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12 Attorneys for Plaintiff  
13 e.Digital Corporation

14 **UNITED STATES DISTRICT COURT**  
15 **SOUTHERN DISTRICT OF CALIFORNIA**

16 e.Digital Corporation,  
17 Plaintiff,  
18 v.  
19 Motorola Mobility LLC,  
20 Defendant.

21 Case No. '13CV0780 JAH MDD  
22 **COMPLAINT FOR PATENT**  
23 **INFRINGEMENT**  
24 **DEMAND FOR JURY TRIAL**

25 Plaintiff e.Digital Corporation (“e.Digital” or “Plaintiff”), by and through its  
26 undersigned counsel, complains and alleges against Defendant Motorola Mobility  
27 LLC (“Motorola” or “Defendant”) as follows:

28 **NATURE OF THE ACTION**

1. This is a civil action for infringement of a patent arising under the laws of the United States relating to patents, 35 U.S.C. § 101, *et seq.*, including, without limitation, § 281. Plaintiff e.Digital seeks a preliminary and permanent injunction and monetary damages for the infringement of its U.S. Patent Nos. 5,742,737; 5,491,774; 5,839,108; and 5,842,170.

**JURISDICTION AND VENUE**

2. This court has subject matter jurisdiction over this case for patent

1 infringement under 28 U.S.C. §§ 1331 and 1338(a) and pursuant to the patent laws  
2 of the United States of America, 35 U.S.C. § 101, *et seq.*

3 3. Venue properly lies within the Southern District of California  
4 pursuant to the provisions of 28 U.S.C. §§ 1391(b), (c), and (d) and 1400(b). On  
5 information and belief, Defendant conducts substantial business directly and/or  
6 through third parties or agents in this judicial district by selling and/or offering to  
7 sell the infringing products and/or by conducting other business in this judicial  
8 district. Furthermore, Plaintiff e.Digital is headquartered and has its principal  
9 place of business in this district, engages in business in this district, and has been  
10 harmed by Defendant's conduct, business transactions and sales in this district.

11 4. This Court has personal jurisdiction over Defendant because, on  
12 information and belief, Defendant transacts continuous and systematic business  
13 within the State of California and the Southern District of California. In addition,  
14 this Court has personal jurisdiction over the Defendant because, on information  
15 and belief, this lawsuit arises out of Defendant's infringing activities, including,  
16 without limitation, the making, using, selling and/or offering to sell infringing  
17 products in the State of California and the Southern District of California. Finally,  
18 this Court has personal jurisdiction over Defendant because, on information and  
19 belief, Defendant has made, used, sold and/or offered for sale its infringing  
20 products and placed such infringing products in the stream of interstate commerce  
21 with the expectation that such infringing products would be made, used, sold  
22 and/or offered for sale within the State of California and the Southern District of  
23 California.

24 **PARTIES**

25 5. Plaintiff e.Digital is a Delaware corporation with its headquarters and  
26 principal place of business at 16870 West Bernardo Drive, Suite 120, San Diego,  
27 California 92127.

28 6. Upon information and belief, Defendant Motorola is a corporation

1 registered and lawfully existing under the laws of the State of Delaware, with an  
2 office and principal place of business located at 600 North US Highway 45,  
3 Libertyville IL 60048.

4 **THE ASSERTED PATENTS**

5 7. On April 21, 1998, the United States Patent and Trademark Office  
6 duly and legally issued United States Patent No. 5,742,737 (“the ’737 patent”)  
7 entitled “Method For Recording Voice Messages On Flash Memory In A Hand  
8 Held Recorder,” to its named inventors, Norbert P. Daberko, Richard K. Davis,  
9 and Richard D. Bridgewater. Plaintiff, e.Digital is the assignee and owner of the  
10 entire right, title and interest in and to the ’737 patent and has the right to bring this  
11 suit for damages and other relief. A true and correct copy of the ’737 patent is  
12 attached hereto as Exhibit A.

13 8. On October 17, 2012, the United States Patent and Trademark Office  
14 issued a Reexamination Certificate for the ’737 patent adding new Claim 13, and  
15 cancelling Claim 5. Claim 13 is substantially identical to former claim 5. A true  
16 and correct copy of the Reexamination Certificate is attached hereto as Exhibit B.

17 9. On February 13, 1996, the United States Patent and Trademark Office  
18 duly and legally issued United States Patent No. 5,491,774 (“the ’774 patent”)  
19 entitled “Handheld Record And Playback Device With Flash Memory,” to its  
20 named inventors Elwood G. Norris, Norbert P. Daberko, and Steven T. Brightbill.  
21 Plaintiff, e.Digital is the assignee and owner of the entire right, title and interest in  
22 and to the ’774 patent and has the right to bring this suit for damages and other  
23 relief. A true and correct copy of the ’774 patent is attached hereto as Exhibit C.

24 10. On August 14, 2012, the United States Patent and Trademark Office  
25 issued a Reexamination Certificate for the ’774 patent. A true and correct copy of  
26 the Reexamination Certificate is attached hereto as Exhibit D.

27 11. On November 17, 1998, the United States Patent and Trademark  
28 Office duly and legally issued United States Patent No. 5,839,108 (“the ’108

1 patent”) entitled “Flash Memory File System In A Handheld Record And Playback  
2 Device,” to its named inventors Norbert P. Daberko and Richard K. Davis.  
3 Plaintiff e.Digital is the assignee and owner of the entire right, title and interest in  
4 and to the ’108 patent and has the right to bring this suit for damages and other  
5 relief. A true and correct copy of the ’108 patent is attached hereto as Exhibit E.

6 12. On November 24, 1998, the United States Patent and Trademark  
7 Office duly and legally issued United States Patent No. 5,842,170 (“the ’170  
8 patent”) entitled “Method For Editing In Hand Held Recorder,” to its named  
9 inventors Norbert P. Daberko, Richard K. Davis, and Richard D. Bridgewater.  
10 Plaintiff, e.Digital is the assignee and owner of the entire right, title and interest in  
11 and to the ’170 patent and has the right to bring this suit for damages and other  
12 relief. A true and correct copy of the ’170 patent is attached hereto as Exhibit F.

13 **COUNT ONE**

14 **INFRINGEMENT OF THE ’737 PATENT BY DEFENDANT**

15 13. Plaintiff re-alleges and incorporates by reference each of the  
16 allegations set forth in paragraphs 1 through 12 above.

17 14. Upon information and belief, Defendant, without authority, (a) has  
18 directly infringed and continues to directly infringe the ’737 patent by making,  
19 using, offering to sell, or selling within the United States, or importing into the  
20 United States, products that practice one ore more claims of the ’737 patent in  
21 violation of 35 U.S.C. § 271(a); (b) has induced and continues to induce  
22 infringement of one or more claims of the ’737 patent in violation of 35 U.S.C. §  
23 271(b); and (c) has contributed and continues to contribute to the infringement of  
24 one ore more claims of the ’737 patent in violation of 35 U.S.C. § 271(c).

25 15. The accused products, alone or in combination with other products,  
26 practice each of the limitations of independent claims 1, 4, 9, and 13, and  
27 dependent claims 3, 6 and 7 of the ’737 patent.

28 16. The accused products for purposes of the ‘737 patent include but are

1 not limited to Motorola smartphones including, but not limited to, the Razr, Razr  
2 Maxx, Razr M, Razr HD, Razr Maxx HD, Razr M Developer Edition, Razr HD  
3 Developer Edition, Droid 4, Photon Q 4G LTE, Photon 4G, Admiral, ES400S,  
4 Electrify 2, Electrify M, Electrify, Defy XT, Atrix HD Developer Edition, Atrix  
5 HD, Atrix 2, Triumph, i867, Titanium, and the XT 886; and certain Motorola  
6 mobile phones including, but not limited, to the Quantico and the Brute i686.

7 17. Upon information and belief, Defendant, without authority, has  
8 actively induced infringement and continues to actively induce infringement of the  
9 '737 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe  
10 the claims of the '737 patent and/or by intentionally instructing others how to use  
11 the accused products in a manner that infringes the claims of the '737 patent. On  
12 information and belief, Defendant has induced and continues to induce  
13 infringement by instructing customers to operate the products in an infringing  
14 manner and/or when Defendant tests or otherwise operates the accused products in  
15 the United States.

16 18. Upon information and belief, Defendant, without authority, has  
17 contributed to and continues to contribute to the infringement of the '737 patent in  
18 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or  
19 offering to sell within the United States accused products that (1) constitute a  
20 material part of the invention of the '737 patent, (2) Defendant knows to be  
21 especially adapted for use in infringing the '737 patent, and (3) are not staple  
22 articles of commerce suitable for substantial noninfringing use with respect to the  
23 '737 patent.

24 19. Based on information and belief, Plaintiff alleges that Defendant sells,  
25 ships, or otherwise delivers the accused products with all the features required to  
26 infringe the asserted claims of the '737 patent. On information and belief, these  
27 products are designed to practice the infringing features.

28 20. Defendant had knowledge of infringement of the '737 patent since at

1 least the filing of this complaint and perhaps as early as 2010 by virtue of the  
2 Plaintiff's filing of complaints against others within Defendant's industry. On  
3 information and belief, Defendant has continued to sell products that practice the  
4 '737 patent after acquiring knowledge of infringement.

5 21. Upon information and belief, the infringement by Defendant has been  
6 and is willful.

7 22. Plaintiff has been irreparably harmed by these acts of infringement  
8 and has no adequate remedy at law. Upon information and belief, infringement of  
9 the '737 patent is ongoing and will continue unless Defendant is enjoined from  
10 further infringement by the court.

11 **COUNT TWO**

12 **INFRINGEMENT OF THE '774 PATENT BY DEFENDANT**

13 23. Plaintiff re-alleges and incorporates by reference each of the  
14 allegations set forth in paragraphs 1 through 12 above.

15 24. Upon information and belief, Defendant, without authority, (a) has  
16 directly infringed and continues to directly infringe the '774 patent by making,  
17 using, offering to sell, or selling within the United States, or importing into the  
18 United States, products that practice one or more claims of the '774 patent in  
19 violation of 35 U.S.C. § 271(a); (b) has induced and continues to induce  
20 infringement of one or more claims of the '774 patent in violation of 35 U.S.C. §  
21 271(b); and (c) has contributed and continues to contribute to the infringement of  
22 one or more claims of the '774 patent in violation of 35 U.S.C. § 271(c).

23 25. The accused products, alone or in combination with other products,  
24 practice each of the limitations of independent claims 33 and 34, and dependent  
25 claims 2, 3, 6, 10, 15 through 16, 18, 23 through 26, and 28 through 31 of the '774  
26 patent.

27 26. The accused products for purposes of the '774 patent include but are  
28 not limited to Motorola smartphones including, but not limited to, the Razr, Razr

1 Maxx, Razr M, Razr HD, Razr Maxx HD, Razr M Developer Edition, Razr HD  
2 Developer Edition, Droid 4, Photon Q 4G LTE, Photon 4G, Admiral, ES400S,  
3 Electrify 2, Electrify M, Electrify, Defy XT, Atrix HD Developer Edition, Atrix  
4 HD, Atrix 2, Triumph, i867, Titanium, and the XT 886; and certain Motorola  
5 mobile phones including, but not limited to, the Brute i686.

6 27. Upon information and belief, Defendant, without authority, has  
7 actively induced infringement and continues to actively induce infringement of the  
8 '774 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe  
9 the claims of the '774 patent and/or by intentionally instructing others how to use  
10 the accused products in a manner that infringes the claims of the '774 patent. On  
11 information and belief, Defendant has induced and continues to induce  
12 infringement by instructing customers to operate the products in an infringing  
13 manner and/or when Defendant tests or otherwise operates the accused products in  
14 the United States.

15 28. Upon information and belief, Defendant, without authority, has  
16 contributed to and continues to contribute to the infringement of the '774 patent in  
17 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or  
18 offering to sell within the United States accused products that (1) constitute a  
19 material part of the invention of the '774 patent, (2) Defendant knows to be  
20 especially adapted for use in infringing the '774 patent, and (3) are not staple  
21 articles of commerce suitable for substantial noninfringing use with respect to the  
22 '774 patent.

23 29. Based on information and belief, Plaintiff alleges that Defendant sells,  
24 ships, or otherwise delivers the accused products with all the features required to  
25 infringe the asserted claims of the '774 patent. On information and belief, these  
26 products are designed to practice the infringing features.

27 30. Defendant had knowledge of infringement of the '774 patent since at  
28 least the filing of this complaint and perhaps as early as 2010 by virtue of the

1 Plaintiff's filing of complaints against others within Defendant's industry. On  
2 information and belief, Defendant has continued to sell products that practice the  
3 '774 patent after acquiring knowledge of infringement.

4 31. Upon information and belief, the infringement by Defendant has been  
5 and is willful.

6 32. Plaintiff has been irreparably harmed by these acts of infringement  
7 and has no adequate remedy at law. Upon information and belief, infringement of  
8 the '774 patent is ongoing and will continue unless Defendant is enjoined from  
9 further infringement by the court.

10 **COUNT THREE**

11 **INFRINGEMENT OF THE '108 PATENT BY DEFENDANT**

12 33. Plaintiff re-alleges and incorporates by reference each of the  
13 allegations set forth in paragraphs 1 through 12 above.

14 34. Upon information and belief, Defendant, without authority, (a) has  
15 directly infringed and continues to directly infringe the '108 patent by making,  
16 using, offering to sell, or selling within the United States, or importing into the  
17 United States, products that practice one or more claims of the '108 patent in  
18 violation of 35 U.S.C. § 271(a); (b) has induced and continues to induce  
19 infringement of one or more claims of the '108 patent in violation of 35 U.S.C. §  
20 271(b); and (c) has contributed and continues to contribute to the infringement of  
21 one or more claims of the '108 patent in violation of 35 U.S.C. § 271(c).

22 35. The accused products, alone or in combination with other products,  
23 practice each of the limitations of independent claim 2 and dependent claim 3 of  
24 the '108 patent.

25 36. Razr, Razr Maxx, Razr M, Razr HD, Razr Maxx HD, Razr M  
26 Developer Edition, Razr HD Developer Edition, Droid 4, Photon Q 4G LTE,  
27 Photon 4G, Admiral, ES400S, Electrify 2, Electrify M, Electrify, Defy XT, Atrix  
28 HD Developer Edition, Atrix HD, Atrix 2, Triumph, i867, Titanium, and the XT



1 886; and certain Motorola mobile phones including, but not limited to, the Brute  
2 i686.

3 37. Upon information and belief, Defendant, without authority, has  
4 actively induced and continues to actively induce infringement of claims 2 and 3 of  
5 the '108 patent in violation of 35 U.S.C. § 271(b) by causing others to directly  
6 infringe the claims of the '108 patent and/or by intentionally instructing others how  
7 to use the accused products in a manner that infringes claims 2 and 3 of the '108  
8 patent. Plaintiff also alleges that Defendant has induced and continues to induce  
9 infringement by instructing customers to operate the products in an infringing  
10 manner and/or when Defendant tests or otherwise operates the accused products in  
11 the United States.

12 38. Upon information and belief, Defendant, without authority, has  
13 contributed and continues to contribute to the infringement of claims 2 and 3 of the  
14 '108 patent in violation of 35 U.S.C. § 271(c) by importing into the United States,  
15 selling and/or offering to sell within the United States accused products that (1)  
16 embody and constitute a material part of the invention of the '108 patent, (2)  
17 Defendant knows to be especially adapted for use in infringing the '108 patent, and  
18 (3) are not staple articles of commerce suitable for substantial non-infringing use  
19 with respect to the '108 patent.

20 39. On information and belief, Defendant sells, ships or otherwise  
21 delivers the accused products with all the features required to infringe the asserted  
22 claims of the '108 patent. On information and belief, these products are designed  
23 to practice the infringing features.

24 40. Defendant had knowledge of infringement of the '108 patent since at  
25 least the filing of this complaint and perhaps as early as 2010 by virtue of the  
26 Plaintiff's filing of complaints against others within Defendant's industry.

27 41. Upon information and belief, the infringement by Defendant has been  
28 and is willful.



1 the claims of the '170 patent and/or by intentionally instructing others how to use  
2 the accused products in a manner that infringes the claims of the '170 patent. On  
3 information and belief, Defendant has induced and continues to induce  
4 infringement by instructing customers to operate the products in an infringing  
5 manner and/or when Defendant tests or otherwise operates the accused products in  
6 the United States.

7 48. Upon information and belief, Defendant, without authority, has  
8 contributed and continues to contribute to the infringement of the '170 patent in  
9 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or  
10 offering to sell within the United States accused products that (1) embody and  
11 constitute a material part of the invention of the '170 patent, (2) Defendant knows  
12 to be especially adapted for use in infringing the '170 patent, and (3) are not staple  
13 articles of commerce suitable for substantial non-infringing use with respect to the  
14 '170 patent.

15 49. Based on information and belief, Plaintiff alleges that Defendant sells,  
16 ships, or otherwise delivers the accused products with all the features required to  
17 infringe the asserted claims of the '170 patent. On information and belief, these  
18 products are designed to practice the infringing features.

19 50. Plaintiff alleges upon information and belief, that the infringement by  
20 Defendant has been and is willful.

21 51. Plaintiff has been irreparably harmed by these acts of infringement  
22 and has no adequate remedy at law. Upon information and belief, infringement of  
23 the '170 patent is ongoing and will continue unless Defendant is enjoined from  
24 further infringement by the court.

25 **PRAYER FOR RELIEF**

26 WHEREFORE, Plaintiff prays for relief and judgment as follows:

- 27 1. That Defendant be declared to have infringed the Patents-in-Suit;  
28 2. That Defendant's infringement of the Patents-in-Suit has been

1 deliberate and willful;

2 3. Preliminarily and permanently enjoining the Defendant's officers,  
3 agents, servants, employees, and attorneys, and those persons in active concert or  
4 participation with them, from infringement of the Patents-in-Suit, including but not  
5 limited to any making, using, offering for sale, selling, or importing of unlicensed  
6 infringing products within and without the United States;

7 4. Compensation for all damages caused by Defendant's infringement of  
8 the Patents-in-Suit to be determined at trial;

9 5. Enhancing Plaintiff's damages up to three (3) times their amount  
10 pursuant to 35 U.S.C. § 284;

11 6. Granting Plaintiff pre- and post-judgment interest on its damages,  
12 together with all costs and expenses; and,

13 7. Awarding such other relief as this Court may deem just and proper.

14  
15 **HANDAL & ASSOCIATES**

16 Dated: April 1, 2013

17 By: /s/ Pamela C. Chalk  
18 Anton N. Handal  
19 Gabriel G. Hedrick  
20 Pamela C. Chalk  
21 Attorneys for Plaintiff  
22 e.Digital Corporation  
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**DEMAND FOR JURY TRIAL**

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Plaintiff hereby demands a trial by jury on all claims.

**HANDAL & ASSOCIATES**

Dated: April 1, 2013

By: /s/ Pamela C. Chalk  
Anton N. Handal  
Gabriel G. Hedrick  
Pamela C. Chalk  
Attorneys for Plaintiff  
e.Digital Corporation