

IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF NORTH CAROLINA
GREENSBORO DIVISION
Case No. 1:17-cv-00767

Loparex LLC,

Plaintiff,

vs.

Mondi Group and Mondi Inncoat GmbH,

Defendants.

COMPLAINT

JURY TRIAL DEMANDED

Plaintiff Loparex LLC (“Loparex”), for its Complaint against the Defendants, alleges:

THE PARTIES

1. Loparex is a company organized under Delaware law and has a principal place of business located at 1255 Crescent Green, Cary, North Carolina.

2. Defendant Mondi Group describes itself as a “dual listed company,” comprising Mondi Limited, a South African incorporated company holding African assets, and Mondi plc, an incorporated company of the United Kingdom holding non-African assets. Together, Mondi Limited and Mondi plc are known as the Mondi Group. Mondi Group further describes itself such that “any ordinary share hold in either Mondi Limited or Mondi plc gives the holder an effective economic

interest in the whole Mondi Group.” Further, according to the Mondi Group, “The board and management team of the Mondi Group operate and manage the business as if it were a single economic entity. While Mondi Limited and Mondi plc are separate corporate entities and each have a board of directors, the Boards and management team are comprised of the same people.” Finally, Mondi Group describes itself as operating in more than thirty countries around the world, with “key operations” in central Europe, Russia, North America, and South Africa. Mondi Group’s corporate office and headquarters are located at Marxergasse 4A, A-1030, Vienna, Switzerland.

3. Defendant Mondi Inncoat GmbH (“Mondi Inncoat”) is a subsidiary of Defendant Mondi Group in the “consumer lines segment.” Mondi Inncoat has a principal place of business located at Andererstrasse 25, Raubling D-83064, Germany. Defendant Mondi Inncoat’s actions and omissions are attributable and imputable to its parent company, Defendant Mondi Group.

NATURE OF ACTION

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

5. This Court may declare the rights and other legal relations of the parties in this case under the Declaratory Judgment Act, *28 U.S.C. §§ 2201-2202*, and Federal Rule of Civil Procedure 57, because there is an actual and

justiciable controversy concerning the rights and other legal relations of Plaintiff and Defendants.

JURISDICTION AND VENUE

6. This Court has subject matter jurisdiction over this matter as the matter arises under the Federal Declaratory Judgment Act and the patent laws of the United States. Thus, jurisdiction is proper under, at a minimum, *28 U.S.C. §§ 1331 and 1338*, and *28 U.S.C. § 2201 et seq.*

7. Jurisdiction in this Court is also based on diversity of citizenship under *28 U.S.C. § 1332*. The matter in controversy exceeds \$75,000.

8. This Court has personal jurisdiction over Defendants. On information and belief, Defendants and/or their affiliates have significant contacts within the State of North Carolina and within this District and purposefully direct activities towards the State of North Carolina and this District because Defendants manufacture (directly or indirectly through third party manufacturers) and/or assemble products and components that are and have been offered for sale, sold, purchased, and used in this District. On information and belief, Defendants and/or their affiliates conduct substantial business within the State of North Carolina and within this District, including by means of sales operations within this District, and regularly solicit business within the State of North Carolina and this District. On information and belief, Defendants and/or their affiliates derive substantial revenue from products provided to customers,

distributors, and/or vendors residing in the State of North Carolina and in this District. In this manner, exercise of jurisdiction over Defendants will not offend traditional notions of fair play and substantial justice. Such an exercise of personal jurisdiction is consistent with the North Carolina long-arm statute, N.C. Gen. Stat. § 1-75.4.

9. Venue is proper in this District under 28 U.S.C. §§ 1391(b), (c), and (d), in that Defendant Mondi Incoat, and thereby its parent company Mondi Group, conduct business in this District, a substantial part of the events giving rise to the claims occurred in this District, and Defendants are subject to personal jurisdiction in this District.

FACTUAL BACKGROUND

10. Loparex is the owner of U. S. Patent No. 7,879,420 (“the ‘420 Patent”), entitled, “Multi-Layered Liner, a Multi-Layered Product Which Includes the Release Liner and a Method for Making the Release Liner.” A copy of the ‘420 patent is attached to this Complaint as Exhibit A. The ‘420 patent issued more than six years ago, on February 1, 2011.

11. The inventors of the invention claimed in the ‘420 Patent are Timo Pahl, Hannu Kaasalainen, and Anssi Pulkkinen.

12. The application upon which the ‘420 patent was issued was filed with the United States Patent and Trademark Office (“USPTO”) on April 25, 2008 and was published to the world by the USPTO on September 25, 2008.

13. The application upon which the '420 patent was issued was a continuation of an earlier patent application, Serial No. 11/035,808, which had been filed with the USPTO on January 14, 2005. Application Serial No. 11/035,808 was published to the world by the USPTO on September 29, 2005.

14. Application Serial No. 11/035,808, upon which the '420 patent was based as described above, was based on an international patent application filed on July 18, 2002, Application No. 2002321342. That international application was published to the world on January 16, 2003 by the World Intellectual Property Organization.

15. Based upon the foregoing, the '420 patent has a "priority date" of July 18, 2002, and its disclosure has been published and available to the public around the world since, at the latest, January 16, 2003.

16. On or about January 6, 2005, the inventors Timo Pahl, Hannu Kaasalainen, and Anssi Pulkkinen assigned their interests in the invention that is disclosed and claimed in the '420 patent to a company named Loparex OY. At that time, Loparex OY, a limited liability company organized and existing in Finland, was a wholly owned subsidiary of Loparex Holding B.V., which was an affiliate of Plaintiff Loparex LLC, in that Loparex OY and Loparex Holding B.V. were both subsidiaries within the Loparex International Holding B.V. group.

17. On or about March 29, 2008, Loparex Holding B.V. entered into an agreement to sell Loparex OY to Mondi Coating B.V. Like Defendant Mondi

Inncoat, Mondi Coating B.V. is, or at least was at that time, a subsidiary of Defendant Mondi Group.

18. Thereafter, on or about July 1, 2008, Loparex OY assigned all of its right, title, and interest in the invention that is disclosed and claimed in the '420 patent to Plaintiff Loparex LLC. That assignment was recorded at the USPTO on August 14, 2008, so it was of public record by that date.

19. On or about August 29, 2008, Plaintiff Loparex LLC licensed Mondi Coating B.V. to practice the '420 technology, with certain geographic limitations.

20. The sale described in Paragraph 17 closed on August 31, 2008.

21. Thus, by reason of the facts described in Paragraphs 16 – 20 above, the invention that is disclosed and claimed in the '420 patent was (a) first owned by the inventors Timo Pahl, Hannu Kaasalainen, and Anssi Pulkkinen, (b) then assigned to Loparex OY, which was not then but which thereafter became a subsidiary of Defendant Mondi Group, and (c) then assigned to Plaintiff Loparex.

22. Thus, Defendants Mondi Group and Mondi Inncoat GmbH are in privity with the entity, Loparex OY, that assigned to Plaintiff Loparex LLC the intellectual property that became the '420 patent. Indeed, Loparex OY is now owned by the Mondi Group, of which Mondi Inncoat GmbH is also a part.

23. In spite of the foregoing, Defendant Mondi Inncoat GmbH now asserts that the inventors named on the '420 patent, as explained above in Paragraph 11, are not the inventors of the invention claimed in the '420 patent.

More particularly, Defendant Mondi Inncoat GmbH now asserts that a different individual, who has allegiance to Defendant Mondi Inncoat GmbH, should have been named as the inventor of the invention claimed in the '420 patent.

24. Also in spite of the foregoing, Defendant Mondi Inncoat GmbH now asserts that the '420 patent is invalid, either for failure to name the proper inventor or for inequitable conduct during the prosecution of the application that led to the issuance of the '420 patent, or both.

25. Were any of the assertions by Defendant Mondi Inncoat GmbH as described in Paragraphs 23 and 24 correct, Plaintiff's ownership of the '420 patent may be jeopardized or eliminated, or the limitations upon the Defendant Mondi Inncoat GmbH from practicing the invention set forth in the claims of the '420 patent would be removed by invalidating the '420 patent.

26. All of the assertions by Defendant Mondi Inncoat GmbH described in Paragraphs 23 and 24 are false.

FIRST CAUSE OF ACTION

(Declaratory Judgment of Patent Claim Validity)

27. Under all the circumstances, there is an actual and substantial controversy between Plaintiff and Defendants, Plaintiff and Defendants having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

28. Plaintiff is entitled to a declaratory judgment from this Court that:
- a. The inventors named on the '420 patent, as explained above in Paragraph 11, are the inventors of the invention claimed in the '420 patent; and
 - b. The claims of the '420 patent are not invalid.

SECOND CAUSE OF ACTION

(Declaratory Judgment of Assignor Estoppel)

29. Plaintiff incorporates by reference each and every allegation set forth above, not inconsistent herewith, as if fully repeated herein.

30. By reason of the foregoing facts as alleged in Paragraphs 1 through 22 and 27, and based upon the principle of assignor estoppel as described in *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220 (Fed. Cir. 1988), *Shamrock Technologies, Inc. v. Medical Sterilization, Inc.*, 903 F.2d 789 (Fed. Cir. 1990), and such other authorities made and provided, Defendants are estopped from contending that the inventors named on the '420 patent, as explained above in Paragraph 11, are not the inventors of the invention claimed in the '420 patent and/or that the '420 patent is invalid, either for failure to name the proper inventor or for inequitable conduct during the prosecution of the application that led to the issuance of the '420 patent.

31. Plaintiff is entitled to a declaratory judgment from this Court that Defendants are estopped from contending that the inventors named on the '420

patent, as explained above in Paragraph 11, were not the inventors of the invention claimed in the '420 patent and/or that the '420 patent is invalid, either for failure to name the proper inventor or for inequitable conduct during the prosecution of the application that led to the issuance of the '420 patent.

THIRD CAUSE OF ACTION

(Declaratory Judgment of Bar by Laches)

32. Plaintiff incorporates by reference each and every allegation set forth above, not inconsistent herewith, as if fully repeated herein.

33. By reason of the foregoing facts as alleged in Paragraphs 1 through 22 and 27, Defendants are barred by the doctrine of laches from contending that the inventors named on the '420 patent, as explained above in Paragraph 11, are not the inventors of the invention claimed in the '420 patent and/or that the '420 patent is invalid, either for failure to name the proper inventor or for inequitable conduct during the prosecution of the application that led to the issuance of the '420 patent.

34. Plaintiff is entitled to a declaratory judgment from this Court that Defendants are barred by the doctrine of laches from contending that the inventors named on the '420 patent, as explained above in Paragraph 11, are not the inventors of the invention claimed in the '420 patent and/or that the '420 patent is invalid, either for failure to name the proper inventor or for inequitable

conduct during the prosecution of the application that led to the issuance of the '420 patent.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays:

- a. For a declaratory judgment that:
 - a. The inventors named on the '420 patent, as explained above in Paragraph 11, are the inventors of the invention claimed in the '420 patent; and
 - b. That the claims of the '420 patent are not invalid; and
- b. For a declaratory judgment that Defendants are estopped from contending that the inventors named on the '420 patent are not the inventors of the invention claimed in the '420 patent and/or that the '420 patent is invalid, either for failure to name the proper inventor or for inequitable conduct during the prosecution of the application that led to the issuance of the '420 patent; and
- c. For a declaratory judgment that Defendants are barred by the doctrine of laches from contending that the inventors named on the '420 patent, as explained above in Paragraph 11, are not the inventors of the invention claimed in the '420 patent and/or that the '420 patent is invalid, either for failure to name the proper inventor or

for inequitable conduct during the prosecution of the application that led to the issuance of the '420 patent; and

- d. Such other and further relief as the Court may deem just and proper.

Respectfully submitted,

NEXSEN PRUET, LLC

August 18, 2017

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