



#1] ¶ 14; compare also id. at 8A.(1) with 8A.(2). On October 30, 2000, defendants moved for summary judgment on plaintiffs' claims of contributory infringement of all five patents, contending that "MJ's thermal cyclers have 'substantial noninfringing use[s]'" and, thus, are 'staple goods' under 35 U.S.C. § 271(c)," See Motion [Doc. #337] at 1, and noting that U.S. Patent No. 5,333,675 (the "'675 Patent") and U.S. Patent No. 5,475,610 (the "'610 Patent") were not claimed by plaintiffs to have been contributorily infringed and therefore were not addressed, see Mem. [Doc. #338] at 2 n.1. On March 28, 2002, the Court (Squatrito, J., presiding) granted defendants' motion, reasoning:

The court finds, as a matter of law, that MJ's thermal cyclers are staple goods suitable for substantial noninfringing uses within the meaning [of 35 U.S.C. § 271(c)]. The defendants have produced overwhelming evidence to support the position that the thermal cyclers are suitable for substantial noninfringing use. Principally, they claim that the thermal cyclers are used to perform numerous biomolecular reactions, including a laboratory technique known as 'cycle sequencing,' which is a process used to determine the sequence of DNA segments. The defendants have proffered evidence that in certain fields of research, thermal cyclers are used exclusively for cycle sequencing ... and the president of PE Biosystem testified that PE's cycle sequencing kit sales approached approximately 70% of the annual sales of the PCR business.

Further, the record contains uncontroverted evidence that thermal cyclers very similar to the ones patented by the plaintiffs predate the disclosure and proliferation of the PCR process by years. ... In fact, the evidence shows that thermal cyclers have existed in some form for several decades. In light of this evidence, it would be nonsensical for PE now to argue that these devices have no other uses aside from performance of the PCR process.

See Ruling [Doc. #624] at 4-5. After defendants filed their

motion for summary judgment on plaintiffs' five contributory infringement claims but before Judge Squatrito issued his ruling, plaintiffs filed an amended complaint on April 11, 2001, alleging in pertinent part,

34. MJ has offered to sell and has sold, in this district and elsewhere, thermal cyclers and thermal cycler accessory apparatus especially adapted for use in infringement of the original and reexamined claims of the '675 Patent, either literally or under the doctrine of equivalents, and said thermal cyclers and thermal cycler accessory apparatus are not staple articles of commerce suitable for substantial non-infringing use.

...

36. MJ has offered to sell and has sold, in this district and elsewhere, thermal cyclers and thermal cycler accessory apparatus especially adapted for use in infringement of the claims of the '610 Patent, either literally or under the doctrine of equivalents, and said thermal cyclers and thermal cycler accessory apparatus are not staple articles of commerce suitable for substantial non-infringing use.

...

**Wherefore**, plaintiffs demand judgment against defendants as follows:

A. on the first claim,

...

(2) a preliminary and permanent injunction prohibiting defendants from infringing, directly or by inducement, or contributorily infringing, any claim of ... U.S. Patent No. 5,333,675; U.S. Patent 5,475,610....

Am. Compl. [Doc. #500] ¶¶ 34, 36, at 12A.(2).

By amended and supplemental proposed jury instructions dated December 15, 2003, plaintiffs request the Court to charge the

jury in the following manner on contributory infringement,

I will first give you a summary of each side's contentions in this case. I will then instruct you on the law that applies to each contention.

...

In addition, Applera asserts that MJ is liable for infringement of the '675, '493, and '610 thermal cyclers patents by making, using, offering to sell, and selling thermal cyclers that are claimed in these patents, by inducing its customers to infringe these patents, and by contributing to another's infringement of the '675 and '610 patents by supplying a component specially designed for the patented inventions.

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Elements of contributory infringement are:

- (1) sale or supply by the defendant;
- (2) of a material component of the patented invention that is not a staple article of commerce capable of substantial noninfringing use;
- (3) with knowledge of the patent and knowledge that the component was especially made for use in infringement of such patented invention.

In determining whether the component supplied by a defendant is a "staple article of commerce," you should take into account the quality, quantity and efficiency of the suggested uses.

The defendant cannot be liable for contributory infringement unless a patent claim is directly infringed. However, proof of contributory infringement and the underlying direct infringement may be based on circumstantial evidence you have heard in this case, rather than direct evidence of infringement.

Beerbower Affirmation [Doc. #783] Ex. 27.

## **II. Discussion**

### **A. Parties' Arguments**

Defendants claim plaintiffs' proposed jury charge on contributory infringement "[b]lantantly ignor[es]" their own pleadings and Judge Squatrito's ruling, interpreting plaintiffs' Amended Complaint as not alleging contributory infringement of the '675 and '610 patents and, even assuming it did, Judge Squatrito's conclusion that MJ's thermal cyclers are staple goods suitable for substantial non-infringing uses other than PCR as barring such claims. Defendants do not read paragraphs 34 and 36 of the Amended Complaint to plead contributory infringement of the '675 and '610 patents because, with respect to the individual defendants, a comparison of paragraph 37 ("Michael and John Finney have knowingly and actively assisted in and induced MJ's infringement of the '675 Patent and the '610 Patent") with paragraph 45 ("Michael and John Finney have knowingly and actively assisted in and induced MJ's contributory infringement of the '202 Patent, the '195 Patent, the '188 Patent, the '756 Patent, and the '493 Patent") "establish[es] the nature of the claims being asserted." Reply [Doc. #830] at 2. Presumably defendants mean that, if plaintiffs had pled contributory infringement of the '675 and '610 patents against MJ, they would also have included an explicit corresponding claim against the Finneys of knowingly and actively assisting in and inducing that

contributory infringement, just as was done for the '202, '195, '188, '493, and '756 patents. Defendants also maintain that, if plaintiffs had alleged contributory infringement of the '675 and '610 patents, they had a duty so to inform defendants and the Court in their December 2000 opposition to defendants' summary judgment motion, see Opp'n [Doc. #377], and draw an inference from their failure to do so that they really have not pled those contributory infringement claims.

In opposition, plaintiffs point to the language of paragraphs 34 and 36 of their amended complaint in which they pleaded MJ's contributory infringement of the '675 and '610 patents by language tracking 35 U.S.C. § 271(c). With respect to Judge Squatrito's ruling, plaintiffs point out that defendants' summary judgment motion was directed to the '202, '195, '188, '756, and '493 patents and not the '675 and '610 patents. Further, reason plaintiffs, the rationale of Judge Squatrito's decision should not extend to the latter two patents because it focused on substantial uses of thermal cyclers other than for PCR and that such non-PCR uses are irrelevant to the claimed apparatuses of the '675 and '610 patents because these patents do not require the performance of PCR as a limitation, see Claim Construction [Doc. #715] at 3, 26.

## **B. Discussion**

The Court holds that plaintiff has pleaded contributory infringement of the '675 and '610 Patents and that those claims are not disposed of by the rationale of Judge Squatrito's ruling and thus remain in the case. The language of paragraphs 34 and 36 of plaintiffs' Amended Complaint explicitly tracks the wording of the contributory infringement statute, 35 U.S.C. § 271(c).<sup>1</sup> Notwithstanding the inconsistent structure of the Amended Complaint, plaintiffs have pled the individual defendants' participation in MJ's contributory infringement of both patents in paragraph 37. While paragraphs 38 through 45 plead corresponding claims against the Finneys immediately following each substantive infringement claim against MJ, and paragraphs 32 through 37 place the corresponding claims against the Finneys after enumeration of all substantive infringement claims against MJ, this juxtaposition is of no import.

Inasmuch as plaintiffs were not granted leave to file their amended complaint until April 2001, they were obviously under no duty in the preceding December 2000 (when filing their opposition to defendants' summary judgment motion) to object to what was then defendants' correct characterization of the extant complaint. In addition, in light of the clear language of paragraphs 34 and 36 of the Amended Complaint, there is no

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<sup>1</sup> The knowledge element of § 271(c) is covered in paragraph 46.

apparent reason why plaintiffs ever should have known that defendants would labor under a misunderstanding about whether claims of contributory infringement of the '675 and '610 patents were being alleged under § 271(c).

Judge Squatrito's conclusion that MJ's thermal cyclers have substantial uses other than for performing PCR and thus the selling or offering to sell them could not form the basis of a claim for contributory infringement of the '202, '195, '188, '493, and '756 patents - patenting inventions which require the performance of PCR - has no applicability in the context of the claimed inventions of the '675 and '610 patents. Unauthorized use of the apparatuses claimed in the '675 and '610 patents, without more, constitutes infringement under 35 U.S.C. § 271(a). See Aro Mfg. Co. v. Convertible Top Replacement Co., 377 U.S. 476, 484 (1964). Because neither invention requires the performance of PCR as a limitation, see Claim Construction [Doc. #715] at 3, 26, the range of potential unauthorized uses are broader than the potential unauthorized uses of the '202, '195, '188, '493, and '756 patents and correspondingly the realm of substantial non-infringing uses narrower, for example, unauthorized use of the claimed inventions of the '675 and '610 patents could include both performance of PCR and cycle sequencing.

At trial, plaintiffs will be required to prove that

defendants sold a component of the apparatus claimed in the '675 or '610 patents constituting a material part of the apparatus, did so knowing that the component was especially adapted for use in an infringement of the '675 Patent or '610 Patent, and the component was not suitable for substantial non-infringing use. See generally Aro, 377 U.S. at 478-491. Questions of substantial non-infringing use in the '675 and '610 context therefore will not focus on whether the component enabled PCR or cycle sequencing but focus on whether or not the component is suitable for use in thermal cycler models or systems which do not infringe the '675 and '610 Patents. See e.g. id. 479, 487-88 and n.7.

### **III. Conclusion**

For the reasons set forth above, defendants' motion [Doc. #781] is DENIED to the extent defendants seek an order precluding plaintiffs from presenting evidence or making arguments at trial that defendants have contributorily infringed the asserted claims of the '675 and '610 Patents.

IT IS SO ORDERED.

/s/

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Janet Bond Arterton, U.S.D.J.

**Dated at New Haven, Connecticut this 24<sup>th</sup> day of February, 2004.**