

**UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

IN RE: MAXIM INTEGRATED PRODUCTS, INC., MDL NO. 2354)	Master Docket
)	Misc. No. 12-244
)	MDL No. 2354
)	
This Document Relates to: 12-cv-89)	CONTI, Chief District Judge
)	
)	
THE PNC FINANCIAL SERVICES GROUP, INC., and PNC BANK, NATIONAL ASSOCIATION)	
)	
Plaintiff and Counter-Defendant,)	C.A. No. 2:12-cv-89-JFC
)	
v.)	
)	
MAXIM INTEGRATED PRODUCTS, INC.,)	
)	
Defendant and Counter-Plaintiff.)	
)	

**FIRST AMENDED COMPLAINT FOR DECLARATORY JUDGMENT AND
VIOLATIONS OF 18 U.S.C. § 1030, 18 U.S.C. § 2511, AND 17 U.S.C. § 1201**

Plaintiffs, The PNC Financial Services Group, Inc. and PNC Bank, National Association (collectively “PNC”), through the undersigned attorneys, alleges the following for its First Amended Complaint against Defendant Maxim Integrated Products, Inc. (“Maxim”):

NATURE OF ACTION

1. This is an action for declaratory judgment seeking relief of non-infringement and invalidity under the patent laws of the United States, Title 35, United States Code, the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, Fed. R. Civ. P. 57, the Computer Fraud and Abuse Act, 18 U.S.C. §§ 1030(a)(2)(C) and 1030(a)(4), the Federal Wiretap Act, 18 U.S.C. §§ 2511(1)(a) and 2511(2)(d), and the Digital Millennium Copyright Act, 17 U.S.C. § 1201(a)(1)(A).

THE PARTIES

2. The PNC Financial Services Group, Inc., a publicly-traded corporation listed on the New York Stock Exchange as “PNC,” is a Pennsylvania corporation with its principal place of business in Pittsburgh, Pennsylvania.

3. PNC Bank, National Association, a national banking association with its principal place of business in Pittsburgh, Pennsylvania, is a wholly-owned, indirect subsidiary of The PNC Financial Services Group, Inc.

4. Upon information and belief, Defendant Maxim is a Delaware corporation with its principal place of business at 120 San Gabriel Drive, Sunnyvale, California.

JURISDICTION AND VENUE

5. This declaratory judgment claim arises under the United States Patent Laws, 35 U.S.C. § 100 et seq., and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. Subject matter jurisdiction is proper under the Computer Fraud and Abuse Act, 18 U.S.C. § 1030; the Federal Wiretap Act, 18 U.S.C. § 2511; the Digital Millennium Copyright Act, 17 U.S.C. § 1201; and 28 U.S.C. §§ 1331 and 1338(a). This matter presents an actual case or controversy and serves the purpose of resolving the legal rights of the parties.

6. This Court has personal jurisdiction over Maxim because Maxim has maintained continuous and systematic contacts with the Commonwealth of Pennsylvania, and Maxim has purposefully availed itself of the benefits and protections of the laws of the Commonwealth of Pennsylvania.

7. Maxim, directly and/or through its distribution networks, offers for sale, sells, and/or distributes products within the Commonwealth of Pennsylvania.

8. Upon information and belief, Maxim maintains sales offices within the Commonwealth of Pennsylvania. *See* Exhibit A, a printout from Maxim’s website

<http://www.maxim-ic.com/sales/offices/worldwide.mvp>, showing its worldwide sales offices, including two for Pennsylvania. Specifically, one of the sales offices listed on Maxim's website references a Maxim sales representative in "US - Pennsylvania (Western)."

9. Upon information and belief, Maxim engages franchised distributors within the Commonwealth of Pennsylvania. *See* Exhibit B, a printout from Maxim's website <http://www.maxim-ic.com/sales/offices/distributor/franchise.mvp>, showing three franchised distributors in Pennsylvania. Specifically, one of the Maxim franchised distributors, Avnet, Inc., has a branch office located in Wexford, Pennsylvania (in the Western District of Pennsylvania).

10. In addition, Maxim operates an interactive website through which persons in Pennsylvania can and do order products from Maxim, which are shipped to Pennsylvania. *See* <http://www.maxim-ic.com/sales/>.

11. On December 2, 2011, counsel for Maxim sent a demand letter to PNC's General Counsel in Pittsburgh, Pennsylvania, alleging patent infringement against PNC in Pennsylvania.

12. Venue is proper in this judicial district under 28 U.S.C. §§ 1391.

FACTUAL BACKGROUND

13. In the December 2, 2011 demand letter, counsel for Maxim accused PNC of infringing Maxim's patents. Specifically, Maxim alleged that PNC's mobile platforms, including multiple software applications for iPhone and other mobile devices, infringe the claims of United States Patent Nos. 5,940,510 ("510 patent"), 5,949,880 ("880 patent"), 6,105,013 ("013 patent"), and 6,237,095 ("095 patent").

14. Upon information and belief, the '510, '880, '013, and '095 patents are assigned to Maxim. True and correct copies of the four patents are attached hereto as Exhibits C, D, E, and F. True and correct assignments of the four patents are attached hereto as Exhibits G, H, I, and J.

15. In the December 2, 2011 letter, Maxim alleged that “[i]t is our belief that PNC is infringing a number of the patents within the Maxim Mobile Transaction Patent Portfolio.” Specifically, Maxim stated that PNC mobile platforms “infringe certain claims within the portfolio via direct infringement, joint infringement, contributory infringement and/or inducement.” It further stated that if it did not hear from PNC within a month (*i.e.*, by January 2, 2012), “Maxim will assume that PNC does not want to obtain a license in a non-litigious manner and will act accordingly.”

16. On December 20, 2011, in-house counsel for PNC responded to counsel for Maxim, advising that: “PNC is in the process of reviewing the claims made in your letter. Due to vacation schedules around the holidays, we will not be in a position to respond to your letter by January 2, 2012.” In response, on January 3, 2012, counsel for Maxim responded, proposing further communications in the form of a conference call on “January 24 or January 26.”

17. Maxim’s initial January 2, 2012 deadline, as later extended by counsel for Maxim to January 24 or January 26, is a clear and unmistakable threat of litigation against PNC.

18. Maxim attached to the December 2, 2011 letter nine pages of claim charts for the ’510, ’880, ’013, and ’095 patents. In particular, for claims of the ’510 patent, Maxim alleged “infringement under joint infringement”; for claims of the ’880 patent, Maxim alleged “infringement under direct infringement”; and for claims of the ’013 and ’095 patents, Maxim alleged “infringement under joint infringement, contributory infringement and inducement.”

19. Maxim also attached to the December 2, 2011 letter a 33-page document entitled “Analysis of PNC Mobile Banking Software Application.” Maxim stated that it analyzed the PNC mobile banking software application to show that “the PNC bank infringes certain claims within Maxim patents.” In addition, Maxim stated that “[t]his document is referenced by the

claim charts, provided herewith, showing the PNC mobile banking application, server structures and processes, and overall system architecture infringe a diverse set of claims within the Maxim patent portfolio.”

20. Maxim’s letter, together with the detailed attachments alleging patent infringement, is a further clear and unmistakable threat of litigation against PNC.

21. As of the filing of this First Amended Complaint, Maxim has filed suit against, or had a declaratory judgment action filed against it after threatening suit by, a total of 51 parties ("Opposing Parties"). All of these Actions, including this Action, are the subject of Multi-District Litigation No. 12-mc-00244-JFC in the Western District of Pennsylvania ("MDL Proceeding"). Maxim has alleged infringement of the '510, '880, '013 and '095 Patents by each of the Opposing Parties in the MDL Proceeding based upon each Opposing Party's mobile phone applications.

22. Attached to Maxim’s demand letter was documentation showing that Maxim had obtained proprietary information belonging to PNC by attempting to access its secured server and by decompiling its mobile application.

23. PNC, in reviewing the pre-filing investigation letter and the attachments provided by Maxim, realized that these materials contained information that was unavailable to the public and proprietary to PNC. In response to this unauthorized access, PNC spent valuable time and resources to determine the extent of the unauthorized access, including determining who accessed the site, when the site was accessed, the scope of the access, and what steps needed to be taken, if any, to safeguard against this again. The amount spent by PNC for purposes of this investigation exceeds five thousand dollars (\$5000.00).

24. PNC alleges the following on information and belief:

a. A third party, ProgForce, was hired by or on behalf of Maxim to access PNC's proprietary computer systems. This third party worked at the direction of Maxim's counsel. In particular, the third party individual who attempted to access PNC's servers used the fake login name of "dimatk" and has been identified by Maxim as Dmitry Tkachuk.

b. It thus appears that Maxim, without any legitimate business purpose or authorization from PNC, and acting through a third party agent, used a fake password and login in an attempt to gain access to PNC's proprietary computer systems. Maxim's letter to PNC included screenshots that documented the actions of the third party agent, including evidence of the software used and the agent's presence on the PNC server. PNC, upon learning this, commenced an immediate investigation as to the extent of Maxim's unauthorized access.

c. Utilizing common network packet analyzing software, Paros and Wireshark, as software described above, Maxim's third party agent decompiled the source code of PNC's proprietary software, watched communication taking place on PNC's networks, and manipulated source code during communications to determine what information was required for logging in.

d. This third party agent obtained PNC's proprietary information about its computer systems and mobile application, none of which was available to the general public. Maxim adopted this third party's actions as its own and held its agent out as possessing power to act on Maxim's behalf. In the documents it sent to PNC, Maxim stated that it had "analyzed the PNC mobile software" and that its analysis included "downloading and decompiling the mobile software, analyzing packets exchanged

between the mobile handset and stores server, and de-encrypting network traffic transmitted from PNC's server[.]” Maxim has subsequently noted that ProgForce worked “at the direction of Maxim’s counsel” to conduct its alleged analysis.

25. In response to this unauthorized access, PNC spent valuable time and resources to determine the extent of the unauthorized access, including determining who accessed the site, when the site was accessed, the scope of the access, and what steps needed to be taken, if any, to safeguard against this access again. The amount spent by PNC for purposes of this investigation exceeds five thousand dollars (\$5,000.00).

COUNT I: DECLARATORY JUDGMENT OF NON-INFRINGEMENT

26. PNC incorporates the preceding paragraphs as if fully set forth herein.

27. PNC has not directly infringed, and does not directly infringe, any claim of the '510, '880, '013, and '095 patents.

28. PNC has not jointly infringed, and does not currently jointly infringe, any claim of the '510, '880, '013, and '095 patents.

29. PNC has not contributorily infringed, and does not currently contributorily infringe, any claim of the '510, '880, '013, and '095 patents.

30. PNC has not induced, and does not currently induce, any infringement of any claim of the '510, '880, '013, and '095 patents.

31. PNC is entitled to a declaration pursuant to 28 U.S.C. §§ 2201 and 2202 that PNC does not infringe any claim of the '510, '880, '013, and '095 patents.

COUNT II: DECLARATORY JUDGMENT OF INVALIDITY

32. PNC incorporates the preceding paragraphs as if fully set forth herein.

33. The claims of each of the '510, '880, '013, and '095 patents are invalid under Title 35 of the United States Code, including but not limited to §§ 101, 102, 103 and/or 112.

34. PNC is entitled to a declaration pursuant to 28 U.S.C. §§ 2201 and 2202 that the claims of the '510, '880, '013, and '095 patents are invalid.

COUNT III: VIOLATION OF THE COMPUTER FRAUD AND ABUSE ACT

35. PNC incorporates the preceding paragraphs as if fully set forth herein.

36. As a financial institution with an online presence, PNC uses its secured server in interstate and foreign commerce. PNC's server, therefore, is a protected computer under the Computer Fraud and Abuse Act, 18 U.S.C. § 1030(e)(2).

37. Acting through a third party agent, Maxim violated §§ 1030(a)(2)(C) and 1030(a)(4) of the Computer Fraud and Abuse Act when it, without authorization, or by exceeding the scope of authorization, attempted to access PNC's secured server and obtained PNC's proprietary information.

38. Maxim knowingly, intentionally, willfully, and for the purpose of financial gain and with intent to defraud manipulated network protocol and sent and received unauthorized commands to and from PNC's server, thereby accessing PNC's proprietary information.

39. Maxim also knowingly, intentionally, willfully, and for the purpose of financial gain and with intent to defraud accessed PNC's secured server by using packet sniffing software and de-encryption tools to monitor secure network traffic and de-encrypt communications from PNC's server.

40. By accessing PNC's server without authorization or by exceeding the scope of authorization, Maxim obtained valuable proprietary information belonging to PNC, including information regarding PNC's security measures and how PNC encrypts data on its secured network.

41. Maxim was not entitled to obtain PNC's proprietary information.

42. Maxim's unauthorized access of PNC's server caused PNC to suffer financial losses in the form of attorneys' fees and the time and efforts of its employees. These losses were incurred as PNC worked to determine the extent of Maxim's unauthorized access, and the kind of information Maxim obtained.

43. As a result of Maxim's unauthorized access, PNC has suffered losses of more than \$5,000.00.

COUNT IV: VIOLATION OF THE FEDERAL WIRETAP ACT

44. PNC incorporates the preceding paragraphs as if fully set forth herein.

45. Using a "man-in-the-middle" approach and acting through a third party agent, Maxim sent and received electronic communications to and from PNC's secured server in order to access and obtain information from PNC's server.

46. Maxim sent and received these electronic communications for the purpose of acts that violate the Computer Fraud and Abuse Act, 18 U.S.C. §§ 1030(a)(2)(C) and 1030(a)(4).

47. Maxim violated the Computer Fraud and Abuse Act by accessing PNC's secured server, sniffing secure network communication, and de-encrypting network communications from PNC's secured server.

48. Maxim also violated the Computer Fraud and Abuse Act by manipulating network commands and sending and receiving unauthorized commands to and from PNC's secured server in order to obtain information residing on the server.

49. By sending and receiving electronic communication to and from PNC's secured server for the purpose of acts that violate the Computer Fraud and Abuse Act, Maxim unlawfully intercepted electronic communications in violation of the Federal Wiretap Act, 18 U.S.C. §§ 2511(1)(a) and 2511(2)(d).

COUNT V:
VIOLATION OF THE DIGITAL MILLENNIUM COPYRIGHT ACT

50. PNC incorporates the preceding paragraphs as if fully set forth herein.

51. PNC's mobile application contains source code, which is an original work of authorship fixed in a tangible medium of expression. The source code to PNC's mobile application is PNC's copyrighted and proprietary material.

52. PNC's source code is protected by technological measures put in place by PNC to prevent others from accessing or copying its source code. These technological measures include the compiling of PNC's source code into object code that renders the source code inaccessible without the application of reverse engineering and decompilation technology.

53. Maxim, acting through a third party agent, used decompilation and reverse engineering tools to circumvent the technological measures put in place by PNC. The decompilation tools were designed or produced for this purpose.

54. By decompiling and reverse engineering PNC's mobile application and source code, Maxim accessed PNC's proprietary information, including its source code.

55. Maxim infringed or facilitated the infringement of PNC's rights under the Copyright Act.

56. Maxim's actions violate the Digital Millennium Copyright Act, 17 U.S.C. § 1201(a)(1)(A).

57. Maxim is vicariously liable under the Computer Fraud and Abuse Act, 18 U.S.C. §§ 1030(a)(2)(C) and 1030(a)(4); the Wiretap Act, 18 U.S.C. §§ 2511(1)(a) and 2511(2)(d); and the Digital Millennium Copyright Act, 17 U.S.C. § 1201(a)(1)(A).

PRAYER FOR RELIEF

WHEREFORE, PNC respectfully requests that this Court enter judgment in its favor as follows:

- a) declare that PNC has not directly infringed, and does not currently directly infringe, any claim of the '510, '880, '013, and '095 patents;
- b) declare that PNC has not jointly infringed, and does not currently jointly infringe, any claim of the '510, '880, '013, and '095 patents;
- c) declare that PNC has not contributorily infringed, and does not currently contributorily infringe, any claim of the '510, '880, '013, and '095 patents;
- d) declare that PNC has not induced, and does not currently induce, any infringement of any claim of the '510, '880, '013, and '095 patents;
- e) declare that the claims of the '510, '880, '013, and '095 patents are invalid;
- f) declare this to be an exceptional case and award PNC its costs, expenses, and disbursements in this action, including reasonable attorney fees, pursuant to 35 U.S.C. § 285;
- g) award PNC all damages provided under the Computer Fraud and Abuse Act, the Digital Millennium Copyright Act, and the Wiretap Act, including actual damages, statutory damages, punitive damages, costs, and attorneys' fees; and
- h) award PNC any further and additional relief that this Court deems just and proper.

JURY DEMAND

PNC requests a trial by jury on all issues so triable.

Dated: January 21, 2014

Respectfully submitted,

The PNC Financial Services Group, Inc.
and
PNC Bank, National Association

By: /s/ Lionel M. Lavenue

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CERTIFICATE OF SERVICE

I, Lionel M. Lavenue, Esquire, hereby certify that on January 21, 2014, I caused the foregoing to be electronically filed with the Clerk of Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

/s/ Lionel M. Lavenue

Lionel M. Lavenue, Esq.