

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

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PERKINELMER HEALTH SCIENCES, INC.,		)	
	Plaintiff,	)	
v.		)	Civil Action No. 1:12-cv-10562-NMG
		)	
AGILENT TECHNOLOGIES, INC.,		)	
	Defendant.	)	
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**SECOND AMENDED COMPLAINT**

Plaintiff PerkinElmer Health Sciences, Inc. (“PerkinElmer”), by and for its Second Amended Complaint against defendant Agilent Technologies, Inc. (“Agilent”), hereby alleges as follows:

**Parties**

1. Plaintiff PerkinElmer is a Delaware Corporation with its principal place of business at 940 Winter Street, Waltham, Massachusetts 02451.
2. Defendant Agilent is a Delaware Corporation with its principal place of business at 5301 Stevens Creek Boulevard, Santa Clara, California 95051. Agilent is in the business of making, selling and servicing mass spectrometers among other analytical instruments.

**Nature of the Action**

3. This is a civil action for the infringement of United States Patent Nos. 5,686,726 (“the ’726 Patent”) and 5,581,080 (“the ’080 Patent”) and for breach of contract. The ’726 Patent is attached hereto as Exhibit A and the ’080 Patent is attached hereto as Exhibit B. The ’726 Patent is entitled “Composition of Matter of a Population of Multiply Charged Ions Derived

from Polyatomic Parent Molecular Species” and the ’080 Patent is entitled “Method for Determining Molecular Weight Using Multiply Charged Ions.”

### **Jurisdiction and Venue**

4. This Court has original jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1338(a) and 1367 because all claims in this action arise under the patent laws of the United States, including 35 U.S.C. § 271, or are so related to such claims as to form part of the same case or controversy.

5. Agilent is subject to personal jurisdiction in this district because Agilent has committed acts of direct and/or indirect infringement of one or more claims of the ’726 Patent and the ’080 Patent in this district.

6. Venue in this district is proper under 28 U.S.C. §§ 1391(b)(2), 1391(c), and 1400(b) because Agilent is subject to personal jurisdiction in this district and has committed acts of patent infringement in this district.

### **Factual Background**

7. The ’726 Patent issued to inventors John Bennett Fenn, Chin-Kai Meng and Matthias Mann on November 11, 1997. The ’080 Patent issued to inventors John B. Fenn, Chin-Kai Meng and Matthias Mann on December 3, 1996. The ’726 Patent was granted from Application Serial No. 911,405, which was a divisional of Application Serial No. 773,776, which matured into U.S. Patent No. 5,130,538, issued July 14, 1992. The ’080 Patent was granted from Application No. 309,852, which was a divisional of Application Serial No. 911,405.

8. The ’726 Patent and ’080 Patent were both originally assigned to John B. Fenn and subsequently assigned to Yale University (“Yale”).

9. Yale granted, *inter alia*, an exclusive license to Analytica of Branford, Inc. (“AoB”) in and to any and all interest Yale has in the patents-in-suit, including the right to sublicense and bring any legal action for infringement of the patents-in-suit.

10. AoB entered into a license agreement with Hewlett-Packard Company (“HP”) in March, 1997 (“License Agreement”), which granted HP a license, *inter alia*, in, to and under U.S. Patent No. 5,130,538 and any and all subsequently-issued U.S. patents issuing from any continuation, divisional, continuation-in-part, reissue, reexamination or extension applications thereof. The License Agreement listed the patents and applications existing as of the date of the License Agreement, including the ’080 Patent and U.S. Patent Application Serial No. 07/911,405, filed July 10, 1992 entitled “A Composition of Matter of a Population of Multiply Charged Ions Derived from Polyatomic Parent Molecular Species” (“the ’405 Application”). The ’405 Application matured into the ’726 Patent.

11. Upon information and belief, in 1999, HP created Agilent to spin off certain of its business related to communications, electronics, semiconductors, test and measurement, life sciences and chemical analysis. Through that spin off, HP assigned the License Agreement to Agilent.

12. AoB merged with and into PerkinElmer in 2009. PerkinElmer, therefore, has the sole right to bring this action for infringement of the patents-in-suit and for Agilent’s breach of the License Agreement.

13. Agilent failed to make royalty payments after June 30, 2011 in accordance with the License Agreement. That failure was a breach of the License Agreement that Agilent did not cure.

14. On or about March 27, 2012, PerkinElmer terminated the License Agreement for material breach.

**COUNT I**  
**(Agilent's Infringement of the '726 Patent)**

15. PerkinElmer incorporates paragraphs 1–14 by reference as if fully alleged herein.

16. Upon information and belief, Agilent makes, uses, sells, offers to sell and/or imports into the United States for subsequent sale or use, products that directly and/or indirectly infringe, literally and/or under the doctrine of equivalents, one or more of the claims of the '726 Patent. Such devices include Agilent's mass spectrometers compatible with Agilent's electrospray ion sources.

17. Upon information and belief, Agilent actively, knowingly, and intentionally induced, and continues to actively, knowingly, and intentionally induce infringement of the '726 Patent by making, using, offering for sale, importing, and selling infringing mass spectrometers and electrospray ion sources, all with knowledge of the '726 Patent and its claims, with knowledge that its customers will use its mass spectrometers to infringe the claims of the '726 Patent, and with knowledge and the specific intent to encourage and facilitate those infringing uses of its mass spectrometers through the creation and dissemination of promotional and marketing materials, including product manuals and technical materials, such as those relating to, but not limited to, Agilent's 6100 Series Quadrupole, 6200 Series TOF, 6300 Series Ion Trap, 6400 Series Triple Quad and 6500 Series Q-TOF models.

18. Agilent has had actual knowledge and notice of the '726 Patent at all relevant times by virtue of the License Agreement. Despite this knowledge, it continues to commit tortious conduct by way of patent infringement.

19. Agilent's infringement of the '726 Patent is and has been willful.

20. PerkinElmer is entitled to recover damages adequate to compensate it for Agilent's infringement.

21. PerkinElmer has suffered and will continue to suffer irreparable injuries unless Agilent's infringement of the '726 Patent is enjoined.

**COUNT II**  
**(Agilent's Infringement of the '080 Patent)**

22. PerkinElmer incorporates paragraphs 1–21 by reference as if fully alleged herein.

23. Upon information and belief, Agilent makes, uses, sells, offers to sell and/or imports into the United States for subsequent sale or use, products that directly and/or indirectly infringe, literally and/or under the doctrine of equivalents, or which employ systems, components and/or processes that make use of systems or processes that directly and/or indirectly infringe, literally and/or under the doctrine of equivalents, one or more of the claims of the '080 Patent. Such devices include Agilent's mass spectrometers compatible with Agilent's electrospray ion sources.

24. Upon information and belief, Agilent actively, knowingly, and intentionally induced, and continues to actively, knowingly, and intentionally induce infringement of the '080 Patent by making, using, offering for sale, importing, and selling infringing mass spectrometers and electrospray ion sources, all with knowledge of the '080 Patent and its claims, with knowledge that its customers will use its mass spectrometers to infringe the claims of the '080 Patent, and with knowledge and the specific intent to encourage and facilitate those infringing uses of its mass spectrometers through the creation and dissemination of promotional and marketing materials, including product manuals and technical materials, such as those relating to, but not limited to, Agilent's 6100 Series Quadrupole, 6200 Series TOF, 6300 Series Ion Trap, 6400 Series Triple Quad and 6500 Series Q-TOF models.

25. Agilent has had actual knowledge and notice of the '080 Patent at all relevant times by virtue of the License Agreement. Despite this knowledge, it continues to commit tortious conduct by way of patent infringement.

26. Agilent's infringement of the '080 Patent is and has been willful.

27. PerkinElmer is entitled to recover damages adequate to compensate it for Agilent's infringement.

28. PerkinElmer has suffered and will continue to suffer irreparable injuries unless Agilent's infringement of the '080 Patent is enjoined.

**COUNT III**  
**(Agilent's Breach of Contract)**

29. PerkinElmer incorporates paragraphs 1–14 by reference as if fully alleged herein.

30. PerkinElmer performed its obligations under the License Agreement.

31. Agilent materially breached the License Agreement when it failed to make royalty payments after June 30, 2011 and failed to cure the breach.

32. Upon information and belief, Agilent sold or provided to its customers products used in a manner which but for the license conferred by the License Agreement infringed one or more claims of the Licensed Patents (as that term is defined in the License Agreement) and then failed to make royalty payments it owed to PerkinElmer prior to or as of June 30, 2011 relating to the sale and/or provision of those infringing products.

33. Upon information and belief, Agilent materially breached the License Agreement when it failed to make all royalty payments due pursuant to the terms of the License Agreement, including but not limited to Articles 3 and 4 of the License Agreement.

34. As a result of Agilent's breaches of the License Agreement, PerkinElmer has suffered damages.

**Prayer for Relief**

WHEREFORE, PerkinElmer Health Sciences, Inc. requests the following relief:

- a) A judgment that Agilent has infringed and is infringing the '726 Patent;
- b) A judgment that Agilent has infringed and is infringing the '080 Patent;
- c) An award of all appropriate damages under 35 U.S.C. § 284 for Agilent's past infringement and any continuing or future infringement of the patents-in-suit;
- d) An order, pursuant to 35 U.S.C. § 283, enjoining Agilent and all persons in active concert or participation with Agilent from any further infringement of the patents-in-suit;
- e) An award for damages caused by Agilent's breach of the License Agreement in an amount to be determined at trial;
- f) An award of interest and costs;
- g) A declaration that this case is exceptional within the meaning of 35 U.S.C. § 285 and an award of PerkinElmer's reasonable attorneys' fees in prosecuting this action; and
- h) Such other and further relief at law or in equity as the Court deems just and proper.

**Jury Demand**

PerkinElmer Health Sciences, Inc. hereby demands trial by jury on all claims and issues so triable.

August 14, 2013

By: /s/ Elizabeth A. Alquist

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