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UNITED STATES DISTRICT COURT

DISTRICT OF OREGON

PORTLAND DIVISION

**E. I. DU PONT DE NEMOURS AND
COMPANY**, a Delaware corporation,

Plaintiff,

v.

**HERAEUS PRECIOUS METALS NORTH
AMERICA CONSHOHOCKEN LLC**, a
Delaware corporation,

Defendant.

No. 3:13-cv-346

COMPLAINT FOR DECLARATORY
JUDGMENT

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff E. I. du Pont de Nemours and Company (“DuPont”) brings this Complaint for a Declaratory Judgment against Defendants Heraeus Precious Metals North America Conshohocken LLC (“Heraeus”) and alleges as follows:

NATURE OF THE ACTION

1. This is an action arising under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
2. Plaintiff seeks a declaration that Plaintiff’s statements in its July 19, 2012 press release and its customer letters do not violate Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). A true and correct copy of both statements are attached hereto as Exhibit A and Exhibit B.

PARTIES

3. Plaintiff DuPont is a corporation organized and existing under the laws of the state of Delaware, with a principal place of business located at 1007 Market Street, Wilmington, Delaware 19898. DuPont is a world leader in science innovation in markets including agriculture and food, building and construction, electronics and communications, general industry, and transportation. DuPont is also a leading supplier of front-side silver photovoltaic pastes.
4. Defendant Heraeus Precious Metals North America Conshohocken LLC is a corporation organized and existing under the laws of the state of Delaware, with a principal place of business at 24 Union Hill Road, West Conshohocken, Pennsylvania 19428. Upon information and belief, Defendant Heraeus Precious Metals North America Conshohocken LLC was previously named Heraeus Materials Technology, LLC, and has recently changed its corporate name. Upon information and belief, Heraeus is a business involved in, among other things, the

processing of precious and platinum group metals as well as a comprehensive range of special metals.

JURISDICTION AND VENUE

5. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). This Court has subject matter jurisdiction over this matter pursuant to 28 U.S.C. § 1331.

6. This Court has personal jurisdiction over Heraeus for at least the reason that Heraeus has submitted itself to the jurisdiction of this Court by previously filing a counterclaim against DuPont for unfair competition under the Lanham Act in Civil Action No. 12-1104-HU. This Court also has personal jurisdiction over Heraeus because on information and belief, Heraeus maintains substantial, continuous, and systematic contacts in Oregon, including making regular sales of its front side silver photovoltaic pastes to customers in Oregon. Heraeus, by conducting business within Oregon, has purposefully availed itself of the benefits and protections of Oregon's laws such that it should reasonably anticipate being haled into court in this forum.

7. Venue is proper in the Portland Division of the District of Oregon pursuant to 28 U.S.C. § 1391(b) because Heraeus's actions in this judicial district created a present, genuine justiciable controversy between DuPont and Heraeus as to whether DuPont's statements violated Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

8. This Court has considered this issue in related case Civil Action No. 12-1104-HU and is therefore a proper forum for resolving this issue.

FACTUAL BACKGROUND

9. On July 2, 2012, Plaintiff DuPont filed its first amended complaint for patent infringement against Heraeus in Civil Action No. 12-1104-HU.

10. On July 19, 2012, DuPont issued a press release, in which DuPont stated that “The company recently filed two lawsuits against PV metallization paste supplier Heraeus and one against its customer SolarWorld, for infringing on DuPont patents for DuPont™ Solamet® PV metallization pastes.”

11. On July 31, 2012, DuPont issued customer letters, in which DuPont stated that “DuPont Microcircuit Materials has recently filed two lawsuits in the U.S. against PV paste supplier Heraeus for infringing on its patents for Solamet® photovoltaic metallization pastes and one against its customer SolarWorld for using ‘infringing’ materials.”

12. DuPont’s press release and customer letters also stated that “Intellectual Property (IP) theft [] is widespread and the issue seems to be growing in the current climate of [this] industry.” IP theft, left unchecked, “has the potential to threaten the [PV] industry broadly at a critical time in its development.”

13. Heraeus’s former head of research and development (R&D) is called Tung Pham. Pham was responsible for the R&D at Heraeus regarding photovoltaic pastes during his employment with Heraeus. The United States has indicted Pham for converting trade secrets both when Pham left his former employer to work for Heraeus in 2008, and when he left Heraeus to work for a Chinese competitor during 2011. The Superseding Indictment against Pham (attached as Exhibit C) includes a count of converting trade secrets, altering and destroying trade secrets, and seven different counts of devising schemes to defraud by means of false and fraudulent pretenses.

14. Trade secret misappropriation is intellectual property theft.

15. Patent infringement is intellectual property theft.

16. On September 19, 2012, Heraeus answered DuPont's Complaint in Civil Action No. 12-1104-HU, and asserted a counterclaim against DuPont for unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Heraeus alleged that DuPont's statements in DuPont's July 19, 2012 press release and its customer letters were false and misleading.

17. On October 10, 2012, DuPont moved to dismiss Heraeus's Lanham Act claim for failure to state a claim. After consideration and oral argument, on January 18, 2013, this Court dismissed Heraeus's Lanham Act claim without prejudice for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6).

18. On February 28, 2013, counsel for Heraeus informed counsel for DuPont that Heraeus intends to assert a claim for unfair competition against DuPont in the United States District Court for the District of Delaware by March 1, 2013.

19. A present, genuine, justiciable controversy exists between the parties as to whether DuPont's statements in its July 19, 2012 press release and DuPont's customer letters are false and misleading in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

COUNT I - DECLARATORY JUDGMENT

20. DuPont restates and realleges each of the assertions set forth in Paragraphs 1 through 18 above.

21. DuPont seeks a declaration of its rights, pursuant to 28 U.S.C. §§ 2201-2202, that the statements in its July 19, 2012 press release and its customer letters do not violate Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

22. Contrary to Heraeus's assertions, DuPont's statements at issue are not false or misleading and do not violate the Lanham Act.

23. A real and actual controversy presently exists between the parties to this action, which is concrete and justiciable in character, and as to which each party possesses an interest in resolving.

24. The controversy between the parties warrants relief declaring the rights of the parties pursuant to 28 U.S.C. §§ 2201-2202, and a finding DuPont's statements do not violate the Lanham Act. This Court has considered this issue in related case Civil Action No. 12-1104-HU and is therefore a proper forum for resolving this issue.

PRAYER FOR RELIEF

WHEREFORE, DuPont respectfully requests that this Court, granting the following relief:

- a. A declaration that DuPont's statements at issue do not violate Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a);
- b. An award to DuPont of its costs and expenses of litigation, including reasonable attorney's fees; and
- c. Any such other and further relief as the Court may deem just and proper under the circumstances.

DEMAND FOR JURY TRIAL

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, DuPont respectfully

requests a trial by jury of any and all issues on which a trial by jury is available under applicable law.

Dated this 28th day of February, 2013.

Respectfully submitted,

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