| 1 | EDWARD R. REINES (Bar No. 135960) | | |
|----|---|----------------------------------|--|
| 2 | edward.reines@weil.com DEREK C. WALTER (Bar No. 246322) | | |
| 2 | derek.walter@weil.com | | |
| 3 | TIMOTHY C. SAULSBURY (Bar No. 281434) | | |
| 4 | timothy.saulsbury@weil.com | | |
| 4 | WEIL, GOTSHAL & MANGES LLP Silicon Valley Office | | |
| 5 | 201 Redwood Shores Parkway | | |
| | Redwood Shores, CA 94065 | | |
| 6 | Telephone: (650) 802-3000 | | |
| 7 | Facsimile: (650) 802-3100 | | |
| , | BRADFORD PAUL SCHMIDT (Bar No. 17444) |)) | |
| 8 | bradford.schmidt@lifetech.com | | |
| 0 | ADAM M. TSCHOP (Bar No. 209767) | | |
| 9 | adam.tschop@lifetech.com LIFE TECHNOLOGIES CORPORATION | | |
| 10 | 5791 Van Allen Way | | |
| | Carlsbad, CA 92008 | | |
| 11 | Telephone: (760) 603-7200 | | |
| 12 | Facsimile: (760) 476-6048 | | |
| 12 | Attorneys for Plaintiffs | | |
| 13 | LIFE TECHNOLOGIES CORPORATION and | | |
| | APPLIED BIOSYSTEMS, LLC | | |
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| 15 | UNITED STATES DISTRICT COURT | | |
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| 18 | LIFE TECHNOLOGIES CORPORATION and | Case No. <u>'12CV2992 WQHMDD</u> | |
| 19 | APPLIED BIOSYSTEMS, LLC, | | |
| 17 | Plaintiff, | | |
| 20 | | COMPLAINT FOR DECLARATORY | |
| 21 | v. | JUDGMENT | |
| 21 | PROMEGA CORPORATION, | | |
| 22 | TROMEGA CORTORN, | JURY TRIAL DEMANDED | |
| | Defendant. | | |
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COMPLAINT
DEMAND FOR JURY TRIAL

Case No.

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Plaintiffs Life Technologies Corporation ("Life Tech") and Applied Biosystems, LLC ("ABLLC") (collectively "Plaintiffs") for their complaint against Defendant Promega Corporation ("Promega") alleges as follows:

NATURE OF THIS ACTION

- 1. This action arises under 28 U.S.C. §§ 1331, 2201 and 2202, and the United States Patent Act, 35 U.S.C. § 100 et seq.
- 2. Plaintiffs bring this action for a declaration that no activities relating to their AuthentiFiler™ line of products do or will directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe U.S. Patent Nos. 5,843,660 (the "660 patent"), 6,221,598 ("the '598 patent"), 6,479,235 ("the '235 patent"), and 7,008,771 (the "'771 Patent) (collectively, the "Patents-in-Suit").

PARTIES

- 3. Plaintiff 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.
- 4. Plaintiff ABLLC 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. ABLLC is a wholly-owned subsidiary of Life Tech.
- 5. On information and belief, Defendant Promega is a Wisconsin corporation with a principal place of business located at 2800 Woods Hollow Road, Madison, WI 53711.
- 6. On information and belief, Defendant has, and has had, continuous and systematic contacts with the State of California, including this District. On information and belief, Defendant has also purposefully directed a broad range of business activities at this District, including among other things research, sales, support services, processing, and related services. On information and belief, residents of this District have used products sold by or from Defendant.

JURISDICTION

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7. This action arises under the Patent Laws of the United States of America, 35 U.S.C. § 1 *et seq*. This Court also has subject matter jurisdiction according to the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, because an immediate and substantial controversy exists between Life Tech, ABLLC and Promega with respect to whether any activities relating to Life Tech and ABLLC's AuthentifilerTM line of products directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe the Patents-in-Suit. 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.

VENUE

8. Venue is proper in this District under 28 U.S.C. §§ 1391(b) and (c) because a substantial part of the events giving rise to Life Tech and ABLLC's claims occurred in this District and because Defendant is subject to personal jurisdiction in this District.

FACTUAL BACKGROUND

- 9. Life Tech and ABLLC develop and manufacture single tandem repeat ("STR") based products for use in forensic DNA analysis and paternity testing. These products utilize polymerase chain reaction ("PCR") technology to identify the number of STRs located at a variety of positions (called "loci") in the genome. In general, the number of STRs at each loci differs from one person or organism to the next such that by looking at a number of loci and determining how many STRs are present at each, a unique DNA "fingerprint" for that person or organism can be generated. As an example, the STR fingerprint allows the determination of whether a suspect's DNA "matches" DNA found at a crime scene.
- 10. Life Tech and ABLCC have sold and continue to sell these PCR analysis products under the umbrella tradename AmpF\ellSTR\enline{\mathbb{R}}. Products sold under this tradename include the AmpF\ellSTR\enline{\mathbb{R}} COfiler\enline{\mathbb{R}} PCR Amplification Kit, the AmpF\ellSTR\enline{\mathbb{R}} Profiler\enline{\mathbb{R}} PCR Amplification Kit, the AmpF\ellSTR\enline{\mathbb{R}} PCR Amplification Kit, and the AmpF\ellSTR\enline{\mathbb{R}} Identifiler\enline{\mathbb{R}} PCR Amplification Kit.

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These products are and have been used extensively in forensics and paternity testing for many years.

- 11. More recently, Life Tech and ABLCC have developed a new line of STR based products for cell line authentication/identification, which they began selling in December 2012 under the tradename AuthentfilerTM. Briefly, in biotech research, the misidentification of and contamination of cell lines presents a serious problem. Research organizations, governmental entities, and scientific journals thus frequently require that the pedigree of cell lines be verified. Like human beings and other organisms, cell lines also have a unique DNA fingerprints associated with them based on the number of STRs located at various loci in their genomes. Life Tech and ABLLC have developed various products for performing cell line authentication/identification based on multiplex PCR analysis using primers specific for STRs in the cell line genomic DNA.
- 12. The AuthentifilerTM products operate according to the same general principals as the AmpF\ellSTR® products, and thus include the same general classes of components. However, the AuthentifilerTM products utilize a different set of STR loci than those used in the AmpFℓSTR® products. The genetic loci used in the Authentifiler™ products also do not overlap with those required by the claims of the Patents-in-Suit. Thus, Life Tech and ABLLC's new Authentifiler™ products do not directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe the Patents-in-Suit.
- 13. Life Tech and ABLLC have made a substantial investment to prepare for the commercial launch of the AuthentifilerTM products. Specifically, Life Tech and ABLCC have invested resources in research and development efforts dedicated to the formulation and optimization of assays and the verification of assay performance, trained sales and marketing employees, and have developed specific marketing and sales materials directed to their AuthentifilerTM products. These are among the many concrete and substantial steps that Life Tech and ABLCC have undertaken to prepare for commercial use and marketing of the Authentifiler™ products.

- In May 2010, Promega initiated litigation against Life Tech, ABLLC and another Life Tech wholly-owned subsidiary, Invitrogen IP Holdings, Inc., in the Western District of Wisconsin, alleging that certain of Life Tech and ABLLC's AmpF\ellSTR® products infringed one or more of the Patents-in-Suit. Promega pursued this litigation aggressively through summary judgment proceedings and a jury trial. At trial, Promega sought \$104 million in damages. Following the jury trial, the jury awarded \$52 million in damages.

 15. Although the \$52 million jury award did not survive post-trial briefing.
- Promega's very recent efforts to enforce the Patents-in-Suit against Life Tech and ABLLC, and the magnitude of damages it sought in connection with those efforts, demonstrate that there is a substantial and immediate controversy as to whether Life Tech and ABLLC's newly released AuthentifilerTM products directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe the Patents-in-Suit. Indeed, Life Tech and ABLLC are presently in the position of having to choose between either abandoning their new AuthentifilerTM products, or running the risk of being sued by Promega for infringement, despite believing that the Patents-in-Suit are not infringed, either directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement).
- wide scope, and that it will attempt to enforce these patents in the broadest possible manner. For instance, during the jury trial in the prior litigation, high ranking Promega officers testified that Promega was, in fact, seeking a "monopoly" in the general technical area of determining the individual from which a cell line came based on the use of STR products, among other technical areas. Specifically, Randall Dimond, Promega's Vice President-Chief Technology Officer, testified as follows:
 - Q. And Promega wants a monopoly on selling kits to scientists who are want to make sure that the cell lines they are looking at are can trace back to the appropriate individual that they came from
 - A. Correct.
 - **Q.** And same for the other uses on Mr. Troupis's chart?
 - **A.** That is correct.

- 17. Mr. Dimond further testified that when considered collectively, Promega's patents "cover all STR loci." Simply put, Promega has made clear that it believes it is impossible for the makers of STR products for cell line authentication/identification (such as Life Tech and ABLLC) to avoid infringement of its patents.

 18. Given the foregoing, it is abundantly clear that Life Tech, ABLLC and
- 18. Given the foregoing, it is abundantly clear that Life Tech, ABLLC and their new AuthentifilerTM products are targets for enforcement of the Patents-in-Suit, creating a substantial and actual controversy between Life Tech, ABLLC and Promega with respect to the AuthentifilerTM products of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.
- 19. Life Tech and ABLLC therefore asks the Court to declare that all activities (including without limitation the use, manufacture, sale, offer for sale, importation and/or exportation) relating to the AuthentifilerTM products do not and will not directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe, any claim of the Patents-in-Suit under 35 U.S.C. § 271, or have done so in the past, which declaration is necessary and appropriate.

CLAIMS FOR RELIEF

COUNTI

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 5,843,660)

- 20. Plaintiffs re-allege and incorporate by reference the allegations contained in paragraphs 1 through 19 above.
- 21. Plaintiffs seek a judicial declaration that the Authentifiler™ products and all activities related thereto (including without limitation the use, manufacture, sale, offer for sale, importation and/or exportation) do not and will not directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe any claim of the '660 patent under 35 U.S.C. § 271, and have not done so in the past, which declaration is necessary and appropriate.

COUNT II

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,221,598)

- 22. Plaintiffs re-allege and incorporate by reference the allegations contained in paragraphs 1 through 19 above.
- 23. Plaintiffs seek a judicial declaration that the Authentifiler™ products and all activities related thereto (including without limitation the use, manufacture, sale, offer for sale, importation and/or exportation) do not and will not directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe any claim of the '598 patent under 35 U.S.C. § 271, and have not done so in the past, which declaration is necessary and appropriate.

COUNT III

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,479,235)

- 24. Plaintiffs re-allege and incorporate by reference the allegations contained in paragraphs 1 through 19 above.
- 25. Plaintiffs seek a judicial declaration that the Authentifiler™ products and all activities related thereto (including without limitation the use, manufacture, sale, offer for sale, importation and/or exportation) do not and will not directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe any claim of the '235 patent under 35 U.S.C. § 271, and have not done so in the past, which declaration is necessary and appropriate.

COUNT IV

(Declaratory Judgment of Non-Infringement U.S. Patent No. 7,008,771)

- 26. Plaintiffs re-allege and incorporate by reference the allegations contained in paragraphs 1 through 19 above.
- 27. Plaintiffs seek a judicial declaration that the Authentifiler™ products and all activities related thereto (including without limitation the use, manufacture, sale, offer for sale, importation and/or exportation) do not and will not directly (whether literally or under the doctrine of equivalents) or indirectly (including without limitation contributory infringement or inducement of infringement) infringe any claim of the '771 patent under 35 U.S.C. § 271, and have not done so in the past, which declaration is necessary and appropriate.

1 PRAYER FOR RELIEF 2 WHEREFORE, Plaintiffs pray for relief as follows: 3 A. Judgment in Plaintiffs' favor on all claims for relief; 4 B. A declaration in favor of Life Tech and ABLLC that all activities 5 (including without limitation the use, manufacture, sale, offer for sale, importation and/or 6 exportation) relating to the AuthentifilerTM products do not and will not directly (whether literally 7 or under the doctrine of equivalents) or indirectly (whether by contributory infringement or 8 inducement of infringement) infringe any claim of the Patents-in-Suit under 35 U.S.C. § 271, and 9 have not done so in the past; 10 **DEMAND FOR JURY TRIAL** 11 Pursuant to Federal Rule of Civil Procedure 38(b) and Civil Local Rule 38.1, Life 12 Tech hereby demands a trial by jury on all issues so triable. 13 Dated: December 17, 2012 Respectfully submitted, 14 15 WEIL, GOTSHAL & MANGES LLP Edward R. Reines 16 Derek C. Walter Timothy C. Saulsbury 17 18 By: 19 Edward R. Reines 20 Attorneys for Plaintiff LIFE TECHNOLOGIES 21 CORPORATION and APPLIED BIOSYSTEMS, LLC 22 23 24 25 26 27

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