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7 Attorneys for Plaintiff  
PROOFPOINT, INC.

8  
9 UNITED STATES DISTRICT COURT  
10 NORTHERN DISTRICT OF CALIFORNIA

11 PROOFPOINT, INC.,

12 Plaintiff,

13 v.

14 INNOVA PATENT LICENSING, LLC,

15 Defendant.  
16

Case No. CV 11-02288 LHK

**PLAINTIFF PROOFPOINT, INC.’S  
AMENDED COMPLAINT FOR  
DECLARATORY JUDGMENT**

17  
18 Plaintiff Proofpoint, Inc. (“Proofpoint”), by and through its attorneys, alleges as follows:

19 **INTRODUCTION**

20 1. This is a civil action arising under the patent laws of the United States, 35 U.S.C.  
21 §§ 101, *et seq.*, seeking declaratory judgment that United States Patent No. 6,018,761 (the “’761  
22 Patent”) is invalid and not infringed by Proofpoint. Proofpoint brings this action to protect its  
23 email security products and services, including its Proofpoint Protection Server and the Proofpoint  
24 Enterprise Protection™, Proofpoint Messaging Security Gateway™, Proofpoint on Demand™, and  
25 Proofpoint Spam Detection™ products and services (the “Accused Proofpoint Products”) from  
26 defendant InNova Patent Licensing, LLC’s (“InNova”) claims that Proofpoint’s products and  
27 services infringed United States Patent No. 6,018,761 (the “’761 Patent”). A true and correct copy  
28 of the ’761 Patent is attached hereto as Exhibit A, and made a part hereof.



1 claims this action, which arise under the patent laws of the United States, pursuant to 28 U.S.C. §§  
2 1331, 1338(a) 2201, and 2201.

3           7.       On July 20, 2010, InNova filed the Texas Action in the United States District Court  
4 for the Eastern District of Texas. On March 19, 2011, InNova filed its First Amended Complaint  
5 alleging, *inter alia*, that certain customers of Proofpoint have infringed and are infringing the '761  
6 Patent by using one or more of the aforementioned Accused Proofpoint Products. More  
7 specifically, InNova alleges that American International Group ("AIG"), Rent-A-Center, Inc.  
8 ("RAC"), and Wells Fargo & Company ("Wells Fargo") infringe the '761 Patent by using one or  
9 more Accused Proofpoint Products. InNova thus contends that the Accused Proofpoint Products  
10 themselves are infringing products. In spite of these allegations implicating the Accused  
11 Proofpoint Products, InNova did not include Proofpoint as a defendant in the Texas Action. In  
12 view of the fact that Proofpoint makes, sells, and offers for sale the Accused Proofpoint Products,  
13 the Texas Action has triggered indemnity requests by Proofpoint's customers. A true and correct  
14 copy of InNova's First Amended Complaint is attached hereto as Exhibit B.

15           8.       Proofpoint denies that the '761 Patent is or has been infringed through the  
16 manufacture, use, sale, offer for sale, or importation of (i) any product or service – including the  
17 Accused Proofpoint Products – by Proofpoint or (ii) any Proofpoint product or service by its  
18 customers.

19           9.       Proofpoint further contends that the '761 Patent is invalid.

20           10.      InNova's infringement allegations threaten actual and imminent injury to Proofpoint  
21 that can be redressed by judicial relief, and that injury is of sufficient immediacy and reality to  
22 warrant the issuance of a declaratory judgment. Such injury includes, among other things, (1)  
23 uncertainty as to whether manufacture, use, offer for sale, sale, or importation of the Accused  
24 Proofpoint Products is free from infringement claims based on the '761 Patent, (2) the injury to  
25 Proofpoint's efforts to market and sell its products and services including the Accused Proofpoint  
26 Products resulting from the Texas Action and the threat that other of Proofpoint's customers will be  
27 sued, and (3) the legal obligations flowing from Proofpoint's indemnity commitments to its  
28 customers.



1 within this judicial district, and Mr. Uomini owns the Fractal Images Company, which is also  
2 located at 62 Lenox Road, Kensington, California 94707.

3 16. On information and belief, Mr. Uomini attempted to monetize, enforce, and/or  
4 license the '761 Patent prior to forming InNova. On information and belief, Robert Uomini offered  
5 to sell the '761 Patent through Ocean Tomo Auctions LLC at The Ocean Tomo Spring 2009 Live  
6 IP Auction and Conference on March 27, 2009 in San Francisco, California. On information and  
7 belief, the formation of InNova represents a continuation and extension of Mr. Uomini's previous  
8 attempts to monetize, enforce, and/or license the '761 Patent and is believed to be a mere  
9 instrumentality of Mr. Uomini.

10 17. On information and belief, InNova acts as an agent and alter-ego of Mr. Uomini  
11 because he has sought to monetize, enforce, and/or license the '761 Patent by and through InNova.  
12 According to public patent assignment records maintained by the United States Patent and  
13 Trademark Office, Robert Uomini assigned the '761 Patent to InNova on June 24, 2010 and  
14 recorded this assignment on July 6, 2010 – just two weeks prior to the filing of the Texas Action.  
15 On information and belief, InNova's sole business activities are related to monetizing, enforcing  
16 and/or licensing the '761 Patent.

17 18. On information and belief, InNova acts as an agent and alter-ego of Robert Uomini  
18 because, among other things, Mr. Uomini directs, controls, and coordinates these activities from his  
19 home in Kensington, California and Mr. Uomini has been responsible for paying maintenance fees  
20 for the '761 Patent. According to the records maintained by the United States Patent and  
21 Trademark Office ("USPTO"), Mr. Uomini paid the 12th year maintenance fee on April 4, 2011.  
22 Before incorporating InNova, Mr. Uomini registered the InNova's website's domain name of  
23 www.innovapatentlicensing.com. According to records maintained by Network Solutions, this  
24 domain name was registered to The Fractal Images Company on May 26, 2010, which is believed  
25 to be an agent and alter-ego of Mr. Uomini.

26 19. On information and belief, Mr. Uomini incorporated InNova for the sole purpose of  
27 filing the Texas Action. According to records from the Texas Secretary of State, InNova's  
28 corporate formation documents were filed on June 9, 2010, less than six weeks before filing the

1 Texas Action. On information and belief, the formation and registration of InNova as a Texas  
2 company appears to have been effected for no other purpose than “creating” jurisdiction for the  
3 Texas Action. On information and belief, Mr. Uomini and InNova named twelve Customer  
4 Defendants who are residents of the Eastern District of Texas for the purpose of pursuing a  
5 favorable venue for the Texas Action. On information and belief, neither Robert Uomini nor  
6 InNova had or has any meaningful contacts with Texas other than the facts that InNova was  
7 incorporated in Texas and that InNova filed the Texas Action.

8 20. On information and belief, Robert Uomini as principal and alter-ego of InNova, took  
9 substantial actions in preparing for litigation in California prior to the filing of the Texas action.

10 21. On information and belief, Robert Uomini is subject to general and specific  
11 jurisdiction in this judicial district in light of his substantial, continuous, and systematic contacts  
12 with California and this judicial district. On information and belief, Mr. Uomini is a resident of this  
13 judicial district and he owns and operates business entities in this judicial district, including The  
14 Fractal Images Company and ChiaraMail. On information and belief, ChiaraMail offers a Dynamic  
15 Mail Content product whose End-User License Agreement specifies that the license shall be  
16 governed by the laws of the State of California.

17 22. On information and belief, Mr. Uomini purposefully, systematically, and  
18 continuously directs activities in California and this judicial district, including directing,  
19 controlling, and coordinating its activities relating to enforcement of the '761 Patent against  
20 residents of this judicial district as outlined above. On information and belief, Mr. Uomini has  
21 purposefully directed actions toward California and residents of this judicial district as outlined  
22 above.

### 23 VENUE

24 23. Venue in this District is proper under 28 U.S.C. §§ 1391(b) and (c) because a  
25 substantial part of the events giving rise to the claims occurred in this judicial district and because  
26 InNova is subject to personal jurisdiction in this judicial district. One of the products at issue in the  
27 Texas Action is a hosted email security service, Proofpoint on Demand™, which is a product  
28 hosted and operated by Proofpoint in this judicial district. Therefore, use of Proofpoint on

1 Demand™ occurs within this judicial district and venue is proper. Additionally, InNova is subject  
2 to personal jurisdiction in this judicial district as outlined above.

3 **INTRA-DISTRICT ASSIGNMENT**

4 24. For the purposes of Civil L.R. 3-2(c), this Intellectual Property action may be  
5 assigned to any division of this District.

6 **FIRST CLAIM**

7 **(Non-Infringement of United States Patent No. 6,018,761)**

8 25. Proofpoint incorporates paragraphs 1-23 above as if fully set forth herein.

9 26. An actual, immediate, and justiciable case or controversy exists between Proofpoint  
10 and InNova as to Proofpoint's alleged infringement of the claims of the '761 Patent.

11 27. Proofpoint does not and has not infringed, directly or indirectly, willfully or  
12 otherwise, any valid and enforceable claim of the '761 Patent, either literally or under the doctrine  
13 of equivalents.

14 28. On information and belief, InNova is precluded under the doctrine of prosecution  
15 history estoppel from asserting or construing, whether literally or by the doctrine of equivalents,  
16 any claim of the '761 Patent in a way that would read upon any product or service made, used, sold,  
17 offered for sale, or imported by Proofpoint.

18 **SECOND CLAIM**

19 **(Invalidity of United States Patent No. 6,018,761)**

20 29. Proofpoint incorporates paragraphs 1-23 above as if fully set forth herein.

21 30. An actual, immediate, and justiciable case or controversy exists between Proofpoint  
22 and InNova as to validity of the claims of the '761 Patent.

23 31. On information and belief, the claims of the '761 Patent are invalid for failure to  
24 meet one or more conditions of patentability specified in Title 35 of the United States Code,  
25 including but not limited to 35 U.S.C. §§ 41, 101, 102, 103, 112, 115, 116 and/or 256.

26 **PRAYER FOR RELIEF**

27 WHEREFORE, Proofpoint prays for judgment as follows:

28 1. Declaring that Proofpoint and its customers have not infringed and are not

1 infringing, directly, indirectly or contributorily, any valid and enforceable claim of the '761 Patent;

2 2. Declaring that each of the claims of the '761 Patent is invalid;

3 3. Declaring that each of the claims of the '761 Patent is unenforceable and/or barred;

4 4. Ordering that InNova and each of its officers, employees, agents, alter egos,  
5 attorneys, and any person in active concert or participation with them be restrained and enjoined  
6 from further prosecuting or instituting any action against Proofpoint or its customers claiming that  
7 the '761 Patent is valid, enforceable, or infringed, or from representing that any of Proofpoint's  
8 products or services, or others' use thereof, infringes the '761 Patent;

9 5. Declaring this case exceptional under 35 U.S.C. § 285 and awarding Proofpoint its  
10 attorneys' fees and costs in connection with this case; and

11 6. Awarding Proofpoint such other and further relief as the Court deems just and  
12 proper.

13

14 Dated: June 23, 2011

CARR & FERRELL *LLP*

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By           /s/ Robert J. Yorio            
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Attorneys for Plaintiff  
PROOFPOINT, INC.

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