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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

MIS SCIENCES CORPORATION,  
Plaintiff,  
v.  
RPOST COMMUNICATIONS LIMITED, et  
al.,  
Defendants.

Case No. [14-cv-00376-VC](#)

**ORDER**

Re: Dkt. No. 32

Plaintiff MIS Sciences Corp. ("MIS") seeks a declaratory judgment that several patents, owned by Defendants RPost Communications Limited, RPost Holdings, Inc., and RMail Limited (together, "RPost"), are invalid, and that MIS has not infringed these patents. On June 16, 2014, RPost moved to dismiss MIS's first amended complaint for lack of jurisdiction under Federal Rule of Civil Procedure 12(b)(1). The motion is denied as to Counts 1-12 of the complaint and granted as to Count 13.

**Counts 1-12**

With respect to the patents alleged in Counts 1-12, the pre-suit communications sent by RPost to MIS constitute sufficient "affirmative act[s] . . . related to the enforcement of [RPost's] patent rights" to establish an actual controversy. *See Assoc. for Molecular Pathology v. U.S. Patent & Trademark Office*, 689 F.3d 1303, 1318 (Fed. Cir. 2012). In a letter dated October 25, 2013, RPost accused MIS of infringing its patents. (Am. Compl. Ex. A, at 1). It provided a "preliminary summary analysis" comparing the claims of certain RPost patents—those upon which Counts 1-12 are based—with features of MIS products and services that, according to RPost, practice those claims. (*Id.* at 2-7). RPost advised MIS that "continued willful infringement of [RPost's] patents . . . may result in trebled damages of RPost's lost profits" and urged MIS to "consider the value of [its] use of RPost's patents, the adverse effects of having to remove the covered features from use, and [the] cost to compensate RPost for past damages." (*Id.* at 1.) Three months later, RPost followed up with an email bearing the subject "Final Letter – Cease &

1 Desist." (Am. Compl. Ex. B, at 1). The email stated: "We request that your client immediately  
2 cease and desist from making/manufacturing, using, and/or offering for sale RPost's patented  
3 technology. We request that your client immediately cease and desist from all infringement,  
4 whether direct or indirect, of RPost's patents." (*Id.*). The email also stated: "We have noted for  
5 our records that despite our courteous outreach to you . . . , you have refused to cease and desist  
6 from your infringement . . . . Your continued use of RPost technology without permission from  
7 RPost is willful, and is causing RPost irreparable harm." (*Id.*). RPost's letter and email  
8 demonstrate that it was ready and willing to enforce its patent rights. They put MIS in the  
9 position of having to choose whether to abandon the features identified by RPost or risk litigation.  
10 "That is enough to establish subject matter jurisdiction." *Danisco U.S. Inc. v. Novozymes A/S*, 744  
11 F.3d 1325, 1332 (Fed. Cir. 2014) (internal quotation marks and citation omitted); *see also*  
12 *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 129 (2007) ("[P]utting the challenger to the  
13 choice between abandoning his rights or risking prosecution . . . is a dilemma that it was the very  
14 purpose of the Declaratory Judgment Act to ameliorate." (internal quotation marks omitted)).

15 RPost contends that this Court lacks jurisdiction because, in its pre-suit communications, it  
16 did not name any specific MIS products or services. Therefore, RPost argues, there is no case or  
17 controversy. As an initial matter, although RPost did not identify any products by name, it did  
18 specify that it was concerned with MIS's "electronic message/email marketing, campaign,  
19 marketing automation, link tracking and message delivery/failure/opening reports." (Am. Compl.  
20 Ex. A, at 1). In addition, as noted above, RPost sent MIS a chart describing the way in which, in  
21 its view, specific features of MIS products infringe RPost patents (*see, e.g., id.* at 2-7). It is clear,  
22 then, that the products at issue are those that contain these features. *Cf. Cold Spring Granite Co.*  
23 *v. Matthews Int'l Corp.*, No. CIV. 10-4272 JRT/LIB, 2011 WL 4549407, at \*2 (D. Minn. Sept. 29,  
24 2011). Indeed, the chart refers to "the above identified products/services," suggesting that RPost's  
25 failure to specifically identify particular products and services by name was inadvertent. (*See id.*).

26 In any event, as explained above, RPost repeatedly asserted that features of MIS products  
27 infringe specific RPost patents, provided a detailed chart comparing these patents with MIS  
28 features, and implicitly—but clearly—threatened to sue MIS based on these features. This is



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**Conclusion**

With respect to Counts 1-12, RPost's motion to dismiss is denied. It is granted, without prejudice, as to Count 13.

The hearing on the motion to dismiss is vacated, but the parties must nonetheless appear at the case management conference on July 24, 2014 at 10:00 a.m. to discuss whether this case should be stayed based on the reasoning set forth in the Court's stay order in *Trend Micro, Inc. v. RPost Holdings, Inc.*, No. 13-5227, Docket No. 79. If this case is stayed, MIS shall have 30 days from the date the stay is lifted to amend its complaint. If it is not stayed, any amended complaint shall be filed within thirty days of the date of this Order.

**IT IS SO ORDERED.**

Dated: July 22, 2014



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VINCE CHHABRIA  
United States District Judge