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8 **THE UNITED STATES DISTRICT COURT**
FOR THE SOUTHERN DISTRICT CALIFORNIA

9
 10 MAUNA KEA TECHNOLOGIES,

11 Plaintiff,

12 v.

13 ANTICANCER, INC.

14 Defendant.

Civil Action No. '11CV1407 AJB JMA

DEMAND FOR JURY TRIAL

15 **COMPLAINT FOR DECLARATORY JUDGMENT**
 16 **OF PATENT NON-INFRINGEMENT, INVALIDITY, AND UNENFORCEABILITY**

17
 18 Plaintiff Mauna Kea Technologies (“Mauna Kea”) for its Complaint against
 19 defendant Anticancer, Inc. (“AntiCancer”) alleges as follows:

20 **THE PARTIES**

- 21 1. Plaintiff Mauna Kea Technologies is a corporation organized and existing under the
 22 laws of France with its principal place of business at 9 rue d'Enghien, 75010 Paris, France.
 23 2. Defendant AntiCancer, Inc. is a California State corporation with its principal place
 24 of business at 7917 Ostrow St., San Diego, CA 92111.

25 **NATURE OF THE ACTION**

- 26 3. This is a declaratory judgment action seeking a determination that Mauna Kea does
 27 not infringe any claim of U.S. Patent Nos. 6,232,523; 6,235,967; 6,235,968; 6,251,384;
 28 6,649,159; 6,759,038; and 6,905,831 (“Patents-In-Suit”).

1 4. This is a declaratory judgment action seeking a determination that one or more of the
2 claims of the Patents-In-Suit is invalid.

3 5. Upon information and belief, AntiCancer is the owner by assignment of each of the
4 Patents-in-Suit.

5 **JURISDICTION AND VENUE**

6 6. This is a complaint for declaratory relief under the patent laws of the United States,
7 35 U.S.C. §§ 1, *et seq.*

8 7. Mauna Kea seeks declaratory relief under 28 U.S.C. §§ 2201 and 2202.

9 8. This Court has subject matter jurisdiction under 35 U.S.C. §§ 1331 and 1338(a).

10 9. Venue is proper within this district pursuant to 28 U.S.C. § 1391(b) and (c).

11 10. This Court has personal jurisdiction over AntiCancer because AntiCancer has its
12 principal place of business located within this district.

13 **THE SUBSTANTIAL CONTROVERSY BETWEEN THE PARTIES**

14 11. AntiCancer has created an actual case or controversy through repeated assertions that
15 Mauna Kea must obtain a license under at least six patents identified by AntiCancer as well
16 as other unidentified AntiCancer patents.

17 12. Commencing in January 2006, AntiCancer, through its president, Robert Hoffman,
18 asserted in a letter to Mauna Kea that it was necessary for Mauna Kea to have a license from
19 AntiCancer in order to sell Mauna Kea's CellVizio imaging device. AntiCancer's letter
20 asserted the following U.S. Patents: No. 6,232,523; No. 6,235,968; No. 6,251,384; No.
21 6,649,159; No. 6,759,038; No. 6,905,831; European Patent 0437488; as well as unidentified
22 "pending world-wide patents." AntiCancer further asserted that the patents are directed in
23 unlimited scope and breadth to "all other applications of In Vivo imaging with fluorescent
24 proteins." Although U.S. patent No. 6,235,967 was not specifically asserted in the January
25 2006 letter, it is part of the same family of patents as the others and covers the same general
26 technology.
27
28

1 13. In response to a request by U.S. counsel for Mauna Kea for specificity with regard to
2 the demand that Mauna Kea take a license, Dr. Hoffman wrote directly to the President of
3 Mauna Kea on March 22, 2006, without copying Mauna Kea's U.S. counsel, reiterating
4 AntiCancer's assertion that the specified patents and unidentified world-wide patent
5 applications required Mauna Kea to take a license from AntiCancer.

6 14. Dr. Hoffman's letter of March 22, 2006 refused Mauna Kea's request for greater
7 specificity but stated that the patents identified in his earlier letter of January 2006 "clearly
8 cover the Cell-Vizio product and its applications."
9

10 15. On November 22, 2010, Mauna Kea's U.S. counsel received a letter from Dan
11 Lawton, an attorney who introduced himself as AntiCancer's legal representative. In his
12 letter, Mr. Lawton demanded answers to a set of ten questions in the nature of interrogatories
13 or requests for admissions pursuant to Rule 36 of the Federal Rules of Civil Procedure.
14 Although the letter stated that it was not the purpose of the letter to accuse Mauna Kea of any
15 infringement of any patent, the letter set a deadline of December 3, 2010, for a "substantive"
16 reply. Mr. Lawton's law firm has filed at least three actions in this Court accusing other
17 companies of infringing the same patents which AntiCancer is asserting against Mauna Kea.
18

19 16. On December 6, 2010, Mauna Kea filed an action for declaratory judgment against
20 AntiCancer in the U.S. District Court for the Eastern District of Pennsylvania (the
21 "Pennsylvania Action"). The Pennsylvania Action sought substantially the same relief as
22 sought in this action. Personal jurisdiction was based on AntiCancer's partnership, licensing,
23 and publishing activity in Pennsylvania, as well as AntiCancer's patent enforcement activity
24 directed toward Mauna Kea Technologies, Inc., the U.S. subsidiary of plaintiff Mauna Kea
25 Technologies and a corporation with its principal place of business in Pennsylvania.

26 17. AntiCancer moved to dismiss the Pennsylvania Action for lack of subject matter
27 jurisdiction. AntiCancer did not move to transfer the Pennsylvania Action to this Court or
28 any other court.

1 18. The Pennsylvania Action was dismissed for lack of personal jurisdiction on May 5,
2 2011.

3 **COUNT I**

4 **(DECLARATORY JUDGMENT OF UNENFORCEABILITY**
5 **DUE TO LACHES AND ESTOPPEL)**
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7
8 19. Mauna Kea realleges and incorporates herein the allegations of the preceding
9 paragraphs of this Complaint as fully set forth herein.

10 20. AntiCancer's delay in asserting its patents after its 2006 accusations of infringement
11 is unreasonable and unexcused and has misled Mauna Kea to reasonably believe that
12 AntiCancer does not intend to assert its patents against Mauna Kea.

13 21. AntiCancer's failure to assert its patents after its letter of November 22, 2010, and its
14 failure to assert its patents in response to Mauna Kea's Pennsylvania Action, constitutes
15 unreasonable and unexcused delay and has misled Mauna Kea to reasonably believe that
16 AntiCancer does not intend to assert its patents against Mauna Kea.

17
18 22. Mauna Kea has detrimentally relied on AntiCancer's delay, failure to respond to
19 Mauna Kea's requests, and failure to assert its patents in the Pennsylvania Action.

20 23. AntiCancer's actions in 2006 and its delay and failure to act since that time have been
21 economically and evidentially prejudicial to Mauna Kea because they cause Mauna Kea to
22 operate in an atmosphere of business uncertainty.

23 24. AntiCancer is barred in whole or in part from asserting the Patents-In-Suit, or
24 otherwise obtaining damages for any alleged infringement of the Patents-In-Suit, under the
25 doctrine of laches and/or estoppel.

26 25. As a result of the acts described in the foregoing paragraphs, a substantial controversy
27 exists of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.
28

1 26. A judicial declaration is necessary and appropriate so that Mauna Kea may ascertain
2 its rights regarding AntiCancer's ability to enforce the Patents-In-Suit or otherwise recover or
3 obtain relief for any alleged infringement of the Patents-In-Suit.

4 **COUNT II**

5 **(DECLARATORY JUDGMENT OF NON-INFRINGEMENT)**

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8 27. Mauna Kea realleges and incorporates herein the allegations of the preceding
9 paragraphs of this Complaint as fully set forth herein.

10 28. Mauna Kea has not directly infringed, induced infringement, or contributed to
11 infringement of any claim of the Patents-In-Suit either directly or under the doctrine of
12 equivalents.

13 29. As a result of the acts described in the foregoing paragraphs, there exists a substantial
14 controversy of sufficient immediacy and reality to warrant the issuance of a declaratory
15 judgment.

16 30. A judicial declaration is necessary and appropriate so that Mauna Kea may ascertain
17 its rights regarding patent Nos. 6,232,523; 6,235,967; 6,235,968; 6,251,384; 6,649,159;
18 6,759,038; and 6,905,831.

19
20 31. Mauna Kea is entitled to a declaratory judgment that it has not infringed and does not
21 infringe any claim of patent Nos. 6,232,523; 6,235,967; 6,235,968; 6,251,384; 6,649,159;
22 6,759,038; 6,905,831.

23
24 **COUNT III**

25 **(DECLARATORY JUDGEMNT OF INVALIDITY)**

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28 32. Mauna Kea realleges and incorporates herein the allegations of the preceding
paragraphs of this Complaint as fully set forth herein.

1 33. One or more claim of the Patents-In-Suit is invalid for failing to comply with the
2 conditions of patentability set forth in 35 U.S.C. §§ 102, 103, and/or 112, and the rules,
3 regulations, and laws pertaining thereto, including without limitation at least U.S. Patent Nos.
4 6,251,384; 6,649,159; and 6759,038.

5 34. Mauna Kea is entitled to a declaratory judgment that one or more of the claims in the
6 Patents-In-Suit are invalid.
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8
9 **RELIEF REQUESTED**

10 WHEREFORE, plaintiff Mauna Kea Technologies requests this Court to enter
11 judgment against defendant AntiCancer, Inc. and any parent corporation, subsidiary, affiliate,
12 agent, employees, and all persons in active concert or participation with AntiCancer and to
13 grant the following relief:

- 14 a) A declaration that Mauna Kea has not infringed, either directly or indirectly, any
15 claim of the Patents-In-Suit, either literally or under the doctrine of equivalents;
16 b) A declaration that the claims of the Patents-In-Suit are invalid;
17 c) A declaration that any past damages claimed by AntiCancer are barred by the
18 doctrine of laches.
19 d) A declaration that enforcement of the Patents-In-Suit, and all relief or recovery
20 sought by AntiCancer regarding the Patents-In-Suit, are barred by the doctrine of
21 estoppel;
22 e) An award of Mauna Kea's fees and costs, including attorney's fees, pursuant to 35
23 U.S.C. § 285; and
24 f) Such other relief as may be just and equitable.
25

26 June 27, 2011

27 YOUNG & THOMPSON

28 By: /s/ Jeffrey M. Goehring
Jeffrey M. Goehring, 233002

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

MAUNA KEA TECHNOLOGIES

(b) County of Residence of First Listed Plaintiff Outside US (EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Jeffrey M. Goehring, Young & Thompson, 209 Madison St., Suite 500, Alexandria, VA 22314, 703-521-2297

DEFENDANTS

ANTICANCER, INC.

County of Residence of First Listed Defendant (IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- 1 U.S. Government Plaintiff, 2 U.S. Government Defendant, 3 Federal Question (U.S. Government Not a Party), 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- Citizen of This State, Citizen of Another State, Citizen or Subject of a Foreign Country, PTF DEF, Incorporated or Principal Place of Business In This State, Incorporated and Principal Place of Business In Another State, Foreign Nation

IV. NATURE OF SUIT (Place an "X" in One Box Only)

Table with 5 columns: CONTRACT, REAL PROPERTY, TORTS, CIVIL RIGHTS, PRISONER PETITIONS, FORFEITURE/PENALTY, LABOR, IMMIGRATION, BANKRUPTCY, SOCIAL SECURITY, FEDERAL TAX SUITS, OTHER STATUTES. Includes various legal categories like Insurance, Personal Injury, Property Rights, etc.

V. ORIGIN (Place an "X" in One Box Only)

- 1 Original Proceeding, 2 Removed from State Court, 3 Remanded from Appellate Court, 4 Reinstated or Reopened, 5 Transferred from another district (specify), 6 Multidistrict Litigation, 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity): 35 U.S.C. 1 et seq.

Brief description of cause: Declaratory judgment of non-infringement, invalidity, and unenforceability of patents

VII. REQUESTED IN COMPLAINT:

CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23, DEMAND \$, CHECK YES only if demanded in complaint: JURY DEMAND: Yes No

VIII. RELATED CASE(S) IF ANY

(See instructions): JUDGE, DOCKET NUMBER

DATE: 06/27/2011, SIGNATURE OF ATTORNEY OF RECORD: /s/ Jeffrey M. Goehring, 233002

FOR OFFICE USE ONLY

RECEIPT #, AMOUNT, APPLYING IFP, JUDGE, MAG. JUDGE