

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK**

NANOBEBE US INC.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 1:23-cv-10075
)	
MAYBORN (UK) LIMITED, MAYBORN)	JURY TRIAL DEMANDED
USA, INC., MAYBORN GROUP)	
LIMITED,)	
)	
Defendants.)	

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Nanobebe US Inc. (“Plaintiff” or “Nanobebe”), for its Complaint against Defendants Mayborn (UK) Limited (“Mayborn UK”), Mayborn USA, Inc. (“Mayborn USA”), and Mayborn Group Limited (“Mayborn Group”) (collectively “Mayborn”) seeking declaratory judgments of non-infringement and unenforceability of U.S. Patent No. 11,730,680 (“’680 patent” or “Asserted Patent”), alleges as follows:

NATURE OF THE ACTION

1. This is an action arising under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, seeking a declaratory judgment of non-infringement and unenforceability of the Asserted Patent and for such other relief as the Court deems just and proper.

2. A true and correct copy of the Asserted Patent is attached as Exhibit 1.

THE PARTIES

3. Plaintiff Nanobebe is a corporation organized and existing under the laws of Delaware, with its principal place of business at 1030 Jenkins Road, Suite A, Charleston, South Carolina 29407.

4. Nanobebe is a wholly owned subsidiary of Nutrits Ltd. (“Nutrits”), a company organized and existing under the laws of Israel.

5. Nanobebe sells specialized baby bottles winning awards and recognition for their innovative designs. For example, Nanobebe’s breast milk bottle was featured on the cover of Time Magazine for invention of the year in 2018. <https://time.com/collection/best-inventions-2018/5454467/nanobebe-breast-milk-bottle>. Nanobebe’s breast milk bottle is engineered to preserve nutrients in previously pumped breast milk when re-eating the breast milk in the bottle. <https://www.nanobebe.com/pages/the-science>. Nanobebe’s unique design includes a concave shape on the bottom of the bottle to spread pumped breast milk in a thin layer, allowing milk to cool or warm more quickly than traditional bottles. (*Id.*) A true and correct copy of images featuring Nanobebe’s breast milk bottle on the cover of Time Magazine is attached as Exhibit 2.

Nanobebe Breast Milk Bottle



Nanobebe bottle design protects nutrients in breast milk during re-heating

6. Nanobebe's silicone bottle was chosen by Parents Magazine as Best for Feeding in 2023. <https://www.parents.com/best-for-baby-2023-feeding-7372498>. Nanobebe's silicone bottle design ensures only silicone components, and not plastic parts, contact the milk. Nanobebe's unique collar configuration interacts with an internal silicone sleeve to create a continuous silicone surface area from the vessel to the aperture. A true and correct image featuring Nanobebe's silicone bottle as featured on Parents is attached as Exhibit 2.

Nanobebe Silicone Bottle



Nanobebe silicone bottle collar and nipple design provides continuous silicone surface area

7. Nanobebe's products have also been featured on national news outlets, including CNN, as well as multiple parenting and pregnancy websites, such as the BUMP, BabyCenter, Popsugar, Fatherly, and Scary Mommy. <https://www.nanobebe.com/pages/press-awards-articles>.

8. Nanobebe sells its baby products online and in traditional retail stores, including at Target, Walmart, and Meijer. In addition, Nanobebe sells its baby products through an online storefront at Amazon.com. <https://www.amazon.com/nanobebe/s?k=nanobebe>.

9. On information and belief, Defendant Mayborn UK is a corporation organized and existing under the laws of England and Wales, with its principal place of business at Mayborn House, Balliol Business Park, Benton Lane, Newcastle Upon Tyne, NE12 8EW, United Kingdom.

10. On information and belief, Mayborn UK is the assignee of the Asserted Patent.

11. On information and belief, Defendant Mayborn USA is a corporation organized and existing under the laws of the State of New York with its principal place of business at 1010 Washington Boulevard, Stamford, CT 06901.

12. On information and belief, Defendant Mayborn Group is a corporation organized and existing under the laws of England and Wales, with its principal place of business at Mayborn House, Balliol Business Park, Benton Lane, Newcastle Upon Tyne, NE12 8EW, United Kingdom.

JURISDICTION AND VENUE

13. This action arises under the Patent Laws of the United States, 35 U.S.C. §§ 1 *et seq.*, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202. This Court has subject matter jurisdiction over this matter pursuant to 28 U.S.C. 1331 and 1338(a).

14. An actual and justiciable controversy exists between Nanobebe and Mayborn as to the non-infringement of the Asserted Patent.

15. On October 21, 2021, Nanobebe filed a complaint for declaratory judgment of non-infringement in this Court seeking declaratory judgment of non-infringement as to U.S. Patent No. 10,952,930 (“the ’930 patent”), which is a related family member of the ’680 patent. *See Nanobebe US Inc. v. Mayborn (UK) Limited et al*, Case No. 1-21-cv-08444 (S.D.N.Y., Oct. 13, 2021) (“2021 SDNY Litigation”). A true and correct copy of the October 21, 2021 Complaint is attached as

Exhibit 4. The October 21, 2021 Complaint was accompanied by exhibits, including two claim charts provided by Mayborn to Nanobebe, accusing “Nanobebe Silicone Bottle” and “Nanobebe Plastic Bottle” of infringing certain claims of the ’930 patent. Exhibit 4 at Ex. 5.

16. On January 13, 2022, Mayborn filed an answer to the complaint in the 2021 SDNY Litigation, asserting counterclaims, including allegations that Nanobebe’s “Plastic Breastmilk Baby Bottle, Flexy Silicone Baby Bottle, and substantially similar products and components thereof” infringed claim 14 of the ’930 patent and claim 21 of the U.S. Patent No. 11,207,244 (“the ’244 patent”), another related family member of the ’680 patent. A true and correct copy of the January 13, 2022 Answer is attached as Exhibit 5.

17. The ’680 patent is a continuation of the ’244 patent, which, in turn, is a continuation of the ’930 patent. All three patents share an identical specification and drawings.

18. On August 10, 2023, Nanobebe received a notice from Mayborn of an infringement accusation relating to the ’680 patent (“August 10, 2023 notice”). The August 10, 2023 notice had the subject header “Mayborn/Nanobebe,” and stated that the Asserted Patent will issue on August 22, 2023. The August 10, 2023 notice was accompanied by two claim charts accusing “Nanobebe Silicone Bottle” and “Nanobebe Plastic Bottle” of infringing the Asserted Patent. A true and correct copy of the August 10, 2023 notice and related claim charts is attached as Exhibit 6.

19. On August 22, 2023, Mayborn filed a complaint against Nutrits, Nanobebe’s parent company, in the Eastern District of Texas alleging that products sold in the United States by Nanobebe, specifically, “Plastic Breastmilk Baby Bottle” and “Flexy Silicone Baby Bottle” (“Accused Products”) infringe claim 1 of the ’680 patent. *See Mayborn (UK) Ltd. f/k/a Jackel International Limited et al v. Nutrits Ltd.*, Case No. 2:23-cv-000378 (E.D. Tex., Aug. 22, 2023)

(the “EDTX Litigation”). A true and correct copy of the August 22, 2023 complaint is attached as Exhibit 7.

20. On information and belief, Mayborn filed that action against Nutrits, a foreign corporation, rather than Nanobebe, in an attempt to establish venue for its later filed patent infringement action in the Eastern District of Texas, rather than here in the first-filed venue, the Southern District of New York, even though: (1) the ‘680 patent is a continuation of the ‘244 and ‘930 parent patents already construed by this Court in the first-filed 2021 SDNY Litigation; and (2) Mayborn is asserting the ‘680 patent against identical products in both Districts, which are all Nanobebe’s products, and not Nutrits’ products.

21. In the EDTX Litigation, Mayborn raises substantially similar infringement allegations against the same products at issue in the 2021 SDNY Litigation (i.e., “Plastic Breastmilk Baby Bottle” and “Flexy Silicone Baby Bottle”). The “Plastic Breastmilk Baby Bottle” and “Flexy Silicone Baby Bottle” products are Nanobebe products as indicated by Mayborn’s own claim charts. (*See* Exhibit 6, e.g., titled “Nanobebe Plastic Bottle,” and “Nanobebe Silicone Bottle”.)

22. On September 6, 2023, Nanobebe received a notice of an infringement accusation (“September 6, 2023 notice”) through its Amazon message portal. The September 6, 2023 notice states that Amazon “received a report from a patent owner who believes the items listed at the end of this email infringe [the Asserted Patent].” The September 6, 2023 notice identified the allegedly infringed patent number as the Asserted Patent. In addition, the September 6, 2023 notice provided the contact information for the owner of the Asserted Patent as “Mayborn (UK) Limited,” “djaskoviak@mayborngroup.com.” The items listed include Nanobebe’s bottles having the following Amazon Standard Identification Numbers (“ASIN”): B08J3Y1ZFB, B0944BP43Y,

B08C5K4XTD, B09448HFXX, B0944B4549, B08C5HPRKJ, B09B85RCTN, B09QT4NWN1, B09NSGNJHG, B08J41KYH1, B08J44MZPF, B0944B2FK7, B09QT5LMDN, B0973PLRH1, B0973HR6YM, B0973JDZD8, B09B7W2ZXY, B07CXSBNM4, B07FS49DPD, B07CXSH82F.

A true and correct copy of the September 6, 2023 notice is attached as Exhibit 8.

23. On information and belief, “djaskoviak@mayborngroup.com” is the email of IP Counsel at Mayborn Group.

24. Accordingly, a definite and concrete dispute exists between Nanobebe and Mayborn regarding non-infringement of the Asserted Patent.

25. This Court has personal jurisdiction over Mayborn. Mayborn USA is incorporated in the State of New York, and therefore this Court has general personal jurisdiction over Mayborn USA.

26. In addition, this Court has general personal jurisdiction over Mayborn UK and Mayborn Group because Mayborn UK and Mayborn Group operate in concert with Mayborn USA. On information and belief, Mayborn Group is a global organization, having “regional commercial offices.” (Exhibit 9, <http://www.mayborngroup.com/>.) On information and belief, Mayborn Group’s regional commercial offices include Mayborn UK and Mayborn USA. (*Id.*) In addition, on information and belief, Mayborn UK’s, Mayborn Group’s, and Mayborn USA’s employees work in concert so that there is no corporate separation among the employees. For example, the September 6, 2023 notice from Amazon provided the “rights owner’s contact information” as IP Counsel for Mayborn Group. (See Exhibit 8.) Further, on information and belief, Mayborn UK and Mayborn Group operate in the same office. On information and belief, all Mayborn employees have email address “@mayborngroup.com.”

27. In view of the forgoing, general personal jurisdiction exists over Mayborn UK and Mayborn Group in this District because, on information and belief, Mayborn USA's corporate presence in the United States, including in this District, provides Mayborn UK and Mayborn Group with substantially all of the business advantages that it would otherwise enjoy if it conducted its business here through their own officers or paid agents. In addition, on information and belief, Mayborn USA is authorized to conduct business in the United States, including in this District, on behalf of Mayborn UK and Mayborn Group.

28. In the alternative, the Court has personal jurisdiction over Mayborn UK and Mayborn Group under Federal Rule of Civil Procedure 4(k)(2), because the claim for a declaratory judgment of noninfringement in this action arises under federal law, Mayborn UK and Mayborn Group are not subject to the jurisdiction of the courts of general jurisdiction of any state, and exercising jurisdiction over Mayborn UK and Mayborn Group is consistent with the United States Constitution.

29. Venue is proper as to Mayborn in this District pursuant to 28 U.S.C. § 1391. Mayborn USA is incorporated in the State of New York and therefore, venue is proper in this District pursuant to 28 U.S.C. § 1391. In addition, venue is proper as to Mayborn UK and Mayborn Group because they operate in concert with Mayborn USA. Venue is also proper in this District as to Mayborn UK and Mayborn Group pursuant to 28 U.S.C. § 1391 because, among other reasons, Mayborn UK and Mayborn Group are not residents in the United States and, thus, may be sued in any judicial district, including this one, pursuant to 28 U.S.C. § 1391(c)(3). *See In re HTC Corp.*, 889 F.3d 1349, 1357 (Fed. Cir. 2018) (“The Court’s recent decision in *TC Heartland* does not alter” the alien-venue rule).

30. Mayborn consented to personal jurisdiction and venue in this Court in connection with the earlier filed 2021 SDNY Litigation. *See* Case. No. 1:21-cv-08444-JLR at Dkt. 25, ¶¶ 30-31. Mayborn also filed counterclaims in this Court in that earlier filed case. *See id.* at 11-21.

THE ASSERTED PATENT

31. The '680 patent is titled "Baby Bottle with Flexible Nipple Regions." (Exhibit 1.) The '680 patent issued on August 22, 2023, from U.S. Patent Application No. 17/562,519, filed on December 27, 2021, to named inventors Arnold Rees, Ian Webb, Mark Armstrong and Tom Cotton.

32. On information and belief, the '680 patent is assigned to Mayborn UK.

FIRST CLAIM FOR RELIEF

(Declaratory Judgment of Non-Infringement of the '680 patent)

33. Nanobebe restates and realleges each of the assertions set forth in the paragraphs above.

34. Nanobebe has not infringed and does not infringe any claim of the '680 patent directly or indirectly, either literally or under the doctrine of equivalents.

35. For example, and without limitation, claim 1 of the '680 patent requires: "wherein the nipple and collar together define a breast shape comprising a teat projecting from a domed configuration that extends outwardly and downwardly to a widest circumferential edge of the collar." Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the nipple and collar in each claim chart (Exhibit 6) do not "together define ... a domed configuration," as defined by the specification of the '680 patent.

36. In addition, for example, and without limitation, claim 1 of the '680 patent requires: "wherein the nipple and collar together define a breast shape comprising a teat projecting from a

domed configuration that extends outwardly and downwardly to a widest circumferential edge of the collar.” Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the nipple and collar in each claim chart (Exhibit 6) do not together “extend[] outwardly and downwardly to a widest circumferential edge of the collar,” as defined by the specification of the ’680 patent.

37. In addition, for example, and without limitation, claim 1 of the ’680 patent also requires: “wherein the flange extends from a substantially cylindrical lower portion of the base to define the outermost nipple circumference.” Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the “base” in each claim chart (Exhibit 6) does not have “a substantially cylindrical lower portion,” from which the flange extends, as defined in the specification of the ’680 patent.

38. In addition, for example, and without limitation, claim 16 of the ’680 patent also requires: “wherein the nipple and collar together define a breast shape having a domed configuration extending from the teat outwardly and downwardly to a widest circumferential edge of the collar.” Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the nipple and collar in each claim chart (Exhibit 6) do not together have “a domed configuration,” as defined by the specification of the ’680 patent.

39. In addition, for example, and without limitation, claim 16 of the ’680 patent requires: “wherein the nipple and collar together define a breast shape having a domed configuration extending from the teat outwardly and downwardly to a widest circumferential edge of the collar.” Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the nipple and collar in each claim chart

(Exhibit 6) do not together “extend[] from the teat outwardly and downwardly to a widest circumferential edge of the collar,” as defined by the specification of the ’680 patent.

40. In addition, for example, and without limitation, claim 16 of the ’680 patent also requires: “wherein the flange extends from a lower portion of the base to define the outermost nipple circumference.” Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the “base” in each claim chart (Exhibit 6) does not have “a lower portion,” from which the flange extends, as defined in the specification of the ’680 patent.

41. In addition, for example, and without limitation, claim 24 of the ’680 patent also requires: “wherein the nipple and collar together define a wide circular breast shape having a domed configuration extending outwardly and downwardly from the teat to a circumferential edge of the collar.” Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the nipple and collar in each claim chart (Exhibit 6) do not together have “a domed configuration,” as defined by the specification of the ’680 patent.

42. In addition, for example, and without limitation, claim 24 of the ’680 patent requires: “wherein the nipple and collar together define a wide circular breast shape having a domed configuration extending outwardly and downwardly from the teat to a circumferential edge of the collar.” Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the nipple and collar in each claim chart (Exhibit 6) do not together “extend[] outwardly and downwardly from the teat to a circumferential edge of the collar,” as defined by the specification of the ’680 patent.

43. In addition, for example, and without limitation, claim 24 of the '680 patent also requires: "wherein the flange extends circumferentially from a lower portion of the base." Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the "base" in each claim chart (Exhibit 6) does not have "a lower portion," from which the flange extends circumferentially, as defined in the specification of the '680 patent.

44. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Nanobebe and Mayborn concerning non-infringement of the '680 patent.

45. Nanobebe is therefore entitled to a declaratory judgment that it has not infringed the '680 patent, directly or indirectly, either literally or under the doctrine of equivalents.

SECOND CLAIM FOR RELIEF

(Declaratory Judgment of Unenforceability of the '680 patent Based Upon Inequitable Conduct)

46. Nanobebe restates and realleges each of the assertions set forth in the paragraphs above.

47. The '680 patent is unenforceable due to inequitable conduct before the USPTO by Mayborn, its patent counsel and/or its agent(s) and/or other person(s) involved in the preparation and prosecution of the application leading to the '680 patent.

48. Mayborn had a general duty of candor and good faith in its dealings with the USPTO. Pursuant to 37 C.F.R. § 1.56, Mayborn had an affirmative obligation to disclose to the USPTO all information that it knows to be material to the examination of its pending patent application. Mayborn's duty extends to its representatives, such as the attorneys, and all others substantially involved in the preparation and prosecution of the patent application.

49. The '680 patent is a continuation of the U.S. Patent Application No. 17/208,932, which issued as U.S. Patent No. 11,207,244 (“the '244 patent”), which, in turn, is a continuation of the U.S. Patent Application No. 14/551,783, which issued as U.S. Patent No. 10,952,930 (“the '930 patent”).

50. The patent applications that issued as the '680, the '244, and '930 patents all used the same firm of record, Fish & Richardson P.C. (“Prosecution Counsel”), for the prosecution of the patent applications that issued as the '680, the '244, and '930 patents.

51. On July 26, 2022, while the '680 patent was still in prosecution, Comotomo, Inc. filed petitions for *inter partes* review of the '244 patent (“Comotomo '244 IPR Petition”) and the '930 patent (“Comotomo '930 IPR Petition”) (collectively, “the Comotomo IPR Petitions”) at the U.S. Patent and Trademark Office before the Patent Trial and Appeal Board (“Board”).

52. On January 13, 2023, Nanobebe filed petitions for *inter partes* review of the '244 patent (“Nanobebe '244 IPR Petition”) and the '930 patent (“Nanobebe '930 IPR Petition”) (collectively, “the Nanobebe IPR Petitions”) at the U.S. Patent and Trademark Office before the Board.

53. Mayborn’s counsel on the Nanobebe IPR Petitions was the firm Fish & Richardson P.C. (“IPR Counsel”), the same firm of record for the prosecution of the '680, the '244, and '930 patents.

54. Mayborn and Prosecution Counsel did not disclose the Nanobebe Petitions to the Examiner who was examining the applications that issued as the '680 patent, and made no such disclosure at any time before issuance of a notice of allowance of the application that led to the '680 patent.

55. On April 11, 2023, Mayborn's Prosecution Counsel, Joshua Griswold from Fish & Richardson P.C., filed a Terminal Disclaimer listing the '244 patent, because the Examiner found that the claims of the '680 patent were not patentably distinct from the claims of the '244 patent.

56. On April 17, 2023, nearly three months after the filings of the Nanobebe Petitions, Mayborn's Prosecution Counsel, Joshua Griswold, filed an Information Disclosure Statement ("IDS") listing the Board's decisions regarding institution for the Comotomo Petitions, which were released on January 24, 2023. A true and correct copy of the April 17, 2023 IDS is attached as Exhibit 10.

57. In the IDS filed on April 17, 2023, Mayborn's Prosecution Counsel, Joshua Griswold, also listed a prior art reference (J.P. Pat. No. 2001299877 ("*Ishimaru*")) relied upon by the Nanobebe Petitions, but did not disclose or submit the Nanobebe Petitions.

58. On April 25, 2023 and May 16, 2023, a first and second Notice of Allowance was issued in connection with the application that resulted in the '680 patent.

59. On June 5, 2023, Mayborn's Prosecution Counsel, Joshua Griswold, filed an Information Disclosure Statement ("IDS") listing additional prior art references, but again did not submit the Nanobebe Petitions.

60. On June 14, 2023, a third Notice of Allowance was issued in connection with the application that resulted in the '680 patent.

61. On June 16, 2023, the Board issued Institution Decisions granting *Inter Parties* review of the Nanobebe Petitions of the '244 patent ("'244 Institution Decision") and the '930 patent ("'930 Institution Decision") (collectively, "the Nanobebe Institution Decisions").

62. On August 2, 2023, an Issue Notification was issued in connection with the application that resulted in the '680 patent, and on August 22, 2023, the '680 patent issued.

63. Neither Mayborn nor Prosecution Counsel provided copies of the Nanobebe Institution Decisions to the USPTO prior to issuance of the '680 patent, nor did the Examiner cite or consider the Nanobebe Institution Decisions before issuance of the '680 patent.

64. The Comotomo Institution Decisions are listed among the references cited on the face of the '680 patent, but the Nanobebe Petitions and Institution Decisions are not listed on the face of the '680 patent.

65. Mayborn and Prosecution Counsel did not submit the Nanobebe Institution Decisions to the USPTO in the manner prescribed by 37 C.F.R. §§ 1.97(b)-(d) and 1.98 prior to issuance of the '680 patent.

66. Pursuant to 37 C.F.R. § 1.56, Mayborn's Prosecution Counsel, including Joshua Griswold from Fish & Richardson P.C., had a general duty of candor and good faith in dealings with the USPTO, and affirmative obligation to disclose material information regarding the prosecution of the patent application that issued as the '680 patent.

67. The failure of Mayborn and Prosecution Counsel to disclose the Nanobebe Institution Decisions in accordance with 37 C.F.R. § 1.56 was done with a specific intent to deceive the USPTO, and was intended to prevent and did prevent withdrawal of the application that resulted in the '680 patent from issuance.

68. On information and belief, Mayborn and Prosecution Counsel selectively disclosed the Comotomo Petitions and Institution Decisions that were favorable to them, but selectively did not disclose the Nanobebe Petitions and Institution Decisions.

69. On information and belief, Mayborn's IPR Counsel at Fish & Richardson, was coordinating with Mayborn's Prosecution Counsel at Fish & Richardson, regarding strategy on the prosecution of the '680 patent. On information and belief, Mayborn's Prosecution Counsel at Fish

& Richardson was well aware of the Nanobebe Institution Decisions and made a deliberate decision to withhold those documents.

70. The Nanobebe Institution Decisions are material to patentability of the '680 patent. These documents are material for at least the following reasons: (i) the applicant filed a terminal disclaimer in the '680 patent application listing the '244 patent because the Examiner found that the claims of the '680 patent are not patentably distinct from the claims of the '244 patent; (ii) certain claim elements of the '680 patent independent claims are substantially similar to certain elements of the '244 and '930 patents' independent claims (i.e., see Exhibit 11 showing claim 1 of the '680 patent mapped against asserted independent claim 21 of the '244 patent, and asserted independent claim 14 of the '930 patent highlighting substantially similar claim elements in all three patents); and (iii) the Board's rationale in the Nanobebe Institution Decisions provides opinions that—if considered—would have led the USPTO to reject (and not issue) the claims of the '680 patent, as explained below. Accordingly, the claims of the '680 patent are more likely than not invalid for at least the reasons stated in the Nanobebe Institution Decisions, and this was known to Mayborn and both its Prosecution and IPR Counsel at Fish & Richardson.

71. If Mayborn and Prosecution Counsel had properly cited the Nanobebe Institution Decisions, and the related exhibits to the USPTO during the prosecution of the application that led to the '680 patent, the '680 patent would not have issued. The prior art relied upon by the Board in the Nanobebe Institution Decisions renders the claims of the '680 patent obvious. In fact, the entirety of the prosecution of the '680 patent application included only a single Office Action, in which no prior art was even applied by the USPTO. And the Board's rationale in the Nanobebe Institution Decisions provides opinions that—if considered—would have led the USPTO to reject (and not issue) the claims of the '680 patent, as explained below.

72. For example, there are substantial similarities between independent claim 1 of the '680 patent, and previously asserted independent claim 21 of the parent '244 patent. Regarding claim 21 of the '244 patent, the Board in their '244 Institution Decision summarized claim 21 as follows: "Upon review of the parties' arguments and supporting evidence, we determine on this record that Petitioner has shown a reasonable likelihood that claim 21 would have been obvious over Ishimaru and Kurkjian." Exhibit 12 ('244 Institution Decision) at 30. Regarding the similarities between claim 1 of the '680 patent and claim 21 of the '244 patent, both claims recite wherein the nipple and collar "together define" a "domed" configuration that "extends outwardly and downwardly" towards "a widest circumferential edge of the collar." Regarding this feature in claim 21 of the '244 patent, the Board indicated "[w]e are not persuaded by Patent Owner's repeated arguments that Kurkjian is a narrow nipple and bottle design and thereby cannot meet the dome shaped limitation as recited in claim 21." *Id.* at 25. Rather, "Petitioner identifies that Kurkjian has a nipple and collar design where 'the edge of the collar that has the widest circumference' and a sloping outer contour, thereby meeting the domed shape limitation." *Id.* "Suggesting that the design is intended to be shaped like a natural breast says nothing about the requisite width of the dome because breasts come in all shapes and sizes." *Id.* at 26. The Board further pointed out that "Kurkjian suggests that the outer face of the cap (i.e., collar) conforms to the contour of the nipple forming a streamline connection" and "[b]ased on these disclosures in Kurkjian, we agree with Petitioner that Kurkjian reasonably suggests a downward dome shape between the nipple and collar and provides motivation to ensure that the transition between the collar and the nipple follows the same contour as the nipple." *Id.* at 28.

73. There are also substantial similarities between independent claim 1 of the '680 patent, and independent claim 14 of the parent '930 patent. Regarding claim 14 of the '930

patent, the Board in their '930 Institution Decision summarized claim 14 as follows: "Upon review of the parties' arguments and supporting evidence, we determine on this record that Petitioner has shown a reasonable likelihood that claim 14 would have been obvious over Meyers in view of Sepehr." Exhibit 13 ('930 Institution Decision) at 41. Regarding the similarities between claim 1 of the '680 patent and claim 14 of the '930 patent, claim 1 of the '680 patent recites an "air vent" which "projects internally into the nipple below the teat," and claim 14 of the '930 patent recites an "air inlet valve (i) extending through said base [of the nipple], (ii) projecting downwardly from the base." Accordingly, claim 1 of the '680 patent is even broader than claim 14 of the '930 patent. Regarding this feature in claim 14 of the '930 patent, the Board indicated "[a]t this stage of the proceeding, Petitioner has shown a reasonable likelihood that Meyers, as modified based on the teachings of Sepehr, would satisfy the recited 'one-way air inlet valve [] extending through said base,' *id.* at 35, and 'projecting downwardly from the base portion.'" *Id.* at 36. Further, both claims recite "a flange" which extends from the "base." Regarding this feature, after analyzing Meyers and the Petition, the Board again found "[a]t this stage of the proceeding, Petitioner has shown a reasonable likelihood that Meyers teaches a 'flange depending from the base portion.'" *Id.* at 35.

74. The Board explained in both of the Nanobebe Institution Decisions rationale for why the prior art cited in the '244 and '930 Petitions renders the claims of the '680 patent obvious. In light of the above, had Mayborn and Prosecution Counsel properly cited the Nanobebe Institution Decisions, it is clear the '680 patent would not have issued.

75. Mayborn, and both their IPR and Prosecution Counsel at Fish & Richardson knew of their duty of candor and good faith in connection with prosecution of the '680 patent.

76. Mayborn, and both their IPR and Prosecution Counsel at Fish & Richardson breached their duty of candor and good faith before the USPTO in connection with prosecution of the '680 patent.

77. Mayborn, and both their IPR and Prosecution Counsel at Fish & Richardson knew the Nanobebe Institution Decisions were material to patentability of the '680 patent prior to issuance of the application that resulted in the '680 patent.

78. Mayborn, and both their IPR and Prosecution Counsel at Fish & Richardson colluded and acted with the specific intent to deceive the USPTO by failing to properly cite or disclose the Nanobebe Institution Decisions to the USPTO in accordance with 37 C.F.R. §1.56.

79. Nanobebe has no adequate remedy at law.

80. Accordingly, Nanobebe seeks a declaratory judgment that the '680 patent is unenforceable due to inequitable conduct.

PRAYER FOR RELIEF

WHEREFORE, Nanobebe respectfully request the following relief:

A. That the Court enter a judgment declaring that Nanobebe has not infringed and does not infringe any claim of the '680 patent, directly or indirectly, either literally or under the doctrine of equivalents;

B. That the Court enter a judgment declaring the '680 patent is unenforceable due to inequitable conduct;

C. That the Court enter preliminary and/or permanent injunctive relief against Mayborn, including without limitation to enjoin Mayborn from bringing or pursuing infringement claims asserting the '680 Patent against Nanobebe, Nutrits, or their affiliates in another venue, including the EDTX Litigation, *Mayborn (UK) Ltd. f/k/a Jackel International Limited et al v. Nutrits Ltd.*, Case No. 2:23-cv-00378;

D. That the Court enter a judgment that this is an exceptional case under 35 U.S.C. § 285 and award Nanobebe its costs, expenses, and reasonable attorneys' fees incurred in this action;

E. That the Court award Nanobebe any and all other relief to which Nanobebe may show itself to be entitled; and

F. That the Court award Nanobebe any other relief it may deem just and proper under the circumstances.

DEMAND FOR JURY TRIAL

Pursuant to Fed. R. Civ. P. 38(b), Nanobebe demands a trial by jury on all issues and claims so triable.

DATED: November 15, 2023

BAKER BOTTS L.L.P.

By: /s/ Robert L. Maier

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