IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF RHODE ISLAND

SUMMER INFANT (USA), INC., Plaintiff, v. KAREN BARSKI DESIGNS, LLC, Defendant.	C.A. No. 22-cv-195

COMPLAINT

Plaintiff, Summer Infant (USA), Inc. ("Plaintiff" or "Summer Infant"), brings this action against defendant Karen Barski Designs, LLC ("Defendant" or "Barski"), and in support thereof avers the following:

INTRODUCTION

1. Summer Infant designs, markets, and distributes branded durable juvenile health, safety, and wellness products for ages 0-3 years. These products are sold principally to large U.S. retailers. Summer Infant has a robust patent portfolio that includes dozens of its own patents, and it also in-licenses patents where appropriate. Summer Infant's proprietary products include: safety gates, bed rails, nursery audio/video monitors, nursery furniture, booster and potty seats, travel accessories, highchairs, swings, and bouncers.

2. Upon information and belief, Barski is a Georgia company that designs baby and toddler products, such as swaddles, wraps, gowns, and mitts. The company also designs pet products.

3. Summer Infant sells a line of baby swaddling products, currently under the brand "SwaddleMe" (collectively the "SwaddleMe Products"). These products, which Summer Infant has sold for many years, vary in design and include garments designed for babies at three stages of development: newborns, older babies who are starting to roll, and babies who have begun walking.

4. Barski also designs a baby swaddling product called the "Woombie Swaddle" for which it has a patent, U.S. Pat. No. 8,609,364 (the "'364" patent"). A copy of the '364 patent is attached hereto as **Exhibit A**.

5. Barski has asserted that a subset of the SwaddleMe Products infringe the '364 patent (the "Accused Products"). The Accused Products include the SwaddleMe Arms Free Convertible Pod, in sizes large and extra large, and the SwaddleMe Pod, in sizes newborn, small/medium, and large.

6. Barski has wrongly and without basis asserted patent infringement in a manner designed to shield the asserted patent, which is plainly invalid and unenforceable, from any scrutiny as to its validity and enforceability, in order to gain an unfair advantage in the marketplace. This action seeks declaratory and other relief necessary to prevent Barski from succeeding in its unlawful business practice.

PARTIES

7. Summer Infant is a Delaware corporation with its principal place of business at 1275 Park East Drive, Woonsocket, Rhode Island.

8. Barski is, upon information and belief, a Georgia limited liability company with a principal place of business at 15355 Tullgean Drive, Milton, Georgia.

9. Upon information and belief, Karen Barski is the sole member of Barski and is a citizen of the state of Georgia.

JURISDICTION AND VENUE

10. This Court has jurisdiction over this lawsuit pursuant to 28 U.S.C. §§ 1332, 1338, and 2201 because the Complaint states claims arising under an Act of Congress relating to patents, including but not limited to 35 U.S.C. § 271 and seeks relief, in part, under the Federal Declaratory Judgment Act.

11. This Court has jurisdiction over Summer Infant's declaratory judgment claim pursuant to 28 U.S.C. §§ 2201 *et seq.* based on Barski's assertion that Summer Infant's sale of the Accused Product constitutes patent infringement, thereby giving rise to an actual case or controversy under 28 U.S.C. §§ 2201 and 2202.

12. This Court has diversity subject matter jurisdiction over this lawsuit under 28 U.S.C. § 1332 because this lawsuit is between citizens of different states and the amount in controversy exceeds $75,000.00 exclusive of interest and costs.

13. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), 1391(c), and 1400(b) because, in part, Barski conducts or has regularly conducted business in this judicial district, and/or, because a substantial part of the events or omissions giving rise to this action occurred in this judicial district, including the acts alleged by Barski to constitute patent infringement.

14. This Court has personal jurisdiction over Barski at least because of its continuous and systematic contacts with the state of Rhode Island, including conducting of substantial and regular business therein through marketing and sales of baby and toddler products, including the Woombie Swaddle, at least on the Amazon.com platform.

FACTUAL BACKGROUND

15. Summer Infant has been selling versions of its SwaddleMe Products since at least as early as 2010, under a license for a patent that issued in 2001.

16. Specifically, as a component of its product development process, on October 22, 2009, Summer Infant entered into a license agreement with Washington University, which held the now-expired U.S. Pat. No. 6,393,612 (the "'612 patent", or "Thach"), attached hereto as **Exhibit B**.

17. Thach, filed in 2001, disclosed a garment for swaddling a baby, including outer and inner surfaces forming an elongate shell that defined an interior volume for receiving the arms, legs, and trunk of a baby therein. Summer Infant made, marketed, and sold each of the Accused Products under the Washington University license until the '612 patent's expiration in 2021.

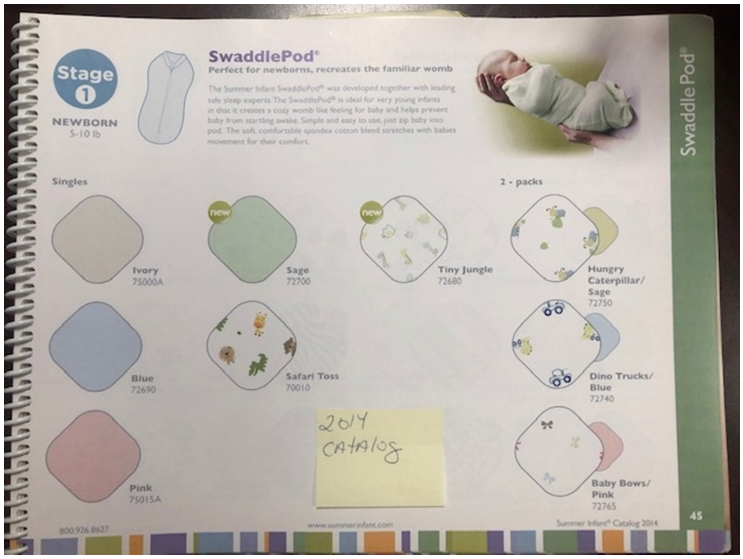
18. The '364 patent issued at least three years later, and twelve years after the issuance of the patent that Summer Infant had licensed, on December 17, 2013.

19. Eight years ago, in 2014, Karen Barski, upon information and belief the principal of Barski, sent a letter to Summer Infant alleging that Summer Infant's "SwaddlePod" products (which are now part of the SwaddleMe Products) infringed Barski's then newly-issued '364 patent. Barski did not include any analysis purporting to show how the patent was infringed.

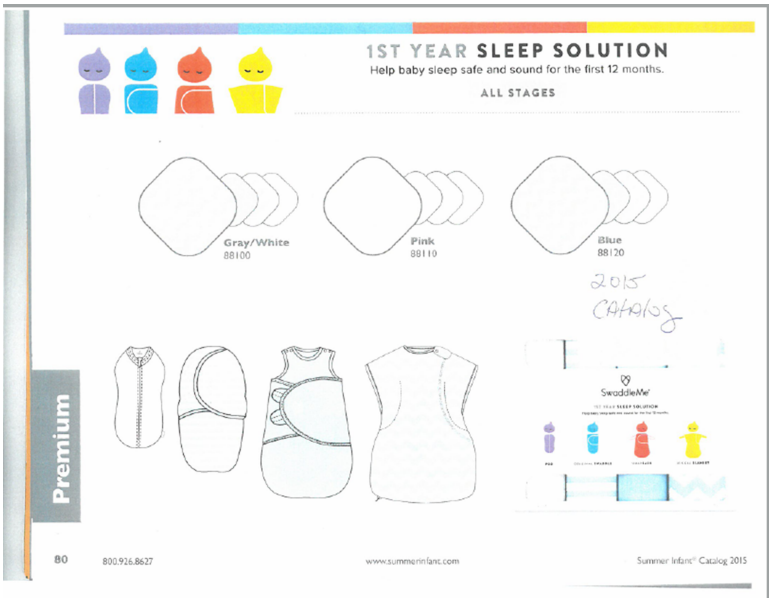
20. The SwaddlePod products sold by Summer Infant in 2014 that Karen Barski had alleged to be infringing are substantially the same as the Swaddle Pod product that is among the Accused Products.

21. The Swaddle Pod product design has not been materially changed since Karen Barski's first asserted that it infringed the '364 patent in 2014.

22. The following image depicts a page from Summer Infant's 2014 product catalog, showing the SwaddlePod product then offered for sale:



23. The following image depicts a page from Summer Infant's 2015 product catalog, showing the SwaddlePod product then offered for sale:



24. The following image depicts a page from Summer Infant's 2017 product catalog, showing the SwaddlePod product then offered for sale:

25. The following image depicts the SwaddleMe Pod currently for sale on the Amazon website, amazon.com (https://www.amazon.com/SwaddleMe-Pod-Medium-Little-Months/dp/B082XTSM8C), which is one of the Accused Products:

26. In response to her allegation that the SwaddlePod product infringed the ’364 patent, in 2015, Summer Infant, through counsel, advised Barski that it had considered her assertion, examined the products and the patent, and concluded that the products did not infringe Barski’s patent.

27. Barski did not respond to Summer Infant’s 2015 correspondence denying infringement.

28. Instead, two years later, Ms. Barski simply repeated her summary assertion of infringement, this time through the services of a law firm, which sent to Summer Infant a letter asserting infringement and threatening a lawsuit without any explanation for its infringement contentions, such as a claim chart. *See* Letter from Wendy W. Kraby to Mark Messner (Jan. 13, 2017), attached hereto as **Exhibit C**.

29. Notwithstanding the summary and unsupported nature of Barski’s repeated allegations, Summer Infant undertook a further review of the patent and the accused product and concluded that the accused patent did not, in fact, infringe any claim of the ’364 patent.

30. Summer Infant, though its counsel and via certified mail, thereafter again responded to Ms. Barski.

31. Summer Infant’s response, sent over five years ago on February 10, 2017, reiterated Summer Infant’s position that there was no infringement of the ’364 patent, and provided a detailed explanation as to the basis for that assertion. The response further explained that Summer Infant made and marketed its SwaddlePod garments under a patent licensed to it by Washington University, U.S. Pat. No. 6,393,612 (the “’612 patent”).

32. From February 10, 2017 until March 2, 2022, Barski was silent.

33. Throughout this time, from Barski's first assertion of patent infringement in 2014 until this year, Summer Infant has continually developed, marketed, and sold its SwaddleMe Products. Summer Infant has expended significant resources in product development, marketing, and sales for the SwaddleMe Products, and incurred and paid royalties on the '612 patent. These efforts were undertaken, in part, in reliance upon the fact that Barski did not dispute Summer Infant's conclusion that there was no infringement of the '364 patent.

34. From 2014 to 2022, Summer Infant grew the product line of the SwaddleMe Products and created a substantial market for such products in various channels of trade, including on the Amazon.com platform. These efforts were undertaken, in part, in reliance upon the fact that Barski did not dispute Summer Infant's conclusion that there was no infringement of the '364 patent.

35. For example, during the period after Summer Infant had denied infringement and while Barski remained silent, Summer Infant introduced the SwaddleMe Arms-Free Convertible Pod, one of the Accused Products, as can be seen, for example, by comparing Summer Infant's line of swaddling products in 2017, which can be seen at https://web.archive.org/web/20170719153545/https://summerinfant.com/nursery/swaddleme, with its current offerings, available at https://summerinfant.com/swaddles/swaddleme-stage-2?page=1.

36. An image of an exemplar of the accused SwaddleMe Arms-Free Convertible Pod is immediately below:

37. As a competitor in the infant swaddling garment field, Barski stands to gain considerable sales if it can prevent those sales being made by Summer Infant, sales that Barski would not have been able to make but for the actions of Summer Infant in creating the market for such products over the past eight years.

38. Taking advantage of this delay, on or about March 2, 2022, Barski issued a third cease and desist demand to Summer Infant based on its assertion that the Accused Products infringed the ’364 patent.

39. Summer Infant sells the Accused Products through a variety of retail outlets, including on the Amazon website, www.amazon.com.

40. In the latest cease and desist demand, Barski informed Summer Infant that it had initiated a patent infringement claim with Amazon’s Utility Patent Neutral Evaluation Program (the “Amazon Claim”), alleging that the Accused Products infringed the ’364 patent and seeking immediate removal of the Accused Products from the Amazon website.

41. According to Amazon Utility Patent Evaluation Procedure, attached hereto as **Exhibit D**, “[i]f the Evaluator finds the Patent Owner is likely to prove that an Accused Product

infringes, Amazon will remove that Accused Product from www.amazon.com as soon as practicable, but generally within 10 business days of Amazon's receipt of the decision."

42. The '364 patent does not preclude Summer Infant's sales of the Accused Products for at least the following reasons.

- The Accused Products do not literally infringe any claim;
- The Accused Products do not infringe any claim under the doctrine of equivalents;
- The '364 patent is invalid; and
- The '364 patent is unenforceable, at least insofar as Summer Infant is concerned.

43. Because the Accused Products do not infringe any valid claim of the asserted patent, and furthermore because the patent may not, as a matter of law, be asserted against Summer Infant, Barski's attempt to use the '364 patent to have the Accused Products de-listed by Amazon is wrongful.

44. Summer Infant manufactures and sells the Accused Products.

45. According to the publicly available information from the United States Patent and Trademark Office concerning the ownership of the '364 patent, the '364 patent has been assigned to Barski.

46. On or about March 2, 2022, Barski informed Summer Infant, by letter from its counsel, that Summer Infant's sale of the Accused Products constitutes patent infringement under 35 U.S.C. § 271." *See* Letter from Joe Staley to Mark Messner (Mar. 2, 2022), attached hereto as **Exhibit E.**

47. On or about March 2, 2022, Barski demanded that Summer Infant "immediately cease, desist, and otherwise abandon its actions that violate and infringe [Barski's] various patents, including the '364 Patent. *See* **Exhibit E.**

48. On or about March 2, 2022, Barski demanded "a full accounting for all infringing products that Summer Infant has made, used, imported, sold, and/or offered for sale in the United States." *See* **Exhibit E.**

49. On or about March 2, 2022, Barski notified Summer Infant that it filed the Amazon Claim. *See* **Exhibit E.**

50. Upon information and belief, Barski decided to use the Amazon UPNEP process to assert her claims rather than bringing them in court because (1) the process is relatively inexpensive, and (2) the process virtually prohibits any defenses of invalidity and unenforceability.

51. The Amazon UPNEP process is essentially compulsory, because once a patentee, like Barski, invokes the process, an accused infringer, like Summer Infant, must participate or the accused products will be automatically de-listed by Amazon.

52. Upon information and belief, Barski understood the essentially compulsory nature of the Amazon UPNEP proceeding when it filed the Amazon Claim.

53. Upon information and belief, Barski has never performed a good faith analysis of the claims as applied to the Accused Products. Barski's assertions of patent infringement are therefore not well founded and lack the good faith basis in fact and law necessary to assert patent infringement in good faith.

54. Despite having fully "briefed" the question of literal infringement in the Amazon Claim, Barski has yet to articulate how required claim elements are to be found in the Accused Products.

COUNT I
DECLARATORY JUDGMENT OF NONINFRINGEMENT

55. Summer Infant incorporates by reference the allegations set forth above.

56. As a result of the acts described in the foregoing paragraphs, a substantial controversy of sufficient immediacy and reality exists to warrant the issuance of a declaratory judgment.

57. A judicial declaration is necessary and appropriate so that Summer Infant may ascertain its rights regarding the '364 patent.

58. Summer Infant is entitled to a declaration that it has not infringed the '364 patent.

COUNT II
DECLARATORY JUDGMENT OF INVALIDITY AND/OR UNENFORCEABILITY

59. Summer Infant incorporates by reference the allegations set forth above.

60. As a result of the acts described in the foregoing paragraphs, a substantial controversy of sufficient immediacy and reality exists to warrant the issuance of a declaratory judgment.

61. A judicial declaration is necessary and appropriate so that Summer Infant may ascertain its rights regarding the '364 patent.

62. Summer Infant is entitled to a declaration that one or more asserted claims of the '364 patent are invalid or otherwise unenforceable for failing to comply with the requirements of 35 U.S.C. § 1 *et seq.*, including, without limitation, §§ 101, 102, 103, and/or 112.

COUNT III
DECLARATORY JUDGMENT - EQUITABLE ESTOPPEL

63. Summer Infant incorporates by reference the allegations set forth above.

64. As a result of the acts described in the foregoing paragraphs, a substantial controversy of sufficient immediacy and reality exists to warrant the issuance of a declaratory judgment.

65. A judicial declaration is necessary and appropriate so that Summer Infant may ascertain its rights regarding the ’364 patent.

66. Summer Infant is entitled to a declaration that Barki is estopped from asserting claims related to the ’364 patent against Summer Infant.

COUNT IV
TORTIOUS INTERFERENCE

67. Summer Infant incorporates by reference the allegations set forth above.

68. At the time Barski filed the Amazon Claim, Summer Infant had a contractual and/or business relationship with Amazon.

69. At the time Barski filed the Amazon Claim, Barski was aware of Summer Infant’s contractual and/or business relationship with Amazon.

70. Barski intentionally interfered with Summer Infant’s contractual and/or business relationship by filing the Amazon Claim, knowing that it was estopped from bringing her claim in court.

71. Barski intentionally interfered with Summer Infant’s contractual and/or business relationship in order to stop Summer Infant from selling the Accused Products on Amazon’s website.

72. Summer Infant suffered damages as a result of Barski’s interference.

PRAYER FOR RELIEF

WHEREFORE, Summer Infant respectfully requests that this Court enter judgment in its favor and against Defendant, and that it grant Summer Infant the following relief:

(a) A judgment declaring that the Accused Products do not infringe any claim of the '364 patent;

(b) A judgment declaring that each asserted claim of the '364 patent is invalid or otherwise unenforceable;

(c) Temporary, preliminary, and permanent injunctive relief barring Barski from employing the Amazon UPNEP process to enforce the '364 patent against Summer Infant pending the outcome of this litigation;

(d) Monetary damages in an amount to be proven at trial;

(e) An award pursuant to 35 U.S.C. § 285 of Summer Infant's costs, expenses, and attorneys' fees incurred in this action;

(f) Pre- and post-judgment interest;

(g) Such other and further relief as this Court deems just and proper.

PLAINTIFF REQUESTS A TRIAL BY JURY ON ALL MATTERS SO TRIABLE.

Dated: May 13, 2022

Respectfully submitted,

PLAINTIFF SUMMER INFANT (USA), INC.
By its attorneys,

/s/ Jeffrey K. Techentin
Jeffrey K. Techentin [No. 6651]
jtechentin@apslaw.com
ADLER POLLOCK & SHEEHAN P.C.
One Citizens Plaza, 8th Floor
Providence, RI 02903
Tel: 401-427-6147
Fax: 401-351-4607