

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

CONSTANT CONTACT, INC.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. _____
)	
UMBANET, INC.,)	JURY TRIAL DEMANDED
)	
Defendant.)	

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Constant Contact, Inc. (“Constant Contact”) files this complaint for declaratory judgment against Defendant Umbanet, Inc. (“Umbanet”) and alleges as follows:

PARTIES

1. Constant Contact is a Delaware corporation, with its principal place of business located at 1601 Trapelo Road, Waltham, MA, 02451.
2. Umbanet is a Delaware corporation, with its principal place of business located at 325 Riverside Drive, New York, NY, 10025.

NATURE OF THE CASE

3. Plaintiff seeks a declaratory judgment that U.S. Patent Nos. 7,076,730 (“the ’730 Patent,” attached as Ex. A) and 7,444,374 (“the ’374 Patent,” attached as Ex. B) are invalid and are not infringed by the use of Plaintiff’s Email Marketing and other commercial email services. The relief sought is necessary because Defendant has sued one of Plaintiff’s customers, Englewood Wine Merchants, in the United States District Court for the District of New Jersey, alleging that Englewood Wine Merchants has infringed the ’730 and ’374 Patents. (Case 1:12-cv-05849-RMB-KMW (D.N.J.)) Plaintiff’s customers, including Englewood Wine Merchants, use Plaintiff’s Email Marketing product and other commercial email services to market their own

products and services. Umbanet's lawsuit against Englewood Wine Merchants has placed a cloud over Plaintiff's Email Marketing and other commercial email services, has caused at least one of Plaintiff's customers to seek relief from Plaintiff, and has created a justiciable controversy between Constant Contact and Umbanet.

FACTUAL BACKGROUND

4. Constant Contact provides an Email Marketing product and other commercial email services to its customers. Constant Contact's Email Marketing product and other commercial email services allow its customers to create materials which may be distributed electronically to recipients.

5. Englewood Wine Merchants ("EWM") is the business name of one of Plaintiff's customers that subscribes to the Email Marketing service. The actual customer of Plaintiff is Gettenberg & Wellisch, L.L.C., which operates under the business name Englewood Wine Merchants, and which operates the Englewood Wine Merchants email service accused of infringement. On information and belief, Umbanet believes that by suing in the name of the EWM business, it has successfully sued Plaintiff's customer. For convenience, throughout the remainder of this Complaint, "EWM" refers to both the customer of Plaintiff, and the entity sued by Umbanet, even though one is an actual business and one is an assumed name for the actual business.

6. On September 18, 2012, Umbanet filed a complaint against EWM in the United District Court for the District of New Jersey, alleging that EWM has infringed the '730 and '374 Patents "by marketing or causing to have their products and services marked to consumers, within this [District of New Jersey] judicial district, using systems and methods that fall under the scope of the claims of the '730 and the '374 Patents." (Case 1:12-cv-05849-RMB-KMW, D.I. 1, at ¶ 10.).

7. Umbanet has filed other lawsuits against other defendants asserting the same '730 and '374 Patents, and on information and belief, intends to file many more lawsuits on these same patents, including against Constant Contact's customers.

8. In its complaint against EWM, Umbanet attached an exhibit that purports to "set[] forth an example of an infringing email and associated source code that falls within the scope of the '730 and '374 Patents." (Case 1:12-cv-05849-RMB-KMW, D.I. 1, at ¶ 11.) Said exhibit reproduces an email newsletter that counsel for Umbanet received from EWM, as well as associated source code. On its face, said exhibit indicates that the email newsletter was created using Constant Contact's commercial email services.

9. EWM has sought indemnity and defense from Constant Contact in connection with Umbanet's lawsuit against EWM.

JURISDICTION AND VENUE

10. The Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 2201, 1331 and 1338(a) because this action arises under the patent laws, and seeks relief under the Federal Declaratory Judgment Act.

11. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391 (b) and (c) because Umbanet is a Delaware corporation.

12. Based upon information and belief, Umbanet's purpose is to assert the '730 and '374 Patents against Constant Contact's customers in an effort to obtain licensing royalties from the use of Constant Contact's commercial email services.

13. This Declaratory Judgment action presents an actual case or controversy because the acts of Umbanet have created in Constant Contact a reasonable apprehension that, as a result of Constant Contact's continuing manufacture, use, and sale of its Email Marketing product and other commercial email services, Constant Contact and its customers will be sued

for infringement of the '730 and '374 Patents. In addition, Constant Contact fears that it will suffer commercial injury if Umbanet continues to sue, and threaten to sue, Constant Contact's customers, as those customers will consequently seek indemnity and defense from Constant Contact. Furthermore, those customers will be dissuaded from purchasing and using Constant Contact's Email Marketing product and other commercial email services.

FIRST CLAIM FOR RELIEF

(Declaratory Judgment of Patent Invalidity of the '730 Patent – 35 U.S.C. §§ 101 *et seq.*)

14. Plaintiff repeats the allegations in the preceding paragraphs as if fully set forth in this paragraph.

15. The '730 Patent is invalid for failure to comply with the requirements of Title 35 of the United States Code, including, without limitation, one or more of §§ 101, 102, 103, and 112. On information and belief, the claims are anticipated and/or obvious in light of prior art references such as *the MOS Multimedia E-Mail System* by M. Ouhyoung, et al., published in 1994, which discloses sending and receiving emails containing non-text content over the Internet, in the manner claimed by the '730 Patent. On information and belief, one or more limitations of the '730 Patent claims fails to satisfy the requirements of 35 U.S.C. § 112, including, without limitation, one or more of the following limitations are indefinite, lack written description, and/or are not adequately enabled by the specification: “encoding means for automatically encoding [said] representation[s] created with said authoring components into an [Internet-compatible] email message” (claims 1, 12, 24, 25); “decoding means for automatically decoding said representation encoded [with] [by] said encoding means” (claims 1, 12, 24, 25); “linking the document-authoring component with the document encoding component” (claim 19).

16. The '730 Patent is invalid because, among other things, there is prior art, not considered by the U.S. Patent and Trademark Office in issuing the patent, that anticipates the claims.

17. Plaintiff seeks and is entitled to a declaratory judgment that the '730 Patent is invalid.

SECOND CLAIM FOR RELIEF
(Declaratory Judgment of Non-Infringement of the '730 Patent)

18. Plaintiff repeats the allegations in the preceding paragraphs as if fully set forth in this paragraph.

19. Plaintiff seeks and is entitled to a declaratory judgment that the use of Plaintiff's Email Marketing product by Plaintiff's customers to send emails does not constitute an infringement of any valid claim of the '730 Patent.

THIRD CLAIM FOR RELIEF
(Declaratory Judgment of Patent Invalidity of the '374 Patent – 35 U.S.C. §§ 101 *et seq.*)

20. Plaintiff repeats the allegations in the preceding paragraphs as if fully set forth in this paragraph.

21. The '374 Patent is invalid for failure to comply with the requirements of Title 35 of the United States Code, including, without limitation, one or more of §§ 101, 102, 103, and 112.

22. The '374 Patent is invalid because, among other things, there is prior art, not considered by the U.S. Patent and Trademark Office in issuing the patent, that anticipates the claims. On information and belief, the claims are anticipated and/or obvious in light of prior art references such as *Lotus Notes Release 4.5: A Developer's Handbook* by IBM, published in 1996, which discloses hiding certain information from viewers. On information and belief, one

or more limitations of the '374 Patent claims fails to satisfy the requirements of 35 U.S.C. § 112, including, without limitation, one or more of the following limitations are indefinite, lack written description, and/or are not adequately enabled by the specification: “encoding means for automatically encoding representations created with said authoring/reading components into an Internet-compatible email message” (claim 11); “decoding means for automatically decoding said representation encoded by said encoding means” (claim 11).

23. Plaintiff seeks and is entitled to a declaratory judgment that the '374 Patent is invalid.

FOURTH CLAIM FOR RELIEF
(Declaratory Judgment of Non-Infringement of the '374 Patent)

24. Plaintiff repeats the allegations in the preceding paragraphs as if fully set forth in this paragraph.

25. Plaintiff seeks and is entitled to a declaratory judgment that the use of Plaintiff's Email Marketing product by Plaintiff's customers to send emails does not constitute an infringement of any valid claim of the '374 Patent.

REQUEST FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that this Court enter judgment in its favor and against Defendant, granting the following relief:

A. For judgment that the '730 Patent, and each of the claims therein, are invalid;

B. For judgment that customers of Plaintiff's Email Marketing product and other commercial email services, including Englewood Wine Merchants sued in the U.S. District Court for the District of New Jersey, do not infringe any valid claim of the '730 Patent;

C. For a preliminary and permanent injunction precluding Defendant, its officers, directors, employees, agents, and all other persons acting in concert or participation with them from suing for infringement or otherwise asserting infringement of the '730 Patent against customers of Plaintiff's Email Marketing product or other commercial email services.

D. For judgment that the '374 Patent, and each of the claims therein, are invalid;

E. For judgment that customers of Plaintiff's Email Marketing product and other commercial email services, including Englewood Wine Merchants sued in the U.S. District Court for the District of New Jersey, do not infringe any valid claim of the '374 Patent;

F. For a preliminary and permanent injunction precluding Defendant, its officers, directors, employees, agents, and all other persons acting in concert or participation with them, from suing for infringement or otherwise asserting infringement of the '374 Patent against customers of Plaintiff's Email Marketing product or other commercial email services.

G. For costs and reasonable attorneys' fees incurred in connection with this action; and

H. For such other and further relief as the Court deems just.

JURY DEMAND

Plaintiff demands a jury trial as to all issues that are triable by a jury in this action.

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