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10 **UNITED STATES DISTRICT COURT**  
11 **SOUTHERN DISTRICT OF CALIFORNIA**

12 ESET, LLC,  
13 Plaintiff,  
14 v.  
15 FINJAN, INC.,  
16 Defendant.

Case No. 3:16-cv-01704-CAB-BGS

**FIRST AMENDED COMPLAINT FOR  
DECLARATORY JUDGMENT**

**JURY TRIAL DEMANDED**

1                   **FIRST AMENDED COMPLAINT FOR DECLARATORY JUDGMENT**

2                   Plaintiff ESET, LLC (“ESET” or “Plaintiff”), by and through its undersigned  
3 attorneys, for its First Amended Complaint for Declaratory Judgment against Finjan, Inc.  
4 (“Finjan” or “Defendant”), and demanding trial by jury, hereby alleges as follows:

5   **NATURE OF ACTION**

6                   1.       This is a declaratory judgment action seeking a declaration of non-  
7 infringement of U.S. Patent Nos. 6,154,844 (“the ’844 patent”), 6,804,780 (“the ’780  
8 patent”), 7,975,305 (“the ’305 patent”), 8,079,086 (“the ’086 patent”), 9,189,621 (“the  
9 ’621 patent”), and 9,219,755 (“the ’755 patent”) a true and correct copy of each of which  
10 are attached hereto as Exhibits 1-6.

11   **THE PARTIES**

12                   2.       ESET is a California Limited Liability Corporation having its principal place  
13 of business at 610 West Ash Street, Suite 1700, San Diego, California 92101.

14                   3.       On information and belief, Defendant Finjan is a Delaware corporation, with  
15 its principal place of business at 2000 University Avenue, Suite 600, East Palo Alto,  
16 California, 94303.

17   **JURISDICTION AND VENUE**

18                   4.       This Complaint arises under the Patent Laws of the United States, 35 U.S.C.  
19 § 100 *et seq.* and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, based upon  
20 an actual controversy between the parties to declare that ESET does not infringe any  
21 claim of the ’844, ’780, ’305, ’086, ’621, and ’755 patents.

22                   5.       This Court has jurisdiction over the subject matter of this claim pursuant to  
23 28 U.S.C. §§ 1331, 1338(a), 1367(a), 2201, and 2202, and 35 U.S.C. § 100, *et seq.*

24                   6.       This Court has personal jurisdiction over Finjan at least because of its  
25 continuous and systematic contacts with the State of California, including conducting of  
26 substantial and regular business therein through the enforcement and licensing of its  
27 intellectual property, including the ’844, ’780, ’305, ’086, ’621, and ’755 patents, to  
28 California corporations and business entities and individuals residing in California and/or

1 organized under the laws of the State of California.

2 7. Venue is proper in this District under 28 U.S.C. §§ 1391(b), (c), and  
3 1400(b).

4 **FACTUAL BACKGROUND**

5 8. Finjan and ESET have been in discussions since February 2015 regarding  
6 Finjan's threat of suit regarding its patent portfolio.

7 9. Finjan has brought a series of lawsuits against various companies concerning  
8 the '844, '780, '305, '086, '621, and '755 patents. *See Finjan, Inc. v. Blue Coat Systems,*  
9 *Inc.*, No. 5:15-cv-03295 (N.D. Cal.); *Finjan, Inc. v. Palo Alto Networks, Inc.*, No. 4:14-  
10 cv-04908 (N.D. Cal.); *Finjan, Inc. v. Symantec Corporation*, No. 3:14-cv-02998 (N.D.  
11 Cal.); *Finjan, Inc. v. Sophos, Inc.*, No. 3:14-cv-01197 (N.D. Cal.); *Finjan, Inc. v.*  
12 *Proofpoint, Inc.*, No. 3:13-cv-05808 (N.D. Cal.); *Finjan, Inc. v. Blue Coat Systems, Inc.*,  
13 No. 5:13-cv-03999 (N.D. Cal.); *Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-03133 (N.D.  
14 Cal.).

15 10. Through communications between the parties, Finjan has accused ESET of  
16 infringing claim 13 of the '305 patent. ESET has explained to Finjan that ESET does not  
17 infringe any claim of the '305 patent.

18 11. Finjan has accused ESET of infringing claims 1-44 of the '844 patent,  
19 claims 1-18 of the '780 patent, claims 1-25 of the '305 patent, claims 1-42 of the '086  
20 patent, claims 1-16 of the '621 patent, and claims 1-8 of the '755 patent. ESET denies  
21 that it infringes any claim of the '844, '780, '305, '086, '621, and '755 patents.

22 **PATENTS-IN-SUIT**

23 12. On its face, the '844 patent entitled "System and Method for Attaching a  
24 Downloadable Security Profile to a Downloadable" indicates it was issued by the United  
25 States Patent and Trademark Office on November 28, 2000.

26 13. According to the records at the United States Patent and Trademark Office,  
27 Finjan is the assignee of the '844 patent.

28 14. Finjan previously alleged in *Finjan, Inc. v. Blue Coat Systems, Inc.*, No.

1 5:15-cv-03295 (N.D. Cal.), *Finjan, Inc. v. Symantec Corporation*, No. 3:14-cv-02998  
2 (N.D. Cal.), *Finjan, Inc. v. Sophos, Inc.*, No. 3:14-cv-01197 (N.D. Cal.), *Finjan, Inc. v.*  
3 *Proofpoint, Inc.*, No. 3:13-cv-05808 (N.D. Cal.), *Finjan, Inc. v. Blue Coat Systems, Inc.*,  
4 No. 5:13-cv-03999 (N.D. Cal.), and *Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-03133  
5 (N.D. Cal.), that it has all substantial rights and interest to the '844 patent.

6 15. On its face, the '780 patent entitled "System and Method for Protecting a  
7 Computer and a Network from Hostile Downloadables" indicates it was issued by the  
8 United States Patent and Trademark Office on October 12, 2004.

9 16. According to the records at the United States Patent and Trademark Office,  
10 Finjan is the assignee of the '780 patent.

11 17. Finjan previously alleged in *Finjan, Inc. v. Palo Alto Networks, Inc.*, No.  
12 4:14-cv-04908 (N.D. Cal.), *Finjan, Inc. v. Sophos, Inc.*, No. 3:14-cv-01197 (N.D. Cal.),  
13 *Finjan, Inc. v. Blue Coat Systems, Inc.*, No. 5:13-cv-03999 (N.D. Cal.), and *Finjan, Inc.*  
14 *v. FireEye, Inc.*, No. 4:13-cv-03133 (N.D. Cal.), that it has all substantial rights and  
15 interest to the '780 patent.

16 18. On its face, the '305 patent entitled "Method and System for Adaptive Rule-  
17 Based Content Scanners for Desktop Computers" indicates it was issued by the United  
18 States Patent and Trademark Office on July 5, 2011.

19 19. According to the records at the United States Patent and Trademark Office,  
20 Finjan is the assignee of the '305 patent.

21 20. Finjan previously alleged in *Finjan, Inc. v. Proofpoint, Inc.*, No. 3:13-cv-  
22 05808 (N.D. Cal.) and *Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-3133 (N.D. Cal.), that it  
23 has all substantial rights and interest to the '305 patent.

24 21. On its face, the '086 patent entitled "Malicious Mobile Code Runtime  
25 Monitoring System and Methods" indicates it was issued by the United States Patent and  
26 Trademark Office on December 13, 2011.

27 22. According to the records at the United States Patent and Trademark Office,  
28 Finjan is the assignee of the '086 patent.

1 23. Finjan previously alleged in *Finjan, Inc. v. Blue Coat Systems, Inc.*, No.  
2 5:15-cv-03295 (N.D. Cal.), *Finjan, Inc. v. Proofpoint, Inc.*, No. 3:13-cv-05808 (N.D.  
3 Cal.), and *Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-03133 (N.D. Cal.), that it has all  
4 substantial rights and interest to the '086 patent.

5 24. On its face, the '621 patent entitled "Malicious Mobile Code Runtime  
6 Monitoring System and Methods" indicates it was issued by the United States Patent and  
7 Trademark Office on November 17, 2015.

8 25. According to the records at the United States Patent and Trademark Office,  
9 Finjan is the assignee of the '621 patent.

10 26. Finjan previously alleged in *Finjan, Inc. v. Blue Coat Systems, Inc.*, No.  
11 5:15-cv-03295 (N.D. Cal.), that it has all substantial rights and interest to the '621 patent.

12 27. On its face, the '755 patent entitled "Malicious Mobile Code Runtime  
13 Monitoring System and Methods" indicates it was issued by the United States Patent and  
14 Trademark Office on December 22, 2015.

15 28. According to the records at the United States Patent and Trademark Office,  
16 Finjan is the assignee of the '755 patent.

17 29. Finjan previously alleged in *Finjan, Inc. v. Blue Coat Systems, Inc.*, No.  
18 5:15-cv-03295 (N.D. Cal.), that it has all substantial rights and interest to the '755 patent.

19 **COUNT I**

20 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

21 **OF THE '844 PATENT**

22 30. ESET repeats and realleges Paragraphs 1-29 of its Complaint as if fully set  
23 forth herein.

24 31. Finjan has asserted that ESET has infringed claims 1-44 of the '844 patent.

25 32. ESET denies any claim of infringement of the claims of the '844 patent, and  
26 contends that it does not infringe any claim of the '844 patent. By way of example, the  
27 ESET products Finjan alleges infringe the '844 patent do not include at least linking the  
28 Downloadable to the Downloadable security profile before a web server makes the

1 Downloadable available to web clients for download as required by the claims of the '844  
2 patent.

3 33. An actual and justiciable controversy has thus arisen between Finjan and  
4 ESET concerning the alleged infringement of the '844 patent.

5 34. Pursuant to the Federal Declaratory Act, 28 U.S.C. § 2201, *et seq.*, ESET is  
6 entitled to judgment from this Court finding that the '844 patent is not infringed, directly  
7 or indirectly, by ESET.

8 **COUNT II**

9 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

10 **OF THE '780 PATENT**

11 35. ESET repeats and realleges Paragraphs 1-29 of its Complaint as if fully set  
12 forth herein.

13 36. Finjan has asserted that ESET has infringed claims 1-18 of the '780 patent.

14 37. ESET denies any claim of infringement of the claims of the '780 patent, and  
15 contends that it does not infringe any claim of the '780 patent. By way of example, the  
16 ESET products Finjan alleges infringe the '780 patent do not include at least “fetching at  
17 least one software component identified by the one or more references” and “performing  
18 a hashing function on the Downloadable and the fetched software components to generate  
19 a Downloadable ID” as required by the claims of the '780 patent.

20 38. An actual and justiciable controversy has thus arisen between Finjan and  
21 ESET concerning the alleged infringement of the '780 patent.

22 39. Pursuant to the Federal Declaratory Act, 28 U.S.C. § 2201, *et seq.*, ESET is  
23 entitled to judgment from this Court finding that the '780 patent is not infringed, directly  
24 or indirectly, by ESET.

25 **COUNT III**

26 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

27 **OF THE '305 PATENT**

28 40. ESET repeats and realleges Paragraphs 1-29 of its Complaint as if fully set

1 forth herein.

2 41. Finjan has asserted that ESET has infringed claims 1-25 of the '305 patent.

3 42. ESET denies any claim of infringement of the claims of the '305 patent, and  
4 contends that it does not infringe any claim of the '305 patent. By way of example, the  
5 ESET products Finjan alleges infringe the '305 patent do not include at least "a database  
6 of parser and analyzer rules" as required by the claims of the '305 patent.

7 43. An actual and justiciable controversy has thus arisen between Finjan and  
8 ESET concerning the alleged infringement of the '305 patent.

9 44. Pursuant to the Federal Declaratory Act, 28 U.S.C. § 2201, *et seq.*, ESET is  
10 entitled to judgment from this Court finding that the '305 patent is not infringed, directly  
11 or indirectly, by ESET.

12 **COUNT IV**

13 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

14 **OF THE '086 PATENT**

15 45. ESET repeats and realleges Paragraphs 1-29 of its Complaint as if fully set  
16 forth herein.

17 46. Finjan has asserted that ESET has infringed claims 1-42 of the '086 patent.

18 47. ESET denies any claim of infringement of the claims of the '086 patent, and  
19 contends that it does not infringe any claim of the '086 patent. By way of example, the  
20 ESET products Finjan alleges infringe the '086 patent do not include at least "appending  
21 a representation of the Downloadable security prolife data to the Downloadable, to  
22 generate an appended Downloadable" as required by claims 1-16, 31-34, and 39-40 of the  
23 '086 patent, and at least "transmitting the Downloadable and a representation of the  
24 Downloadable security profile data to a destination computer via a transport protocol  
25 transmission" as required by claims 17-30, 35-38, and 41-42 of the '086 patent.

26 48. An actual and justiciable controversy has thus arisen between Finjan and  
27 ESET concerning the alleged infringement of the '086 patent.

28 49. Pursuant to the Federal Declaratory Act, 28 U.S.C. § 2201, *et seq.*, ESET is

1 entitled to judgment from this Court finding that the '086 patent is not infringed, directly  
2 or indirectly, by ESET.

3 **COUNT V**

4 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

5 **OF THE '621 PATENT**

6 50. ESET repeats and realleges Paragraphs 1-29 of its Complaint as if fully set  
7 forth herein.

8 51. Finjan has asserted that ESET has infringed claims 1-16 of the '621 patent.

9 52. ESET denies any claim of infringement of the claims of the '621 patent, and  
10 contends that it does not infringe any claim of the '621 patent. By way of example, the  
11 ESET products Finjan alleges infringe the '621 patent do not include at least “a first  
12 comparator coupled to the plurality of operating system probes for comparing  
13 information pertaining to the downloadable against a predetermined security policy,  
14 wherein the information pertaining to the downloadable includes information pertaining  
15 to an operation of the downloadable and distinct from information pertaining to the  
16 request” as required by claims 1-9 of the '621 patent, and at least “a comparator coupled  
17 to the plurality of operating system probes for comparing information pertaining to the  
18 Downloadable against a predetermined security policy” as required by claims 11-16 of  
19 the '621 patent.

20 53. An actual and justiciable controversy has thus arisen between Finjan and  
21 ESET concerning the alleged infringement of the '621 patent.

22 54. Pursuant to the Federal Declaratory Act, 28 U.S.C. § 2201, *et seq.*, ESET is  
23 entitled to judgment from this Court finding that the '621 patent is not infringed, directly  
24 or indirectly, by ESET.

25 **COUNT VI**

26 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

27 **OF THE '755 PATENT**

28 55. ESET repeats and realleges Paragraphs 1-29 of its Complaint as if fully set

1 forth herein.

2 56. Finjan has asserted that ESET has infringed claims 1-8 of the '755 patent.

3 57. ESET denies any claim of infringement of the claims of the '755 patent, and  
4 contends that it does not infringe any claim of the '755 patent. By way of example, the  
5 ESET products Finjan alleges infringe the '755 patent do not include at least "a request  
6 broker for receiving a notification message from the downloadable engine regarding the  
7 extension call" as required by the claims of the '755 patent.

8 58. An actual and justiciable controversy has thus arisen between Finjan and  
9 ESET concerning the alleged infringement of the '755 patent.

10 59. Pursuant to the Federal Declaratory Act, 28 U.S.C. § 2201, *et seq.*, ESET is  
11 entitled to judgment from this Court finding that the '755 patent is not infringed, directly  
12 or indirectly, by ESET.

13 **DEMAND FOR JURY TRIAL**

14 ESET demands a jury trial on all issues so triable.

15 **PRAAYER FOR RELIEF**

16 WHEREFORE, ESET prays as follows:

17 A. Declare that ESET has not infringed any claim of the '844, '780, '305, '086,  
18 '621, and '755 patents;

19 B. Enjoin Finjan, its assigns, and all those in privity therewith from asserting  
20 any of the claims of the '844, '780, '305, '086, '621, and '755 patents against ESET or  
21 any of its customers or suppliers;

22 C. Find this case an exceptional case and award ESET its fees and costs in this  
23 suit under 35 U.S.C. § 285; and

24 D. For such other and further relief as the Court may deem just and proper.

1 Dated: July 11, 2016  
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4

Respectfully submitted,  
FOLEY & LARDNER LLP

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