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13 Corporation and the California Institute of  
14 Technology

15 LIFE TECHNOLOGIES CORPORATION  
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23 Corporation

24 UNITED STATES DISTRICT COURT  
25 CENTRAL DISTRICT OF CALIFORNIA  
26 WESTERN DIVISION

27 LIFE TECHNOLOGIES  
28 CORPORATION, a Delaware  
corporation and the CALIFORNIA  
INSTITUTE OF TECHNOLOGY, a  
California corporation,

Plaintiffs,

vs.

PROMEGA CORPORATION, a  
Wisconsin corporation,

Defendant.

FILED  
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CLERK U.S. DISTRICT COURT  
CENTRAL DIST. OF CALIF.  
LOS ANGELES  
BY \_\_\_\_\_  
CV 12 9879 - JAK (Ex)  
CASE NO.  
COMPLAINT FOR PATENT  
INFRINGEMENT  
JURY TRIAL DEMANDED

1 Plaintiffs Life Technologies Corporation and the California Institute of  
2 Technology file this complaint against Promega Corporation:

3 **The Parties**

4 1. Plaintiff Life Technologies Corporation (“Life”) is a Delaware  
5 corporation with a principal place of business at 5791 Van Allen Way, Carlsbad,  
6 California 92008.

7 2. Plaintiff the California Institute of Technology (“Caltech” and  
8 collectively with Life, the “Plaintiffs”) is a California corporation with a principal  
9 place of business at 1200 East California Boulevard, Pasadena, California 91125.

10 3. Upon information and belief, Defendant Promega Corporation  
11 (“Promega”) is a Wisconsin corporation with its headquarters at 2800 Woods  
12 Hollow Road, Madison, Wisconsin 53711.

13 **Jurisdiction and Venue**

14 4. This lawsuit is an action for patent infringement arising under the  
15 patent laws of the United States, 35 U.S.C. §§ 1 *et seq.* This Court has jurisdiction  
16 over this action pursuant to 28 U.S.C. §§ 1331 and 1338.

17 5. This Court has personal jurisdiction over Promega because Promega  
18 conducts business in the State of California and has committed acts of patent  
19 infringement and/or contributed to or induced acts of patent infringement by others  
20 in the Central District of California and elsewhere in California and the United  
21 States. For example, Promega maintains a facility within this district, located at 277  
22 Granada Drive, San Luis Obispo, California 93401.

23 6. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391  
24 and 1400 because Promega regularly conducts business in this judicial district, and  
25 certain of the acts complained of herein occurred in this judicial district. Promega  
26 offers to sell and sells the accused products in this judicial district.

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1 **The Patent in Suit**

2 7. On January 10, 2012, the United States Patent Office issued U.S. Patent  
3 Re-issue No. 43,096 titled “Tagged Extendable Primers and Extension Products”  
4 (the “‘096 patent”). A true and correct copy of the ‘096 patent is attached hereto as  
5 Exhibit A. The ‘096 patent is a reissue of United States Patent No. 6,200,748 (the  
6 “‘748 patent”).

7 8. Following an October 30, 2012 agreement, Plaintiffs have all right,  
8 title, and interest in, and are fully entitled to enforce, the ‘096 patent. Pursuant to  
9 that agreement, Life possesses, among other rights, the exclusive right to both  
10 sublicense and enforce the ‘096 patent. Prior to this agreement, neither Life nor its  
11 subsidiaries had unrestricted and exclusive rights to sublicense or enforce the ‘096  
12 patent.

13 9. The inventions of the ‘096 patent are a seminal improvement to genetic  
14 assays and analysis. The patent discloses various inventions, including methods,  
15 compositions, and mixtures that employ fluorescence instead of radioisotopes to  
16 label oligonucleotides, and the use of fluorescent labeling overcame the many  
17 known disadvantages and obstacles of the then-conventional radioisotope labeling in  
18 genetic assays. The claims of the ‘096 patent relate to and cover compositions,  
19 mixtures of reagents and other components, and methods for nucleic acid sequence  
20 analysis, all of which are useful in various types of genetic analysis.

21 **Background to the Action**

22 10. The inventions disclosed in the ‘096 patent and its predecessor have  
23 numerous applications to genetic assays and analysis.

24 11. Promega offers numerous products for genetic assays and analysis,  
25 including those it brands as “PowerPlex” “StemElite” and “CellID.” Each of these  
26 product lines utilize fluorescent-tagged oligonucleotides in genetic assays in a  
27 manner disclosed in, described by, and claimed by the ‘096 patent.  
28



1 products that practice one or more of the inventions claimed in the '096 patent. For  
2 example, Promega makes, uses, offers for sale, sells, and/or imports or exports  
3 various products, including, but not limited to, those offered under the brand names  
4 "PowerPlex," "StemElite" and "CellID."

5 19. Upon information and belief, in violation of 35 U.S.C. § 271, Promega  
6 has infringed and is continuing to infringe the '096 patent by contributing to and/or  
7 actively inducing the infringement by others of the '096 patent by the manufacture,  
8 use, offering for sale, sale, and/or importation or exportation of various products,  
9 including, but not limited to, those offered under the brand names "PowerPlex,"  
10 "StemElite" and "CellID."

11 20. As but one example of Promega's contributory and/or induced  
12 infringement, Promega explicitly encourages its customers to practice the methods  
13 disclosed and claimed in the '096 patent by using Promega's products. In its  
14 "Technical Manual: PowerPlex 18D System/Instructions for Use of Products  
15 DC1802 and DC1808" (revised August 2012, and *available at*  
16 [http://www.promega.com/~media/files/resources/protocols/  
17 technical%20manuals/101/powerplex%2018d%20system%20protocol.pdf?la=en](http://www.promega.com/~media/files/resources/protocols/technical%20manuals/101/powerplex%2018d%20system%20protocol.pdf?la=en)),  
18 Promega provides detailed, step-by-step instructions on using its products "for  
19 human identification applications including forensic analysis, relationship testing  
20 and research use. The [Promega PowerPlex] system allows co-amplification and  
21 four-color fluorescent detection of eighteen loci (seventeen STR loci and  
22 Amelogenin). . ." *Id.* at p. 2. Through materials such as these, Promega actively  
23 encourages its customers to infringe the '096 patent through the use of Promega's  
24 products.

25 21. Promega has had knowledge of the '096 patent since at least January  
26 13, 2012, and knowledge of the subject matter of the '096 patent since at least the  
27 assertion of the predecessor '748 patent in the 2001 litigation.

28 22. Upon information and belief, Promega has had knowledge that its

1 products are especially made or especially adapted for use in an infringement of the  
2 '096 patent and are not a staple article or commodity of commerce suitable for  
3 substantial noninfringing use.

4 23. Upon information and belief, Promega knowingly induced  
5 infringement of the '096 patent after learning of its issuance and possessed specific  
6 intent to encourage another's infringement (*e.g.*, Promega's customers).

7 24. Upon information and belief, Promega has willfully infringed the '096  
8 patent. Among other facts, Promega has had knowledge of the subject matter of the  
9 '096 patent since at least the assertion of its predecessor patent in the 2001  
10 litigation. Moreover, by entering into the cross-license agreement that specifically  
11 agreed to pay royalties on covered products, Promega has acknowledged that its  
12 products practice the inventions disclosed by the '096 patent and its predecessors.

13 25. Upon information and belief, Promega's accused actions continued  
14 despite an objectively high likelihood that they constituted infringement of the '096  
15 patent. Promega either knew or should have known about its risk of infringing the  
16 '096 patent based at least on its litigation history involving the predecessor '748  
17 patent and its knowledge of the reissue proceedings that preceded the '096 patent.  
18 Promega's conduct despite this knowledge was made with both objective and  
19 subjective reckless disregard for the infringing nature of its activities as  
20 demonstrated by Promega's extensive knowledge regarding the claims of the '748  
21 and '096 patents.

22 26. Upon information and belief, Promega's acts of infringement of the  
23 '096 patent will continue after service of this complaint unless enjoined by the  
24 Court.

25 27. As a result of Promega's infringement, Plaintiffs have suffered and will  
26 suffer damages.

27  
28 28. Plaintiffs are entitled to recover from Promega the damages sustained

1 as a result of Promega’s wrongful acts in an amount subject to proof at trial.

2 29. Unless Promega is enjoined by this Court from continuing its  
3 infringement of the ‘096 patent, Plaintiffs will suffer additional irreparable harm and  
4 impairment of the value of their patent rights. Thus, Plaintiffs are entitled to a  
5 preliminary and a permanent injunction against further infringement.

6 **Prayer for Relief**

7 WHEREFORE, Plaintiffs pray for the following relief:

8 (a) That, pursuant to 35 U.S.C. § 284, Promega be ordered to pay damages  
9 adequate to compensate Plaintiffs for Promega’s infringement of the ‘096 patent;

10 (b) That, pursuant to 35 U.S.C. § 284, Promega be ordered to pay treble  
11 damages for willful infringement of the ‘096 patent;

12 (c) That, pursuant to 35 U.S.C. § 285, that this case be deemed  
13 exceptional, and that Promega be ordered to pay attorneys’ fees;

14 (d) That, pursuant to 35 U.S.C. § 283, Promega, its officers, agents,  
15 servants, employees, and those persons acting in active concert or participation with  
16 them be enjoined from further infringement of the ‘096 patent;

17 (e) That Promega be ordered to pay prejudgment interest;

18 (f) That Promega be ordered to pay all costs and expenses associated with  
19 this action; and

20 (g) That Plaintiffs be granted such other and additional relief as the Court  
21 deems just and proper.

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1 DATED: November 19, 2012

Respectfully submitted,

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3 QUINN EMANUEL URQUHART &  
SULLIVAN, LLP

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5  
6 By 

Brian Cannon

7 Attorneys for Plaintiffs Life Technologies  
8 Corporation and the California Institute of  
9 Technology

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**DEMAND FOR JURY TRIAL**

Pursuant to Rule 38 of the Federal Rules of Civil Procedure and Local Rule 38-1 of this Court, Plaintiffs hereby demand a trial by jury as to all issues so triable.

DATED: November 19, 2012      Respectfully submitted,

QUINN EMANUEL URQUHART &  
SULLIVAN, LLP

By *Brian Cannon* / FOR  
Brian Cannon  
Attorneys for Plaintiffs Life Technologies  
Corporation and the California Institute of  
Technology