

JUDGE CONLON

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

MAGISTRATE JUDGE MASON

GLORY LTD., a Japanese Corporation;
GLORY SHOJI CO., LTD., a Japanese
Corporation; and GLORY (U.S.A.), INC., a
California Corporation,

Plaintiffs,

vs.

CUMMINS-ALLISON CORP.,
an Indiana Corporation,

Defendant.

03C 8547

Civil Action No.

COMPLAINT FOR
DECLARATORY AND
INJUNCTIVE RELIEF

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U.S. DISTRICT COURT
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THE PARTIES

1. Plaintiff Glory Ltd. is a corporation existing and organized under the laws of Japan, with its principal place of business at 1-3-1, Shimoteno, Himeji, Hyogo, 670-8567, Japan.

2. Plaintiff Glory Shoji Co., Ltd. is a corporation existing and organized under the laws of Japan, with its principal place of business at 4-8-17, Nishitenma, Kita-ku, Osaka, 530-8671, Japan.

3. Plaintiff Glory (U.S.A.) Inc. is a corporation existing and organized under the laws of the State of California and has its principal place of business at 10 York Avenue, West Caldwell, New Jersey 07006, and a sales office at 2506 Wisconsin Avenue, Downers Grove, Illinois 60515.

4. Upon information and belief, Defendant Cummins-Allison Corp. ("Cummins") is a corporation organized under the laws of Indiana and has its

principal place of business at 891 Feehanville Drive, Mt. Prospect, Illinois, 60056.

5. Cummins purports to be the owner of U.S. patent No. 5,692,067 ("the '067 patent").

6. Cummins purports to be the owner of U.S. patent No. 5,815,592 ("the '592 patent").

7. Cummins purports to be the owner of U.S. patent No. 6,381,354 ("the '354 patent").

Related Actions

8. On October 1, 2002, Cummins filed a Complaint in this Court ("the Illinois Action"), accusing Plaintiffs of infringing U.S. patent No. 6,459,806 ("the '806 patent").

9. On June 19, 2003, Cummins was granted leave by the Court to amend and did amend its Complaint in the Illinois Action to add U.S. patent No. 5,295,196 ("the '196 patent"), asserting that Glory also infringes the '196 patent.

10. The Illinois Action, as amended, is currently pending as Civil Action No. 02 C 7008 before Hon. Ronald Guzman, U.S. District Court Judge.

11. On October 10, 2003, Cummins filed a motion to amend its complaint yet again in order to add three new patents: '592, '354, and '067, to the suit.

12. On October 16, 2003, Judge Guzman denied Cummins' motion to add the three new patents on the basis that adding the patents would disrupt the discovery schedule.

13. On or about October 20, 2003, Cummins filed a Complaint in the U.S. District Court for the Eastern District of Texas ("the Texas Action"), accusing Plaintiffs of infringing the '067, '592 and '354 patents.

14. Glory Ltd. and Glory Shoji Co., Ltd., Plaintiffs herein, have not yet been served in the Texas Action.

15. The '806, '196, '067, '592, and '354 patents are related by virtue of the '806, '067, '592, and '354 patents' issuing from applications that are continuations from the '196 patents.

JURISDICTION AND VENUE

16. This action arises under the Declaratory Judgment Act and the patent Laws of the United States, more particularly under Title 28 U.S.C. §§ 2201 and 2202 and Title 35 U.S.C. §§ 100 et. seq., respectively. This court has jurisdiction under Title 28 U.S.C. §§ 1338 and 2201.

17. Venue in this district is proper under 28 U.S.C. § 1391(b) and (c), and by virtue of Defendant having brought the Illinois Action.

18. An actual and justiciable controversy exists between Plaintiffs and Defendant as to the infringement, validity and enforceability of the '067, '592 and '354 patent, as evidenced, inter alia, by the Texas Action and the Complaint in this action.

COUNT I

(Declaratory Judgment of Invalidity)

19. The '067, 354 and '592 patents are invalid under one or more provisions of Title 35 of the United States Code, including, without limitation, Sections 101, 102, 103 and 112.

(a) The claims of the '067, 354 and '592 patents are vague and indefinite and do not particularly point out and distinctly claim the part, improvement, method, or combination which the patentees claim as their invention, as required by Title 35, U.S. Code, Section 112.

(b) The specifications of the '067, 354 and '592 patents do not contain a written description of the invention and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains or with which it is most nearly connected to make and/or use the same, nor set forth the best mode contemplated by the inventors for carrying out the purported invention, as required by Title 35, U.S. Code, Section 112.

(c) The claims of the '067, 354 and '592 patents fail to fulfill the requirements of Title 35, U.S. Code, Section 102 and/or 103.

COUNT II

(Declaratory Judgment of Non-Infringement)

20. Neither Plaintiffs nor their customers infringe or have infringed any claim of the '067, 354 or '592 patents.

21. No device made, used, sold or offered for sale by Plaintiffs has been knowingly made or especially adapted for a use that would infringe the '067, 354 or '592 patents.

22. Plaintiffs have not done any act and are not proposing to do any act in violation of any rights validly belonging to Defendant under the '067, 354 and '592 patents, which patents are invalid and unenforceable and are not infringed by Plaintiffs.

COUNT III

(Declaratory Judgment of Unenforceability)

23. The '067 and '592 patents are unenforceable due to inequitable conduct.

24. The '067 and '592 patents are unenforceable due to Defendant's inequitable conduct during prosecution of the applications that lead to issuance of those patents.

25. During the prosecution of U.S. patent No. 6,028,951 ("the '951 patent"), which patent is a successor to the '196 patent, which patent is an ancestor of the '067 and '592 patents, Cummins filed an "Information Disclosure Statement", which included a declaration by Per Torling, dated March 18, 1999, which referred to outside field testing of Cummins' currency discriminators ("CRC") prior to May 19, 1991.

26. The information disclosed to the PTO by the Per Torling declaration were known to Cummins at the time of the filing of the applications which led to the '196, '067 and '592 patents. Such information includes:

(a) Prior to May 19, 1991, Cummins had performed testing of machines whose "operation resembled the currency discriminating devices disclosed in U.S. patent No. 5,295,196."

(b) Prior to May 19, 1991, Cummins had conducted "three phases" of "outside field testing" with such machines.

(c) Prior to May 19, 1991, Cummins had conducted one or more beta-testings of its machines, indicating that the machines had been reduced to practice at least as of the date of the beta-testings

27. Cummins failed to disclose to the USPTO that:

(a) The invention of the '196 patent had been reduced to practice before field testing commenced.

(b) The field tests of the Torling Declaration were performed at the facilities of potential customers for the CRC and existing customers of other Cummins equipment.

(c) According to the Torling declaration, the "machines [used in the field tests] and their operation **resembled** the currency

discriminating devices disclosed in U.S. Pat. No. 5,295,196.”
(emphasis added). However, the ‘196 patent was, in fact, **based on**
the machines that were the subject of the Torling declaration.

(d) Torling was a recipient of a memo dated January 31,
1991, in which Mr. D. Mennie recognized that Cummins needed to
file patent applications on the CRC before testing began at
customer sites.

(e) During September 1990 to January 1991 and prior to the
field testing at potential customers, Cummins built two machines
and extensively tested those machines at Cummins and at the
Glenview State Bank.

(f) Cummins’ customers and potential customers testing
such equipment and their employees did not sign confidentiality
agreements with respect to information regarding such machines.

(g) The test sites of the potential customers were not subject
to control by Cummins and the machines were left with the
potential customers.

(h) Cummins’ customers used the machines in the normal
manner that such machines were intended to be used for a period
as long as seven weeks or more.

(i) Cummins’ customers tested “beta test” machines before
the May 19, 1991 bar date.

(j) Sales of Glory GFR 100 currency denominators had
occurred in the United States since 1994 and other multiple
output pocket denominators had also been sold and offered for sale
in the United States years before the claims of the ‘196, ‘592 and
‘067 patents were presented to the USPTO.

28. This and other information known to Plaintiff was material to the
prosecution of the ‘196 patent, and the ‘067 and ‘592 patents, as it would have

directly refuted arguments made in prosecution of those patents and would have been material to the patentability of claims that issued therefrom.

29. Upon information and belief, the failure to bring this material prior art to the attention of the Examiner was done with intent to deceive the USPTO.

30. The '354 patent is unenforceable due to Plaintiff's inequitable conduct during prosecution of the application that led to issuance of the '354 patent.

31. Throughout the prosecution of the '354 patent, Cummins failed to disclose to the USPTO material information known to the Applicant.

32. During the prosecution of the '354 patent, Cummins filed an "Information Disclosure Statement", which included a declaration by Per Torling, dated March 18, 1999, which referred to outside field testing of Cummins' currency discriminators ("CRC") prior to May 19, 1991.

33. The information disclosed to the PTO by the Per Torling declaration includes:

(a) Prior to May 19, 1991, Cummins had performed testing of machines whose "operation resembled the currency discriminating devices disclosed in U.S. patent No. 5,295,196."

(b) Prior to May 19, 1991, Cummins had conducted "three phases" of "outside field testing" with such machines.

(c) Prior to May 19, 1991, Cummins had conducted one or more beta-testings of its machines, indicating that the machines had been reduced to practice at least as of the date of the beta-testings.

34. Moreover, Cummins failed to disclose to the USPTO that:

(a) The invention of the '196 patent had been reduced to practice before field testing commenced.

(b) The field tests of the Torling Declaration were performed at the facilities of potential customers for the CRC and existing customers of other Cummins equipment.

(c) According to the Torling declaration, the "machines [used in the field tests] and their operation **resembled** the currency discriminating devices disclosed in the '196 patent." (emphasis added). However, the '196 patent was, in fact, **based on** the machines that were the subject of the Torling declaration.

(d) Torling was a recipient of a memo dated January 31, 1991, in which Mr. D. Mennie recognized that Cummins needed to file patent applications on the CRC before testing began at customer sites.

(e) During September 1990 to January 1991 and prior to the field testing at potential customers, Cummins built two machines and extensively tested those machines at Cummins and at the Glenview State Bank.

(f) Cummins' customers and potential customers testing such equipment and their employees did not sign confidentiality agreements with respect to information regarding such machines.

(g) The test sites of the potential customers were not subject to control by Cummins and the machines were left with the potential customers.

(h) Cummins' customers used the machines in the normal manner that such machines were intended to be used for a period as long as seven weeks or more.

(i) Cummins' customers tested "beta test" machines before the May 19, 1991 bar date.

(j) Sales of Glory GFR-100 currency denominators had occurred in the United States since 1994 and other multiple

output pocket denominators had also been sold and offered for sale in the United States years before the claims of the '354 patent was presented to the USPTO.

35. This and other information known to Plaintiff was material to the prosecution of the '196 and the '354 patents, as it would have directly refuted arguments made in prosecution of the patent and would have been material to the patentability of claims that issued therefrom.

36. Upon information and belief, the failure to bring this material prior art to the attention of the Examiner was done with intent to deceive the USPTO.

WHEREFORE, Plaintiff prays for adjudication as follows:

1.

a) Entry of judgment that Defendant Cummins is without right or authority to threaten or to maintain suit against Plaintiffs, or any of them, or their customers for alleged infringement of U.S. patent Nos. 5,692,067, 5,815,592 and 6,381,354;

b) that said patents are invalid, unenforceable and void in law; and

c) that said patents are not infringed by Plaintiffs, or any of them, or by any of their customers.

2. Entry of preliminary and permanent injunctions enjoining Defendant, its officers, agents, servants, employees, and attorneys and those persons in active concert or participation with them who receive actual notice thereof from initiating infringement litigation and from threatening Plaintiffs, or each of them, or any of their customers, dealers, agents, servants, or employees, or any prospective or present sellers, dealers, or users of Plaintiffs' devices or apparatus, with respect to the '067, '354, and '592 patents because of the manufacture, use, sale or offering for sale of apparatus made by Plaintiff, said injunction to be made permanent following trial.

3. That Defendants be enjoined from prosecuting the Texas Action and that said action be dismissed with prejudice;
4. That this case is declared exceptional under 35 U.S. § 285, and that Glory be awarded the reasonable attorney fees and costs incurred in connection with this action;
5. That this Court grant the Plaintiffs such other further relief as the Court deems appropriate.

JURY DEMAND

Plaintiffs hereby demand trial by jury on all issues triable to a jury.

Dated: 25 Nov 03



DONOHUE BROWN MATHEWSON
& SMYTH

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Attorneys for GLORY (U.S.A.) INC.

Certificate of Service

Laurie A. Rompala, an attorney, hereby certifies that he caused the foregoing COMPLAINT FOR DECLARATORY AND INJUNCTIVE RELIEF to be served by facsimile and by first class mail, this 21st day of November 2003, on the following counsel of record:

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Laurie A. Rompala

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JUDGE CONLON

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS

03C 8547
MAGISTRATE JUDGE

Civil Cover Sheet

This automated JS-44 conforms generally to the manual JS-44 approved by the Judicial Conference of the United States in September 1974. The data is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. The information contained herein neither replaces nor supplements the filing and service of pleadings or other papers as required by law. This form is authorized for use only in the Northern District of Illinois.

Plaintiff(s): GLORY, LTD., a Japanese Corporation; GLORY SHOJI CO., LTD., a Japanese Corporation; and GLORY (U.S.A.), INC., a California Corporation,		Defendant(s): CUMMINS-ALLISON CORP., an Indiana Corporation	
County of Residence:		County of Residence:	
Plaintiff's Atty: Donohue Brown Mathewson & Smyth 140 S. Dearborn Street, Suite 700 Chicago, Illinois 60603 312/422-0900	Defendant's Atty: Jenkens & Gilchrist 225 W. Washington Street, Suite 2600 Chicago, Illinois 60606 312/425-3900		

II. Basis of Jurisdiction: 3. Federal Question (U.S. not a party)

III. Citizenship of Principal Parties (Diversity Cases Only)
Plaintiff:- N/A
Defendant:- N/A

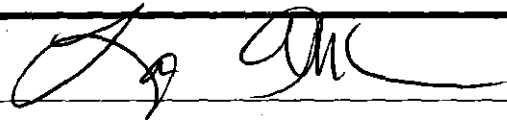
IV. Origin : 1. Original Proceeding

V. Nature of Suit: 830 Patent

VI. Cause of Action: 28 U.S.C. Sections 2201 and 2202; 35 U.S.C. Section 100 et. seq.; 28 U.S.C. Section 1391(b) and (c); 28 U.S.C. Sections 1338 and 2201.
This is a declaratory judgment action relating to the enforceability of certain patents.

VII. Requested in Complaint
Class Action: No
Dollar Demand: declaratory judgment and injunctive relief
Jury Demand: Yes

VIII. This case IS NOT a refiling of a previously dismissed case.

Signature: 

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U.S. DISTRICT COURT
CLERK

Civil Cover Sheet

Date: 25 Nov 03

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Once correct, print this form, sign and date it and submit it with your new civil action. **Note: You may need to refresh your browser display to make the form print properly.** Revised

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS**

JUDGE CONLON

MAGISTRATE JUDGE MASO

In the Matter of

GLORY, LTD., a Japanese Corporation; GLORY SHOJI CO., LTD., a Japanese Corporation; and GLORY (U.S.A.) INC., a California Corporation, -- Plaintiffs

v.

Case Number:

CUMMINS-ALLISON CORP., an Indiana Corporation -- Defendant.

03C 8547

APPEARANCES ARE HEREBY FILED BY THE UNDERSIGNED AS ATTORNEY(S) FOR

Plaintiffs, Glory, Ltd., Glory Shoji Co., Ltd.

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U.S. DISTRICT COURT
CHICAGO, ILL.

(A)		(B)	
SIGNATURE <i>Kent Mathewson</i>		SIGNATURE <i>Laurie A. Rompala</i>	
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IDENTIFICATION NUMBER (SEE ITEM 4 ON REVERSE) 6183297		IDENTIFICATION NUMBER (SEE ITEM 4 ON REVERSE) 6272958	
MEMBER OF TRIAL BAR?	YES <input checked="" type="checkbox"/> NO <input type="checkbox"/>	MEMBER OF TRIAL BAR?	YES <input checked="" type="checkbox"/> NO <input type="checkbox"/>
TRIAL ATTORNEY?	YES <input checked="" type="checkbox"/> NO <input type="checkbox"/>	TRIAL ATTORNEY?	YES <input type="checkbox"/> NO <input checked="" type="checkbox"/>
DESIGNATED AS LOCAL COUNSEL?	YES <input checked="" type="checkbox"/> NO <input type="checkbox"/>	DESIGNATED AS LOCAL COUNSEL?	YES <input checked="" type="checkbox"/> NO <input type="checkbox"/>
(C)		(D)	
SIGNATURE		SIGNATURE	
NAME		NAME	
FIRM		FIRM	
STREET ADDRESS		STREET ADDRESS	
CITY/STATE/ZIP		CITY/STATE/ZIP	
TELEPHONE NUMBER	FAX NUMBER	TELEPHONE NUMBER	FAX NUMBER
E-MAIL ADDRESS		E-MAIL ADDRESS	
IDENTIFICATION NUMBER (SEE ITEM 4 ON REVERSE)		IDENTIFICATION NUMBER (SEE ITEM 4 ON REVERSE)	
MEMBER OF TRIAL BAR?	YES <input type="checkbox"/> NO <input type="checkbox"/>	MEMBER OF TRIAL BAR?	YES <input type="checkbox"/> NO <input type="checkbox"/>
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