

1 John C. Hueston, CA State Bar No. 164921
jhueston@hueston.com
2 Christina V. Rayburn, CA State Bar No. 255467
crayburn@hueston.com
3 HUESTON HENNIGAN LLP
620 Newport Center Dr., Ste 1300
4 Newport Beach, CA 92660
Telephone: (949) 226-6740
5 Facsimile: (888) 866-4825

6 *Attorneys for Plaintiffs Jacuzzi Brands LLC*
7 *and Jacuzzi Inc.*
8
9
10

11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF CALIFORNIA
13

14 JACUZZI BRANDS LLC and JACUZZI
INC.,
15 Plaintiffs,
16 vs.
17 BCI ACRYLIC, INC.,
18 Defendant.
19

Case No. 8:24-cv-674

**COMPLAINT FOR DECLARATORY
JUDGMENT**

DEMAND FOR JURY TRIAL

20
21 Plaintiffs Jacuzzi Brands LLC and Jacuzzi Inc. (together, “Jacuzzi”) bring this
22 suit against BCI Acrylic, Inc. (“BCI”), and allege as follows:

23 **INTRODUCTION**

24 1. For decades, Jacuzzi (and its related entities) has been a leading
25 manufacturer and distributor of premium wellness products, supported by unmatched
26 consumer awareness in hot tubs, swim spas, bath, shower, hydrotherapy, sauna,
27 massage, steam, and related products. Founded in 1915 by seven brothers in
28 Berkeley, California, Jacuzzi® is now a well-known, worldwide brand, known for

1 excellence and attention to detail. The company is the owner of the globally iconic
2 Jacuzzi® trademark and is the recognized inventor of in-home hydrotherapy.

3 2. Jacuzzi’s famous whirlpool baths were first developed in the 1960’s,
4 and are considered the first whirlpool baths designed for relaxation. Over time,
5 Jacuzzi’s products have grown in popularity and breadth. Jacuzzi now also markets
6 and sells products such as bathtub and shower fixtures, and designer wall paneling
7 for bathtubs and showers. Through a subsidiary, Jacuzzi also offers remodeling
8 services to help consumers update their homes to the luxury standard for which
9 Jacuzzi is known. Jacuzzi employs hundreds of individuals in the United States, and
10 close to forty in this District.

11 3. On January 22, 2024, Jacuzzi launched a new type of designer wall
12 paneling for bathtubs and showers: textured grout walls. Jacuzzi offers these
13 textured grout walls, in four different designs, in addition to the multiple Premium
14 and Signature Wall designs already offered by Jacuzzi. As part of its product launch,
15 Jacuzzi hosted a webinar for its dealers and shipped sales samples of its textured
16 grout product to its dealers. The webinar was hosted by Jacuzzi’s Group Product
17 Marketing Manager out of his home in Murrieta, California. In total, Jacuzzi sent
18 637 textured grout wall samples to its dealers.

19 4. On March 18, 2024, Jacuzzi received at its headquarters in Irvine,
20 California, a letter from a lawyer for BCI. That letter claims that BCI is in
21 possession “of a simulated tile wall manufactured and sold by” Jacuzzi. BCI’s letter,
22 dated March 5, 2024, accuses Jacuzzi of infringing U.S. Patent No. 10,144,243 (the
23 “’243 Patent”) “in connection with its shower remodeling service by using the
24 claimed method to create its simulated tile walls.” The letter further demands that
25 “Jacuzzi immediately cease and desist all activities that infringe on the ’243 Patent,
26 including but not limited to the manufacturing [of] its simulated tile walls by using a
27 computer-controlled material removal tool to form grout lines.”
28

1 5. BCI’s infringement accusation is baseless. The claims of the ’243
2 Patent are method claims, directed to *a way* of manufacturing a simulated tile sheet
3 for a shower wall. BCI’s letter makes clear that its investigation to date has solely
4 consisted of looking at a Jacuzzi product sample. From that sample, BCI has no way
5 of knowing whether Jacuzzi manufactures its products according to BCI’s claimed
6 method. And indeed Jacuzzi does not.

7 6. Jacuzzi therefore brings this action for declaratory judgment of non-
8 infringement in this District to seek a full and final resolution of BCI’s patent
9 infringement allegations against it.

10 **NATURE OF THE ACTION**

11 7. Jacuzzi seeks a declaration that the development, manufacturing, use,
12 sale, promotion, and related activities of its textured grout wall products, and any and
13 all Jacuzzi products substantially similar thereto, do not infringe the ’243 Patent.

14 **THE PARTIES**

15 8. Plaintiff Jacuzzi Brands LLC is a Delaware company with a principal
16 place of business at 17872 Gillette Ave, Ste. 300, Irvine, California, 92614-6573.

17 9. Plaintiff Jacuzzi Inc. is a corporation organized under the laws of
18 Delaware with a principal place of business at 17872 Gillette Ave, Ste. 300, Irvine,
19 California, 92614-6573.

20 10. On information and belief, defendant BCI is a corporation organized
21 under the laws of Illinois with a principal place of business at 1800 Industrial Dr.,
22 Libertyville, Illinois, 60048.

23 11. BCI purports to be the owner of the ’243 Patent. BCI further purports
24 that it uses the method claimed in the ’243 Patent “in conjunction with its bath
25 renovation products and services.”

26 **JURISDICTION AND VENUE**

27 12. This Complaint arises under the Patent Laws of the United States, 35
28 U.S.C. § 100 *et seq.*, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and

1 2202, based upon an actual controversy between the parties with respect to the '243
2 Patent. As described in more detail below, an actual, justiciable, immediate and
3 substantial controversy exists because BCI contends Jacuzzi infringes claims of the
4 '243 patent, and Jacuzzi denies infringement.

5 13. The Court has subject matter jurisdiction over this action pursuant to 28
6 U.S.C. §§ 1331 and 1338(a).

7 14. The Court has specific personal jurisdiction over BCI because: (1) BCI
8 has purposefully directed activities at residents of this District; (2) this request for
9 declaratory judgment of non-infringement arises out of or relates to BCI's activities
10 in this District; and (3) assertion of personal jurisdiction in this District is reasonable
11 and fair.

12 15. BCI purposefully directs numerous activities at this District, including
13 the following.

14 16. On July 17, 2020, counsel for BCI sent a cease-and-desist letter to
15 Jacuzzi's then-headquarters in Chino Hills, California, as well as to CT Corporation
16 in Los Angeles, California, accusing Jacuzzi of violating the Lanham Act.

17 17. On March 5, 2024, a different attorney for BCI sent a cease-and-desist
18 letter accusing Jacuzzi of infringing the '243 Patent to the Chief Legal Officer of
19 Jacuzzi at Jacuzzi's headquarters in Irvine, California. This letter appears to be part
20 of a broader campaign that BCI has initiated to enforce the '243 patent against
21 companies across the country. BCI has previously filed at least two cases alleging
22 infringement of the '243 Patent. Upon information and belief, the defendants in
23 those suits sell products in California.

24 18. As the basis for its infringement claims, BCI's March 5, 2024 letter
25 referenced (and included a photo of) a sample of a tile wall allegedly "manufactured
26 and sold by Jacuzzi Inc. and/or Jacuzzi Group Worldwide." The sample in BCI's
27 March 5, 2024 letter is a sales sample of a new product, Jacuzzi's Textured Grout
28

1 Subway wall paneling, that Jacuzzi shipped to its customers including to a customer
2 in Irwindale, California.

3 19. BCI is registered to do business in the State of California.

4 20. BCI maintains an expansive sales and distribution network within
5 California and this District related to products that, upon information and belief, are
6 covered by the '243 Patent. Specifically, BCI's March 5, 2024 letter claims that
7 "BCI uses the method claimed in the patent in conjunction with its bath renovation
8 products and services." On information and belief, BCI's "bath renovation products
9 and services" are sold under multiple brands, including the brands "Bath Planet" and
10 "Luxury Bath." Bath Planet brand products are sold by licensed dealers at a
11 minimum of eight locations across California, including at "Bath Planet of South
12 OC." And BCI's Luxury Bath products are also sold by dealers across California
13 and in this District, including at "Luxury Bath of Orange County" (Irvine) and
14 "Luxury Bath of Pacific Coast" (Valencia). On information and belief, BCI is highly
15 engaged with its dealers, providing them trainings, advertising materials, and other
16 assistance in the marketing and sales of BCI products, including products covered by
17 the '243 Patent.

18 21. Through its licensed distributors, BCI's sales and distribution network is
19 actively expanding within California and this District. For instance, BCI's licensed
20 distributors maintain active postings for sales representative, brand ambassador, and
21 installer positions on popular job search websites such as ZipRecruiter and Indeed
22 that, upon information and belief, appear to be related to sales of products covered by
23 the '243 Patent.

24 22. BCI's privacy policy includes individual requests for California
25 customers.

26 23. Upon information and belief, BCI has employed a Western U.S.
27 regional sales manager in this District for at least 12 years.
28

1 27. When the '864 Application was filed on February 18, 2016, the first
2 claim in that application read as follows:

3 A method of manufacturing a tile sheet for a shower wall enclosure
4 comprising the steps of:

- 5 a. designing a tile pattern and storing it digitally in a database in a
6 computer controlled material removal tool;
- 7 b. selecting a sheet of acrylic material;
- 8 c. placing the sheet of acrylic material below the material removal
9 tool;
- 10 d. retrieving the stored tile pattern from the database; and
- 11 e. forming the tile pattern in the sheet of acrylic material by means
12 of the computer controlled material removal tool following the
13 tile pattern stored in the database.

12 28. On February 6, 2018, the patent examiner rejected all pending claims of
13 the '864 Application, including Claim 1, above. As to Claim 1, the examiner
14 rejected it as invalid under 35 U.S.C. § 101 “because the claimed invention is
15 directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an
16 abstract idea) without significantly more.” The examiner also rejected Claim 1 as
17 invalid under 35 U.S.C. § 102, explaining that it was “anticipated” by an earlier
18 patent, U.S. Patent Number 5,568,391 to Mckee.

19 29. Thereafter, BCI revised the claims of the '864 Application. As of June
20 4, 2018, BCI's new Claim 1 read as follows:

21 A method of manufacturing a simulated tile sheet for a shower
22 wall enclosure comprising the steps of:

- 23 a. determining a first set of tile pattern characteristics comprising
24 the steps of:
- 25 i. determining a first set of tile shapes,
- 26 ii. determining an orientation of the first set of tile shapes
27 on the simulated tile sheet;
- 28 iii. determining a first set of tile dimensions,
- iv. determining a depth of cut in the simulated tile sheet,

- 1 b. entering the first set of tile pattern characteristics into a
- 2 computer and storing the first set of tile pattern characteristics
- 3 digitally in a database in a computer controlled material
- 4 removal tool;
- 5 c. selecting a first sheet of acrylic material based on the first set of
- 6 tile pattern characteristics, the first sheet of acrylic material
- 7 having a top displayed surface;
- 8 d. placing the first sheet of acrylic material below the computer
- 9 controlled material removal tool;
- 10 e. retrieving the first set of tile pattern characteristics stored in the
- 11 database; and
- 12 f. forming a first set of grout lines by removing from the top
- 13 displayed surface of the first sheet of acrylic material by means
- 14 of the computer controlled material removal tool a first
- 15 predetermined amount of material based on the first set of tile
- 16 pattern characteristics to create the first set of tile pattern
- 17 characteristics in the first sheet of acrylic material.

18 30. Claim 1 later issued in that form. *See* Ex. 1 at Claim 1. All other claims
19 of the '243 Patent depend upon Claim 1. *Id.* at Claims 2-7.

20 **Jacuzzi's Product Launch and BCI's Cease-and-Desist Letter**

21 31. On January 22, 2024, Jacuzzi launched a new type of designer wall
22 paneling for bathtubs and showers: textured grout walls.

23 32. On March 5, 2024, an attorney sent a letter to Jacuzzi on behalf of BCI.
24 Jacuzzi received that letter via certified mail on March 18, 2024. A true and correct
25 copy of that letter is attached hereto as **Exhibit 2**. The letter is addressed to Jacuzzi's
26 headquarters in Irvine, which is a city in this District. Ex. 2 at 1.

27 33. In that letter, BCI claimed to be the "owner of United States Patent No.
28 10,144,243," and attached a copy of the patent. *Id.* at 1; *see also id.* at Ex. A.

34. In the letter, BCI further stated that it was "in receipt of a sample of a
simulated tile wall manufactured and sold" by Jacuzzi, "as well as the advertisement
attached hereto as Exhibit B." Ex. 2 at 1. The advertisement attached to the letter

1 depicts Jacuzzi's Textured Grout Subway shower wall paneling. *See id.* at Ex. B.
2 Activities relating to this advertising occurred in this District.

3 35. BCI's letter further stated that the materials it had reviewed "indicate
4 that Jacuzzi is infringing the '243 Patent in connection with its shower remodeling
5 service by using the claimed method to create its simulated tile walls." Ex. 2 at 1.

6 36. BCI then "demand[ed] that Jacuzzi immediately cease and desist all
7 activities that infringe on the '243 Patent, including but not limited to the
8 manufacturing [of] its simulated tile walls by using a computer-controlled material
9 removal tool to form grout lines." *Id.*

10 37. BCI's letter demanded "a written response within 14 calendar days
11 indicating that Jacuzzi will cease and desist its infringing activities." *Id.*

12 **Jacuzzi Does Not Infringe The '243 Patent**

13 38. Jacuzzi's method of manufacturing its textured grout wall paneling
14 products does not infringe the '243 Patent. At the very least, Jacuzzi's method of
15 manufacturing does not involve "selecting a first sheet of acrylic material based on
16 [a] first set of tile pattern characteristics." Jacuzzi's selection of sheets of acrylic
17 material is not based on any "tile pattern characteristics," but instead is based simply
18 on the size of acrylic sheet needed for the bathroom installation. Accordingly,
19 Jacuzzi seeks a judicial declaration that it does not directly or indirectly infringe any
20 claim of the '243 Patent, literally or under the doctrine of equivalents.

21 39. An actual and justiciable controversy exists between Jacuzzi and BCI
22 regarding Jacuzzi's non-infringement of the '243 Patent. BCI has accused Jacuzzi of
23 infringing the '243 Patent by "using the claimed method to create its simulated tile
24 walls," and Jacuzzi maintains that the creation of its simulated tile walls does not
25 infringe the '243 Patent.

26 **FIRST CAUSE OF ACTION**

27 **Declaratory Judgment of Non-Infringement of the '243 Patent**

28 40. Jacuzzi hereby incorporates by reference its allegations contained in

1 paragraphs 1 through 39 of this Complaint as if fully set forth herein.

2 41. Jacuzzi does not directly, contributorily, or by inducement, infringe any
3 claims of the '243 Patent, either literally or under the doctrine of equivalents.

4 42. The manufacture, importation, use, sale, or offer for sale of Jacuzzi's
5 textured grout wall paneling products does not directly infringe, contributorily
6 infringe, or induce infringement of any claims of the '243 Patent, either literally or
7 under the doctrine of equivalents.

8 43. As set forth above, an actual controversy exists between Jacuzzi and
9 BCI concerning Jacuzzi's non-infringement of the '243 Patent. Absent a declaration
10 of non-infringement, BCI will continue to wrongfully assert the '243 Patent against
11 Jacuzzi, in violation of the laws and contrary to public policy, and will thereby cause
12 Jacuzzi injury and damage. A judicial determination is necessary and appropriate at
13 this time so that the parties may ascertain their respective rights and obligations with
14 respect to the '243 Patent and any past, present, or future manufacture, use,
15 importation, distribution, sale, or offer for sale of the Jacuzzi's textured grout
16 products.

17 44. Accordingly, Jacuzzi seeks and is entitled to a judgment against BCI
18 that Jacuzzi's textured grout products, as well as any other Jacuzzi products that are
19 not colorably different therefrom, have not infringed and do not infringe (directly,
20 indirectly, contributorily, or by inducement) any claim of the '243 Patent.

21 **PRAYER FOR RELIEF**

22 WHEREFORE, Jacuzzi requests the following relief:

- 23 1. A judgment and declaration that Jacuzzi has not infringed and does not
24 infringe, either directly or indirectly, any claim of the '243 Patent;
- 25 2. A permanent injunction against BCI and its affiliates, subsidiaries,
26 assigns, employees, agents, or anyone acting in privity or concert with BCI from
27 alleging infringement or instituting any legal action for infringement of the '243
28 Patent or any related patents against Jacuzzi or anyone acting in privity with

1 Jacuzzi, including the divisions, successors, assigns, agents, suppliers,
2 manufacturers, contractors, integrators, and customers of Jacuzzi, for alleged
3 infringement relating to Jacuzzi’s textured grout products, or products not colorably
4 different therefrom;

5 3. A judgment and declaration that this action is an exceptional case and
6 awarding Jacuzzi reasonable attorneys’ fees pursuant to 35 U.S.C. § 285; and

7 4. A judgment for such other and further relief in law or equity as this
8 Court deems just or proper.

9 **JURY DEMAND**

10 Pursuant to Federal Rule of Civil Procedure 38(b), Jacuzzi hereby demands a
11 trial by jury on all issues so triable.

12
13 Dated: March 28, 2024

HUESTON HENNIGAN LLP

14
15 By: /s/ John C. Hueston

16 John C. Hueston
jhueston@hueston.com
17 Christina V. Rayburn
crayburn@hueston.com
18 HUESTON HENNIGAN LLP
620 Newport Center Dr., Ste 1300
19 Newport Beach, CA 92660
Telephone: (949) 226-6740
20 Facsimile: (888) 775-0898

21 *Attorneys for Plaintiffs*
22 *JACUZZI BRANDS LLC and*
23 *JACUZZI INC.*