

1 SPENCER HOSIE (CA Bar No. 101777)
shosie@hosielaw.com
2 BRUCE WECKER (CA Bar No. 078530)
bwecker@hosielaw.com
3 GEORGE F. BISHOP (CA Bar No. 89205)
gbishop@hosielaw.com
4 DIANE S. RICE (CA Bar No. 118303)
drice@hosielaw.com
5 HOSIE RICE LLP
6 188 The Embarcadero, Suite 750
San Francisco, CA 94105
7 (415) 247-6000 Tel.
8 (415) 247-6001 Fax

9 *Attorneys for Plaintiff*
BACKWEB TECHNOLOGIES, LTD.

10
11 UNITED STATES DISTRICT COURT
12 FOR THE NORTHERN DISTRICT OF CALIFORNIA

13
14 BACKWEB TECHNOLOGIES, LTD.,

15 Plaintiff,

16 v.

17 HEWLETT-PACKARD COMPANY,

18 Defendant.
19
20
21
22
23
24
25
26
27
28

ORIGINAL
FILED

SEP 23 2010

RICHARD W. WIENING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

E-filing

PVT

Case No. **CV 10-4311**

ORIGINAL COMPLAINT AND
DEMAND FOR JURY TRIAL

1 Plaintiff BackWeb Technologies, LTD. ("BackWeb" or "Plaintiff") hereby files its
2 complaint against Defendant Hewlett-Packard Company ("HP" or "Defendant"), for patent
3 infringement. For its complaint, Plaintiff alleges, on personal knowledge as to its own acts
4 and on information and belief as to all other matters, as follows:

5 **PARTIES**

6 1. BackWeb is a corporation organized under the laws of the State of Israel, and
7 has its principal place of business in Rosh Ha'ayin, Israel. BackWeb's wholly owned
8 subsidiary, BackWeb Technologies, Inc. maintains its principal office in Santa Clara,
9 California. BackWeb is and at all pertinent times was the assignee and owner of the patents
10 at issue in this case.

11
12 2. HP is a corporation organized under the laws of the State of Delaware, with its
13 principal place of business in Palo Alto, California.

14 **JURISDICTION AND VENUE**

15
16 3. This complaint asserts a cause of action for patent infringement under the
17 Patent Act, 35 U.S.C. § 271. This Court has subject matter jurisdiction over this matter by
18 virtue of 28 U.S.C. § 1338(a). Venue is proper in this Court by virtue of 28 U.S.C. § 1391(b)
19 and (c) and 28 U.S.C. § 1400(b), in that Defendant HP may be found in this district, has
20 committed acts of infringement in this district, and a substantial part of the events or
21 omissions giving rise to the claim occurred and a substantial part of property that is the
22 subject of the action is situated in this district.

23
24 4. This Court has personal jurisdiction over Defendant HP because it has a place
25 of business in, and provides infringing products and services in, the Northern District of
26 California.

INTRADISTRICT ASSIGNMENT

1
2 5. Pursuant to Civil LR 3-2(c), this case should be subject to district-wide
3 assignment because it is an Intellectual Property Action.

BACKGROUND

The BackWeb Patents

4
5
6 6. Plaintiff owns a patent, U.S. Patent No. 5,913,040 (“’040 Patent”), issued on
7 June 15, 1999, to inventors Yuval Rakavy and Eli Barkat. A true and correct copy of the
8 ’040 Patent is attached as Exhibit “A” and is incorporated herein by reference. Plaintiff is
9 the legal and rightful owner of the ’040 Patent.
10

11 7. The ’040 Patent contains fourteen (14) patent claims covering unique and
12 novel methods and processes for transmitting digital information in background mode over a
13 communications link between a computer network and a local computer and throttling the
14 transfer speed to create minimal interference with other processes communicating over the
15 communications link. The digital information described in the patent could be in a variety of
16 forms, including, but not limited to, news, weather, stock quotes, sports scores, software
17 updates or trip reservation information.
18

19 8. Plaintiff also owns two continuation patents, U.S. Patent No. 6,317,789 (“’789
20 Patent”) and U.S. Patent No. 6,539,429 (“’429 Patent”), issued on November 13, 2001 and
21 March 25, 2003, respectively. A true and correct copy of the ’789 Patent is attached as
22 Exhibit “B” and is incorporated herein by reference. Plaintiff is the legal and rightful owner
23 of the ’789 Patent. A true and correct copy of the ’429 Patent is attached as Exhibit “C” and
24 is incorporated herein by reference. Plaintiff is the legal and rightful owner of the ’429
25 Patent. The two continuation patents contain twenty-eight (28) patent claims covering
26 unique and novel methods, processes and systems for transmitting digital information in
27
28

1 background mode over a communications link between a computer network and a local
2 computer with minimal interference with other processes communicating over the
3 communications link. Plaintiff's three patents in this patent family will be referred to herein
4 as its Transparent Update Patents.

5 **HP's Infringing Goods and Services**

6 9. HP distributes and sells software for the management of enterprise computer
7 systems called HP Client Automation that facilitates the distribution of software over
8 network connections. These software updates are provided using bandwidth throttling
9 technologies that allow for the software to be transferred in the background without
10 disturbing the user's other network activities.

11 **COUNT I**
12 **(Patent Infringement)**

13
14 10. Plaintiff incorporates by reference the allegations of paragraphs 1 through 10
15 above.

16 11. BackWeb is the owner of the '040, '789, and '429 patents.

17 12. HP has infringed and is still infringing the Transparent Update Patents, by,
18 without authority, consent, right or license, and in direct infringement of the patents, making,
19 using, offering for sale and/or selling digital information transfer products using the methods,
20 processes and apparatuses claimed in the patents in this country. This conduct constitutes
21 infringement under 35 U.S.C. § 271(a).

22
23 13. In addition, HP has infringed and is still infringing the Transparent Update
24 Patents in this country, through, *inter alia*, its active inducement of others to make, use,
25 and/or sell the systems, products and methods claimed in one or more claims of the patents.
26 This conduct constitutes infringement under 35 U.S.C. § 271(b).

1 14. In addition, HP has infringed and is still infringing the Transparent Update
2 Patents in this country through, *inter alia*, providing and selling goods and services including
3 products designed for use in practicing one or more claims of the Transparent Update
4 Patents, where the goods and services constitute a material part of the invention and are not
5 staple articles of commerce, and which have no use other than infringing one or more claims
6 of the Transparent Update Patents. HP has committed these acts with knowledge that the
7 goods and services it provides are specially made for use in a manner that directly infringes
8 the Transparent Update Patents. This conduct constitutes infringement under 35 U.S.C. §
9 271(c).
10

11 15. HP's infringing conduct is unlawful and willful. HP's willful conduct makes
12 this an exceptional case as provided in 35 U.S.C. § 285.

13 16. As a result of HP's infringement, Plaintiff has been damaged, and will
14 continue to be damaged, until they are enjoined from further acts of infringement.

15 17. HP will continue to infringe the Transparent Update Patents unless enjoined
16 by this Court. Plaintiff faces real, substantial and irreparable damage and injury of a
17 continuing nature from HP's infringement for which Plaintiff has no adequate remedy at law.
18

19 WHEREFORE, Plaintiff prays:

20 (a) That this Court find Defendant has committed acts of patent infringement
21 under the Patent Act, 35 U.S.C. § 271;

22 (b) That this Court enter judgment that:

23 (i) The Transparent Update Patents are valid and enforceable;

24 (ii) Defendant HP has willfully infringed the Transparent Update
25 Patents;

26
27
28

1 (c) That this Court issue a preliminary and final injunction enjoining HP, its
2 officers, agents, servants, employees and attorneys, and any other person in active concert
3 or participation with them, from continuing the acts herein complained of, and more
4 particularly, that HP and such other persons be permanently enjoined and restrained from
5 further infringing the Transparent Update Patents;

6 (d) That this Court award Plaintiff the damages to which it is entitled due to
7 Defendant HP's patent infringement, with both pre-judgment and post-judgment interest;

8 (f) That Defendant HP's infringement of the BackWeb Patents be adjudged
9 willful and that the damages to Plaintiff be increased by three times the amount found or
10 assessed pursuant to 35 U.S.C. § 284;


11 (g) That this be adjudged an exceptional case and that Plaintiff be awarded its
12 attorney's fees in this action pursuant to 35 U.S.C. § 285;

13 (h) That this Court award Plaintiff its costs and disbursements in this civil
14 action, including reasonable attorney's fees; and

15 (i) That this Court grant Plaintiff such other and further relief, in law or in
16 equity, both general and special, to which it may be entitled.

17 Dated: September 23, 2010

18 Respectfully submitted,

19
20
21 
22 _____
23 SPENCER HOSIE (CA Bar No. 101777)
24 shosie@hosielaw.com
25 BRUCE WECKER (CA Bar No. 078530)
26 bwecker@hosielaw.com
27 GEORGE F. BISHOP (CA Bar No. 89205)
28 gbishop@hosielaw.com
DIANE S. RICE (CA Bar No. 118303)
drice@hosielaw.com
HOSIE RICE LLP

188 The Embarcadero, Suite 750
San Francisco, CA 94105
(415) 247-6000 Tel.
(415) 247-6001 Fax

Attorneys for Plaintiff
BACKWEB TECHNOLOGIES, LTD.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

DEMAND FOR JURY TRIAL

Plaintiff, by its undersigned attorneys, demands a trial by jury on all issues so triable.

Dated: September 23, 2010

Respectfully submitted,



SPENCER HOSIE (CA Bar No. 101777)
shosie@hosielaw.com
BRUCE WECKER (CA Bar No. 078530)
bwecker@hosielaw.com
GEORGE F. BISHOP (CA Bar No. 89205)
gbishop@hosielaw.com
DIANE S. RICE (CA Bar No. 118303)
drice@hosielaw.com
HOSIE RICE LLP
188 The Embarcadero, Suite 750
San Francisco, CA 94105
(415) 247-6000 Tel.
(415) 247-6001 Fax

Attorneys for Plaintiff
BACKWEB TECHNOLOGIES, LTD.