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3:04-CV-01200 PROMETHEUS LAB INC V. MAYO COLLABORATIVE

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Natalie J. Morgan (SBN 211,143)
2 Michael J. Hostetler (SBN 216,656)
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5 Attorneys for Plaintiff Prometheus Laboratories Inc.
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FILED

06 APR 14 PM 2:25

CLERK, U.S. DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

BY

DEPUTY

8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA

10 PROMETHEUS LABORATORIES, INC.,)
11 Plaintiff,)
12 v.)
13 MAYO COLLABORATIVE SERVICES dba)
MAYO MEDICAL LABORATORIES, and)
14 MAYO CLINIC ROCHESTER)
15 Defendant.)

CASE NO.: 04-CV-1200 JAH (RBB)

SECOND AMENDED COMPLAINT
FOR PATENT INFRINGEMENT

JURY DEMAND

16 MAYO COLLABORATIVE SERVICES dba)
17 MAYO MEDICAL LABORATORIES,)
18 Counter-Claimant,)
19 v.)
20 PROMETHEUS LABORATORIES, INC.,)
21 Counter-Defendant.)
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ORIGINAL

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1 Plaintiff PROMETHEUS LABORATORIES INC. ("PROMETHEUS") for its Second
2 Amended Complaint against Defendant MAYO COLLABORATIVE SERVICES dba MAYO
3 MEDICAL LABORATORIES ("MML") and Defendant MAYO CLINIC ROCHESTER
4 ("MAYO CLINIC") alleges as follows:

5 **THE PARTIES**

6 1. Plaintiff PROMETHEUS is a corporation organized and existing under the laws
7 of the State of California with its principal place of business located at 5739 Pacific Center
8 Blvd., San Diego, California.

9 2. Defendant MML is a corporation organized and existing under the laws of the
10 State of Minnesota and doing business within this judicial district.

11 3. Defendant MAYO CLINIC is a non-profit corporation organized and existing
12 under the laws of the State of Minnesota and doing business in the State of California.

13 **JURISDICTION AND VENUE**

14 4. This is a civil action for patent infringement arising under the Patent Laws of the
15 United States, 35 U.S.C. §§ 1 *et seq.* Subject matter jurisdiction is proper under 28 U.S.C.
16 §§ 1331 and 1338(a). Venue is proper in this judicial district under 28 U.S.C. §§ 1391(b) and
17 1400(b).

18 **FIRST CLAIM FOR RELIEF**

19 **INFRINGEMENT OF U.S. PATENT NO. 6,355,623**

20 5. On March 12, 2002, United States Patent No. 6,355,623 ("the '623 Patent"),
21 entitled "Method of Treating IBD/Crohn's Disease And Related Conditions Wherein Drug
22 Metabolite Levels In Host Blood Cells Determine Subsequent Dosage," was duly and legally
23 issued to Hopital-Sainte-Justine, as Assignee. PROMETHEUS is presently the sole and
24 exclusive licensee of the '623 patent. A true and correct copy of the '623 Patent is attached
25 hereto as Exhibit A.

26 6. PROMETHEUS alleges that MML and MAYO CLINIC have infringed and
27 continue to infringe the '623 Patent directly, contributorily, and by inducement of others, by
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1 making, using, selling, importing and/or offering for sale methods covered by the '623 Patent.

2 MML and MAYO CLINIC are liable for patent infringement pursuant to 35 U.S.C. § 271.

3 7. Further, PROMETHEUS is entitled to a declaration that if the test described in the
4 June 9, 2004 "Implementation Notice: New Test" were used or sold, such use or sale would
5 infringe methods covered by the '623 Patent pursuant to the Federal Declaratory Judgment Act,
6 28 U.S.C. §§ 2201 *et seq.*

7 8. MML's and MAYO CLINIC's infringement of the '623 Patent has caused and
8 continues to cause damage to PROMETHEUS in an amount to be determined at trial. MML's
9 and MAYO CLINIC's infringement as herein alleged will continue to cause immediate and
10 irreparable harm to PROMETHEUS for which there is no adequate remedy at law, unless this
11 Court enjoins and restrains such activities.

12 9. PROMETHEUS is informed and believes and, on the basis of such information
13 and belief, alleges that MML's and MAYO CLINIC's infringement of the '623 Patent is willful
14 and deliberate, entitling PROMETHEUS to enhanced damages pursuant to 35 U.S.C. §284 and
15 to an award of attorneys' fees and costs incurred in prosecuting this action pursuant to 35 U.S.C.
16 285.

17 **SECOND CLAIM FOR RELIEF**

18 **INFRINGEMENT OF U.S. PATENT NO. 6,680,302**

19 10. On January 20, 2004, United States Patent No. 6,680,302 ("the '302 Patent"),
20 entitled "Methods of optimizing drug therapeutic efficacy for treatment of immune-mediated
21 gastrointestinal disorders," was duly and legally issued to Hopital-Sainte-Justine, as Assignee.
22 PROMETHEUS is presently the sole and exclusive licensee of the '302 Patent. A true and
23 correct copy of the '302 Patent is attached hereto as Exhibit B.

24 11. PROMETHEUS alleges that MML and MAYO CLINIC have infringed and
25 continue to infringe the '302 Patent directly, contributorily, and by inducement of others, by
26 making, using, selling, importing and/or offering for sale methods covered by the '302 Patent.
27 MML and MAYO CLINIC are liable for patent infringement pursuant to 35 U.S.C. § 271.

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1 12. Further, PROMETHEUS is entitled to a declaration that if the test described in the
2 June 9, 2004 "Implementation Notice: New Test" were used or sold, such use or sale would
3 infringe methods covered by the '623 Patent pursuant to the Federal Declaratory Judgment Act,
4 28 U.S.C. §§ 2201 *et seq.*

5 13. MML's and MAYO CLINIC's infringement of the '302 Patent has caused and
6 continues to cause damage to PROMETHEUS in an amount to be determined at trial. MML's
7 and MAYO CLINIC's infringement as herein alleged will continue to cause immediate and
8 irreparable harm to PROMETHEUS for which there is no adequate remedy at law, unless this
9 Court enjoins and restrains such activities.

10 14. PROMETHEUS is informed and believes and, on the basis of such information
11 and belief, alleges that MML's and MAYO CLINIC's infringement of the '302 Patent is willful
12 and deliberate, entitling PROMETHEUS to enhanced damages pursuant to 35 U.S.C. § 284 and
13 to an award of attorneys' fees and costs incurred in prosecuting this action pursuant to 35 U.S.C.
14 § 285.

15 WHEREFORE, PROMETHEUS prays for relief as follows:

16 1. That judgment be entered in favor of PROMETHEUS that the '623 Patent is
17 infringed by MML and MAYO CLINIC;

18 2. A declaration that if the test described in the June 9, 2004 "Implementation
19 Notice: New Test" were used or sold, such use or sale would infringe methods covered by the
20 '623 Patent;

21 3. That PROMETHEUS be granted an accounting of all damages sustained as a
22 result of MML's and MAYO CLINIC's infringement of the '623 Patent;

23 4. That judgment be entered in favor of PROMETHEUS that the '302 Patent is
24 infringed by MML and MAYO CLINIC;

25 5. A declaration that if the test described in the June 9, 2004 "Implementation
26 Notice: New Test" were used or sold, such use or sale would infringe methods covered by the
27 '302 Patent;

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1 6. That PROMETHEUS be granted an accounting of all damages sustained as a
2 result of MML's and MAYO CLINIC's infringement of the '302 Patent;

3 7. That PROMETHEUS be awarded actual damages together with prejudgment
4 interest according to proof, and enhanced damages pursuant to 35 U.S.C. § 284.

5 8. For a preliminary and permanent injunction enjoining MML's and MAYO
6 CLINIC's acts of infringement and those of its officers, agents, servants, employees,
7 subsidiaries, and any persons acting in concert with MML and MAYO CLINIC, including
8 related individuals and entities, customers, representatives, OEMs, dealers, and distributors;

9 9. That PROMETHEUS be awarded attorneys' fees and costs pursuant to 35 U.S.C.
10 § 285 or as otherwise provided by law; and

11 10. That the Court award PROMETHEUS such other and further relief as the Court
12 deems just and proper.

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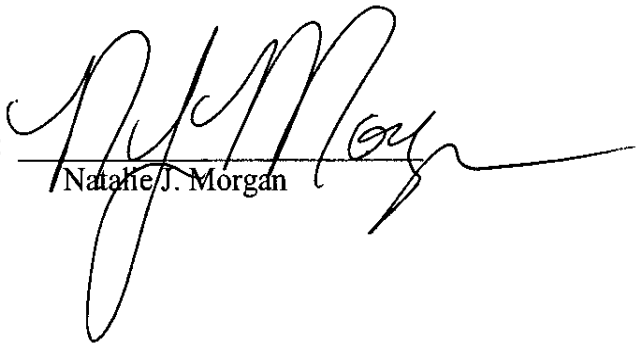
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JURY DEMAND

PROMETHEUS demands a trial by jury on all issues so triable as a matter of right and law.

DATED: April 11, 2006

WILSON SONSINI GOODRICH & ROSATI
Attorneys for Plaintiff Prometheus Laboratories Inc.

By: 
Natalie J. Morgan

1 F. T. Alexandra Mahaney (SBN 125,984)
Natalie J. Morgan (SBN 211,143)
2 Michael J. Hostetler (SBN 216,656)
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8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA

10 PROMETHEUS LABORATORIES, INC.,)

CASE NO.: 04-CV-1200 JAH (RBB)

11 Plaintiff,)

CERTIFICATE OF SERVICE

12 v.)

13 MAYO COLLABORATIVE SERVICES dba)
MAYO MEDICAL LABORATORIES, and)
14 MAYO CLINIC ROCHESTER)

15 Defendant.)

16 MAYO COLLABORATIVE SERVICES dba)
MAYO MEDICAL LABORATORIES,)

17 Counter-Claimant,)

18 v.)

19 PROMETHEUS LABORATORIES, INC.,)
20)

21 Counter-Defendant.)
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I, Tracy J. Cassell, declare:

I am and was at the time of the service mentioned in this declaration, employed in the County of San Diego, California. I am over the age of 18 years and not a party to the within action. My business address is 12235 El Camino Real, Ste. 200, San Diego, CA, 92130.

On April 11, 2006, I served a copy(ies) of the following document(s):

1. SECOND AMENDED COMPLAINT FOR PATENT INFRINGEMENT

on the parties to this action addressed as follows:

Attorney	Party(ies) Served	Method of Service
Juanita Brooks, Esq. Jennifer Bush, Esq. Fish & Richardson P.C. 12390 El Camino Real San Diego, CA 92130 Tel.: 858 678-7070 Facsimile: 858 678-5099	Attorneys for: MAYO COLLABORATIVE dba MAYO MEDICAL LABORATORIES and MAYO CLINIC ROCHESTER	Facsimile and Federal Express
Jonathan E. Singer, Esq. Fish & Richardson P.C. 3300 Dain Rauscher Plaza 60 South Sixth Street Minneapolis, MN 55402 Tel.: 612 335-5070 Facsimile: 612 288-9696	Attorney for: MAYO COLLABORATIVE SERVICES dba MAYO MEDICAL LABORATORIES and MAYO CLINIC ROCHESTER	Facsimile and Federal Express

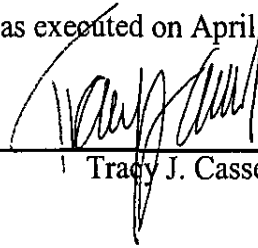
(BY MAIL) I placed the sealed envelope(s) for collection and mailing by following the ordinary business practices of Wilson Sonsini Goodrich & Rosati, 12235 El Camino Real, Ste. 200, San Diego, CA. I am readily familiar with WSGR's practice for collecting and processing of correspondence for mailing with the United States Postal Service, said practice being that, in the ordinary course of business, correspondence with postage fully prepaid is deposited with the United States Postal Service the same day as it is placed for collection.

(BY FACSIMILE) I caused to be transmitted by facsimile machine (number of sending facsimile machine is (858) 350-2399 at the time stated on the attached transmission report(s) by sending the document(s) to (see above). The facsimile transmission(s) was reported as complete and without error.

(BY PERSONAL SERVICE) I caused to be delivered by hand to the addressee(s) noted above. I delivered to an authorized courier or driver to be delivered on the same date. A proof of service signed by the authorized courier will be filed with the court upon request.

1 (BY OVERNIGHT DELIVERY) I placed the sealed envelope(s) or package(s), to the
2 addressee(s) noted above, designated by the express service carrier for collection and
3 overnight delivery by following the ordinary business practices of Wilson Sonsini
4 Goodrich & Rosati, 12235 El Camino Real, Ste. 200,, San Diego, CA. I am readily
5 familiar with WSGR's practice for collecting and processing of correspondence for
6 overnight delivery, said practice being that, in the ordinary course of business,
7 correspondence for overnight delivery is deposited with delivery fees paid or provided for
8 at the carrier's express service offices for next-day delivery the same day as the
9 correspondence is placed for collection.

10 I declare under penalty of perjury under the laws of the State of California that the
11 above is true and correct, and that this declaration was executed on April 11, 2006 .

12 

13 _____
14 Tracy J. Cassell