

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

BLACKBOARD INC.,

Plaintiff,

v.

UNILOC 2017 LLC,

Defendant.

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CASE NO.

JURY TRIAL DEMANDED

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Blackboard Inc. brings this action against Defendant Uniloc 2017 LLC and pleads as follows:

NATURE OF THE ACTION

1. This is an action arising 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.* Blackboard Inc. requests a declaratory judgment of non-infringement of one or more claims of U.S. Patent No. 6,324,578, entitled “Methods, Systems and Computer Program Products for Management of Configurable Application Programs on a Network,” which issued on November 27, 2001 (the “’578 patent”) (Ex. A), and U.S. Patent No. 7,069,293, entitled “Methods, Systems and Computer Program Products for Distribution of Application Programs to a Target Station on a Network,” which issued on June 27, 2006 (the “’293 patent”) (Ex. B) (collectively the “patents-in-suit”).

RELATED CASES

2. At least two cases involving the same patents-in-suit are pending in this District. Those cases will likely involve common issues of law and fact. They include *Uniloc 2017 LLC v.*

ZenPayroll Inc. d/b/a Gusto, C.A. No. 19-1075 (CFC), and *Nexon America Inc. v. Uniloc 2017 LLC*, C.A. No. 19-1096 (RGA).

PARTIES

3. Plaintiff Blackboard Inc. is a Delaware corporation with its principal place of business in Washington, D.C.

4. Upon information and belief, Defendant Uniloc 2007 LLC (“Uniloc”) is a Delaware limited liability company.

JURISDICTION AND VENUE

5. This is an action for patent infringement arising under the patent laws of the United States, Title 35 of the United States Code. This Court has jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

6. Uniloc is subject to personal jurisdiction in Delaware because it is formed under Delaware law and because it has brought suit alleging infringement of the patents-in-suit in this Court against numerous defendants.

7. Venue is proper in the District of Delaware pursuant to 28 U.S.C. § 1391(b)(1) because Uniloc resides here.

GENERAL ALLEGATIONS

8. Uniloc claims to be the owner of the patents-in-suit.

9. Upon information and belief, Uniloc is under common control with related entities including Uniloc USA, Inc. and Uniloc Luxembourg, S.A. (the “other Uniloc entities”). In 2016, the other Uniloc entities sued Blackboard for infringement of the patents-in-suit in the U.S. District Court for the Eastern District of Texas. *See Uniloc USA, Inc. v. Blackboard, Inc.*, C.A. No. 16-859 (E.D. Tex). In 2017, when it became apparent that they were about to suffer adverse rulings

both on claim construction and Blackboard's pending motion to dismiss, they voluntarily dismissed their claims against Blackboard and simultaneously re-filed them in the U.S. District Court for the Western District of Texas, where they remain pending. *See Uniloc USA, Inc. v. Blackboard, Inc.*, C.A. No. 17-755 (W.D. Tex).

10. In May 2018, the other Uniloc entities purportedly assigned the patents-in-suit to Uniloc. As a result, as of the filing of this complaint for declaratory judgment, the plaintiffs in the Western District of Texas case lack standing to pursue the claims at issue there.

11. Uniloc, which claims to be the entity with standing to sue Blackboard, has not sued Blackboard in any court. Nor has Uniloc been joined as a plaintiff in the case against Blackboard in the Western District of Texas. And neither Uniloc nor the other Uniloc entities has sought such joinder. Uniloc nevertheless contends that Blackboard infringes the patents-in-suit.

12. Blackboard does not infringe the patents-in-suit. Indeed, under a final non-appealable claim construction order by the Eastern District of Texas, there can be no good faith basis for a claim that Blackboard infringes the patents-in-suit.

COUNT I

NON-INFRINGEMENT OF THE '578 PATENT

13. Blackboard incorporates the foregoing paragraphs as if separately set forth herein.

14. There is an actual controversy within the meaning of 28 U.S.C. §§ 2201 and 2202 between Blackboard and Uniloc concerning the infringement of claims of the '578 patent that requires a declaration of rights by this Court.

15. Blackboard has not infringed one or more claims of the '578 patent.

16. Blackboard is entitled to a declaration that it has not infringed one or more claims of the '578 patent.

COUNT II

NON-INFRINGEMENT OF THE '293 PATENT

17. Blackboard incorporates the foregoing paragraphs as if separately set forth herein.

18. There is an actual controversy within the meaning of 28 U.S.C. §§ 2201 and 2202 between Blackboard and Uniloc concerning the infringement of claims of the '293 patent that requires a declaration of rights by this Court.

19. Blackboard has not infringed one or more claims of the '293 patent.

20. Blackboard is entitled to a declaration that it has not infringed one or more claims of the '293 patent.

DEMAND FOR JURY TRIAL

Blackboard demands a jury trial on all issues so triable.

REQUESTED RELIEF

Blackboard respectfully requests that this Court:

a. Issue a declaratory judgment of non-infringement as to one or more claims of the '578 patent.

b. Issue a declaratory judgment of non-infringement as to one or more claims of the '293 patent.

c. Find this case exceptional under 35 U.S.C. § 285 and award Blackboard its attorneys' fees and costs.

d. Award Blackboard its costs pursuant to 28 U.S.C. § 1920; and

e. Grant Blackboard other such relief as the Court deems just and proper.

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October 31, 2019

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