

**UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

<p>3M COMPANY, Plaintiff, vs. TRUDELL MEDICAL INTERNATIONAL, Defendant.</p>	<p>Civil No. COMPLAINT FOR DECLARATORY JUDGMENT <u>JURY TRIAL DEMANDED</u></p>
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Plaintiff 3M Company (“3M”) seeks a declaratory judgment that it does not infringe any claim of United States Patent No. 7,984,826, entitled “Indicating Device,” which issued on July 26, 2011 (“the ’826 patent”), or any claim of United States Patent No. 8,074,643, entitled “Dispensing Device,” which issued on December 13, 2011 (“the ’643 patent”). Copies of the ’826 patent and ’643 patent are attached to this complaint as Exhibits A and B, respectively.

PARTIES, JURISDICTION, AND VENUE

1. Plaintiff 3M is a corporation organized and existing under the laws of the state of Delaware, with its principal place of business at 3M Center, St. Paul, MN 55144.
2. On information and belief, Defendant Trudell Medical International (“Trudell”) is a partnership organized and existing under the laws of the Province of

Ontario, Canada, with a principal place of business at 725 Third Street, London, Ontario, Canada, N5V 5G4.

3. On information and belief, including based on the records of the U.S. Patent & Trademark Office, Defendant Trudell is the assignee of the '826 and '643 patents.

4. This action arises under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202, and the patent laws of the United States, 35 U.S.C. §§ 101, *et. seq.*

5. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

6. This Court has personal jurisdiction over Trudell. Trudell has directed enforcement activities relating to the '826 and '643 patents at 3M in this District. In addition, Trudell, which is a foreign corporation based in Canada, “is not subject to jurisdiction in any state’s courts of general jurisdiction” and “exercising jurisdiction is consistent with the United States Constitution and laws.” Fed. R. Civ. P. 4(k)(2). Trudell, for example, has directed specific enforcement activities relating to the '826 and '643 patents at 3M in the State of Minnesota, including accusing 3M of infringing the '826 and '643 patents in Minnesota and traveling from Ontario to Minnesota for licensing discussions relating to the '826 and '643 patents. In addition, Trudell has previously invoked the U.S. federal courts to enforce another patent in the same family as the '826 patent—namely, U.S. Patent No. 8,505,773—against allegedly infringing dose indicator metering mechanisms. *See Trudell Medical Int’l v. RPC Formatec GmbH*, 14-cv-032 (E.D. Va. Jan 13, 2014) (complaint). Trudell has also used the U.S. federal courts to

enforce other patents. Accordingly, under the circumstances, it is, at a minimum, reasonable and fair for this Court to assert personal jurisdiction over Trudell pursuant to Federal Rule of Civil Procedure 4(k)(2).

7. Venue is proper in this Court under 28 U.S.C. §§ 1391 and 1400.

FACTUAL BACKGROUND

8. 3M manufactures and sells certain dose counter products, which are incorporated into medical device inhalers marketed under the name Dulera®. The 3M dose counter products will be referred to in this Complaint as “the Threatened 3M Products.”

9. 3M brings this declaratory judgment action because Trudell has engaged in a series of acts that create a real and concrete dispute between the parties and constitute a clear threat that Trudell will sue 3M for infringement of the '826 and/or '643 patents based on 3M's manufacture, sale, and use of the Threatened 3M Products. These affirmative acts by Trudell create a case or controversy between the parties. 3M need not risk a suit for infringement by continuing to engage in the manufacture, sale, and use of the Threatened 3M Products without seeking a declaration of its legal rights.

10. On May 5, 2016, Mr. Joaquim Balles, VP & General Counsel for Trudell, sent an email to Mr. Kevin Rhodes, Chief Intellectual Property Counsel for 3M and President of 3M Innovative Properties Company, entitled “IP Matter.” In his email, Mr. Balles stated: “There is a patent matter involving a 3M company I would like to discuss with you or someone else in your department, as appropriate.” Mr. Rhodes directed Mr. Balles to Ms. Colene Blank, 3M's Assistant Chief IP Counsel, Health Care Business

Group.

11. On August 4, 2016, Mr. Balles notified Ms. Blank that Trudell believed 3M was manufacturing and selling dose counters that infringe the '826 and '643 patents. On August 11, 2016, Mr. Balles specifically identified the Threatened 3M Products as allegedly infringing the '826 and '643 patents. Mr. Balles also proposed license terms for the '826 and '643 patents and the Threatened 3M Products.

12. On October 18, 2016, Mr. Balles and Mr. Andrew Varghese, Vice President & General Manager at Trudell, visited Ms. Blank and Dean Kavanaugh at 3M's headquarters in St. Paul, MN to discuss a potential license to the '826 and '643 patents and other potential business relationships. 3M, however, does not believe that the Threatened 3M Products infringe any claims of the '826 or '643 patents and communicated that fact to Trudell.

13. After the October 18 meeting, 3M and Trudell continued to have communications about a potential license to the '826 and '643 patents for the Threatened 3M Products. Mr. Balles indicated that if the parties were not able to reach agreement on a license to the '826 and '643 patents, then Trudell would proceed accordingly.

14. The parties have not reached any agreement on a license to the '826 or '643 patents.

15. Accordingly, based on these circumstances and communications from Trudell, 3M was and continues to be under reasonable apprehension of suit by Trudell for alleged infringement of the '826 and '643 patents by the Threatened 3M Products. Indeed, as mentioned above, Trudell previously filed a lawsuit in the United States to

enforce a related patent against dose indicator products.

16. Furthermore, for a number of reasons, 3M is entitled to make, use, sell, offer to sell, and/or import the Threatened 3M Products, notwithstanding Trudell's position with respect to the '826 and '643 patents. In particular, 3M is entitled to make, use, sell, offer to sell, and/or import the Threatened 3M Products at least because 3M does not and has not infringed any claim of the '826 patent or '643 patent either literally or by the doctrine of equivalents, directly or indirectly.

COUNT ONE

Declaratory Judgment of Non-Infringement of the '826 Patent
28 U.S.C. § 2201

17. 3M repeats and realleges paragraphs 1 through 16 of this complaint, as though fully set forth.

18. For the reasons set out in this complaint, an actual case and controversy exists between 3M and Trudell based on Trudell's '826 patent and the Threatened 3M Products.

19. 3M is entitled to make, use, sell, offer to sell, and import the Threatened 3M Products because 3M does not and has not infringed any claim of the '826 patent either literally or by the doctrine of equivalents, directly or indirectly. For example, and without limitation, the Threatened 3M Products do not include an indicator member that is rotatable about a rotation axis that forms an obtuse angle with the longitudinal axis, as required by the independent claims of the '826 patent. Accordingly, the Threatened 3M Products do not infringe any of the claims of the '826 patent.

20. 3M asks the Court to declare that 3M has not infringed any claim of the '826 patent.

COUNT TWO

Declaratory Judgment of Non-Infringement of the '643 Patent
28 U.S.C. § 2201

21. 3M repeats and realleges paragraphs 1 through 20 of this complaint, as though fully set forth.

22. For the reasons set out in this complaint, an actual case and controversy exists between 3M and Trudell based on Trudell's '643 patent and the Threatened 3M Products.

23. 3M is entitled to make, use, sell, offer to sell, and import the Threatened 3M Products because 3M does not and has not infringed any claim of the '643 patent either literally or by the doctrine of equivalents, directly or indirectly. For example, and without limitation, the claims of the '643 patent are directed to a top mounted dose counter. However, the Threatened 3M Products are not top mounted dose counters. Rather, the Threatened 3M Products have a dose counter that is internal and not top mounted. Thus, the Threatened 3M Products are not covered by any claims of the '643 patent.

24. 3M asks the Court to declare that 3M has not infringed any claim of the '643 patent.

PRAYER FOR RELIEF

Wherefore, 3M prays for the following relief:

- A. That the Court declare and enter judgment that 3M has not infringed and does not infringe any claim of the '826 patent;
- B. That the Court declare and enter judgment that 3M has not infringed and does not infringe any claim of the '643 patent;
- C. That 3M be awarded its reasonable costs and attorneys' fees pursuant to 35 U.S.C. § 285; and
- D. That the Court award 3M such other relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

3M demands a trial by jury of all issues triable of right by jury.

Dated: December 29, 2016

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