

1 Michael Rueckheim
MRueckheim@winston.com
2 Matt McCullough
MRMcCullough@winston.com
3 WINSTON & STRAWN LLP
255 Shoreline Drive, Suite 520
4 Redwood City, California 94065
Telephone: (650) 858-6500
5 Facsimile: (650) 858-6550

6 Michael Bittner (pro hac pending)
MBittner@winston.com
7 WINSTON & STRAWN LLP
2121 North Pearl Street, Suite 900
8 Dallas, Texas 75201
Telephone: (214) 453-6500
9 Facsimile: (214) 453-6400

10 Attorneys for Plaintiff
11 MX3 DIAGNOSTICS, INC.

12
13 **UNITED STATES DISTRICT COURT**
14 **NORTHERN DISTRICT OF CALIFORNIA**

15
16 MX3 Diagnostics, Inc.,

17 Plaintiff,

18 v.

19 IpVenture, Inc.,

20 Defendant.

Case No. 3:22-cv-04466

**COMPLAINT FOR DECLARATORY
JUDGMENT OF NON-INFRINGEMENT OF
U.S. PATENT NO. 11,337,650**

JURY TRIAL DEMANDED

1 Plaintiff MX3 Diagnostics, Inc. (“MX3”) seeks a declaration that it does not infringe United
2 States Patent No. 11,337,650 (“the ’650 Patent”) (Ex. A) as follows:

3 **NATURE OF THE ACTION**

4 1. MX3 brings this action seeking a declaratory judgment of non-infringement that arises
5 under the patent laws of the United States, Title 35 of the United States Code. MX3 requests this relief
6 because Defendant IpVenture, Inc. (“IpVenture”), the purported owner by assignment of the ’650
7 Patent, has alleged and continues to allege that MX3 infringes certain patent rights held by IpVenture,
8 including the ’650 Patent.

9 **THE PARTIES**

10 2. MX3 is a corporation organized and existing under the laws of the state of Delaware,
11 with its principal place of business at 2707 Stratford Dr., Austin, Texas 78746.

12 3. Defendant IpVenture, Inc. is a corporation organized and existing under laws of the
13 state of California, with its principal place of business at 4010 Moorpark Ave., Suite 211, San Jose,
14 California 95117.

15 **JURISDICTIONAL STATEMENT**

16 4. This action arises under the Declaratory Judgment Act, 28 U.S.C. § 2201, and under
17 the patent laws of the United States, 35 U.S.C. §§ 1-390.

18 5. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1331,
19 1338(a), and 2201(a).

20 6. This Court has personal jurisdiction over defendant IpVenture. IpVenture is registered
21 to do business in the State of California (Registration No. C2465865) and has its principal place of
22 business in the State of California and more particularly in this District. IpVenture, directly and
23 through agents, regularly does, solicits, and transacts business in this District and elsewhere in the
24 State of California. Upon information and belief, IpVenture has conducted business in California and
25 in this District related to the prosecution, licensing, or enforcement of the ’650 Patent.

26 7. Venue is proper in this District under 28 U.S.C. §§ 1391(b) and 1391(c) because,
27 among other reasons, IpVenture is subject to personal jurisdiction in this judicial district, IpVenture
28 has conducted business in this District, or because a substantial part of the events or omissions giving

1 rise to the claims herein occurred in this District.

2 8. As set forth herein, an immediate, real, and justiciable controversy exists between MX3
3 and IpVenture as to whether MX3 is infringing or has infringed the '650 Patent.

4 **INTRADISTRICT ASSIGNMENT**

5 9. For purposes of intradistrict assignment under Civil Local Rules 3-2(c) and 3-5(b), this
6 Intellectual Property Action will be assigned on a district-wide basis.

7 **BACKGROUND**

8 10. On July 9, 2021, IpVenture sued MX3 in the Western District of Texas alleging that
9 MX3 infringed United States Patent No. 11,013,461 (the '461 Patent"). *See IpVenture, Inc. v. MX3*
10 *Diagnostics, Inc.*, Case No. 6:21-cv-713 (W.D. Tex. Jul. 9, 2021). The '650 Patent is a continuation
11 of the '461 Patent.

12 11. While resolving IpVenture's prior suit, IpVenture represented MX3 that it had filed
13 U.S. Patent App. No. 17/211,977, which eventually issued as the '650 Patent. While the parties
14 resolved their dispute regarding the '461 Patent, no resolution could be reached regarding the '650
15 Patent application. Instead, IpVenture specifically excluded any patent or patent application related
16 to the '461 Patent, including subsequently issuing patents. IpVenture further represented that if the
17 '650 Patent to issue, then MX3 would infringe and require a license.

18 12. Once the '650 Patent issued, IpVenture wrote to MX3 stating that "MX3 is not licensed
19 to the '650 patent" and reiterated that it has advised MX3 "during the previous litigation that IpVenture
20 believed MX3 would need a license to the claims pending in the application that has now issued as the
21 '650 patent." *See* July 14, 2022 Letter from PTong to MLuther (Ex. B). Included with IpVenture's
22 letter was a detailed claim chart alleging infringement by MX3 of claims 4, 6, 8, 9, 10, 11, 12, 13, 14,
23 15, 16, 17, 18, 19, and 20.

24 **COUNT I**

25 **DECLARATION OF NON-INFRINGEMENT**

26 13. MX3 incorporates and realleges the foregoing paragraphs.

27 14. Based on IpVenture's past and continuing allegations of infringement of the '650
28 Patent by MX3, an actual controversy has arisen and now exists between the parties as to whether

1 MX3 infringes the '650 Patent.

2 15. MX3 does not infringe and has not infringed, under any theory of infringement
3 (including directly (whether individually or jointly), indirectly (whether contributorily or by
4 inducement)), and/or under the doctrine of equivalents, any claim of the '650 Patent.

5 16. Pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, MX3
6 requests a declaration by the Court that it does not infringe and has not infringed, under any theory of
7 infringement (including directly (whether individually or jointly) or indirectly (whether contributorily
8 or by inducement)), any enforceable claim of the '650 Patent.

9 **JURY DEMAND**

10 17. MX3 hereby demands trial by jury on all issues.

11 **PRAYER FOR RELIEF**

12 WHEREFORE, MX3 asks this Court to enter judgment in MX3's favor and against IpVenture
13 by granting the following relief:

- 14 a) a declaration that MX3 does not infringe and has not infringed, under any theory of
15 infringement (including directly (whether individually or jointly) or indirectly (whether
16 contributorily or by inducement)), any claim of the '650 Patent;
- 17 b) a permanent injunction restraining IpVenture, and its respective officers, agents,
18 servants, employees, attorneys, and any other persons acting on their behalf or in
19 concert with them, from charging or threatening, orally or in writing, that the '650
20 Patent has been infringed by MX3 under any subsection of 35 U.S.C. § 271; and
- 21 c) an award to MX3 of its reasonable attorneys' fees, costs, and all interest (including
22 without limitation any attorneys' fees awards based upon 35 U.S.C. § 285), and
- 23 d) any such other and further relief as the Court finds just and proper.
- 24
25
26
27
28

1 Dated: August 2, 2022

WINSTON & STRAWN LLP

2
3 By: /s/ Michael Rueckheim
Michael Rueckheim

4 Attorneys for Plaintiff
5 MX3 DIAGNOSTICS, INC.
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28