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3:01-CV-1628 INVITROGEN CORPORATION V. TOYOBO CO LTD

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ORIGINAL

4 Attorneys for Plaintiff Invitrogen Corporation

BY: *[Signature]* DEPUTY

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8 **UNITED STATES DISTRICT COURT**

9 **FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

10 INVITROGEN CORPORATION,

) Civil Action No.:

11 Plaintiff,

) **'01 CV 1628 W (JFS)**

12 vs.

) **COMPLAINT FOR PATENT
INFRINGEMENT AND INDUCEMENT TO
INFRINGE**

13 TOYOBO CO., LTD.,

)

14 Defendant.

) Jury Demanded

15

16 Plaintiff Invitrogen Corporation ("Invitrogen"), for its complaint against Defendant

17 Toyo Boseki Kabushiki Kaisha, DBA Toyobo Co., Ltd. ("Toyobo"), alleges as follows:

18

PARTIES

19

1. Plaintiff Invitrogen is a corporation organized and existing under the laws of
20 the State of Delaware, with its principle place of business at 1600 Faraday Ave., Carlsbad, CA
21 92008.

22

2. On information and belief, Defendant Toyobo is a corporation organized and
23 existing under the laws of Japan, its principal place of business located at 2-8, Dojima Hama
24 2-chome, Kita-ku, Osaka 530-8230, Japan.

25

JURISDICTION AND VENUE

26

3. This action arises under the patent laws of the United States, Title 35, United
27 States Code, and more particularly under 35 U.S.C. § § 271, *et seq.*

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1 4. Jurisdiction of this cause is conferred on this Court by Title 28, U.S.C.
2 § 1338(a).

3 5. Venue properly lies in this judicial district pursuant to 28 U.S.C. §§ 1391(d)
4 and 1400(b) in that Defendant Toyobo is an alien corporation.

5 6. This Court has personal jurisdiction over Defendant Toyobo pursuant to the
6 California long arm statute, California Code of Civil Procedure section 410.10 .

7 ALLEGATIONS COMMON TO ALL COUNTS

8 7. The following United States Patents (hereinafter "Plaintiff Invitrogen's
9 Patents") were duly and legally issued to Michael L. Kotewicz and Gary F. Gerard on the
10 dates indicated:

- 11 • United States Letters Patent No. 6,063,608 entitled, "CLONED GENES
12 ENCODING REVERSE TRANSCRIPTASE LACKING RNASE H ACTIVITY",
13 issued on May 16, 2000;
- 14 • United States Letters Patent No. 5,668,005 entitled, "CLONED GENES
15 ENCODING REVERSE TRANSCRIPTASE LACKING RNASE H ACTIVITY",
16 issued on September 16, 1997;
- 17 • United States Letters Patent No. 5,405,776 entitled, "CLONED GENES
18 ENCODING REVERSE TRANSCRIPTASE LACKING RNASE H ACTIVITY",
19 issued on April 11, 1995; and
- 20 • United States Letters Patent No. 5,224,797 entitled, "CLONED GENES
21 ENCODING REVERSE TRANSCRIPTASE LACKING RNASE H ACTIVITY",
22 issued on September 14, 1993.

23 8. Plaintiff Invitrogen is the record owner of the entire right, title and interest in
24 and to Plaintiff Invitrogen's Patents with the right to sue and recover for past, present and
25 future infringement thereof.

26 9. Plaintiff Invitrogen's Patents describe and claim certain polypeptides or
27 reverse transcriptases having DNA polymerase activity and having substantially no RNase H
28 activity, no detectable RNase H activity, or lacking RNase H activity.

1 10. Plaintiff Invitrogen sells and distributes products styled SuperScript and
2 SuperScript II, which are manufactured under one or more of Plaintiff Invitrogen's Patents,
3 and marks said products with one or more of Plaintiff Invitrogen's Patents.

4 11. On information and belief, Defendant Toyobo has offered for sale within the
5 United States, imported into the United States and/or sold to third parties within the United
6 States RNase H-Minus Reverse Transcriptase products, including but not limited to a product
7 styled "Moloney Murine Leukemia Virus (M-MLV) Reverse Transcriptase RNase H Minus"
8 (hereinafter "RNase H-minus RT").

9 12. On information and belief, Defendant Toyobo sold Toyobo's RNase H-minus
10 RT to third parties, whose use thereof within the United States directly infringed and/or
11 continues to infringe one or more claims of one or more of Plaintiff Invitrogen's Patents.

12 13. On information and belief, Defendant Toyobo's RNase H-minus RT is a
13 polypeptide or reverse transcriptase having DNA polymerase activity and substantially no
14 RNase H activity.

15 14. On information and belief, Defendant Toyobo's RNase H-minus RT is a
16 polypeptide or reverse transcriptase having DNA polymerase activity and no detectable
17 RNase H activity.

18 15. On information and belief, Defendant Toyobo's RNase H-minus RT is a
19 polypeptide or reverse transcriptase having DNA polymerase activity and lacking RNase H
20 activity.

21 16. On information and belief, Defendant Toyobo's RNase H-minus RT is a
22 polypeptide or reverse transcriptase encoded by a modified reverse transcriptase nucleotide
23 sequence derived from a retrovirus.

24 17. On information and belief, Defendant Toyobo's RNase H-minus RT is a
25 polypeptide or reverse transcriptase encoded by a modified reverse transcriptase nucleotide
26 sequence derived from Moloney murine leukemia virus ("M-MLV").

27 18. On information and belief, Defendant Toyobo's RNase H-minus RT is
28 obtained by modifying a nucleotide sequence coding for a reverse transcriptase, transforming

1 a host cell with the modified nucleotide sequence, culturing the transformed host cell under
2 conditions which produces the reverse transcriptase, and isolating the reverse transcriptase.

3 19. Defendant Toyobo's RNase H-minus RT falls squarely within the scope of one
4 or more claims of Plaintiff Invitrogen's Patents.

5 20. On information and belief, Defendant Toyobo had and has actual and/or
6 constructive notice of Plaintiff Invitrogen's Patents.

7 21. At no time has Plaintiff Invitrogen granted to Defendant Toyobo a license to
8 make, offer for sale, sell, import or use its RNase H-minus RT in or into the United States or
9 elsewhere.

10 22. Defendant Toyobo did not and does not have a license under any one of
11 Plaintiff Invitrogen's Patents to make, offer for sale, sell, import or use its RNase H-minus
12 RT.

13 23. On information and belief, Defendant Toyobo has advertised RNase H-minus
14 RT in its product catalogues which it distributed, free of charge, to customers and potential
15 customers throughout the world.

16 24. On information and belief, Defendant Toyobo has represented its RNase H-
17 minus RT as a reverse transcriptase lacking RNase H activity.

18 FIRST CLAIM FOR RELIEF
19 (Direct Patent Infringement)

20 25. Plaintiff Invitrogen repeats and realleges each and every allegation contained
21 in paragraphs 1 through 24 above as if fully repeated herein.

22 26. Defendant Toyobo has infringed one or more claims of Plaintiff Invitrogen's
23 Patents by importing into the United States, offering for sale, using, selling, and/or causing to
24 be used or sold in the United States, for commercial purposes and without authority one or
25 more RNase H-minus RT products as described in Paragraphs 1 through 24 above.

26 27. Plaintiff Invitrogen has been damaged by the aforesaid infringing acts of
27 Defendant Toyobo.

28

1 28. Defendant Toyobo's infringing acts will continue unless enjoined by this
2 Court.

3 29. Upon information and belief, the acts of infringement complained of herein
4 have been carried out willfully and with full knowledge by Defendant Toyobo of Plaintiff
5 Invitrogen's Patents.

6 SECOND CLAIM FOR RELIEF
7 (Inducement to Infringe)

8 30. Plaintiff Invitrogen repeats and realleges each and every allegation contained
9 in paragraphs 1 through 29 above as if fully repeated herein.

10 31. Defendant Toyobo has actively induced others to infringe one or more claims
11 of Plaintiff Invitrogen's Patents by providing advertisements and instructions intended to
12 persuade others to use and/or make without authority one or more RNase H-minus RT
13 products as described in Paragraphs 1 through 24 above.

14 32. Defendant Toyobo's customers who purchased and are using and/or have used
15 Defendant Toyobo's RNase H-minus RT are directly infringing and/or have directly infringed
16 one or more claims of Plaintiff Invitrogen's Patents.

17 33. Plaintiff Invitrogen has been damaged and will continue to be damaged by the
18 aforesaid infringing acts of Defendant Toyobo.

19 34. Defendant Toyobo's infringing acts will continue unless enjoined by this
20 Court.

21 35. On information and belief, the acts of infringement complained of herein have
22 been carried out willfully and with full knowledge by Defendant Toyobo of Plaintiff
23 Invitrogen's Patents.

24 PRAYER FOR RELIEF

25 WHEREFORE, Plaintiff Invitrogen prays for the following:

26 1. A preliminary and permanent injunction against continued patent infringement,
27 either by direct infringement or by inducing the infringement of others, by Defendant Toyobo,
28

1 its officers, agents, servants, employees and attorneys, and upon those persons in active
2 concert or participation with them;

3 2. An accounting for profits and damages, or general damages to be assessed by
4 or under the Court's discretion, occasioned by the acts of Defendant Toyobo of which
5 Complaint is made, together with pre- and post-judgment interest;

6 3. An increase of said damages not to exceed three times the amount found or
7 assessed;

8 4. An award of Plaintiff Invitrogen's costs incurred herein;

9 5. An award of Plaintiff Invitrogen's reasonable attorneys' fees incurred herein;

10 and

11 6. Judgment for such other and further relief as the Court may deem just and
12 proper.

13 DEMAND FOR TRIAL BY JURY

14 Pursuant to Rule 38, Fed. R. Civ. P., Plaintiff Invitrogen hereby demands a jury trial
15 of the issues raised in the foregoing Complaint.

16
17 Dated: September 6, 2001

MAZZARELLA, DUNWOODY & CALDARELLI LLP

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19 By: 

20 WILLIAM J. CALDARELLI
21 Attorneys for Plaintiff INVITROGEN
22 CORPORATION
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TO: Commissioner of Patents and Trademarks Washington, D.C. 20231	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT
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In compliance with the Act of July 19, 1952 (66 Stat. 814; 35 U.S.C. 290) you are hereby advised that a court action has been filed on the following patent(s) in the U.S. District Court:

DOCKET NO. 01cv1628W (JFS)	DATE FILED 9/6/01	U.S. DISTRICT COURT United States District Court, Southern District of California
PLAINTIFF Invitrogen Corporation		DEFENDANT Toyobo Co. LTD
PATENT NO.	DATE OF PATENT	PATENTEE
1. 6,063,608	5/16/00	Michael L. Kotewicz and Gary F. Gerard
2. 5,668,005	9/16/97	"
3. 5,405,776	4/11/95	"
4. 5,224,797	9/14/93	"
5		

In the above-entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY			
	<input type="checkbox"/> Amendment	<input type="checkbox"/> Answer	<input type="checkbox"/> Cross Bill	<input type="checkbox"/> Other Pleading
PATENT NO.	DATE OF PATENT	PATENTEE		
1				
2				
3				
4				
5				

In the above-entitled case, the following decision has been rendered or judgment issued:

DECISION/JUDGMENT		
CLERK	(BY) DEPUTY CLERK	DATE

Copy 1 - Upon initiation of action, mail this copy to Commissioner Copy 3 - Upon termination of action, mail this copy to Commissioner
 Copy 2 - Upon filing document adding patent(s), mail this copy to Commissioner Copy 4 - Case file copy

I. (a) PLAINTIFFS

INVITROGEN CORPORATION

DEFENDANTS

TOYOBO CO., LTD.

ORIGINAL
01 SEP -5 PM 4:25

(b) COUNTY OF RESIDENCE OF FIRST LISTED PLAINTIFF San Diego
(EXCEPT IN U.S. PLAINTIFF CASES)

COUNTY OF RESIDENCE OF FIRST LISTED DEFENDANT Alien
(IN U.S. PLAINTIFF CASES ONLY)

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

(c) ATTORNEYS (FIRM NAME, ADDRESS, AND TELEPHONE NUMBER)
MAZZARELLA, DUNWOODY & CALDARELLI, LLP
William J. Caldarelli
MAZZARELLA, DUNWOODY & CALDARELLI, LLP
San Diego, CA 92101
(619) 238-4900

ATTORNEYS (IF KNOWN) **01 CV 1628 W (JFS)**

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)

	PT	DEF		PT	DEF
Citizen of This State	<input type="checkbox"/> 1	<input type="checkbox"/> 1	Incorporated or Principal Place of Business in This State	<input type="checkbox"/> 4	<input type="checkbox"/> 4
Citizen of Another State	<input type="checkbox"/> 2	<input type="checkbox"/> 2	Incorporated and Principal Place of Business in Another State	<input type="checkbox"/> 5	<input type="checkbox"/> 5
Citizen or Subject of a Foreign Country	<input type="checkbox"/> 3	<input type="checkbox"/> 3	Foreign Nation	<input type="checkbox"/> 6	<input type="checkbox"/> 6

IV. CAUSE OF ACTION (CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE A BRIEF STATEMENT OF CAUSE. DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY.) **35 U.S.C. § 271, Patent Infringement**

V. NATURE OF SUIT (PLACE AN "X" IN ONE BOX ONLY)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury - Medical Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input checked="" type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (13958) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS - Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reappointment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce/ICC Rates/etc. <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes <input type="checkbox"/> 890 Other Statutory Actions
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 440 Other Civil Rights	PRISONER PETITIONS <input type="checkbox"/> 510 Motion to Vacate Sentence HABEAS CORPUS: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Conditions		

VI. ORIGIN (PLACE AN "X" IN ONE BOX ONLY)

- 1 Original Proceeding
 2 Removal 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

VII. REQUESTED IN COMPLAINT: CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23 DEMAND \$ 500,000

CHECK YES only if demanded in complaint:
JURY DEMAND: YES NO

VIII. RELATED CASE(S) IF ANY (See instructions): JUDGE _____ Docket Number _____

DATE: September 6, 2001 SIGNATURE OF ATTORNEY OF RECORD: *William J. Caldarelli* William J. Caldarelli

#074761 \$150.00
 :ODMA\PCDOCS\WORDPERFECT\228161 January 24, 2000 (3:10pm)