

1 Sterling A. Brennan (CA State Bar No. 126019)

2 E-mail: sbrennan@mabr.com

3 MASCHOFF BRENNAN GILMORE & ISRAELSEN

4 100 Spectrum Center Drive, Suite 1200

5 Irvine, California 92618

6 Telephone: (949) 202-1900

7 Facsimile: (949) 453-1104

8 David R. Wright (*pro hac vice* application to be submitted)

9 E-mail: drwright@foley.com

10 Michael A. Manookin (*pro hac vice* application to be submitted)

11 E-mail: mmanookin@foley.com

12 FOLEY & LARDNER LLP

13 299 South Main Street, Suite 2000

14 Salt Lake City, Utah 84111

15 Telephone: (801) 401-8900

16 Facsimile: (385) 799-7576

17 Attorneys for Plaintiff VIVINT, INC.

18 **UNITED STATES DISTRICT COURT**  
19 **CENTRAL DISTRICT OF CALIFORNIA**

20 VIVINT, INC., a Utah corporation,

21 Plaintiff,

22 vs.

23 SB IP HOLDINGS, LLC, a Delaware  
24 limited liability company,

25 Defendant.

Case No. 8:22-cv-34

**COMPLAINT FOR DECLARATORY  
JUDGMENT**

Demand for Jury Trial

26  
27  
28

1 Plaintiff Vivint, Inc. (“Vivint”), as a Complaint against defendant SB IP Holdings,  
2 LLC (“SBIP”), alleges as follows:

3 **NATURE OF THE ACTION**

4 1. This is an action for declaratory judgment of non-infringement and  
5 unenforceability of the following six United States patents (collectively, the “SBIP  
6 Patents”): No. 7,193,644 attached hereto as Exhibit 1 (the “’644 patent”); No. 8,139,098  
7 attached hereto as Exhibit 2 (the “’098 patent”); No. 8,144,183 attached hereto as Exhibit  
8 3 (the “’183 patent”); No. 8,144,184 attached hereto as Exhibit 4 (the “’184 patent”);  
9 No. 8,154,581 attached hereto as Exhibit 5 (the “’581 patent”); and No. 8,164,614  
10 attached hereto as Exhibit 6 (the “’614 patent”). Vivint prays for declaratory judgment  
11 pursuant to the Declaratory Judgment Act, 28 U.S.C. §§ 2201-02, and the patent laws of  
12 the United States, 35 U.S.C. § 100 *et seq.*, as well as such other and further relief as the  
13 Court deems just and proper.

14 **PARTIES**

15 2. Vivint is a corporation organized and existing under the laws of the state of  
16 Utah, having its principal place of business at 4921 North 300 West, Provo, Utah 84604.

17 3. On information and belief, SBIP is a limited liability company organized  
18 under the laws of the state of Delaware, having its principal place of business at 1 Jenner,  
19 Suite 100, Irvine, California 92618.

20 4. On information and belief, SBIP is a wholly owned subsidiary of Skybell  
21 Technologies, Inc. (“Skybell”).

22 5. On information and belief, Skybell is a corporation organized and existing  
23 under the laws of the state of Nevada, having its principal place of business at 1 Jenner,  
24 Suite 100, Irvine, California 92618.

25 6. Given that (a) Vivint is incorporated and has its principal place of business  
26 in Utah and (b) SBIP is organized in Delaware and has its principal place of business in  
27 California, the parties are of diverse citizenship within the meaning of 28 U.S.C § 1332;

28

1 and the matter in controversy exceeds the sum or value of \$75,000, exclusive of interest  
2 and costs.

3 **JURISDICTION AND VENUE**

4 7. This Court has exclusive subject matter jurisdiction for and over this action  
5 pursuant to 28 U.S.C. §§ 1331, 1338(a), 1367, 2201, and 2202, and the patent laws of the  
6 United States, 35 U.S.C. § 1, *et seq.* This Court also has diversity of citizenship  
7 jurisdiction for and over this action pursuant to 28 U.S.C. § 1332.

8 8. Venue for this action is proper in this judicial district pursuant to 28 U.S.C.  
9 §§ 1391 and 1400.

10 9. SBIP purports to be the owner of all rights, title, and interest in and to the  
11 SBIP Patents. SBIP filed suit in the United States District Court in the Eastern District of  
12 Texas on November 17, 2020 against Vivint Smart Home, Inc. (“Smart Home”), Vivint’s  
13 parent holding company, asserting patent infringement of the SBIP Patents (“SBIP  
14 Complaint”). *See SB IP Holdings, LLC v. Vivint Smart Home, Inc. et al*, Case No. 4:20-  
15 cv-00886-ALM (“E.D. Tex. Case No. 1”), Dkt. No. 1. In that suit, SBIP claims to be the  
16 owner of the SBIP patents.

17 10. In E.D. Tex. Case No. 1, SBIP accused Smart Home of infringing seven  
18 patents that claim priority to the SBIP Patents (the “SBIP Priority Patents”) through  
19 activity related to video doorbells, video doorbell accessories such as control panels and  
20 electronic locks, IP cameras (i.e., digital video cameras that record and send video and  
21 audio over the internet), and video recording accessories for use with its video doorbells  
22 and IP cameras (“Accused Products”).

23 11. Smart Home does not make, use, sell, offer to sell, sell, or import any  
24 Accused Products. Instead, Smart Home’s subsidiary, Vivint, is the operating entity that  
25 conducts commercial business related to the Accused Products.

26 12. In response to SBIP’s allegations against Smart Home in E.D. Tex. Case  
27 No. 1, Smart Home denied that it sold, made, used, offered to sell, sold, or imported any  
28

1 Accused Product. Additionally, Vivint joined the case by asserting patent infringement  
2 claims against Skybell.

3 13. Skybell and SBIP filed a motion to dismiss Vivint and Skybell from E.D.  
4 Texas Case No. 1 due to objections to venue in the Eastern District of Texas.

5 14. During briefing on the motion, Vivint explained that: “The real parties in  
6 interest to this lawsuit are SkyBell [Technologies, Inc.] and Vivint[, Inc]. SBIP  
7 [Holdings, LLC] and Vivint Smart Home[, Inc.] are holding companies while SkyBell  
8 [Technologies, Inc.] and Vivint[, Inc.] are companies that conduct commercial activity.”

9 15. Following briefing for the motion to dismiss, the parties to E.D. Texas Case  
10 No. 1 agreed to a stipulation to transfer Vivint’s counterclaims against Skybell to the  
11 Southern Division of this Court. On November 17, 2021, United States District Judge  
12 Amos L. Mazzant III entered in E.D. Texas Case No. 1 an Order Granting Joint  
13 Stipulation to Transfer Parties and Claims. *See* E.D. Texas Case, Dkt. No. 65 (Nov. 17,  
14 2021). In particular, Judge Mazzant ordered that “Vivint, Inc. and all of its counterclaims  
15 against Skybell Technologies, Inc. ... are transferred to the United States District Court  
16 for the Central District of California.” *Id.* It further dismissed without prejudice Vivint’s  
17 counterclaims regarding invalidity and non-infringement of the SBIP Priority Patents. *Id.*  
18 Pursuant to Judge Mazzant’s Order, on December 17, 2021, Vivint’s counterclaims  
19 against Skybell were transferred to this Court and assigned to District Judge George H.  
20 Wu and given Case No. 2:21-cv-09472 GW-GJS (“C.D. Cal. Case No. 1”).

21 16. Upon the transfer of Vivint’s counterclaims against SkyBell to this Court in  
22 C.D. Cal. Case No. 1, SBIP’s infringement claims against Smart Home continue in the  
23 Eastern District of Texas. After the transfer, SBIP sought production of sales information  
24 related to Vivint despite having expressly agreed to dismissal of Vivint from E.D. Texas  
25 Case No. 1. When pressed for relevance of the sales documents of a third-party (i.e.,  
26 Vivint), SBIP’s counsel confirmed that SBIP seeks to hold Smart Home liable for  
27 Vivint’s alleged infringement of the SBIP Priority Patents. This communication was the  
28 first express accusation by SBIP of direct patent infringement attributable to Vivint.

1 17. On November 18, 2021, SBIP filed a second action against Smart Home in  
2 the Eastern District of Texas, accusing Smart Home of infringing the SBIP Patents. *SB IP*  
3 *Holdings, LLC v. Vivint Smart Home, Inc. et al*, Case No. 4:21-cv-00912-ALM, Dkt. No.  
4 1 (Nov. 18, 2021) (“E.D. Tex. Case No. 2”).

5 18. In E.D. Tex. Case No. 2, SBIP accuses Smart Home of infringing the SBIP  
6 Patents through activity related to the Accused Products.

7 19. But, again, Smart Home does not make, use, sell, offer to sell, or import any  
8 Accused Products—instead, Vivint is the operating entity that conducts commercial  
9 business related to the Accused Products.

10 20. Accordingly, there is a real and substantial controversy regarding whether  
11 Vivint’s products infringe any valid claim of the SBIP Patents.

12 21. Vivint has not infringed and does not infringe, either directly or indirectly,  
13 any valid and enforceable claim of the SBIP Patents, either literally or under the doctrine  
14 of equivalents. A substantial controversy exists between Vivint and SBIP that is of  
15 sufficient immediacy and reality to warrant declaratory relief.

16 22. This Court has personal jurisdiction over SBIP. Skybell’s headquarters and  
17 principal place of business are in Orange County, California. Further, SBIP has  
18 conducted, and does conduct, business in California pertaining to the SBIP Patents.

19 **COUNT I**

20 **(Declaratory Judgment of Noninfringement of the ’644 Patent)**

21 23. Vivint repeats and realleges the allegations in paragraphs 1–22 as though  
22 fully set forth herein.

23 24. SBIP claims to be the owner and assignee of the ’644 Patent.

24 25. SBIP has alleged that the Accused Products sold by Vivint infringe one or  
25 more of the claims of the ’644 patent.

26 26. Absent a declaration that any asserted claim of the ’644 patent is not  
27 infringed by the Accused Products, SBIP will continue to wrongfully assert the ’644  
28 patent against Vivint, thereby causing Vivint irreparable harm and injury.

1 27. Vivint neither has infringed nor does infringe, directly or indirectly, any  
2 valid and enforceable claim of the '644 patent.

3 28. For example, without limitation, the Accused Products do not include a  
4 component that records audio communication transmitted to the Accused Product as  
5 required by claim 1 of the '644 patent.

6 29. An actual, substantial, and justiciable controversy of sufficient immediacy  
7 and reality exists between the parties as to whether the claims of the '644 patent are  
8 infringed by Vivint. A judicial declaration is necessary and appropriate in view of SBIP's  
9 allegations.

10 30. Based on the foregoing, Vivint hereby requests a declaration that the claims  
11 of the '644 patent are not infringed by the Accused Products.

12 **COUNT II**

13 **(Declaratory Judgment of Noninfringement of the '098 Patent)**

14 31. Vivint repeats and realleges the allegations in paragraphs 1–22 as though  
15 fully set forth herein.

16 32. SBIP claims to be the owner and assignee of the '098 patent.

17 33. SBIP has alleged that the Accused Products sold by Vivint infringe one or  
18 more of the claims of the '098 patent.

19 34. Absent a declaration that any asserted claim of the '098 patent is not  
20 infringed by the Accused Products, SBIP will continue to wrongfully assert the '098  
21 patent against Vivint, thereby causing Vivint irreparable harm and injury.

22 35. Vivint neither has infringed nor does infringe, directly or indirectly, any  
23 valid and enforceable claim of the '098 patent.

24 36. For example, without limitation, the Accused Products do not include a user  
25 interface on a peripheral device that is provided by an application software running on a  
26 central controller as required by claim 1 of the '098 patent.

27 37. An actual, substantial, and justiciable controversy of sufficient immediacy  
28 and reality exists between the parties as to whether the claims of the '098 patent are

1 infringed by Vivint. A judicial declaration is necessary and appropriate in view of SBIP's  
2 allegations.

3 38. Based on the foregoing, Vivint hereby requests a declaration that the claims  
4 of the '098 patent are not infringed by the Accused Products.

5 **COUNT III**

6 **(Declaratory Judgment Noninfringement of the '183 Patent)**

7 39. Vivint repeats and realleges the allegations in paragraphs 1–22 as though  
8 fully set forth herein.

9 40. SBIP claims to be the owner and assignee of the '183 patent.

10 41. SBIP has alleged that the Accused Products sold by Vivint infringe one or  
11 more of the claims of the '183 patent.

12 42. Absent a declaration that any asserted claim of the '183 patent is not  
13 infringed by the Accused Products, SBIP will continue to wrongfully assert the '183  
14 patent against Vivint, thereby causing Vivint irreparable harm and injury.

15 43. Vivint neither has infringed nor does infringe, directly or indirectly, any  
16 valid and enforceable claim of the '183 patent.

17 44. For example, without limitation, the Accused Products do not transmit video  
18 or audio after detection of a person as required by claim 1 of the '183 patent.

19 45. An actual, substantial, and justiciable controversy of sufficient immediacy  
20 and reality exists between the parties as to whether the claims of the '183 patent are  
21 infringed by Vivint. A judicial declaration is necessary and appropriate in view of SBIP's  
22 allegations.

23 46. Based on the foregoing, Vivint hereby requests a declaration that the claims  
24 of the '183 patent are not infringed by the Accused Products.

25 **COUNT IV**

26 **(Declaratory Judgment Noninfringement of the '184 Patent)**

27 47. Vivint repeats and realleges the allegations in paragraphs 1–22 as though  
28 fully set forth herein.

1 48. SBIP claims to be the owner and assignee of the '184 patent.

2 49. SBIP has alleged that the Accused Products sold by Vivint infringe one or  
3 more of the claims of the '184 patent.

4 50. Absent a declaration that any asserted claim of the '184 patent is not  
5 infringed by the Accused Products, SBIP will continue to wrongfully assert the '184  
6 patent against Vivint, thereby causing Vivint irreparable harm and injury.

7 51. Vivint neither has infringed nor does infringe, directly or indirectly, any  
8 valid and enforceable claim of the '184 patent.

9 52. For example, without limitation, the Accused Products do not include a  
10 sensor that activates a camera as required by claim 1 of the '184 patent.

11 53. An actual, substantial, and justiciable controversy of sufficient immediacy  
12 and reality exists between the parties as to whether the claims of the '184 patent are  
13 infringed by Vivint. A judicial declaration is necessary and appropriate in view of SBIP's  
14 allegations.

15 54. Based on the foregoing, Vivint hereby requests a declaration that the claims  
16 of the '184 patent are not infringed by the Accused Products.

17 **COUNT V**

18 **(Declaratory Judgment of Noninfringement of the '581 Patent)**

19 55. Vivint repeats and realleges the allegations in paragraphs 1–22 as though  
20 fully set forth herein.

21 56. SBIP claims to be the owner and assignee of the '581 patent.

22 57. SBIP has alleged that the Accused Products sold by Vivint infringe one or  
23 more of the claims of the '581 patent.

24 58. Absent a declaration that any asserted claim of the '581 patent is not  
25 infringed by the Accused Products, SBIP will continue to wrongfully assert the '581  
26 patent against Vivint, thereby causing Vivint irreparable harm and injury.

27 59. Vivint neither has infringed nor does infringe, directly or indirectly, any  
28 valid and enforceable claim of the '581 patent.



1 60. For example, without limitation, the Accused Products do not include any  
2 device for detecting the proximity of objects as required by claim 1 of the '581 patent.

3 61. An actual, substantial, and justiciable controversy of sufficient immediacy  
4 and reality exists between the parties as to whether the claims of the '581 patent are  
5 infringed by Vivint. A judicial declaration is necessary and appropriate in view of SBIP's  
6 allegations.

7 62. Based on the foregoing, Vivint hereby requests a declaration that the claims  
8 of the '581 patent are not infringed by the Accused Products.

9 **COUNT VI**

10 **(Declaratory Judgment of Noninfringement of the '614 Patent)**

11 63. Vivint repeats and realleges the allegations in paragraphs 1–22 as though  
12 fully set forth herein.

13 64. SBIP claims to be the owner and assignee of the '614 patent.

14 65. SBIP has alleged that the Accused Products sold by Vivint infringe one or  
15 more of the claims of the '614 patent.

16 66. Absent a declaration that any asserted claim of the '614 patent is not  
17 infringed by the Accused Products, SBIP will continue to wrongfully assert the '614  
18 patent against Vivint, thereby causing Vivint irreparable harm and injury.

19 67. Vivint neither has infringed nor does infringe, directly or indirectly, any  
20 valid and enforceable claim of the '614 patent.

21 68. For example, without limitation, the Accused Products do not include a user  
22 interface on a peripheral device that is provided by an application software running on a  
23 central controller as required by claim 1 of the '614 patent.

24 69. An actual, substantial, and justiciable controversy of sufficient immediacy  
25 and reality exists between the parties as to whether the claims of the '614 patent are  
26 infringed by Vivint. A judicial declaration is necessary and appropriate in view of SBIP's  
27 allegations.

28

1 70. Based on the foregoing, Vivint hereby requests a declaration that the claims  
2 of the '614 patent are not infringed by the Accused Products.

3 **COUNT VII**

4 **(Inequitable Conduct Based on False Designation of Inventor)**

5 71. Vivint repeats and realleges the allegations in paragraphs 1–22 as though  
6 fully set forth herein.

7 72. On information and belief, in 2002 Ronald Carter (the only named inventor  
8 on the SBIP Patents) approached Emmanuel Ozoeneh. Carter identified problems  
9 associated with missing deliveries from UPS and FedEx when he was not at home.  
10 According to Ozoeneh, Carter had a general idea of the problem to be solved but had no  
11 technical expertise to solve it. Ozoeneh, on the other hand, did have the technical  
12 expertise to solve the problem. The two then proceeded to meet on a regular basis to  
13 discuss the idea for a voice and video monitoring system and later sought counsel for  
14 patent protection.

15 73. On information and belief, Carter and Ozoeneh hired the law firm  
16 Dougherty & Clements to prosecute a patent. After several meetings, attorney Jason S.  
17 Miller of the law firm Dougherty & Clements filed provisional patent application  
18 No. 60/418,384, on October 15, 2002, listing both Carter and Ozoeneh as co-inventors.  
19 After the provisional patent application was filed, Carter told Ozoeneh that he, in turn,  
20 had been told by the patent prosecutors that the invention was unpatentable, and that  
21 Carter no longer wanted to pursue this endeavor. Carter also told Ozoeneh that Dougherty  
22 & Clements had disintegrated and that he and Ozoeneh could no longer work with the  
23 law firm. Carter then had little or no contact with Ozoeneh, despite Ozoeneh's attempts to  
24 contact him. Contrary to Carter's assertion to Ozoeneh, however, Carter did not abandon  
25 the claimed invention. Nor did Dougherty & Clements immediately disintegrate. Instead,  
26 Carter continued to pursue patent protection. In October 2003, Dougherty & Clements  
27 filed a nonprovisional application, Application No. 10/682,185 ("the '185 application"),  
28 on behalf of Carter alone and without Ozoeneh's knowledge or approval. This patent

1 application eventually matured into U.S. Patent No. 7,193,644 and is the basis for all the  
2 SBIP Patents, which list Carter as the sole inventor despite Ozoeneh’s direct involvement  
3 and contribution of inventive concepts.

4 74. On information and belief, Ozoeneh invented at least “having a computer  
5 and software to control the unit, making the device communicable with a mobile phone, a  
6 motion sensor, a camera, and a device for keeping a record of visitors.”

7 75. Ozoeneh is at least co-inventor of each of the SBIP Patents.

8 76. On information and belief, Ozoeneh was intentionally omitted as a correct  
9 inventor on each of the SBIP Patents.

10 77. Upon information and belief, Carter knowingly and with intent to deceive  
11 the PTO signed false declarations claiming to be the sole inventor of the inventions  
12 claimed in the applications that issued as the SBIP Patents when he was fully aware that  
13 Ozoeneh was at least a joint inventor of the inventions. Submitting an unmistakably false  
14 oath or declaration regarding the inventorship of an invention is per se material. On  
15 October 9, 2003, Carter’s attorney filed the ’185 application with the PTO at Carter’s  
16 direction. The ’185 application described and claimed an “Automated Audio Video  
17 Messaging and Answering System.” The ’185 application claimed priority to a  
18 provisional application, No. 60/418,384, that named both Carter and Ozoeneh as  
19 inventors. The application included a signed declaration from Carter, dated  
20 September 23, 2003, falsely stating that he was the sole inventor of the subject matter  
21 claimed in the ’185 application.

22 78. The intentional omission of Ozoeneh as an inventor on each of the SBIP  
23 Patents is material and on information and belief was done to deceive and mislead the  
24 PTO, thereby constituting inequitable conduct. Accordingly, each of the SBIP Patents is  
25 unenforceable.

26 **PRAYER FOR RELIEF**

27 Vivint prays that the Court grant its relief by entering a judgment in its favor on  
28 each of its claims for relief, and specifically:

- 1 A. a declaration that the Accused Products do not infringe any claim of the '644
- 2 patent;
- 3 B. a declaration that the Accused Products do not infringe any claim of the '098
- 4 patent;
- 5 C. a declaration that the Accused Products do not infringe any claim of the '183
- 6 patent;
- 7 D. a declaration that the Accused Products do not infringe any claim of the '184
- 8 patent;
- 9 E. a declaration that the Accused Products do not infringe any claim of the '581
- 10 patent;
- 11 F. a declaration that the Accused Products do not infringe any claim of the '614
- 12 patent;
- 13 G. a declaration that the '644 patent is unenforceable due to inequitable
- 14 conduct;
- 15 H. a declaration that the '098 patent is unenforceable due to inequitable
- 16 conduct;
- 17 I. a declaration that the '183 patent is unenforceable due to inequitable
- 18 conduct;
- 19 J. a declaration that the '184 patent is unenforceable due to inequitable
- 20 conduct;
- 21 K. a declaration that the '581 patent is unenforceable due to inequitable
- 22 conduct;
- 23 L. a declaration that the '614 patent is unenforceable due to inequitable
- 24 conduct;
- 25 M. award Vivint its costs of suit, expenses, and attorney's fees; and
- 26 N. award Vivint such other and further relief as the Court may deem just and
- 27 proper.
- 28

**DEMAND FOR JURY TRIAL**

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Vivint hereby requests a trial by jury of all issues properly triable by jury.

DATED: January 7, 2022

Sterling A. Brennan  
MASCHOFF BRENNAN GILMORE &  
ISRAELSEN

David R. Wright  
Michael A. Manookin  
FOLEY & LARDNER  
LLP

By: Sterling A. Brennan  
Sterling A. Brennan

Attorneys for Plaintiff VIVINT, INC.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28