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9 **UNITED STATES DISTRICT COURT**
10 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
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12 BIOTIUM, INC.,) Case No.
13)
14 Plaintiff,) **COMPLAINT FOR PATENT**
15 vs.) **INFRINGEMENT, COMMON LAW**
16) **TRADEMARK INFRINGEMENT,**
GENECOPOEIA, INC.) **UNFAIR COMPETITION AND FALSE**
17) **DESIGNATION OF ORIGIN**
18 Defendant.) **DEMAND FOR JURY TRIAL**
19)

20 Plaintiff Biotium, Inc. (“Biotium”) hereby brings this action against Defendant
21 Genecopoeia, Inc. (“Genecopoeia”) for infringement of United States Patent Nos. 8,092,784 and
22 8,586,325, for common law trademark infringement and unfair competition, and for false
23 designation of origin, and alleges as follows:

24 **JURISDICTION AND VENUE**

25 1. This action arises under the patent laws of the United States of America, 35 U.S.C.
26 § 1 et. seq. and jurisdiction is properly based on Title 35 United States Code, particularly §§ 271
27 and 281, and Title 28 United States Code, particularly § 1338(a). This Court also has jurisdiction
28 of this action pursuant to 15 U.S.C. § 1121, 15 U.S.C. § 1125, 28 U.S.C. §§ 1331, 1338(a) and

1 1338(b), in that this case arises under the Trademark Laws of the United States, 15 U.S.C. §1051
2 et seq.

3 2. This court has personal jurisdiction over Genecopoeia because Genecopoeia has
4 committed acts of patent infringement and trademark infringement in this District and, upon
5 information and belief, has and continues to transact business in this District.

6 3. Venue is proper in this District under 28 U.S.C. §1391 (b) and (c) because a
7 substantial part of the events giving rise to the claims arose in this District. Since this is a patent
8 infringement action, the matter is subject to direct-wide assignment under *Civil L.R. 3-2(c)*.

9 **THE PARTIES**

10 4. Biotium is a California corporation with its principal place of business located at
11 46117 Landing Parkway, Fremont, CA 94538.

12 5. Biotium is informed and believes, and based thereon alleges, that Genecopoeia is a
13 domestic corporation organized under the laws of Maryland with a principal place of business at
14 9620 Medical Center Drive, Rockville, MD 20850, and is directly responsible and liable for the
15 injuries and damages to Biotium hereinafter alleged.

16 **BACKGROUND**

17 6. Biotium is a biotechnology company that strives for innovation in biochemicals
18 and fluorescent reagents. Biotium devotes a significant amount of resources to research,
19 development, advertizing, promotion and intellectual property protection for its products.
20 Biotium's products are sold world-wide through the company's international distributors,
21 including VWR USA and VWR Europe. Biotium frequently collaborates with academic scientists
22 around the world to develop new tools for the ever-changing needs in research, allowing Biotium
23 to extend its reach to more customers and expand applications of Biotium's cutting-edge
24 technologies in life science research, medical diagnostics and pharmaceutical science.

25 7. Biotium's research and development efforts have resulted in a growing number of
26 granted and pending patents, including United States Patent Nos. 8,092,784 and 8,586,325.

27 8. Biotium's efforts have also resulted in a development and commercialization of a
28 growing number of industry-leading technologies, including, among many others, NucView™

1 Caspase 3/7 Enzyme Substrate to detect caspase activity in live cells by releasing a cell nucleus-
2 staining dye upon substrate cleavage; Live-or-Dye™ Fixable Viability Staining Kits, which are
3 designed for discrimination between live and dead cells when analyzing cell surface protein
4 expression by flow cytometry; MitoView™ Blue, MitoView™ Green, and MitoView™ 633
5 fluorescent mitochondrial dyes; and LysoView™ 540 and LysoView™ 633 fluorescent dyes with
6 pH-dependent fluorescence for staining acidic organelles in live cells.

7 9. Since at least as early as August 2011, Biotium has continuously used the highly
8 distinctive trademark NucView™ to advertise, promote, and sell its caspase enzyme substrates in
9 the United States and the world.

10 10. Since at least as early as September 2011, Biotium has continuously used the
11 highly distinctive trademark MitoView™ to advertise, promote, and sell its fluorescent
12 mitochondrial dyes in the United States and the world.

13 11. Since at least as early as August 2014, Biotium has continuously used the highly
14 distinctive trademark LysoView™ to advertise, promote, and sell its fluorescent dyes with pH-
15 dependent fluorescence in the United States and the world.

16 12. Since at least as early as October 2014, Biotium has continuously used the highly
17 distinctive trademark Live-or-Dye™, to advertise, promote and sell its fixable viability staining
18 kits in the United States and the world.

19 13. Biotium has devoted substantial time, effort, and resources to the development and
20 promotion of the NucView™, the MitoView™, the LysoView™, and the Live-or-Dye™
21 trademarks and the products offered thereunder. The development of NucView alone was the
22 result of an effort led by three senior Ph.D. scientists and a technician working full-time for over
23 two years, and is estimated to have cost at least \$1 million, including labor and materials. A
24 comparable effort was expended for the Live-or-Dye products. As a result of Biotium's efforts,
25 the public has come to recognize and rely upon the NucView™, the MitoView™, the
26 LysoView™, and the Live-or-Dye™ trademarks as an indication of the high quality associated
27 with Biotium's biochemical and fluorescent reagents products.
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1 14. As a result of use, sales, advertising, and promotion by Biotium, the NucView™,
2 the MitoView™, the LysoView™, and the Live-or-Dye™ trademarks have become well and
3 favorably known throughout the biotechnology industry. NucView, MitoView, LysoView and
4 Live-or-Dye products have been used extensively by other researchers, as evidenced by over 100
5 scientific publications which reference these products. Further, the Biotium products have been
6 licensed by significant industry partners, including ThermoFisher, Essen Biosciences, and
7 Nexcelom.

8 15. Long prior to any complained of acts of the Genecopoeia, and by virtue of the
9 foregoing use, promotion, and recognition of the NucView™, the MitoView™, the LysoView™,
10 and the Live-or-Dye™ trademarks, the marks has acquired valuable commercial magnetism and
11 distinctiveness for Biotium itself and the products provided under these marks.

12 16. Genecopoeia is a biomedical company that describes itself as a “functional
13 genomics company founded in 1999, [that] develops cutting edge products and services for
14 genomics, proteomics, and molecular and cellular biology. With emphasis on innovative R&D
15 and superior product quality, Genecopoeia serves the needs of biomedical scientists in academic
16 research, and R&D of pharmaceutical and diagnostic products in their pursuit of discoveries and
17 innovation.”

18 17. Biotium is informed and believes, and based thereon alleges, that after Biotium’s
19 adoption and use of the NucView™, the MitoView™, the LysoView™, and the Live-or-Dye™
20 trademarks and subsequent to the acquisition of goodwill, commercial magnetism, and
21 distinctiveness, Genecopoeia commenced the use of NucView, Mitoview, Lysoview, and Live-or-
22 Die trademarks in connection with its biotechnology products. Upon information and belief,
23 Genecopoeia spells the Live-or-Dye™ as “Live-or-Die.”

24 18. Biotium is informed and believes, and based thereon alleges, that Genecopoeia
25 engaged in wrongful and infringing conduct by advertising and promoting its biotechnology
26 products under the NucView, Mitoview, Lysoview, and Live-or-Die trademarks in this District,
27 the State of California, throughout the United States, and on the Internet.

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1 19. Specifically, Genecopoeia is and has been advertising, promoting, offering for sale
2 and selling NucView Green Dead Nucleic Acid Stain; Live-or-Die Blue Fixable Dead Cell Stain
3 Kit; Live-or-Die Violet Fixable Dead Cell Stain Kit; Live-or-Die Green Fixable Dead Cell Stain
4 Kit; Live-or-Die Far-Red Fixable Dead Cell Stain Kit; Live-or-Die Cell Viability/Cytotoxicity Kit
5 for Animal Cells; Live-or-Die Cell Viability/Cytotoxicity Kit for Bacterial Cells; Live-or-Die
6 Cell Viability/Cytotoxicity Kit for Yeast; MitoView Orange; MitoView Red; MitoView Deep
7 Red; Lysoview Blue; and Lysoview Green products in this District, the State of California,
8 throughout the United States, and on the Internet.

9 20. Genecopoeia's use of product names and trademarks substantially identical to
10 and/or confusingly similar to Biotium's NucView™, MitoView™, LysoView™, and Live-or-
11 Dye™ trademarks is likely to and does permit Genecopoeia to misappropriate and unfairly trade
12 upon the valuable goodwill and reputation of Biotium and will subject the goodwill and
13 reputation in the NucView™, the MitoView™, the LysoView™, and the Live-or-Dye™
14 trademarks to the hazards and perils attendant upon Genecopoeia's business activities, activities
15 over which Biotium has no control.

16 21. Biotium is informed and believes, and based thereon alleges that Genecopoeia's
17 acts are likely to cause, have caused, and are now causing widespread confusion, mistake, and
18 deception in the public mind that the above-described products offered by the Genecopoeia are
19 offered by Biotium. Further, Genecopoeia's acts are likely to cause confusion (and have actually
20 caused confusion), deceive, and mislead the consuming public as to the source, origin, or
21 sponsorship of the biotechnology products offered by Genecopoeia.

22 22. Biotium is informed and believes, and based thereon alleges, that the tortuous acts
23 of Genecopoeia complained of herein were committed willfully and with full knowledge of
24 Biotium's rights, and with the intention of deceiving and misleading the public at large and that
25 Genecopoeia is wrongfully trading on the goodwill and reputation of Biotium.

26 23. Genecopoeia's acts as alleged above are without license or consent of Biotium.
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1 weakly fluorescent, in general, and relatively fluorescent, in a particular condition, such as when
2 bound to a partner molecule, partner molecules, or an assembly of partner molecules. An enzyme
3 substrate of the '325 patent may thus be useful in fluorescence detection, and/or in any of a
4 variety of useful applications, such as the detection of enzymatic activity in a cell-free system or
5 in a living cell, the screening of drugs, or the diagnosis of disease.

6 38. Genecopoeia, on information and belief, manufactures, uses, offers to sell and sells
7 products that infringe the '325 patent, including but not limited to its LIVE Caspase-3/7 Green
8 Detection Reagent and LIVE Caspase-3/7 Green Apoptosis Assay Kit.

9 39. By providing such products, Genecopoeia has in the past and continues to infringe
10 directly, by inducement, or by contributing to the infringement of at least claims 1-16 of the '325
11 patent.

12 40. Genecopoeia's infringement of the '325 patent alleged above has injured Biotium
13 and, thus, Biotium is entitled to recover damages adequate to compensate for Genecopoeia's
14 infringement, which in no event can be less than a reasonable royalty.

15 41. Upon information and belief, Genecopoeia has deliberately and willfully infringed
16 the '325 patent, making this an exceptional case and justifying the assessment of treble damages
17 pursuant to 35 U.S.C. § 284 and the award of attorneys fees pursuant to 35 U.S.C. § 285.

18 42. As a consequence of the Genecopoeia's infringement, Biotium has been
19 irreparably damaged and such damage will continue without the issuance of an injunction by this
20 Court.

21 **THIRD CAUSE OF ACTION**

22 **(Common Law Trademark Infringement and Unfair Competition**

23 **Under 15 U.S.C. §1125(a))**

24 43. Biotium re-alleges and incorporates by reference each and every allegation
25 contained in paragraphs 1 through 42 as though fully set forth herein.

26 44. As a result of the association by the public of Biotium's NucView™, MitoView™,
27 LysoView™, and Live-or-Dye™ trademarks with Biotium and its products, the use by
28 Genecopoeia of NucView, Live-or-Die, MitoView and Lysoview as trademarks in connection

1 with Genecopoeia's operations, advertising, and virtually identical products, is likely to cause
2 confusion, deceive, and mislead the relevant consuming public as to the origin or sponsorship of
3 Genecopoeia's biotechnology products, all to the profit of Genecopoeia and to Biotium's
4 detriment.

5 45. Genecopoeia's conduct constitutes infringement of Biotium's common law rights
6 in and to Biotium's NucView™, MitoView™, LysoView™, and Live-or-Dye™ trademarks and
7 further constitutes common law unfair competition.

8 46. As a direct and proximate result of Genecopoeia's conduct, Biotium has suffered
9 irreparable harm and is entitled to injunctive relief. In addition, Biotium is entitled to money
10 damages, the amount of which will be established at trial.

11 **FOURTH CAUSE OF ACTION**

12 **(False Designation of Origin Under 15 U.S.C. §1125(a))**

13 47. Biotium re-alleges and incorporates by reference each and every allegation
14 contained in paragraphs 1-46 as though fully set forth herein.

15 48. Genecopoeia's use of the NucView, Live-or-Die, MitoView and Lysoview
16 trademarks is a false designation of origin as to the products made or to be made available by
17 Genecopoeia in interstate commerce. By virtue of Genecopoeia's use of NucView, Live-or-Die,
18 MitoView and Lysoview trademarks, consumers who use or learn of the Genecopoeia products
19 will mistakenly believe that the products associated with Genecopoeia originate with, are
20 sponsored by, or are affiliated with Biotium.

21 49. Genecopoeia's use of product names identical to and/or confusingly similar to
22 Biotium, the continuation of such uses, and all other acts of Genecopoeia, particularly the
23 unauthorized use of the NucView, Live-or-Die, MitoView and Lysoview trademarks as alleged,
24 create the likelihood that the public will be confused as to the true source, sponsorship, or
25 affiliation of the products of Genecopoeia.

26 50. Biotium has suffered, is suffered, and will continue to suffer irreparable injury for
27 which it has no adequate remedy at law.

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1 officers, agents, servants, employees, and attorneys, and all those
2 in active concert or participation with them, from further infringing the '325
3 patent;

4 12. That Genecopoeia, its officers, agents, servants, affiliates, employees, attorneys,
5 and representatives, and all those in privity or acting in concert with Genecopoeia, be
6 preliminarily and permanently enjoined and restrained from directly or indirectly:

7 a. Using as a service mark, trademark, trade name, or domain name, for its
8 entire range of business and services, NucView, MitoView, LysoView, and Live-or-Dye or their
9 phonetic or visual equivalents, alone or in connection with any other trademarks confusingly
10 similar to those of Biotium;

11 b. Performing any actions or using any words, names, styles, titles, or marks
12 that are likely to cause confusion, to cause mistake, or to deceive; or to otherwise mislead the
13 industry or public into believing that Biotium and Genecopoeia are one and the same or
14 connected in any way;

15 c. Using any words, names, styles, titles, or marks that create a likelihood of
16 injury to the business reputation of Biotium or its affiliates, or a likelihood of misappropriation
17 and dilution of Biotium's trademarks and the goodwill associated therewith;

18 d. Using any trade practices whatsoever, including those complained of
19 herein that tend to unfairly compete with or injure Biotium, its business and the goodwill
20 pertaining thereto; and

21 e. Registering as a service mark or trademark any name or mark using the
22 words NucView, MitoView, LysoView, and Live-or-Dye or their phonetic or visual equivalents,
23 alone or in combination with other words, names, styles, titles, or marks for any services or goods
24 relating to the provision of biotechnology products.

25 13. That Genecopoeia be required to pay Biotium compensatory damages for the
26 injuries sustained by Biotium in consequence of trademark infringement activities and unfair
27 business practices complained of herein according to proof, and that such damages be trebled
28 because of the willful acts described herein in disregard of Biotium's known rights in Biotium's

1 NucView™, MitoView™, LysoView™, and Live-or-Dye™ trademarks as provided by 15
2 U.S.C. § 1117;

3 14. That Genecopoeia be required to delete the terms NucView, MitoView,
4 LysoView, and Live-or-Dye or their phonetic or visual equivalents from all printed and digital
5 materials;

6 15. That Genecopoeia be required to account to Biotium for any and all gains, profits,
7 and advantages derived from its trademark infringement activities complained of herein;

8 16. That Genecopoeia be required to pay punitive or exemplary damages for its
9 trademark infringement activities and unfair business practices complained of herein to Biotium
10 in an amount to be presented by Biotium at trial;

11 17. That Genecopoeia be directed to file with the Court and serve on Biotium within
12 thirty (30) days after entry of a permanent injunction, a report in writing under oath setting forth
13 in detail the manner and form in which Genecopoeia has complied with the injunction;

14 18. That Genecopoeia be required to pay to Biotium all of its litigation expenses,
15 including reasonable attorneys' fees and costs of this action; and

16 19. That Biotium be granted such other and further relief as the Court may deem just
17 and proper.

18 Dated: March 17, 2017

DERGOSITS & NOAH LLP

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20 By: /s/ Igor Shoiket
Igor Shoiket

21 Attorneys for Plaintiff Biotium, Inc.
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DEMAND FOR TRIAL BY JURY

Biotium hereby demands a jury trial as provided by Rule 38(a) of the Federal Rules of Civil Procedure.

Dated: March 17, 2017

DERGOSITS & NOAH LLP

By: /s/ Igor Shoiket
Igor Shoiket
Attorneys for Plaintiff Biotium, Inc.