

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

NANOBEBE US INC.	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. _____
	)	
MAYBORN (UK) LIMITED, MAYBORN	)	JURY TRIAL DEMANDED
USA, INC., MAYBORN GROUP	)	
LIMITED,	)	
	)	
Defendants.	)	

COMPLAINT FOR DECLARATORY JUDGMENT OF NON-INFRINGEMENT

Plaintiff Nanobebe US Inc. (“Plaintiff” or “Nanobebe”), for its Complaint against Defendants Mayborn (UK) Limited (“Mayborn UK”), Mayborn USA, Inc. (“Mayborn USA”), and Mayborn Group Limited (“Mayborn Group”) (collectively “Mayborn”) seeking declaratory judgment of non-infringement as to U.S. Patent No. 10,952,930 (“930 patent” or “Asserted Patent”), alleges as follows:

NATURE OF THE ACTION

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

THE PARTIES

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

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

5. Nanobebe sells innovative baby products designed for “today’s modern parents and their lifestyles.” <https://www.nanobebe.com/pages/about>. Nanobebe’s innovative baby products include a unique bottle, designed to solve problems that accompanying heating breast milk above body temperature. <https://www.nanobebe.com/pages/the-science>. For example, Nanobebe’s unique bottle includes a concave design that spreads breast milk out onto a thin layer across a wide surface area, which allows breast milk to cool and warm more quickly than traditional bottles. (*Id.*)

6. Nanobebe’s baby products have been featured on national news outlets, including CNN and Time Magazine, and on several parenting and pregnancy websites, including the BUMP, BabyCenter, Popsugar, Fatherly, and Scary Mommy. <https://www.nanobebe.com/pages/press-awards-articles>.

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

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

9. On information and belief, in or around September 2018, Mayborn UK changed its name from Jackel International Limited (“Jackel”) to Mayborn (UK) Limited. A true and correct copy of the Certificate of Incorporation on Change of Name is attached as Exhibit 2.

10. On information and belief, Mayborn UK is the assignee of the Asserted Patent. (Exhibit 2.)

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

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

JURISDICTION AND VENUE

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

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

15. On August 11, 2021, Nanobebe received a notice of an infringement accusation (“notice”) through its Amazon message portal. A true and correct copy of the August 11, 2021 notice is attached as Exhibit 3. The August 11, 2021 notice states that Amazon is “contacting you because we received a report from a rights owner that your listings infringe their patent rights.” The August 11, 2021 notice identified the allegedly infringed patent number as the Asserted Patent. In addition, the August 11, 2021 notice provided the contact information for the owner of the Asserted Patent as “Jane Du, jdu@mayborngroup.com.”

16. On information and belief, Ms. Jane Du is IP Counsel at Mayborn Group.

17. On August 30, 2021, Mr. Ayal Lanternari, CEO and Co-founder of Nanobebe sent a letter to Ms. Du in response to the August 11, 2021 notice. A true and correct copy of the August 30, 2021 letter is attached as Exhibit 4. In the letter, Mr. Lanternari stated that “Nanobebe respects valid

intellectual property rights,” and noted that Mayborn “did not provide sufficient information for the patent infringement allegation made.” Accordingly, Mr. Lanternari requested “an asserted claims chart or other pertinent information.” (Exhibit 4.)

18. On August 31, 2021, on behalf of Mayborn, Ms. Du sent an email response to Mr. Lanternari’s August 30, 2021 letter, attaching a copy of the Asserted Patent and two claim charts. The first claim chart alleged that the Nanobebe Plastic Bottle (ASIN: B07CXSBNM4) infringed claims 14, 16, 17 and 19 of the Asserted Patent. The second claim chart alleged that the Nanobebe Silicone Bottle (ASIN: B08J44MZPF) infringed claims 14, 16, 17 and 19 of the Asserted Patent. In addition, Ms. Du stated in her email that Mayborn “has the right exclude the selling and offering for sale (in addition to making, using, and importing) of products that infringe its patents” and that “Mayborn is entitled to take all available actions to protect its patent rights.” A true and correct copy of Ms. Du’s August 31, 2021 email and the claim charts is attached as Exhibit 5.

19. On September 15, 2021, Mr. Lanternari sent an email to Ms. Du in response to Ms. Du’s August 31, 2021 email informing Ms. Du that “[i]t’s currently the high holiday season in Israel” and Nanobebe’s “offices are mainly closed” until the end of September. In addition, Mr. Lanternari informed Ms. Du that Nanobebe is “reviewing the materials” that she provided in her August 31, 2021 email and that Nanobebe “will respond after the holidays have concluded and [they] return to work.” A true and correct copy of Mr. Lanternari’s September 15, 2021 email is attached as Exhibit 6.

20. Despite Mr. Lanternari’s September 15, 2021 email, Mayborn did not wait for a response from Nanobebe. Rather, Mayborn took further action with Amazon in an effort to remove Nanobebe’s products from Amazon prior to the end of September.

21. Specifically, on September 23, 2021, Nanobebe received an email from patent-evaluation@amazon.com, which was titled “Notice: Amazon Utility Patent Neutral Evaluation

Process – Action Required.” The September 23, 2021 email stated that Amazon “received a report from a patent owner who believes the items listed at the end of this email infringe their U.S. Patent No. 10,952,930.” The items listed include Nanobebe’s bottles having the following Amazon Standard Identification Numbers (“ASIN”): B07CL9TG2R, B07CZL6B85, B08J41KYH1, B08C5HPRKJ, B07CXSBNM4, B07FS49DPD, B08J44MZPF, B08DYBLG9T, B07CKNNTL1, B07FS9N3BY, B07FS2C1GH, B09448HFXX, B07CXSH82F, B08C5K4XTD, B07FS44T22, B0944B2FK7, B07D39ZMDJ, B08J3Y1ZFY, B07XM8ZP6X, B0944B4549 (collectively, “Accused Products”). A true and correct copy of the September 23, 2021 email is attached as Exhibit 7.

22. The September 23, 2021 email attached a copy of an Amazon Utility Patent Neutral Evaluation Agreement, which was executed by Mr. Timothy Ardizzone, identified as counsel for Mayborn. In the executed Evaluation Agreement, Mayborn identified Mayborn UK as the Patent Owner, and identified Mayborn USA and Mayborn Group as “corporate parents, subsidiaries, or other entities related to” Mayborn UK. In addition, Mayborn identified claim 14 of the Asserted Patent as the “Patent Claim number for Evaluation.” A true and correct copy of Mayborn’s executed Evaluation Agreement is attached as Exhibit 8.

23. The September 23, 2021 email provided Nanobebe with two options for continuing to sell the Accused Products on Amazon: (1) “resolve [the] claim with the patent owner directly,” or (2) “participate in neutral evaluation of the patent owner’s claim.” (Exhibit 7.) The September 23, 2021 email set a 3-week time period for Nanobebe to make its choice. (Exhibit 7.)

24. The September 23, 2021 email also attached a copy of Amazon’s Utility Patent Neutral Evaluation Procedure. A true and correct copy of Amazon’s Utility Patent Neutral Evaluation Procedure (“NEP”) is attached as Exhibit 9. The NEP stated that “[i]f there is litigation pending on a

patent subject to a proposed pending Evaluation, Amazon may decide not to initiate or suspend an Evaluation until the completion of that litigation.” (Exhibit 9.)

25. The September 23, 2021 email concluded by stating that “[i]f [Nanobebe] do[es] not either resolve your claim with the patent owner directly, or agree to participate in the neutral evaluation process, [Amazon] will remove the [Accused Products] from Amazon.com.” (Exhibit 7.)

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

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

28. In addition, this Court has general personal jurisdiction over Mayborn UK and Mayborn Group because Mayborn UK and Mayborn Group operate in concert with Mayborn USA. On information and belief, Mayborn Group is a global organization, having “regional commercial offices.” (Exhibit 10, <http://www.mayborngroup.com/>.) On information and belief, Mayborn Group’s regional commercial offices include Mayborn UK and Mayborn USA. (*Id.*) In addition, on information and belief, Mayborn UK’s, Mayborn Group’s, and Mayborn USA’s employees work in concert so that there is no corporate separation among the employees. For example, Mayborn identified Mayborn UK as the owner of the Asserted Patent in Mayborn’s executed Amazon Utility Patent Neutral Evaluation Agreement, while the August 11, 2021 notice from Amazon provided the “rights owner’s contact information” as Ms. Du—IP Counsel for Mayborn Group. (Exhibit 3.) Further, on information and belief, Mayborn UK and Mayborn Group operate in the same office. In addition, Mr. Ludovic Galand, a General Manager for Mayborn Group contacted Nanobebe’s Co-Founder and Nutrits’ CEO, Mr. Asaf Kehat, regarding “strategic development projects,” and suggested that Mr. Galand’s “colleague Chris Parsons – President for Americas” meet Mr. Kehat since they “are both based in the

US.” (Exhibits 11-12.) Ms. Du, Mr. Parsons and Mr. Ludovic each have email addresses “@mayborngroup.com.” On information and belief, all Mayborn employees have email address “@mayborngroup.com.”

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

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

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

THE ASSERTED PATENT

32. The '930 patent is titled "Baby Bottle with Flexible Nipple." (Exhibit 1.) The '930 patent issued on March 23, 2021 from U.S. Patent Application No. 14/551,783, filed on November 24, 2014, to named inventors Arnold Rees, Ian Webb, Mark Armstrong and Tom Cotton.

33. On information and belief, the '930 patent is assigned to Mayborn UK.

THE PARTIES' DISPUTE CONCERNING THE ASSERTED PATENT

34. On information and belief, Mayborn is a global company selling baby products, including bottles and other products under the brand name "Tommee Tippee." (Exhibit 10.)

35. On information and belief, Mayborn knew about Nanobebe and the Accused Products prior to contacting Amazon in August 2021. On April 9, 2019, Mr. Kehat, received a message from Mr. Galand via LinkedIn. A true and correct copy of the April 9, 2019 correspondence is attached as Exhibit 11. The message states that Mr. Galand was "Tommee Tippee Regional President for EMEA Region and we are reviewing strategic opportunities, so may be interesting to get to know each other better." (Exhibit 11.) On information and belief, Mr. Galand is a General Manager for Mayborn Group. (Exhibit 12.)

36. On April 11, 2019, Mr. Kehat sent a response to Mr. Galand stating that he is "happy to schedule a video conf call and get to know each other." (Exhibit 11.)

37. On May 16, 2019, Mr. Galand emailed Mr. Kehat stating "[w]e have been in contact through LinkedIn a few weeks ago as I was proposing to meet and get to know each other and our Companies better as we operate in the same Categories" and that Mayborn was "working on strategic development projects." A true and correct copy of the May 16, 2019 email is attached as Exhibit 12. The email concludes stating "[i]n fact it may be easier that my colleague Chris Parsons – President for

Americas (here in copy) see how you can meet together, as you are both based in the US. I let Chris contact you and hope you will agree to a meeting to get this introduction.” (Exhibit 12.)

38. On July 2, 2019, Mr. Parsons emailed Mr. Kehat stating that “[i]t would be great to connect at some point in the next couple of weeks if you are available and I’d be happy to come down from Stamford to meet at your convenience or we can set up an introductory call.” (Exhibit 12.)

39. Following the communications between Mr. Kehat and Mayborn in 2019, Mr. Kehat received emails from Mr. Alex Moody of Finquest in June, July, and August of 2020. Mr. Moody, who was working on behalf of Mayborn, informed Mr. Kehat that Mayborn was “hoping to engage with you in order to discuss the potential of investing in, acquiring, or setting up a strategic partnership with [Nanobebe].” True and correct copies of the June, July, and August 2020 emails are attached as Exhibit 13.

40. During the above-referenced communications, Mayborn and its agents or representatives did not inform Nanobebe that Mayborn owned any patents or pending patent applications.

41. On information and belief, Mayborn contacted Amazon regarding Nanobebe’s alleged infringement of the ’930 patent on or around August 11, 2021. Mayborn did not inform Nanobebe of the ’930 patent or Nanobebe’s alleged infringement of the ’930 patent prior to contacting Amazon. Nanobebe was not aware of the ’930 patent prior to the August 11, 2021 notification from Amazon.

FIRST CLAIM FOR RELIEF

(Declaratory Judgment of Non-Infringement of the ’930 Patent)

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

43. Nanobebe has not infringed and does not infringe any claim of the ’930 patent directly or indirectly, either literally or under the doctrine of equivalents.

44. For example, and without limitation, claim 14 of the '930 patent requires: "a teat portion having a variable wall thickness including an aperture." Nanobebe does not practice this limitation because, at a minimum, the Accused Products do not have "a teat portion having a variable wall thickness including an aperture" as defined in the specification of the '930 patent.

45. In addition, for example, and without limitation, claim 14 of the '930 patent also requires: "a base portion having a domed configuration." Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the "base portion" in each claim chart (Exhibit 5) does not have "a domed configuration" as defined in the specification of the '930 patent.

46. Further, for example, and without limitation, claim 14 of the '930 patent requires: "an areola portion between the teat portion and the base portion." Nanobebe does not practice this limitation because, at a minimum, the portion of the Accused Products that Mayborn alleges demarcates the "areola" in each claim chart (Exhibit 5) is not "an areola portion between the teat portion and the base portion" as defined in the specification of the '930 patent.

47. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Nanobebe and Mayborn concerning the non-infringement of the '930 patent.

48. Nanobebe is therefore entitled to a declaratory judgment that it has not infringed the '930 patent, directly or indirectly, either literally or under the doctrine of equivalents.

PRAYER FOR RELIEF

WHEREFORE, Nanobebe respectfully request the following relief:

A. That the Court enter a judgment declaring that Nanobebe has not infringed and does not infringe any claim of the '930 patent, directly or indirectly, either literally or under the doctrine of equivalents;

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

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

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

DEMAND FOR JURY TRIAL

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

DATED: October 13, 2021

GREENBERG TRAURIG, LLP

By: /s/ Julie P. Bookbinder

Julie P. Bookbinder
bookbinderj@gtlaw.com
Elana B. Araj
araje@gtlaw.com
GREENBERG TRAURIG, LLP
MetLife Building
200 Park Avenue
New York, NY 10166
Telephone: 212.801.9200
Facsimile: 212.801.6400

Laurin Buettner (*pro hac vice forthcoming*)
buettnerl@gtlaw.com
GREENBERG TRAURIG, LLP
500 Campus Drive, Suite 400
Florham Park, NJ 07932
Telephone: 973.360.7900
Facsimile: 973.301.8410

Attorneys for Plaintiff Nanobebe US Inc.