

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

THE REGENTS OF THE UNIVERSITY OF
CALIFORNIA,
1111 Franklin Street, 12th Floor
Oakland, California 94607-5200

Plaintiff,

v.

HONORABLE DAVID KAPPOS, in his official
capacity as UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL
PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND
TRADEMARK OFFICE,

United States Patent and Trademark Office
Office of the General Counsel
Madison Building East, Room 10B20
600 Dulany Street
Alexandria, Virginia 22314

Defendant.

Case: 1:10-cv-02031
Assigned To : Sullivan, Emmet G.
Assign. Date : 11/29/2010
Description: General Civil

**COMPLAINT FOR REVERSAL OF A DECISION OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE BOARD OF
PATENT APPEALS AND INTERFERENCES**

Plaintiff, THE REGENTS OF THE UNIVERSITY OF CALIFORNIA (“Plaintiff” or
“The Regents”) for its Complaint against Defendant alleges as follows:

THE PARTIES

1. This civil action is brought by Plaintiff against the Director of United States
Patent and Trademark Office (“PTO”) for a judgment that Plaintiff is entitled to a patent
pursuant to 35 U.S.C. §§ 145 and 306.

2. The Regents is the assignee and owner of United States Patent No. 5,916,912, entitled “Dietary Composition for Enhancing Metabolism and Alleviating Oxidative Stress” (hereinafter the “’912 patent”), by assignment from the inventors Bruce N. Ames and Tory M. Hagen. The Regents is a public corporation under the laws of the State of California operating under Article 9, Section 9 of the California Constitution, having its principal place of business at 1111 Franklin Street, 12th Floor, Oakland, California 94607-5200.

3. Defendant the Honorable David Kappos is the Under Secretary of Commerce for Intellectual Property and Director of the PTO, who in his official capacity as Director of the PTO is a legal resident of the District of Columbia and within the jurisdiction of this Court. Mr. Kappos is hereby sued in his official capacity as Director pursuant to 35 U.S.C. §§ 145 and 306.

JURISDICTION AND VENUE

4. This is an action by a patent owner dissatisfied with the decision of the Board of Patent Appeals and Interferences (“BPAI”) in the *ex parte* reexamination of the ’912 patent. Jurisdiction and venue are proper in this Court pursuant to 35 U.S.C. §§ 145 and 306, and, in the alternative, 28 U.S.C. §§ 1338 and 1391.

FACTUAL BACKGROUND

5. The ’912 patent, which was filed on June 16, 1997 and issued on June 29, 1999, is directed generally to, *inter alia*, methods for enhancing mitochondrial metabolism without a concomitant increase in metabolic production of oxygen reactive species, using specific doses of a combination of carnitine, together with lipoic acid (or N-acetyl-cysteine). The invention resulted, *inter alia*, from the inventors’ recognition that administration of the claimed combinations at the specified doses to old animals restored mitochondrial function and reversed

several gross indicia of aging, including activity, muscle tone, coat appearance and kidney morphology.

6. A request for *ex parte* reexamination of claims 1 through 10 of the '912 patent was filed by a third party requestor on July 13, 2005. Claims 1 through 10 were the only existing claims of the '912 patent at the time the reexamination was filed. The reexamination for the '912 patent was given Application No. 90/007,626 (the '626 application).

7. During the course of the *ex parte* reexamination proceeding, the patentee amended certain of the pre-existing claims and also added new claims.

8. The PTO examiner determined that claims 13, 32, 34, and 57-59 of the '626 application were patentable over the cited references. The examiner, however, rejected claims 1, 2, 4-7, 9-11, 16, 17, 20-23, 26-29, 37-40, 43-47, and 50-54 as unpatentable over the cited references.

9. The Regents timely appealed the PTO examiner's rejection of claims 1, 2, 4-7, 9-11, 16, 17, 20-23, 26-29, 37-40, 43-47, and 50-54 of the '626 application to BPAI pursuant to 35 U.S.C. § 134.

10. On September 27, 2010, the BPAI issued a decision reversing the PTO examiner's rejection of claim 5 of the '626 application, but, in error, affirmed the rejections of claims 1, 2, 4, 6, 7, 9-11, 16, 17, 20-23, 26-29, 37-40, 43-47, and 50-54.

11. Pursuant to 35 U.S.C. §§ 145 and 306 the Regents seek a judgment that the decision of the BPAI affirming the PTO examiner's rejections of claims 1, 2, 4, 6, 7, 9-11, 16, 17, 20-23, 26-29, 37-40, 43-47, and 50-54 of the '626 application was in error, that the Regents are entitled to these claims, and that the Director should issue a patent containing such claims.

12. No appeal to the United States Court of Appeals for the Federal Circuit has been taken from the decision of the BPAI.

REQUEST FOR RELIEF

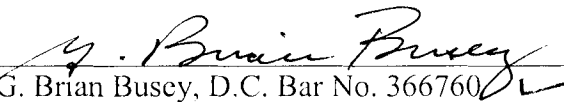
WHEREFORE, plaintiff respectfully prays for the entry of judgment:

- A. Reversing the Board of Patent Appeals and Interferences' affirmance of the examiner's final rejection of claims 1, 2, 4, 6, 7, 9-11, 16, 17, 20-23, 26-29, 37-40, 43-47, and 50-54 of the '626 application.
- B. Declaring that, in addition to claims 5, 13, 32, 34, and 57-59 of the '626 application, United States Letters Patent should issue for the inventions defined by claims 1, 2, 4, 6, 7, 9-11, 16, 17, 20-23, 26-29, 37-40, 43-47, and 50-54 of that application.
- C. Granting such other and further relief as the Court shall deem just and proper.

Dated: November 29, 2010

Respectfully submitted,

By:


G. Brian Busey, D.C. Bar No. 366760

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