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VIA ECF

Hon. Gregory H. Woods
United States District Court for the Southern District of New York
500 Pearl Street, Room 2260
New York, NY 10007

Re: *Nanobebe US Inc. v. Mayborn (UK) Limited, et al.*, No. 1:21-cv-8444-GHW (S.D.N.Y.)

Dear Judge Woods:

Pursuant to the Notice of Initial Pretrial Conference dated October 14, 2021 (Dkt. 13), Plaintiff Nanobebe US Inc. ("Nanobebe") and Defendants Mayborn (UK) Limited, Mayborn USA, Inc., and Mayborn Group Limited (collectively, "Mayborn") (together, the "Parties") hereby submit this joint status letter.

(1) A brief statement of the nature of the case, the principal claims and defenses, and the major legal and factual issues that are most important to resolving the case, whether by settlement or dispositive motion.

Joint Submission: This is a patent case concerning baby feeding bottles. Nanobebe brought this action for declaratory judgment of non-infringement concerning U.S. Patent No. 10,952,930 ("the '930 patent") entitled "Baby Bottle with Flexible Nipple Regions." On or before January 13, 2022, Mayborn expects to bring a counterclaim for infringement of that patent and a separate claim for infringement of a newly issued patent in the same family. In response, Nanobebe expects to assert affirmative defenses including invalidity of the patents asserted by Mayborn. Both Parties seek any additional relief as the Court sees fit.

The Parties differ on how best move forward to resolve the case and their respective positions are set forth below.

Nanobebe's Position: Nanobebe proposes that the Parties follow the District's Local Patent Rules and exchange infringement and invalidity contentions prior to the claim construction process. Nanobebe further proposes that the Parties engage in discovery limited to claim construction issues

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prior to the *Markman* process, and defer the remainder of fact discovery until after the Court issues its claim-construction decision. Mayborn's proposal would prejudice Nanobebe by forcing Nanobebe to guess what the infringement disputes are when identifying disputed terms for construction. At present, Mayborn has not identified what claims of its newly issued patent will be asserted in the case, or against which of Nanobebe's products, so Nanobebe cannot respond to Mayborn's contention that the issues are not complex. While Mayborn relies on Judge McMahon's individual rules to support its position, parties in patent cases on Judge McMahon's docket still exchange infringement and invalidity contentions prior to the *Markman* process. *See, e.g., Perry Street Software, Inc. v. Jedi Techs, Inc.*, 20 Civ. 4539, Scheduling Order and Written Order Denying Stay (Jan. 26, 2021) (Dkt. No. 76). Further, Mayborn's proposal would prevent Nanobebe from fully developing its claim construction positions and is contrary to the law. It is well-settled that, in forming their claim construction opinions, district courts may "rely on extrinsic evidence, which consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (citations omitted). That Mayborn may not believe extrinsic evidence is necessary, does not mean that Nanobebe should be precluded relying on it. Accordingly, Nanobebe requests that the Court adopt Nanobebe's proposed schedule.

Mayborn's Position: Mayborn believes that the best way forward is to stay all discovery until after the Court issues its claim-construction decision. This approach makes particular sense here because the claim construction issues are likely to be dispositive on the question of infringement, and the patents at issue relate to mechanical technologies that are not complex. In addition, Mayborn has provided to Nanobebe infringement claim charts concerning the '930 patent and will also do that with respect to the other soon-to-be asserted patent in the same family. So prior to the *Markman* proceedings, Nanobebe will be fully apprised of Mayborn's infringement reads. Moreover, it will be simple to produce the entire intrinsic record for both patents, which Mayborn will do soon. Finally, given the nature of the technology and the to-be construed claims, Mayborn believes that no expert testimony or inventor testimony will be needed for resolution of the claim construction issues.

For all these reasons, Mayborn submits that it will be useful to proceed in this case the way Judge McMahon does in all of her patent cases, regardless of complexity. For the Court's reference, Judge McMahon's individual rules of practice for patent cases state:

Judge McMahon first assesses claim construction in patent cases, absent some compelling reason to do otherwise. She requires papers limited to intrinsic evidence before she allows any discovery. Keep that in mind when discussing a proposed schedule.

This common-sense approach to dealing with patent cases makes particular sense here for the reasons explained above. Mayborn's proposed claim construction schedule can be found in the supplement to Your Honor's case management form, filed concurrently herewith.

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(2) A brief statement by plaintiff as to the basis of subject matter jurisdiction and venue, and a brief statement by each party as to the presence or absence of subject matter jurisdiction and venue. Statements shall include citations to relevant statutes.

Nanobebe's Position: This Court has subject matter jurisdiction 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. An actual and justiciable controversy exists between Nanobebe and Mayborn as to the non-infringement of the Asserted Patent, because Mayborn affirmatively alleged that certain of Nanobebe's baby bottle products sold on Amazon infringe the '930 patent. (Dkt. 1, ¶¶13-26.)

In addition, venue is proper as to each Defendant in this District pursuant to 28 U.S.C. § 1391. Specifically, 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). (Dkt. 1, ¶31.)

Mayborn's Position: Mayborn agrees with Nanobebe that subject matter jurisdiction and venue are proper in this case.

(3) A brief description of any (i) motions that any party seeks or intends to file, including the principal legal and other grounds in support of and opposition to the motion, (ii) pending motions, and (iii) other applications that are expected to be made at the status conference.

Joint Submission: There are no pending motions and neither Party expects to make any applications at the status conference. The Parties will be working together soon on a Stipulated Confidentiality Agreement and Protective Order based on the Court's Form of Protective Order. Nanobebe expects to seek certain additional provisions including an Attorneys' Eyes Only tier of confidentiality, a prosecution bar, and procedures governing disclosure of expert witnesses prior to sharing Confidential Discovery Material. The Parties will work together on these additional provisions and will raise any disagreements with the Court, if necessary.

Following claim construction and fact and expert discovery, Nanobebe intends to file at least a motion for summary judgment of non-infringement.

(4) A brief description of any discovery that may be necessary for the resolution of this matter.

Joint Submission: While the Parties disagree on whether to exchange infringement and invalidity contentions prior to the *Markman* briefing and whether any other *Markman*-related discovery is appropriate prior to the *Markman* briefing, the Parties anticipate that after the *Markman* ruling normal patent-case discovery will be required on issues of infringement, validity, and damages in

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addition to any other discovery that is relevant to the Parties' claims and defenses and proportional to the needs of the case.

(5) A statement describing the status of any settlement discussions and whether the parties would like a settlement conference.

Joint Submission: The Parties have had multiple settlement discussions, on their own and through counsel. The settlement discussions have not yet been successful. The Parties hope that they can reach an agreement and request a referral to the SDNY Mediation Program for an initial session early in the case. As noted in the Parties' disputed proposed case-management form, Nanobebe believes it will be most productive to begin the mediation process after Mayborn serves its infringement contentions. Mayborn believes it will be most productive after the Parties exchange their respective proposed claim constructions for the disputed terms.

(6) Any other information the parties believe may assist the Court in resolving the action.

Nanobebe's Position: Nanobebe requests that the Court enter a schedule in which the Parties exchange infringement and invalidity contentions per the District's Local Rules and engage in claim construction discovery prior to *Markman* proceedings, and thereafter engage in the remainder of fact discovery. Thus, Nanobebe requests that the Court enter its proposed schedule submitted to the Court via email on the Court's form Proposed Case Management Plan and Scheduling Order, which proposes a longer overall timeline for discovery than provided by the Court's default instructions. Nanobebe proposes a longer timeline because this is a patent case that presents complex technical and legal issues including, without limitation, claim construction. Nanobebe believes that claim construction must be resolved before the close of fact discovery so that they can take fact discovery on issues impacted by the Court's claim construction order. In addition, two of the defendants—Mayborn (UK) Limited and Mayborn Group Limited—are foreign companies, and Nanobebe's proposed schedule provides time to obtain discovery from these defendants. Nanobebe further proposes that it would be most efficient for the Parties to participate in an alternative dispute resolution mechanism after Mayborn serves its infringement contentions.

Mayborn's Position: Mayborn requests that the Court stay all discovery until after the Court's ruling on claim construction and that the parties engage in ADR after the exchange of proposed constructions for the disputed claim terms. Mayborn suggests that if the case is not resolved during *Markman* proceedings or after the Court's claim construction ruling, the parties work together to propose a case schedule after *Markman* that is consistent with both the Local Patent Rules and Your Honor's form case-management plan.

In the event that the Court elects to issue a complete schedule now, Mayborn urges the Court to implement a fast schedule. The issues of infringement, validity, and damages in this patent case are not complicated. Discovery related to these issues, particularly concerning the publicly available and widely distributed accused products will be quite limited. And that certain defendants are in the UK will not impede discovery in any way. As such, a fast schedule is warranted and there is no basis for the protracted and delayed schedule that Nanobebe proposes. Indeed, the event deadlines that Nanobebe proposes in the submitted case-management form are in general much longer than they need to be for a patent case of this type. There is no basis to

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deviate from Your Honor's typical case-scheduling practices and in this case a faster schedule is warranted, although as noted above Mayborn believes that the most efficient way forward is to stay all discovery and proceed to an early *Markman*.

Respectfully Submitted,

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