

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Broadsign International, LLC,

Petitioner

v.

T-Rex Property AB,

Patent Owner

U.S. Patent Number 6,430,603

Issue Date: August 6, 2002

Title: System for Direct Placement of Commercial Advertising, Public Service
Announcements and Other Content on Electronic Billboard Displays

Case Number CBM2017-00008

DECLARATION OF BURR R. SMITH

I, Burr R. Smith, declare the following facts:

1. I am the Chairman, President, and Chief Executive Officer at Broadsign International, LLC (“Broadsign”). I have personal knowledge of the facts set forth herein, and can testify competently thereto.
2. Broadsign supplies hardware and software solutions to customers, including operators of networks of digital displays.
3. Since 2012, T-Rex Property AB has filed at least 58 cases against digital signage media owners and vendors, including our customers, alleging infringement of one or more of the following patents: U.S. Patent Number 6,430,603 (“the ’603 Patent”), U.S. Patent Number 7, 382,334 (“the ’334 Patent”), and U.S. Patent Number RE39,470 (“the ’470 Patent”).
4. So far, T-Rex Property AB has filed at least five patent-infringement lawsuits against Broadsign customers.
5. One Broadsign customer, Health Media Network, LLC was sued by T-Rex Property AB on May 27, 2016 in the United States District for the Northern District of Illinois (Case No. 1:16-cv-05673). T-Rex Property AB accused Broadsign’s customer of infringing the ’603 Patent, the ’334 Patent, and the ’470 Patent and identified the infringing devices and systems as the “digital health media advertising network.” Broadsign sold and delivered the “digital health media advertising network” product to Health Media Network, LLC.

6. Another Broadsign customer, ContextMedia Health, LLC, was sued by T-Rex Property AB on July 11, 2016 in the United States District Court for the Northern District of Illinois (Case No. 1:16-cv-04826). T-Rex Property AB accused Broadsign's customer of infringing the '603 Patent, the '334 Patent, and the '470 Patent and identified the infringing devices and systems as the "Digital Waiting Room Screen." Broadsign sold and delivered the "Digital Waiting Room Screen" product to ContextMedia.

7. T-Rex Property AB has had direct discussions, including an in-person meeting, with representatives of Broadsign. I have been involved with the discussions with T-Rex Property AB and, in July 2016, I personally attended a meeting with T-Rex principals at T-Rex Property AB's offices in Sweden to discuss T-Rex Property AB's proposal that Broadsign take a license to the '603 Patent, the '334 Patent, and the '470 Patent in order to protect Broadsign and its customers from litigation and future law suits. In those discussions, T-Rex Property AB produced a form of license agreement which Broadsign did not agree to sign. In addition to myself, the meeting in Sweden was attended by Sandra Beauchesne on behalf of Broadsign. Since the meeting in Sweden in July, 2016, T-Rex Property AB has contacted Broadsign threatening to sue additional Broadsign customers unless Broadsign takes a license to the '603 Patent, '334 Patent and the '470 Patent.

8. As a result of the T-Rex Property AB lawsuits filed against Broadsign's customers over the past year accusing Broadsign's products and services of infringing each of the patents-in-suit, as well as T-Rex Property AB's demands that Broadsign take a license to the '603 Patent, the '334 Patent and the '470 Patent in order to resolve pending litigation against Broadsign's customers and to prevent future litigation against Broadsign and its customers, I believe that there is a real, immediate controversy between T-Rex Property AB and Broadsign concerning T-Rex Property AB's assertions that the Broadsign products and services are infringing. Moreover, I believe that there is a real and palpable threat of suit by T-Rex Property AB against Broadsign and against additional Broadsign customers arising from their use of Broadsign's products. This threat is real and not idle, not only because of the suits against Broadsign's existing customers, but also because T-Rex Property AB has filed approximately 58 patent infringement suits asserting one or more of these same patents in 17 separate judicial districts throughout the United States.

9. The lawsuits against Broadsign's customers, the demand for a license from Broadsign and T-Rex Property AB's litigious business model and conduct 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 Property AB. Broadsign cannot simply

stand by while its business suffers irreparable harm.

10. T-Rex Property AB's patent-assertion campaign against the digital display industry has affected and continues to harm Broadsign's business and customers. On June 16, 2016, Broadsign filed a complaint in the United States District Court for the Southern District of New York (Case No. 1:16-cv-04586) seeking a declaratory judgment of non-infringement against T-Rex Property AB as to the '603 Patent, the '334 Patent, and the '470 Patent. On September 15, 2016, Broadsign filed an Amended Complaint.

11. The lawsuits brought by T-Rex Property AB against Broadsign's customers have adversely affected Broadsign's business by, for example, causing strain on the relationships between T-Rex Property AB and its customers.

12. I declare that all statements made herein of my knowledge are true, and that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

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