

**UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

WEBROOT INC. and	)	
OPEN TEXT, INC.,	)	
	)	
Plaintiffs,	)	
v.	)	Civil Action No. 6:22-cv-00243
	)	
AO KASPERSKY LAB,	)	JURY TRIAL DEMANDED
	)	
Defendant.	)	
	)	

PLAINTIFFS’ MOTION FOR AN ORDER AUTHORIZING ALTERNATIVE SERVICE

Plaintiffs OpenText Inc. (“OpenText”) and Webroot, Inc. (“Webroot”) (collectively “Plaintiffs”) respectfully request an order from this Court under Federal Rule of Civil Procedure 4(h)(2) and 4(f)(3) allowing Plaintiffs to serve the summons and complaint on Russian Defendant AO Kaspersky Lab (“Kaspersky” or “Defendant”) via electronic mail directed to their U.S. Counsel and to the e-mail address Kaspersky has provided to its customers for communicating about its products.

Factual Background

Plaintiffs are the owners and exclusive licensees of patented technologies that helped revolutionize and have become widely adopted in the fields of malware detection, network security, and endpoint protection. (*See, e.g.*, ECF No. 1 ¶ 1.) Plaintiffs maintain multiple offices and employ scores of employees in this District. (*Id.* ¶ 22.)

Kaspersky is a Russian joint-stock company with its principal place of business at d. 39A str. 2, shosse Leningradskoe, Moscow, Russia. Kaspersky offers and sells in this District security software and systems that, without authorization, implement Plaintiffs’ patented technologies. (*Id.* ¶ 15.) Plaintiffs filed this action to address Kaspersky’s ongoing infringement of their patents.

On March 10, counsel for Plaintiffs attempted to reach Kaspersky's U.S. counsel by telephone to request that counsel accept service on behalf of Kaspersky. The same day, counsel for Plaintiffs e-mailed Kaspersky's U.S. counsel requesting counsel indicate whether it would accept service for Kaspersky. Ex. A. On March 17, counsel for Plaintiffs again e-mailed Kaspersky's U.S. counsel regarding this request. *Id.* Kaspersky's U.S. counsel has not responded to any of counsel for Plaintiffs' telephone calls or e-mails.

As discussed below, Plaintiffs have no viable means of effecting service of Kaspersky under the Federal Rules unless this Court orders an alternative method of service. Accordingly, Plaintiffs' respectfully request leave to effect service upon Kaspersky by e-mailing their U.S. counsel Michelle Doolin and Leo Norton of Cooley LLP (*see* Ex. B; Ex. C), and in addition or alternatively, e-mailing the e-mail address that Kaspersky provides to its customers for communicating about Kaspersky's infringing products: info@kaspersky.com.

Legal Standard

Rule 4(h) of the Federal Rules of Civil Procedure governs service of process on corporations, partnerships, or associations. Fed. R. Civ. P. 4(h). Pursuant to Rule 4(h)(2), serving a domestic or foreign corporation, or a partnership or other unincorporated incorporation "at a place not within any judicial district of the United States" must be done "in any manner prescribed by Rule 4(f) for serving an individual, except personal delivery under (f)(2)(C)(i)." Fed. R. Civ. P. 4(h)(2). Rule 4(f)(3) provides that the Court may authorize service on a foreign individual "by other means not prohibited by international agreement." Fed. R. Civ. P. 4(f)(3). "Thus, so long as the method of service is not *prohibited* by international agreement the Court has considerable discretion to authorize an alternative means of service." *Maxwell, Ltd. v. Lenovo Grp. Ltd.*, No.

6:21-CV-1169-ADA, 2022 WL 479133, at *1 (W.D. Tex. Feb. 15, 2022) (citing *Rio Props. Inc. v. Rio Int'l Interlink*, 284 F.3d 1007, 1014 (9th Cir. 2002)).

“[A] plaintiff does not have to attempt to effect service under Rule 4(f)(1) or Rule 4(f)(2) prior to requesting the authorization of an alternative method of service pursuant to Rule 4(f)(3). *Affinity Labs of Tex., LLC v. Nissan N. Am. Inc.*, No. WA:13-CV-369, 2014 WL 11342502, at *1 (W.D. Tex. July 2, 2014). “Indeed, ‘service of process under Rule 4(f)(3) is neither a ‘last resort’ nor ‘extraordinary relief.’ . . . It is merely one means among several which enables service of process on an international defendant.” *Maxwell*, 2022 WL 479133, at *1 (quoting *Rio Props.*, 284 F.3d at 1015).

“[A]n alternative method of service of process is valid if it complies with Texas’ long-arm statute.” *Maxwell*, 2022 WL 479133, at *2. “Courts have repeatedly interpreted the Texas long-arm statute ‘to reach as far as the federal constitutional requirements of due process will allow.’” *Id.* (quoting *CSR Ltd. v. Link*, 925 S.W.2d 591, 594 (Tex. 1996)). “To satisfy the constitutional requirements of due process, the method of service must be ‘reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections.’” *Id.* (quoting *Mullane v. Cent. Hanover Bank & Trust Co.*, 339 U.S. 306, 314 (1950)).

Argument

I. Plaintiffs Cannot Effect Service Under Rule 4(f)(1) or Rule 4(f)(2).

While this Court has stated that “principles of comity encourage the court to insist, as a matter of discretion, that a plaintiff attempt to follow foreign law in its efforts to secure service of

process upon defendant,”¹ Plaintiffs have no viable means of effecting service of U.S. Process on Kaspersky in Russia under the present circumstances.

Plaintiffs cannot effect service under Rule 4(f)(1) because there is no “internationally agreed means of service that is reasonably calculated to give notice”. Fed. R. Civ. P. 4(f)(1). Russia initially signed on to the Hague Convention on the Service Abroad of Judicial and Extra Judicial documents in Civil and Commercial Matters (“Hague Service Convention”). But in July 2003, “Russia unilaterally suspended all judicial cooperation with the United States in civil and commercial matters.”² “The Russian Federation refuses to serve letters of request from the United States for service of process presented under the terms of the 1965 Hague Service Convention or to execute letters rogatory requesting service of process transmitted via diplomatic channels.” *Id.* According to the U.S. Department of State: “[w]hile the [United States] Department of State is prepared to transmit letters rogatory for service or evidence to Russian authorities via diplomatic channels, in the Department's experience, all such requests are returned unexecuted. Likewise requests sent directly by litigants to the Russian Central Authority under the Hague Service Convention are returned unexecuted.”³ Russia’s consistent refusal to forward requests for service has also been recognized by U.S. District Courts. *See, e.g., AMTO, LLC v. Bedford Asset Mgmt., LLC*, No. 14-CV-9913, 2015 WL 3457452, at *4 (S.D.N.Y. June 1, 2015); *Arista Recs. LLC v. Media Servs. LLC*, No. 06 CIV. 15319NRB, 2008 WL 563470, at *2 (S.D.N.Y. Feb. 25, 2008). “[B]ecause there is no reason to believe that service would be effective if [a plaintiff] were required to serve [a defendant based in Russia] in accordance with the Hague Convention procedures,

¹ *Maxwell*, 2022 WL 479133, at *1 (quotations omitted).

² <https://travel.state.gov/content/travel/en/legal/Judicial-Assistance-Country-Information/RussianFederation.html>.

³ <https://travel.state.gov/content/travel/en/legal/Judicial-Assistance-Country-Information/RussianFederation.html>.

substituted service pursuant to Rule 4(f)(3) is appropriate.” *AMTO*, 2015 WL 3457452, at *4 (alterations in original) (quoting *Arista*, 2008 WL 563470, at *2).

Plaintiffs respectfully submit that comity should not require Plaintiffs to attempt to effect service in a manner Russia has demonstrated consistently for years that it will not honor as a prerequisite for this Court to issue an order for alternative service. “Rule 4 was not intended to burden plaintiffs with the Sisyphean task of attempting service through the Hague Convention procedures when a member state has categorically refused to effect service.” *Nuance Comms., Inc. v. Abby Software House*, 626 F.3d 1222, 1238 (Fed. Cir. 2010) (internal quotations and alterations omitted) (holding that a district court erred in requiring service of a Russian defendant under the Hague Service Convention).

No means for effective service in Russia is available under Rule 4(f)(2) either. Rule 4(f)(2) contains three subparts, 4(f)(2)(A), (B), and (C). Rule 4(f)(2)(A) allows for service “as prescribed by the foreign country’s law for service in that country in an action in its courts of general jurisdiction.” Fed. R. Civ. P. 4(f)(2)(A). Russian law does not allow for private service of process. “In Russian internal judicial proceedings, service is always issued by the court and is either put in the mail by the judge or is carried out by a court-appointed official, because Russia, like other civil law countries, considers service of process an official act of the state.”⁴ “Private service of the U.S. process, on the other hand, is not authorized by Russian law.” *Id.* Neither the U.S. Department of State nor the U.S. Department of Justice, nor the case law, identify any means (and Plaintiffs are aware of none) to effect service of U.S. process by applying to a Russian court. The only identified

⁴ Tatyana Gidirimski, *Service of United States Process in Russia under Rule 4(f) of the Federal Rules of Civil Procedure*, Pacific Rim L. & Pol’y J. 691, 708 (2001).

means for service in Russia is a letter of request sent via the U.S. Department of State, but as discussed above, Russia has consistently refused to honor such requests.

Moreover, under the present circumstances, there is no reasonable likelihood that any Russian government court or agency is going to entertain a request to serve U.S. process on a Russian company. In response to Russia's recent invasion of Ukraine, the United States and European Union announced severe economic sanctions designed to hinder, if not outright prevent, the ability of Russian businesses to interact with U.S. and European entities.⁵ Many U.S. and European couriers, such as FedEx Corporation, have suspended operations in Russia.⁶ In response, the Russian government issued a Decree authorizing the use of inventions patented by companies residing in a so-called "hostile country," such as the United States, without compensation.⁷ Russian courts are not going to authorize service on a Russian company to answer IP infringement claims in a U.S. court (a "hostile country") when they will not even entertain IP infringement claims brought by a U.S. company in Russian courts. *Id.* Thus, there is presently no viable means of service available to Plaintiffs under Rule 4(f)(2)(A).

Plaintiffs cannot effect service in Russia under Rule 4(f)(2)(B) either. Rule 4(f)(2)(B) allows for service "as the foreign authority directs in response to a letter rogatory or letter of request." Fed. R. Civ. P. 4(f)(2)(B). As discussed above, Russia has consistently refused to effect service in response to letters rogatory or letters of request. It has a nearly 20-year history of simply

⁵ See, e.g., <https://home.treasury.gov/news/press-releases/jy0608>; https://ec.europa.eu/commission/presscorner/detail/en/ip_22_1484.

⁶ <https://newsroom.fedex.com/newsroom/a-message-to-team-members-on-the-conflict-in-ukraine/>.

⁷ European Innovation Council and SMEs Executive Agency, *Russia suspending some IP Rights and Peppa Pig trade mark infringement* (Mar. 17, 2022), <https://intellectual-property-helpdesk.ec.europa.eu/news-events/news/russia-suspending-some-ip-rights-and-peppa-pig-trade-mark-infringement-2022-03-17en>.

returning such letters unexecuted. *See Facebook, Inc. v. Kokhtenko*, No. 21-CV-03036-YGR, 2021 WL 3373211, at *1 (N.D. Cal. Aug. 3, 2021); *see also Nuance*, 626 F.3d at 1237-38. According to the U.S. Department of State, it has been negotiating with Russia for years to identify a method of service amenable to Russia but has been unsuccessful.⁸

Nor can Plaintiffs effect service under Rule 4(f)(2)(C). Rule 4(f)(2)(C) allows for service (i) by personally delivering a copy of the summons and complaint, or (ii) by using any form of mail that a U.S. court clerk addresses and sends. Rule 4(h)(2) expressly prohibits in-person service of a foreign entity under Rule 4(f)(2)(C)(i). Service by mail under Rule 4(f)(2)(C)(ii) is likewise unavailable. Russia has objected to service via postal channels under Article 10(a) of the Hague Service Convention. “[T]he Hague Service Convention . . . prohibits service through certified international mail or Federal Express International Priority mail on individuals residing in the Russian Federation due to that country’s objection to Article 10 of the convention.” *AMTO*, 2015 WL 3457452, at *7 (denying motion to serve Russian defendant by mail). Russia’s objection to service via postal channels extends to the use of a private courier. “Courts have held, however, that service of documents by international courier constitutes service through ‘postal channels,’ and accordingly this method of service is insufficient in light of Russia’s objection to Article 10” *Id.* at *10. A 2003 Special Commission on the Practical Operation of the Hague Apostille, Evidence and Service Conventions likewise advises that “for the purposes of Article 10(a) the use of a private courier was the equivalent of the postal channel.”⁹

⁸ <https://travel.state.gov/content/travel/en/legal/Judicial-Assistance-Country-Information/RussianFederation.html>.

⁹ Permanent Bureau Conclusions and Recommendations Adopted by the Special Commission on the Practical Operation of the Hague Apostille, Evidence and Service Conventions, p. 11, Oct. 28 – Nov. 4, 2003, https://assets.hcch.net/upload/wop/lse_concl_e.pdf.

II. Effective Service of Kaspersky Is Available Under Rule 4(f)(3).

By contrast, Kaspersky may be effectively served by alternate means of service under Rule 4(f)(3). Rule 4(f)(3) provides for service “by other means not prohibited by international agreement, as the court orders.” Here, Kaspersky may be effectively served using two alternate forms of service, e-mail to U.S. counsel who has represented Kaspersky in U.S. court proceedings, and by e-mail to the e-mail address that Kaspersky provides to its U.S. customers for communications about Kaspersky’s products.

First, Plaintiffs request leave to serve Kaspersky via the e-mail address “info@kaspersky.com.” Several courts have held that Russia does not prohibit service via e-mail and have authorized e-mail as a method of service on Russian defendants. *See AMTO*, 2015 WL 3457452, at *7 (collecting cases) (“Russia has not explicitly objected to service by electronic means . . . and the Court is not aware of any other international agreement or Russian law that prohibits service via email . . .”). Though Russia objects to the use of “postal channels” (including registered mail and private couriers) to effect service under Article 10(a) of the Hague Service Convention, neither Russia nor the United States interpret “postal channels” to include e-mail.¹⁰ Thus, neither Russia’s objection to Article 10(a) nor any other international agreement between the United States and Russia prohibits service via e-mail. Indeed, the Special Commission on the Practical Operation of the Hague Apostille, Evidence and Service Conventions concluded that “the

¹⁰ Synopsis of Responses to the Questionnaire of July 2008 Relating to the Hague Convention of 15 November 1965 on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters (Service Convention) (Revised Version as per August 2009), p. 135, <https://assets.hcch.net/upload/wop/2008synopsis14.pdf>.

transmission of documents internationally for the purposes of the Convention can and should be undertaken by IT-Business methods including e-mail.”¹¹

Serving Kaspersky at the e-mail address it provides to customers is reasonably likely to provide Kaspersky with notice of Plaintiffs’ lawsuit concerning its products. Kaspersky provides this e-mail address to customers as the appropriate method to contact the company for legal matters and issues related to its products. The end user license agreements for each of the Kaspersky products accused of infringement in this case instruct licensees to e-mail “info@kaspersky.com” for “any questions concerning this Agreement, or if you desire to contact the Rightholder [(Kaspersky)] for any reason.” *See, e.g.*, Ex. D § 15. Additionally, Kaspersky’s Russian-language website, contains a web page entitled “Legal Information” (“Юридическая Информация”). <https://www.kaspersky.ru/legal>. This webpage contains information such as Kaspersky’s “legal address” (“Юридический адрес”) in Moscow (“Москва”) and lists Kaspersky’s e-mail address as “info@kaspersky.com.” *Id.* Thus, Kaspersky has held out “info@kaspersky.com” as the appropriate e-mail address to contact for general legal issues and issues related to Kaspersky’s products. Plaintiff’s lawsuit raises legal issues related to Kaspersky’s products.

Second, Kaspersky may be effectively served by serving Kaspersky’s U.S. Counsel. This Court and others have recognized service of process on a foreign entity’s U.S. counsel as an appropriate alternative means of service. *Nuance*, 626 F.3d at 1239 (“[F]ederal law plainly permits service on Defendants’ . . . domestic counsel.” (internal quotation omitted)); *WSOU Investments LLC v. OnePlus Technology (Shenzhen) Co., Ltd.*, No. 6:20-cv-00952-ADA, 2021 WL 2870679, at *5-6 (W.D. Tex. July 8, 2021). Service via e-mail to Kaspersky’s U.S. counsel is an effective

¹¹ Permanent Bureau Conclusions and Recommendations Adopted by the Special Commission on the Practical Operation of the Hague Apostille, Evidence and Service Conventions, p. 11, Oct. 28 – Nov. 4, 2003, https://assets.hcch.net/upload/wop/lse_concl_e.pdf.

means of providing notice of Plaintiffs' lawsuit and comports with due process. "E-mail on the domestic counsel of a foreign defendant complies with constitutional notions of due process, because it is reasonably calculated to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections." *WSOU*, 2021 WL 2870679, at *5. "Due process does not require that the individuals served on behalf of foreign defendants have represented them or been authorized to accept on their behalf." *Affinity*, 2014 WL 11342502, at *3 (quoting *Brown v. China Integrated Energy, Inc.*, 285 F.R.D. 560, 565–66 (C.D. Cal. July 17, 2012)).

Plaintiffs have identified Michelle Doolin (mdoolin@cooley.com) and Leo Norton (lnorton@cooley.com) of the law firm Cooley LLP as U.S. counsel for Kaspersky. These lawyers represent Kaspersky in a lawsuit brought in California *Licea v. Kaspersky Lab, Inc.*, No. 20STCV36486 (Cal. Super. Ct. Jan. 25, 2021). *See, e.g.*, Ex. B, Declaration of Leo Norton; Ex. C *Licea* Docket Sheet. According to the docket, *Licea* remains pending in California,¹² and Cooley remains Kaspersky's counsel of record in that action. Cooley LLP is a reputable law firm whose attorneys regularly appear before this Court.¹³ It is "all but certain that" if Kaspersky is served through its domestic counsel, Kaspersky "will receive notice of the suit." *Brown*, 285 F.R.D. at 566. Serving Kaspersky through its domestic counsel also enables Plaintiffs and the Court to verify through its counsel that the service has been effective.

¹² The docket sheet indicates that Plaintiff *Licea* filed a request for dismissal on November 24, 2021.

¹³ *See, e.g., Topia Techs., Inc. v. Box, Inc.*, No. 6:21-cv-1372-ADA (W.D. Tex. Dec. 29, 2021); *AlmondNet, Inc. v. Meta Platforms, Inc.*, No. 6:21-cv-896-ADA (W.D. Tex. Aug. 27, 2021); *Spectra Comms. AB v. Absolute Software, Inc.*, No. 6:21-cv-759-ADA (W.D. Tex. July 23, 2021).

Plaintiffs understand the Court's preference that, before it orders alternative service under Rule 4(f)(3), plaintiffs "attempt[] service through other means first." *Maxwell*, 2022 WL 479133, at *1. As explained above, Russia has provided no avenues for Plaintiffs to "attempt to follow foreign law in its efforts to secure service of process upon defendant." *Id.* Plaintiffs have not been able to identify any potential avenue of service other than e-mail that would comport with Russian law and the Federal Rules. Plaintiffs have asked Kaspersky, via its U.S. counsel, to voluntarily accept service via e-mail, but to date counsel has not responded to these requests. Accordingly, Plaintiffs respectfully request that the Court enter an order pursuant to FRCP 4(h)(2) and 4(f)(3) allowing alternate service on Kaspersky

Conclusion

Plaintiffs respectfully request leave to effect service upon Cooley via e-mail to its domestic counsel, Michelle Doolin and Leo Norton, and/or via e-mail to its publicly advertised e-mail address for legal matters, info@kaspersky.com.

DATED: March 24, 2022

By: /s/ Jeffrey D. Mills

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CERTIFICATE OF CONFERENCE

The undersigned certifies that no counsel of record has contacted Counsel for Plaintiffs or entered an appearance for Defendant AO Kaspersky Lab in this matter. Counsel for Plaintiffs made requests to meet and confer on the relief sought herein via e-mails to Kaspersky's domestic counsel, Michelle Doolin, who represents Kaspersky in *Licea v. Kaspersky Lab, Inc.*, No. 20STCV36486 (Cal. Super. Ct. Jan. 25, 2021) on March 10, 2022 and March 17, 2022. Counsel for Plaintiffs received no response to these e-mails.

/s/ Jeffrey D. Mills
Jeffrey D. Mills

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing document was served on all parties who have appeared in this case on March 24, 2022, via the Court's CM/ECF system.

/s/ Jeffrey D. Mills

Jeffrey D. Mills