

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
WESTERN DIVISION**

PREMIERE CONCRETE)
ADMIXTURES LLC,)
)
Plaintiff,)
)
v.)
)
E5 INCORPORATED)
)
Defendant.)
)
)

COMPLAINT AND JURY DEMAND

Plaintiff Premiere Concrete Admixtures LLC, by and through its undersigned attorneys,
hereby brings its Complaint against Defendant E5 Incorporated and alleges as follows:

NATURE OF THE ACTION

1. This is a declaratory judgment action pursuant to the Declaratory Judgment Act, under 28 U.S.C. §§ 2201-2202 and the Patent Laws of the United States, 35 U.S.C. § 1 *et seq.*, for a declaration that U.S. Patent No. 11,279,658 (“the ‘658 Patent”; Ex. 1) as modified by the Reexamination Certificate (Ex. 8) is invalid and unenforceable, a declaration that U.S. Patent No. 11,919,823 (“the ‘823 Patent”; Ex. 2) is invalid and unenforceable, a declaration of non-infringement by Plaintiff of the ‘658 Patent as modified by the Reexamination Certificate, and a declaration of non-infringement by Plaintiff of the ‘823 Patent.

2. This is also a civil action arising under the laws of the United States, specifically under 35 U.S.C. § 292, for false marking, brought by a person who has suffered a competitive injury as a result of the false marking.

3. This is also a civil action arising under the laws of the United States, specifically under 15 U.S.C. § 1125(a), for false advertising, brought by a person who believes that he or she is or is likely to be damaged by such act.

PARTIES

4. Plaintiff is a limited liability company organized in the state of Delaware and having its principal place of business at 508 Cedar St., Pioneer, Ohio.

5. Plaintiff is a concrete admixture company operating a manufacturing facility in Pioneer, Ohio. Plaintiff develops, manufactures, and sells an extensive line of concrete admixtures including, but not limited to, accelerators, air entrainments, high range water reducers, low range water reducers, mid-range water reducers, and retarders.

6. Plaintiff provides concrete admixtures for construction projects throughout Ohio, including for bridge decks as permitted by the Ohio Department of Transportation.

7. Plaintiff sells concrete admixture products to Ready-mix concrete producers, pavers, and precast producers who create concrete mixtures in transit or at their locations by mixing Plaintiff's admixture products with other components of concrete and then deliver the mixed concrete to construction sites.

8. Plaintiff is not a contractor engaged in the business of mixing and pouring concrete at a construction site.

9. Defendant E5 Incorporated is a for-profit corporation incorporated in the state of Delaware in 2023 and having a principal place of business at 1718 Pleasant Street, Noblesville, IN 46060.

10. On information and belief, Defendant E5 Incorporated is a successor company, and/or alter ego, of Specification Products, Inc. ("SPI"), which is a for-profit corporation incorporated in the state of Indiana and having a principal place of business at 1718 Pleasant Street, Noblesville, IN 46060.

11. According to the assignment records of the United States Patent and Trademark Office ("USPTO"), Defendant is the current assignee of the '658 Patent, having been assigned the interests of Specification Products, Inc. in the '658 Patent who, in turn, had been assigned the interests of the inventors. (Ex. 3.)

12. According to the assignment records of the USPTO, Defendant is the current assignee of the '823 Patent, having been assigned the interests of Specification Products, Inc. in the '823 Patent who, in turn, had been assigned the interests of the inventors. (Ex. 3.)

13. Defendant operates the website located at <https://www.e5nanosilica.com>, formerly located at <https://poure5.com>, and formerly located at <https://specificationproducts.com> ("Defendant's website").

14. Defendant operates the LinkedIn page located at <https://www.linkedin.com/company/e5nanosilica> (“Defendant’s LinkedIn page”).

15. Defendant operates the Facebook page located at <https://www.facebook.com/e5nanosilica/> (“Defendant’s Facebook page”).

16. Defendant sells a line of concrete admixture products in connection with the trademark E5®, including E5® Internal Cure, E5® Liquid Fly Ash, E5® Daily Restore, E5® Miracle Aid, and E5® ShotCure.

17. Defendant has sold its E5® concrete admixture products to customers in Ohio.

18. Defendant has provided concrete admixtures for bridge deck replacements in Ohio, including but not limited to the U.S. 127 bridge over the Maumee River, in this District.

19. On information and belief, all of Defendant’s E5® products include amorphous silica.

20. Defendant, including through its predecessor company SPI, has filed numerous patent applications with the USPTO, and has obtained issued U.S. patents, which purport to claim processes of using amorphous silica, and which describe at least one its E5® products as an example product containing amorphous silica. By way of example and without limitation, the ‘658 Patent states that “E5 INTERNAL CURE . . . from Specification Products” is a commercially available additive “which contains about 15 wt% amorphous silica in about 85 wt% water” with the silica particles having “an average particle size of less than about 10 nm” and having “a surface area of about 550 m²/g.” (See Ex. 1, column 8, lines 46-52.)

JURISDICTION AND VENUE

21. An actual and justiciable controversy exists between Plaintiff and Defendant as to the invalidity and unenforceability of the ‘658 Patent and the ‘823 Patent.

22. An actual and justiciable controversy exists between Plaintiff and Defendant as to whether Plaintiff has infringed or is infringing, directly or indirectly, any claim of the '658 Patent as modified by the Reexamination Certificate or the '823 Patent.

23. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a) because this action arises, *inter alia*, under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and relates to patents.

24. The Court also has subject matter jurisdiction over this action because Plaintiff's claims under 35 U.S.C. § 292 and 15 U.S.C. § 1125(a) arise under the laws of the United States.

25. This Court has personal jurisdiction over Defendant at least because of Defendant's continuous and systematic contacts with the State of Ohio which include, but are not limited to, providing concrete admixtures for bridge deck replacements in Ohio, such as the U.S. 127 bridge over the Maumee River, in this District.

26. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b)(2). A substantial part of the events or omissions giving rise to this action occurred in this District. By way of example and without limitation, Defendant has alleged in a Cease and Desist Letter (Ex. 4) that Plaintiff has engaged in activities which infringe the '658 Patent and the '823 Patent, namely, by selling Plaintiff's ULTRAFINISH 1L™ product and instructing use thereof. Plaintiff produces its concrete admixtures, including its ULTRAFINISH 1L™ product, and principally conducts its business, in Pioneer, Ohio, which is in this District.

27. Defendant's Cease and Desist Letter (Ex. 4) was sent by Defendant's counsel to Plaintiff's principal place of business in Pioneer, Ohio, which is in this District.

FACTS AND ALLEGATIONS COMMON TO ALL CLAIMS FOR RELIEF

28. Defendant has provided concrete admixtures for numerous construction projects in

Ohio as permitted by the Ohio Department of Transportation. These include bridge deck projects, such as for the U.S. 127 bridge over the Maumee River.

29. The '658 Patent as modified by the Reexamination Certificate claims a process of making a concrete installation, where the method involves, *inter alia*, creating a mix with a quantity of amorphous nanosilica having certain parameters, namely, an average particle size in the range of from about 1 to about 55 nanometers and/or an amorphous silica surface area in the range of from about 300 to about 900 m²/g.

30. The '823 Patent claims a process for the preparation of a concrete mixture in a Ready-mix, where the process involves, *inter alia*, creating a concrete mix from components in the Ready-mix where said components include a quantity of amorphous silica having the same certain parameters as recited in the independent claims of the '658 Patent, namely, an average particle size in the range of from about 1 to about 55 nanometers and/or an amorphous silica surface area in the range of from about 300 to about 900 m²/g.

31. The '823 Patent also claims a process for the preparation of a concrete installation where the process involves, *inter alia*, creating a concrete mix from components comprising a quantity of amorphous silica having the same certain parameters as recited in the independent claims of the '658 Patent, namely, an average particle size in the range of from about 1 to about 55 nanometers and/or an amorphous silica surface area in the range of from about 300 to about 900 m²/g.

32. In 2023, Plaintiff began selling a concrete admixture product which contains colloidal silica, under the trademark ULTRAFINISH 1L™.

33. Defendant's counsel sent a letter (the "Cease and Desist Letter") to Plaintiff dated April 3, 2024 in which Defendant's counsel identified the '658 Patent and the '823 Patent,

identified Plaintiff's ULTRAFINISH 1L™ product, and stated “we believe that Premiere is selling products and instructing their use in a manner which infringes the Patents, including at least claim 1 of the ‘823 Patent.” (Ex. 4.) The Cease and Desist Letter further “demand[ed] that Premiere refrain from marketing and selling any nano-silica based concrete admixtures that infringe”, and requested confirmation within 10 days of the date of the Cease and Desist Letter of Plaintiff's “intent to ensure that Premiere products do not, directly or indirectly, infringe upon E5 intellectual property rights.”

34. Through the Cease and Desist Letter, Defendant placed Plaintiff in reasonable apprehension of an imminent suit for patent infringement.

35. Defendant has indicated on at least Defendant's website and Defendant's LinkedIn profile that its E5® products are “patented products” and a “patented system” when, in fact, they are not.

36. Plaintiff has been damaged, and has suffered a competitive injury, as a result of Defendant's false marking of its E5® products as “patented products” and a “patented system”.

37. Defendant has promoted one of its concrete admixture products under the INTERNAL CURE® mark as providing internal curing, when in fact, Defendant's predecessor-in-interest SPI admitted to the USPTO that its admixture product sold under the INTERNAL CURE® mark does not “contain or execute internal curing”.

38. Plaintiff has been damaged by Defendant's false advertising with the INTERNAL CURE® mark.

The ‘658 Patent

39. The ‘658 Patent was issued from United States Application No. 16/501,232, which was filed by Defendant's predecessor-in-interest SPI on March 8, 2019.

40. The '658 Patent claims priority to three provisional applications, namely, U.S. Provisional Application No. 62/761,064 filed on March 9, 2018, U.S. Provisional Application No. 62/761,393 filed on March 22, 2018, and U.S. Provisional Application No. 62/765,597 filed on September 1, 2018. Therefore, the earliest possible effective filing date the '658 Patent may be entitled to is March 9, 2018.

41. The claims of the '658 Patent – both originally and as modified by the Reexamination Certificate – all require, *inter alia*, “a quantity of amorphous silica . . . wherein the average silica particle size is in the range of from 1 to 55 nanometers and/or wherein the surface area of the silica particles is in the range of from about 300 to about 900 m²/g”.

42. Plaintiff, anonymously through counsel, filed a Request for *Ex Parte* Reexamination of the '658 Patent with the United States Patent and Trademark Office (“USPTO”) on June 1, 2023 (“Plaintiff’s Request”). (Ex. 5.)

43. The USPTO agreed that Plaintiff’s Request raised a substantial new question of patentability with respect to the '658 Patent and therefore granted Plaintiff’s Request (Ex. 6) and subsequently conducted a reexamination of the '658 Patent.

44. During the reexamination of the '658 Patent, the USPTO rejected all claims of the '658 Patent as failing to be novel and/or non-obvious over the prior art. (Ex. 7.)

45. In response to the rejections by the USPTO in the reexamination of the '658 Patent, Defendant’s predecessor-in-interest SPI (the then-assignee of the '658 Patent) ultimately amended all the claims of the '658 Patent in order to overcome the rejections. (Ex. 21.)

46. As a result of SPI’s amendments, the reexamination of the '658 Patent resulted in all the claims of the '658 Patent being limited by one of two additional limitations, namely, either a limitation reciting “wherein the amorphous silica is dispersed in the concrete mix without using

a superplasticizer” or a limitation reciting “wherein the concrete mix is essentially superplasticizer-free”. (Ex. 8.)

47. The Examiner in the reexamination of the ‘658 Patent stated, in Reasons for Patentability and/or Confirmation included in the Notice of Intent to Issue Reexamination Certificate, that “Du^[1] uses superplasticizer in the concrete mix as a surfactant so as to obtain an aqueous solution of the nano-silica (i.e., amorphous silica) and keep the consistency of the mix Claim 1 excludes Du’s superplasticizer since claim 1 recites ‘wherein the amorphous silica is dispersed in the concrete mix without using a superplasticizer.’” (Ex. 9, at 4.)

48. In the Reasons for Patentability and/or Confirmation, the Examiner further stated that “Claim 11 and its dependent claims require ‘the concrete mix is essentially superplasticizer-free’ [which] means that the superplasticizer is in trace amounts of less than about 0.1% based on the weight of the cement. Du’s ‘0.3 Nano-Silica’ in Table 2 on p. 707 contains . . . 1.5% by weight superplasticizer based on the weight of the cement. This amount is more than an order of magnitude greater than the claimed upper limit of about 0.1%.” (Ex. 9, at 4.)

49. The Examiner’s statements in the Reasons for Patentability and/or Confirmation included in the Notice of Intent to Issue Reexamination Certificate indicate the USPTO believed that the affirmative exclusion of superplasticizer, or the affirmative exclusion of more than a trace amount of superplasticizer, was critical for the patentability of the claims of the ‘658 Patent over the prior art.

50. A Reexamination Certificate was issued by the USPTO on February 9, 2024 (Ex. 8), effectively ending the reexamination and modifying the claims of the ‘658 Patent “as if the

¹ “Du” refers to the Du article submitted with Plaintiff’s Request and cited by the USPTO to reject the claims of the ‘658 Patent during the reexamination. The Du article is “Durability performances of concrete with nano-silica”, CONSTRUCTION AND BUILDING MATERIALS 73 (2014) 705-712.

same had been originally granted in such amended form”. *See* 35 U.S.C. §§ 307(b), 252; *see also Fortel Corp. v. Phone-Mate, Inc.*, 825 F.2d 1577, 1579 (Fed. Cir. 1987) (noting that § 307(b) incorporates both paragraphs of § 252).

51. The claims of the ‘658 Patent as modified by the Reexamination Certificate recite “a quantity of amorphous silica . . . wherein the average silica particle size is in the range of from 1 to 55 nanometers and/or wherein the surface area of the silica particles is in the range of from about 300 to about 900 m²/g”.

SPI’s Pre-Filing Public Disclosures, Public Uses, and/or Sales, and Trademark Applications

52. In 2016 and 2017, Joe Shetterley, the founder of SPI, the CEO of Defendant, and an inventor on each of the ‘658 Patent and the ‘823 Patent, publicly used an admixture containing nanosilica on job sites.

53. In or around January of 2017, Joe Shetterley publicly used, publicly disclosed, and/or sold a concrete admixture containing nanosilica in connection with the finishing of a concrete parking garage in South Bend, Indiana with Wilhelm Concrete.

54. On information and belief, the concrete admixture containing nanosilica publicly used, publicly disclosed, and/or sold in connection with the parking garage project with Wilhelm Concrete in or around January of 2017 included amorphous nanosilica, wherein the average particle size of the amorphous silica was in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the amorphous silica was in the range of from about 300 to about 900 m²/g.

55. As part of the parking garage project in or around January of 2017, the concrete admixture containing nanosilica was used in a process for the preparation of a concrete installation.

56. As part of the parking garage project in or around January of 2017, the concrete

admixture containing nanosilica was used in a process for the preparation of a concrete mixture in a Ready-mix.

57. January of 2017 is more than one year prior to March 9, 2018.

58. In the YouTube video available at <https://www.youtube.com/watch?v=D8j5t2y-Blo>, Joe Shetterley states that “the first commercial job with” the E5® Internal Cure® admixture was “a 1 million square foot parking garage”, and states that the E5® Internal Cure admixture “was launched . . . in 2017 on that parking garage”.

59. On or around February 28, 2017, Joe Shetterley and/or other representatives of SPI presented on SPI’s E5® admixture technology to architectural firms in New York, as evidenced by a post on Defendant’s Facebook page dated February 28, 2017. (Exhibit 22.)

60. In or around March of 2017, SPI and/or Joe Shetterley publicly used, publicly disclosed, and/or sold a concrete admixture containing nanosilica in connection with the finishing of a Whole Foods Market in Indianapolis, Indiana.

61. On information and belief, the concrete admixture containing nanosilica publicly used, publicly disclosed, and/or sold in connection with the Whole Foods Market project included amorphous nanosilica, wherein the average particle size of the amorphous silica was in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the amorphous silica was in the range of from about 300 to about 900 m²/g.

62. As part of the Whole Foods Market project in or around March of 2017, the concrete admixture containing nanosilica was used in a process for the preparation of a concrete installation.

63. As part of the Whole Foods Market project in or around March of 2017, the concrete admixture containing nanosilica was used in a process for the preparation of a concrete mixture in a Ready-mix.

64. Before March 9, 2017, SPI and/or Joe Shetterley publicly used, publicly disclosed, and/or sold a concrete admixture containing nanosilica in connection with the finishing of the Community North Cancer Center in Indianapolis, Indiana.

65. On information and belief, the concrete admixture containing nanosilica publicly used, publicly disclosed, and/or sold in connection with the Community North Cancer Center project included amorphous nanosilica, wherein the average particle size of the amorphous silica was in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the amorphous silica was in the range of from about 300 to about 900 m²/g.

66. As part of the Community North Cancer Center project before March 9, 2017, the concrete admixture containing nanosilica was used in a process for the preparation of a concrete installation.

67. As part of the Community North Cancer Center project before March 9, 2017, the concrete admixture containing nanosilica was used in a process for the preparation of a concrete mixture in a Ready-mix.

68. On March 9, 2017, Defendant's predecessor-in-interest SPI made a post on Defendant's LinkedIn Page and on Defendant's Facebook page, included as Exhibit 10, which stated, "finishing new sample slabs for our clients and showing off what the E5 system can do!" The post further stated, "E5 Admixture contains the water at time of placement and creates an internal curing process." The post further included a picture and stated, "This slab was poured on Saturday and polished on Wednesday."

69. On information and belief, the "E5 Admixture" referred to in the LinkedIn post and Facebook post from March 9, 2017 is the same product later branded by Defendant, and/or Defendant's predecessor-in-interest SPI, as E5® Internal Cure®, as evidenced by the reference in

the LinkedIn post and Facebook post to the “internal curing process” allegedly created by “the E5 Admixture”.

70. On information and belief, the “E5 Admixture” referred to in the LinkedIn post and Facebook post from March 9, 2017 included amorphous nanosilica.

71. On information and belief, the “E5 Admixture” referred to in the LinkedIn post and Facebook post from March 9, 2017 included amorphous nanosilica, wherein the average particle size of the amorphous silica was in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the amorphous silica was in the range of from about 300 to about 900 m²/g.

72. Defendant’s predecessor-in-interest SPI made other posts on Defendant’s LinkedIn page and Defendant’s Facebook page in March and April of 2017, including one on March 23, 2017 which indicated that the E5® products were “hard at work” in construction projects. (Ex. 11.)

73. On information and belief, all E5® products sold or publicly used by Joe Shetterley and/or Defendant’s predecessor-in-interest SPI prior to March 9, 2018 included a quantity of amorphous silica.

74. On information and belief, all concrete admixtures sold or publicly used by Joe Shetterley and/or Defendant’s predecessor-in-interest SPI between July 1, 2016 and March 9, 2018 included a quantity of amorphous silica.

75. On information and belief, all E5® products sold or publicly used by Joe Shetterley and/or Defendant’s predecessor-in-interest SPI prior to March 9, 2018 included a quantity of amorphous silica, wherein the average particle size of the amorphous silica was in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the

amorphous silica was in the range of from about 300 to about 900 m²/g.

76. On information and belief, all concrete admixtures sold or publicly used by Joe Shetterley and/or Defendant's predecessor-in-interest SPI between July 1, 2016 and March 9, 2018 included a quantity of amorphous silica, wherein the average particle size of the amorphous silica was in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the amorphous silica was in the range of from about 300 to about 900 m²/g.

77. On January 21, 2020, Defendant's predecessor-in-interest SPI filed U.S. Trademark



Application No. 88/767,487 for the mark (the "E5 plus design mark") ("the '487 Application").

78. The '487 Application, or registration stemming therefrom, was later assigned by SPI to Defendant.

79. As part of filing the '487 Application, SPI's attorney made the assertion, under penalty of punishment under 18 U.S.C. § 1001, to the USPTO that SPI began using the E5 plus design mark in commerce in connection with "concrete; concrete building materials, namely, finishing systems and admixture" goods at least as early as January 15, 2017. (Ex. 12.)

80. On September 2, 2020, Defendant's predecessor-in-interest SPI filed U.S. Trademark Application No. 90/153,767 ("the '767 Application") for the mark INTERNAL CURE.

81. The '767 Application, or registration stemming therefrom, was later assigned by SPI to Defendant.

82. As part of filing the '767 Application, SPI's attorney made the assertion, under penalty of punishment under 18 U.S.C. § 1001, to the USPTO that SPI began using the INTERNAL CURE mark in commerce in connection with "concrete admixtures" at least as early

as July 1, 2016. (Ex. 13.)

83. In a response in the '767 Application filed on June 3, 2021, SPI's attorney stated that "It is true that Applicant's Internal Cure does contain water, said water is present to transport suspended Silica particles. The suspended silica particles increase concrete matrix formation, increasing early strength and final strength through a different process than simply making water available internally" (Ex. 14).

84. Thus, Defendant's predecessor-in-interest SPI admitted to the USPTO in the '767 Application that the INTERNAL CURE product both includes silica particles and was first sold in commerce as early as July 1, 2016.

85. On information and belief, Defendant and Defendant's predecessor-in-interest SPI have only ever used the mark INTERNAL CURE in connection with a product which contains a quantity of amorphous silica, wherein the average particle size of the amorphous silica is in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the amorphous silica is in the range of from about 300 to about 900 m²/g.

86. In the response in the '767 Application filed on June 3, 2021, Defendant's predecessor-in-interest SPI argued against a merely descriptive refusal by arguing to the USPTO that the INTERNAL CURE mark "was selected to evoke the effect of internal curing, but does not contain or execute internal curing, including, notable [sic], as that term is defined by the American Concrete Institute . . ." (Ex. 14.)

The '823 Patent

87. The '823 Patent issued on March 5, 2024 from U.S. Application No. 18/114,214 ("the '214 Application"), filed on February 24, 2023.

88. The '214 Application purported to claim priority to U.S. Application No.

17/569,269 (“the ‘269 Application”). However, the ‘269 Application became abandoned prior to the ‘214 Application being filed, thereby precluding a valid priority claim from being made to the ‘269 Application under 35 U.S.C. § 120.

89. Though the ‘214 Application purported to claim priority to an abandoned application at the time when the ‘214 Application was filed, contrary to 35 U.S.C. § 120, the USPTO originally examined the ‘214 Application as if it were entitled to this priority and therefore did not consider the applicability of certain prior art, specifically including US 2020/0062659 A1.

90. In October of 2023, the USPTO allowed the ‘214 Application as if the ‘214 Application were entitled to the claimed priority.

91. Plaintiff, anonymously through counsel, sent SPI’s then-attorney of record in the ‘214 Application a letter on December 12, 2023 to demand that the ‘214 Application be withdrawn from issue, or alternatively expressly abandoned, to prevent the USPTO from erroneously issuing a clearly invalid patent. (Ex. 15.)

92. SPI’s counsel promptly withdrew the ‘214 Application from issue and filed the requisite petitions and documents to change the priority claim in the ‘214 Application to a different family of applications still co-pending at the time, namely, U.S. Application No. 16/501,311 filed on March 22, 2019 (“the ‘311 Application”) and U.S. Provisional Application No. 62/761,393 filed on September 1, 2018. (Ex. 16.)

93. As a result, because the ‘311 Application claims priority to U.S. Provisional Application No. 62/761,393 filed on March 22, 2018, when the ‘823 Patent subsequently issued, the ‘823 Patent issued with an earliest possible effective filing date of March 22, 2018.

94. All of the claims of the ‘823 Patent require, *inter alia*, creating a concrete mix from components, where the components include “a quantity of amorphous silica, wherein the average

particle size of the amorphous silica is in the range of from about 1 to about 55 nanometers and/or wherein the surface area of the particles of the amorphous silica is in the range of from about 300 to about 900 m²/g”.

Plaintiff’s ULTRAFINISH 1L™ Product

95. Plaintiff has developed a concrete admixture product which contains colloidal silica.

96. In 2023, Plaintiff began selling the concrete admixture product containing colloidal silica under the trademark ULTRAFINISH 1L™.

97. Plaintiff’s ULTRAFINISH 1L™ product does not include amorphous silica having an average silica particle size in the range of from 1 to 55 nanometers.

98. Plaintiff’s ULTRAFINISH 1L™ product does not include amorphous silica particles with a surface area in the range of from about 300 to about 900 m²/g.

99. Before beginning to sell the ULTRAFINISH 1L™ product, Plaintiff had the ULTRAFINISH 1L™ product tested by a third-party laboratory to determine the average silica particle size range in the ULTRAFINISH 1L™ product. The results of this test indicated the amorphous silica had an average particle size outside the range of from 1 to 55 nanometers.

100. Plaintiff has since had its ULTRAFINISH 1L™ product re-tested by a third-party laboratory to determine the average particle size and surface area of the silica particles contained in it. These tests showed the amorphous silica in the ULTRAFINISH 1L™ product has an average particle size outside the range of from 1 to 55 nanometers and a surface area outside the range of from about 300 to about 900 m²/g.

101. Plaintiff recommends to its customers of the ULTRAFINISH 1L™ product that a superplasticizer, namely, a polycarboxylate, be added to a concrete mix prepared with the

ULTRAFINISH 1L™ product for the purpose of addressing Type 1L cement deficiencies.

Defendant's Patent Marking and Commercial Advertisements or Promotion

102. Defendant's website has promoted Defendant's E5® products as being "patented products". (Ex. 17.)

103. Defendant's LinkedIn page states that "E5® is the only patented system in the world to chemically bind nano silica in concrete at the initial reaction point." (Ex. 18.)

104. Neither the '658 Patent (originally or as modified by the Reexamination Certificate) nor the '823 Patent include claims directed to an article, a composition, a product, a system, an installation, or other non-process.

105. All of the claims of the '658 Patent, originally and as modified by the Reexamination Certificate, are process claims.

106. All of the claims of the '658 Patent, originally and as modified by the Reexamination Certificate, are directed to processes of using an admixture.

107. All of the claims of the '823 Patent are process claims.

108. All of the claims of the '823 Patent are directed to processes of using an admixture.

109. Defendant does not own, have any ownership interest, or have any rights under in any United States Patent that, but for such ownership, ownership interest, or rights, would be infringed by Defendant's making, using, selling, offering for sale, importing, or having imported any of its E5® admixture products.

110. Defendant does not own, have any ownership interest in, or have any rights in any United States Patent which claims a product.

111. Defendant does not own, have any ownership interest in, or have any rights in any United States Patent which claims a system.

112. Defendant's E5® products are unpatented articles.

113. Defendant has nonetheless maintained on its website that the E5® "products" are patented, and has maintained on its LinkedIn page that E5® is a "patented system". (Ex. 17, 18.) On information and belief, Defendant has done this with the intent to secure a commercial advantage by deceiving contractors into believing their use of admixture products which compete with Defendant's E5® products would bring liability for patent infringement. Thus, Defendant has maintained this language on its website and LinkedIn page for the purpose of deceiving the public.

114. Plaintiff has lost business because of Defendant's false assertions that its E5® "products" are patented and/or that E5® is a "patented system". At least one customer of Plaintiff's has indicated to Plaintiff that they do not wish to risk litigation as a result of purchasing Plaintiff's ULTRAFINISH 1L™ product, and to date such customer has not purchased Plaintiff's ULTRAFINISH 1L™ product.

115. At least one state department of transportation, namely, the Indiana Department of Transportation ("InDoT"), has the belief that the E5® Internal Cure® and Liquid Fly Ash® products are patented, as evidenced by an InDot presentation given at the National Concrete Consortium in April of 2022. (Ex. 24, at 3.)

116. Defendant's website states that Defendant's E5® INTERNAL CURE® concrete admixture is the "first admixture proven to provide internal curing of concrete", in explicit contrast to the arguments made by Defendant's predecessor-in-interest SPI to the USPTO in the '767 Application. (Ex. 19.)

117. Defendant's website includes an "About E5®" section with a drop-down option heading which reads "What is internal curing?" under which there is an explanation of the American Concrete Institute's definition of "internal curing". (Ex. 20.)

118. Defendant's predecessor-in-interest SPI expressly stated to the USPTO in the '767 Application that the INTERNAL CURE® product did not execute internal curing "as that term is defined by the American Concrete Institute". (Ex. 14.)

119. On information and belief, one or more of Plaintiff's customers who are also consumers of Defendant's E5® INTERNAL CURE® admixture product have been deceived by Defendant's advertising of the E5® INTERNAL CURE® admixture as providing internal curing of concrete.

120. Defendant's website formerly promoted a benefit of "higher strength" in the resulting concrete slab from using Defendant's E5® admixtures (formerly referred to as "ElementFive" admixtures). (Ex. 25.)

121. Testing on Defendant's E5® admixtures has shown that Defendant's E5® admixtures do not actually provide an increase in strength in the resulting concrete slab. (Ex. 26.)

122. Distributors of Defendant's E5® admixtures have continued to promote Defendant's E5® admixtures with advertisements which tout an increase in ultimate strength. (Ex. 23.)

123. On information and belief, Defendant has continued to provide distributors of its E5® admixture products with advertising materials which promote the benefit of increased strength.

Defendant's Threats of Patent Infringement

124. Defendant has effectively threatened Plaintiff with claims of patent infringement based on each of the '658 Patent and the '823 Patent.

125. Defendant's counsel sent Plaintiff the Cease and Desist Letter which alleges infringement of the '658 Patent and the '823 Patent by Plaintiff's "selling and instructing . . . use"

of Plaintiff's ULTRAFINISH 1LTM product. (Ex. 4.)

126. Defendant's conduct in having the Cease and Desist Letter sent to Plaintiff has given Plaintiff a well-grounded fear and reasonable apprehension of an impending patent infringement suit brought by Defendant against Plaintiff.

COUNT I

Declaratory Judgment under 28 U.S.C. § 2201(a) of Non-Infringement of the '658 Patent

127. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

128. Plaintiff has standing to bring a declaratory judgement action with respect to the '658 Patent because Defendant has charged Plaintiff with infringement of the '658 Patent through the Cease and Desist Letter sent to Plaintiff.

129. Plaintiff does not engage in the practice of preparing a concrete installation, and therefore is not a direct infringer of the '658 Patent.

130. Plaintiff does not sell a product meeting the "quantity of amorphous silica" limitation of the claims of the '658 Patent as modified by the Reexamination Certificate. Therefore, Plaintiff is not an indirect infringer of the '658 Patent, and does not induce or contribute to infringement of the '658 Patent.

131. Plaintiff's ULTRAFINISH 1LTM product is not a material part of the invention claimed in the '658 Patent as modified by the Reexamination Certificate.

132. Plaintiff's ULTRAFINISH 1LTM product is not especially adapted for use in an infringement of the '658 Patent as modified by the Reexamination Certificate.

133. Plaintiff's ULTRAFINISH 1LTM product is commercially suitable for substantial uses which do not infringe the '658 Patent as modified by the Reexamination Certificate.

134. The claims of the '658 Patent as modified by the Reexamination Certificate require either that the amorphous silica is dispersed in the concrete mix without using a superplasticizer or that the concrete mix is essentially superplasticizer-free.

135. Plaintiff recommends to its customers of the ULTRAFINISH 1L™ product that a superplasticizer, namely, a polycarboxylate, be added to a concrete mix prepared with the ULTRAFINISH 1L™ product, contrary to the claims of the '658 Patent as modified by the Reexamination Certificate, and contrary to the Reasons for Allowance in the reexamination of the '658 Patent.

136. Plaintiff's ULTRAFINISH 1L™ product does not have the specific silica particles required by the claims of the '658 Patent as modified by the Reexamination Certificate, in that Plaintiff's ULTRAFINISH 1L™ product does not include silica having an average silica particle size in the range of from 1 to 55 nanometers or a surface area in the range of from about 300 to about 900 m²/g.

137. Because at least the limitations of the claims of the '658 Patent as modified by the Reexamination Certificate defining the silica particle size and surface area, which are required by all claims of the '658 Patent as modified by the Reexamiantion Certificate, are not met by Plaintiff's ULTRAFINISH 1L™ product, Plaintiff's ULTRAFINISH 1L™ product cannot be used to infringe the claims of the '658 Patent as modified by the Reexamination Certificate.

138. Because there cannot be direct infringement of the '658 Patent as modified by the Reexamination Certificate with Plaintiff's ULTRAFINISH 1L™ product, Plaintiff is not indirectly infringing the '658 Patent as modified by the Reexamination Certificate by selling and instructing use of the ULTRAFINISH 1L™ product.

139. In addition, because Plaintiff recommends to its customers that a superplasticizer, namely, a polycarboxylate, be included in a concrete mix prepared with Plaintiff's ULTRAFINISH 1L™ product, Plaintiff is not indirectly infringing the claims of the '658 Patent as modified by the Reexamination Certificate.

140. The reason that the USPTO allowed any claim of the '658 Patent in the reexamination is because it either (i) excludes the use of superplasticizer in dispersing the amorphous nanosilica in the concrete mix, or (ii) excludes from the concrete mix the presence of superplasticizer in more than trace amounts of less than about 0.1% based on the weight of the cement. Each of these limitations was added by amendment in the reexamination. Therefore, prosecution history estoppel applies to preclude the application of the doctrine of equivalents to cover methods which (i) include the use of superplasticizer to disperse the amorphous nanosilica in the concrete mix, or (ii) include a concrete mix which includes more than about 0.1% superplasticizer based on the weight of the cement. *See Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 828 (Fed. Cir. 1999) ("If the claims were amended for a reason 'related to patentability,' prosecution history estoppel applies.") (citing *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29-35 (1997)).

141. Nonetheless, Defendant has alleged that Plaintiff is infringing the '658 Patent by selling its ULTRAFINISH 1L™ product and instructing its use. Therefore, an actual and justiciable controversy exists between Plaintiff and Defendant as to whether Plaintiff is infringing or has infringed, directly or indirectly, the claims of the '658 Patent as modified by the Reexamination Certificate.

142. A judicial determination of non-infringement is necessary and appropriate.

COUNT II

Declaratory Judgment under 28 U.S.C. § 2201(a) of Invalidity of the ‘658 Patent

143. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

144. Plaintiff has standing to bring a declaratory judgement action with respect to the ‘658 Patent because Defendant has charged Plaintiff with infringement of the ‘658 Patent through the Cease and Desist Letter sent to Plaintiff.

145. The claims of the ‘658 Patent are invalid because of a failure to meet the conditions of patentability and/or otherwise comply with one or more of 35 U.S.C. § 1 *et seq.*, specifically including §§ 102, 103, and 112.

146. The invention claimed in the ‘658 Patent as modified by the Reexamination Certificate was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention, or the claimed invention was described in a patent, or in an application for patent published or deemed published, in which the patent or application names another inventor and was effectively filed before the effective filing date of the claimed invention, contrary to 35 U.S.C. § 102.

147. The claims of the ‘658 Patent as modified by the Reexamination Certificate are invalid because the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains, contrary to 35 U.S.C. § 103.

148. Defendant’s predecessor-in-interest SPI, and/or Joe Shetterley in an individual capacity, sold the E5® products for use, and/or used the E5® products, in construction projects

prior to March 9, 2017, which is more than one year prior to the earliest possible² effective filing date of the '658 Patent.

149. March 9, 2017 was a Thursday.

150. The LinkedIn post and Facebook post on March 9, 2017, while being within one year of the earliest possible effective filing date of the '658 Patent, describe a sale and/or public use of the "E5 Admixture" that occurred "on Saturday". Thus, the sale and/or public use described in the post occurred, at the latest, on the Saturday before March 9, 2017, which was Saturday, March 4, 2017.

151. Any day before March 9, 2017, specifically including March 4, 2017, is more than one year prior to the earliest effective filing date of the '658 Patent.

152. The E5® products containing amorphous silica were in public use prior to March 9, 2017 in a method of making a concrete installation as recited by claim 1 of the '658 Patent as modified by the Reexamination Certificate, where the E5® product was or included the "quantity of amorphous silica" recited by the claim.

153. The claims of the '658 Patent as modified by the Reexamination Certificate are anticipated by the public use of the E5® admixture products in processes of making a concrete installation prior to March 9, 2017. Therefore, the claims of the '658 Patent as modified by the Reexamination Certificate are invalid under 35 U.S.C. § 102(a)(1).

154. The claims of the '658 Patent as modified by the Reexamination Certificate are rendered obvious by the public use of the E5® admixture products in processes of making a concrete installation prior to March 9, 2017, either alone or in combination with other prior art.

² Plaintiff does not admit that any of the three provisional applications which the '658 Patent claims priority to actually provide the requisite support and enablement to establish the claimed priority.

Therefore, the claims of the '658 Patent as modified by the Reexamination Certificate are invalid under 35 U.S.C. § 103.

155. Third parties used the E5® products in the claimed method of making a concrete installation prior to the effective filing date of the '658 Patent, which is no later than March 9, 2018. Such public uses of the E5® products are not excepted from being prior art under 35 U.S.C. § 102(b)(1) because the public use of the E5® products was not a disclosure “made by . . . another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor”. On information and belief, while the third parties obtained the E5® *products* from Defendant’s predecessor-in-interest SPI, the subsequent public use of a *process* involving the E5® products was not obtained from Defendant’s predecessor-in-interest SPI.

156. Various other prior art disclosures, including patents and printed publications, anticipate and/or render obvious the claims of the '658 Patent as modified by the Reexamination Certificate under 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

157. The specification of the '658 Patent does not contain a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, contrary to 35 U.S.C. § 112(a).

158. By way of example and without limitation, claims 4-7 of the '658 Patent as modified by the Reexamination Certificate recite introducing the amorphous silica into the mix as a colloidal silica solution that comprises between about 50 about 95 wt% silica (in the case of claim 4) or between about 75 and about 90 wt% silica (in the case of claims 5-7). However, the specification does not enable a person of ordinary skill in the art to use such a high-concentration silica solution in the process. Rather, the specification of the '658 Patent gives the example of E5

INTERNAL CURE, “which contains about 15 wt % amorphous silica in about 85 wt % water.” (See Ex. 1, column 8, lines 46-50.) The specification also states the colloidal silica is added to the concrete mix in the range of from about 40 to about 98 wt % silica (see column 9, lines 10-13), but a person of ordinary skill in the art would question whether it is even possible to make such high-concentration colloidal silica solutions. It is not clear that amorphous silica solutions having such a high concentration of silica could even exist as colloidal silica solutions. Therefore, claims 4-7 of the ‘658 Patent as modified by the Reexamination Certificate are invalid as non-enabled under 35 U.S.C. § 112(a).

159. The claims of the ‘658 Patent as modified by the Reexamination Certificate do not particularly point out and distinctly claim the subject matter which the inventors regard as the invention, contrary to 35 U.S.C. § 112(b).

160. By way of example and without limitation, the claims of the ‘658 Patent as modified by the Reexamination Certificate include ambiguous limitations. Each of claims 1 and 11 recites, in limitation A)a)ii), the term “the value” in an apparent attempt to refer to “manufacturer suggested water/cement ratio range” but after introducing the terms “an upper value and a lower value”, making it entirely unclear whether “the value” refers to the manufacturer suggested water/cement ratio range, the upper value, or the lower value. Therefore, the claims of the ‘658 Patent as modified by the Reexamination Certificate are invalid as indefinite under 35 U.S.C. § 112(b).

161. By way of a further example and without limitation, each of claims 1 and 11 recites, in limitation A)a)i), the phrases “a manufacturer suggested water/cement ratio value”, “said suggested ratio”, “the water/cement ratio”, “the suggested value”, “the value”, “manufacturer suggested water/cement ratio range”, and “the value” in an apparent attempt to refer to the same

thing, while a person of ordinary skill in the art would not know whether “the value” is referring to “a manufacturer suggested water/cement ratio value” or “the suggested value”. This ambiguity further renders the claims of the ‘658 Patent as modified by the Reexamination Certificate invalid as indefinite under 35 U.S.C. § 112(b).

162. By way of a further example and without limitation, each of claims 1 and 11 recites, in limitation B), “wherein the amorphous silica and the tailwater are, optionally, added optionally intercombined”, which renders the limitation nonsensical because of the second “optionally”. The second “optionally” means the first “optionally” must make the addition of silica and tailwater in general optional, which contradicts the limitation in B) that the water is added in its entirety or in portions comprising an initial portion and a tailwater portion. Where a claim is susceptible to only one reasonable interpretation and that interpretation results in a nonsensical construction of the claim as a whole, the claim must be invalidated. *See, e.g., Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004).

163. Nonetheless, Defendant has alleged that Plaintiff is infringing the ‘658 Patent by selling its ULTRAFINISH 1L™ product and instructing its use. Therefore, an actual and justiciable controversy exists between Plaintiff and Defendant regarding the invalidity of the ‘658 Patent.

164. A judicial determination of invalidity is necessary and appropriate.

COUNT III

Declaratory Judgment under 28 U.S.C. § 2201(a) of Unenforceability of the ‘658 Patent

165. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

166. Plaintiff has standing to bring a declaratory judgement action with respect to the ‘658 Patent because Defendant has charged Plaintiff with infringement of the ‘658 Patent through

the Cease and Desist Letter sent to Plaintiff.

167. All individuals associated with a non-provisional patent application pending in the USPTO have a duty of candor and good faith in dealing with the USPTO, which includes a duty to disclose to the USPTO all information known to said individuals to be material to patentability. 37 C.F.R. § 1.56(a).

168. Applicants are required to prosecute patent applications in the USPTO with candor, good faith, and honesty. *See Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1178 (Fed. Cir. 1995) (citing *Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co.*, 324 U.S. 806, 8016 (1945)). This duty also extends to the applicant's representatives. *Id.* A breach of this duty constitutes inequitable conduct. *Id.*

169. Defendant's predecessor-in-interest SPI, and/or Joe Shetterley in an individual capacity, publicly disclosed, publicly used, and/or sold a concrete admixture product containing a quantity of amorphous silica having an average silica particle size in the range of from 1 to 55 nanometers or a surface area of silica particles in the range of from about 300 to about 900 m²/g prior to March 9, 2017, as evidenced at least by the LinkedIn post and Facebook post dated March 9, 2017 about the "E5 Admixture" product having been recently used, as well as evidenced by the alleged first dates of use of the E5® and INTERNAL CURE® trademarks.

170. During the prosecution of the application which issued as the '658 Patent, then-applicant SPI did not file an information disclosure statement disclosing, or otherwise make the USPTO aware, of the public disclosures, public uses, and/or sales of the E5® products by SPI and/or Joe Shetterley more than one year prior to the earliest possible effective filing date of the '658 Patent.

171. Because one or more E5® admixture products containing a quantity of amorphous

silica were publicly disclosed, publicly used, and/or sold prior to March 9, 2017 by SPI and/or Joe Shetterley, SPI was aware of the disclosure(s), use(s), and/or sale(s) of the E5® admixture products.

172. Because one or more E5® admixture products containing a quantity of amorphous silica was publicly used by customers of SPI before March 9, 2017, SPI was aware of the public use(s) of the E5® admixture products which occurred prior to March 9, 2017.

173. One or more of the E5® admixture products containing a quantity of amorphous silica was used to create a concrete installation prior to March 9, 2017, and Defendant's predecessor-in-interest SPI was aware of such public use before the '658 Patent issued.

174. The public disclosures, public uses, and/or sales of SPI's E5® admixture products prior to March 9, 2017 were material to the patentability of the claims of the '658 Patent.

175. Then-applicant SPI had a duty to disclose the public disclosures, public uses, and/or sales of its concrete admixture products containing amorphous silica to the USPTO in considering the patentability of the '658 Patent, and did not comply with this duty.

176. During the reexamination of the '658 Patent, SPI again had a duty to disclose the public disclosures, public uses, and/or sales of its concrete admixture products containing amorphous silica to the USPTO, and did not comply with this duty.

177. SPI's failure to disclose the pre-March 9, 2017 public disclosures, public uses, and/or sales of its concrete admixture products containing amorphous silica to the USPTO was willful and with an intent to deceive the USPTO.

178. SPI's attorney in the '487 Application represented to the USPTO that SPI began using the E5® plus design mark in commerce in connection with "concrete; concrete building materials, namely, finishing systems and admixture", at least as early as January 15, 2017.

179. On information and belief, the January 15, 2017 date corresponds with the E5® products being used by SPI and/or Joe Shetterley in connection with the finishing of a concrete parking garage in South Bend, Indiana with Wilhelm Concrete.

180. On information and belief, the E5® products sold by SPI and/or Joe Shetterley at least as early as January 15, 2017 contained a quantity of amorphous silica as recited in the claims of the '658 Patent, namely, having an average silica particle size in the range of from 1 to 55 nanometers and/or a surface area of the silica particles in the range of from about 300 to about 900 m²/g.

181. SPI's attorney in the '767 Application represented to the USPTO that SPI began using the INTERNAL CURE® mark in commerce in connection with "concrete admixtures", at least as early as July 1, 2016, and later argued to the Trademark Office in the '767 Application that said "concrete admixtures" contain silica particles.

182. Defendant's predecessor-in-interest SPI had an obligation to disclose to the USPTO the public disclosures, public uses, and sales of its concrete admixture products containing amorphous nanosilica, specifically including the E5® INTERNAL CURE® products, which occurred before March 9, 2017 (specifically including those which occurred between July 1, 2016 and March 9, 2017), and failed to do so.

183. The failure by then-applicant SPI to disclose to the USPTO the material prior art of the pre-March 9, 2017 public disclosures, public uses, and/or sales of its concrete admixture products amounts to inequitable conduct.

184. Because of SPI's inequitable conduct during the prosecution and reexamination of the '658 Patent, the '658 Patent must be declared unenforceable.

185. Defendant has charged Plaintiff with infringement of the '658 Patent through the

Cease and Desist Letter sent to Plaintiff. Therefore, an actual and justiciable controversy exists between Plaintiff and Defendant regarding the unenforceability of the '658 Patent.

186. A judicial determination of unenforceability is necessary and appropriate.

COUNT IV

Declaratory Judgment under 28 U.S.C. § 2201(a) of Non-Infringement of the '823 Patent

187. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

188. Plaintiff has standing to bring a declaratory judgment action with respect to the '823 Patent because Defendant has charged Plaintiff with infringement of the '823 Patent through the Cease and Desist Letter sent to Plaintiff.

189. Plaintiff does not engage in the practice of preparing a concrete installation, and for at least this reason is not a direct infringer of the '823 Patent.

190. Plaintiff does not sell a product meeting the "quantity of amorphous silica" limitation of the claims of the '823 Patent. For at least this reason, Plaintiff is not an indirect infringer of the '823 Patent, and does not induce or contribute to infringement of the '823 Patent.

191. Plaintiff's ULTRAFINISH 1L™ product is not a material part of the invention claimed in the '823 Patent.

192. Plaintiff's ULTRAFINISH 1L™ product is not especially adapted for use in an infringement of the '823 Patent.

193. Plaintiff's ULTRAFINISH 1L™ product is commercially suitable for substantial uses which do not infringe the '823 Patent.

194. All of the claims of the '823 Patent require "a quantity of amorphous silica . . . wherein the average silica particle size is in the range of from 1 to 55 nanometers and/or wherein the surface area of the silica particles is in the range of from about 300 to about 900 m²/g".

195. Plaintiff's ULTRAFINISH 1L™ product does not include amorphous silica having an average silica particle size in the range of from 1 to 55 nanometers.

196. Plaintiff's ULTRAFINISH 1L™ product does not include amorphous silica where the surface area of the silica particles is in the range of from about 300 to about 900 m²/g.

197. Because Plaintiff's ULTRAFINISH 1L™ product does not include the amorphous silica required by the claims of the '823 Patent, Plaintiff's ULTRAFINISH 1L™ product cannot be used to infringe the claims of the '823 Patent.

198. Because there cannot be direct infringement of the '823 Patent with Plaintiff's ULTRAFINISH 1L™ product, Plaintiff is not indirectly infringing the '823 Patent by selling and instructing use of the ULTRAFINISH 1L™ product.

199. Defendant has charged Plaintiff with infringement of the '823 Patent through the Cease and Desist Letter sent to Plaintiff. Therefore, an actual and justiciable controversy exists between Plaintiff and Defendant regarding the non-infringement of the '823 Patent.

200. A judicial determination of non-infringement is necessary and appropriate.

COUNT V
Declaratory Judgment under 28 U.S.C. § 2201(a) of Invalidity of the '823 Patent

201. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

202. Plaintiff has standing to bring a declaratory judgement action with respect to the '823 Patent because Defendant has charged Plaintiff with infringement of the '823 Patent through the Cease and Desist Letter sent to Plaintiff.

203. The '823 Patent fails to meet the requirements of one or more of 35 U.S.C. §§ 102, 103, or 112.

204. The earliest possible effective filing date of the '823 Patent is March 22, 2018, by

virtue of U.S. Provisional Application No.62/761,393.

205. Defendant's predecessor-in-interest SPI and/or Joe Shetterley publicly disclosed, publicly used, and/or sold the E5® admixture products, specifically including the E5® INTERNAL CURE® admixture product, prior to March 22, 2017 (i.e., prior to one-year before the earliest possible effective filing date of the '823 Patent).

206. The pre-March 22, 2017 public disclosures, public uses, and/or sales of the E5® admixture products by SPI and/or Joe Shetterley, specifically including the E5® INTERNAL CURE® admixture product, anticipate or render obvious the claims of the '823 Patent.

207. Third parties used the E5® admixture products in the claimed method of making a concrete installation prior to the effective filing date of the '823 Patent, which is no earlier than March 22, 2018. Such public uses of the E5® products are not excepted from being prior art under 35 U.S.C. § 102(b)(1) because the public use of the E5® products was not a disclosure "made by . . . another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor". On information and belief, while the third parties obtained the E5® *products* from Defendant's predecessor-in-interest SPI, the subsequent public use of the E5® products in a *process* was not obtained from SPI.

208. The third-party uses of the E5® admixture products prior to March 22, 2017 anticipate or render obvious the claims of the '823 Patent.

209. Various other prior art disclosures, including patents and printed publications, anticipate and/or render obvious the claims of the '823 Patent under 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

210. Defendant has charged Plaintiff with infringement of the '823 Patent through the Cease and Desist Letter sent to Plaintiff. Therefore, an actual and justiciable controversy exists

between Plaintiff and Defendant regarding the invalidity of the '823 Patent.

211. A judicial determination of invalidity is necessary and appropriate.

COUNT VI

Declaratory Judgment under 28 U.S.C. § 2201(a) of Unenforceability of the '823 Patent

212. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

213. Plaintiff has standing to bring a declaratory judgement action with respect to the '823 Patent because Defendant has charged Plaintiff with infringement of the '823 Patent through the Cease and Desist Letter sent to Plaintiff.

214. All individuals associated with a non-provisional patent application pending in the USPTO have a duty of candor and good faith in dealing with the USPTO, which includes a duty to disclose to the USPTO all information known to said individuals to be material to patentability. 37 C.F.R. § 1.56(a).

215. Applicants are required to prosecute patent applications in the USPTO with candor, good faith, and honesty. *See Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1178 (Fed. Cir. 1995) (citing *Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co.*, 324 U.S. 806, 8016 (1945)). This duty also extends to the applicant's representatives. *Id.* A breach of this duty constitutes inequitable conduct. *Id.*

216. Defendant's predecessor-in-interest SPI and/or Joe Shetterley publicly disclosed, publicly used, and/or sold a concrete admixture product containing a quantity of amorphous silica having an average silica particle size in the range of from 1 to 55 nanometers or a surface area of silica particles in the range of from about 300 to about 900 m²/g prior to March 22, 2017, as evidenced at least by the LinkedIn post from March 9, 2017 about the "E5 Admixture" product having been recently used and the LinkedIn post from March 23, 2017 which indicated that the

E5® products were “hard at work” in construction projects.

217. During the prosecution of the application which issued as the ‘823 Patent, then-applicant SPI did not file an information disclosure statement disclosing, or otherwise make the USPTO aware, of the public disclosures, public uses, and/or sales of the E5® products by SPI and/or Joe Shetterley more than one year prior to the earliest possible effective filing date of the ‘823 Patent.

218. Because one or more E5® admixture products containing a quantity of amorphous silica was publicly disclosed, publicly used, and/or sold prior to March 22, 2017 by SPI and/or Joe Shetterley, SPI was aware of the public disclosure, public use, and/or sale of the E5® admixture products.

219. Because one or more E5® admixture products containing a quantity of amorphous silica was publicly used by customers of SPI before March 22, 2017, SPI was aware of the public use(s) of the E5® admixture products which occurred prior to March 22, 2017.

220. One or more of the E5® admixture products containing a quantity of amorphous silica was used to create a concrete installation prior to March 22, 2017, and Defendant’s predecessor-in-interest SPI was aware of such use before the ‘823 Patent issued.

221. The public disclosures, public uses, and/or sales of the E5® admixture products prior to March 22, 2017 were material to the patentability of the claims of the ‘823 Patent.

222. Then-applicant SPI had a duty to disclose the public disclosures, public uses, and/or sales of its concrete admixture products containing amorphous silica to the USPTO in considering the patentability of the ‘823 Patent, and did not comply with this duty.

223. SPI’s failure to disclose the pre-March 22, 2017 public disclosures, public uses, and/or sales of its concrete admixture products containing amorphous silica to the USPTO was

willful and with an intent to deceive the USPTO.

224. SPI's attorney in the '487 Application represented to the USPTO that SPI began using the E5® plus design mark in commerce in connection with "concrete; concrete building materials, namely, finishing systems and admixture", at least as early as January 15, 2017.

225. On information and belief, the E5® products sold by Defendant's predecessor-in-interest SPI and/or Joe Shetterley at least as early as January 15, 2017 contained a quantity of amorphous silica as recited in the claims of the '823 Patent, namely, having an average silica particle size in the range of from 1 to 55 nanometers and/or a surface area of the silica particles in the range of from about 300 to about 900 m²/g.

226. SPI's attorney in the '767 Application represented to the USPTO that SPI began using the INTERNAL CURE® mark in commerce in connection with "concrete admixtures", at least as early as July 1, 2016, and later argued to the Trademark Office in the '767 Application that said "concrete admixtures" contain silica particles.

227. Then-applicant SPI had an obligation to disclose to the USPTO the public disclosures, public uses, and sales of its concrete admixture products containing amorphous nanosilica, specifically including the E5® INTERNAL CURE® products, which occurred before March 22, 2017, and failed to do so.

228. The failure by Defendant's predecessor-in-interest SPI to disclose to the USPTO the material prior art of the pre-March 22, 2017 public disclosures, public uses, and/or sales of its concrete admixture products amounts to inequitable conduct.

229. Because of SPI's inequitable conduct during the prosecution of the '823 Patent, the '823 Patent must be declared unenforceable.

230. Defendant has charged Plaintiff with infringement of the '823 Patent through the

Cease and Desist Letter sent to Plaintiff. Therefore, an actual and justiciable controversy exists between Plaintiff and Defendant regarding the unenforceability of the '823 Patent.

231. A judicial determination of unenforceability is necessary and appropriate.

COUNT VII
False Marking under 35 U.S.C. § 292

232. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

233. Defendant has falsely indicated that Defendant's E5® products are patented "products" when, in fact, Defendant has no patent claiming a product which reads on its E5® products.

234. Defendant has falsely indicated that its E5® products are a "patented system" when, in fact, Defendant has no patent claiming a system which reads on its E5® products.

235. Defendant's concrete admixtures, including its E5® products, are unpatented articles, in that Defendant's patents only claim processes of using concrete admixtures and not the concrete admixtures themselves.

236. Defendant has intentionally maintained the false marking of its E5® products on at least Defendant's website and Defendant's LinkedIn page for the purpose of deceiving the public into believing that buying a competing product could give rise to liability for patent infringement.

237. Plaintiff is a person who has suffered a competitive injury as a result of Defendant's false marking, in that at least one of Plaintiff's customers has declined to purchase Plaintiff's products out of concern over litigation and at least one state department of transportation believes that Defendant's E5® products are patented.

238. Defendant's website and LinkedIn page constitute advertising for Defendant's E5® products.

239. Defendant's statements on Defendant's website and Defendant's LinkedIn page that the E5® "products" or "system" are patented constitute false marking in violation of 35 U.S.C. § 292.

240. Plaintiff should be compensated for its competitive injury caused by Defendant's false marking.

COUNT VIII
False Advertising under 15 U.S.C. § 1125(a)

241. Plaintiff hereby incorporates the facts and allegations contained in Paragraphs 1 through 126 above as though fully set forth herein.

242. Defendant has sold concrete admixtures in commerce in connection with the INTERNAL CURE® mark, namely, Defendant's E5® INTERNAL CURE® admixture product, to provide a false representation to consumers that the E5® INTERNAL CURE® admixture product provides internal curing of concrete.

243. As evidenced by SPI's arguments to the USPTO in the '767 Application, the mark INTERNAL CURE® was intentionally selected to "evoke the effect of internal curing" and give consumers the impression that the concrete admixture provides internal curing when, in fact, the products "do[] not contain or execute internal curing".

244. By selling concrete admixtures under the mark INTERNAL CURE® and promoting or alleging internal curing of concrete with said products, Defendant has likely deceived and continues to deceive consumers into believing that the concrete admixtures provide internal curing of concrete.

245. Defendant knows that its INTERNAL CURE® admixture product does not "contain or execute" internal curing of concrete, as admitted in SPI's argument to the USPTO in the '767 Application.

246. Defendant has, in commercial advertising or promotion, misrepresented that the concrete admixture sold under the INTERNAL CURE® mark provides internal curing, and has thereby misrepresented the nature, characteristics, or qualities of the INTERNAL CURE® admixture product.

247. Defendant advertises on Defendant's website that its E5® INTERNAL CURE® admixture product is the "first admixture proven to provide internal curing of concrete" in order to provide a false representation to consumers that the concrete admixtures provide internal curing.

248. The statement on Defendant's website that "E5® Internal Cure is the first admixture proven to provide internal curing of concrete" is literally false in view of SPI's admission to the USPTO that the product sold under the INTERNAL CURE® mark "does not contain or execute internal curing", in violation of 15 U.S.C. § 1125(a).

249. The statement on Defendant's website that "E5® Internal Cure is the first admixture proven to provide internal curing of concrete" is misleading in view of SPI's admission to the USPTO that the product sold under the INTERNAL CURE® mark "does not contain or execute internal curing", and such statement has actually deceived a significant portion of reasonable consumers.

250. Defendant's website explains what internal curing is by citing the American Concrete Institute's definition of "internal curing" despite Defendant's predecessor-in-interest SPI having argued to the USPTO in the '767 Application that the INTERNAL CURE® admixture product "does not contain or execute internal curing, including, notable [sic], as that term is defined by the American Concrete Institute".

251. Given SPI's explicit disclaimer to the USPTO of internal curing "as that term is defined by the American Concrete Institute", Defendant's website's inclusion of the American

Concrete Institute's definition of internal curing on a page promoting the internal curing of Defendant's E5® INTERNAL CURE® admixture product is misleading, and has actually deceived a significant portion of reasonable consumers.

252. Defendant has promoted its INTERNAL CURE® product in a manner which is explicitly contrary to the statements made by Defendant's predecessor-in-interest SPI to the USPTO in obtaining the trademark registration for INTERNAL CURE®.

253. Plaintiff is likely to be, and has been, damaged by Defendant's misrepresentations of the nature, characteristics, or qualities of Defendant's INTERNAL CURE® admixture products, in violation of 15 U.S.C. § 1125(a)(1)(B).

254. Defendant has promoted, and has provided advertising materials to its distributors to promote, Defendant's E5® admixture products as increasing the strength of concrete.

255. Statements that the E5® concrete admixture products increase strength misrepresent the nature, characteristics, or qualities of Defendant's E5® concrete admixture products.

256. Defendant has, in commercial advertising or promotion, misrepresented that its E5® concrete admixtures provide increased strength to concrete, and has thereby misrepresented the nature, characteristics, or qualities of the E5® concrete admixture products.

257. By selling concrete admixture products while promoting or alleging increased strength as a benefit from the concrete admixture products, Defendant has likely deceived and continues to deceive consumers into believing that the concrete admixtures provide increased strength.

258. Defendant's statements in advertising that the E5® admixture products provide increased strength are literally false.

259. Defendant's statements in advertising that the E5® admixture products provide increased strength are misleading in that the E5® admixture products do not actually provide increased strength, and such statements have actually deceived a significant portion of reasonable consumers.

260. Plaintiff is likely to be, and has been, damaged by Defendant's misrepresentations of the nature, characteristics, or qualities of Defendant's E5® concrete admixture products products, in violation of 15 U.S.C. § 1125(a)(1)(B).

PRAYER FOR RELIEF

WHEREFORE, Plaintiff seeks the following relief against Defendant:

- A. A judgment for Plaintiff on all Counts of the Complaint.
- B. A declaration that Plaintiff has not infringed, and is not infringing, directly or indirectly, the '658 Patent.
- C. A declaration that the '658 Patent is invalid.
- D. A declaration that the '658 Patent is unenforceable.
- E. A declaration that Plaintiff has not infringed, and is not infringing, directly or indirectly, the '823 Patent.
- H. A declaration that the '823 Patent is invalid.
- I. A declaration that the '823 Patent is unenforceable.
- J. An injunction against Defendant and its affiliates, subsidiaries, assignments, employees, agents, or anyone acting in privity or concert with Defendant, from instituting any legal action against Plaintiff for infringement of the '658 Patent or the '823 Patent.

K. Money damages adequate to compensate Plaintiff for its competitive injury resulting from Defendant's false marking of the E5® products as being "patented products" and a "patented system".

L. An order finding that this is an exceptional case and awarding Plaintiff its costs, expenses, disbursements, and reasonable attorneys' fees under 35 U.S.C. § 285 and all other applicable statutes, rules, and common law.

M. Money damages adequate to compensate Plaintiff for its damage resulting from Defendant's false advertising.

N. The costs of this action, pursuant to 15 U.S.C. § 1117(a).

O. An order finding that this is an exceptional case and awarding Plaintiff reasonable attorney fees as a prevailing party pursuant to 15 U.S.C. § 1117(a).

P. Such other further relief, in law or in equity, as this Court deems just.

JURY TRIAL DEMAND

Plaintiff demands a trial by jury for all claims and issues so triable.

Respectfully submitted,

/s/ Joseph W. Tucker
Joseph W. Tucker (Ohio bar # 0087951)
MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, 5th Floor
720 Water Street
Toledo, Ohio 43604-1853
Phone: (419) 255-5900
Fax: (419) 255-9639
tucker@mstfirm.com (E-mail)

J. Matthew Buchanan (Michigan bar # P61938)
MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, 5th Floor
720 Water Street
Toledo, Ohio 43604-1853
Phone: (419) 255-5900
Fax: (419) 255-9639
buchanan@mstfirm.com (E-mail)

Matthew J. Sorosiak (Ohio bar # 0098430)
MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, 5th Floor
720 Water Street
Toledo, Ohio 43604-1853
Phone: (419) 255-5900
Fax: (419) 255-9639
sorosiak@mstfirm.com (E-mail)

Joshua S. Higgins (Ohio bar # 0099581)
MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, 5th Floor
720 Water Street
Toledo, Ohio 43604-1853
Phone: (419) 255-5900
Fax: (419) 255-9639
higgins@mstfirm.com (E-mail)

John S. Shaffer (Ohio bar # 0001925)
Newcomer, Shaffer, Spangler & Breininger
117 West Maple Street
Bryan, Ohio 43506
Phone: (419) 636-3196
Fax: (419) 636-0867
jshaffer@nssblawoffice.com (E-mail)

Attorneys for Plaintiff
Premiere Concrete Admixtures LLC