

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

BROADSIGN INTERNATIONAL, LLC,	:	X
	:	
	:	
Plaintiff,	:	Civil Action No.: 1:16-cv-04586 (LTS)
	:	
v.	:	
	:	JURY TRIAL REQUESTED
	:	
T-REX PROPERTY AB,	:	
	:	
	:	
Defendant.	:	
	:	
	:	X

JOINT PRELIMINARY PRETRIAL STATEMENT

Pursuant to the Court's July 25, 2016 Initial Conference Order (Dkt. 9), counsel for Plaintiff BroadSign International, LLC ("Plaintiff" or "BroadSign") and Declaratory Judgment Defendant T-Rex Property AB ("Defendant" or "T-Rex") conferred regarding the matters set forth in the Initial Conference Order. Additionally, the parties continue to work towards streamlining the dispute, particularly with regard to e-discovery, document productions, and a stipulated protective order for the Court's consideration.

A. NATURE OF THE ACTION

On June 16, 2016, BroadSign filed a Complaint (Dkt. 1) against T-Rex seeking a declaratory judgment of non-infringement as to U.S. Patent No. RE39, 470 ("the '470 patent"); U.S. Patent No. 7,382,334 ("the '334 patent"); and U.S. Patent No. 6,430,603 ("the '603 patent") (collectively, the "patents-in-suit") and intervening rights as to the '470 patent.

On September 15, 2016, BroadSign filed an Amended Complaint (Dkt. 10).

The complaint was served on T-Rex in Sweden on November 11, 2016.

On December 14, 2016, T-Rex filed a Motion to Dismiss for Lack of Jurisdiction (Dkt. 14) which is pending before the Court. T-Rex has not yet filed an Answer or counterclaims in this case.

B. PENDING RELATED CRIMINAL OR CIVIL ACTIONS

There are no pending related criminal or civil actions in which both BroadSign and T-Rex are both parties to the action.

The following is a list of pending District Court cases involving one or more of the patents-in-suit:

	Case Name	Case No.	Jurisdiction
1	T-Rex Property AB v. Barco, Inc.	1:16-cv-06938	Northern District of Illinois
2	T-Rex Property AB v. Cedar Fair, L.P.	0:16-cv-02018	District of Minnesota

	Case Name	Case No.	Jurisdiction
3	T-Rex Property AB v. Contextmedia Inc. et al	1:16-cv-04826	Northern District of Illinois
4	T-Rex Property AB v. AMC Entertainment Holdings, Inc.	6:16-cv-01029	Eastern District of Texas
5	T-Rex Property AB v. Regal Entertainment Group	6:16-cv-00927	Eastern District of Texas
6	T-Rex Property AB v. Four Winds Interactive, LLC	1:16-cv-06934	Northern District of Illinois
7	T-Rex Property AB v. Adaptive Micro Systems, LLC	1:16-cv-05667	Northern District of Illinois
8	T-Rex Property AB v. Clear Channel Outdoor Holdings, Inc. et al	6:16-cv-00974	Eastern District of Texas

The following pending Patent Office proceedings were filed by BroadSign and involve one or more of the patents-in-suit:

- CBM2017-00008 (U.S. Patent No. 6,430,603)
- IPR2017-00006 (U.S. Pat. No. 7,382,334)
- IPR2016-01869 (U.S. Reissue Patent No. RE039,470)

C. STATEMENT OF EACH PARTY’S POSITION AS TO THE BASIS OF THE COURT’S JURISDICTION OF THE ACTION

BroadSign’s Statement:

This action arises under the Declaratory Judgment Act, 28 U.S.C. §§2201, *et seq.*, and under the Patent Laws of the United States, as enacted under Title 35 of the United States Code. This Court has jurisdiction over this action pursuant to 35 U.S.C. §§ 271, *et seq.*, and 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

BroadSign is a supplier of hardware and software solutions to operators of networks of digital displays. BroadSign’s platform includes an interface for managing a network of

BroadSign Players associated with the digital displays, and among other things, upload desired content, book and manage advertising campaigns and monitor network health. The BroadSign Players organize the content based on booked advertising campaigns and enable content to be played on the associated digital displays.

To date, T-Rex has filed over 40 patent infringement actions against digital content providers. At least five (5) BroadSign customers who are digital content providers have been sued by T-Rex for patent infringement on one or more of the patents-in-suit. One of those customers, Health Media Network, LLC (“HMN”), was sued on May 27, 2016, in the United States District Court for the Northern District of Illinois. In that complaint, T-Rex accuses BroadSign’s customer of infringing the ’470 patent and identifies the allegedly infringing devices and systems as the defendant’s “digital health media advertising network.” The accused “digital health media advertising network” which T-Rex claims to infringe the ’470 patent is the product that BroadSign sold and delivered to defendant Health Media Network. HMN has no other platform provider for its “digital health media network.”

HMN has also been accused by T-Rex of infringing the ’334 patent. Again, T-Rex identifies HMN’s “digital health media advertising network” provided to HMN by BroadSign as the allegedly infringing product. HMN has no other platform provider for its “digital health media network.”

HMN has also been accused by T-Rex of infringing the ’603 patent. Again, T-Rex identifies HMN’s “digital health media advertising network” provided to HMN by BroadSign as the allegedly infringing product. HMN has no other platform provider for its “digital health media network.”

As a result of the T-Rex lawsuits filed against BroadSign’s customers over the past year accusing BroadSign’s products and services of infringing each of the patents-in-suit, there is a real, immediate and justiciable controversy between T-Rex and BroadSign

concerning infringement of sufficient immediacy to warrant the issuance of a declaratory judgment. There is a real and palpable threat of suit by T-Rex against BroadSign and/or against additional BroadSign customers arising from their use of BroadSign's products. This threat is real and not idle, not only because of the existing suits against BroadSign's customers, but also because T-Rex has filed at least 43 patent infringement suits asserting one or more of these same patents in 17 separate judicial districts throughout the United States. Given the lawsuits against BroadSign's customers and T-Rex's litigious business model and conduct, T-Rex's actions have placed a cloud over BroadSign and its business and have injured or are injuring BroadSign's business, creating a concrete and immediate justiciable controversy between BroadSign and T-Rex. BroadSign cannot simply stand by while its business suffers irreparable harm to await yet another filing of litigation by T-Rex at a future date. BroadSign seeks a declaratory judgment so that its business can move forward without the imminent and ever-present threat of litigation.

T-Rex's Statement

T-Rex maintains that this Court lacks subject matter jurisdiction over the claims asserted by BroadSign because there is no case or controversy between BroadSign and T-Rex. *See* T-Rex's Motion to Dismiss and Supporting Documents (Dkt.14-16 and 26-27) (incorporating by reference the arguments contained in those documents). As T-Rex has not answered BroadSign's amended complaint, T-Rex reserves its right to raise additional objections to the Court's jurisdiction in this action.

D. MATERIAL UNCONTESTED OR ADMITTED FACTS

The following facts are uncontested and/or admitted:

T-Rex is the assignee and owner of the right, title and interest in and to the patents-in-suit, including the right to assert all causes of action arising under the patents-in-suit and the right to any remedies for infringement.

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