo et al.); Published U.S. App. 2003/0095184 (Lin); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2003/0122514 (Mercier et al.); Published U.S. App. 2004/0080615 (Klein et al.); Published U.S. App. 2004/0080627 (Kroll et al.); Published U.S. App. 2005/0001717 (Bohbot et al.); Published U.S. App. 2005/0165612 (Van Rysselberghe); Published U.S. App. 2009/0224912 (Sobol); Published Germany App. DE10039263; France Pat. No. FR2759804; Published United Kingdom App. GB2285365 (Yau et al.); Published United Kingdom App. GB2377582 (Hunter); Published Japan App. JPH09-107409 (Onozuka); Published Japan App. JPH11-224383 (Kumagai); Published Korea App. KR19980039422 (Kim et al.); Published Korea App. KR20010074212 (Shin); Published PCT App. WO2002/05220 (Bennett); Published PCT App. WO2003/028375 (Hong); U.S. Pat. No. 5,822,542 (Smith et al.); U.S. Pat. No. 5,878,283 (House et al.); U.S. Pat. No. 6,060,994 (Chen); U.S. Pat. No. 6,104,785 (Chen);

U.S. Pat. No. 6,134,303 (Chen); U.S. Pat. No. 6,185,294 (Chornenky et al.); U.S. Pat. No. 6,323,897 (Kogane et al.); U.S. Pat. No. 6,476,858 (Diaz et al.); Published U.S. App. 2002/0016971 (Berezowski et al.); Published U.S. App. 2002/0067259 (Fufidio et al.); Published U.S. App. 2002/0071031 (Lord et al.); Published U.S. App. 2002/0076049 (Boykin et al.); Published U.S. App. 2002/0118283 (Guerrero); Published U.S. App. 2003/0061344 (Monroe); Published U.S. App. 2003/0062997 (Naidoo et al.); Published U.S. App. 2003/0075287 (Weik); Published U.S. App. 2003/0081747 (Ahlstrom et al.); Published U.S. App. 2003/0103138 (Assayag et al.); Published U.S. App. 2003/0171930 (Junqua); Published U.S. App. 2003/0206101 (Dixon et al.); Published U.S. App. 2004/0003051 (Krzyzanowski et al.); Published U.S. App. 2004/0036603 (Bingham); Published U.S. App. 2006/0095539 (Renkis); Published U.S. App. 2006/0171453 (Rohlfing et al.); Published U.S. App. 2006/0255931 (Hartsfield et al.); Published Canada App. CA2228679 (Heggie et al.); Published Germany App. DE20101205; Published Japan App. JP2001086486 (Kogane et al.); Japan Pat. No. JP2001167365 (Ishikawa et al.); Published Japan App. JPH11-112494 (Yamaguchi et al.); Published PCT App. WO01/027763 (Simerly et al.); Published PCT App. WO01/050731 (Noyman et al.); Published PCT App. WO01/097524 (Scaman et al.); Published PCT App. WO02/065420 (Vojtech et al.); Published Korea App. KR20010035246A (Lee); “Motion Activated Video Surveillance Using TI DSP,” Carnegie Mellon University, August 4-6, 1999, available at <https://www.ti.com/sc/docs/general/dsp/fest99/avi/1paper.pdf>; “Video Surveillance Equipment Selection and Application Guide,” NIJ Guide 201-99, October 1999, available at <https://www.ojp.gov/pdffiles1/nij/179545.pdf>; “Nanny-Cam May Leave a Home Exposed,” New York Times, April 14, 2002, available at <https://www.nytimes.com/2002/04/14/business/nanny-cam-may-leave-a-home-exposed.html>; “Scalable Multimedia System for Interactive Surveillance

and Video Communication Applications,” IEEE 10th European Signal Processing Conference, September 4-8, 2000, available at <https://ieeexplore.ieee.org/document/7075784>.

55. The asserted claims of the ’796 Patent are also invalid under 35 U.S.C. §§ 101 and 102(f) because the claimed invention was conceived by Emmanuel Ozoeneh and was communicated to Ronald Carter in a manner that was sufficient to enable him to construct and successfully operate the claimed invention.

56. The asserted claims of the ’796 Patent are also invalid under 35 U.S.C. § 112. By way of example and without limitation, at least the following terms, phrases, and limitations (and substantially similar phrases) in the Asserted Claims fail to satisfy the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112: “a proximity sensor for detecting the person at the entrance”; “receiving a person at an entrance”; “real time” (claim 3 and 7).

57. The second element after the preamble of claim 3, a system claim, recites “an exterior module, comprising.” At least the phrases “a video camera that captures video of the person at the entrance,” “a microphone that receives audio from the person at the entrance,” “an RF transmitter that transmits, to the software application, digital streaming video that a user of the remote peripheral device may view in real time,” “an RF receiver that receives audio from the peripheral device,” and “a speaker that outputs the audio received by the RF receiver” show that actions are required to be performed by the “exterior module.” The claim therefore requires a system and an “exterior module” to perform the method steps of “captur[ing] video of the person at the entrance,” “receiv[ing] audio from the person at the entrance,” “transmit[ting] . . . digital streaming video,” “receiv[ing] audio from the peripheral device,” and output[ting] the audio received.” As such, claim 3 of the ’796 patent is invalid because it covers both a system and a method.

58. A judicial declaration that the '796 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that SimpliSafe can ascertain its rights and duties with respect to the SimpliSafe Video Doorbell Pro, which Defendants accuse of infringing the '796 patent.

COUNT FIVE

DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '797 PATENT

59. Paragraphs 1 through 58 are incorporated by reference as if fully stated herein.

60. Defendants claim to own all rights, title, and interest in the '797 patent.

61. In filing the ITC Complaint, Defendants accused SimpliSafe of “directly infring[ing] claims 6, 8, and 9 of the '797 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . . the SimpliSafe [Video] Doorbell Camera.” Ex. I, ¶ 5.73.

62. Defendants also accused SimpliSafe of “indirectly infring[ing] claims 6, 8, and 9 [of the '797 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe [Video] Doorbell Camera and/or perform all or some of the steps recited in claims 6, 8, and 9 of the '797 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a patented process, when such material or apparatus is especially adapted for use in the infringement of the '797 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.” *Id.*

63. Contrary to Defendants' assertions in the ITC Complaint, the SimpliSafe Video Doorbell Pro does not infringe—directly or indirectly—claims 6, 8, and 9 of the '797 patent.

64. The SimpliSafe Video Doorbell Pro also does not perform substantially the same function, in substantially the way, to obtain substantially the same result as claims 6, 8, and 9 of the '797 patent.

65. Absent a declaration that any asserted claims of the '797 patent are not infringed, Defendants will continue to wrongfully assert the '797 patent against SimpliSafe, thereby causing SimpliSafe irreparable harm and injury.

66. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and SimpliSafe as to whether the claims of the '797 patent are infringed. A judicial declaration is necessary and appropriate so that SimpliSafe may ascertain its rights regarding the '797 patent.

67. Based on the foregoing, SimpliSafe hereby requests a declaration that the claims of the '797 patent are not infringed by the SimpliSafe Video Doorbell Pro.

COUNT SIX

DECLARATORY JUDGMENT OF INVALIDITY OF THE '797 PATENT

68. Paragraphs 1 through 67 are incorporated by reference as if fully stated herein.

69. The '797 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 and/or under the doctrine of double patenting, at least because they attempt to claim the abstract idea of receiving and wirelessly communicating with a visitor at an entrance. The claims also recite well-known conventional off-the-shelf components that in combination do not provide an inventive concept sufficient to transform this abstract idea into a patent-eligible application of the idea.

70. Moreover, detection, viewing, communication, and monitoring systems comprising at least the transmission, storage, and/or accessibility of related information or data was well-

known in the prior art prior to the priority date of the '797 Patent. In particular, as explained below due to the break in co-pendency, the claims of the '797 Patent are invalid under 35 U.S.C. §§ 102 and 103 in view of the Priority Art. *See* Exs. T-X.

71. Additionally, the asserted claims of the '797 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 7,119,609 (Naidoo et al.); Published U.S. App. No. 2019/0058720 (Lindquist); U.S. Pat. No. 6,542,078 (Script et al.); U.S. Pat. No. 6,828,909 (Script et al.); U.S. Pat. No. 7,113,090 (Saylor et al.), Published United Kingdom App. GB2357387 (Golightly et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2002/0075307 (Alexander et al.); U.S. Pat. No. 5,861,804 (Fansa et al.); U.S. Pat. No. 6,069,655 (Seeley et al.); U.S. Pat. No. 6,385,772 (Courtney); U.S. Pat. No. 6,400,265 (Saylor et al.); U.S. Pat. No. 6,424,371 (Wen); U.S. Pat. No. 7,019,770 (Katz), U.S. Pat. No. 7,242,295 (Milinusic et al.); U.S. Pat. No. 7,277,010 (Joao); Korea Pat. No. KR100373449 (Son); U.S. Pat. No. 6,359,560 (Budge et al.); Published U.S. App. 2003/0046557 (Miller et al.); Published PCT App. WO99/006976 (Meyvis).

72. Furthermore, the asserted claims of the '797 Patent are invalid as obvious under 35 U.S.C. § 103 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 9,300,921 (Naidoo et al.); Published U.S. App. 2003/0071724 (D'Amico); Duy Nguyen, "Mobile Home Security with GPRS" (2002); China

Pat. No. CN2589640Y (Hudlin); U.S. Pat. No. 5,428,388 (von Bauer et al.); U.S. Pat. No. 5,717,379 (Peters); U.S. Pat. No. 6,064,303 (Klein et al.); U.S. Pat. No. 6,097,429 (Seeley et al.); U.S. Pat. No. 6,421,080 (Lambert); U.S. Pat. No. 5,151,945 (Lee et al.); U.S. Pat. No. 6,816,085 (Haynes et al.); U.S. Pat. No. 6,943,682 (Dowens et al.); U.S. Pat. No. 6,956,478 (Oyagi et al.); U.S. Pat. No. 7,012,523 (Stuart); U.S. Pat. No. 9,250,267 (Jackson et al.); Published U.S. App. 2002/0030583 (Jang et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2002/0147982 (Naidoo et al.); Published U.S. App. 2003/0095184 (Lin); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2003/0122514 (Mercier et al.); Published U.S. App. 2004/0080615 (Klein et al.); Published U.S. App. 2004/0080627 (Kroll et al.); Published U.S. App. 2005/0001717 (Bohbot et al.); Published U.S. App. 2005/0165612 (Van Rysselberghe); Published U.S. App. 2009/0224912 (Sobol); Published Germany App. DE10039263; France Pat. No. FR2759804; Published United Kingdom App. GB2285365 (Yau et al.); Published United Kingdom App. GB2377582 (Hunter); Published Japan App. JPH09-107409 (Onozuka); Published Japan App. JPH11-224383 (Kumagai); Published Korea App. KR19980039422 (Kim et al.); Published Korea App. KR20010074212 (Shin); Published PCT App. WO2002/05220 (Bennett); Published PCT App. WO2003/028375 (Hong); U.S. Pat. No. 5,822,542 (Smith et al.); U.S. Pat. No. 5,878,283 (House et al.); U.S. Pat. No. 6,060,994 (Chen); U.S. Pat. No. 6,104,785 (Chen); U.S. Pat. No. 6,134,303 (Chen); U.S. Pat. No. 6,185,294 (Chornenky et al.); U.S. Pat. No. 6,323,897 (Kogane et al.); U.S. Pat. No. 6,476,858 (Diaz et al.); Published U.S. App. 2002/0016971 (Berezowski et al.); Published U.S. App. 2002/0067259 (Fufidio et al.); Published U.S. App. 2002/0071031 (Lord et al.); Published U.S. App. 2002/0076049 (Boykin et al.); Published U.S. App. 2002/0118283 (Guerrero); Published U.S. App. 2003/0061344 (Monroe); Published U.S. App. 2003/0062997 (Naidoo et al.); Published U.S. App. 2003/0075287 (Weik);

Published U.S. App. 2003/0081747 (Ahlstrom et al.); Published U.S. App. 2003/0103138 (Assayag et al.); Published U.S. App. 2003/0171930 (Junqua); Published U.S. App. 2003/0206101 (Dixon et al.); Published U.S. App. 2004/0003051 (Krzyzanowski et al.); Published U.S. App. 2004/0036603 (Bingham); Published U.S. App. 2006/0095539 (Renkis); Published U.S. App. 2006/0171453 (Rohlfing et al.); Published U.S. App. 2006/0255931 (Hartsfield et al.); Published Canada App. CA2228679 (Heggie et al.); Published Germany App. DE20101205; Published Japan App. JP2001086486 (Kogane et al.); Japan Pat. No. JP2001167365 (Ishikawa et al.); Published Japan App. JPH11-112494 (Yamaguchi et al.); Published PCT App. WO01/027763 (Simerly et al.); Published PCT App. WO01/050731 (Noyman et al.); Published PCT App. WO01/097524 (Scaman et al.); Published PCT App. WO02/065420 (Vojtech et al.); Published Korea App. KR20010035246A (Lee); “Motion Activated Video Surveillance Using TI DSP,” Carnegie Mellon University, August 4-6, 1999, available at <https://www.ti.com/sc/docs/general/dsp/fest99/avi/1paper.pdf>; “Video Surveillance Equipment Selection and Application Guide,” NIJ Guide 201-99, October 1999, available at <https://www.ojp.gov/pdffiles1/nij/179545.pdf>; “Nanny-Cam May Leave a Home Exposed,” New York Times, April 14, 2002, available at <https://www.nytimes.com/2002/04/14/business/nanny-cam-may-leave-a-home-exposed.html>; “Scalable Multimedia System for Interactive Surveillance and Video Communication Applications,” IEEE 10th European Signal Processing Conference, September 4-8, 2000, available at <https://ieeexplore.ieee.org/document/7075784>.

73. The asserted claims of the '797 Patent are also invalid under 35 U.S.C. §§ 101 and 102(f) because the claimed invention was conceived by Emmanuel Ozoeneh and was communicated to Ronald Carter in a manner that was sufficient to enable him to construct and successfully operate the claimed invention.

74. The asserted claims of the '797 Patent are also invalid under 35 U.S.C. § 112. By way of example and without limitation, at least the following terms, phrases, and limitations (and substantially similar phrases) in the Asserted Claims fail to satisfy the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112: “viewing system associated with an entrance”; “partially via the Internet”; “person associated with the entrance”; “wherein the exterior device is capable of wirelessly transmitting digital streaming video, at least partially via the internet, to a peripheral device, which is a cell phone, upon detection of a person associated with the entrance by the motion detector”; “a keypad having one or more buttons” (claim 6 and 8); “a person at an entrance”; “exterior device associated with the entrance”; “partially via the Internet”; “wirelessly transmitting the recorded video and digital audio from the exterior device to a peripheral device at least partially via the Internet upon detection of the person at the entrance via the motion sensor or pressing of the one or more buttons of the keypad”; “placing a timestamp on the digital streaming video before transmission of the digital streaming video by the exterior device” (claim 9).

75. A judicial declaration that the '797 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that SimpliSafe can ascertain its rights and duties with respect to the SimpliSafe Video Doorbell Pro, which Defendants accuse of infringing the '797 patent.

COUNT SEVEN

DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '478 PATENT

76. Paragraphs 1 through 75 are incorporated by reference as if fully stated herein.

77. Defendants claim to own all rights, title, and interest in the '478 patent.

78. In filing the ITC Complaint, Defendants accused SimpliSafe of “directly infring[ing] claims 9, 10, 11, and 17 of the ’478 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . . the SimpliSafe [Video] Doorbell Camera.” Ex. I, ¶ 5.75.

79. Defendants also accused SimpliSafe of “indirectly infring[ing] claims 9, 10, 11, and 17 [of the ’478 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe [Video] Doorbell Camera and/or perform all or some of the steps recited in claims 9, 10, 11, and 17 of the ’478 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a patented process, when such material or apparatus is especially adapted for use in the infringement of the ’478 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.” *Id.*

80. Contrary to Defendants’ assertions in the ITC Complaint, the SimpliSafe Video Doorbell Pro does not infringe—directly or indirectly—claims 9, 10, 11, and 17 of the ’478 patent.

81. The SimpliSafe Video Doorbell Pro also does not perform substantially the same function, in substantially the way, to obtain substantially the same result as claims 9, 10, 11, and 17 of the ’478 patent.

82. Absent a declaration that any asserted claims of the ’478 patent are not infringed, Defendants will continue to wrongfully assert the ’478 patent against SimpliSafe, thereby causing SimpliSafe irreparable harm and injury.

83. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and SimpliSafe as to whether the claims of the ’478 patent are

infringed. A judicial declaration is necessary and appropriate so that SimpliSafe may ascertain its rights regarding the '478 patent.

84. Based on the foregoing, SimpliSafe hereby requests a declaration that the claims of the '478 patent are not infringed by the SimpliSafe Video Doorbell Pro.

COUNT EIGHT

DECLARATORY JUDGMENT OF INVALIDITY OF THE '478 PATENT

85. Paragraphs 1 through 84 are incorporated by reference as if fully stated herein.

86. The '478 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 and/or under the doctrine of double patenting, at least because they attempt to claim the abstract idea of receiving and wirelessly communicating with a visitor at an entrance. The claims also recite well-known conventional off-the-shelf components that in combination do not provide an inventive concept sufficient to transform this abstract idea into a patent-eligible application of the idea.

87. Moreover, detection, viewing, communication, and monitoring systems comprising at least the transmission, storage, and/or accessibility of related information or data was well-known in the prior art prior to the priority date of the '478 Patent. In particular, as explained below due to the break in co-pendency, the claims of the '478 Patent are invalid under 35 U.S.C. §§ 102 and 103 in view of the Priority Art. *See* Exs. T-X.

88. Additionally, the asserted claims of the '478 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 7,119,609 (Naidoo et al.); Published U.S.

App. No. 2019/0058720 (Lindquist); U.S. Pat. No. 6,542,078 (Script et al.); U.S. Pat. No. 6,828,909 (Script et al.); U.S. Pat. No. 7,113,090 (Saylor et al.), Published United Kingdom App. GB2357387 (Golightly et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2002/0075307 (Alexander et al.); U.S. Pat. No. 5,861,804 (Fansa et al.); U.S. Pat. No. 6,069,655 (Seeley et al.); U.S. Pat. No. 6,385,772 (Courtney); U.S. Pat. No. 6,400,265 (Saylor et al.); U.S. Pat. No. 6,424,371 (Wen); U.S. Pat. No. 7,019,770 (Katz), U.S. Pat. No. 7,242,295 (Milinusic et al.); U.S. Pat. No. 7,277,010 (Joao); Korea Pat. No. KR100373449 (Son); U.S. Pat. No. 6,359,560 (Budge et al.); Published U.S. App. 2003/0046557 (Miller et al.); Published PCT App. WO99/006976 (Meyvis).

89. Furthermore, the asserted claims of the '478 Patent are invalid as obvious under 35 U.S.C. § 103 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 9,300,921 (Naidoo et al.); Published U.S. App. 2003/0071724 (D'Amico); Duy Nguyen, "Mobile Home Security with GPRS" (2002); China Pat. No. CN2589640Y (Hudlin); U.S. Pat. No. 5,428,388 (von Bauer et al.); U.S. Pat. No. 5,717,379 (Peters); U.S. Pat. No. 6,064,303 (Klein et al.); U.S. Pat. No. 6,097,429 (Seeley et al.); U.S. Pat. No. 6,421,080 (Lambert); U.S. Pat. No. 5,151,945 (Lee et al.); U.S. Pat. No. 6,816,085 (Haynes et al.); U.S. Pat. No. 6,943,682 (Dowens et al.); U.S. Pat. No. 6,956,478 (Oyagi et al.); U.S. Pat. No. 7,012,523 (Stuart); U.S. Pat. No. 9,250,267 (Jackson et al.); Published U.S. App. 2002/0030583 (Jang et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2002/0147982 (Naidoo et al.); Published U.S. App. 2003/0095184 (Lin); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2003/0122514 (Mercier et al.); Published U.S.

App. 2004/0080615 (Klein et al.); Published U.S. App. 2004/0080627 (Kroll et al.); Published U.S. App. 2005/0001717 (Bohbot et al.); Published U.S. App. 2005/0165612 (Van Rysselberghe); Published U.S. App. 2009/0224912 (Sobol); Published Germany App. DE10039263; France Pat. No. FR2759804; Published United Kingdom App. GB2285365 (Yau et al.); Published United Kingdom App. GB2377582 (Hunter); Published Japan App. JPH09-107409 (Onozuka); Published Japan App. JPH11-224383 (Kumagai); Published Korea App. KR19980039422 (Kim et al.); Published Korea App. KR20010074212 (Shin); Published PCT App. WO2002/05220 (Bennett); Published PCT App. WO2003/028375 (Hong); U.S. Pat. No. 5,822,542 (Smith et al.); U.S. Pat. No. 5,878,283 (House et al.); U.S. Pat. No. 6,060,994 (Chen); U.S. Pat. No. 6,104,785 (Chen); U.S. Pat. No. 6,134,303 (Chen); U.S. Pat. No. 6,185,294 (Chornenky et al.); U.S. Pat. No. 6,323,897 (Kogane et al.); U.S. Pat. No. 6,476,858 (Diaz et al.); Published U.S. App. 2002/0016971 (Berezowski et al.); Published U.S. App. 2002/0067259 (Fufidio et al.); Published U.S. App. 2002/0071031 (Lord et al.); Published U.S. App. 2002/0076049 (Boykin et al.); Published U.S. App. 2002/0118283 (Guerrero); Published U.S. App. 2003/0061344 (Monroe); Published U.S. App. 2003/0062997 (Naidoo et al.); Published U.S. App. 2003/0075287 (Weik); Published U.S. App. 2003/0081747 (Ahlstrom et al.); Published U.S. App. 2003/0103138 (Assayag et al.); Published U.S. App. 2003/0171930 (Junqua); Published U.S. App. 2003/0206101 (Dixon et al.); Published U.S. App. 2004/0003051 (Krzyzanowski et al.); Published U.S. App. 2004/0036603 (Bingham); Published U.S. App. 2006/0095539 (Renkis); Published U.S. App. 2006/0171453 (Rohlfing et al.); Published U.S. App. 2006/0255931 (Hartsfield et al.); Published Canada App. CA2228679 (Heggie et al.); Published Germany App. DE20101205; Published Japan App. JP2001086486 (Kogane et al.); Japan Pat. No. JP2001167365 (Ishikawa et al.); Published Japan App. JPH11-112494 (Yamaguchi et al.); Published PCT App. WO01/027763 (Simerly et

al.); Published PCT App. WO01/050731 (Noyman et al.); Published PCT App. WO01/097524 (Scaman et al.); Published PCT App. WO02/065420 (Vojtech et al.); Published Korea App. KR20010035246A (Lee); “Motion Activated Video Surveillance Using TI DSP,” Carnegie Mellon University, August 4-6, 1999, available at <https://www.ti.com/sc/docs/general/dsp/fest99/avi/1paper.pdf>; “Video Surveillance Equipment Selection and Application Guide,” NIJ Guide 201-99, October 1999, available at <https://www.ojp.gov/pdffiles1/nij/179545.pdf>; “Nanny-Cam May Leave a Home Exposed,” New York Times, April 14, 2002, available at <https://www.nytimes.com/2002/04/14/business/nanny-cam-may-leave-a-home-exposed.html>; “Scalable Multimedia System for Interactive Surveillance and Video Communication Applications,” IEEE 10th European Signal Processing Conference, September 4-8, 2000, available at <https://ieeexplore.ieee.org/document/7075784>.

90. The asserted claims of the ’478 Patent are also invalid under 35 U.S.C. §§ 101 and 102(f) because the claimed invention was conceived by Emmanuel Ozoeneh and was communicated to Ronald Carter in a manner that was sufficient to enable him to construct and successfully operate the claimed invention.

91. The asserted claims of the ’478 Patent are also invalid under 35 U.S.C. § 112. By way of example and without limitation, at least the following terms, phrases, and limitations (and substantially similar phrases) in the Asserted Claims fail to satisfy the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112: “real-time,” “each of said at least one peripheral devices associated with a respective user”; “a wireless device comprising a video camera, a speaker, a microphone, and a keypad having one or more buttons”; “a computer configured for wireless communication with the wireless device to receive digital real-time digital streaming video data, wherein said computer is configured for communication with each of said

at least one peripheral devices to transmit the digital real-time digital video data to at least one peripheral device” (claims 9, 10, 11, 17); “the association of each of the at last one peripheral device with a respective user is maintained” (claim 10); “wherein said wireless device comprises a proximity sensor located within the wireless device for detecting the presence of a person” (claim 11).

92. A judicial declaration that the '478 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that SimpliSafe can ascertain its rights and duties with respect to the SimpliSafe Video Doorbell Pro, which Defendants accuse of infringing the '478 patent.

COUNT NINE

DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '638 PATENT

93. Paragraphs 1 through 92 are incorporated by reference as if fully stated herein.

94. Defendants claim to own all rights, title, and interest in the '638 patent.

95. In filing the ITC Complaint, Defendants accused SimpliSafe of “directly infring[ing] claim 6 of the '638 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . . the SimpliSafe [Video] Doorbell Camera.” Ex. I, ¶ 5.77.

96. Defendants also accused SimpliSafe of “indirectly infring[ing] claim 6 [of the '638 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe [Video] Doorbell Camera and/or perform all or some of the steps recited in claim 6 of the '638 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a patented process, which such material or apparatus is especially adapted for use in the infringement of the '638

patent, and is not a staple article or commodity of commerce suitable for substantial noninfringing use.” *Id.*

97. Contrary to Defendants’ assertions in the ITC Complaint, the SimpliSafe Video Doorbell Pro does not infringe—directly or indirectly—claim 6 of the ’638 patent.

98. The SimpliSafe Video Doorbell Pro also does not perform substantially the same function, in substantially the way, to obtain substantially the same result as claim 6 of the ’638 patent.

99. Absent a declaration that any asserted claims of the ’638 patent are not infringed, Defendants will continue to wrongfully assert the ’638 patent against SimpliSafe, thereby causing SimpliSafe irreparable harm and injury.

100. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and SimpliSafe as to whether the claims of the ’638 patent are infringed. A judicial declaration is necessary and appropriate so that SimpliSafe may ascertain its rights regarding the ’638 patent.

101. Based on the foregoing, SimpliSafe hereby requests a declaration that the claims of the ’638 patent are not infringed by the SimpliSafe Video Doorbell Pro.

COUNT TEN

DECLARATORY JUDGMENT OF INVALIDITY OF THE ’638 PATENT

102. Paragraphs 1 through 101 are incorporated by reference as if fully stated herein.

103. The ’638 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 and/or under the doctrine of double patenting, at least because they attempt to claim the abstract idea of receiving and wirelessly communicating with a visitor at an entrance. The claims also recite well-known conventional off-the-shelf components that in combination do not provide

an inventive concept sufficient to transform this abstract idea into a patent-eligible application of the idea.

104. Moreover, detection, viewing, communication, and monitoring systems comprising at least the transmission, storage, and/or accessibility of related information or data was well-known in the prior art prior to the priority date of the '638 Patent. In particular, as explained below due to the break in co-pendency, the claims of the '638 Patent are invalid under 35 U.S.C. §§ 102 and 103 in view of the Priority Art. *See* Exs. T-X.

105. Additionally, the asserted claims of the '638 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 7,119,609 (Naidoo et al.); Published U.S. App. No. 2019/0058720 (Lindquist); U.S. Pat. No. 6,542,078 (Script et al.); U.S. Pat. No. 6,828,909 (Script et al.); U.S. Pat. No. 7,113,090 (Saylor et al.), Published United Kingdom App. GB2357387 (Golightly et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2002/0075307 (Alexander et al.); U.S. Pat. No. 5,861,804 (Fansa et al.); U.S. Pat. No. 6,069,655 (Seeley et al.); U.S. Pat. No. 6,385,772 (Courtney); U.S. Pat. No. 6,400,265 (Saylor et al.); U.S. Pat. No. 6,424,371 (Wen); U.S. Pat. No. 7,019,770 (Katz), U.S. Pat. No. 7,242,295 (Milinusic et al.); U.S. Pat. No. 7,277,010 (Joao); Korea Pat. No. KR100373449 (Son); U.S. Pat. No. 6,359,560 (Budge et al.); Published U.S. App. 2003/0046557 (Miller et al.); Published PCT App. WO99/006976 (Meyvis).

106. Furthermore, the asserted claims of the '638 Patent are invalid as obvious under 35 U.S.C. § 103 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614

(Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 9,300,921 (Naidoo et al.); Published U.S. App. 2003/0071724 (D'Amico); Duy Nguyen, "Mobile Home Security with GPRS" (2002); China Pat. No. CN2589640Y (Hudlin); U.S. Pat. No. 5,428,388 (von Bauer et al.); U.S. Pat. No. 5,717,379 (Peters); U.S. Pat. No. 6,064,303 (Klein et al.); U.S. Pat. No. 6,097,429 (Seeley et al.); U.S. Pat. No. 6,421,080 (Lambert); U.S. Pat. No. 5,151,945 (Lee et al.); U.S. Pat. No. 6,816,085 (Haynes et al.); U.S. Pat. No. 6,943,682 (Dowens et al.); U.S. Pat. No. 6,956,478 (Oyagi et al.); U.S. Pat. No. 7,012,523 (Stuart); U.S. Pat. No. 9,250,267 (Jackson et al.); Published U.S. App. 2002/0030583 (Jang et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2002/0147982 (Naidoo et al.); Published U.S. App. 2003/0095184 (Lin); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2003/0122514 (Mercier et al.); Published U.S. App. 2004/0080615 (Klein et al.); Published U.S. App. 2004/0080627 (Kroll et al.); Published U.S. App. 2005/0001717 (Bohbot et al.); Published U.S. App. 2005/0165612 (Van Rysselberghe); Published U.S. App. 2009/0224912 (Sobol); Published Germany App. DE10039263; France Pat. No. FR2759804; Published United Kingdom App. GB2285365 (Yau et al.); Published United Kingdom App. GB2377582 (Hunter); Published Japan App. JPH09-107409 (Onozuka); Published Japan App. JPH11-224383 (Kumagai); Published Korea App. KR19980039422 (Kim et al.); Published Korea App. KR20010074212 (Shin); Published PCT App. WO2002/05220 (Bennett); Published PCT App. WO2003/028375 (Hong); U.S. Pat. No. 5,822,542 (Smith et al.); U.S. Pat. No. 5,878,283 (House et al.); U.S. Pat. No. 6,060,994 (Chen); U.S. Pat. No. 6,104,785 (Chen); U.S. Pat. No. 6,134,303 (Chen); U.S. Pat. No. 6,185,294 (Chornenky et al.); U.S. Pat. No. 6,323,897 (Kogane et al.); U.S. Pat. No. 6,476,858 (Diaz et al.); Published U.S. App.

2002/0016971 (Berezowski et al.); Published U.S. App. 2002/0067259 (Fufidio et al.); Published U.S. App. 2002/0071031 (Lord et al.); Published U.S. App. 2002/0076049 (Boykin et al.); Published U.S. App. 2002/0118283 (Guerrero); Published U.S. App. 2003/0061344 (Monroe); Published U.S. App. 2003/0062997 (Naidoo et al.); Published U.S. App. 2003/0075287 (Weik); Published U.S. App. 2003/0081747 (Ahlstrom et al.); Published U.S. App. 2003/0103138 (Assayag et al.); Published U.S. App. 2003/0171930 (Junqua); Published U.S. App. 2003/0206101 (Dixon et al.); Published U.S. App. 2004/0003051 (Krzyzanowski et al.); Published U.S. App. 2004/0036603 (Bingham); Published U.S. App. 2006/0095539 (Renkis); Published U.S. App. 2006/0171453 (Rohlfing et al.); Published U.S. App. 2006/0255931 (Hartsfield et al.); Published Canada App. CA2228679 (Heggie et al.); Published Germany App. DE20101205; Published Japan App. JP2001086486 (Kogane et al.); Japan Pat. No. JP2001167365 (Ishikawa et al.); Published Japan App. JPH11-112494 (Yamaguchi et al.); Published PCT App. WO01/027763 (Simerly et al.); Published PCT App. WO01/050731 (Noyman et al.); Published PCT App. WO01/097524 (Scaman et al.); Published PCT App. WO02/065420 (Vojtech et al.); Published Korea App. KR20010035246A (Lee); “Motion Activated Video Surveillance Using TI DSP,” Carnegie Mellon University, August 4-6, 1999, available at <https://www.ti.com/sc/docs/general/dsp/fest99/avi/1paper.pdf>; “Video Surveillance Equipment Selection and Application Guide,” NIJ Guide 201-99, October 1999, available at <https://www.ojp.gov/pdffiles1/nij/179545.pdf>; “Nanny-Cam May Leave a Home Exposed,” New York Times, April 14, 2002, available at <https://www.nytimes.com/2002/04/14/business/nanny-cam-may-leave-a-home-exposed.html>; “Scalable Multimedia System for Interactive Surveillance and Video Communication Applications,” IEEE 10th European Signal Processing Conference, September 4-8, 2000, available at <https://ieeexplore.ieee.org/document/7075784>.

107. The asserted claims of the '638 Patent are also invalid under 35 U.S.C. §§ 101 and 102(f) because the claimed invention was conceived by Emmanuel Ozoeneh and was communicated to Ronald Carter in a manner that was sufficient to enable him to construct and successfully operate the claimed invention.

108. The asserted claims of the '638 Patent are also invalid under 35 U.S.C. § 112. By way of example and without limitation, at least the following terms, phrases, and limitations (and substantially similar phrases) in the Asserted Claims fail to satisfy the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112: “an exterior device located proximate a door comprising a camera, a microphone, a speaker, an RF receiver, an RF transmitter, a proximity detector, and a keypad comprising one or more buttons operable to wirelessly transmit streaming video data after the keypad is pressed by a person at the door”; “a computer configured for wireless communication with the exterior device to receive digital video data”; “at least one peripheral device”; “wherein said at least one peripheral device comprises a cellular phone and is configured to display the video transmitted wirelessly by the camera, . . . receive and display an alert transmitted wirelessly from the exterior device after pressing of the keypad by the person to the user, and speaking with the person at the door using the software application running on the cellular phone” (claim 6).

109. The final element of claim 6, an apparatus claim, recites “and wherein said at least one peripheral device comprises a cellular phone and is configured to display the video transmitted wirelessly by the camera, receive a message from the person transmitted wirelessly by the camera, receive and display an alert transmitted wirelessly from the exterior device after pressing of the keypad by the person to the user, and speaking with the person at the door using the software application running on the cellular phone.” At least the phrases “after pressing of the keypad by

the person to the user” and “speaking with the person at the door” show that a user is required to perform an action. The claim therefore requires an apparatus and a “person” to perform the method step of pressing press the keypad and a “user” to perform the method step of speaking with the person. As such, claim 6 of the ’638 patent is invalid because it covers both a system and a method.

110. A judicial declaration that the ’638 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that SimpliSafe can ascertain its rights and duties with respect to the SimpliSafe Video Doorbell Pro, which Defendants accuse of infringing the ’638 patent.

COUNT ELEVEN

DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE ’906 PATENT

111. Paragraphs 1 through 110 are incorporated by reference as if fully stated herein.

112. Defendants claim to own all rights, title, and interest in the ’906 patent.

113. In filing the ITC Complaint, Defendants accused SimpliSafe of “directly infring[ing] claims 9, 13, and 18 of the ’906 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . . the SimpliSafe [Video] Doorbell Camera.” Ex. I, ¶ 5.79.

114. Defendants also accused SimpliSafe of “indirectly infring[ing] claims 9, 13, and 18 [of the ’906 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe [Video] Doorbell Camera and/or perform all or some of the steps recited in claims 9, 13, and 18 of the ’906 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a patented process, when such material or apparatus is especially adapted for use in the

infringement of the '906 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.” *Id.*

115. Contrary to Defendants’ assertions in the ITC Complaint, the SimpliSafe Video Doorbell Pro does not infringe—directly or indirectly—claims 9, 13, and 18 of the '906 patent.

116. The SimpliSafe Video Doorbell Pro also does not perform substantially the same function, in substantially the way, to obtain substantially the same result as 9, 13, and 18 of the '906 patent.

117. Absent a declaration that any asserted claims of the '906 patent are not infringed, Defendants will continue to wrongfully assert the '906 patent against SimpliSafe, thereby causing SimpliSafe irreparable harm and injury.

118. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and SimpliSafe as to whether the claims of the '906 patent are infringed. A judicial declaration is necessary and appropriate so that SimpliSafe may ascertain its rights regarding the '906 patent.

119. Based on the foregoing, SimpliSafe hereby requests a declaration that the claims of the '906 patent are not infringed by the SimpliSafe Video Doorbell Pro.

COUNT TWELVE

DECLARATORY JUDGMENT OF INVALIDITY OF THE '906 PATENT

120. Paragraphs 1 through 119 are incorporated by reference as if fully stated herein.

121. The '906 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 and/or under the doctrine of double patenting, at least because they attempt to claim the abstract idea of receiving and wirelessly communicating with a visitor at an entrance. The claims also recite well-known conventional off-the-shelf components that in combination do not provide

an inventive concept sufficient to transform this abstract idea into a patent-eligible application of the idea.

122. Moreover, detection, viewing, communication, and monitoring systems comprising at least the transmission, storage, and/or accessibility of related information or data was well-known in the prior art prior to the priority date of the '906 Patent. In particular, as explained below due to the break in co-pendency, the claims of the '906 Patent are invalid under 35 U.S.C. §§ 102 and 103 in view of the Priority Art. *See* Exs. T-X.

123. Additionally, the asserted claims of the '906 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 7,119,609 (Naidoo et al.); Published U.S. App. No. 2019/0058720 (Lindquist); U.S. Pat. No. 6,542,078 (Script et al.); U.S. Pat. No. 6,828,909 (Script et al.); U.S. Pat. No. 7,113,090 (Saylor et al.), Published United Kingdom App. GB2357387 (Golightly et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2002/0075307 (Alexander et al.); U.S. Pat. No. 5,861,804 (Fansa et al.); U.S. Pat. No. 6,069,655 (Seeley et al.); U.S. Pat. No. 6,385,772 (Courtney); U.S. Pat. No. 6,400,265 (Saylor et al.); U.S. Pat. No. 6,424,371 (Wen); U.S. Pat. No. 7,019,770 (Katz), U.S. Pat. No. 7,242,295 (Milinusic et al.); U.S. Pat. No. 7,277,010 (Joao); Korea Pat. No. KR100373449 (Son); U.S. Pat. No. 6,359,560 (Budge et al.); Published U.S. App. 2003/0046557 (Miller et al.); Published PCT App. WO99/006976 (Meyvis).

124. Furthermore, the asserted claims of the '906 Patent are invalid as obvious under 35 U.S.C. § 103 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614

(Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 9,300,921 (Naidoo et al.); Published U.S. App. 2003/0071724 (D'Amico); Duy Nguyen, "Mobile Home Security with GPRS" (2002); China Pat. No. CN2589640Y (Hudlin); U.S. Pat. No. 5,428,388 (von Bauer et al.); U.S. Pat. No. 5,717,379 (Peters); U.S. Pat. No. 6,064,303 (Klein et al.); U.S. Pat. No. 6,097,429 (Seeley et al.); U.S. Pat. No. 6,421,080 (Lambert); U.S. Pat. No. 5,151,945 (Lee et al.); U.S. Pat. No. 6,816,085 (Haynes et al.); U.S. Pat. No. 6,943,682 (Dowens et al.); U.S. Pat. No. 6,956,478 (Oyagi et al.); U.S. Pat. No. 7,012,523 (Stuart); U.S. Pat. No. 9,250,267 (Jackson et al.); Published U.S. App. 2002/0030583 (Jang et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2002/0147982 (Naidoo et al.); Published U.S. App. 2003/0095184 (Lin); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2003/0122514 (Mercier et al.); Published U.S. App. 2004/0080615 (Klein et al.); Published U.S. App. 2004/0080627 (Kroll et al.); Published U.S. App. 2005/0001717 (Bohbot et al.); Published U.S. App. 2005/0165612 (Van Rysselberghe); Published U.S. App. 2009/0224912 (Sobol); Published Germany App. DE10039263; France Pat. No. FR2759804; Published United Kingdom App. GB2285365 (Yau et al.); Published United Kingdom App. GB2377582 (Hunter); Published Japan App. JPH09-107409 (Onozuka); Published Japan App. JPH11-224383 (Kumagai); Published Korea App. KR19980039422 (Kim et al.); Published Korea App. KR20010074212 (Shin); Published PCT App. WO2002/05220 (Bennett); Published PCT App. WO2003/028375 (Hong); U.S. Pat. No. 5,822,542 (Smith et al.); U.S. Pat. No. 5,878,283 (House et al.); U.S. Pat. No. 6,060,994 (Chen); U.S. Pat. No. 6,104,785 (Chen); U.S. Pat. No. 6,134,303 (Chen); U.S. Pat. No. 6,185,294 (Chornenky et al.); U.S. Pat. No. 6,323,897 (Kogane et al.); U.S. Pat. No. 6,476,858 (Diaz et al.); Published U.S. App.

2002/0016971 (Berezowski et al.); Published U.S. App. 2002/0067259 (Fufidio et al.); Published U.S. App. 2002/0071031 (Lord et al.); Published U.S. App. 2002/0076049 (Boykin et al.); Published U.S. App. 2002/0118283 (Guerrero); Published U.S. App. 2003/0061344 (Monroe); Published U.S. App. 2003/0062997 (Naidoo et al.); Published U.S. App. 2003/0075287 (Weik); Published U.S. App. 2003/0081747 (Ahlstrom et al.); Published U.S. App. 2003/0103138 (Assayag et al.); Published U.S. App. 2003/0171930 (Junqua); Published U.S. App. 2003/0206101 (Dixon et al.); Published U.S. App. 2004/0003051 (Krzyzanowski et al.); Published U.S. App. 2004/0036603 (Bingham); Published U.S. App. 2006/0095539 (Renkis); Published U.S. App. 2006/0171453 (Rohlfing et al.); Published U.S. App. 2006/0255931 (Hartsfield et al.); Published Canada App. CA2228679 (Heggie et al.); Published Germany App. DE20101205; Published Japan App. JP2001086486 (Kogane et al.); Japan Pat. No. JP2001167365 (Ishikawa et al.); Published Japan App. JPH11-112494 (Yamaguchi et al.); Published PCT App. WO01/027763 (Simerly et al.); Published PCT App. WO01/050731 (Noyman et al.); Published PCT App. WO01/097524 (Scaman et al.); Published PCT App. WO02/065420 (Vojtech et al.); Published Korea App. KR20010035246A (Lee); “Motion Activated Video Surveillance Using TI DSP,” Carnegie Mellon University, August 4-6, 1999, available at <https://www.ti.com/sc/docs/general/dsp/fest99/avi/1paper.pdf>; “Video Surveillance Equipment Selection and Application Guide,” NIJ Guide 201-99, October 1999, available at <https://www.ojp.gov/pdffiles1/nij/179545.pdf>; “Nanny-Cam May Leave a Home Exposed,” New York Times, April 14, 2002, available at <https://www.nytimes.com/2002/04/14/business/nanny-cam-may-leave-a-home-exposed.html>; “Scalable Multimedia System for Interactive Surveillance and Video Communication Applications,” IEEE 10th European Signal Processing Conference, September 4-8, 2000, available at <https://ieeexplore.ieee.org/document/7075784>.

125. The asserted claims of the '906 Patent are also invalid under 35 U.S.C. §§ 101 and 102(f) because the claimed invention was conceived by Emmanuel Ozoeneh and was communicated to Ronald Carter in a manner that was sufficient to enable him to construct and successfully operate the claimed invention.

126. The asserted claims of the '906 Patent are also invalid under 35 U.S.C. § 112. By way of example and without limitation, at least the following terms, phrases, and limitations (and substantially similar phrases) in the Asserted Claims fail to satisfy the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112: “real time”; “associated with an entrance”; “sensitivity of the motion detector”; “threshold of the motion detector”; “wherein the exterior device is capable of modifying the sensitivity of the motion detector upon receiving the request to do so”; “allow a user to modify a threshold of the motion detector”; “wherein the exterior device is capable of receiving the digital audio from a peripheral device” (claim 9); “captured by a software application”; “predetermined condition”; “replicating at least a portion of the database”; “transmitting digital streaming video from a device upon detection of a person”; “storing the digital streaming video and digital audio in a database”; “replicating at least a portion of the database on one or more computers” (claims 13, 18).

127. A judicial declaration that the '906 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that SimpliSafe can ascertain its rights and duties with respect to the SimpliSafe Video Doorbell Pro, which Defendants accuse of infringing the '906 patent.

COUNT THIRTEEN

DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '120 PATENT

128. Paragraphs 1 through 127 are incorporated by reference as if fully stated herein.

129. Defendants claim to own all rights, title, and interest in the '120 patent.

130. In filing the ITC Complaint, Defendants accused SimpliSafe of “directly infring[ing] claim 1 of the ’120 patent pursuant to 35 U.S.C. § 271(a), either literally or under the doctrine of equivalents, or both, by making, using, offering for sale, selling, and/or importing . . . the SimpliSafe SimpliCam.” Ex. I, ¶ 5.81.

131. Defendants also accused SimpliSafe of “indirectly infring[ing] claim 1 [of the ’120 patent] . . . by instructing, directing, and/or enabling others, including its customers, purchasers, users and developers, alone, or in combination to use the SimpliSafe SimpliCam and/or perform all or some of the steps recited in claim 1 of the ’120 patent, either literally or under the doctrine of equivalents, and by providing a material or apparatus for use in a patented process, when such material or apparatus is especially adapted for use in the infringement of the ’120 patent, and is not a staple article or commodity of commerce suitable for substantial non-infringing use.” *Id.*

132. Contrary to Defendants’ assertions in the ITC Complaint, the SimpliSafe SimpliCam does not infringe—directly or indirectly—claim 1 of the ’120 patent.

133. The SimpliSafe SimpliCam also does not perform substantially the same function, in substantially the way, to obtain substantially the same result as claim 1 of the ’120 patent.

134. Absent a declaration that any asserted claims of the ’120 patent are not infringed, Defendants will continue to wrongfully assert the ’120 patent against SimpliSafe, thereby causing SimpliSafe irreparable harm and injury.

135. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and SimpliSafe as to whether the claims of the ’120 patent are infringed. A judicial declaration is necessary and appropriate so that SimpliSafe may ascertain its rights regarding the ’120 patent.

136. Based on the foregoing, SimpliSafe hereby requests a declaration that the claims of the '120 patent are not infringed by the SimpliSafe SimpliCam.

COUNT FOURTEEN

DECLARATORY JUDGMENT OF INVALIDITY OF THE '120 PATENT

137. Paragraphs 1 through 136 are incorporated by reference as if fully stated herein.

138. The '120 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 and/or under the doctrine of double patenting, at least because they attempt to claim the abstract idea of receiving and wirelessly communicating with a visitor at an entrance. The claims also recite well-known conventional off-the-shelf components that in combination do not provide an inventive concept sufficient to transform this abstract idea into a patent-eligible application of the idea.

139. Moreover, detection, viewing, communication, and monitoring systems comprising at least the transmission, storage, and/or accessibility of related information or data was well-known in the prior art prior to the priority date of the '120 Patent. In particular, as explained below due to the break in co-pendency, the claims of the '120 Patent are invalid under 35 U.S.C. §§ 102 and 103 in view of the Priority Art. *See* Exs. T-X.

140. Additionally, the asserted claims of the '120 Patent are invalid as anticipated under 35 U.S.C. § 102 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 7,119,609 (Naidoo et al.); Published U.S. App. No. 2019/0058720 (Lindquist); U.S. Pat. No. 6,542,078 (Script et al.); U.S. Pat. No. 6,828,909 (Script et al.); U.S. Pat. No. 7,113,090 (Saylor et al.), Published United Kingdom App.

GB2357387 (Golightly et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2002/0075307 (Alexander et al.); U.S. Pat. No. 5,861,804 (Fansa et al.); U.S. Pat. No. 6,069,655 (Seeley et al.); U.S. Pat. No. 6,385,772 (Courtney); U.S. Pat. No. 6,400,265 (Saylor et al.); U.S. Pat. No. 6,424,371 (Wen); U.S. Pat. No. 7,019,770 (Katz); U.S. Pat. No. 7,242,295 (Milinusic et al.); U.S. Pat. No. 7,277,010 (Joao); Korea Pat. No. KR100373449 (Son); U.S. Pat. No. 6,359,560 (Budge et al.); Published U.S. App. 2003/0046557 (Miller et al.); Published PCT App. WO99/006976 (Meyvis); X10 Wireless Technology, Inc.'s XCam2 (technical user manual http://www.electronicoscaldas.com/datasheet/XCam2-WideEye_X10.pdf).

141. Furthermore, the asserted claims of the '120 Patent are invalid as obvious under 35 U.S.C. § 103 in view of the following exemplary prior art references: U.S. Pat. Nos. 8,164,614 (Issued Apr. 24, 2012), 8,154,581 (Issued Apr. 10, 2012); 7,193,644 (Issued Mar. 20, 2007); U.S. Pat. Pub. Nos. 2008/0117299 (Published May 22, 2008), 2007/0103548 (Published May 10, 2007), 2005/0285934 (Published Dec. 29, 2005); U.S. Pat. No. 9,300,921 (Naidoo et al.); Published U.S. App. 2003/0071724 (D'Amico); Duy Nguyen, "Mobile Home Security with GPRS" (2002); China Pat. No. CN2589640Y (Hudlin); U.S. Pat. No. 5,428,388 (von Bauer et al.); U.S. Pat. No. 5,717,379 (Peters); U.S. Pat. No. 6,064,303 (Klein et al.); U.S. Pat. No. 6,097,429 (Seeley et al.); U.S. Pat. No. 6,421,080 (Lambert); U.S. Pat. No. 5,151,945 (Lee et al.); U.S. Pat. No. 6,816,085 (Haynes et al.); U.S. Pat. No. 6,943,682 (Dowens et al.); U.S. Pat. No. 6,956,478 (Oyagi et al.); U.S. Pat. No. 7,012,523 (Stuart); U.S. Pat. No. 9,250,267 (Jackson et al.); Published U.S. App. 2002/0030583 (Jang et al.); Published U.S. App. 2002/0075307 (Alexander et al.); Published U.S. App. 2002/0147982 (Naidoo et al.); Published U.S. App. 2003/0095184 (Lin); Published U.S. App. 2003/0095185 (Naifeh); Published U.S. App. 2003/0122514 (Mercier et al.); Published U.S.

App. 2004/0080615 (Klein et al.); Published U.S. App. 2004/0080627 (Kroll et al.); Published U.S. App. 2005/0001717 (Bohbot et al.); Published U.S. App. 2005/0165612 (Van Rysselberghe); Published U.S. App. 2009/0224912 (Sobol); Published Germany App. DE10039263; France Pat. No. FR2759804; Published United Kingdom App. GB2285365 (Yau et al.); Published United Kingdom App. GB2377582 (Hunter); Published Japan App. JPH09-107409 (Onozuka); Published Japan App. JPH11-224383 (Kumagai); Published Korea App. KR19980039422 (Kim et al.); Published Korea App. KR20010074212 (Shin); Published PCT App. WO2002/05220 (Bennett); Published PCT App. WO2003/028375 (Hong); U.S. Pat. No. 5,822,542 (Smith et al.); U.S. Pat. No. 5,878,283 (House et al.); U.S. Pat. No. 6,060,994 (Chen); U.S. Pat. No. 6,104,785 (Chen); U.S. Pat. No. 6,134,303 (Chen); U.S. Pat. No. 6,185,294 (Chornenky et al.); U.S. Pat. No. 6,323,897 (Kogane et al.); U.S. Pat. No. 6,476,858 (Diaz et al.); Published U.S. App. 2002/0016971 (Berezowski et al.); Published U.S. App. 2002/0067259 (Fufidio et al.); Published U.S. App. 2002/0071031 (Lord et al.); Published U.S. App. 2002/0076049 (Boykin et al.); Published U.S. App. 2002/0118283 (Guerrero); Published U.S. App. 2003/0061344 (Monroe); Published U.S. App. 2003/0062997 (Naidoo et al.); Published U.S. App. 2003/0075287 (Weik); Published U.S. App. 2003/0081747 (Ahlstrom et al.); Published U.S. App. 2003/0103138 (Assayag et al.); Published U.S. App. 2003/0171930 (Junqua); Published U.S. App. 2003/0206101 (Dixon et al.); Published U.S. App. 2004/0003051 (Krzyzanowski et al.); Published U.S. App. 2004/0036603 (Bingham); Published U.S. App. 2006/0095539 (Renkis); Published U.S. App. 2006/0171453 (Rohlfing et al.); Published U.S. App. 2006/0255931 (Hartsfield et al.); Published Canada App. CA2228679 (Heggie et al.); Published Germany App. DE20101205; Published Japan App. JP2001086486 (Kogane et al.); Japan Pat. No. JP2001167365 (Ishikawa et al.); Published Japan App. JPH11-112494 (Yamaguchi et al.); Published PCT App. WO01/027763 (Simerly et

al.); Published PCT App. WO01/050731 (Noyman et al.); Published PCT App. WO01/097524 (Scaman et al.); Published PCT App. WO02/065420 (Vojtech et al.); Published Korea App. KR20010035246A (Lee); “Motion Activated Video Surveillance Using TI DSP,” Carnegie Mellon University, August 4-6, 1999, available at <https://www.ti.com/sc/docs/general/dsp/fest99/avi/1paper.pdf>; “Video Surveillance Equipment Selection and Application Guide,” NIJ Guide 201-99, October 1999, available at <https://www.ojp.gov/pdffiles1/nij/179545.pdf>; “Nanny-Cam May Leave a Home Exposed,” New York Times, April 14, 2002, available at <https://www.nytimes.com/2002/04/14/business/nanny-cam-may-leave-a-home-exposed.html>; “Scalable Multimedia System for Interactive Surveillance and Video Communication Applications,” IEEE 10th European Signal Processing Conference, September 4-8, 2000, available at <https://ieeexplore.ieee.org/document/7075784>.

142. The asserted claims of the ’120 Patent are also invalid under 35 U.S.C. §§ 101 and 102(f) because the claimed invention was conceived by Emmanuel Ozoeneh and was communicated to Ronald Carter in a manner that was sufficient to enable him to construct and successfully operate the claimed invention.

143. The asserted claims of the ’120 Patent are also invalid under 35 U.S.C. § 112. By way of example and without limitation, at least the following terms, phrases, and limitations (and substantially similar phrases) in the Asserted Claims fail to satisfy the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112: “a peripheral device, which is a smartphone”; “a software application capable of operating on a smartphone, wherein the software application is capable of (a) displaying the digital streaming video and at the same time displaying at least one icon; (b) displaying recorded video; and (c) modifying one or more control parameters associated with the device”; “control parameters”; “wherein the device is capable of wirelessly

transmitting digital streaming video to a peripheral device, which is a smartphone, upon detection of a person by the motion sensor”; “a database comprising a hierarchy of storage for the digital streaming video captured by the device” (claim 1).

144. A judicial declaration that the ’120 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that SimpliSafe can ascertain its rights and duties with respect to the SimpliSafe SimpliCam, which Defendants accuse of infringing the ’120 patent.

COUNT FIFTEEN

DECLARATORY JUDGMENT OF INVALIDITY OF THE ASSERTED PATENTS

145. Paragraphs 1 through 144 are incorporated by reference as if fully stated herein.

146. Defendants allege that the Asserted Patents are entitled to a priority date of at least March 26, 2015, the date the application that to the ’478 patent was filed. The applications leading to the other Asserted Patents were filed after March 26, 2015.

147. Defendants also allege that the Asserted Patents are entitled to claim priority to the Priority Patents. Specifically, Defendants allege that each of the Asserted Patents is a continuation of an earlier filed application and is entitled to claim priority to those applications, going back to October 30, 2007, the date the application that lead to U.S. Patent No. 8,164,614 (“the ’614 patent” was filed), which further claims priority to December 29, 2006, the date the application that lead to U.S. Patent No. 8,154,581 (“the ’581 patent”) was filed.

148. Defendants further allege that the Asserted Patents are entitled to a priority date of October 9, 2003 through a priority claim to the application that lead to U.S. Patent No. 7,193,644 (“the ’644 patent”) as continuations-in-part.

149. Defendants further allege that the Asserted Patents are entitled to a priority date of October 15, 2002, through U.S. Provisional Application No. 60/418,384 (“the Provisional Application”).

150. The Asserted Patents each claim priority to the ’614 and ’581 patents through abandoned applications U.S. patent application nos. 14/338,525 (“the ’525 application”) and 13/453,100 (“the ’100 application”). Defendants contend that the specifications of the ’614 and ’581 patents disclose each limitation of the asserted claims from the Asserted Patents in the ITC investigation.

151. The Asserted Patents each claim priority to the ’644 patent through the ’525 and ’100 applications. Defendants contend that the specifications of the ’644 patent discloses each limitation of the asserted claims from the Asserted Patents in the ITC investigation.

152. The Asserted Patents each claim priority to the Provisional Application through the ’525 and ’100 applications. Defendants contend that the Provisional Application discloses each limitation of the asserted claims from the Asserted Patents in the ITC investigation.

153. The ’614 patent issued on April 24, 2012, was filed on October 30, 2007 as U.S. Patent Application No. 11/929,464, and was published on May 22, 2008 as U.S. Patent Publication No. 2008/0117299.

154. The ’581 patent issued on April 10, 2012, was filed on December 29, 2006 as U.S. Patent Application No. 11/618,615, and was published on May 10, 2007 as U.S. Patent Publication No. 2007/0103548.

155. The ’644 patent issued on March 20, 2007, was filed on October 9, 2003 as U.S. Patent Application No. 10/682,185, and was published as U.S. Patent Publication No. 2005/0285934 on December 29, 2005.

156. U.S. provisional application no. 60/418,384 was filed on October 15, 2002 and became public no later than December 29, 2005.

157. The application that led to each of the Asserted Patents were filed more than one year after each of the Priority Art issued, were published, or were otherwise publicly available.

158. Therefore, unless Defendants can establish that the Asserted Patents are entitled to claim priority to the '614, '518, or '644 patents or the Provisional Application, the '614, '518, and '644 patents and the Provisional Application anticipate or render obvious the asserted claims of the Asserted Patents.

159. The Asserted Patents are not entitled to claim priority of an application that lead to the '478 patent because the application that lead to the '478 patent was not filed before the abandonment of the '525 application.

160. The '525 application was abandoned as of October 7, 2014, and the application that lead to the '478 patent was filed on March 26, 2015.

161. The '525 application was filed on July 23, 2014.

162. On August 4, 2014, the PTO mailed an office action regarding a “notice to file missing parts of nonprovisional application” and specified that “[a]pplicant is given TWO MONTHS from the date of this Notice within which to file all required items below to avoid abandonment.” Ex. N. The missing items were “the statutory basic filing fee”; “the application search fee”; “the application examination fee”; “the inventor’s oath or declaration or an application data sheet (ADS) naming each inventor”; “replacement drawings in compliance with 37 C.F.R. 1.84 and 37 C.F.R. 1.21(d).” Ex. N. The office action also specified the total fees that were necessary to avoid abandonment (\$1740). Ex. N.

163. The August 4, 2014 office action therefore set the deadline to respond as October 6, 2014. 37 C.F.R. § 1.134 (“An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.”).

164. Revolutionary Concepts, Inc. (the then-assignee of the application) (hereinafter, “RCI”) failed to respond to the notice to file missing parts before the October 6, 2014 deadline. Ex. N.

165. The ’525 application was therefore “regarded as abandoned after midnight of the date the period for reply expired,” i.e., midnight on October 7, 2014. MPEP § 710.01(A). The PTO listed the application as abandoned as of October 7, 2014:

14/338,525		COMMUNICATION AND MONITORING SYSTEM						1043.060
Select New Case	Application Data	Transaction History	Image File Wrapper	Continuity Data	Address & Attorney/Agent	Supplemental Content	Assignments	
Transaction History								
Date	Transaction Description							
04-07-2015	Abandonment Mailed							
10-07-2014	Abandonment -- During Preexam Processing							
03-25-2015	Change in Power of Attorney (May Include Associate POA)							
03-25-2015	Correspondence Address Change							
02-04-2015	Mail Pre-Exam Notice							
02-04-2015	Notice of Incomplete Reply							
11-23-2014	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic							
11-23-2014	Applicant has submitted new drawings to correct Corrected Papers problems							

Ex. O.

166. An application is undisputedly abandoned in these circumstances. 35 U.S.C. § 133 (“*Upon failure of the applicant to prosecute the application* within six months after any action therein, of which notice has been given or mailed to the applicant, or *within such shorter time*, not less than thirty days, *as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto.*”) (emphases added); 37 C.F.R. § 1.135(a) (“If an applicant

of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.”).

167. On November 23, 2014, six weeks *after* the deadline to respond, RCI included an application data sheet naming each inventor, which was only one of the missing items identified in the August 2014 office action as necessary to avoid abandonment. And even this ADS was deficient in meeting any requirements set forth in the August 4, 2014 office action as not being properly marked up to show the desired changes.

168. No extension fees (or the filing fees for that matter) or any of the other required documentation, which would have otherwise been required to maintain the '525 application's pendency beyond the shortened statutory period that expired on October 6, 2014 (resulting in abandonment), were filed with the November 23, 2014 submission, or at any other point before the application that lead to the '478 patent was filed. The failure to pay a fee for the '525 application serves as an independent basis to find that the '525 application was not pending when the application that lead to the '478 patent was filed.

169. The examiner later issued a Notice of Incomplete Reply on February 4, 2015, but as a matter of law, this did not operate to revive the abandoned '525 application or otherwise indicate that the '525 application was not abandoned as of October 7, 2014. 37 C.F.R. §§ 1.135(b), (c).

170. There is no separate requirement that a proceeding on a patent application be terminated, in addition to being abandoned, under § 120. Termination of a proceeding on a patent application refers to appellate proceedings. The '525 application was never subject to appellate proceedings at the PTO or otherwise.

171. Complainants cannot remedy the abandonment now through a petition to revive, which could only be filed and decided by the UPSTO. A petition to revive an abandoned application must be accompanied by, among other things, “[a] statement that the *entire delay* in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this section was *unintentional*.” 37 CFR § 1.137(b) (emphasis added); *see also* MPEP § 711.03(II)(C). Defendants cannot establish that the entire delay was unintentional.

172. As a result, all seven Asserted Patents are invalid under §§ 102 and 103 in view of the Priority Patents.

COUNT SIXTEEN

DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE ASSERTED PATENTS DUE TO INEQUITABLE CONDUCT

173. Paragraphs 1 through 172 are incorporated by reference as if fully stated herein.

174. Each of the Asserted Patents is unenforceable because of repeated inequitable conduct before the United States Patent & Trademark Office (“PTO”) by the applicant and/or his attorneys during the productions of the applications that led to the Asserted Patents.

175. Individuals that owed a duty of candor and good faith to the PTO that engaged in inequitable conduct included at least named inventor Ronald Carter (“Carter”), and/or attorneys F. Rhett Brockington (“Brockington”), Chad D. Tillman (“Tillman”), Jeremy C. Doerre (“Doerre”), Bobby W. Braxton (“Braxton”), and Kirby B. Drake (“Drake”), among others.

176. The Asserted Patents are unenforceable because of inequitable conduct by the applicant and/or his attorneys during the prosecution of: (1) U.S. Patent Application No. 10/682,185 (“the ’185 application”), which issued as U.S. Patent No. 7,193,644 on March 20, 2007; (2) U.S. Patent Application No. 11/618,615 (“the ’615 application”), which issued as U.S.

Patent No. 8,154,581 on April 10, 2012; (3) U.S. Patent Application No. 11/618,618 (“the ’618 application”), which issued as U.S. Patent No. 8,144,183 on March 27, 2012; (4) U.S. Patent Application No. 11/618,621 (“the ’621 application”), which issued as U.S. Patent No. 8,139,098 on March 20, 2012; (5) U.S. Patent Application No. 11/929,412 (“the ’412 application”), which issued as U.S. Patent No. 8,144,184 on March 27, 2012; (6) U.S. patent application No. 11/929,464 (“the ’464 application”), which issued as U.S. Patent No. 8,164,614 on April 24, 2012; (7) U.S. Patent Application No. 14/794,299 (“the ’299 application”), which issued as U.S. Patent No. 9,432,638 on August 30, 2016; (8) U.S. Patent Application No. 14/670,044 (“the ’044 application”), which issued as U.S. Patent No. 9,485,478 on November 1, 2016; (9) U.S. Patent Application No. 15/237,797 (“the ’797 application”), which issued as U.S. Patent No. 10,097,796 on October 9, 2018; (10) U.S. Patent Application No. 15/238,228 (“the ’228 application”), which issued as U.S. Patent No. 10,097,797 on October 9, 2018; (11) U.S. Patent Application No. 15/237,933 (“the ’933 application”), which issued as U.S. Patent No. 10,200,660 on February 5, 2019; (12) U.S. Patent Application No. 16/225,979 (“the ’979 application”), which issued as U.S. Patent No. 10,523,906 on December 31, 2019; (13) U.S. Patent Application No. 16/570,530 (“the ’530 application”), which issued as U.S. Patent No. 10,674,120 on June 2, 2020 (collectively “the Patent Applications”), and all other related applications.

177. First, based on the public record of the *Carter v. Ozoeneh*, No. 3:8-cv-00614 (W.D.N.C. 2010) litigation and the file histories of the Patent Applications, Carter knowingly signed false declarations claiming to be the sole inventor of the inventions claimed in the applications that issued as the Asserted Patents when he was fully aware that Ozoeneh was at least a joint inventor of the inventions. Carter did this with the intent to deceive the PTO. On information and belief, Brockington, Tillman, Doerre, Braxton, and Drake submitted Carter’s false

declarations to the PTO with the applications that issued as the Asserted Patents knowing that the declarations were false and with the intent to deceive the PTO.

178. Second, based on the public record of the *Carter v. Ozoeneh*, No. 3:8-cv-00614 (W.D.N.C. 2010) litigation and the file histories of the Patent Applications, Carter and/or Braxton knowingly made material misrepresentations to the PTO that the Asserted Patents were entitled to priority of the previous filed applications. They did this knowing, and without disclosing, that the newly filed application was not entitled to claim priority to the earlier application because the '525 application had been abandoned. They did this with the intent to deceive the PTO.

179. Based on the public record of the *Carter v. Ozoeneh*, No. 3:8-cv-00614 (W.D.N.C. 2010) litigation and the file histories of the Patent Applications, Carter, Brockington, Tillman, Doerre, Braxton, and/or Drake acted with specific intent to deceive the Patent Office in prosecuting the Asserted Patents in ways material to the patentability of the Asserted Patents because, but for the intentional and deliberate misrepresentations to the Patent Office, each of the Asserted Patents would not have issued.

180. In 2002, Carter approached Emmanuel Ozoeneh ("Ozoeneh") at Ozoeneh's workplace (an electronics company named "Tweeter"). Ex. P, *Carter v. Ozoeneh*, No. 3:8-cv-00614, Dkt. No. 26-1 at 6 (W.D.N.C. 2010). Carter identified problems associated with missing deliveries from UPS and FedEx when he was not at home. *Id.* at 8. According to Ozoeneh, Carter, who was a housing development specialist for the City of Charlotte at the time, had a general idea of the problem to be solved, but he had no technical expertise to solve it. *Id.* at 8-10. Ozoeneh, on the other hand, did have the technical expertise to solve the problem. *Id.* The two then proceeded to meet on a regular basis to discuss the idea for a voice and video monitoring system and later sought counsel for patent protection. *Id.*

181. Carter and Ozoeneh subsequently formed a company together to promote and develop the invention (Revolutionary Engineering Concepts, Inc.). *Carter v. Ozoeneh*, 717 F. Supp. 2d 507, 508 (W.D.N.C. 2010). Carter and Ozoeneh jointly retained and corresponded with a company that was assisting them in preparing patent drawings and a description of the invention. *Id.* Carter and Ozoeneh hired the law firm Dougherty & Clements to prosecute a patent. *Id.* After several meetings, attorney Jason S. Miller (“Miller”) from Dougherty & Clements filed a provisional patent application on October 15, 2002, listing both Carter and Ozoeneh as co-inventors. *Id.* at 508–09. After the provisional patent application was filed, Carter explained to Ozoeneh that he had been told by the patent prosecutors that the invention was unpatentable, and that Carter no longer wanted to pursue this endeavor. *Id.* at 509. Carter told Ozoeneh that Dougherty & Clements had disintegrated and that they could no longer work with the law firm. *Id.* Carter then had little or no contact with Ozoeneh, despite Ozoeneh’s attempts to contact him. *Id.* Contrary to Carter’s assertion to Ozoeneh, however, Carter did not abandon the invention. *Id.* Carter continued to pursue patent protection. *Id.* In October 2003, Dougherty & Clements filed a non-provisional application, the ’185 application, on behalf of Carter and without Ozoeneh’s knowledge. *Id.* This patent application eventually matured into the ’644 Patent and is the basis for all the Asserted Patents, which lists only Carter as inventor.

182. On or about February 13, 2004, without the knowledge or consent of Ozoeneh, Carter then formed a North Carolina corporation of RCI. Ex. Q, *Carter*, No. 3:8-cv-00614, Dkt. No. 85 at 6-7. Thereafter, on or about February 28, 2005, Carter incorporated another new legal entity, RCI, under the laws of the State of Nevada. *Id.* Without the knowledge of Ozoeneh, on or July 17, 2006, Carter purported to assign all right, title and interest in and to the non-provisional application to RCI. *Id.* Ozoeneh remained unaware of the non-provisional application filing until

late 2008 when he was notified by Dougherty & Clements attorneys as part of a lawsuit between Carter and RCI against Dougherty & Clements related to a claim of legal malpractice. *Id.*

183. Upon Carter learning that Ozoeneh had been informed of the subsequent patent filings, Carter embarked on a campaign of intimidation to cover up his deception. Specifically, on December 30, 2008, Carter filed a complaint in the Western District of North Carolina (Case No. 3:08-cv-614-RJC-DSC) (the “*Carter v. Ozoeneh* matter”) seeking declaratory, compensatory, and injunctive relief with respect to the inventorship and ownership of the ’644 Patent. *Carter v. Ozoeneh*, 2010 WL 4054343, *2 (W.D.N.C. Oct. 15, 2010). Carter sought a declaratory judgment that Ozoeneh is not an inventor or owner of the technology that is subject of the ’644 Patent. *Id.* Without adequate funds to pay for legal representation, Ozoeneh was forced to proceed pro se. *Id.* Carter subsequently filed a motion for summary judgment motion with respect to inventorship. *Id.*

184. Upon discovering that Ozoeneh lacked legal representation, Dougherty & Clements’s insurance company, Lawyers Mutual, paid an attorney to represent Ozoeneh in the action through the summary judgment stage. *Id.* Carter, after becoming aware of these payments, amended the complaint to assert claims of tortious interference with contract and maintenance and unfair and deceptive trade practices against Lawyers Mutual. *Id.* Carter also amended the complaint to assert claims of tortious interference with contract and maintenance against Miller for allegedly disclosing to Ozoeneh that Carter had told the parties Ozoeneh had died or gone back to Nigeria. *Id.* at 3. The Court rejected Carter’s motion for summary judgment. *See Carter v. Ozoeneh*, 717 F.Supp.2d 507 (W.D.N.C. 2010). The Court also granted the defendants’ motions for summary judgment on the other claims. *See Carter v. Ozoeneh*, 2010 WL 4054343 (W.D.N.C. 2010). On January 28, 2011, the case settled on the eve of trial.

185. Carter, Brockington, Tillman, Doerre, Braxton, and/or Drake's misstatements and omissions about inventorship were material to the patentability of the asserted claims. Upon information and belief, Carter knowingly signed false declarations claiming to be the sole inventor of the inventions claimed in the applications that issued as the Asserted Patents when he was fully aware that Ozoeneh was at least a joint inventor of the inventions. Upon information and belief, Brockington, Tillman, Doerre, Braxton, and Drake submitted Carter's false declarations to the PTO with the applications that issued as the Asserted Patents knowing that the declarations were false.

186. Submitting an unmistakably false oath or declaration regarding the inventorship of an invention is *per se* material. On October 9, 2003, Brockington filed the '185 application with the PTO at Carter's direction. The '185 application described and claimed an "Automated Audio Video Messaging and Answering System." The '185 application claimed priority to a provisional application, No. 60/418,384, that named both Carter and Ozoeneh as inventors. The '185 application was materially the same as the provisional application except it named Carter as the sole inventor. The application included a signed declaration from Carter, dated September 23, 2003, stating that he believed he was the sole inventor of the subject matter claimed in the '185 application. In the declaration, Carter represented, among other things, that: (1) I believe I am the original, first and sole inventor . . . of the subject matter which is claimed and for which a patent is sought on the invention entitled[] AUTOMATED AUDIO VIDEO MESSAGING AND ANSWERING SYSTEM, [t]he specification of which is attached hereto . . ."; (2) "I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56"; (3) "I hereby claim the benefit under 35 USC § 119(e) of any United States provisional application(s) listed below: 60/418,384"; (4) "I . . . declare that all statements made herein of my

own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.” Ex. R. On December 29, 2006, March 24, 2015, and August 16, 2016, Tillman, Doerre, Braxton, and/or Drake filed similar declarations in the other Patent Applications.

187. In addition to declarations filed in the other Patent Applications, the conduct in the prosecution of the ’185 patent directly relates to the Asserted Claims of the Asserted Patents. All of the Asserted Patents purport to be continuations-in-part of the ’644 patent and purport to claim priority to the subject matter of the ’644 patent. Moreover, during the prosecution of the ’478 and ’638 patents, Carter included a mapping of the proposed claims to the ’644 patent claims to demonstrate that those patent applications were entitled to the ’644 patent’s priority date. Carter’s conduct during the prosecution of the ’185 application directly led to the Asserted Claims and Asserted Patents in this matter.

188. Moreover, clear and convincing evidence elicited during the *Carter v. Ozoeneh* matter confirmed that Ozoeneh was at least a co-inventor of the invention described and claimed in the Patent Applications. For example, Mr. Ozoeneh testified under oath that “having a computer and software to control the unit, making the device communicable with a mobile phone, a motion sensor, a camera, and a device for keeping a record of visitors” are features of the invention disclosed and claimed in the ’185 application that were his ideas. *Carter*, 717 F. Supp. 2d at 509-10. He also provided evidence of a fax dated May 23, 2002 addressed to Miller and listing “Emmanuel, Revolutionary Engineering Concepts” as the sender. *Id.* The document included a

drawing of a purported prototype with parts labeled, including an “external unit” including a “camera,” a “microphone,” a “speaker”; and a peripheral device (labeled “Interior unit”) that can be “programmed” and receive the digital audio and video, along with other features found in the Asserted Patents. Ex. S, *Carter* No. 3:8-cv-00614, Dkt. No. 26-2. Christopher Bernard, Dougherty & Clement’s 30(b)(6) witness testified that the firm’s documents and invoices are “consistent with” Ozoeneh’s position that he was an inventor of the ’644 Patent. *Carter*, 717 F.Supp.2d at 510. These documents included an invention disclosure form that was signed by both Carter and Ozoeneh on adjacent lines that listed them as “Inventor 1” and “Inventor 2.” *Id.* An October 22, 2002 letter to Ozoeneh from Dougherty & Clement also attached an invoice and the provisional application that listed both Carter and Ozoeneh as inventors. *Id.* Miller also testified that it was his understanding that Carter and Ozoeneh were co-inventors of the ’644 Patent based on discussions he had with the two of them, the documents provided to him, and the invention disclosure form. *Id.* Miller specifically testified that it was his understanding that both Carter and Ozoeneh contributed to Claim 1 of the ’644 patent as a whole. *Id.* at 511. He also testified that “neither Mr. Ozoeneh nor Mr. Carter ever objected to the fact [that they were listed as co-inventors] after being provided copies of the Provisional Application as filed.” *Id.*

189. Upon information and belief, Carter, Brockington, Tillman, Doerre, Braxton, and/or Drake also had the specific intent to deceive the PTO. As explained above, the evidence shows that Carter knew that Ozoeneh had conceived of the inventive solution to the problem that he had identified. Carter took steps to deceive Ozoeneh about the patentability of the invention, removed him from any business associated with the invention, and hid the filing of the ’185 application from him. When Ozoeneh was informed of Carter’s deceit, Carter embarked on a campaign of intimidation against Ozoeneh. These actions confirm that Carter, and upon

information and belief, Brockington, Tillman, Doerre, Braxton, and/or Drake, knew Ozoeneh should have been named as at least a co-inventor, but intentionally submitted a false sworn declaration to the PTO removing him as an inventor.

190. Moreover, upon information and belief, during the pendency of and after the matter, Carter, Tillman, Doerre, Braxton, and/or Drake took further steps to hide the misconduct by withholding information about the dispute from the PTO and subsequently attempting to bury information about the litigation, despite the pendency of the '615, '618, '612, '412, and '464 patent applications during the litigation. Despite knowing they had an obligation to disclose pending litigations, they withheld information about the litigation from the PTO during the pendency of the litigation in an information disclosure statement or otherwise. They also withheld the specific key testimony and evidence from the lawsuit, including evidence outlined above, that showed Ozoeneh was the proper inventor, as well as Carter's responses which are also material to the patent ability of the Asserted Patents' claims. Carter, Tillman, Doerre, Braxton, and/or Drake then attempted to bury the existence of the lawsuit by listing of the case name in a patent determination report on the '644 patent (per 35 U.S.C. § 290) three years after its issuance, indicating only that a consent judgment had been entered, without any information about what the case related to or the evidence elicited in the trial. They did not provide any information at all about the litigation or material facts in the pending applications. This confirms that Carter, Tillman, Doerre, Braxton, and/or Drake knew they were required to make disclosures of the litigation, but intentionally withheld material details showing that Carter was not the sole inventor of the Asserted Patents.

191. Furthermore, upon information and belief, Carter and/or Braxton also knowingly made material misrepresentations to the PTO that the Asserted Patents were entitled to priority of the previous filed applications. They did this knowing, and without disclosing, that the newly filed

application was not entitled to claim priority to the earlier application because the '525 application had been abandoned. They did this with the intent to deceive the PTO.

192. Based on the public record of the *Carter v. Ozoeneh*, No. 3:8-cv-00614 (W.D.N.C. 2010) litigation and the file histories of the Patent Applications, in submitting and prosecuting the '044 application, Carter and/or Braxton knowingly and intentionally prosecuted an application based on a claim of priority they knew to not be supported, despite the “duty of candor and good faith in dealing with the [PTO] . . .” 37 C.F.R. § 1.56(a), (e). They did this knowing, and without disclosing, that the newly filed application was not entitled to claim priority to the earlier application because the '525 application had been abandoned. They therefore did this with the intent to deceive the PTO.

193. As a result of these actions also, all claims of the Asserted Patents, and all related patents, are unenforceable due to inequitable conduct.

PRAYER FOR RELIEF

WHEREFORE, SimpliSafe respectfully requests that this Court enter judgment in its favor and prays that the Court grant the following relief:

- A. A declaration that SimpliSafe's Video Doorbell Pro and SimpliCam do not infringe any claim of the '660 patent;
- B. A declaration that all claims of the '660 patent are invalid and unenforceable;
- C. A declaration that SimpliSafe's Video Doorbell Pro does not infringe any claim of the '796 patent;
- D. A declaration that all claims of the '796 patent are invalid and unenforceable;
- E. A declaration that SimpliSafe's Video Doorbell Pro does not infringe any claim of the '797 patent;

- F. A declaration that all claims of the '797 patent are invalid and unenforceable;
- G. A declaration that SimpliSafe's Video Doorbell Pro does not infringe any claim of the '478 patent;
- H. A declaration that all claims of the '478 patent are invalid and unenforceable;
- I. A declaration that SimpliSafe's Video Doorbell Pro does not infringe any claim of the '638 patent;
- J. A declaration that all claims of the '638 patent are invalid and unenforceable;
- K. A declaration that SimpliSafe's Video Doorbell Pro does not infringe any claim of the '906 patent;
- L. A declaration that all claims of the '906 patent are invalid and unenforceable;
- M. A declaration that SimpliSafe's SimpliCam does not infringe any claim of the '120 patent;
- N. A declaration that all claims of the '120 patent are invalid and unenforceable;
- O. An order that Defendants, and their officers, directors, employees, agents, attorneys, and all persons in active concert or participation with them, are restrained and enjoined from further instituting or further prosecuting any action against SimpliSafe with respect to any of the Asserted Patents;
- P. A declaration that this case is exceptional within the meaning of 35 U.S.C. § 285;
- Q. An award to SimpliSafe of its costs and attorneys' fees; and
- R. Such other and further relief at law or equity as this Court deems just and proper.

DEMAND FOR JURY TRIAL

In accordance with Federal Rule of Civil Procedure 38, SimpliSafe respectfully demands a jury trial of all issues triable to a jury in this action.

Dated: March 26, 2021

Respectfully submitted,

/s/ Kristina R. Cary

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CERTIFICATE OF SERVICE

I certify that this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and paper copies will be sent to those indicated as non-registered participants on March 26, 2021.

/s/ Kristina R. Cary

Kristina R. Cary