

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

MESSAGE NOTIFICATION
TECHNOLOGIES LLC,

Plaintiff,

v.

AT&T MESSAGING, LLC,

Defendant.

C.A. NO. 13-1877-GMS

JURY TRIAL DEMANDED

FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Message Notification Technologies LLC files this first amended complaint against the above-named defendant, alleging, based on its own knowledge with respect to itself and its own actions, and based on information and belief as to all other matters, as follows:

PARTIES

1. Plaintiff Message Notification Technologies LLC (“MessageTech”) is a limited liability company formed under the laws of the State of Delaware, with a principal place of business in Wilmington, Delaware.

2. Defendant AT&T Messaging, LLC (“AT&T”) is a Delaware limited liability company with a principal place of business in Texas. AT&T can be served with process by serving its registered agent: The Corporation Trust Company; Corporation Trust Center, 1209 Orange St., Wilmington, DE 19801.

JURISDICTION AND VENUE

3. This is an action for infringement of a United States patent arising under 35 U.S.C. §§ 271, 281, and 284–85, among others. This Court has subject matter jurisdiction of the action under 28 U.S.C. § 1331 and § 1338(a).

4. Venue is proper in this district under 28 U.S.C. §§ 1391 and 1400(b). Upon information and belief, defendant is incorporated in this district, has transacted business in this district, and/or has committed and/or induced acts of patent infringement in this district.

5. Defendant is subject to this Court’s specific and general personal jurisdiction under due process and/or the Delaware Long Arm Statute due at least to defendant’s having been incorporated in this forum and/or defendant’s substantial business in this forum, including: (i) at least a portion of the infringements alleged herein; and (ii) regularly doing or soliciting business, engaging in other persistent courses of conduct, and/or deriving substantial revenue from goods and services provided to individuals in Delaware.

COUNT I
INFRINGEMENT OF U.S. PATENT NO. 5,944,786

6. On August 31, 1999, United States Patent No. 5,944,786 (“the 786 patent”) was duly and legally issued by the United States Patent and Trademark Office for an invention titled “Automatic Notification of Receipt of Electronic Mail (E-mail) via Telephone System without Requiring Log-On to E-mail Server.”

7. MessageTech is the owner of the 786 patent with all substantive rights in and to that patent, including the sole and exclusive right to prosecute this action and enforce the 786 patent against infringers, and to collect damages for all relevant times. A true and correct copy of the 786 patent is attached hereto as Exhibit A.

8. AT&T had knowledge of the 786 patent at least from the filing date and/or service date of the original complaint against it for infringement of the 786 patent.

9. In addition, AT&T had knowledge of the 786 patent at least from the date the 786 patent was cited by AT&T or its affiliates during the prosecution of U.S. Pat. No. 7,850,539 (titled “System and method for email notification”), which lists as inventor Mark Kirkpatrick and was originally assigned, as issued, to AT&T Intellectual Property I, L.P. The 539 patent’s application was filed on June 28, 2000.

10. The title of the 539 patent bears similarities to the title of the 786 patent. The title of the 786 patent is “Automatic notification of receipt of electronic mail (e-mail) via telephone system without requiring log-on to e-mail server.”

11. The 539 patent covers the same or substantially similar subject matter as the 786 patent.

12. The 539 patent appears to read on several claims of the 786 patent.

13. The 539 patent’s inventor, Mark Kirkpatrick, was involved in the prosecution of that patent.

14. Mark Kirkpatrick is currently employed by AT&T as an “Inventor” and “Technical Solutions Architect,” and has worked there for over 17 years. He has been awarded forty two patents, some of which are in the “concept area” of “applications for the TELCO network (wireless and wireline).” *See* <http://www.linkedin.com/pub/mark-kirkpatrick/41/802/213>.

15. Mark Kirkpatrick has been employed in a number of management positions during his time at AT&T.

16. Mark Kirkpatrick has knowledge of the 786 patent at least through his activities related to the prosecution of the 539 patent.

17. On information and belief, Mark Kirkpatrick works or worked on the accused products/instrumentalities (as defined below) or systems related to the accused products/instrumentalities.

18. By virtue of at least his positions in AT&T and his work involving the accused products/instrumentalities, Mark Kirkpatrick's personal knowledge of the 786 patent should be imputed to AT&T.

19. Upon information and belief, the original assignee of the 539 patent as issued is or was a subsidiary and/or affiliate of AT&T.

20. The knowledge of the 786 patent possessed by its subsidiaries and/or affiliates should be imputed to AT&T.

21. Upon information and belief, AT&T was involved in the prosecution of the 539 patent.

22. AT&T has knowledge of the 786 patent at least due to its involvement in the prosecution of the 539 patent.

23. In addition, AT&T had knowledge of the 786 patent at least from the date the 786 patent was cited by AT&T or its affiliates during the prosecution of U.S. Pat. No. 7,266,184 (titled "Securely sending notification of a new incoming e-mail message by way of a public network"), which lists as inventors Charles M. Link II and Vernon Meadows and was originally assigned, as issued, to AT&T Intellectual Property, Inc. The 184 patent's application was filed on December 14, 2000.

24. The title of the 184 patent bears similarities to the title of the 786 patent. The title of the 786 patent is “Automatic notification of receipt of electronic mail (e-mail) via telephone system without requiring log-on to e-mail server.”

25. The 184 patent covers the same or substantially similar subject matter as the 786 patent.

26. The 184 patent appears to read on several claims of the 786 patent.

27. The 184 patent’s inventors, Charles M. Link II and Vernon Meadows, were involved in the prosecution of that patent.

28. Vernon Meadows is currently employed by AT&T and is actively inventing for AT&T. *See* <http://www.fiercetelecom.com/story/att-files-patent-self-destructing-email/2013-06-24> (“The patent was filed by William A. Hartselle, Shannon M. Short and Vernon Meadows, three AT&T employees based in Atlanta.”).

29. Upon information and belief, Vernon Meadows has been employed in a number of management positions during his time at AT&T.

30. Vernon Meadows has knowledge of the 786 patent at least through his activities related to the prosecution of the 184 patent.

31. On information and belief, Vernon Meadows works or worked on the accused products/instrumentalities (as defined below) or systems related to the accused products/instrumentalities.

32. By virtue of at least his positions in AT&T and his work involving the accused products/instrumentalities, Vernon Meadows’s personal knowledge of the 786 patent should be imputed to AT&T.

33. Upon information and belief, the original assignee of the 184 patent as issued is or was a subsidiary and/or affiliate of AT&T.

34. The knowledge of the 786 patent possessed by its subsidiaries and/or affiliates should be imputed to AT&T.

35. Upon information and belief, AT&T was involved in the prosecution of the 184 patent.

36. AT&T has knowledge of the 786 patent at least due to its involvement in the prosecution of the 184 patent.

37. In addition, AT&T had knowledge of the 786 patent at least from the date the 786 patent was cited by AT&T or its affiliates during the prosecution of U.S. Pat. No. 7,609,820 (titled "Identification and management of automatically-generated voicemail notifications of voicemail and electronic mail receipt"), which lists as inventor James Carlton Bedingfield, Sr. and was originally assigned, as issued, to AT&T Intellectual Property I, L.P. The 820 patent's application was filed on November 12, 2003.

38. The patent examiner cited the 786 patent during the prosecution of the 820 patent, specifically in an Office Action dated Dec. 27, 2007 where the 786 patent was grounds for rejection of claims of the 820 patent under 35 U.S.C. § 102(b).

39. The applicants of the 820 patent overcame the examiner's objections by distinguishing the 786 patent in an Amendment and Remarks dated July 9, 2008.

40. The title of the 820 patent bears similarities to the title of the 786 patent. The title of the 786 patent is "Automatic notification of receipt of electronic mail (e-mail) via telephone system without requiring log-on to e-mail server."

41. The 820 patent covers the same or substantially similar subject matter as the 786 patent.

42. The 820 patent appears to read on several claims of the 786 patent.

43. The 820 patent's inventor, Carlton Bedingfield, Sr., was involved in the prosecution of that patent.

44. Upon information and belief, the original assignee of the 820 patent as issued is or was a subsidiary and/or affiliate of AT&T.

45. The knowledge of the 786 patent possessed by its subsidiaries and/or affiliates should be imputed to AT&T.

46. Upon information and belief, AT&T was involved in the prosecution of the 820 patent.

47. AT&T has knowledge of the 786 patent at least due to its involvement in the prosecution of the 820 patent.

48. In addition, AT&T had knowledge of the 786 patent at least from the date the 786 patent was cited by AT&T or its affiliates during the prosecution of U.S. Pat. No. 7,539,289 (titled "Selective deactivation of a voicemail system"), which lists as inventors La Veria Baker and David Scott and was originally assigned, as issued, to AT&T Intellectual Property I, L.P. The 289 patent's application was filed on August 18, 2005.

49. The title of the 289 patent bears similarities to the title of the 786 patent. The title of the 786 patent is "Automatic notification of receipt of electronic mail (e-mail) via telephone system without requiring log-on to e-mail server."

50. The 289 patent covers the same or substantially similar subject matter as the 786 patent.

51. The 289 patent appears to read on several claims of the 786 patent.

52. The 289 patent's inventors, La Veria Baker and David Scott, were involved in the prosecution of that patent.

53. Upon information and belief, the original assignee of the 289 patent as issued is or was a subsidiary and/or affiliate of AT&T.

54. The knowledge of the 786 patent possessed by its subsidiaries and/or affiliates should be imputed to AT&T.

55. Upon information and belief, AT&T was involved in the prosecution of the 289 patent.

56. AT&T has knowledge of the 786 patent at least due to its involvement in the prosecution of the 289 patent.

57. In addition, AT&T had knowledge of the 786 patent at least from the date the 786 patent was cited by AT&T or its affiliates during the prosecution of U.S. Pat. No. 8,090,785 (titled "System and method for email notification"), which lists as inventor Mark Kirkpatrick and was originally assigned, as issued, to AT&T Intellectual Property I, L.P. The 289 patent's application was filed on April 15, 2009.

58. The title of the 785 patent bears similarities to the title of the 786 patent. The title of the 786 patent is "Automatic notification of receipt of electronic mail (e-mail) via telephone system without requiring log-on to e-mail server."

59. The 785 patent covers the same or substantially similar subject matter as the 786 patent.

60. The 785 patent appears to read on several claims of the 786 patent.

61. The 785 patent's inventor, Mark Kirkpatrick, was involved in the prosecution of that patent.

62. Mark Kirkpatrick is currently employed by AT&T as an "Inventor" and "Technical Solutions Architect," and has worked there for over 17 years. He has been awarded forty two patents, some of which are in the "concept area" of "applications for the TELCO network (wireless and wireline)." *See* <http://www.linkedin.com/pub/mark-kirkpatrick/41/802/213>.

63. Mark Kirkpatrick has been employed in a number of management positions during his time at AT&T.

64. Mark Kirkpatrick has knowledge of the 786 patent at least through his activities related to the prosecution of the 785 patent.

65. On information and belief, Mark Kirkpatrick works or worked on the accused products/instrumentalities (as defined below) or systems related to the accused products/instrumentalities.

66. By virtue of at least his positions in AT&T and his work involving the accused products/instrumentalities, Mark Kirkpatrick's personal knowledge of the 786 patent should be imputed to AT&T.

67. Upon information and belief, the original assignee of the 785 patent as issued is or was a subsidiary and/or affiliate of AT&T.

68. The knowledge of the 786 patent possessed by its subsidiaries and/or affiliates should be imputed to AT&T.

69. Upon information and belief, AT&T was involved in the prosecution of the 785 patent.

70. AT&T has knowledge of the 786 patent at least due to its involvement in the prosecution of the 785 patent.

71. Between the prosecutions of the 184, 289, 539, 820, and 785 patents, the 786 patent was cited at least a total of 47 times.

72. AT&T infringed¹ one or more claims of the 786 patent and is being accused of doing so both directly and indirectly.

73. AT&T, either alone and/or in conjunction with others, including its customers and/or suppliers, made, had made, used, imported, provided, supplied, distributed, sold, and/or offered for sale unified messaging systems/products/services that, upon receipt of an email, actuate a voice mail system to send an e-mail notification signal to a telephone node (including at least systems/products/services under following designation: AT&T Unified Messaging) that infringed one or more claims of the 786 patent.

74. To the extent that AT&T acted in conjunction with others, including its customers and/or suppliers, in its infringement, these others are contractually or otherwise obliged to AT&T to carry out their acts.

75. AT&T's customers and/or suppliers directly made, had made, used, imported, provided, supplied, distributed, sold, and/or offered for sale unified messaging systems/products/services that, upon receipt of an email, actuate a voice mail system to send an e-mail notification signal to a telephone node (including at least systems/products/services under following designation: AT&T Unified Messaging) that infringed one or more claims of the 786 patent.

¹ MessageTech accuses AT&T of past, present, and future infringement. All allegations of infringement or acts leading to infringement are made in the past tense, rather than also in the present and future tense, strictly for simplicity's sake.

76. AT&T induced infringement and/or contributed to the infringement of one or more of the claims of the 786 patent by its customers and/or suppliers.

77. AT&T took active steps, directly and/or through contractual relationships with others, to cause infringement with both knowledge of the 786 patent, the specific intent to cause its customers and/or suppliers (e.g., manufacturers of computer and telecommunications equipment, companies selling message management software) to make, use, sell, import, or otherwise provide the accused systems/products/services in a manner that infringed the 786 Patent, and knowledge that these acts by its customers and/or suppliers constituted infringement. Such steps by AT&T included, among other things, advising or directing its customers and/or suppliers to make, use, sell, or import the accused systems/products/services in an infringing manner; advertising and promoting the use of the accused systems/products/services in an infringing manner; and/or distributing instructions that guide users to use the accused systems/products/services in an infringing manner. AT&T, being involved in the relevant telecom hardware and software systems of its customers and/or suppliers, had sufficiently detailed knowledge of the related activities of its customers and/or suppliers to know that these acts constituted infringement yet took the above steps to cause infringement regardless.

78. The accused systems/products/services contain hardware and software components that are especially designed to be used in conjunction with other devices or systems that may not be provided by AT&T. These other devices or systems may include: email servers and clients; telephone hardware; and voice servers. To the extent AT&T did not provide these other devices and systems, it took active steps, directly and/or through contractual relationships, to cause infringement by its customers and/or suppliers, including, among other things, advising or directing others to integrate such other devices and systems with accused

systems/products/services; advertising and promoting the use by others of the accused systems/products/services with such other devices and systems; and distributing instructions that guide users to integrate the accused systems/products/services with such other devices and systems.

79. The accused systems/products/services have hardware and/or software components that are especially designed and/or adapted to be used with such other devices and systems in carrying out unified messaging functionality, as seen by how prominently the unified messaging feature is promoted by AT&T on its website and marketing literature. These components in the Accused Products constitute a material part of the invention of one or more asserted claims of the 786 patent and are not staple articles of commerce suitable for substantial non-infringing use. These distinct and separate components are used only to perform the unified messaging functionality and not any other functionality.

80. For the reasons stated above, AT&T infringed the 786 patent both directly and indirectly.

81. AT&T's infringement was willful at least from the date it had knowledge of the 786 patent, as AT&T knew or should have known of the risk of infringement from that point in time. AT&T acted in the face of "an objectively high likelihood that its actions constituted infringement of a valid patent" or with reckless disregard of that likelihood.

82. MessageTech has been, is being, and will continue to be damaged as a result of the infringing conduct by defendant alleged above. Thus, defendant is liable to MessageTech in an amount that adequately compensates MessageTech for such infringements, which, by law, cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

JURY DEMAND

MessageTech hereby requests a trial by jury on all issues so triable by right.

PRAYER FOR RELIEF

MessageTech requests that the Court find in its favor and against the defendant and that the Court grant MessageTech the following relief:

a. Judgment that one or more claims of the 786 patent have been infringed, either literally and/or under the doctrine of equivalents, by defendant and/or by others to whose infringement defendant has contributed and/or by others whose infringement has been induced by defendant;

b. A permanent injunction enjoining defendant and its officers, directors, agents, servants, affiliates, employees, divisions, branches, subsidiaries, parents, and all others acting in active concert therewith from infringement, inducing infringement of, or contributing to infringement of the 786 patent;

c. Judgment that defendant account for and pay to MessageTech all damages to and costs incurred by MessageTech because of defendant's infringing activities and other conduct complained of herein;

d. That MessageTech be granted pre-judgment and post-judgment interest on the damages caused by defendant's infringing activities and other conduct complained of herein;

e. That this Court declare this an exceptional case and award MessageTech its reasonable attorneys' fees and costs in accordance with 35 U.S.C. § 285; and

f. That MessageTech be granted such other and further relief as the Court may deem just and proper under the circumstances.

Dated: January 28, 2014

BAYARD, P.A.

OF COUNSEL:

Zachariah S. Harrington
Matthew J. Antonelli
Larry D. Thompson, Jr.
ANTONELLI, HARRINGTON &
THOMPSON LLP
4200 Montrose Blvd., Ste. 430
Houston, TX 77006
(713) 581-3000
zac@ahtlawfirm.com
matt@ahtlawfirm.com
larry@ahtlawfirm.com

/s/ Stephen B. Brauerman
Richard D. Kirk (rk0922)
Stephen B. Brauerman (sb4952)
Vanessa R. Tiradentes (vt5398)
Sara E. Bussiere (sb5725)
222 Delaware Avenue, Suite 900
P.O. Box 25130
Wilmington, DE 19899
(302) 655-5000
rkirk@bayardlaw.com
brauerman@bayardlaw.com
vtiradentes@bayardlaw.com
sbussiere@bayardlaw.com

*Attorneys for Message Notification
Technologies LLC*