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15 CORPORATION

16 UNITED STATES DISTRICT COURT
17 NORTHERN DISTRICT OF CALIFORNIA

18
19 LIFE TECHNOLOGIES) Case No.
20 CORPORATION,)
Plaintiff,) **COMPLAINT**
21 vs.)
22)
23 PACIFIC BIOSCIENCE OF)
CALIFORNIA, INC.)
24 Defendant.)
25)

26 Plaintiff Life Technologies Corp. (“Life Technologies”) alleges as follows for its
27 complaint against defendant Pacific Biosciences of California, Inc. (“PacBio”):

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1 **PARTIES**

2 1. Life Technologies is a Delaware corporation with a principal place of business
3 at 5791 Van Allen Way, Carlsbad, California 92008.

4 2. PacBio is a Delaware corporation with a principal place of business at 1380
5 Willow Road, Menlo Park, California 94025.

6 **NATURE OF ACTION**

7 3. This is an action under 35 U.S.C. § 146 to review the rulings of the Board of
8 Patent Appeals and Interferences (the “Board”) of the United States Patent and Trademark
9 Office (the “PTO”) in Interference No. 105,677 (the “’677 Interference”), including the
10 Decision on Motions (Paper 132) (the “Decision”) and the Judgment (Paper 133), both entered
11 January 31, 2011.

12 **JURISDICTION AND VENUE**

13 4. This Court has jurisdiction over the subject matter of this action pursuant to 35
14 U.S.C. § 146 and 28 U.S.C. § 1338.

15 5. Venue is proper in this judicial district under 28 U.S.C. §1391(c).

16 **FACTS GIVING RISE TO THIS COMPLAINT**

17 6. This action arises from the Board’s rulings in the ’677 Interference, including
18 but not limited to the Board’s Decision and Judgment. A true and correct copy of the Judgment
19 is attached as Exhibit A hereto and a true and correct copy of the Decision is attached as
20 Exhibit B hereto.

21 7. Life Technologies is the owner by assignment of the entire right, title and
22 interest in and to the invention disclosed in U.S. Patent No. 7,329,492 issued February 12, 2008
23 (the “’492 patent”) in the names of Susan Hardin, Xiaolian Gao, James Briggs, Richard
24 Willson, and Shiao-Chun Tu (collectively “Hardin”). Visigen Biotechnologies, Inc. was
25 previously the owner of the ’492 patent. A copy of the ’492 patent is attached as Exhibit C
26 hereto.

27 8. PacBio is the owner by assignment of the entire right, title and interest in and to
28 U.S. Application No. 11/459,182 filed July 21, 2006 (the “’182 application”) in the name of

1 John G.K. Williams (“Williams”). PacBio actively participated in the ’677 Interference.

2 9. On December 18, 2008, the Board declared and instituted the ’677 Interference
3 between Life Technologies’ Hardin ’492 patent and PacBio’s Williams ’182 application.

4 10. Count 1, the sole Count in the ’677 Interference, is claim 1 of the ’492 patent or
5 claim 73 of the 182 application, which are identical.

6 11. Claims 1-12 and 15-23 of the ’492 patent (“Life Technologies’ involved
7 claims”) were designated as corresponding to the Count. After initially having been designated
8 as corresponding to the Count, claims 13-14 of the ’492 patent were de-designated and
9 therefore not involved further in the Interference.

10 12. All the claims of the ’182 application, claims 73-93 (“PacBio’s involved
11 claims”), were designated as corresponding to the Count. PacBio copied those claims from
12 Life Technologies’ ’492 patent.

13 13. During the course of the ’677 Interference, Life Technologies filed Hardin
14 Motions 1-9 and PacBio filed Williams Motions 1-9.

15 14. Hardin Motion 1 sought judgment that PacBio’s involved claims are
16 unpatentable to PacBio under 35 U.S.C. § 112. Specifically, PacBio’s involved claims are not
17 patentable to PacBio because the ’182 specification provides neither an adequate written
18 description of the invention that is now claimed nor an enabling disclosure of the invention, as
19 required by the first paragraph of 35 U.S.C. § 112.

20 15. Hardin Motion 2 sought judgment that PacBio’s involved claims are not entitled
21 to the benefit of Application No. 09/460,303 because that application neither describes nor
22 enables the subject matter of the Count. Hardin’s List of Proposed Motions (Paper 19) also
23 proposed motions seeking judgment that PacBio’s involved claims are not entitled to the filing
24 dates of PacBio’s two provisional applications (Nos. 60/112,078 and 60/115,496). The Board
25 denied Life Technologies authority to make those two motions (Paper 22 at 3).

26 16. Contingent upon denial of Hardin Motion 1, Hardin Motion 3 sought judgment
27 that PacBio’s involved claims are unpatentable to PacBio under 35 U.S.C. § 103 over Rabani,
28 Int’l Pub. No. WO 96/27025 (“Rabani”) or Rabani in view of Yarbrough and Bock, THE

1 JOURNAL OF BIOLOGICAL CHEMISTRY, 255(20):9907-11 (1980) (“Yarborough) and
2 Keller et al., APPLIED SPECTROSCOPY, 50(7):12A-32A (1996) (“Keller”).

3 17. Hardin Motion 4 sought discovery pursuant to 37 C.F.R. § 41.150 regarding
4 PacBio’s U.S. Patent 6,762,048 (the “’048 patent”), asserted as prior art by PacBio against Life
5 Technologies’ ’492 patent. Hardin Motion 5 sought reconsideration of the denial of Hardin
6 Motion 4.

7 18. Hardin Motion 7 sought discovery pertaining to a collaboration of PacBio’s
8 expert witness, Jay Trautman, Ph.D. (“Trautman”) with a research group at Cornell University
9 including Jonas Korlach.

10 19. Hardin Motion 8, pursuant to 37 C.F.R. §§ 41.121(a)(3), 41.122(b), 41.128, and
11 41.155(c) and Standing Order paragraphs 121.3, 122.5, and 155.2, sought to exclude PacBio’s
12 exhibits 1122-29, 1133-43, 1146-47, and 1149-52 and PacBio’s Replies 2 and 4. Contingent
13 upon denial of Motion 8, Hardin Motion 9 sought leave to file a sur-reply with evidence.

14 20. Williams Motion 2 sought judgment that Life Technologies’ involved claims are
15 unpatentable for lack of written description and/or enablement.

16 21. On June 24, 2009 and August 17, 2009, in Papers 57 and 72, the Board denied
17 Hardin Motions 4 and 5, denying Life Technologies the requested discovery relating to the
18 ’048 patent.

19 22. On November 18, 2009, in Paper 126, the Board denied Hardin Motion 7,
20 denying Life Technologies the requested Trautman-related discovery.

21 23. After holding an Oral Hearing on December 9, 2009, the Board entered a
22 Decision on Motions (Paper 132) and a Judgment (Paper 133), both on January 31, 2011.

23 24. In Paper 132, the Board granted Hardin Motion 1 in part and denied it in part.
24 Specifically, the Board held that: 1) claims 73-78, 80, 82, and 85-93 of the PacBio ’182
25 application were unpatentable to PacBio for lack of written description support; 2) claims 79,
26 81, and 83-84 of the ’182 application were not unpatentable to PacBio as lacking written
27 description support; and 3) none of the involved PacBio claims were unpatentable to PacBio as
28 lacking an enabling disclosure.

1 25. In Paper 132, the Board also denied Hardin Motion 3 and determined not to
2 reach Hardin Motion 2.

3 26. In Paper 132, the Board further granted Williams Motion 2 in part, specifically
4 that portion alleging Life Technologies' involved claims lack written description support.

5 27. In Paper 133, based on the partial grant of Hardin Motion 1, the Board entered
6 judgment that claims 73-78, 80, 82, and 85-93 of PacBio's '182 application are finally refused.
7 Based on the partial grant of Williams Motion 2, the Board entered judgment on priority
8 against Life Technologies and canceled the involved claims of Life Technologies' '492 patent
9 (claims 1-12 and 15-23).

10 28. The Board's decisions that resulted in the entry of judgment and the Board's
11 other decisions that were adverse to Life Technologies and favorable to PacBio were erroneous
12 and contrary to fact and law.

13 29. Life Technologies, the owner of the '492 patent and a party dissatisfied with the
14 result of the '677 Interference, seeks review and modification of the decisions rendered by the
15 Board and in particular the Judgment based on those decisions.

16 30. Pursuant to 35 U.S.C. § 146, Life Technologies has commenced this action in
17 this Court rather than appealing from the Board's Decision and Judgment to the United States
18 Court of Appeals for the Federal Circuit.

19 31. The Board's decisions in the '677 Interference were erroneous and, based on the
20 record before the Board, evidence Life Technologies sought to obtain and introduce into the
21 record before the Board, and any additional evidence that Life Technologies may introduce in
22 this action, Life Technologies is entitled to judgment correcting the erroneous decisions and
23 judgment of the Board.

24 32. Life Technologies has priority as to the subject matter at issue in the '677
25 Interference and PacBio's involved claims are unpatentable to PacBio.

26 33. Life Technologies' involved claims are valid.

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PRAYER FOR RELIEF

WHEREFORE, plaintiff Life Technologies prays for judgment:

A. Reversing the Board’s denial of Hardin Motion 1 as to claims 79, 81, and 83-84 of the PacBio ’182 application and finding those claims unpatentable to PacBio;

B. Reversing the Board’s partial denial of Hardin Motion 1 as to claims 73-78, 80, 82, and 85-93 of the PacBio ’182 application and finding those claims unpatentable to PacBio for lack of an enabling disclosure;

C. Reversing the Board’s grant of Williams Motion 2 and finding the involved Life Technologies claims patentable, including having adequate written description support as required under 35 U.S.C. § 112;

D. Granting Hardin Motion 2 and ruling that PacBio’s ’182 application does not have the benefit of the filing dates of PacBio’s earlier applications and ruling that the involved claims of the ’182 application are unpatentable to PacBio over the prior art;

E. Reversing the Board’s denial of Hardin Motion 3, in the event that PacBio’s ’182 application is found to enable the subject matter of the Count;

F. Granting Hardin Motions 4-5 and 7-9, and the Hardin motions not authorized, as specified in ¶15 above, as necessary to grant Life Technologies complete relief in this action;

G. Reversing all other rulings of the Board adverse to Life Technologies; and

H. Awarding Life Technologies its costs and attorneys’ fees in this action, and such other and further relief as this Court may deem appropriate.

Dated: March 31, 2011

Respectfully Submitted,

LIFE TECHNOLOGIES CORPORATION

By: 
Polaphat Veravanich