

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

| | | |
|------------------------------|---|------------------------|
| SANDBOX SOFTWARE LLC, |) | |
| |) | |
| Plaintiff, |) | |
| |) | C. A. No. _____ |
| v. |) | |
| |) | |
| 18BIRDIES, LLC, |) | |
| |) | |
| Defendant. |) | |

COMPLAINT

COMES NOW Plaintiff, Sandbox Software, LLC ("Sandbox Software" or "Plaintiff"), and for its Complaint against Defendant, 18Birdies, LLC ("18Birdies" or "Defendant"), states the following:

THE PARTIES

1. Sandbox Software is a corporation organized under the laws of the State of Georgia, with its principal place of business in Cordele, Georgia.
2. Upon information and belief, Defendant 18Birdies is a Delaware corporation, with its principal place of business in Oakland, California. 18Birdies can be served through its registered agent, CT Corporation System.

JURISDICTION AND VENUE

3. This is an action against Defendant 18Birdies for patent infringement arising under the Patent Laws of the United States, specifically 35 U.S.C. § 271 and 35 U.S.C. § 281.
4. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1331 as it involves a federal question and 28 U.S.C. §1338(a) as it involves federal patent law,

and 28 U.S.C. § 1332 as the action is between citizens of different States, and the amount in controversy in this action, exclusive of interest and costs, exceeds the sum of \$75,000.00.

5. This Court has personal jurisdiction over 18Birdies because it has knowingly and actively engaged in acts that have infringed, will infringe, and/or aid and abet in the direct infringement of claims of Sandbox Software's patent in this judicial district and division.

6. Venue is proper in this District pursuant to 28 U.S.C. § 1400(b) as Defendant is incorporated in this District.

THE CONTROVERSY

7. Sandbox Software has been and continues to be engaged in the development of software in the United States.

8. On August 22, 2017, the United States Patent and Trademark Office duly and lawfully issued U.S. Patent No. 9,737,803 B2 ("the '803 Patent") to inventor Marion O'Neill Lee and Jared Brandon Emrich for the invention entitled "SYSTEM AND METHOD FOR GAMING UTILIZING A MOBILE DEVICE." (See Exhibit A, Plaintiff's U.S. Patent No. 9,737,803 B2.)

9. The '803 Patent discloses and claims, *inter alia*, a method of playing a mobile computer device based game and a mobile computer device based game.

10. The '803 Patent is currently in full force and effect. In accordance with 35 U.S.C. § 282, the '803 Patent, and each and every claim thereof, is presumed to be valid.

11. All rights, title and interest in and to the '803 Patent have been assigned to Sandbox Software, which is the sole owner of the '803 Patent.

12. Defendant 18Birdies promotes, offers to sell, provides and sells a golf related software application ("Accused Product"), which infringes, includes and/or practices one or more of the inventions claimed in the '803 Patent. (See Exhibit B, which shows claims 1, 5 and 10 of

the '803 Patent and a comparison utilizing photographs to the 18Birdies' Accused Products appearing upon two mobile computer devices)

13. On May 15, 2018, Sandbox Software sent 18Birdies a cease and desist letter outlining the infringement of the '803 Patent.

14. On June 20, 2018, Sandbox Software sent to counsel for 18Birdies an email outlining the reasons 18Birdies is liable for indirect patent infringement; information requested by counsel for 18Birdies.

15. On August 1, 2018, 18Birdies responded to the cease and desist letter and denied infringement of the '803 Patent.

16. The Accused Product infringes at least independent claims 1, 5 and 10 of the '803 Patent.

17. As shown in Exhibit B, incorporated herein by reference, the Accused Product infringes claim 1 of the '803 Patent because the Accused Product preforms all the steps recited in the claimed method, either directly or indirectly.

18. Claim 1 recites, in part, "[a] method for playing a mobile computer device based game based on a plurality of game related events which relates to the observation of another player's action." ['803 Patent at 4:38-40].

19. 18Birdies' Accused Product is a game including a method for playing a mobile computer device based game based on a plurality of golf game related events which relates to the observation of another golf player's action. (Ex. B, p.1)

20. Claim 1 recites, in part, "providing a first player's mobile computer device having a select mobile device game application." ['803 Patent at 4:42-43].

21. 18Birdies' Accused Product provides a first player's mobile computer device with a select mobile device golf game application. (Ex. B, p.1)

22. Claim 1 recites, in part, "providing a second player's mobile device having a select mobile device game application." ['803 Patent at 4:44-45].

23. 18Birdies' Accused Product provides a second player's mobile computer device with a select mobile device golf game application. (Ex. B, p.1)

24. Claim 1 recites, in part, "entering the occurrence of each game related event of a plurality of game related events at the time of occurrence of each game related event by a first player which has physically occurred at a remote location which relates to the observation of another player's action that enables the first player to advance in a mobile computer device game application into the first player's mobile computer device utilizing the mobile computer device game application." ['803 Patent at 4:46-54].

25. 18Birdies' Accused Product provides for entering the occurrence of each game related event of a plurality of game related events at the time of occurrence of each game related event by a first player which has physically occurred at a remote location which relates to the observation of another player's action that enables the first player to advance in a mobile computer device game application into the first player's mobile computer device utilizing the mobile computer device game application. (Ex. B, p.2)

26. Claim 1 recites, in part, "transmitting the occurrence of each game related event of the plurality of game related events at the time of occurrence of each game related event which relates to the observation of another player's action from the first player's mobile computer device to a central server associated with the mobile computer device game application." ['803 Patent at 4:55-61].

27. 18Birdies' Accused Product provides for transmitting the occurrence of each game related event of the plurality of game related events at the time of occurrence of each game related event which relates to the observation of another player's action from the first player's mobile computer device to a central server associated with the mobile computer device game application. (Ex. B, p.3)

28. Claim 1 recites, in part, "verifying the occurrence of each game related event of the plurality of game related events by sending a message from the central server to the second player's mobile computer device located at the remote location upon each game related event of the plurality of game related events." ['803 Patent at 4:63-67].

29. 18Birdies' Accused Product provides for verifying the occurrence of each game related event of the plurality of game related events by sending a message from the central server to the second player's mobile computer device located at the remote location upon each game related event of the plurality of game related events. (Ex. B, p.3)

30. Claim 1 recites, in part, "transmitting a verification response from the second player's mobile computer device to the central server upon each game related event of the plurality of game related events." ['803 Patent at 5:1-4].

31. 18Birdies' Accused Product provides for transmitting a verification response from the second player's mobile computer device to the central server upon each game related event of the plurality of game related events. (Ex. B, p.4)

32. Claim 1 recites, in part, "changing a score associated with the first player which is stored on the central server in response to the verifying of the occurrence of each game related event." ['803 Patent at 5:5-7].

33. 18Birdies' Accused Product provides for changing a score associated with the first player which is stored on the central server in response to the verifying of the occurrence of each game related event. (Ex. B, p. 4)

34. Claim 5 recites, in part, "a method of providing a mobile computer device based game based on a plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event." ['803 Patent at 5:27-30].

35. 18Birdies' Accused Product provides for a mobile computer device based game based on a plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, p.7)

36. Claim 5 recites, in part, "transmitting a request to enter each score enabling game related event of the plurality of game related events from a remote location through the use of a first person's mobile computer device to a central server which relates to the observation of another player's action at the time of occurrence of each game related event." ['803 Patent at 5:32-38].

37. 18Birdies' Accused Product provides for transmitting a request to enter each score enabling game related event of the plurality of game related events from a remote location through the use of a first person's mobile computer device to a central server which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, p.7)

38. Claim 5 recites, in part, "receiving each transmitted request from the first person's mobile computer device with the central server, and in response transmitting a verification request from the central server to a second person's mobile device upon each of the plurality of

game related events which relates to the observation of another player's action at the time of occurrence of each game related event." ['803 Patent at 5:39-45].

39. 18Birdies' Accused Product provides for receiving each transmitted request from the first person's mobile computer device with the central server, and in response transmitting a verification request from the central server to a second person's mobile device upon each of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, p.9)

40. Claim 5 recites, in part, "receiving the transmitted verification request with the second person's mobile computer device upon the completion of each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event and in response transmitting a verification response from the second person's mobile computer device to the central server for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event." ['803 Patent at 5:46-57].

41. 18Birdies' Accused Product provides for receiving the transmitted verification request with the second person's mobile computer device upon the completion of each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event and in response transmitting a verification response from the second person's mobile computer device to the central server for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, p.9)

42. Claim 5 recites, in part, "receiving the verification response from the second person's mobile computer device with the central server for each game related event of the

plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, and reflecting a change in the first person's game score in response to each affirmative verification response from the second person's mobile device for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event." ['803 Patent at 5:58-6:2].

43. 18Birdies' Accused Product provides for receiving the verification response from the second person's mobile computer device with the central server for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, and reflecting a change in the first person's game score in response to each affirmative verification response from the second person's mobile device for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, p.10)

44. Claim 10 recites, in part, "a mobile computer device based game based on a plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event." ['803 Patent at 6:22-25].

45. 18Birdies' Accused Product provides a mobile computer device based game based on a plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, p.12)

46. Claim 10 recites, in part, "a central server." ['803 Patent at 6:26].

47. 18Birdies' Accused Product provides a central server. (Ex. B, p.12)

48. Claim 10 recites, in part, "a first mobile computer device having a mobile computer device gaming application software." ['803 Patent at 6:27-28].

49. 18Birdies' Accused Product provides the software application product for a first mobile computer device having a mobile computer device gaming application software. (Ex. B, p.12)

50. Claim 10 recites, in part, "a second mobile computer device having the mobile computer device gaming application software." ['803 Patent at 6:32-46].

51. 18Birdies' Accused Product provides the software application product for a second mobile computer device having the mobile computer device gaming application software. (Ex. B, p.12)

52. Claim 10 recites, in part, "said first and second mobile devices each having means for entering an observed gaming game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event into said mobile computer device as a scoring request for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, and means for transmitting said entered gaming game related event scoring request to said central server for processing for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event."

53. 18Birdies' Accused Product provides the software application product for the first and second mobile devices each having means for entering an observed gaming game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event into the mobile computer device as a

scoring request for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, and means for transmitting the entered gaming game related event scoring request to the central server for processing for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, p.13)

54. Claim 10 recites, in part, "said central server having processing means for processing said scoring request from said first mobile device for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, means for transmitting a verification request from said central server to said second mobile device for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event; means for receiving a response to said verification request from said second mobile device for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, and means for processing said verification request response from said second mobile computer device and in response thereto processing a score advancement associated with said observed gaming game related event scoring request for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event." ['803 Patent at 6:47-7:1].

55. 18Birdies' Accused Product provides the central server having processing means for processing the scoring request from the first mobile device for each game related event of the

plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, means for transmitting a verification request from the central server to the second mobile device for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event; means for receiving a response to the verification request from the second mobile device for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event, and means for processing the verification request response from the second mobile computer device and in response thereto processing a score advancement associated with the observed gaming game related event scoring request for each game related event of the plurality of game related events which relates to the observation of another player's action at the time of occurrence of each game related event. (Ex. B, pp.14-15)

56. With the '803 Patent in full force and effect, 18Birdies has made, used, sold, offered for sale and/or imported golf related software application products in blatant disregard of Sandbox Software's patent rights. Indeed, 18Birdies' infringing acts, including the introduction, promotion and sale of products covered by Sandbox Software's '803 patent, has occurred without Sandbox Software's knowledge and without any attempt made by 18Birdies to secure any rights or authorization from Sandbox Software to make, use, import, offer to sell, or sell the patented products.

57. Upon information and belief, 18Birdies is distributing its golf related software application product (Accused Product) throughout the United States, including the States of California and Delaware.

COUNT I

PATENT INFRINGEMENT--U.S. PAT. 9,737,803 B2

58. Sandbox Software hereby incorporates and realleges paragraphs one (1) through fifty-seven (57) as if fully set forth herein.

59. 18Birdies has made, used, offered for sale, distributed, sold and/or imported into the United States golf related software application products, which infringe the '803 Patent.

60. 18Birdies has caused and will continue to cause Sandbox Software irreparable injury and damage by directly infringing, actively inducing others to infringe through the direct cooperation of actions occurring between 18Birdies and the players, and/or contributing to infringement through the sale or distribution of the 18Birdies' Accused Product as a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing the patented process, constituting a material part of the invention, knowing it to be especially made or especially adapted for use in an infringement of the '803 Patent, all under 35 U.S.C. § 271. Sandbox Software will suffer further irreparable injury, for which Sandbox Software has no adequate remedy at law, unless and until 18Birdies is enjoined from infringing the '803 Patent.

61. 18Birdies' infringement constitutes willful and intentional infringement making this an exceptional case and justifying the imposition of treble damages and an award of reasonable attorney fees to Sandbox Software within the provisions of 35 U.S.C. §§ 284-85.

62. By reason of the acts of 18Birdies alleged herein, Sandbox Software has suffered, is suffering and will continue to suffer irreparable damage, and unless 18Birdies is restrained from continuing its wrongful acts, the damage to Sandbox Software will increase.

JURY DEMAND

Sandbox Software demands a trial by jury of all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Sandbox Software respectfully prays for the following relief:

A. That the Court enter judgment that 18Birdies has infringed, induced infringement of and/or contributorily infringed one or more claims of the '803 Patent in violation of 35 U.S.C. § 271;

B. That the Court issue an injunction requiring 18Birdies, its officers, agents, servants and employees be enjoined and restrained from making, using, offering to sell, selling, or importing into the United States 18Birdies' infringing products;

C. That the Court enter judgment and order as part of the injunction that 18Birdies be directed to file with this Court and serve on Plaintiff within thirty days after issuance of the injunction, a report in writing under oath, setting forth in detail the manner and form in which 18Birdies has complied with the injunction;

D. That as a further part of the injunction, 18Birdies be required to deliver up and destroy all of 18Birdies' infringing products and all literature, advertisements and other materials displaying 18Birdies' infringing products and contributing to false and erroneous impressions concerning the nature, characteristics, qualities, and/or geographic origin of its products, services and/or commercial activities;

E. That the Court enter judgment and order that 18Birdies account for and pay to Plaintiff all damages available to Sandbox Software for 18Birdies' infringement of the '803 Patent, and that the Court increase the amount of damages to three times the amount found or

assessed by the Court because of the willful and deliberate nature of the infringement, in accordance with 35 U.S.C. § 284;

F. That the Court declare this an exceptional case and that Plaintiff be granted its reasonable attorneys' fees in accordance with 35 U.S.C. § 285;

G. That the Court require 18Birdies to notify its commercial licensees, dealers, associates, suppliers and customers of said injunction and judgment of this Court;

H. That the Court grant Sandbox Software prejudgment interest and costs; and

I. That the Court grant such other and further relief as the Court may deem just.

Respectfully submitted this 23rd day of October, 2018.

Respectfully submitted,

Of Counsel:

Dorian B. Kennedy (Ga. Bar No. 414385)
Pro Hac Vice Application Forthcoming
L. Clint Crosby (Ga. Bar No. 197877)
Pro Hac Vice Application Forthcoming
dkennedy@bakerdonelson.com
ccrosby@bakerdonelson.com
BAKER, DONELSON, BEARMAN,
CALDWELL & BERKOWITZ, P.C.

3414 Peachtree Road, NE
Suite 1600
Atlanta GA 30326
Tel: 404-577-6000
Fax: 404-221-6501

O'KELLY ERNST & JOYCE, LLC

/s/ Sean T. O'Kelly
Sean T. O'Kelly (No. 4349)
901 N. Market Street, Suite 1000
Wilmington, DE 19801
(302) 778-4000
(302) 295-2873 (facsimile)
sokelly@oelegal.com

Attorney for Plaintiff, Sandbox Software,
LLC