

Bereskin & Parr and H. Samuel Frost, Civil Action No. 0006584-06, in the Superior Court of the District of Columbia, Civil Division (“D.C. Court Action”). Defendant B&P is a Canadian law firm; Defendant Frost is a registered patent agent and partner at B&P who serves as head of the firm’s office in Mississauga, Ontario, Canada. Plaintiffs allege that Defendants committed professional malpractice in conjunction with the preparation and filing of a patent application on behalf of Plaintiffs before the U.S. Patent and Trademark Office. Defendants strenuously deny these allegations.

2. According to the papers on file in the D.C. Court Action, Plaintiffs filed their original complaint on August 25, 2005, which asserts claims for negligence and breach of contract. The claims stem from Plaintiffs’ assertion that Defendants omitted certain source code from the U.S. patent application, and that the missing source code was critical to the patent’s validity. Specifically, Plaintiffs allege that Frost, in his capacity as a partner at B&P, prepared and registered United States Patent No. 5,027,282 on behalf of Touchcom. The U.S. patent was later held to be invalid by the United States District Court for the Eastern District of Texas based on the omission of certain source code.¹ Plaintiffs allege that, but for the omission of the disputed source code from the U.S. application, the U.S. patent would not have been invalidated. Defendants deny this allegation. The Eastern District of Texas opinion is not dispositive of the invalidity issue, as the defendant in that case raised other arguments regarding the patent’s invalidity that were not addressed. The opinion is also not dispositive with respect to infringement, which was not addressed in the Texas proceeding.

3. Plaintiffs seek compensatory damages in excess of \$50 million and

¹ *Touchcom, Inc., et al. v. Dresser, Inc.*, 427 F. Supp. 2d 730 (E.D. Tex. 2005).

attorneys' fees. Plaintiffs have made a jury demand.

II. BASIS FOR REMOVAL

4. This Court has subject-matter jurisdiction under to 28 U.S.C. §§ 1331 and 1338.²

5. Under 28 U.S.C. § 1441, a party may remove any action “of which the district courts of the United States have original jurisdiction.”³ In turn, 28 U.S.C. § 1338 grants to the federal courts “original jurisdiction of any civil action arising under any Act of Congress relating to patents . . .”. The Supreme Court has interpreted this statute to grant original jurisdiction to United States District Courts in two situations involving patent issues: (1) where federal patent law creates the cause of action asserted by plaintiff; or (2) where “the plaintiff’s right to relief necessarily depends on resolution of a substantial question of federal patent law, in that patent law is a necessary element of the well-pleaded claims.”⁴

6. In the instant case, Plaintiffs allege that, but for Defendants’ omission of the disputed source code from the U.S. patent application, the patent would not have been found invalid by the United States District Court for the Eastern District of Texas. Plaintiffs’ complaint hinges on the contention that “[t]he U.S. ‘282 patent, as registered by B&P and Frost, was indefinite and invalid because of the missing computer source

² While Defendants invoke the subject matter jurisdiction of this Court, they contest personal jurisdiction in the District of Columbia and will timely file a motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(2).

³ 28 U.S.C. § 1441(a).

⁴ *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 808-09, 108 S. Ct. 2166, 2174 (1988).

code, and did not protect the technology . . .”.⁵ In order to resolve this claim, this Court will be required to decide whether the patent application prepared by Defendants would have resulted in a valid and infringed patent, had it contained the source code at issue. Because resolution of Plaintiffs’ claims requires interpretation of substantial questions of federal patent law, this case is properly removable.

III. PROCEDURAL REQUIREMENTS

7. This Notice of Removal is timely under 28 U.S.C. § 1446(b). The 30-day limitation period for removal commences upon formal service of the state court action.⁶ Both Defendants were personally served with the D.C. Court Action on August 31, 2006. Thus, the filing of this Notice of Removal is well within the 30-day limitation period, which runs until September 30, 2006.

8. Under 28 U.S.C. § 1441(a), this case is properly removed to this Court, the United States District Court for the District of Columbia, as the district embracing the place where the D.C. Court Action is pending.

9. Defendants, the removing parties, will promptly give Plaintiffs written notice of the filing of this Notice of Removal, as required by 28 U.S.C. § 1446(d). Defendants will promptly file a copy of this Notice of Removal with the clerk of the Superior Court of the District of Columbia, Civil Division, where the D.C. Court Action is pending, in accordance with 28 U.S.C. § 1446(d).

⁵ Original Compl. at ¶ 24.

⁶ *Murphy Bros., Inc. v. Michetti Pipe Stringing, Inc.*, 526 U.S. 344, 347-56 (1999).

10. An index of all documents being filed with this Notice of Removal is attached as Exhibit A.⁷ A true and correct copy of the D.C. Court Action docket sheet is attached as Exhibit B.⁸ True and correct copies of each document filed in the D.C. Court Action, except discovery materials, are attached as Exhibit C.⁹ A true and correct copy of the summons is attached as Exhibit D.¹⁰ These attachments contain copies of all process, pleadings, and orders from the D.C. Court Action, as required by 28 U.S.C. § 1446(a).

IV. CONCLUSION

Defendants pray that this Court remove the D.C. Court Action to this Court, issue any orders necessary to stay proceedings in the state court, assume jurisdiction of this action for all purposes, and issue such other and further relief to which Defendants may be justly entitled.

⁷ Appendix, Exhibit A — Index.

⁸ Appendix, Exhibit B — Docket Sheet.

⁹ Appendix, Exhibit C — State Court Pleadings.

¹⁰ Appendix, Exhibit D — Summons.

Dated: September 19, 2006

Respectfully submitted,



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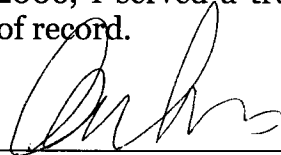
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CERTIFICATE OF SERVICE

On this 19th day of September, 2006, I served a true and correct copy of this document by regular mail on all counsel of record.



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