

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

CORNING INCORPORATED,

Plaintiff,

v.

DSM DESOTECH, INC., and  
DSM I.P. ASSETS, B.V.,

Defendants.

C.A. No. 14-cv-01081-SLR

**JURY TRIAL DEMANDED**

**AMENDED COMPLAINT FOR DECLARATORY JUDGMENT**

Plaintiff, Corning Incorporated, files this complaint for declaratory judgment against Defendants DSM Desotech, Inc. and DSM I.P. Assets, B.V. and alleges as follows:

**THE PARTIES**

1. Corning Incorporated (“Corning”) is a New York corporation having its principal place of business at One Riverfront Plaza, Corning, NY 14831.

2. On information and belief, Koninklijke DSM N.V. (“Koninklijke”) is a Netherlands corporation.

3. On information and belief, DSM I.P. Assets B.V. (“DSM I.P. Assets”) is a Netherlands corporation. On information and belief, DSM I.P. Assets is a wholly-owned subsidiary of Koninklijke.

4. On information and belief, DSM Desotech Inc. (“DSM Desotech”) is a Delaware corporation, with headquarters at 2711 Centerville Rd., Suite 400, Wilmington, DE 19808, and having its principal place of business in Elgin, Illinois. On information and belief, DSM

Desotech is a wholly-owned subsidiary of DSM NeoResins B.V. which is itself a subsidiary of Koninklijke.

5. On information and belief, DSM Desotech is an agent in the United States of DSM I.P. Assets. DSM I.P. Assets and DSM Desotech are herein collectively referred to as “DSM.”

6. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 7,171,103 (“the ’103 Patent”) entitled “Coated optical fibers,” which issued January 30, 2007. A copy of the ’103 Patent is attached hereto as Exhibit A.

7. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 6,961,508 (“the ’508 Patent”) entitled “Coated optical fibers,” which issued November 1, 2005. A copy of the ’508 Patent is attached hereto as Exhibit B.

8. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 6,339,666 (“the ’666 Patent”) entitled “Radiation-curable optical glass fiber coating compositions, coated optical glass fibers, and optical glass fiber assemblies,” which issued January 15, 2002. A copy of the ’666 Patent is attached hereto as Exhibit C.

9. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 6,438,306 (“the ’306 Patent”) entitled “Radiation curable resin composition,” which issued August 20, 2002. A copy of the ’306 Patent is attached hereto as Exhibit D.

10. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 6,298,189 (“the ’189 Patent”) entitled “Radiation-curable optical glass fiber coating compositions, coated optical glass fibers, and optical glass fiber assemblies,” which issued October 2, 2001. A copy of the ’189 Patent is attached hereto as Exhibit E.

11. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 7,276,543 (“the ’543 Patent”) entitled “Radiation curable resin composition,” which issued October 2, 2007. A copy of the ’543 Patent is attached hereto as Exhibit F.

12. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 7,067,564 (“the ’564 Patent”) entitled “Coated Optical Fibers,” which issued June 27, 2006. A copy of the ’564 Patent is attached hereto as Exhibit H.

13. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 7,706,659 (“the ’659 Patent”) entitled “Coated Optical Fibers,” which issued April 27, 2010. A copy of the ’659 Patent is attached hereto as Exhibit I.

14. On information and belief, DSM I.P. Assets is the assignee, and DSM Desotech is the exclusive licensee, of U.S. Patent No. 7,865,055 (“the ’055 Patent”) entitled “Coated Optical Fibers,” which issued January 4, 2011. A copy of the ’055 Patent is attached as Exhibit J.

15. The patents described in paragraphs 6–14 are herein collectively referred to as “the DSM patents.”

### **JURISDICTION AND VENUE**

16. This action is based on the patent laws of Title 35 of the United States Code, § 1 *et seq.*, with a specific remedy sought under the Federal Declaratory Judgments Act, 28 U.S.C.

§§ 2201 and 2202. An actual, substantial, and continuing justiciable controversy exists between Corning and Defendants with respect to the validity and infringement of the DSM patents that requires a declaration of rights by this Court.

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

18. This Court has personal jurisdiction over DSM Desotech because it resides in the state of Delaware and in this District, and is incorporated in the state of Delaware. Further, this Court also has personal jurisdiction over DSM Desotech by virtue of its purposeful contacts with this District, such that it could have reasonably expected to be haled into Court in this District.

19. This Court has personal jurisdiction over DSM I.P. Assets because, for example, DSM I.P. Assets both transacts business in Delaware and contracts to supply services or things in Delaware. On information and belief, DSM Desotech is an agent of DSM I.P. Assets with respect to the DSM patents and therefore DSM Desotech's activities are relevant to establishing personal jurisdiction over DSM I.P. Assets, and vice versa. DSM I.P. Assets' purposeful activities within this District are continuous and systematic such that DSM I.P. Assets should have reasonably anticipated being haled into Court in this District. The existence of personal jurisdiction is, at a minimum, supported by, on information and belief: (1) the corporate relationship between DSM Desotech and DSM I.P. Assets (*see* paragraphs 2–4); (2) the licensing relationship between DSM Desotech and DSM I.P. Assets involving use of the DSM patents in connection with Delaware (*see* paragraph 28); (3) DSM Desotech's coatings are incorporated into optical fibers sold in Delaware; (4) DSM Desotech's threats to assert intellectual property assigned to DSM I.P. Assets (*see* paragraphs 31-37); (5) the automatic redirection from [www.dsmdesotech.com](http://www.dsmdesotech.com), which is registered to DSM I.P. Assets B.V., to [www.dsm.com](http://www.dsm.com), which

is also registered to DSM I.P. Assets B.V.; (6) DSM Desotech's representatives' repeated use of "@dsm.com" e-mail addresses, a domain name that is registered to DSM I.P. Assets B.V.; and (7) DSM I.P. Assets' statements during Inter Partes Review ("IPR") proceedings providing that both entities are the "the real parties-in-interest" with respect to six of the DSM patents (*see* paragraph 28).

20. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b)(1) because all Defendants "reside" in this District within the meaning of 28 U.S.C. § 1391(c)(2) insofar as they are subject to personal jurisdiction in this District as described above. In addition, venue in this District is proper pursuant to 28 U.S.C. § 1391(b)(3) and 35 U.S.C. § 1391(c)(3) because DSM Desotech resides in this District and DSM I.P. Assets is a foreign corporation.

#### **THE PRESENCE OF AN ACTUAL CONTROVERSY**

21. Corning is one of the world's leading innovators in materials science. Corning has applied its innovations in the fields of specialty glass, ceramics, and optical fibers. Today, Corning's products enable diverse industries such as consumer electronics, telecommunications, transportation, and life sciences. Corning employs approximately 30,000 people worldwide.

22. DSM Desotech is a developer and manufacturer of optical fiber coatings.

23. On information and belief, DSM Desotech is the exclusive licensee of the DSM patents, which are assigned to DSM I.P. Assets.

24. Corning has purchased optical fiber coatings from DSM Desotech since at least the 1990's. Corning and DSM Desotech are parties to a supply agreement which, as amended, is now expired. Despite repeated attempts in 2013 and 2014, the parties have been unable to reach an agreement for future purchases of optical fiber coatings. In the absence of a supply agreement, DSM Desotech has consistently maintained that Corning would infringe upon DSM

Desotech's intellectual property rights if it produced its own optical coatings or acquired them from other suppliers. On information and belief, in making these threats, DSM Desotech was referring to intellectual property assigned to DSM I.P. Assets and exclusively licensed to DSM Desotech, including the DSM patents.

25. While Corning continued to purchase coatings from DSM Desotech under the supply agreement, Corning also has developed and manufactures, or has third parties manufacture for its exclusive use, proprietary coatings of its own, including its "Kuna" coating.

26. In November 2012, Corning filed petitions in the United States Patent & Trademark Office ("USPTO") seeking Inter Partes Reviews ("IPRs") of the following DSM patents: U.S. Pat. Nos. 7,171,103 (IPR2013-00043); 6,961,508 (IPR2013-00044); 6,339,666 (IPR2013-00045); 6,438,306 (IPR2013-00047); 6,298,189 (IPR2013-00048; IPR2013-00049); and 7,276,543 (IPR2013-00052; IPR2013-00053). While many patent claims were invalidated, each patent contains at least one claim that was not invalidated. All of these IPR proceedings were instituted against DSM I.P. Assets which, on information and belief, is the assignee of the DSM patents.

27. Corning filed two additional IPRs, also on patents assigned to DSM I.P. Assets, which invalidated all associated patent claims: U.S. Pat. Nos. 6,110,593 (IPR2013-00046); 6,323,255 (IPR2013-00050).

28. During the IPR proceedings, DSM I.P. Assets identified DSM Desotech as a "real party in interest." For example, with respect to U.S. Pat. No. 7,171,103 (IPR2013-00043), DSM I.P. Assets' notice pursuant to 37 C.F.R. § 42.8 provided that: "The real parties-in-interest are DSM I.P. Assets B.V., the owner of the U.S. Patent No. 7,171,103 ("103"), and DSM Desotech Inc., a corporate affiliate of DSM I.P. Assets B.V. that develops and sells coating compositions

for optical fibers.” Similar notices were filed with respect to the other DSM patents which were subject to IPR.

29. The USPTO issued “Final Written Decisions” in May 2014 for each of the IPRs mentioned in paragraph 26. Corning filed a motion for rehearing of the decisions in the IPRs relating to the ’103 Patent and ’508 Patent, but this motion was denied on August 12, 2014. On July 8, 2014, Corning filed a notice of appeal of the decision in the IPR for the ’666 Patent to the United States Court of Appeals for the Federal Circuit.

30. With the recent issuance of Final Written Decisions for the IPRs, the upcoming expiration of the supply agreement, and Corning’s intention of using its own proprietary coatings, such as its “Kuna” coating, instead of optical coatings supplied by DSM Desotech, there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

31. Further, DSM has threatened and continues to threaten litigation against Corning and/or alternate coating suppliers if they make or use optical fiber coatings other than those supplied by DSM Desotech.

32. For example, on March 22, 2013, DSM Desotech’s Rob Crowell (head of sales) and Corning’s Barry Linchuck (VP and Director of Worldwide Marketing and Product Line Operations) participated in a videoconference. During this videoconference, Mr. Crowell touted DSM’s intellectual property rights and made statements to the following effect: “Even if Corning knocks out some claims, DSM will still have enough IP to protect themselves.”

33. On April 16, 2013, Mr. Crowell and Mr. Linchuck participated in another teleconference. During this teleconference, Mr. Crowell asserted that Corning should accept a proposal and withdraw from the IPR process in order to lock in “security of supply,” implying

that DSM would assert its IP in the absence of a deal. Mr. Crowell further asserted that “even if Corning wins a few claims, it will NOT be 100% and DSM does not need to win all the claims. We will win enough such that (without a deal) it becomes a litigious drawn out thing in 2014 and possibly 2013....possibly on the scale up.”

34. On April 29, 2013, Mr. Crowell and Mr. Linchuck participated in an in-person conversation. During this conversation, Mr. Crowell asserted that DSM is likely to file suit for anticipatory breach and injunction to prohibit Corning from using coatings in (alleged) violation of DSM IP. Further, Mr. Crowell stated that anything short of continued supply would result in a significant legal battle that would be to the detriment of all involved. Further, Mr. Crowell questioned “how we [Corning’s representatives] could be putting Corning in such a high risk position” given the likelihood of DSM being successful in litigation.

35. On May 21, 2013, Mr. Crowell and Mr. Linchuck participated in a teleconference. During this teleconference, Mr. Crowell asserted that “the further the process goes (without a resolution), the more contentious it will get,” implying that litigation is likely.

36. Shortly thereafter, DSM escalated its allegations of infringement. Around July 22, 2013, Corning received a letter purporting to be from DuGuan Hou of DSM Functional Materials. On information and belief, DSM Functional Materials does business as DSM Desotech, Inc. In this letter, Mr. Hou asserted that DSM owns I.P. rights and has the ability to test any supercoating “against the claims of its global patent portfolio for UV-curable coatings for optical fiber.” Mr. Hou further asserted that DSM “wants to ensure all optical fiber manufacturers can access superior-quality UV-curable coatings for optical fiber that do not infringe on DSM’s intellectual property.” On information and belief, the purpose of this letter



was to coerce Corning to continue purchasing its coatings from DSM by threatening litigation. A copy of this letter is attached hereto as Exhibit G.

37. DSM Desotech has made additional express and implied threats of enforcing its intellectual property rights, in addition to those specifically enumerated above, including threats in the months immediately preceding the filing of this complaint. For example, as recently as August 7, 2014, Corning's Stephen Miller received an e-mail purporting to be from Mr. Crowell. In this e-mail, Mr. Crowell asserted that: "As a starting point, I have asked our legal staff to select a list of patents which, together with the requested support information below, can give a good representation and insight of potential intellectual property issues Corning may face based upon the intended direction of Corning described in our past discussions."

38. Therefore, an actual controversy exists between Corning and DSM with respect to whether Corning's past and planned activities infringe any valid claims of the DSM patents. DSM continues to threaten Corning regarding its making, purchasing, using, offering to sell, and selling of optical fiber coatings, which directly impacts Corning's business activities. Corning will suffer concrete and imminent harm through DSM's threats, and a favorable decision invalidating the DSM patents, or holding that Corning does not infringe any valid and enforceable claims of the DSM patents, will stop the imminent harm.

### **FIRST CLAIM FOR RELIEF**

#### **(Declaratory Judgment of Non-Infringement of the DSM Patents)**

39. Corning restates and incorporates by reference the allegations in paragraphs 1–38.

40. This is an action for declaratory judgment of non-infringement of any valid and enforceable claims of the DSM patents.

41. Defendants have alleged and continue to allege that any Corning or third party coatings (e.g., Corning's "Kuna" coating) will infringe the DSM patents.

42. Corning asserts that its optical fiber coatings are not covered by the DSM patents, and that Corning does not infringe and has not infringed any valid and enforceable claim of the DSM patents by making, using, offering to sell, or selling its optical fiber coatings. Corning further asserts that its suppliers, customers, licensees, affiliates, and privies have not infringed and do not infringe any valid and enforceable claim of the DSM patents through supplying or using their optical fiber coatings.

43. Therefore, there exists a substantial controversy between Corning and Defendants, parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment that Corning and its suppliers, customers, licensees, affiliates, and privies have not infringed and do not infringe any valid and enforceable claim of the DSM patents.

44. A judicial declaration is necessary and appropriate so that Corning may ascertain its rights regarding the DSM patents.

## **SECOND CLAIM FOR RELIEF**

### **(Declaratory Judgment of Invalidity of the DSM Patents)**

45. Corning restates and incorporates by reference the allegations in paragraphs 1–38.

46. This is an action for declaratory judgment of invalidity of any and all asserted claims of the DSM patents.

47. On information and belief, Defendants have alleged and continue to allege that Corning's optical fiber coatings are or will be covered by the DSM patents.

48. The asserted claims of the DSM patents are invalid because they fail to comply with the conditions and requirement for patentability set forth in 35 U.S.C. § 1 *et seq.*, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

49. For example, with respect to DSM's '103 and '508 patents, the "cure dose" claim limitation is not supported by the written description, not enabled, and/or indefinite under 35 U.S.C. § 112. As another example, on information and belief, claims of the '103 and '508 patents are invalid under 35 U.S.C. § 102(b) and/or § 103 by virtue of DSM Desotech's prior public use and/or sales of its optical fiber coatings.

50. As a further example, with respect to the '666 and '189 patents, the "sufficient adhesion," "moisture," "fiber pull-out friction" and "ratio of the change in length" claim limitations are not supported by the written description, not enabled, and/or indefinite under 35 U.S.C. § 112. In addition, on information and belief, claims of these patents are invalid under 35 U.S.C. § 102(b) and/or § 103 by virtue of DSM Desotech's prior public use and/or sales of its optical fiber coatings.

51. As a further example, with respect to the '306 and '543 patents, the "percentage reacted acrylate unsaturation" claim limitation is not supported by the written description, not enabled, and/or indefinite under 35 U.S.C. § 112. In addition, on information and belief, claims of these patents are invalid under 35 U.S.C. § 102(b) and/or § 103 by virtue of DSM Desotech's prior public use and/or sales of its optical fiber coatings.

52. As a further example, with respect to the '564, '659 and '055 patents, claims of these patents are invalid under 35 U.S.C. § 102 and/or § 103 by virtue of at least U.S. Patent No. 6,316,516 and DSM Desotech's prior public use and/or sales of its optical fiber coatings.

53. Therefore, there exists a substantial controversy between Corning and Defendants, parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment that each asserted claim of the DSM patents is invalid.

54. A judicial declaration is necessary and appropriate so that Corning may ascertain its rights regarding the DSM patents.

#### **PRAYER FOR RELIEF**

WHEREFORE, Corning prays for judgment against Defendants as follows:

1. A declaration that Corning does not infringe any valid and enforceable claim of the DSM patents;
2. A declaration that Corning's suppliers, customers, licensees, affiliates, and privies do not infringe any valid and enforceable claim of the DSM patents by virtue of using or supplying any of Corning's optical fiber coatings, including its "Kuna" coating;
3. A declaration that the DSM patents are invalid;
4. The Court issue an injunction against Defendants and anyone acting in privity or concert with Defendants from charging infringement or instituting any legal action for infringement of the DSM patents against Corning, anyone acting in privity with Corning, or the divisions, successors, assigns, agents, suppliers, manufacturers, contractors and customers of Corning, based on their manufacture or use of any Corning optical fiber coating;
5. That this case is "exceptional" pursuant to 35 U.S.C. § 285, entitling Corning to an award of its reasonable attorneys' fees;
6. For such other relief as this Court deems just, reasonable and proper.

#### **DEMAND FOR A JURY TRIAL**

Corning hereby demands a trial by jury in this action.

Dated: February 9, 2015

FISH & RICHARDSON P.C.

By: /s/ Warren K. Mabey, Jr.

Susan M. Coletti (No. 4690)

Warren K. Mabey, Jr. (No. 5775)

222 Delaware Avenue, 17th Floor

P.O. Box 1114

Wilmington, DE 19899

Tel.: (302) 652-5070

coletti@fr.com

mabey@fr.com

Frank E. Scherkenbach

Chet D. Campbell

One Marina Park Drive

Boston, MA 02210-1878

Tel.: (617) 542-5070

scherkenbach@fr.com

chet@fr.com

Edmond R. Bannon

601 Lexington Ave., 52nd Floor

New York, NY 10022-4611

Tel.: (212) 765-5070

bannon@fr.com

Carl Bruce

1717 Main Street

Suite 5000

Dallas, TX 75201

Tel.: (214) 747-5070

bruce@fr.com

**ATTORNEYS FOR PLAINTIFF  
CORNING INCORPORATED**