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10 **UNITED STATES DISTRICT COURT**
11 **SOUTHERN DISTRICT OF CALIFORNIA**
12

13 e.Digital Corporation,
14

Plaintiff,
15

v.
16

Research In Motion Limited dba
BlackBerry; Research In Motion
17 Corporation dba BlackBerry; AT&T
Mobility, LLC; Verizon
18 Communications, Inc.; Sprint Nextel
Corporation; and, T-Mobile USA, Inc.,
19

Defendants.
20

Case No. **'13CV0781 LAB JMA**

**COMPLAINT FOR PATENT
INFRINGEMENT**

DEMAND FOR JURY TRIAL

21 Plaintiff, e.Digital Corporation (“e.Digital” or “Plaintiff”), by and through its
22 undersigned counsel, complains and alleges against Defendants Research In
23 Motion Limited (“RIM Canada”), Research In Motion Corporation (“RIM US”)
24 (collectively referred to hereafter as “BlackBerry”); AT&T Mobility, LLC
25 (“AT&T”); Verizon Communications, Inc. (“Verizon”); Sprint Nextel Corporation
26 (“Sprint ”); and, T-Mobile USA, Inc. (“T-Mobile”) (all collectively referred to as
27 “Defendants”) 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 infringement under 28 U.S.C. §§ 1331 and 1338(a) and pursuant to the patent laws of the United States of America, 35 U.S.C. § 101, *et seq.*

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

4. This Court has personal jurisdiction over Defendants because, on information and belief, Defendants transact continuous and systematic business within the State of California and the Southern District of California. In addition, this Court has personal jurisdiction over the Defendants because, on information and belief, this lawsuit arises out of Defendants' infringing activities, including, without limitation, the making, using, selling and/or offering to sell infringing products in the State of California and the Southern District of California. Finally, this Court has personal jurisdiction over Defendants because, on information and belief, Defendants have made, used, sold and/or offered for sale its infringing products and placed such infringing products in the stream of interstate commerce with the expectation that such infringing products would be made, used, sold

1 and/or offered for sale within the State of California and the Southern District of
2 California.

3 **PARTIES**

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

7 6. Upon information and belief, Defendant RIM Canada is a corporation
8 registered and lawfully existing under the laws of Canada, with an office and
9 principal place of business located at 295 Phillip Street, Waterloo, Ontario, N2L
10 3W8, Canada.

11 7. Upon information and belief, Defendant RIM US is a corporation
12 registered and lawfully existing under the laws of the State of Delaware, with an
13 office and principal place of business located 5000 Riverside Drive, Irving, Texas
14 75039.

15 8. Upon information and belief, Defendant AT&T is a limited liability
16 company organized and lawfully existing under the laws of the State of Delaware,
17 with an office and principal place of business located at 1025 Lenox Park Blvd.
18 NE, Atlanta, GA, 30319. Upon information and belief, certain of the products
19 manufactured by BlackBerry have been and/or are currently sold and/or offered for
20 sale at, among other places, AT&T retail stores in this jurisdiction and AT&T's
21 website located at www.att.com.

22 9. Upon information and belief, Defendant Verizon is a company
23 organized and lawfully existing under the laws of the State of Delaware, with an
24 office and principal place of business located at 1 Verizon Way, Basking Ridge,
25 New Jersey 07920. Upon information and belief, certain of the products
26 manufactured by BlackBerry have been and/or are currently sold and/or offered for
27 sale at, among other places, Verizon retail stores in this jurisdiction and Verizon's
28 website located at www.verizonwireless.com.

10. Upon information and belief, Defendant Sprint is a company organized and lawfully existing under the laws of the State of Kansas, with an office and principal place of business located at 6500 Sprint Pkwy HI- 5A STX, Overland Park, KS 66251. Upon information and belief, certain of the products manufactured by BlackBerry have been and/or are currently sold and/or offered for sale at, among other places, Sprint retail stores in this jurisdiction and Sprint's website located at www.sprint.com.

11. Upon information and belief, Defendant T-Mobile is a company organized and lawfully existing under the laws of the State of Delaware, with an office and principal place of business located at 12920 SE 38th Street, Bellevue, WA 98006. Upon information and belief, certain of the products manufactured by BlackBerry have been and/or are currently sold and/or offered for sale at, among other places, T-Mobile retail stores in this jurisdiction and T-Mobile's website located at <http://www.t-mobile.com>.

THE ASSERTED PATENTS

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

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

14. On February 13, 1996, the United States Patent and Trademark Office

1 duly and legally issued United States Patent No. 5,491,774 (“the ‘774 patent”)
2 entitled “Handheld Record And Playback Device With Flash Memory,” to its
3 named inventors Elwood G. Norris, Norbert P. Daberko, and Steven T. Brightbill.
4 Plaintiff, e.Digital is the assignee and owner of the entire right, title and interest in
5 and to the ’774 patent and has the right to bring this suit for damages and other
6 relief. A true and correct copy of the ’774 patent is attached hereto as Exhibit C.

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

10 16. On November 17, 1998, the United States Patent and Trademark
11 Office duly and legally issued United States Patent No. 5,839,108 (“the ’108
12 patent”) entitled “Flash Memory File System In A Handheld Record And Playback
13 Device,” to its named inventors Norbert P. Daberko and Richard K. Davis.
14 Plaintiff e.Digital is the assignee and owner of the entire right, title and interest in
15 and to the ’108 patent and has the right to bring this suit for damages and other
16 relief. A true and correct copy of the ’108 patent is attached hereto as Exhibit E.

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

24 **COUNT ONE**

25 **INFRINGEMENT OF THE ’737 PATENT BY DEFENDANTS**

26 18. Plaintiff re-alleges and incorporates by reference each of the
27 allegations set forth in paragraphs 1 through 17 above.

28 19. Upon information and belief, Defendants, without authority, (a) have

1 directly infringed and continues to directly infringe the '737 patent by making,
2 using, offering to sell, or selling within the United States, or importing into the
3 United States, products that practice one or more claims of the '737 patent in
4 violation of 35 U.S.C. § 271(a); (b) have induced and continue to induce
5 infringement of one or more claims of the '737 patent in violation of 35 U.S.C. §
6 271(b); and (c) have contributed and continue to contribute to the infringement of
7 one or more claims of the '737 patent in violation of 35 U.S.C. § 271(c).

8 20. The accused products, alone or in combination with other products,
9 practice each of the limitations of independent claims 1, 4, 9, and 13, and
10 dependent claims 3, 6 and 7 of the '737 patent.

11 21. The accused products for purposes of the '737 patent include but are
12 not limited to BlackBerry tablets and mobile phone products including but not
13 limited to the BlackBerry Playbook, the BlackBerry Z10 and Q10 series of
14 products; BlackBerry Torch series of products to include the BlackBerry Torch
15 9850, 9860, 9810, and the 9800; the BlackBerry Bold series of products to include
16 the BlackBerry Bold 9900, 9930, 9700, 9650, 9780, 9790, and the 9000; the
17 BlackBerry Curve series of products to include the 9220, 9380, 9350, 9360, 9370,
18 9300, 9330, 9310, 9315, 9320, 8980, 8900, 8320, 8310, 8330, 8300, 8520, 8530,
19 and the 8350i; the BlackBerry Porsche Design P'9981; the BlackBerry Pearl series
20 of products to include the BlackBerry Pearl 9100, 9105, 8100, 8110, 8120, 8130,
21 8220, and the 8230; the BlackBerry Pearl 3G series of products to include the
22 BlackBerry Pearl 3G 9100 and 9105; the BlackBerry Storm series of products to
23 include the BlackBerry Storm 9500 and 9530; the BlackBerry Storm 2 series of
24 products to include the BlackBerry Storm 9550 and the 9520; the BlackBerry Style
25 9670; and the BlackBerry 9620, 9630, 8830, 8820, 8800, 7100i, 8707h, 8707g,
26 8707, 8703e, 8700, 7130e and the 7130g.

27 22. Upon information and belief, Defendants, without authority, have
28 actively induced infringement and continues to actively induce infringement of the

1 '737 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe
2 the claims of the '737 patent and/or by intentionally instructing others how to use
3 the accused products in a manner that infringes the claims of the '737 patent. On
4 information and belief, Defendants have induced and continues to induce
5 infringement by instructing customers to operate the products in an infringing
6 manner and/or when Defendants test or otherwise operate the accused products in
7 the United States.

8 23. Upon information and belief, Defendants, without authority, have
9 contributed to and continue to contribute to the infringement of the '737 patent in
10 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or
11 offering to sell within the United States accused products that (1) constitute a
12 material part of the invention of the '737 patent, (2) Defendants know to be
13 especially adapted for use in infringing the '737 patent, and (3) are not staple
14 articles of commerce suitable for substantial noninfringing use with respect to the
15 '737 patent.

16 24. Based on information and belief, Plaintiff alleges that Defendants sell,
17 ship, or otherwise deliver the accused products with all the features required to
18 infringe the asserted claims of the '737 patent. On information and belief, these
19 products are designed to practice the infringing features.

20 25. Defendants had knowledge of infringement of the '737 patent since at
21 least the filing of this complaint and perhaps as early as 2010 by virtue of the
22 Plaintiff's filing of complaints against others within Defendants' industry. On
23 information and belief, Defendants have continued to sell products that practice the
24 '737 patent after acquiring knowledge of infringement.

25 26. Upon information and belief, the infringement by Defendants has
26 been and is willful.

27 27. Plaintiff has been irreparably harmed by these acts of infringement
28 and has no adequate remedy at law. Upon information and belief, infringement of

1 the '737 patent is ongoing and will continue unless Defendants are enjoined from
2 further infringement by the court.

3 **COUNT TWO**

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

5 28. Plaintiff re-alleges and incorporates by reference each of the
6 allegations set forth in paragraphs 1 through 17 above.

7 29. Upon information and belief, Defendants, without authority, (a) have
8 directly infringed and continue to directly infringe the '774 patent by making,
9 using, offering to sell, or selling within the United States, or importing into the
10 United States, products that practice one or more claims of the '774 patent in
11 violation of 35 U.S.C. § 271(a); (b) have induced and continue to induce
12 infringement of one or more claims of the '774 patent in violation of 35 U.S.C. §
13 271(b); and (c) have contributed and continue to contribute to the infringement of
14 one or more claims of the '774 patent in violation of 35 U.S.C. § 271(c).

15 30. The accused products, alone or in combination with other products,
16 practice each of the limitations of independent claims 33 and 34, and dependent
17 claims 2, 3, 6 through 8, 10, 15 through 16, 18, 23 through 26, and 28 through 31
18 of the '774 patent.

19 31. The accused products for purposes of the '774 patent include but are
20 not limited to BlackBerry mobile phone products including but not limited to the
21 BlackBerry Z10 AND Q10 series of products; BlackBerry Torch series of products
22 to include the BlackBerry Torch 9850, 9860, 9810, and the 9800; the BlackBerry
23 Bold series of products to include the BlackBerry Bold 9900, 9930, 9700, 9650,
24 9780, 9790, and the 9000; the BlackBerry Curve series of products to include the
25 9220, 9380, 9350, 9360, 9370, 9300, 9330, 9310, 9315, 9320, 8980, 8900, 8320,
26 8310, 8330, 8300, 8520, 8530, and the 8350i; the BlackBerry Porsche Design
27 P'9981; the BlackBerry Pearl series of products to include the BlackBerry Pearl
28 9100, 9105, 8100, 8110, 8120, 8130, 8220, and the 8230; the BlackBerry Pearl 3G

1 series of products to include the BlackBerry Pearl 3G 9100 and 9105; the
2 BlackBerry Storm series of products to include the BlackBerry Storm 9500 and
3 9530; the BlackBerry Storm 2 series of products to include the BlackBerry Storm
4 9550 and the 9520; the BlackBerry Style 9670; and the BlackBerry 9620, 9630,
5 8830, 8820, and the 8800.

6 32. Upon information and belief, Defendants, without authority, have
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, Defendants have induced and continue to induce
12 infringement by instructing customers to operate the products in an infringing
13 manner and/or when Defendants test or otherwise operate the accused products in
14 the United States.

15 33. Upon information and belief, Defendants, without authority, have
16 contributed to and continue 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) Defendants know 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 34. Based on information and belief, Plaintiff alleges that Defendants sell,
24 ship, or otherwise deliver 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 35. Defendants 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 Defendants' industry. On
2 information and belief, Defendants have continued to sell products that practice the
3 '774 patent after acquiring knowledge of infringement.

4 36. Upon information and belief, the infringement by Defendants has
5 been and is willful.

6 37. 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 Defendants are enjoined from
9 further infringement by the court.

10 **COUNT THREE**

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

12 38. Plaintiff re-alleges and incorporates by reference each of the
13 allegations set forth in paragraphs 1 through 17 above.

14 39. Upon information and belief, Defendants, without authority, (a) have
15 directly infringed and continue 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) have induced and continue 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) have contributed and continue 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 40. 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 41. The accused products for purposes of the '108 patent include but are
26 not limited to BlackBerry mobile phone products including but not limited to the
27 BlackBerry Z10 AND Q10 series of products; BlackBerry Torch series of
28 products.

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

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

18 44. On information and belief, Defendants sell, ship or otherwise deliver
19 the accused products with all the features required to infringe the asserted claims of
20 the '108 patent. On information and belief, these products are designed to practice
21 the infringing features.

22 45. Defendants had knowledge of infringement of the '108 patent since at
23 least the filing of this complaint and perhaps as early as 2010 by virtue of the
24 Plaintiff's filing of complaints against others within Defendants' industry.

25 46. Upon information and belief, the infringement by Defendants has
26 been and is willful.

27 47. Plaintiff has been irreparably harmed by these acts of infringement
28 and has no adequate remedy at law. Upon information and belief, infringement of

1 the '108 patent is ongoing and will continue unless Defendants are enjoined from
2 further infringement by the court.

3 **COUNT FOUR**

4 **INFRINGEMENT OF THE '170 PATENT BY DEFENDANTS**

5 48. Plaintiff re-alleges and incorporates by reference each of the
6 allegations set forth in paragraphs 1 through 17 above.

7 49. Upon information and belief, Defendants, without authority, (a) have
8 directly infringed and continues to directly infringe the '170 patent by making,
9 using, offering to sell, or selling within the United States, or importing into the
10 United States, products that practice one or more claims of the '170 patent in
11 violation of 35 U.S.C. § 271(a); (b) have induced and continues to induce
12 infringement of one or more claims of the '170 patent in violation of 35 U.S.C. §
13 271(b); and (c) have contributed and continue to contribute to the infringement of
14 one or more claims of the '170 patent in violation of 35 U.S.C. § 271(c).

15 50. The accused products, alone or in combination with other products,
16 practice each of the limitations of independent claims 1 and 7 and certain
17 dependent claims 2, 3 and 8, 9, 10, 11 and 12 of the '170 patent.

18 51. The accused products for purposes of the '170 patent include but are
19 not limited to the BlackBerry mobile phone products including but not limited to
20 the BlackBerry Z10 AND Q10.

21 52. Upon information and belief, Defendants, without authority, have
22 actively induced infringement and continue to actively induce infringement of the
23 '170 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe
24 the claims of the '170 patent and/or by intentionally instructing others how to use
25 the accused products in a manner that infringes the claims of the '170 patent. On
26 information and belief, Defendants have induced and continue to induce
27 infringement by instructing customers to operate the products in an infringing
28 manner and/or when Defendants test or otherwise operate the accused products in

1 the United States.

2 53. Upon information and belief, Defendants, without authority, have
3 contributed and continue to contribute to the infringement of the '170 patent in
4 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or
5 offering to sell within the United States accused products that (1) embody and
6 constitute a material part of the invention of the '170 patent, (2) Defendants know
7 to be especially adapted for use in infringing the '170 patent, and (3) are not staple
8 articles of commerce suitable for substantial non-infringing use with respect to the
9 '170 patent.

10 54. Based on information and belief, Plaintiff alleges that Defendants sell,
11 ship, or otherwise deliver the accused products with all the features required to
12 infringe the asserted claims of the '170 patent. On information and belief, these
13 products are designed to practice the infringing features.

14 55. Plaintiff alleges upon information and belief, that the infringement by
15 Defendants has been and is willful. Plaintiff has been irreparably harmed by these
16 acts of infringement and has no adequate remedy at law. Upon information and
17 belief, infringement of the '170 patent is ongoing and will continue unless
18 Defendants are enjoined from further infringement by the court.

19 **PRAYER FOR RELIEF**

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

- 21 1. That Defendants be declared to have infringed the Patents-in-Suit;
- 22 2. That Defendants' infringement of the Patents-in-Suit has been
23 deliberate and willful;
- 24 3. Preliminarily and permanently enjoining the Defendants' officers,
25 agents, servants, employees, and attorneys, and those persons in active concert or
26 participation with them, from infringement of the Patents-in-Suit, including but not
27 limited to any making, using, offering for sale, selling, or importing of unlicensed
28 infringing products within and without the United States;

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

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

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

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

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

DEMAND FOR JURY TRIAL

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