

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

PROMEGA CORPORATION,

Plaintiff,

v.

APPLIED BIOSYSTEMS, LLC,
LIFE TECHNOLOGIES CORPORATION, and
CALIFORNIA INSTITUTE OF TECHNOLOGY,

Defendants.

C.A. No. 12-cv-49

JURY TRIAL DEMAND

REDACTED PUBLIC VERSION

FOURTH AMENDED COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Promega Corporation for its Fourth Amended Complaint against Defendants Applied Biosystems, LLC, Life Technologies Corporation and the California Institute of Technology hereby alleges as follows:

NATURE OF THE ACTION

1. This is a Declaratory Judgment action brought against Applied Biosystems, LLC (“ABLLC”), Life Technologies Corporation (“Life Tech”) and the California Institute of Technology (“Caltech”) (collectively “Defendants”) based on their infringement assertions and infringement allegations against Promega.

2. This action was first filed in this district on January 31, 2012. It arises under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202 and the patent laws of the United States, Title 35, United States Code. Specifically, this action seeks a declaration that U.S. Reissue Patent No. RE43,096 (“the ’096 patent” or “the patent-in-suit”) is invalid and

unenforceable and/or not infringed by Promega. The '096 patent is a reissue of U.S. Patent No. 6,200,784 ("the '748 patent"), which was previously asserted against Promega in this district. As such, the current case is related to a claim filed in this district in 2001. A copy of the '096 patent is attached as Exhibit A.

3. Promega's Fourth Amended Complaint is made necessary by Defendants' continued gamesmanship with regard to their collective rights in the '096 patent, and their repeated efforts to deprive Promega of its choice of forum.

THE PARTIES

4. Promega Corporation ("Promega") is a corporation organized and existing under the laws of Wisconsin with a principal place of business at 2800 Woods Hollow Road, Madison, Wisconsin 53711.

5. Upon information and belief, Defendant Applied Biosystems, LLC is a wholly-owned subsidiary of Life Technologies Corporation, with a principal place of business at 5791 Van Allen Way, Carlsbad, California 92008.

6. Upon information and belief, Applied Biosystems, LLC was the exclusive licensee of the '096 patent, and related patents and applications, including the '748 patent until October 30, 2012. Upon information and belief, Life Tech became the exclusive licensee of the '096 patent on October 30, 2012. Promega is without knowledge as to any division of rights in the '096 patent between ABLLC and Life Tech.

7. Upon information and belief, Defendant Caltech is a private university having a principal address of 1200 East California Boulevard, Pasadena, California 91125. Caltech is the assignee of the '096 patent, and related patents and applications, including the '748 patent.

JURISDICTION AND VENUE

8. This action arises under the United States patent laws, 35 U.S.C. §§ 1 *et seq.*, and under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.

9. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. § 1331 and §1338(a).

10. Venue is proper in this judicial district under 28 U.S.C. § 1391.

11. Defendant ABLLC is subject to personal jurisdiction in this district. Upon information and belief, ABLLC conducts business in this district by selling various products, including products related to DNA sequencing, nucleic acid detection and purification and PCR amplification.

12. Defendant Life Tech is subject to personal jurisdiction in this district. Upon information and belief, Life Tech conducts business in this district by selling various products, including products related to DNA sequencing, PCR amplification and gene expression analysis.

13. Defendant Caltech is subject to personal jurisdiction in this district. Caltech is an internationally-recognized institution of higher learning that recruits undergraduate and graduate students from various locations across the nation and around the world. Caltech's admissions office specifically recruits students from the State of Wisconsin. By virtue of these substantial activities within Wisconsin, Caltech is subject to the personal jurisdiction of this Court pursuant to Wis. Stat. § 801.05(1)(d). Further, upon information and belief, Caltech is also subject to the personal jurisdiction of this Court because it has previously elected to assert other, unrelated patent rights in this district in litigation with other parties. (*Sirona Dental Sys., Inc. and California Institute of Technology v. Palodex Group Oy and Instrumentarium Dental, Inc.*, No. 3:09-cv-00266-bbc.)

14. Upon information and belief, Defendants Caltech and ABLLC are also subject to personal jurisdiction in this district because they, and ABLLC's predecessors-in-interest, have purposefully directed activities related to enforcement of the '096 patent, and its predecessor patent, the '748 patent, against Promega, a resident of this district. ABLLC's predecessor-in-interest, Applera Corporation, alleged that Promega infringed the '748 patent in 2001, after having received explicit permission from Caltech to assert the patent. In January 2012, following the reissue of the '748 patent as the '096 patent, ABLLC contacted Promega to demand payment of royalties it asserted that Promega owed. This claim arises out of and relates to those activities, and this Court's exercise of personal jurisdiction over Caltech and ABLLC comports with due process.

15. There is an actual and justiciable controversy between the parties concerning the patent-in-suit, as set forth more fully below.

BACKGROUND TO THE ACTION

16. This declaratory judgment action relates to the '096 patent," entitled "Tagged Extendable Primers and Extension Products," which issued on January 10, 2012.

17. The '096 patent claims priority, through a chain of continuation and continuation-in-part applications—many of which were abandoned—to a patent application filed almost thirty (30) years ago, on January 16, 1984.

18. On its face, the '096 patent is assigned to Caltech. Upon information and belief, the '096 patent was exclusively licensed to ABLLC at the time this action was filed. Upon information and belief, ABLLC held the exclusive license to the '096 patent until October 30, 2012, at which time Caltech purportedly transferred the exclusive license to Life Tech.

19. Upon information and belief Caltech exclusively licensed the '096 patent and related patents in 1988 to ABLLC's predecessor-in-interest, Applied Biosystems, Inc. ("ABI"). Upon information and belief, Caltech explicitly authorized ABI to enforce these patent rights through both licensing and litigation efforts.

20. Upon information and belief, and as further set forth below, ABI's interest in the '748 patent and any reissue patents, including the '096 patent, was acquired by Applera Corporation and its Applied Biosystems Group (collectively "Applera").

21. Upon information and belief, ABLLC subsequently acquired Applera's interest in the '748 patent and any reissue patents.

22. This action is not the first patent litigation between Promega and ABLLC, or its predecessors-in-interest, in this district. Nor is it the first time that an attempt has been made to enforce a patent claiming the alleged invention of the '096 patent against Promega.

23. In 2001, Promega filed a lawsuit on patents unrelated to the '096 patent against several defendants, including Applera, in this district. (*Promega Corporation v. Applera Corporation*, No. 3:01-cv-00244-bbc) ("the 2001 litigation").

24. Applera counterclaimed, asserting that Promega's products infringed the '748 patent. Applera did not join Caltech as a party to the 2001 litigation, but instead pled that Applera had "rights" in the '748 patent, "such that it may enforce that patent."

25. Upon information and belief, Caltech explicitly authorized Applera's assertion of the '748 patent against Promega.

26. During the 2001 litigation, Applera alleged that Promega infringed the '748 patent "by its activities in connection with products containing fluorescently labeled oligonucleotides, including but not limited to its GenePrint and PowerPlex systems and associated products."

(*Promega Corporation v. Applera Corporation*, No. 3:01-cv-00244, First Amended Answer at ¶ 57 (Oct. 29, 2001).)

27. During the 2001 litigation, Judge Crabb of this district construed certain terms of the '748 patent in light of the specification's teaching that an "object of this invention" was to "provide a novel process for the sequence analysis of DNA." (*Promega Corporation v. Applera Corporation*, No. 3:01-cv-00244, 2002 U.S. Dist. LEXIS 26927 at *32 (January 2, 2002).)

28. Promega moved for summary judgment of no infringement of the '748 patent, and for invalidity of the '748 patent under 35 U.S.C. §§ 102, 103 and 112. Shortly thereafter, the parties reached substantial settlement of their dispute. The court dismissed the 2001 litigation on October 30, 2002, after the parties fully briefed Promega's summary judgment motions, but before any rulings on those motions were made.

29. [REDACTED]

30. On March 13, 2003, Caltech placed the '748 patent into an allegedly broadening reissue proceeding at the U.S. Patent & Trademark Office ("the USPTO"). The '096 reissue patent did not issue for nearly a decade.

31. Upon information and belief, in 2008, Applera's Applied Biosystems Group merged with Invitrogen Corporation to form a Life Tech.

32. In 2010, Promega filed a lawsuit on patents unrelated to the '096 patent against several defendants, including Life Tech and ABLLC. (*Promega Corporation v. Life Technologies Corporation*, No. 3:10-cv-00281-bbc) (W.D. Wisc.) (“the 2010 litigation”). The 2010 litigation went to trial in February of 2012.

33. During the course of the 2010 litigation, Judge Crabb addressed in some respects the scope of the Cross License Agreement between the parties, determining, for example, the meaning of “Forensics and Human Identity Applications.”

34. On January 13, 2012, ABLLC sent a letter (“Demand Letter”) to Promega concerning the '748 patent, informing Promega that ABLLC was successor-in-interest to Applera and stating that the '096 reissue patent had been granted three days earlier.

35. ABLLC stated in the Demand Letter that [REDACTED]

[REDACTED]

[REDACTED]

36. ABLLC also accused Promega of infringement in the Demand Letter, stating that

[REDACTED]

[REDACTED]

[REDACTED]

37. In the Demand Letter, ABLLC [REDACTED]

[REDACTED]

[REDACTED] and further set a deadline of January 31, 2012 for Promega to respond to ABLLC’s demands in writing.

38. Lacking information as to the distribution of rights in the '096 patent between ABLLC and its parent company, Life Tech, Promega filed this action on January 31, 2012

against both companies based on the Demand Letter and the parties' history of litigation on the '748 patent.

39. Upon information and belief, ABLLC informed Caltech of this action on February 9, 2012, and requested that Caltech bring a counterclaim of infringement.

40. Promega was informed that the only license agreement regarding Caltech's rights in the '096 patent was an exclusive license agreement from Caltech to ABLLC. Life Tech was dismissed from this suit without prejudice on April 19, 2012.

41. Promega amended its Complaint in this action on May 14, 2012 to name Caltech, the '096 patent owner, as a defendant in this litigation. (Dkt. No. 42). Caltech was named a defendant in this action based on ABLLC's representations—with which Promega disagreed—that ABLLC was an exclusive licensee that lacked all substantial rights in the '096 patent. (Dkt. Nos. 38, 89, 107).

42. Upon information and belief, Caltech transferred an exclusive license to the '096 patent from ABLLC to Life Tech on October 30, 2012.

43. On November 19, 2012, Caltech and Life Tech filed a second action in the Central District of California alleging that Promega infringed one or more claims of the '096 patent. (*Life Technologies Corporation and the California Institute of Technology v. Promega Corporation*, No. cv12-9878-JAK).

44. There is an actual and justiciable controversy between the parties concerning the '096 patent, based on the history of litigation between the parties, a prior lawsuit in which Promega was accused of infringing the '784 patent, which has just been reissued as the '096 patent, and the positions that ABLLC and Life Tech, Caltech's exclusive licensees, have taken

regarding the scope of the Cross License Agreement, the '096 patent and certain Promega products alleged to infringe claims of the '096 patent.

COUNT I

**(Declaratory Judgment of Invalidity of
U.S. Reissue Patent No. RE43,096)**

45. Promega hereby restates and realleges the allegations set forth in paragraphs 1-44 above.

46. The claims of the '096 patent are invalid because they do not meet one or more of the conditions for patentability specified in at least 35 U.S.C. §§ 102, 103, 112 and 251.

47. Promega is entitled to a declaration that the claims of the '096 patent are invalid.

COUNT II

**(Declaratory Judgment of Unenforceability of U.S. Reissue Patent No.
RE43,096 for Prosecution Laches)**

48. Promega hereby restates and realleges the allegations set forth in paragraphs 1-44 above.

49. The claims of the '096 patent issued after an unreasonable and unexplained delay in prosecution, claiming priority to a patent application filed almost thirty (30) years ago in 1984.

50. During applicant's delay in seeking the '096 patent claims, Promega invested in the technology that, upon information and belief, Defendants intend to allege in this district as they have in another district, is now purportedly claimed in the '096 patent, by developing products and launching them in the market. Thus, Promega has been prejudiced by the delay in prosecution of the claims of the '096 patent.

51. Promega is entitled to a declaration that the claims of the '096 patent are unenforceable for prosecution laches.

COUNT III

**(Declaratory Judgment of Non-Infringement of
U.S. Reissue Patent No. RE43,096)**

52. Promega hereby restates and realleges the allegations set forth in paragraphs 1-44 above.

53. ABLLC's predecessor-in-interest alleged that Promega infringed the predecessor patent to the '096 patent, the '748 patent, "by its activities in connection with products containing fluorescently labeled oligonucleotides, including but not limited to its GenePrint and PowerPlex systems and associated products."

54. In connection with a demand letter sent on January 13, 2012, ABLLC has asserted that products including Promega's PowerPlex® 16 HS System, StemElite™ ID System and Cell ID™ System infringe one or more claims of the '096 patent. ABLLC has also asserted that royalties are owed on products that include, but are not limited to, products listed on Schedule 1.9(a) of a 2006 Settlement Agreement between Promega and Applera.

55. In connection with a second-filed action in the Central District of California, Life Tech and Caltech have alleged that Promega infringes claims of the '096 patent in connection with various products that include, but are not limited to, Promega's PowerPlex®, StemElite™ and Cell ID™ products.

56. Promega does not infringe, either directly or indirectly, whether literally or under the Doctrine of Equivalents, or, in the alternative by application of the reverse Doctrine of Equivalents, any valid, properly construed claim of the '096 patent.

57. Promega is entitled to a declaration that it does not infringe any valid claim of the '096 patent.

JURY DEMAND

Promega requests a trial by jury of all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Promega prays for judgment as follows:

- a. A declaration that the claims of the '096 patent are invalid;
- b. A declaration that the claims of the '096 patent are unenforceable for prosecution laches;
- c. A declaration that it does not infringe any valid claim of the '096 patent;
- d. That Promega be awarded its costs, disbursements and attorneys' fees in accordance with 35 U.S.C. § 285; and
- e. That Promega be awarded such other and further relief as the Court may deem just and equitable.

Dated: December 10, 2012

Respectfully submitted,

/s/ Sharon E. Roberg-Perez

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CERTIFICATE OF SERVICE

I hereby certify that this document, filed through the ECF system of the Western District of Wisconsin, will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) on December 10, 2012. Any non-registered participants to whom non-ECF service must be made will be served by electronic mail.

/s/ Matthew B. McFarlane

Matthew B. McFarlane