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**ORIGINAL**

**ROBERT H. CLELAND**

**Thomas Carlson**

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF MICHIGAN  
SOUTHERN DIVISION**

**UBE MACHINERY INC.,  
a Delaware Corporation,**

**Plaintiff,**

**Case No.**

**v.**

**MILACRON INC.,  
a Delaware Corporation,  
Defendant.**

**DEMAND FOR JURY TRIAL**

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**FILED**

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**COMPLAINT FOR DECLARATORY JUDGMENT  
OF NON-INFRINGEMENT AND INVALIDITY**

Plaintiff, UBE Machinery Inc. ("Plaintiff"), for its complaint against Defendant,

Milacron Inc. ("Milacron"), alleges as follows:

### THE PARTIES

1. Plaintiff UBE Machinery Inc. is a corporation organized and existing under the laws of the State of Delaware and has a principal place of business at 5700 S. State Street, Ann Arbor, Michigan 48108. For many years, including prior to June 20, 1988, UBE Machinery Inc. and its predecessors (herein after collectively "UMI") have sold in the United States injection molding machines for plastic products.

2. On information and belief, Milacron is a corporation organized under the laws of the State of Delaware having a place of business at 2090 Florence Avenue, Cincinnati, Ohio 45206 as well as other locations in and outside of the United States, including the State of Michigan. Milacron is in commercial competition with UMI in the field of plastic injection molding machines. On information and belief, Milacron is the owner, by assignment, of United States Patent No. 5,062,052 ("the '052 patent"), titled "Logic Controlled Plastic Molding Machine With Programmable Operator Interface," which issued on October 29, 1991, on an application filed in the United States on June 20, 1989. The '052 patent was subsequently reexamined and issued a reexamination certificate number B1 5,062,052. (Exhibit I)

### JURISDICTION AND VENUE

3. Jurisdiction in this action is predicated on 35 U.S.C. § 101 et seq. in that this action arises out of the Patent Laws of the United States, Title 35 of the United States Code; the provisions of 28 U.S.C. § 1338; on 28 U.S.C. § 1331; and on the fact

that the specific remedy sought is based on the laws authorizing Declaratory Judgments, 28 U.S.C. §§ 2201 and 2202.

4. Venue is proper in this Judicial District pursuant to 28 U.S.C. § 1391, since Defendant Milacron resides in this Judicial District and/or a substantial part of the events giving rise to this Complaint for Declaratory Relief occurred within this Judicial District.

5. This Court also has a personal jurisdiction over Milacron, because it regularly conducts business in this Judicial District out of which this action in part arises.

6. This action is brought for the purpose of determining a question of actual controversy between the parties as hereinafter more fully described.

#### **FACTUAL ALLEGATIONS**

7. UMI has for many years been a leading seller of UBE injection molding machines to customers in the United States including automobile manufacturers and other molders with offices and plants in this District. As a result, UBE injection molding machines have gained wide acceptance among this customer base including, importantly, the United States automotive industry.

8. The importation and sale of UBE injection molding machines to customers in the United States began years before Milacron's June 20, 1989 filing of its application for the '052 patent. For example, the UBE Saturn system was sold to and installed at Saturn Corporation's plant years before Milacron's application for the '052 patent was filed and remains in use today at the Saturn plant.

9. Unlike the injection molding machine of the '052 patent which requires four control levels that can process simultaneously, the UBE injection molding machines, including the Saturn system, have only two control levels, and a control architecture substantially different from the four-level control architecture of the '052 patent. This UBE two-level control architecture remains to this day in all UBE injection molding machines.

10. Despite the significant and substantial differences between the UBE injection molding machines and the claims of the '052 patent, and the sales of the UBE injection molding machines in the United States years prior to the filing of the '052 patent application, Milacron on July 24, 2000, sent Plaintiff a letter alleging infringement of the '052 patent. (Exhibit II). In that letter, Milacron asserted its allegation of infringement and threatened to pursue action against Plaintiff before the International Trade Commission and in Federal Court. On information and belief, Milacron on August 17, 2000 filed a patent infringement action against Plaintiff in Federal District Court in Ohio, a venue in which Plaintiff \ neither resides nor has a place of business.

11. Plaintiff denies the charges of infringement and further alleges that the claims of the '052 patent are invalid and/or unenforceable. Thus, an actual justiciable controversy exists between Plaintiff and Milacron as to the infringement, validity and enforceability of the '052 patent.

**COUNT I**  
**DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

12. Plaintiff reasserts Paragraphs 1 through 11 as if fully contained herein.

13. Given the significant and substantial differences between the UBE machines and the '052 patent, it is clear that UMI has not manufactured, used, sold, offered for sale, or imported in the United States any products that infringe the '052 patent, and has not otherwise committed any acts in violation of 35 U.S.C. § 271.

14. Because of the amendments and arguments made during the prosecution of the applications, including the reexamination application, leading to the '052 patent, Milacron is estopped from contending that the claims of the '052 patent can be interpreted to cover any accused UMI products.

15. Milacron is estopped from construing the claims of the '052 patent to cover and include any products made, used, sold, offered for sale, or imported by UMI.

16. UMI's products are far different in function, way of operation and result from the product disclosed and claimed '052 patent, thereby precluding any infringement of the '052 patent.

17. Milacron's assertion of infringement ignores the elements of the '052 patent claims, elements that were argued to the United States Patent and Trademark Office as being necessary to distinguish over the prior art and were found by the United States Patent Office Board of Patent Appeals and Interferences necessary to distinguish the '052 claims from the prior art. Indeed the Board of Patent Appeals and

Interferences in construing the claims of the '052 patent stated: "Means-plus-function claims are limited to the means described in the specification and their reasonable equivalents [citations omitted] ....The ['052] claims, when read in light of the structure in the specification, are quite specific."

18. In view of the above, when the claims of the '052 patent are construed properly, Milacron's allegation of infringement is without merit since the claims of the '052 patent are not infringed.

**COUNT II**  
**DECLARATORY JUDGMENT OF INVALIDITY**

19. Plaintiff reasserts Paragraphs 1 through 18 as if fully contained herein.

20. If construed as alleged by Milacron, the claims of the '052 patent are invalid based upon the prior UBE injection molding machines, which were on sale in the United States more than one year prior to the June 20, 1989 filing date of the '052 patent. For example, the UBEMAX415-50F injection molding machine, which includes a Hi-jector-10 controller and a "Hiject Call/C" operator terminal, and the UBE Saturn system machine, which incorporates a GE Alphix™ controller and a Nematron computer, were offered for sale and sold in the United States, before June 20, 1988.

21. In view of the above, even were the claims to be construed as Milacron has alleged for purposes of infringement, the sale of UBE injection molding machines in the United States prior to June 20, 1988 renders the '052 patent invalid.

22. The '052 patent is invalid for failing to comply with the conditions and requirements as set forth in the United States Patent laws, including but not limited to

35 U.S.C. §§ 102 and 103.

23. The '052 patent is also invalid for failing to comply with the conditions and requirements for patentability as set forth in the United States patent laws, 35 U.S.C., § 112, including but not limited to the enablement requirement, the written description requirement, the best mode requirement, and the requirement that the claims particularly point out and distinctly claim the subject matter of the patent.

24. Plaintiff alleges that Milacron failed to make adequate investigation of the accused products before threatening to bring and, on information and belief, now actually has brought an action for patent infringement against Plaintiff and has wrongfully and without reasonable basis threatened to maintain such an action. Notwithstanding knowledge that the claims against Plaintiff have no merit, Milacron continues to maintain a patent infringement action in a venue in which Plaintiff neither resides nor has a place of business.

25. This case is an exceptional case under 35 U.S.C. § 285 because, inter alia, Milacron failed to make an adequate investigation before alleging infringement and threatening and now having brought a patent infringement action.

**PRAYER FOR RELIEF**

WHEREFORE, THE PLAINTIFF, UBE MACHINERY INC., prays that this Court:

- a) Enter judgment that UBE Machinery Inc.'s. manufacture, importation, sale, offer for sale, and use of its products do not constitute an infringement of the '052 patent and that it has not otherwise performed any acts that violate 35 U.S.C. § 271, or in the alternative, enter judgment that the '052 patent is invalid, void and unenforceable;
- b) Enter judgment awarding UBE Machinery Inc. its costs and expenses, including attorneys' fees;
- c) Enter judgment that this is an exceptional case under 35 U.S.C. § 285 and award attorneys' fees pursuant to that section.
- d) Enter judgment for UBE Machinery Inc. for such other relief as this Court may deem just or proper.

JURY DEMAND: UBE MACHINERY INC. requests a trial by jury on all issues so triable.

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DATED: August 18, 2000

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF MICHIGAN

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THAT WERE NOT  
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