

1 MATTHEW D. POWERS (Bar No. 104795)
VERNON M. WINTERS (Bar No. 130128)
2 ALICE GARBER (Bar No. 202854)
PAT COSTELLO (Bar No. 218591)
3 WEIL, GOTSHAL & MANGES LLP
Silicon Valley Office
4 201 Redwood Shores Parkway
Redwood Shores, CA 94065-1175
5 Telephone: (650) 802-3000
Facsimile: (650) 802-3100

6 Attorneys for Plaintiff,
7 APPLERA CORPORATION –
APPLIED BIOSYSTEMS GROUP
8

9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
11 SAN JOSE DIVISION

12 APPLERA CORPORATION – APPLIED
13 BIOSYSTEMS GROUP,

14 Plaintiff,

15 v.

16 ILLUMINA, INC.,

17 Defendants.
18
19

NO. CV 03-01048 MHP

**AMENDED COMPLAINT FOR
PATENT INFRINGEMENT**

DEMAND FOR JURY TRIAL

CERTIFICATION OF INTERESTED
ENTITIES OR PERSONS

20 Plaintiff, Applera Corporation – Applied Biosystems Group (“Applied
21 Biosystems”), by and for its Amended Complaint against defendant, Illumina, Inc. (“Illumina”),
22 alleges as follows:

23 **I.**

24 **NATURE OF THE CASE**

25 1. This is a patent infringement case. Applied Biosystems holds the rights to
26 U.S. Patents Nos. 4,883,750 (“the ‘750 Patent”), 5, 242,794 (“the ‘794 Patent”), 5,521,065 (“the
27 ‘065 Patent”) and 5,489,507 (“the ‘507 Patent”). The United States patent laws grant the holder
28 of a patent the right to exclude infringers from practicing the inventions claimed in a patent, and

1 to recover damages for the infringer's violations of those rights – and where the infringer has
2 infringed willfully, to recover treble damages. The defendant, Illumina, Inc. is infringing those
3 patents, and is doing so willfully. Applied Biosystems therefore sues Illumina for infringing
4 Applied Biosystems' United States patent rights in the patents-in-suit. Applied Biosystems seeks
5 both injunctive relief to stop Illumina's further infringement and to recover damages for
6 Illumina's infringement – including treble damages for its willful infringement – of Applied
7 Biosystems' United States patent rights in the patents-in-suit.

8 **II.**

9 **THE PARTIES**

10 2. Applera Corporation – Applied Biosystems Group is an operating group of
11 Applera Corporation, a Delaware Corporation. Applied Biosystems' principal place of business
12 is within this judicial district at: Applied Biosystems, Division Headquarters, 850 Lincoln Centre
13 Drive, Foster City, CA 94404.

14 3. Upon information and belief, Illumina, Inc., is a Delaware corporation with
15 its principal place of business at: 9885 Towne Centre Drive, San Diego, CA 92121-1975.

16 **III.**

17 **JURISDICTION AND VENUE**

18 4. This is an action for patent infringement arising under the patent laws of
19 the United States, Title 35 of the United States Code.

20 5. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and
21 1338(a).

22 6. Venue is proper in this judicial district under 28 U.S.C. §§ 1391 and
23 1400(b) because, upon information and belief, Illumina has, among other things, committed
24 infringing acts in this district and does business in this district generally.

25 \

26 \

27 \

28

1 IV.

2 FIRST CLAIM FOR RELIEF

3 (INFRINGEMENT OF THE '750 PATENT)

4 7. Plaintiffs here incorporate ¶¶ 1-6 of this Amended Complaint.

5 8. U.S. Patent Number 4,883,750, entitled "Detection of Specific Sequences
6 in Nucleic Acids," duly and legally issued on November 28, 1989, to Whiteley et al. (attached
7 hereto as Exhibit A), with Applied Biosystems, Inc., as the named assignee.

8 9. Applied Biosystems is the current assignee of the rights under the '750
9 Patent. Applied Biosystems is empowered to bring suit against Illumina for infringement of the
10 '750 Patent.

11 10. On information and belief, Illumina has been and is currently infringing,
12 both directly and indirectly, the '750 Patent by, among other things, making, using, selling,
13 importing, and/or offering for sale, certain genotyping products and services, within the territorial
14 boundaries of the United States, that embody and/or practice inventions claimed in the '750
15 Patent.

16 11. On information and belief, Illumina's infringement of the '750 Patent has
17 been and is willful, and will continue unless enjoined by this Court. Applied Biosystems has
18 suffered, and will continue to suffer, irreparable injury as a result of this willful infringement.
19 Under 35 U.S.C. §284, Applied Biosystems is entitled to damages for infringement and treble
20 damages. Under 35 U.S.C. §283, Applied Biosystems is entitled to a permanent injunction
21 against further infringement.

22 12. This case is exceptional and, therefore, Applied Biosystems is entitled to
23 attorneys' fees pursuant to 35 U.S.C. §285.

24 V.

25 SECOND CLAIM FOR RELIEF

26 (INFRINGEMENT OF THE '794 PATENT)

27 13. Plaintiffs here incorporate ¶¶ 1-6 of this Amended Complaint.

28 14. U.S. Patent Number 5,242,794, entitled "Detection of Specific Sequences

1 in Nucleic Acids,” duly and legally issued on September 7, 1993, to Whiteley et al. (attached
2 hereto as Exhibit B), with Applied Biosystems, Inc., as the named assignee.

3 15. Applied Biosystems is the current assignee of the rights under the ‘794
4 Patent. Applied Biosystems is empowered to bring suit against Illumina for infringement of the
5 ‘794 Patent.

6 16. On information and belief, Illumina has been and is currently infringing,
7 both directly and indirectly, the ‘794 Patent by, among other things, making, using, selling,
8 importing, and/or offering for sale, certain genotyping products and services, within the territorial
9 boundaries of the United States, that embody and/or practice inventions claimed in the ‘794
10 Patent.

11 17. On information and belief, Illumina’s infringement of the ‘794 Patent has
12 been and is willful, and will continue unless enjoined by this Court. Applied Biosystems has
13 suffered, and will continue to suffer, irreparable injury as a result of this willful infringement.
14 Under 35 U.S.C. §284, Applied Biosystems is entitled to damages for infringement and treble
15 damages. Under 35 U.S.C. §283, Applied Biosystems is entitled to a permanent injunction
16 against further infringement.

17 18. This case is exceptional and, therefore, Applied Biosystems is entitled to
18 attorneys’ fees pursuant to 35 U.S.C. §285.

19 **VI.**

20 **THIRD CLAIM FOR RELIEF**

21 **(INFRINGEMENT OF THE ‘065 PATENT)**

22 19. Plaintiffs here incorporate ¶¶ 1-6 of this Amended Complaint.

23 20. U.S. Patent Number 5,521,065, entitled “Detection of Specific Sequences
24 in Nucleic Acids,” duly and legally issued on May 28, 1996, to Whiteley et al. (attached hereto as
25 Exhibit C), with Applied Biosystems, Inc., as the named assignee.

26 21. Applied Biosystems is the current assignee of the rights under the ‘065
27 Patent. Applied Biosystems is empowered to bring suit against Illumina for infringement of the
28 ‘065 Patent.

1 22. On information and belief, Illumina has been and is currently infringing,
2 both directly and indirectly, the ‘065 Patent by, among other things, making, using, selling,
3 importing, and/or offering for sale, certain genotyping products and services, within the territorial
4 boundaries of the United States, that embody and/or practice inventions claimed in the ‘065
5 Patent.

6 23. On information and belief, Illumina’s infringement of the ‘065 Patent has
7 been and is willful, and will continue unless enjoined by this Court. Applied Biosystems has
8 suffered, and will continue to suffer, irreparable injury as a result of this willful infringement.
9 Under 35 U.S.C. §284, Applied Biosystems is entitled to damages for infringement and treble
10 damages. Under 35 U.S.C. §283, Applied Biosystems is entitled to a permanent injunction
11 against further infringement.

12 24. This case is exceptional and, therefore, Applied Biosystems is entitled to
13 attorneys’ fees pursuant to 35 U.S.C. §285.

14 **VII.**
15 **FOURTH CLAIM FOR RELIEF**
16 **(INFRINGEMENT OF THE ‘507 PATENT)**

17 25. Plaintiffs here incorporate ¶¶ 1-6 of this Amended Complaint.

18 26. U.S. Patent Number 5,489,507 entitled “DNA Detection by Color
19 Complementation,” duly and legally issued on February 6, 1996, to Farid F. Chehab (attached
20 hereto as Exhibit D).

21 27. Applied Biosystems is the current assignee of the rights under the ‘507
22 Patent. Applied Biosystems is empowered to bring suit against Illumina for infringement of the
23 ‘507 Patent.

24 28. On information and belief, Illumina has been and is currently infringing,
25 both directly and indirectly, the ‘507 Patent by, among other things, making, using, selling,
26 importing, and/or offering for sale, certain genotyping products and services, within the territorial
27 boundaries of the United States, that embody and/or practice inventions claimed in the ‘507
28 Patent.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

7. That Applied Biosystems have such other and further relief as this Court may deem just and proper.

Dated: April 22, 2003

WEIL, GOTSHAL & MANGES LLP

By: /s/ Vernon M. Winters
Vernon M. Winters
Attorneys for Plaintiff,
Applera Corporation – Applied
Biosystems Group

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

JURY DEMAND

Applied Biosystems hereby demands a jury trial for this action.

Dated: April 22, 2003

WEIL, GOTSHAL & MANGES LLP

By: /s/ Vernon M. Winters
 Vernon M. Winters
 Attorneys for Plaintiff,
 Applera Corporation – Applied
 Biosystems Group

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

CERTIFICATION OF INTERESTED ENTITIES OR PERSONS

Pursuant to Civil Local Rule 3–16, the undersigned certifies that the following listed persons, associations of persons, firms, partnerships, corporations (including parent corporations) or other entities (i) have a financial interest in the subject matter in controversy or in a party to the proceeding, or (ii) have a nonfinancial interest in that subject matter or in a party that could be substantially affected by the outcome of this proceeding: Applera Corporation and Applera Corporation – Applied Biosystems Group.

Dated: April 22, 2003

WEIL, GOTSHAL & MANGES LLP

By: /s/ Vernon M. Winters
Vernon M. Winters
Attorneys for Plaintiff,
Applera Corporation – Applied
Biosystems Group