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21 **UNITED STATES DISTRICT COURT**
22 **NORTHERN DISTRICT OF CALIFORNIA**

23 APPLE INC.,

24 Plaintiff,

25 v.

26 ZIPIT WIRELESS, INC.,

27 Defendant.

Civil Action No. 3:20-cv-4448

**COMPLAINT FOR
DECLARATORY JUDGMENT OF
NON-INFRINGEMENT OF U.S.
PATENT NOS. 7,292,870 AND
7,894,837**

DEMAND FOR JURY TRIAL

1 **COMPLAINT FOR DECLARATORY JUDGMENT**

2 Plaintiff Apple Inc. (“Apple”) hereby alleges for its Complaint against
3 Defendant Zipit Wireless, Inc. (“Zipit”) as follows:

4 **NATURE AND HISTORY OF THE ACTION**

5 1. This is an action for a declaratory judgment of non-infringement of U.S.
6 Patent Nos. 7,292,870 (“the ’870 patent”) and 7,894,837 (“the ’837 patent”)
7 (collectively, the “Zipit Patents”). Zipit has alleged that Apple has infringed these
8 patents, and Apple disagrees.

9 2. Zipit previously asserted the Zipit Patents against Apple. Specifically,
10 Zipit filed suit against Apple on June 11, 2020, accusing Apple of infringing the Zipit
11 Patents directly, contributorily, and by inducement. (*See Zipit Wireless, Inc., v.*
12 *Apple Inc.*, Civil Action No. 1:20-cv-02488-ELR (N.D. Ga.) (“the Former Zipit
13 Litigation”), ECF No. 1.)

14 3. Without any prior notice to Apple, Zipit voluntarily dismissed the
15 Former Zipit Litigation without prejudice on June 24, 2020 and the action was
16 terminated on June 25, 2020.

17 4. The parties’ history extends back beyond Zipit’s actual lawsuit. Zipit, as
18 it alleged in its Complaint in the Former Zipit Litigation, first contacted Apple
19 regarding the Zipit Patents several years before filing suit. *See* Former Zipit
20 Litigation ECF No. 1 at 38, 43. In fact, Zipit’s and Apple’s respective representatives
21 met at Apple’s Cupertino, California headquarters in 2015 for the express purpose of
22 conducting extensive negotiations regarding the Zipit Patents (including whether a
23 license was appropriate at all). Overall, the parties’ interactions took place over the
24 course of several years, from at least 2014 through 2016, and further encompassed
25 the exchange of many rounds of correspondence about the Zipit Patents.
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27
28

5. Zipit maintained throughout these conversations that Apple required a license to the Zipit Patents. Apple maintains that it does not infringe any claims of the Zipit Patents. The parties never reached agreement.

6. Zipit's actions have created a real and immediate controversy between Zipit and Apple as to whether Apple's products and/or services infringe any claims of the Zipit Patents. Both the pre-suit negotiations between Apple and Zipit, wherein Zipit insisted that Apple requires a license to the Zipit Patents, and Zipit's dismissal of the Former Zipit Litigation *without prejudice*, demonstrates that it is highly likely that Defendant Zipit will again assert infringement of the Zipit Patents against Apple. In the meantime, the cloud of Zipit's allegations and litigation hangs over Apple.

7. As set forth herein, Apple does not infringe the Zipit Patents. Therefore, an actual and justiciable controversy exists between the parties as to whether Apple's products and/or services infringe any claims of the Zipit Patents. The facts and allegations recited herein show that there is a real, immediate, and justiciable controversy concerning these issues. A judicial declaration is necessary to determine the respective rights of the parties regarding the asserted patents, and Apple respectfully seeks a judicial declaration that the Zipit Patents are not infringed by any Apple products and/or services.

THE PARTIES

8. Plaintiff Apple is a California corporation with its principal place of business at One Apple Park Way, Cupertino, California 95014.

9. On information and belief, and based on Zipit's allegations in the Former Zipit Litigation, Defendant Zipit is a Delaware Corporation with a principal place of business located at 101 North Main Street, Suite 201, Greenville, South Carolina 29601.

10. On information and belief, including Zipit's allegations in the Former Zipit Litigation, Zipit claims to own the Zipit Patents.

JURISDICTION AND VENUE

11. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and under the Patent Laws of the United States, 35 U.S.C. §§ 1 *et seq.*

12. This Court has subject matter jurisdiction over the claims alleged in this action at least under 28 U.S.C. §§ 1331, 1332, 1338, 2201, and 2202, because this Court has exclusive jurisdiction over declaratory judgment claims arising under the Patent Laws pursuant to 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

13. This Court can provide the relief sought in this Declaratory Judgment Complaint because an actual case and controversy exists between the parties within the scope of this Court's jurisdiction pursuant to 28 U.S.C. § 2201, at least because Zipit sued Apple for patent infringement, despite the fact that Apple does not infringe, and has not infringed, any claims of the Zipit Patents. While Zipit dismissed the Former Zipit Litigation, it did so without prejudice, leaving open the possibility of Zipit suing Apple again on these same patents. Zipit's actions have created a real, live, immediate, and justiciable case or controversy between Zipit and Apple.

14. Zipit has consciously and purposefully directed activities at Apple, a company that resides and operates in this District. As previously described, Apple and Zipit had extensive pre-suit communications regarding the Zipit Patents over the course of several years. Zipit also came to the District for an in-person meeting at Apple's facilities in Cupertino to discuss the Zipit Patents. Throughout, Zipit maintained that Apple required a license to the Zipit Patents. Zipit purposefully directed these activities relating to the Zipit Patents at Apple in this District, and this action arises out of and directly relates to Zipit's contacts with Apple in this District.

15. In doing so, Zipit has established sufficient minimum contacts with the Northern District of California such that Zipit is subject to specific personal jurisdiction in this action. The exercise of personal jurisdiction based on these

1 repeated and pertinent contacts does not offend traditional notions of fairness and
2 substantial justice.

3 16. Venue in this District is proper under 28 U.S.C. §§ 1391(b), (c), and (d)
4 with respect to Apple's declaratory judgment claims. As discussed above, this Court
5 has personal jurisdiction over Zipit because Zipit has engaged in actions in this
6 District that form the basis of Apple's claims against Zipit—namely, the pre-suit
7 communications and interactions with Apple representatives in Cupertino, and the
8 meeting at Apple's Cupertino headquarters.

9 17. An actual and justiciable controversy exists under 28 U.S.C. §§ 2201-
10 2202 between Apple and Zipit as to whether the Zipit's Patents are infringed by the
11 Apple products and/or services that Zipit alleged to infringe the Zipit Patents in the
12 Former Zipit Litigation.

13 **PATENTS-IN-SUIT**

14 18. The '870 patent, entitled "Instant Messaging Terminal Adapted For Wi-
15 Fi Access Points," states on its face that it issued on November 6, 2007. A true and
16 correct copy of the '870 patent is attached as Exhibit A.

17 19. The '837 patent, entitled "Instant Messaging Terminal Adapted For Wi-
18 Fi Access Points," states on its face that it issued on February 22, 2011. A true and
19 correct copy of the '837 patent is attached as Exhibit B.

20 **FIRST CLAIM FOR RELIEF**

21 **(Declaratory Judgment That Apple Does Not Infringe The '870 Patent)**

22 20. Apple repeats and realleges each and every allegation contained in
23 paragraphs 1 through 19 of this Complaint as if fully set forth herein.

24 21. In view of the facts and allegations set forth above, there is an actual,
25 justiciable, substantial, and immediate controversy between Apple, on the one hand,
26 and Zipit, on the other, regarding whether Apple infringes any claim of the '870
27 patent.



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