

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

Xerox Corporation,

Plaintiff,

-vs-

Monument Peak Ventures, LLC,

Defendant.

Civil Action No. 6:20-cv-6263

JURY TRIAL DEMANDED

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Xerox Corporation (“Xerox”), for its Complaint against Defendant Monument Peak Ventures LLC (“MPV”), alleges as follows:

NATURE OF THE ACTION

1. Xerox files this lawsuit because MPV accuses it of infringing patents that Xerox does not, in fact, infringe.

2. MPV is one of a vast array of patent assertion entities associated with Dominion Harbor Enterprises, LLC. MPV does not exist to invent new ideas, make products or provide services to consumers. It exists to acquire and then assert patents against companies who actually have done the hard work in researching, developing and bringing products and services to market.

3. In 2017, MPV bought the patents that are the subject of this suit from another non-practicing entity (Intellectual Ventures) who had obtained them from the Eastman Kodak Company (“Kodak”). As their origin would suggest, these Kodak patents relate to camera technology. MPV is now trying to stretch the scope of these camera related patents to cover Xerox’s printer devices. Needless to say, office printers are not cameras, and the patents at issue are not relevant to Xerox’s business.

4. MPV, however, has a business model predicated on buying patents on the cheap and asserting them against a wide array of targets to obtain nuisance value settlements, taking whatever positions necessary to claim infringement (no matter how implausible) and threatening litigation (and its attendant expense) if a party does not accede to its licensing demands. This is what MPV has done here. It has asserted patents without any connection to Xerox's business, pushed a licensing agenda unconnected to the fundamental question of whether Xerox needs a license, and threatened litigation if Xerox does not pay.

5. MPV's claims of infringement are completely unfounded, and as a result, Xerox seeks a declaration from this Court that it does not infringe United States Patents Nos.: 5,923,908 (the "'908 patent"); 6,157,436 (the "'436 patent"); 6,215,559 (the "'559 patent"); 6,396,599 (the "'599 patent"); 6,873,336 (the "'336 patent"); 7,006,890 (the "'890 patent"); 7,092,966 (the "'966 patent"); and 7,684,090 (the "'090 patent") (collectively, the "Patents-in-Suit").¹ This case is authorized by and arises under 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.*

THE PARTIES

6. Xerox is a corporation and existing under the laws of New York. Xerox's largest base of employees is in and around Rochester, New York, including its lead engineering, design and manufacturing campus in Webster, New York. Founded in 1906 in Rochester, New York, Xerox has been one of the most innovative companies in the U.S. for more than a century. In addition to pioneering now-everyday concepts in personal computing, such as the graphical user interface and the mouse, Xerox also developed the very first plain paper photocopier. Xerox maintains its reputation for human-centered innovation to this day: In 2019, it was recognized in

¹ Copies of the Patents-in-Suit are attached as Exhibits A–H to this complaint.

Fortune Magazine's "World's Most Admired Companies" and in 2018, it was named a "2018 Thomson Reuters Top 100 Global Technology Leader."

7. MPV is a company organized and existing under the laws of Texas, with a principal place of business at 200 Crescent Court, Suite 1550, Dallas, Texas 75201-2095. As explained above, MPV is no innovator: it is an opportunistic non-practicing entity that seeks to turn twice purchased patents into profit for its owners. In recent years, it has filed a number of lawsuits, seeking to monetize its patents.² Significantly, not one of these lawsuits has been decided on the merits in favor of MPV.

8. MPV claims to be the owner by assignment of the right, title and interest in the Patents-in-Suit.

JURISDICTION AND VENUE

9. 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.*

10. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1331, 1338(a) and 2201(a).

11. As described in more detail below, an immediate, real, and justiciable controversy exists between Xerox and MPV as to whether Xerox is infringing or has infringed the Patents-in-Suit.

² See *Monument Peak Ventures, LLC v. Hitachi, Ltd.*, No. 2:20-cv-00098 (E.D. Tex.); *Monument Peak Ventures, LLC v. Toshiba*, No. 8:19-cv-02181 (C.D. Cal.); *Monument Peak Ventures, LLC v. Sakar International, Inc.*, No. 1:19-cv-01890 (S.D.N.Y.); *Monument Peak Ventures, LLC v. HMD Global Oy*, No. 2:18-cv-00521 (E.D. Tex.); *Monument Peak Ventures, LLC v. Bosch Security Systems, Inc.*, No. 1:18-cv-01335 (D. Del.); *Monument Peak Ventures, LLC v. GE Healthcare, Ltd.*, No. 3:18-cv-01158 (S.D. Cal.); *Monument Peak Ventures v. Hasselblad, Inc.*, No. 1:18-cv-00732 (D. Del.); *Monument Peak Ventures v. GoPro, Inc.*, No. 1:18-cv-00416 (D. Del.); *Monument Peak Ventures, LLC v. SZ DJI Tech. Co., Ltd.*, No. 2:18-cv-02210 (C.D. Cal.); *Monument Peak Ventures, LLC v. Hasselblad, Inc.*, No. 2:18-cv-02214 (C.D. Cal.).

12. MPV is subject to personal jurisdiction in this district by virtue of the extensive enforcement activities it has conducted in and purposefully directed to the State of New York, including in this District.

13. MPV first approached Xerox's New York based Intellectual Property Law Department about the Patents-in-Suit on April 2, 2019. It emailed Xerox's Chief IP Counsel and Associate General Counsel who is located in New York. That email asserted that "[i]n examining the Kodak portfolio it has become evident to us that Xerox would benefit from a license to this portfolio." Over the course of the next year, MPV aggressively escalated its rhetoric with respect to Xerox. It sent more than 40 communications to Xerox personnel in New York, including those located within this District, in an attempt to persuade Xerox to license the Patents-in-Suit.

14. MPV also met via web conference with Xerox personnel in New York, including personnel located in this District. On June 26, 2019, November 14, 2019, and February 11, 2020, MPV scheduled and led three web conferences with Xerox personnel in Webster, New York as part of its efforts to convince Xerox to license the Patents-in-Suit. On information and belief, MPV knew that it was interacting with Xerox's New York operations and was purposeful in directing its licensing efforts to the State of New York and this District.

15. MPV, in fact, has had prior dealings with Xerox. As early as April 7, 2016, Xerox and MPV signed a Confidential Disclosure Agreement regarding a different set of patents. In that agreement, MPV did not object to jurisdiction in New York but rather agreed that "[t]his Agreement shall be construed in accordance with the laws of the State of New York, without regard to its choice of law provisions. All disputes arising out of or in connection with this Agreement shall be adjudicated in, and the parties consent to the jurisdiction of, the state and federal courts of the State of New York."

16. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b)-(c).

17. MPV's enforcement activities have created an actual and substantial controversy regarding whether Xerox infringes the Patents-in-Suit that is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment. MPV, for example, accused Xerox of infringing the Patents-in-Suit and provided Xerox with a set of claim charts—which it labeled “examples of use”—that purport to map features of Xerox's products to a claim from each of the Patents-in-Suit.

18. MPV repeated its allegations of infringement throughout its correspondence and on the web conferences. In return, Xerox demonstrated to MPV that it did not require a license to the Patents-in-Suit. By February 2020, MPV was clear that Xerox faced a decision—take a license or face litigation. MPV wrote to Xerox on February 5, 2020, threatening, “[w]e will need to get this call set up ASAP in order to avoid escalating this matter for litigation.” And, on April 16, 2020, it again wrote to Xerox, stating, “[a]t this point we really need to have a call in the next week to either move the licensing discussions forward or to pivot to litigation.” There is an actual, ripe and judicable controversy regarding the infringement of the Patents-in-Suit.

BACKGROUND ON THE PATENTS-IN-SUIT

19. MPV acquired the Patents-in-Suit from another patent assertion entity called Intellectual Ventures in 2017 who, in turn, had acquired the patents from their original assignee, Kodak.

20. Kodak is a camera company, and the Patents-in-Suit reflect that fact.

21. For example, the '908 patent is entitled, “*Camera* With Touch Sensitive Control” (emphasis added). Claim 11, which MPV asserts Xerox infringes, claims:

A *camera* comprising:

(a) a touch sensitive screen;

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