

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF KENTUCKY
CENTRAL DIVISION AT LEXINGTON**
Electronically Filed

LEXMARK INTERNATIONAL, INC.)	
)	
Plaintiff,)	
)	
v.)	Civil Action No.
)	
NUANCE COMMUNICATIONS, INC.)	
)	
Defendant.)	
)	

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Lexmark International, Inc. (“Lexmark”) brings this complaint for declaratory judgment against defendant, Nuance Communications, Inc., (“Nuance”) in order to establish non-infringement and invalidity of five patents allegedly owned by defendant.

THE PARTIES

1. Plaintiff, Lexmark, is a Delaware corporation with its principal place of business at 740 New Circle Road, NW, Lexington, Kentucky.
2. Defendant, Nuance, is a Delaware corporation having a principal place of business at 1 Wayside Road, Burlington, Massachusetts.

JURISDICTION AND VENUE

3 This is an action for a declaratory judgment that U.S. Patent Nos. 5,131,053 (“the ‘053 patent”); 5,381,489 (“the ‘489 patent”); 5,436,983 (“the ‘983 patent”), 6,038,342 (“the ‘342 patent”); and 5,261,009 (“the ‘009 patent”) (collectively “the patents-in-suit”) are invalid and not

infringed by any device made, used, offered for sale or sold by Lexmark. This action arises under the patent laws of the United States, 35 U.S.C. § 271 et seq. and the declaratory judgment statute, 28 U.S.C. § 2201 et seq., and is based upon an actual justiciable controversy between the parties with respect to alleged infringement and invalidity of the '053, '489, '983, '342 and '009 patents.

4. This Court has exclusive jurisdiction over this action pursuant to 28 U.S.C. §§ 1338(a), 2201 and 2202.

5. Venue is proper before this Court pursuant to 28 U.S.C. §§ 1391 and 1400.

ACTUAL CONTROVERSY WITHIN THIS COURT'S JURISDICTION

6. Lexmark is in the business of designing, developing, making and selling printers, including multi-function printers, in this judicial district.

7. Nuance is doing business in this judicial district and elsewhere throughout the United States by, *inter alia*, offering and selling optical character recognition and other software. Nuance has asserted, and continues to assert, in this judicial district and elsewhere that it is the owner of the '053, '489, '983, '342 and '009 patents, that the '053, '489, '983, '342 and '009 patents are valid, and that the '053, '489, '983, '342 and '009 patents are infringed by certain printer products made, used, offered for sale and/or sold by Lexmark in this judicial district and elsewhere. True and correct copies of the '053, '489, '983, '342 and '009 patents are attached as Exhibits A through E, respectively.

8. For example, in a Complaint filed by Nuance on January 16, 2008, in the U.S. District Court for the Western District of Wisconsin (Civil Action No. 08-C-0042-S) ("the Wisconsin Action"), Nuance alleged, *inter alia*, with respect to each of the '053, '489, '983, '342 and '009 patents that "Lexmark has infringed and is continuing to infringe one or more claims of

the [] patent, directly, contributorily and/or by inducement, by making, using, selling and/or offering to sell in this country, and/or importing into this country, devices for performing optical character recognition in violation of 35 U.S.C. § 271.” Although Nuance recently filed a Notice of Dismissal in the Wisconsin Action, that dismissal was without prejudice and Nuance has not withdrawn its allegations of infringement, leaving Lexmark in apprehension of further suit.

9. Nuance has asserted rights under the ‘053, ‘489, ‘983, ‘342 and ‘009 patents based upon certain identifiable ongoing activity of Lexmark (including the activities of Lexmark identified by Nuance in the Wisconsin Action, above), and Lexmark contends that it has the right to engage in the accused activity without license under the ‘053, ‘489, ‘983, ‘342 and ‘009 patents. Nuance’s threats of infringement with respect to the ‘053, ‘489, ‘983, ‘342 and ‘009 patents continue against Lexmark, and as a result of Nuance’s above acts, Lexmark is apprehensive that Nuance will again file suit against Lexmark for infringement of the ‘053, ‘489, ‘983, ‘342 and ‘009 patents.

10. Accordingly, there is an actual present justiciable controversy as to infringement of the ‘053, ‘489, ‘983, ‘342 and ‘009 patents by Lexmark, and as to the validity of these patents.

COUNT ONE

DECLARATORY JUDGMENT OF NON-INFRINGEMENT AND INVALIDITY OF U.S. PATENT NO. 5,131,053

11. Lexmark incorporates by reference paragraphs 1-10, above.

12. Lexmark has not infringed, and is not infringing, any claim of the ‘053 patent directly, indirectly, or by inducement.

13. One or more of the claims of the '053 patent are invalid because they fail to satisfy one or more of the conditions for patentability under Title 35 of the United States Code, including *inter alia* sections 101, 102, 103 and/or 112.

14. Accordingly, Lexmark seeks a judgment of this Court declaring that Lexmark has not infringed and is not infringing any claim of the '053 patent, and that one or more claims of the '053 patent are invalid.

COUNT TWO

DECLARATORY JUDGMENT OF NON-INFRINGEMENT AND INVALIDITY OF U.S. PATENT NO. 5,381,489

15. Lexmark incorporates by reference paragraphs 1-14, above.

16. Lexmark has not infringed, and is not infringing, any claim of the '489 patent directly, indirectly, or by inducement.

17. One or more of the claims of the '489 patent are invalid because they fail to satisfy one or more of the conditions for patentability under Title 35 of the United States Code, including *inter alia* sections 101, 102, 103 and/or 112.

18. Accordingly, Lexmark seeks a judgment of this Court declaring that Lexmark has not infringed and is not infringing any claim of the '489 patent, and that one or more claims of the '489 patent are invalid.

COUNT THREE

**DECLARATORY JUDGMENT OF
NON-INFRINGEMENT AND INVALIDITY OF U.S. PATENT NO. 5,436,983**

19. Lexmark incorporates by reference paragraphs 1-18, above.

20. Lexmark has not infringed, and is not infringing, any claim of the '983 patent directly, indirectly, or by inducement.

21. One or more of the claims of the '983 patent are invalid because they fail to satisfy one or more of the conditions for patentability under Title 35 of the United States Code, including *inter alia* sections 101, 102, 103 and/or 112.

22. Accordingly, Lexmark seeks a judgment of this Court declaring that Lexmark has not infringed and is not infringing any claim of the '983 patent, and that one or more claims of the '983 patent are invalid.

COUNT FOUR

**DECLARATORY JUDGMENT OF
NON-INFRINGEMENT AND INVALIDITY OF U.S. PATENT NO. 6,038,342**

23. Lexmark incorporates by reference paragraphs 1-22, above.

24. Lexmark has not infringed, and is not infringing, any claim of the '342 patent directly, indirectly, or by inducement.

25. One or more of the claims of the '342 patent are invalid because they fail to satisfy one or more of the conditions for patentability under Title 35 of the United States Code, including *inter alia* sections 101, 102, 103 and/or 112.

26. Accordingly, Lexmark seeks a judgment of this Court declaring that Lexmark has not infringed and is not infringing any claim of the '342 patent, and that one or more claims of the '342 patent are invalid.

COUNT FIVE

**DECLARATORY JUDGMENT OF
NON-INFRINGEMENT AND INVALIDITY OF U.S. PATENT NO. 5,261,009**

27. Lexmark incorporates by reference paragraphs 1-26, above.

28. Lexmark has not infringed, and is not infringing, any claim of the '009 patent directly, indirectly, or by inducement.

29. One or more of the claims of the '009 patent are invalid because they fail to satisfy one or more of the conditions for patentability under Title 35 of the United States Code, including *inter alia* sections 101, 102, 103 and/or 112.

30. Accordingly, Lexmark seeks a judgment of this Court declaring that Lexmark has not infringed and is not infringing any claim of the '009 patent, and that one or more claims of the '009 patent are invalid.

EXCEPTIONAL CASE

31. This case is exceptional under 35 U.S.C. § 285.

PRAYER FOR RELIEF

WHEREFORE, Lexmark prays that this Court:

A. Declare that Lexmark has not infringed and is not infringing any claim of the '053 patent.

- B. Declare that the '053 patent is invalid.
- C. Declare that Lexmark has not infringed and is not infringing any claim of the '489 patent.
- D. Declare that the '489 patent is invalid.
- E. Declare that Lexmark has not infringed and is not infringing any claim of the '983 patent.
- F. Declare that the '983 patent is invalid.
- G. Declare that Lexmark has not infringed and is not infringing any claim of the '342 patent.
- H. Declare that the '342 patent is invalid.
- I. Declare that Lexmark has not infringed and is not infringing any claim of the '009 patent.
- J. Declare that the '009 patent is invalid.
- K. Declare that this case is an exceptional case under 35 U.S.C. § 285 and enter judgment awarding Lexmark its costs and reasonable attorney fees; and
- L. Award Lexmark such other and further relief as the Court deems just and proper.

Respectfully submitted,

LEXMARK INTERNATIONAL, INC.,

By their Attorneys,

Dated: February 19, 2008

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