

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WISCONSIN**

PROMEGA CORPORATION,

Plaintiff,

MAX-PLANCK GESELLSCHAFT ZUR
FORDERUNG DER WISSENSCHAFTEN
E.V.,

Involuntary Plaintiff,

v.

LIFE TECHNOLOGIES CORPORATION and
APPLIED BIOSYSTEMS, LLC,

Defendants.

Civil Action No. 13-cv-119

COMPLAINT

Plaintiff Promega Corporation (“Promega”) for its complaint against Defendants Life Technologies Corporation (“Life Tech”) and Applied Biosystems, LLC (“Applied Biosystems”) alleges as follows:

NATURE OF THIS ACTION

1. This is an action for patent infringement arising from Life Tech and Applied Biosystems’ infringement of U.S. Patent No. Re 37,984 (the “’984 Patent”) by the use, manufacture, importation, sales and offers for sale of the AuthentiFiler™ products discussed below.
2. Promega seeks damages and injunctive relief for Life Tech and Applied Biosystems’ willful infringement of the ’984 Patent, being a valid patent to which Promega owns exclusive rights in certain fields of use pursuant to a license agreement between Promega and Research Genetics, Inc. (“Research Genetics”) dated June 19, 1996 (the “1996 Agreement”).

3. Pursuant to the 1996 Agreement, Research Genetics granted to Promega, *inter alia*, certain exclusive rights to use, make, offer to sell, sell and import methods, products, and compositions of matter embraced by the '984 Patent. Life Tech and Applied Biosystems have been using, manufacturing, selling, and offering for sale the AuthentiFiler™ products, which products infringe Promega's exclusive rights to the '984 Patent.

PARTIES

4. Plaintiff Promega is a Wisconsin corporation with a principal place of business located at 2800 Woods Hollow Road, Madison, WI 53711.

5. Involuntary Plaintiff Max-Planck Gesellschaft zur Forderung der Wissenschaften e.V. ("Max-Planck") is a non-profit research institute organized and existing under the laws of Germany, with its principal offices located at Hofgartenstr. 8, 80539 München, Germany. Max-Planck is a German corporation without any Wisconsin offices or significant Wisconsin contacts. Max-Planck is named as an involuntary plaintiff because it has expressed its unwillingness to participate in the previous, related litigation of *Promega Corp. v. Life Technologies, et al.*, No. 10-cv-281-bbc (W.D. Wis. filed May 26, 2010). Max-Planck is the owner of the '984 Patent and may have an interest therein.

6. Defendant Life Tech is a corporation organized under the laws of Delaware with a principal place of business located at 5791 Van Allen Way, Carlsbad, California.

7. Defendant Applied Biosystems is a limited liability corporation organized under the laws of Delaware with a principal place of business located at 5791 Van Allen Way, Carlsbad, California.

JURISDICTION

8. This action arises under the Patent Laws of the United States of America, 35 U.S.C. § 1 *et seq.* This Court has federal question jurisdiction under 28 U.S.C. § 1331 and 28 U.S.C. § 1338(a) because this is a civil action arising under the Patent Act.

9. This Court also has jurisdiction based on the diversity of citizenship existing between the parties pursuant to 28 U.S.C. § 1332. Plaintiff Promega is incorporated in and has its principal place of business in the State of Wisconsin. Involuntary Plaintiff Max-Planck is incorporated in and has its principal place of business in Germany. Life Tech and Applied Biosystems are each incorporated in Delaware and have their principal place of business in California. The amount in controversy exceeds the sum of \$75,000.00, exclusive of interest and costs.

10. This Court has personal jurisdiction over Life Tech and Applied Biosystems because, among other things, they transact business within this judicial district, and therefore have substantial and continuous contacts with this judicial district.

VENUE

11. Venue is proper under 28 U.S.C. § 1391 because for venue purposes Life Tech and Applied Biosystems reside in this judicial district, and under 28 U.S.C. § 1400 because Life Tech and Applied Biosystems have committed acts of infringement in this district.

FACTUAL BACKGROUND

U.S. Patent No. Re 37,984 (the “984 Patent”)

12. On February 11, 2003, following reexamination proceedings, the ‘984 Patent was duly and legally issued to Herbert Jäckle and Diethard Tautz for an invention entitled “Process for Analyzing Length Polymorphism in DNA Regions.” A copy of the ‘984 Patent is attached hereto as Exhibit A and made part of this Complaint.

13. Involuntary Plaintiff Max-Planck is the owner by assignment of the '984 Patent. Max Planck Innovation, called Garching Instruments GmbH until 1993, and from 1993 to the end of 2006 called Garching Innovation GmbH ("Garching"), is a 100% subsidiary and technology transfer agency of Max-Planck, organized and existing under the laws of Germany, with its principal offices located at Amalienstr. 33, 80799, München, Germany. It has the right through Max-Planck to license technology owned by Max-Planck, including the '984 Patent.

14. By the terms of an agreement dated September 30, 1993, between Research Genetics and Garching/Max-Planck, Research Genetics obtained exclusive worldwide patent rights in German patent number 38 34 636 and corresponding patents and patent applications in the United States, including what became the '984 Patent.

The Promega/Research Genetics 1996 License Agreement

15. Promega, Garching, and Research Genetics executed the 1996 Agreement on June 19, 1996.

16. Pursuant to the terms of the 1996 Agreement, Research Genetics granted to Promega a license in certain of Research Genetics' patent rights, including the '984 Patent. Promega also granted a license to Research Genetics in certain of Promega's patent rights.

17. The patents involved in the 1996 Agreement relate to the analysis of STR (small tandem repeat) loci for genetic analysis. Genetic analysis using STRs has a host of applications in, for example, research, forensics, paternity determination, and medicine. As a result, government agencies, universities, courts, hospitals and many other public and private institutions utilize products that require access to patent rights implicated by the 1996 Agreement.

18. The 1996 Agreement grants to Promega certain exclusive rights to the '984 Patent. The 1996 Agreement also grants to Promega the right to sublicense to third parties the rights

Promega acquired pursuant to the 1996 Agreement. By virtue of the rights acquired under the 1996 Agreement, Promega has standing to sue for infringement of the '984 Patent.

Life Tech and Applied Biosystems' AuthentiFiler™ Products

19. In December 2012, Life Tech and Applied Biosystems notified Promega that they had developed a new line of STR products called AuthentiFiler™, and filed a lawsuit in the United States District Court for the Southern District of California, *Life Technologies Corp., et al., v. Promega Corp.*, No 12-cv-2987 (filed Dec. 17, 2012) (“the California action”) related to the AuthentiFiler™ products. The California action, *inter alia*, seeks a declaratory judgment that the AuthentiFiler™ products do not infringe Promega’s exclusive rights to the ‘984 Patent under the 1996 Agreement. Promega has not yet been served with the complaint in the California action.

20. According to the allegations contained in the complaint filed in the California action, Life Tech and Applied Biosystems began selling the AuthentiFiler™ products in December 2012. Life Tech and Applied Biosystems also allege that the “AuthentiFiler™ products operate according to the same general principles as [their] AmpFISTR® products, and thus include the same general classes of components.”

21. In 2010, Promega sued Life Tech, Applied Biosystems, and Invitrogen Holdings in the United States District Court for the Western District of Wisconsin alleging, *inter alia*, that certain AmpFISTR® products infringed the ‘984 Patent. *Promega Corp. v. Life Technologies, et al.*, No. 10-cv-281-bbc (W.D. Wis. filed May 26, 2010). That litigation remains ongoing.

22. Because Life Tech and Applied Biosystems have asserted that the new AuthentiFiler™ products rely on the same technology as the AmpFISTR® products that were the subject of Promega’s claims for infringement of the ‘984 Patent in the 2010 suit, and based on an

investigation of the AuthentiFiler™ products, Promega believes that the AuthentiFiler™ products also infringe Promega's exclusive rights to the '984 Patent.

CLAIMS FOR RELIEF

COUNT I — Direct Infringement of U.S. Patent No. Re 37,984

23. Promega repeats and incorporates by reference the allegations contained in the foregoing paragraphs as though fully set forth herein.

24. Life Tech and Applied Biosystems' use, manufacture, importation, sales and offers for sale of the AuthentiFiler™ products constitute infringement of at least claim 35 of the '984 Patent in violation of 35 U.S.C. § 271(a).

25. Life Tech and Applied Biosystems' infringement of the '984 Patent has caused and is causing injury to Promega.

26. Life Tech and Applied Biosystems had knowledge of the '984 Patent and of Promega's exclusive rights to the '984 Patent at all relevant times, and their infringement of the '984 has been and continues to be willful.

COUNT II — Induced Infringement of U.S. Patent No. Re 37,984

27. Promega repeats and incorporates by reference the allegations contained in the foregoing paragraphs as though fully set forth herein.

28. Through their labeling, package inserts, publications, website, and/or promotional materials, Life Tech and Applied Biosystems instruct their customers to use the AuthentiFiler™ products in an infringing manner. Specifically, Life Tech and Applied Biosystems encourage infringement of at least claim 15 of the '984 Patent.

29. Life Tech and Applied Biosystems have knowledge of the '984 Patent and Promega's exclusive rights to the '984 Patent, and that the uses indicated and promoted on their labeling,

package inserts, publications, website, and/or promotional materials infringe the claims of the '984 Patent. Life Tech and Applied Biosystems intentionally encourage this infringing use.

30. Life Tech and Applied Biosystems' acts described above constitute active inducement of infringement of the '984 Patent, and they are liable as infringers under 35 U.S.C. § 271(b).

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Promega Corporation respectfully requests that this Court grant judgment in its favor and against Defendants Life Technologies Corporation and Applied Biosystems, L.L.C. and respectfully prays for the following relief:

- A. A judgment that Life Tech and Applied Biosystems have infringed and induced others to infringe the '984 Patent;
- B. An award of damages to Promega, in an amount to be determined at trial, with interest and costs for Life Tech and Applied Biosystems' infringement of the '984 Patent;
- C. A finding that Life Tech and Applied Biosystems' infringement of the '984 Patent was willful and that Promega is entitled to enhanced damages within the meaning of 35 U.S.C. § 284;
- C. A judgment in Promega's favor that this is an exceptional case within the meaning of 35 U.S.C. § 285 and an award of attorneys' fees pursuant thereto;
- D. A permanent injunction enjoining Life Tech and Applied Biosystems, its officers, partners, employees, agents, parents, subsidiaries, attorneys, and anyone acting or participating with them, from manufacturing, making, selling, offering for sale, importing, or using the AuthentiFilerTM products in an infringing fashion;
- E. Such other relief as the Court deems just and equitable.

DEMAND FOR A JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff Promega Corporation hereby demands a trial by jury on all issues so triable.

Dated this 19th day of February, 2013

Respectfully submitted,

/s/ David L. Anstaett

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