

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION

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U.S. DISTRICT COURT
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TEXAS EASTERN

GENETIC APPLICATIONS LLC

Plaintiff,

vs.

INVITROGEN CORPORATION

Defendant.

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Civil Action No. *6:06cv 434*
Jury Trial Demanded

BY _____

COMPLAINT

Plaintiff Genetic Applications LLC (“Genetic Applications”) brings this action against Defendant Invitrogen Corporation (“Invitrogen”) and for its cause of action alleges:

JURISDICTION AND VENUE

1. This is an action for patent infringement arising under the patent laws of the United States, more particularly 35 U.S.C. §§ 271 and 281.
2. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).
3. Venue is proper in this Judicial District under 28 U.S.C. §§ 1391(b) and 1400(b).

THE PARTIES

4. Plaintiff Genetic Applications LLC is a California Limited Liability Company with its principal place of business at 11009 Alonda Ct., San Diego, CA 92126.
5. Upon information and belief, defendant Invitrogen is a corporation organized and existing under the laws of the State of Delaware with its principal place of business at 1500 Faraday Avenue, Carlsbad, CA 92008. Invitrogen may be served with process by serving its registered agent, Corporation Service Company D/B/A/ CSC-Lawyers

Incorporating Service Company, 701 Brazos Street, Suite 1050, Austin, TX 78701. Genetic Applications is further informed and believes, and thereon alleges, that Invitrogen does business in this Judicial District.

6. Upon information and belief, Life Technologies, Inc. ("Life Technologies") was until July 7, 2000 a corporation organized and existing under the laws of the State of Delaware with its principal place of business at 9800 Medical Center Drive Rockville, MD 20850. Upon information and belief, Life Technologies entered into a definitive merger agreement with Invitrogen on July 7, 2000.

7. Genetic Applications is the sole assignee of United States Patent No. 5,670,347 ("the '347 patent"), duly and lawfully issued on September 23, 1997, describing and claiming the invention entitled "Peptide-mediated gene transfer." A true and correct copy of the '347 patent is attached hereto as Exhibit 1. As Assignee, Genetic Applications has acquired and continues to maintain an exclusive interest in the '347 patent, including the right to sue thereon and the right to obtain relief for infringement thereof.

8. Life Technologies, now merged with Invitrogen, was put on notice on June 25, 1999 of the '347 patent via letter. On June 29, 1999, Genetic Applications filed a lawsuit against Life Technologies alleging patent infringement of the '347 patent in the Southern District of California, case number 99-CV-01337. This lawsuit was not served, as the patent was put into the reissue process at the request of Life Technologies shortly thereafter. During the course of negotiations, Life Technologies brought several references to the attention of Genetic Applications that it believed were relevant to the patentability of the '347 patent and thus its reissue. Life Technologies provided additional references for review in the reissue process as late as June 2, 2000. All of these materials have been considered by the United States Patent and Trademark Office ("PTO") during the course of the reissue process.

9. On information and belief, the employees involved in the negotiations for Life

Technologies now hold prominent positions at Invitrogen, including: Stuart Hepburn, Vice President of Corporate Development; Alan W. Hammon, Esq., Chief Intellectual Property Counsel, and John Cottingham, Esq., Senior vice President, General Counsel and Corporate Secretary.

10. Genetic Applications is the sole assignee of United States Reissue Patent No. RE39220 (“the R’220 patent”), a reissue of the ‘347 patent that duly and lawfully issued on August 1, 2006. A true and correct copy of the R’220 patent is attached hereto as Exhibit 2. As Assignee, Genetic Applications has acquired and continues to maintain an exclusive interest in the R’220 patent, including the right to sue thereon and obtain relief for infringement thereof.

11. Defendant Invitrogen has infringed and actively induced infringement of the R’220 patent within this District by selling products employing the invention, without authority or license from plaintiff.

12. Defendant Invitrogen has profited and continues to profit by its infringing activities.

13. Plaintiff Genetic Applications has been damaged as a result of defendant's infringing activities.

FACTUAL BACKGROUND

14. On information and belief, Life Technologies invited the inventor of the ‘347 patent to their Rockville, MD headquarters in March of 1997. After Life Technologies signed a confidentiality agreement, the inventor of the ‘347 patent discussed his proprietary “Peptide-Mediated Gene Transfer” technology. A copy of this agreement is attached as Exhibit 3. The information discussed regarding the patent-pending technology became public only after the patent issued September 23, 1997. This confidentiality agreement was signed by Stuart Hepburn, Vice President of Corporate Development of Life Technologies. He retained this position at Invitrogen after the merger.

15. On information and belief, in August of 1997 Life Technologies introduced a product named the PLUS Reagent useful for the introduction of DNA into the nucleus of living cells. A true and correct copy of an initial reference is attached hereto as Exhibit 4. On information and belief, Defendant Invitrogen continues to sell the PLUS Reagent.

16. On May 17, 1999, Genetic Applications purchased the PLUS Reagent from Life Technologies. A true and correct copy of the invoice is attached hereto as Exhibit 5.

17. On information and belief, Life Technologies offers its products for sale and sells its products in the Eastern District of Texas.

18. Prior to filing this Complaint, Genetic Applications sent an unopened vial of PLUS Reagent to the Howard Hughes Medical Institute (HHMI) Biopolymer Facility at Yale University to ascertain its composition. A true and correct copy of the report from the analysis is attached hereto as Exhibit 6.

19. Prior to the filing the initial Complaint, the PLUS Reagent was sold in combination with another product, LipofectAMINE, and marketed as LipofectAMINE Plus. On information and belief, after the filing of the initial Complaint, Life Technologies separated the products, however it continued, and Invitrogen continues, to sell both products and actively promote their combination.

20. Based upon the Yale report, Genetic Applications concluded that the defendant's PLUS Reagent does, in fact, continue to infringe one or more claims of the R'220 patent.

CLAIM FOR RELIEF

INFRINGEMENT OF UNITED STATES REISSUE PATENT NO. 39,220

21. The allegations of Paragraphs 1-19 are repeated, realleged, and incorporated by reference as though fully set forth herein.

22. On information and belief, Invitrogen has been and still is infringing the R'220 patent by making, using, offering for sale, and selling the PLUS Reagent embodying the claimed inventions of the R'220 patent and will continue to make, use,

offer for sale, and sell such infringing products, to the irreparable loss and injury of Genetic Applications unless restrained therefrom by this Court. By providing such products, Invitrogen has in the past and continues to infringe directly, by inducement, or by contributing to the infringement of the R'220 patent.

23. On information and belief, Genetic Applications LLC alleges that Life Technologies and thus Invitrogen knew of their infringement after the '347 patent issued on September 23, 1997 and before the R'220 patent issued on August 1, 2006. Despite such knowledge, Invitrogen continued to make, use, offer for sale, and sell infringing products, such acts subsequent to the '347 patent's issuance on September 23, 1997 constituting willful and deliberate infringement.

24. On information and belief, Invitrogen has derived, received, and will continue to derive and receive from the aforesaid acts of infringement gains, profits, and advantages in the amount that is not presently known to Genetic Applications. By reason of the aforesaid acts of infringement, Genetic Applications has been, and will continue to be, greatly damaged in an amount to be determined at trial.

DEMAND FOR JUDGMENT

WHEREFORE, Genetic Applications prays for the following relief:

A. That this court adjudge that plaintiff is the exclusive licensee under the R'220 patent and is entitled to right of recovery thereunder;

B. That this court adjudge that the R'220 patent is good and valid law and that defendant has infringed, actively induced and/or contributed to the infringement thereof;

C. That defendant's infringement of the R'220 patent be adjudged to have been willful under 35 U.S.C. §284;

D. That defendant, its officers, employees, servants, agents, attorneys, and all other persons acting in concert, participation, or privity with it who receive actual notice of the order by personal service of otherwise, and defendant's successors and assigns, be forthwith preliminarily and thereafter permanently restrained and enjoined from directly

or indirectly infringing on the R'220 patent;

E. An accounting and an award for damages arising out of defendant's infringement of the R'220 patent;


F. An award of treble damages and attorneys' fees because of defendant's willful infringement of the R'220 patent under 35 U.S.C. §§ 284 & 285;

G. An assessment of prejudgment and post judgment interest and costs against defendants, together with an award of such interests and costs, in accordance with 35 U.S.C. § 284; and

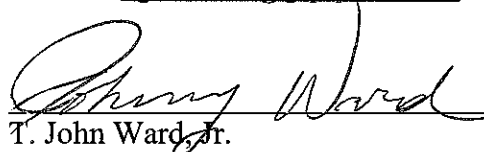
H. That this Court grant plaintiff such other and further relief as it may deem just and appropriate.

Respectfully Submitted,

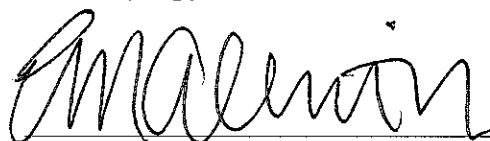
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