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FILED

JAN - 4 2007

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

1 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
A Limited Liability Partnership
2 Including Professional Corporation
3 PHILIP F. ATKINS-PATTENSON, Cal. Bar No. 94901
Four Embarcadero Center, 17th Floor
4 San Francisco, CA 94111-4106
Telephone: 415-434-9100
5 Facsimile: 415-434-3947

6 Attorneys for Plaintiff
7 INTUITIVE SURGICAL, INC.

8 UNITED STATES DISTRICT COURT
9 NORTHERN DISTRICT OF CALIFORNIA

10 SAN JOSE DIVISION

C 07 0063

JCS

12 INTUITIVE SURGICAL, INC.,

13 Plaintiff,

14 v.

16 CALIFORNIA INSTITUTE OF
TECHNOLOGY,

17 Defendant.

Case No.

**COMPLAINT FOR DECLARATORY
RELIEF**

DEMAND FOR JURY TRIAL

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2 Plaintiff Intuitive Surgical, Inc. (“Intuitive Surgical”), for its complaint against Defendant
3 California Institute of Technology (“Caltech”), alleges as follows:

4 **THE PARTIES**

5 1. Intuitive Surgical is a Delaware corporation having its principal place of
6 business in Sunnyvale, California.

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8 2. Upon information and belief, Caltech is an entity organized under the laws
9 of California having a principal place of business in Pasadena, California.

10 **JURISDICTION AND VENUE**

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12 3. These claims arise under the patent laws of the United States, 35 U.S.C.
13 §§ 100 *et seq.*, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. Jurisdiction is
14 conferred upon this Court by 28 U.S.C. §§ 1331, 2201 and 2202.

15 4. Venue is proper in this District pursuant to 28 U.S.C. § 1391 because
16 Caltech resides in this District for purposes of venue determination.

17 **NATURE OF THE ACTION**

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19 5. This is an action for declaratory relief arising under the patent laws of the
20 United States, 35 U.S.C. §§ 100, *et seq.*, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201
21 and 2202. As described below, Intuitive Surgical seeks a declaratory judgment that the claims of
22 United States Patent Nos. 6,385,509; 6,223,504; 5,784,542; and 5,710,870 are invalid under one or
23 more provisions of 35 U.S.C. §§ 102, 103, and/or 112, and/or are not infringed by Intuitive
24 Surgical. An actual controversy over the validity of the patents at issue and their alleged
25 infringement exists between Intuitive Surgical and Caltech as explained below
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FIRST CLAIM FOR RELIEF

(Declaratory Judgment of Invalidity and Noninfringement of the '509 Patent)

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4 6. Intuitive Surgical re-alleges and incorporates herein Paragraphs 1 through 5
5 of this Complaint.

6 7. Caltech is identified on the face of United States Patent No. 6,385,509 (the
7 "'509 patent") as the assignee. The face of the '509 patent indicates that it was issued on May 15,
8 2001.

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10 8 An actual justiciable controversy exists between Caltech and Intuitive
11 Surgical as to whether the claims of the '509 patent are invalid and/or not infringed by Intuitive
12 Surgical.

13 9. Intuitive Surgical does not infringe any of the claims of the '509 patent by
14 the making, using, or selling of any product.

15 10. Each claim of the '509 patent is invalid for failure to comply with one or
16 more of the requirements of Title 35, United States Code, including but not limited to, 35 U.S.C.
17 §§ 102, 103 and 112.

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SECOND CLAIM FOR RELIEF

(Declaratory Judgment of Invalidity and Noninfringement of the '504 Patent)

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11. Intuitive Surgical re-alleges and incorporates herein Paragraphs 1 through 10 of this Complaint.

12. Caltech is identified on the face of United States Patent No. 6,233,504 (the "504 patent") as the assignee. The face of the patent indicates that it was issued on May 15, 2001.

13. An actual justiciable controversy exists between Caltech and Intuitive Surgical as to whether the claims of the '504 patent are invalid and/or not infringed by Intuitive Surgical.

14. Intuitive Surgical does not infringe any of the claims of the '504 patent by the making, using, or selling of any product.

15. Each claim of the '504 patent is invalid for failure to comply with one or more of the requirements of Title 35, United States Code, including but not limited to, 35 U.S.C. §§ 102, 103 and 112.

THIRD CLAIM FOR RELIEF

(Declaratory Judgment of Invalidity and Noninfringement of the '542 Patent)

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3 16. Intuitive Surgical re-alleges and incorporates herein Paragraphs 1 through
4 15 of this Complaint.

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6 17. Caltech is identified on the face of United States Patent No. 5,784,542 (the
7 “542 patent”) as the assignee. The face of the patent indicates that it was issued on July 21, 1998.

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9 18. An actual justiciable controversy exists between Caltech and Intuitive
10 Surgical as to whether the claims of the '542 patent are invalid and/or not infringed by Intuitive
11 Surgical.

12 19. Intuitive Surgical does not infringe any of the claims of the '542 patent by
13 the making, using, or selling of any product.

14 20. Each claim of the '504 patent is invalid for failure to comply with one or
15 more of the requirements of Title 35, United States Code, including but not limited to, 35 U.S.C.
16 §§ 102, 103 and 112.

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FOURTH CLAIM FOR RELIEF

(Declaratory Judgment of Invalidity and Noninfringement of the '870 Patent)

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21. Intuitive Surgical re-alleges and incorporates herein Paragraphs 1 through 20 of this Complaint.

22. Caltech is identified on the face of United States Patent No. 5,710,870 (the "870 patent") as the assignee. The face of the patent indicates that it was issued on January 20, 1998.

23. An actual justiciable controversy exists between Caltech and Intuitive Surgical as to whether the claims of the '870 patent are invalid and/or not infringed by Intuitive Surgical.

24. Intuitive Surgical does not infringe any of the claims of the '870 patent by the making, using, or selling of any product.

25. Each claim of the '870 patent is invalid for failure to comply with one or more of the requirements of Title 35, United States Code, including but not limited to, 35 U.S.C. §§ 102, 103 and 112.

PRAYER FOR RELIEF

Wherefore, Intuitive Surgical prays that:

1. A Declaration and Judgment be entered providing that:

1. The claims of the '509 patent are invalid;

2. None of the claims of the '509 patent is infringed by Intuitive

Surgical;

3. The claims of the '504 patent are invalid;

4. None of the claims of the '504 patent is infringed by Intuitive

Surgical;

5. The claims of the '542 patent are invalid;

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6. None of the claims of the '542 patent is infringed by Intuitive Surgical;
7. The claims of the '870 patent are invalid;
8. None of the claims of the '870 patent is infringed by Intuitive Surgical;

2.. Intuitive Surgical be awarded its costs and, pursuant to 35 U.S.C. § 285, its reasonable attorneys' fees; and

3.. Intuitive Surgical be awarded such other relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Intuitive Surgical hereby demands trial by jury as to all issues in this action triable by a jury.

CERTIFICATION OF INTERESTED ENTITIES OR PERSONS

Pursuant to Civil L.R. 3-16, the undersigned certifies that as of this date, other than the named parties, there is no such interest to report.

Dated: January 4, 2007

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By 
PHILIP F. ATKINS-PATTENSON

Attorneys for Plaintiff
INTUITIVE SURGICAL, INC.