

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

Paradise IP LLC,

Plaintiff,

v.

Gannett Co., Inc. (USA Today),

Defendant.

Case No. 21-118-RGA

Patent Case

Jury Trial Demanded

FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT

1. Plaintiff Paradise IP LLC (“Plaintiff”), through its attorneys, complains of Gannett Co., Inc. (USA Today) (“Defendant”), and alleges the following:

PARTIES

2. Plaintiff Paradise IP LLC is a corporation organized and existing under the laws of Delaware that maintains its principal place of business at 2108 Dallas Pkwy, Ste 214 - 1025, Plano, TX 75093-4362.

3. Defendant Gannett Co., Inc. (USA Today) is a corporation organized and existing under the laws of Delaware that maintains an established place of business at 7950 Jones Branch Drive McLean, VA 22107-0150.

JURISDICTION

4. This is an action for patent infringement arising under the patent laws of the United States, Title 35 of the United States Code.

5. This Court has exclusive subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

6. This Court has personal jurisdiction over Defendant because it has engaged in systematic and continuous business activities in this District and is incorporated in this District's state. As described below, Defendant has committed acts of patent infringement giving rise to this action within this District.

VENUE

7. Venue is proper in this District under 28 U.S.C. § 1400(b) because Defendant has an established place of business in this District. In addition, Defendant has committed acts of patent infringement in this District, and Plaintiff has suffered harm in this district.

PATENTS-IN-SUIT

8. Plaintiff is the assignee of all right, title and interest in United States Patent Nos. 7,200,613; and 7,791,741 (the "Patents-in-Suit"); including all rights to enforce and prosecute actions for infringement and to collect damages for all relevant times against infringers of the Patents-in-Suit. Accordingly, Plaintiff possesses the exclusive right and standing to prosecute the present action for infringement of the Patents-in-Suit by Defendant.

THE '613 PATENT

9. The '613 Patent is entitled "Asset management system for network-based and non-network-based assets and information," and issued 2007-04-03. The application leading to the '613 Patent was filed on 2002-11-04. A true and correct copy of the '613 Patent is attached hereto as Exhibit 1 and incorporated herein by reference.

THE '741 PATENT

10. The '741 Patent is entitled "On-the-fly state synchronization in a distributed system," and issued 2010-09-07. The application leading to the '741 Patent was filed on 2005-04-08. A true and correct copy of the '741 Patent is attached hereto as Exhibit 2 and incorporated herein by reference.

The '613 Patent

11. Prior art networking systems were limited to network communications between conventional devices. The claimed invention, on the other hand, includes interoperating with assets that lack network communication capabilities: “a system for retaining information about a large set of not only electronic machines, but also any “assets” which may or may not have inherent network-communication capabilities. Such assets may include machines such as analog copiers, typewriters, and telephones; and may further include items such as desks and chairs.” ‘613 patent, 1:44-50.

12. The claimed invention addresses the problem of managing assets, including those that lack network communication capabilities with unconventional, technical solutions. *Id.*, 2:32-44 (“According to one aspect of the present invention, there is provided a method of retaining data about a plurality of assets, the assets including network assets and non-network assets, the data including network data and non-network data, the network data being obtainable over a network. For each asset, a file is associated with the asset, the file including spaces for holding data, each space being associated with a type of data. For a network asset, a space associated with a first type of data in the associated file is populated with the network data. For a non-network asset, the space associated with the first type of data in the associated file is populated with non-network data.”).

The '741 Patent

13. As the processing demands for systems has increased over time, conventional systems have addressed this demand by making a single system more complex and increasing the number of embedded processors. The specification highlights this problem of increasing system complexity and processors to address increasing processing demands: “However, as machines

become more complex and contain larger numbers of embedded processors, instances of tightly coupled distributed control systems are becoming more common. In a tightly coupled system, controllers may interact through fast physical or informational coupling. That is, the actions of one controller may have an impact on an ability of a second controller to perform its function. Therefore, there is a desire for coordination and communication among the various controllers. One aspect of the coordination problem is how to synchronize a newly activated process or controller, which has been activated in order to address a particular portion of a process, to the status or state of the ongoing process in the face of communication delays.” ‘741 patent, 3:63-67.

14. The claimed invention tackles this problem by providing “systems and methods for synchronizing a second process to a first process in the face of communications delays.” *Id.*, 4:1-24. (“A method for synchronizing a second process to a first process, wherein state data regarding input to and output of a model of the first process is available to the second process after a delay period, can include beginning a data collection period, receiving delayed state data points regarding the input to and output of the model, storing the delayed state data points received during the data collection period, ending the data collection period after receiving and storing delayed state data that represents the state of the input to and output of the model at a point in time after the beginning of the data collection period and determining a current state of the model of the process based on at least some of the stored state data points and predetermined information regarding a behavior of the state of the model. Additionally, the method for synchronizing can include setting a current state of the second process according to the determined current state of the model, thereby synchronizing the second process to the first process.”).

The '613 Patent

15. The exemplary asserted claims of this patent assert the following.

Exemplary Asserted Claims of the '613 Patent

1. A method of retaining data about a plurality of assets in an effectively single database controlled by a computer, the assets including network assets and non-network assets, the data including network data and non-network data, the network data being obtainable over a network, comprising:

for each asset, associating the asset with a file in the database, the file including spaces for holding data, each space being associated with a type of data;

discovering a network asset, the network asset having a network address associated therewith;

as a result of discovering the network asset, creating a file and populating at least one predetermined space in the file with network data relating to the network asset;

inferring non-network data related to the network asset and populating at least one predetermined space in the file with the inferred non-network data relating to the network asset, the non-network data including data relating to at least one of a physical location of the asset, a person associated with the asset, a warranty associated with the asset, and a lease associated with the asset; and

for a non-network asset, associating the non-network asset with a file and populating a space in the associated file with non-network data.

6. The method of claim 1, wherein a type of data relates to an identity of a vendor of the asset.

The '741 Patent

16. The exemplary asserted claims of this patent assert the following.

Exemplary Asserted Claims of the '741 Patent

1. A method for synchronizing a second process to a first process, wherein state data regarding input to and output of a model of the first process is available to the second process after a delay period, the method comprising:

beginning a data collection period;

receiving delayed state data points regarding the input to and output of the model by a controller of the second process;

storing the delayed state data points received during the data collection period;

ending the data collection period after receiving and storing delayed state data that represents the state of the input to and output of the model at a point in time after the beginning of the data collection period;

determining a current state of the model of the process based on at least some of the stored state data points and predetermined information regarding a behavior of the state of the model; and

setting a current state of the second process according to the determined current state of the model, thereby synchronizing the second process to the first process.

COUNT 1: INFRINGEMENT OF THE '613 PATENT

17. Plaintiff incorporates the above paragraphs herein by reference.

18. **Direct Infringement.** Defendant has infringed one or more claims of the '613 Patent in at least this District by making, using, offering to sell, selling and/or importing, without limitation, at least the Defendant products identified in the charts incorporated into this Count below (among the "Exemplary Defendant Products") that infringe at least the exemplary claims of the '613 Patent also identified in the charts incorporated into this Count below (the "Exemplary '613 Patent Claims") literally or by the doctrine of equivalents. On information and belief, numerous other devices that infringe the claims of the '613 Patent have been made, used, sold, imported, and offered for sale by Defendant and/or its customers.

19. Defendant also has infringed, literally or under the doctrine of equivalents, the Exemplary '613 Patent Claims, by having its employees internally test and use these Exemplary Products.

20. Exhibit 3 includes charts comparing the Exemplary '613 Patent Claims to the Exemplary Defendant Products. As set forth in these charts, the Exemplary Defendant Products practice the technology claimed by the '613 Patent. Accordingly, the Exemplary Defendant Products incorporated in these charts satisfy all elements of the Exemplary '613 Patent Claims.

21. Plaintiff therefore incorporates by reference in its allegations herein the claim charts of Exhibit 6.

22. Plaintiff is entitled to recover damages adequate to compensate for Defendants infringement.

COUNT 2: INFRINGEMENT OF THE '741 PATENT

23. Plaintiff incorporates the above paragraphs herein by reference.

24. **Direct Infringement.** Defendant has infringed one or more claims of the '741 Patent in at least this District by making, using, offering to sell, selling and/or importing, without limitation, at least the Defendant products identified in the charts incorporated into this Count below (among the "Exemplary Defendant Products") that infringe at least the exemplary claims of the '741 Patent also identified in the charts incorporated into this Count below (the "Exemplary '741 Patent Claims") literally or by the doctrine of equivalents. On information and belief, numerous other devices that infringe the claims of the '741 Patent have been made, used, sold, imported, and offered for sale by Defendant and/or its customers.

25. Defendant also has infringed, literally or under the doctrine of equivalents, the Exemplary '741 Patent Claims, by having its employees internally test and use these Exemplary Products.

26. Exhibit 4 includes charts comparing the Exemplary '741 Patent Claims to the Exemplary Defendant Products. As set forth in these charts, the Exemplary Defendant Products

practice the technology claimed by the '741 Patent. Accordingly, the Exemplary Defendant Products incorporated in these charts satisfy all elements of the Exemplary '741 Patent Claims.

27. Plaintiff therefore incorporates by reference in its allegations herein the claim charts of Exhibit 8.

28. Plaintiff is entitled to recover damages adequate to compensate for Defendants infringement.

JURY DEMAND

29. Under Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff respectfully requests a trial by jury on all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests the following relief:

- A. A judgment that the '613 Patent is valid and enforceable
- B. A judgment that Defendant has infringed directly one or more claims of the '613 Patent;
- C. A judgment that the '741 Patent is valid and enforceable
- D. A judgment that Defendant has infringed directly one or more claims of the '741 Patent;
- E. An accounting of all damages not presented at trial;
- F. A judgment that awards Plaintiff all appropriate damages under 35 U.S.C. § 284 for Defendants past infringement of the Patents-in-Suit.
- G. And, if necessary, to adequately compensate Plaintiff for Defendant's infringement, an accounting:

- i. that this case be declared exceptional within the meaning of 35 U.S.C. § 285 and that Plaintiff be awarded its reasonable attorneys fees against Defendant that it incurs in prosecuting this action;
- ii. that Plaintiff be awarded costs, and expenses that it incurs in prosecuting this action; and
- iii. that Plaintiff be awarded such further relief at law or in equity as the Court deems just and proper.

Dated: May 14, 2021

Respectfully submitted,

GAWTHROP GREENWOOD, PC

/s/ David W. deBruin
David W. deBruin (#4846)
3711 Kennett Pike, Suite 100
Wilmington, DE 19807
(302) 777-5353
ddebruin@gawthrop.com

Isaac Rabicoff
Rabicoff Law LLC
(*Pro hac vice* application forthcoming)
5680 King Centre Dr. Suite 645
Alexandria, VA 22315
773-669-4590
isaac@rabilaw.com

**Counsel for Plaintiff
Paradise IP LLC**