

certain of its Alli ® and Nicoderm CQ ® branded products with the expired patents with the intent to deceive competitors and the public, and to gain a competitive advantage in the market.

3.

Plaintiff seeks an award of monetary damages against Defendant pursuant to 35 U.S.C. § 292 (b) of up to \$500 for each offense, with one-half going to the use of the United States and the other half going to the person bringing the action.

THE PARTIES

4.

Plaintiff is a person residing in Lakeland, Tennessee.

5.

Defendant GLAXOSMITHKLINE CONSUMER HEALTHCARE, LP, is a Delaware corporation with its principal place of business near Pittsburgh, Pennsylvania. Defendant's registered agent for service of process is Corporation Service Company, 2711 Centerville Road, Suite 400, Wilmington, DE 19808.

6.

Defendant GLAXOSMITHKLINE, LLC, is a Delaware corporation with its principal place of business in Philadelphia, Pennsylvania. Defendant's registered agent for service of process is Corporation Service Company, 2908 Poston Avenue, Nashville, TN 37203.

JURISDICTION AND VENUE

7.

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

8.

Venue is proper in this District under 28 U.S.C. §§ 1391(c) and 1395(a) because, at least in part, Defendant GlaxoSmithKline's products that are the subject-matter of this Complaint, were and are advertised, offered for sale, and sold within this District.

9.

This Court has personal jurisdiction over Defendant GlaxoSmithKline because Defendant has sold and continues to sell falsely marked products in Tennessee and in this District, and/or in the streams of commerce with knowledge that said products would be sold in Tennessee and in this District. Upon information and belief, such sales by Defendant are substantial, continuous, and systematic.

10.

Plaintiff brings this action under 35 U.S.C. § 292(b), which provides that any person may sue for civil money penalties for false patent marking.

GENERAL ALLEGATIONS

11.

Defendant GlaxoSmithKline has in the past manufactured and marketed (or caused to be manufactured and marketed), and presently manufactures and markets (or causes to be manufactured and marketed), products for sale to the general consuming public, including Alli ® and Nicoderm CQ ®.

12.

Specifically, Defendant GlaxoSmithKline has and continues to market the following products: Alli ®, a non-prescription weight loss capsule; and Nicoderm CQ ®, a non-prescription anti-smoking drug administered in the form of a therapeutic transdermal patch.

13.

Alli ®, including its packaging and/or labeling, has been and continues to be marked with United States patent number 4,598,089 (hereinafter referred to as the “ ‘089 Patent”).

14.

The ‘089 Patent has expired, but Defendant GlaxoSmithKline nevertheless continues using the improper patent markings on Alli ®, with the intent to deceive the public and to gain competitive advantage in the market.

15.

Nicoderm CQ ®, including its packaging and/or labeling, has been and continues to be marked with United States patent number 5,004,610 (hereinafter referred to as the “ ‘610 Patent”).

16.

The ‘610 Patent has expired, but Defendant GlaxoSmithKline nevertheless continues using the improper patent marking on Nicoderm CQ ®, with the intent to deceive the public and to gain competitive advantage in the market.

17.

When a patent expires, all monopoly rights to the patent terminate irrevocably. Therefore, a product marked with an expired patent is not currently patented by such expired patent. In other words, the product is unpatented.

18.

Marking products with expired patents is likely to, or at least has the potential to, discourage or deter persons and companies from commercializing competing products, which, in

turn, causes harm to the consuming public, including Plaintiff, by quelling product innovation and price competition.

19.

Defendant GlaxoSmithKline is a sophisticated company with many decades of experience applying for and obtaining patents, and therefore knows that patents do not have an indefinite duration but, rather, expire.

20.

Upon information and belief, Defendant GlaxoSmithKline employs an in-house legal department.

21.

Upon information and belief, attorneys in Defendant GlaxoSmithKline's in-house legal department are responsible for Defendant's intellectual property and marketing, labeling, and advertising law.

22.

Defendant GlaxoSmithKline by itself or by its representatives cannot genuinely believe that a patent does not expire, and that prospective patent rights apply even after its expiration.

23.

Defendant GlaxoSmithKline knew that both the '089 Patent marked on Alli ® as identified herein, had expired. Similarly, Defendant knew that '610 Patent, marked on Nicoderm CQ ® as identified herein, had expired.

24.

After the '089 Patent, Defendant GlaxoSmithKline marked, or caused to be marked, said expired patent number upon Alli ® and/or its packaging. Similarly, after the '610 Patent

expired, Defendant marked, or caused to be marked, said expired patent number upon Nicoderm CQ ® and/or its packaging.

25.

Defendant GlaxoSmithKline knew that the patents marked on the products identified herein were expired during time periods Defendant was marking products with such expired patents.

26.

Because all monopoly rights in the aforementioned expired patents have terminated, Defendant GlaxoSmithKline cannot have any reasonable belief that Alli ® and/or Nicoderm CQ ® are patented or otherwise covered by the expired patents marked upon the packaging of these products.

27.

By repeatedly marking Alli ® and Nicoderm CQ ® with expired patents, Defendant GlaxoSmithKline has committed numerous violations of 35 U.S.C. § 292(a).

28.

Defendant GlaxoSmithKline has committed such violations of 35 U.S.C. § 292(a) with an intent to deceive competitors and the public.

29.

Plaintiff seeks an award of monetary damages against Defendant GlaxoSmithKline, one half of which shall be paid to the United States pursuant to 35 U.S.C. § 292(b).

COUNT ONE: THE '089 PATENT (ALLI ®)

30.

Plaintiff restates and incorporates the foregoing paragraphs as if fully set forth herein.

31.

United States Patent Number 4,598,089 was filed on June 18, 1984, and issued on July 1, 1986. (Please see United States Patent No. 4,598,089, attached hereto as Exhibit 'A').

32.

The '089 Patent expired on June 18, 2009. (Please see "Certificate Extending Patent Term," attached hereto as Exhibit 'B').

33.

Defendant GlaxoSmithKline marketed for sale to the public the product known as Alli ®, marked with the '089 Patent.

34.

Defendant GlaxoSmithKline violated 35 U.S.C. § 292(a) by marking, or causing to be marked, the packaging, labeling, and/or product commonly known as Alli ® with the '089 Patent, and any and all other products marked with the '089 Patent, subsequent to the date the patent expired with the intent to deceive the public. (Please see "Photograph of Alli ® Package," attached hereto as Exhibit 'C').

35.

Upon information and belief, Defendant GlaxoSmithKline knew, on or about the date of expiration, that the '089 Patent had expired.

36.

Defendant GlaxoSmithKline cannot genuinely believe that the '089 Patent applies even after it expired.

37.

Upon information and belief, Defendant GlaxoSmithKline is a sophisticated company and has many decades of experience applying for, obtaining, and litigating patents. Defendant has committed a substantial amount of its resources to patent procurement and enforcement. Upon information and belief, Defendant has an in-house legal department and attorneys working therein are responsible for Defendant's intellectual property and marketing, labeling, and advertising law. As a sophisticated company, with in-house legal counsel that regularly handles patent matters, including but not limited to patent procurement and patent-related litigation, Defendant is aware of the requirements of 35 U.S.C. § 292.

38.

Defendant GlaxoSmithKline has falsely marked Alli ® as described with the intent to deceive the public, in violation of 35 U.S.C. § 292(a).

39.

Each false marking on the product(s) identified is likely to, or at least has the potential to, discourage or deter persons and companies from commercializing competing products.

40.

Defendant GlaxoSmithKline's false marking of products with the '089 Patent after it expired has wrongfully quelled competition with respect to such products, thereby causing harm to Plaintiff, the United States, and the general public.

41.

Defendant GlaxoSmithKline wrongfully and illegally advertised a patent monopoly which it did not possess and, as a result, has benefitted commercially and financially by maintaining false statements of patent rights.

WHEREFORE, Plaintiff demands a trial by jury and requests that the Court enter judgment as follows:

- (a) Enter judgment against Defendant and in favor of Plaintiff for the violations alleged in this Complaint;
- (b) Order Defendant to pay a civil monetary fine of up to five hundred dollars (\$500) per false marking “offense” (or falsely marked article), or an alternative amount as determined by the Court, one-half of which shall be paid to the United States;
- (c) Order Defendant to pay discretionary costs and prejudgment interest;
- (d) Award attorney’s fees to plaintiff pursuant to 35 USC § 285;
- (e) Order an accounting for any falsely marked products not presented at trial and an award by the Court of additional damages for any such falsely marked products; and
- (f) Grant Plaintiff such other and further relief, at law or in equity, to which Plaintiff is justly entitled.

COUNT TWO: THE ‘610 PATENT (NICODERM CQ ®)

42.

Plaintiff restates and incorporates the foregoing paragraphs as if fully set forth herein.

43.

United States Patent Number 5,004,610 was filed on June 14, 1990, and issued on April 2, 1991. (Please see United States Patent No. 5,004,610, attached hereto as Exhibit ‘D’).

44.

The ‘610 Patent expired on in June, 2008.

45.

Defendant GlaxoSmithKline marketed for sale to the public the product known as Nicoderm CQ ®, marked with the '610 Patent. (Please see "Photograph of Nicoderm CQ ® Package," attached hereto as Exhibit 'E').

46.

Defendant GlaxoSmithKline violated 35 U.S.C. § 292(a) by marking, or causing to be marked, the packaging, labeling, and/or product commonly known as Nicoderm CQ ® with the '610 Patent, and any and all other products marked with the '610 Patent, subsequent to the date the patent expired with the intent to deceive the public.

47.

Upon information and belief, Defendant GlaxoSmithKline knew, on or about the date of expiration, that the '610 Patent had expired.

48.

Defendant GlaxoSmithKline cannot genuinely believe that the '610 Patent applies even after it expired.

49.

Upon information and belief, Defendant GlaxoSmithKline is a sophisticated company and has many decades of experience applying for, obtaining, and litigating patents. Defendant has committed a substantial amount of its resources to patent procurement and enforcement. Upon information and belief, Defendant has an in-house legal department and attorneys working therein are responsible for Defendant's intellectual property and marketing, labeling, and advertising law. As a sophisticated company, with in-house legal counsel that regularly handles

patent matters, including but not limited to patent procurement and patent-related litigation, Defendant is aware of the requirements of 35 U.S.C. § 292.

50.

Defendant GlaxoSmithKline has falsely marked Nicoderm CQ ® as described with the intent to deceive the public, in violation of 35 U.S.C. § 292(a).

51.

Each false marking on the product(s) identified is likely to, or at least has the potential to, discourage or deter persons and companies from commercializing competing products.

52.

Defendant GlaxoSmithKline's false marking of products with the '610 Patent after it expired has wrongfully quelled competition with respect to such products, thereby causing harm to Plaintiff, the United States, and the general public.

53.

Defendant GlaxoSmithKline wrongfully and illegally advertised a patent monopoly which it did not possess and, as a result, has benefitted commercially and financially by maintaining false statements of patent rights.

WHEREFORE, Plaintiff demands a trial by jury and requests that the Court enter judgment as follows:

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- (c) Order Defendant to pay discretionary costs and prejudgment interest;
- (d) Award attorney's fees to plaintiff pursuant to 35 USC § 285;
- (e) Order an accounting for any falsely marked products not presented at trial and an award by the Court of additional damages for any such falsely marked products; and
- (f) Grant Plaintiff such other and further relief, at law or in equity, to which Plaintiff is justly entitled.

DEMAND FOR JURY TRIAL

Pursuant to Fed. R. Civ. P. 38(b), Plaintiff demands a trial by jury on all issues so triable.

Respectfully submitted this 13th day of April, 2010.

/s/ W. Daniel Miles, III
W. DANIEL "DEE" MILES, III *

/s/ Roman A. Shaul
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* Application for admission pending on behalf of W. Daniel "Dee" Miles and Archie I. Grubb, II.

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