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Facebook, Inc.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

FACEBOOK, INC.,

Plaintiff,

v.

MITEL NETWORKS CORP.,  
a Canadian corporation;

MITEL (DELAWARE), INC.,  
a Delaware corporation,

Defendants.

Case No. 4:12-cv-4230-PJH

**FIRST AMENDED COMPLAINT FOR  
PATENT INFRINGEMENT**

**DEMAND FOR JURY TRIAL**

Plaintiff Facebook, Inc. ("Facebook") submits this First Amended Complaint ("Complaint") for Patent Infringement against Defendants Mitel Networks Corporation and Mitel (Delaware), Inc. (collectively "Mitel") as set forth below:

**BACKGROUND**

1. On March 16, 2012, Mitel filed a lawsuit against Facebook in the United States District Court for the District of Delaware alleging infringement of two Mitel patents. The case brought by Mitel is styled *Mitel Networks Corp. v. Facebook, Inc.*, Case No. 1:12-cv-00325-GMS ("the Delaware Action").

2. Facebook believes Mitel's lawsuit to be without merit and has filed a motion to dismiss with respect to Mitel's complaint, and a motion to transfer to this District. Facebook's

1 motion to dismiss and motion to transfer are currently pending before the Delaware Court.

2 3. Facebook accordingly brings this action in this District based on Mitel's  
3 infringement of U.S. Patent Nos. 7,454,709 ("the '709 patent") and 7,778,396 ("the '396 patent")  
4 (collectively the "Asserted Patents"), as described herein.

#### 5 **THE PARTIES**

6 4. Facebook is a Delaware corporation with its principal place of business located at  
7 1601 Willow Road, Menlo Park, California, 94025.

8 5. On information and belief, Defendant Mitel Networks Corporation is a Canadian  
9 corporation with its principal place of business located at 350 Leggett Drive, Ottawa, Ontario  
10 Canada, K2K 2W7.

11 6. On information and belief, Defendant "Mitel (Delaware), Inc." has its principal  
12 place of business at 7300 W. Boston Street, Chandler, Arizona 85226 and is incorporated in  
13 Delaware. On information and belief, that company is a subsidiary of Mitel Networks  
14 Corporation and is responsible for Mitel's U.S. operations, including sales and marketing.

15 7. Mitel purports to be a global provider of business communications and  
16 collaboration software, hardware, and services. Among its offerings are the Mitel Unified  
17 Communicator Advanced, Mitel 5000 Communications Platform, and Mitel Communications  
18 Director products. Mitel provides on its website detailed instructions on how to implement,  
19 configure, and operate these products in a customer environment, including product manuals,  
20 specifications, and data sheets. Mitel likewise offers configuration services and works directly  
21 with customers and potential customers to choose and implement particular configurations of  
22 Mitel products, including Mitel Unified Communicator Advanced, Mitel 5000 Communications  
23 Platform, and Mitel Communications Director.

24 8. Mitel's website features profiles of customers that Mitel assists in implementing  
25 communications solutions using the Mitel Unified Communicator Advanced, Mitel 5000  
26 Communications Platform, and Mitel Communications Director products. For example, the Mitel  
27 website includes a case study for Pacific City Bank, located in Los Angeles, California, which  
28 indicates that Pacific City implements and operates Mitel Unified Communicator Advanced for

1 110 users. Mitel also advertises that customers Link Engineering Company, based in Plymouth,  
2 Michigan, and Intrasphere Technologies, Inc., located in New Jersey, also implement Mitel  
3 Unified Communicator Advanced. On information and belief, Mitel has provided each of these  
4 customers with support, including documentation and instructions on how to operate Unified  
5 Communicator Advanced and the telephone line status and contact list features of that product.

6 9. On information and belief, Mitel includes these customer profiles and case studies  
7 on its website as a means of marketing its products and services, including Mitel Unified  
8 Communicator Advanced, Mitel 5000 Communications Platform, and Mitel Communications  
9 Director, and the features of those products, to potential customers.

### 10 **JURISDICTION AND VENUE**

11 10. This is an action for infringement of the Asserted Patents. This action arises under  
12 the patent laws of the United States, including 35 U.S.C. § 101, *et seq.* This Court has original  
13 jurisdiction over the subject matter of this action under 28 U.S.C. § 1338.

14 11. This Court has personal jurisdiction over Mitel because it regularly conducts  
15 business, including selling products, in the State of California and has had continuous and  
16 systematic contacts with the State of California, including maintaining an office in this District  
17 located at 6475 Christie Ave., Suite 325, Emeryville, California 94608.

18 12. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b) and (c) and  
19 § 1400(b) because Mitel has committed acts of infringement and maintains a regular and  
20 established place of business in this District at 6475 Christie Ave., Suite 325, Emeryville,  
21 California 94608.

### 22 **INTRADISTRICT ASSIGNMENT**

23 13. This case is an Intellectual Property Action subject to district-wide assignment  
24 under Civil Local Rule 3-2(c).

### 25 **THE PATENTS**

26 14. The '709 patent, entitled "User Definable On-Line Co-User Lists," issued on  
27 November 18, 2008, naming Barry Appelman as the inventor. Facebook is the owner of all right,  
28 title, and interest in the '709 patent. A true and correct copy of the '709 patent is attached hereto

1 as **Exhibit A** and is incorporated herein.

2 15. The '396 patent, entitled "Telephone Status Notification System," issued on  
3 August 17, 2010, naming Joseph Vardi, Arie Vardi, Joseph Vigiser, and Yair Goldfinger, as  
4 inventors. Facebook is the owner of all right, title, and interest in the '396 patent. A true and  
5 correct copy of the '396 patent is attached hereto as **Exhibit B** and is incorporated herein.

## 6 **COUNT I**

### 7 **INFRINGEMENT OF THE '709 PATENT**

8 16. Facebook incorporates by reference the allegations of paragraphs 1-15 above as  
9 though fully set forth herein.

10 17. Mitel has infringed and continues to infringe one or more claims of the '709 patent  
11 under 35 U.S.C. § 271(a) by making, using, offering for sale and/or selling within the United  
12 States, or importing into the United States, network-based messaging and presence software and  
13 hardware, including, but not limited to, the Mitel Unified Communicator Advanced product,  
14 without authorization by Facebook.

15 18. Since at least August 10, 2012, when Mitel received notice of the Asserted Patents  
16 through the filing of Facebook's Complaint for Patent Infringement (Dkt. No. 1), Mitel has  
17 further, and without authorization, induced third parties, including its customers and potential  
18 customers, to infringe the '709 patent, alone or in conjunction with Mitel. Mitel's website has  
19 included, and continues to provide, product manuals and instructions for the Mitel Unified  
20 Communicator Advanced product that encourage and induce customers to perform, alone or in  
21 conjunction with Mitel, one or more claims of the '709 patent, including at least claims 33, 34,  
22 36-38, 41, and 44-46. Mitel's website specifically identifies customers who, on information and  
23 belief, are currently performing, alone or in conjunction with Mitel, one or more claims of the  
24 '709 patent through their use of the Mitel Unified Communicator Advanced product. On  
25 information and belief, through these and other actions, Mitel has encouraged third parties to  
26 commit acts that Mitel knew would induce actual infringement of the '709 patent.

27 19. Mitel's infringement of the '709 patent has caused and will continue to cause  
28 damage to Facebook for which Facebook is entitled to recovery under 35 U.S.C. § 284.

1 Facebook has been irreparably harmed by Mitel's infringement, for which there is no adequate  
2 remedy at law, and such harm will continue unless Mitel is enjoined by this Court.

3 **COUNT II**

4 **INFRINGEMENT OF THE '396 PATENT**

5 20. Facebook incorporates by reference the allegations of paragraphs 1-15 above as  
6 though fully set forth herein.

7 21. Mitel has infringed and continues to infringe one or more claims of the '396 patent  
8 under 35 U.S.C. § 271(a) by making, using, offering for sale and/or selling within the United  
9 States, or importing into the United States, communications and presence software and hardware,  
10 including, but not limited to, the Mitel Unified Communicator Advanced, Mitel 5000  
11 Communications Platform, and Mitel Communications Director products, without authorization  
12 by Facebook.

13 22. Since at least August 10, 2012, when Mitel received notice of the Asserted Patents  
14 through the filing of Facebook's Complaint for Patent Infringement (Dkt. No. 1), Mitel has  
15 further, and without authorization, induced third parties, including its customers and potential  
16 customers, to infringe the '396 patent, alone or in conjunction with Mitel. Mitel's website has  
17 included, and continues to provide, product manuals and instructions for the Mitel Unified  
18 Communicator Advanced, Mitel 5000 Communications Platform, and Mitel Communications  
19 Director products that encourage and induce customers to perform, alone or in conjunction with  
20 Mitel, one or more claims of the '396 patent, including at least claims 1-3 and 6-7. Mitel's  
21 website specifically identifies customers who, on information and belief, are currently  
22 performing, alone or in conjunction with Mitel, one or more claims of the '396 patent through  
23 their use of the Mitel Unified Communicator Advanced, Mitel 5000 Communications Platform,  
24 and Mitel Communications Director products. On information and belief, through these and other  
25 actions, Mitel has encouraged third parties to commit acts that Mitel knew would induce actual  
26 infringement of the '396 patent.

27 23. Mitel's infringement of the '396 patent has caused and will continue to cause  
28 damage to Facebook for which Facebook is entitled to recovery under 35 U.S.C. § 284.

Facebook has been irreparably harmed by Mitel's infringement, for which there is no adequate remedy at law, and such harm will continue unless Mitel is enjoined by this Court.

**PRAYER FOR RELIEF**

Wherefore, Facebook respectfully requests the following relief:

- A. A judgment that Mitel has directly infringed, and induced infringement of, the '709 and '396 patents;
- B. An award of damages in favor of Facebook in an amount sufficient to compensate it for Mitel's infringement, including pre- and post-judgment interest;
- C. An order enjoining Mitel and its officers, directors, agents, employees, successors, and assigns, and all persons acting under, through, or for Mitel, from further infringement of the '709 and '396 patents;
- D. A declaration that this case is exceptional under 35 U.S.C. § 285 and awarding Facebook its attorneys' fees and costs in connection with this case; and
- E. An award to Facebook of such other and further relief as this Court deems just and proper.

Dated: January 30, 2013

Respectfully submitted,

/s/ Brian P. Wikner

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Facebook, Inc.

**JURY DEMAND**

Facebook, Inc. demands a trial by jury as to any and all matters to which it is so entitled.

Dated: January 30, 2013

Respectfully submitted,

/s/ Brian P. Wikner

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