

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

AMERICAN FUJI SEAL, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 24-1215 (MN)
	)	
BROOK + WHITTLE LTD,	)	
	)	
Defendant.	)	

**BROOK + WHITTLE’S MOTION TO DECLINE JURISDICTION, DISMISS, OR STAY
PURSUANT TO THE FIRST-TO-FILE RULE AND ALTERNATIVE MOTION TO
DISMISS UNDER FED. R. CIV. P. 12(B)(1)**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. BACKGROUND	3
III. LEGAL STANDARD.....	4
IV. ARGUMENT	7
A. AFS’s Complaint Should Be Dismissed Pursuant to the First-to-File Rule	7
1. AFS’s Complaint Is Duplicative Over the Texas Action.....	7
2. No Exception to the First-to-File Rule Applies	9
a. There is No Gamesmanship, Forum Shopping, or Bad Faith	9
b. The Customer Suit Exception Does Not Apply	9
i. B+W Sued the Manufacturer in Texas.....	10
ii. Nestlé Is Not Merely a Customer or Reseller	12
c. AFS Is Not a Necessary or Desirable Party in the Texas Action.....	14
d. The Convenience Factors Do Not Favor Delaware	15
3. Public Policy Would Best Be Served By Proceeding Only with the Texas Action	18
B. This Court Should At Least Stay this Case Until EDTX Rules on the First- to-File Issue.....	18
C. This Case Should Be Dismissed for Lack of Subject Matter Jurisdiction.....	18
V. CONCLUSION.....	20

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Allen Med. Sys., Inc. v. Mizuho Orthopedic Sys., Inc.</i> , No. CV 21-1739-CFC, 2022 WL 1046258 (D. Del. Apr. 7, 2022)	17
<i>Apeldyn Corp. v. Sony Corp.</i> , 852 F. Supp. 2d 568 (D. Del. 2012)	14
<i>Ballentine v. United States</i> , 486 F.3d 806 (3d Cir. 2007)	6, 19
<i>Bambuser AB v. SITO Mobile R&D IP, LLC</i> , No. CV 23-21757, 2024 WL 4024174 (D.N.J. Sept. 3, 2024)	6, 13, 19, 20
<i>Bockman v. First Am. Mktg. Corp.</i> , 459 F. App'x 157 (3d Cir. 2012)	11
<i>Candid Care Co. v. Smiledirectclub, LLC</i> , No. CV 20-1764-CFC, 2021 WL 3269092 (D. Del. July 30, 2021)	9, 18
<i>Collectis S.A. v. Precision Biosciences, Inc.</i> , 881 F. Supp. 2d 609 (D. Del. 2012)	5, 19
<i>Cisco Sys., Inc. v. Synqor, Inc.</i> , No. CIV.A. 11-86, 2011 WL 1326062 (D. Del. Apr. 1, 2011)	14
<i>Citrix Sys., Inc. v. Parallel Networks Licensing, LLC</i> , No. CV 19-2005-LPS, 2020 WL 2309073 (D. Del. May 8, 2020), <i>report and recommendation adopted sub nom. Citrix Sys., Inc. v. Parallel Networks Licensing, LLC</i> , No. CV 19-2005-LPS, 2020 WL 8079822 (D. Del. June 4, 2020)	10
<i>Commc'ns Test Design, Inc. v. Contec, LLC</i> , 952 F.3d 1356 (Fed. Cir. 2020)	4, 5, 6, 12
<i>E.E.O.C. v. Univ. of PA</i> , 850 F.2d 969 (3d Cir. 1988), <i>aff'd</i> , 493 U.S. 182 (1990)	5
<i>Foreman v. Lowe</i> , 261 F. App'x 401 (3d Cir. 2008)	11
<i>Futurewei Techs., Inc. v. Acacia Rsch. Corp.</i> , 737 F.3d 704 (Fed. Cir. 2013)	5, 6, 14

<i>Jumara v. State Farm Ins. Co.</i> , 55 F.3d 873 (3d Cir. 1995).....	15, 16, 17
<i>Jurimex Kommerz Transit G.M.B.H. v. Case Corp.</i> , 65 F. App'x 803 (3d Cir. 2003)	11
<i>Kahn v. Gen. Motors Corp.</i> , 889 F.2d 1078 (Fed. Cir. 1989).....	10, 11, 12
<i>In re Link A Media Devices Corp.</i> , 662 F.3d 1221 (Fed. Cir. 2011).....	15
<i>MedImmune, Inc. v. Genentech, Inc.</i> , 549 U.S. 118 (2007).....	19
<i>Microsoft Corp. v. DataTern, Inc.</i> , 755 F.3d 899 (Fed. Cir. 2014).....	6, 19, 20
<i>Neste Oil OYJ v. Dynamic Fuels, LLC</i> , No. CV 12-1744-GMS, 2013 WL 3353984 (D. Del. July 2, 2013).....	18
<i>Nexon Am. Inc. v. Uniloc 2017 LLC</i> , No. CV 19-1096-CFC, 2020 WL 3035647 (D. Del. June 5, 2020)	6, 12, 14, 15
<i>In re Nitro Fluids L.L.C.</i> , 978 F.3d 1308 (Fed. Cir. 2020).....	15
<i>Papst Licensing GmbH & Co. KG v. Lattice Semiconductor Corp.</i> , 126 F. Supp. 3d 430 (D. Del. 2015).....	16, 17, 18
<i>Phillips v. Cnty. of Allegheny</i> , 515 F.3d 224 (3d Cir. 2008).....	11
<i>Pinker v. Roche Holdings Ltd.</i> , 292 F.3d 361 (3d Cir. 2002).....	11
<i>Pragmatus Telecom, LLC v. Advanced Store Co.</i> , No. CV 12-088-RGA, 2012 WL 2803695 (D. Del. July 10, 2012).....	10, 11
<i>Roadie, Inc. v. Baggage Airline Guest Servs., Inc.</i> , No. CV 17-1079, 2017 WL 11506886 (D. Del. Nov. 2, 2017)	8
<i>Roku, Inc. v. AlmondNet, Inc.</i> , No. CV 21-1035-MN, 2021 WL 5299247 (D. Del. Nov. 15, 2021).....	5, 6, 9
<i>Rovi Corp. v. Haier Grp. Corp.</i> , No. CV 11-1140 (KAJ), 2013 WL 4534641 (D. Del. Aug. 23, 2013)	9

<i>Samsara Inc. v. Motive Techs., Inc.</i> , No. CV 24-84 (MN), 2024 WL 3822981 (D. Del. Aug. 14, 2024)	15, 16, 17
<i>Samsung Elecs. Co. v. Netlist, Inc.</i> , No. CV 21-1453-RGA, 2022 WL 3027312 (D. Del. Aug. 1, 2022).....	6, 7
<i>Teleconference Sys. v. Proctor & Gamble Pharms., Inc.</i> , 676 F. Supp. 2d 321 (D. Del. 2009).....	5
<i>Time Warner Cable, Inc. v. GPNE Corp.</i> , 497 F. Supp. 2d 584 (D. Del. 2007).....	5, 8, 9
<i>Time Warner Cable, Inc. v. USA Video Tech. Corp.</i> , 520 F. Supp. 2d 579 (D. Del. 2007).....	2, 8, 9
<i>WiTricity Corp. v. Ideanomics, Inc.</i> , C.A. No. 24-895-JLH, D.I. 15 (D. Del. Sept. 9, 2024).....	1
Statutes	
28 U.S.C. § 2201(a)	4
Rules	
D. Del R. Civ. P. 3.1(b)(3).....	1
Fed. R. Civ. P. 12.....	<i>passim</i>

Defendant Brook + Whittle LTD (“B+W”) respectfully brings this motion to decline jurisdiction and to dismiss Plaintiff American Fuji Seal, Inc.’s (“AFS”) Complaint (D.I. 1) pursuant to the first-to-file rule because this action follows B+W’s first-filed action on the same subject matter in the Eastern District of Texas (“E.D. Tex.”). Alternatively, B+W seeks to stay this case pending the resolution of the first-filed Eastern District of Texas case for the same reasons, or at least pending the resolution of a parallel motion in that district to enjoin prosecution of the present declaratory judgment action based on the first-to-file rule. Finally, in the alternative, B+W seeks dismissal of this action pursuant to Rule 12(b)(1) for lack of standing.

I. INTRODUCTION

This recently-filed case is completely identical in Asserted Patent, Accused Products, and virtually identical in parties to a case that was already pending in the Eastern District of Texas. There, Brook + Whittle LTD (“B+W”) accused Fuji Seal Intl., Inc. (“Fuji”) and its co-developer and customer Nestlé USA, Inc. (“Nestlé”) of infringing the 11,961,422 (’422 Patent) through their manufacture, use, and sale of Fuji’s RecShrink with light-blocking technology. That case has been pending for months, is in discovery, and already has a trial date set. *See, e.g.*, Ex. 1 (Complaint in *Brook + Whittle LTD v. Nestlé USA, Inc., Fuji Seal Int’l, Inc.*, Case No. 2:24-cv-00735-JRG-RSP (“*B+W v. Fuji*” or the “Texas Action”), D.I. 1, 12, 14, 15 (E.D. Tex.).¹

In a transparent attempt to forum-shop and in violation of fundamental first-to-file principles, Fuji’s wholly-owned and controlled subsidiary, American Fuji Seal, Inc (“AFS”), has filed this identical lawsuit seeking declaratory judgment that it does not infringe the same patent,

¹ In contravention of D. Del. LR 3.1(b)(3), Plaintiff also failed to indicate on its Civil Cover Sheet that this matter is related to the Texas Action. *See* D.I. 1–3; *See also WiTricity Corp. v. Ideanomics, Inc.*, C.A. No. 24-895-JLH, D.I. 15 (D. Del. Sept. 9, 2024) (dismissing case for failure to identify related matter on Civil Cover Sheet).

same products, for the same acts of infringement that underlie the Texas action. There is no meaningful difference between the substance and scope of the cases, and AFS' Complaint does not identify any justification for why its copy-cat complaint here in Delaware justifies violating the first-to-file rule or otherwise seeks any relief other than what is already being decided in Texas. It makes no difference that the parties differ slightly because the first-to-file rule applies when the two cases "involve[] the **same subject matter**, not necessarily the same parties." *Time Warner Cable, Inc. v. USA Video Tech. Corp.*, 520 F. Supp. 2d 579, 585 (D. Del. 2007) (emphasis added). And AFS does not dispute (nor can it) that the Texas Defendants—Fuji and Nestlé—were involved in the design, development, manufacture, and ultimate sale and use of the Accused Products, just as B+W properly alleged in Texas. Ex. 1 (*B+W v. Fuji*, D.I. 1), ¶¶ 21, 25, 31, 57 (E.D. Tex. Sep. 8, 2024). In sum, the first-to-file rule is designed to prevent the exact inefficiency that AFS seeks to introduce with this case, so this Court may decline to hear it, dismiss it, or stay it.

No exception to the first-to-file rule applies. First, there has been no improper gamesmanship, wasteful forum shopping, or other bad faith actions on B+W's part—nor does AFS make any such allegations in its complaint. Second, there is no "necessary and desirable" party missing from the Texas Action (and AFS is not a "necessary and desirable" party). Rather, the ultimate parent entity, as well as a co-developer and customer, are already included as defendants in the Texas Action. Third to the extent AFS seeks to invoke the customer-suit exception, this exception does not apply because the Texas Action is not a proceeding against a customer, but two designers and manufacturers of the accused products. Finally, the second-filed forum (*i.e.*, this District) is no more convenient than the first-filed forum in a way that would necessitate deviating from the first-to-file rule. Indeed, given AFS's delay in filing this suit, this action will be substantially behind the Texas action in providing a swift resolution of this dispute.

Judicial economy would also best be served by proceeding only with the Texas Action. Since AFS waited two months to file this case, the Texas Action is well ahead of this one—discovery has begun and a schedule has been entered—and the Eastern District of Texas offers a faster time to trial. Moreover, discovery from both Nestlé and Fuji is crucial in this case, and it will be far more efficient to seek discovery from them in the Texas Action where they are parties, rather than through burdensome third-party mechanisms here. There is no need for this Court to tread this same ground (and more) to resolve an identical dispute.

Alternatively, this Court should stay the case pending the resolution of the Texas Action, and at the very least, until the Eastern District of Texas rules on a motion to enjoin prosecution of this case based on the first-to-file rule. As a further alternative, the Court should dismiss this case for lack of subject matter jurisdiction under Rule 12(b)(1).

II. BACKGROUND

B+W is a leading manufacturer in the commercial printing, labels, and packaging industry as well as a global pioneer in recycling and sustainability. In fact, B+W was the first to design, manufacture, and sell recyclable light-blocking shrink sleeve labels.² It sells millions of labels each year implementing this technology and obtained the '422 Patent to protect this innovation. Both independent claims of the '422 Patent are directed to a “recyclable shrink label comprising . . . [a] light blocking layer.” Ex. 2 ('422 Patent) at Cls. 1, 19.

Earlier this year, in light of Fuji and Nestlé's use of the technology claimed by the '422 Patent, B+W attempted to negotiate a license for the '422 Patent with *inter alia*, Fuji's Executive

² Many consumable products (*e.g.*, dairy) may be degraded by light, requiring a light-blocking mechanism to preserve the products' quality. Certain product labels have performed a similar function in the past, but B+W's patented technology was the first to combine light-blocking technology into a fully recyclable shrink label.

Officer Satoru Kawasaki. Pollard Declaration, ¶ 4. After negotiations stalled, B+W filed the Texas Action in the Eastern District of Texas against Fuji and Nestlé on September 8, 2024. Ex. 1.

The Texas Action complaint alleges one sole count of infringement of the '422 Patent. *See id.* Per B+W's infringement contentions, the products accused of infringement are "any recyclable shrink sleeve labels sold by Fuji Seal in connection with American Fuji Seal that utilize . . . recyclable, light-blocking shrink sleeve label technology such as Fuji Seal's RecShrink with light-blocking technology." Ex. 3 (Texas Action Infringement Contentions) at 3

Two months after B+W's complaint in the Texas Action, AFS filed this "action for a declaratory judgment that American Fuji Seal does not infringe any claim of U.S. Patent No. 11,961,422." D.I. 1, ¶ 1 (filed November 4, 2024). The products AFS placed at issue are "certain of American Fuji Seal's shrink sleeve labels," which AFS ties to Nestlé, alleging that "[t]he sole basis for Nestlé's alleged infringement [in the Texas Action] is Nestlé's sale and other commercialization of Accused Products." *Id.*, ¶¶ 11, 14. However, Nestlé claims on its public-facing website that *Nestlé* itself has spent more than five years in research and development, to bring out the technology used in the accused products. Ex. 4 (Nestlé's website).

III. LEGAL STANDARD

The Declaratory Judgment Act provides that a district court "*may* declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought." 28 U.S.C. § 2201(a) (emphasis added). "Given the statute's use of the word 'may,' the Supreme Court has said that a district court has unique and substantial discretion in deciding whether to declare the rights of litigants." *Commc 'ns Test Design, Inc. v. Contec, LLC*, 952 F.3d 1356, 1361 (Fed. Cir. 2020) (internal quotation marks omitted).

"Under the first-to-file rule, a district court may choose to stay, transfer, or dismiss a later-

filed duplicative action” or decline jurisdiction, as discussed below.³ See *Commc’ns Test Design*, 952 F.3d at 1362. “The first-to-file rule reduces the possibility of dispositive differences between the jurisdictions and ensures that litigants receive a single determination of their controversy, rather than multiple decisions which may conflict and require separate appeals.” *Time Warner Cable, Inc. v. GPNE Corp.*, 497 F. Supp. 2d 584, 588 (D. Del. 2007). “Generally, as a principle of sound judicial administration, when two suits are filed involving similar issues and similar parties, the first suit should have priority absent special circumstances.” *Teleconference Sys. v. Proctor & Gamble Pharms., Inc.*, 676 F. Supp. 2d 321, 326–27 (D. Del. 2009). Moreover, the first-to-file rule “does not specifically require the exact identity of the parties. Historically, the Third Circuit has applied the first-to-file rule for cases involving *the same issues*.” *GPNE*, 497 F. Supp. 2d at 971 (citing *E.E.O.C. v. Univ. of PA*, 850 F.2d 969 (3d Cir. 1988), *aff’d*, 493 U.S. 182 (1990)). And “[a]pplication of the first-to-file rule is generally a matter for a district court’s discretion, exercised within governing legal constraints.” *Futurewei Techs., Inc. v. Acacia Rsch. Corp.*, 737 F.3d 704, 708 (Fed. Cir. 2013) (citations omitted).

To dispense with the first-to-file rule, “there must ‘be sound reason that would make it unjust or inefficient to continue the first-filed action.’” *Roku, Inc. v. AlmondNet, Inc.*, No. CV 21-1035-MN, 2021 WL 5299247, at *4 (D. Del. Nov. 15, 2021) (quoting *Commc’ns Test Design*, 952 F.3d at 1362). “Courts must be presented with exceptional circumstances before exercising their discretion to depart from the first-filed rule.” *Collectis S.A. v. Precision Biosciences, Inc.*, 881 F. Supp. 2d 609, 612 (D. Del. 2012). “The burden is on the party seeking to establish a compelling circumstances exception to the first-to-file rule.” *Roku*, 2021 WL 5299247, at *4.

³ B+W does not seek transfer of this case to the Eastern District of Texas, including because AFS is not a necessary and desirable party to the Texas Action, as explained further below.

Accordingly, with respect to declaratory judgment actions that are also duplicative of first-filed actions, “district courts enjoy a **‘double dose’ of discretion**: discretion to decline to exercise jurisdiction over a declaratory judgment action *and* discretion when considering and applying the first-to-file rule and its equitable exceptions.” *Commc’ns Test Design*, 952 F.3d at 1362 (citation omitted). Courts routinely exercise such discretion to decline jurisdiction over declaratory judgment actions in view of a first-filed action covering the same subject matter. *See, e.g., Samsung Elecs. Co. v. Netlist, Inc.*, No. CV 21-1453-RGA, 2022 WL 3027312, at *3–5 (D. Del. Aug. 1, 2022). In fact, “the general rule that the first-filed case is favored over the second-filed action **may be even stronger** where the second-filed action is for a declaratory judgment.” *Futurewei Techs.*, 737 F.3d at 707 (Fed. Cir. 2013) (internal quotation marks and alterations omitted). Similarly, “[t]he Federal Circuit **prefer[s]** that district courts decline to hear a declaratory judgment action if a first-filed case involves the same subject matter as the declaratory judgment action.” *Nexon Am. Inc. v. Uniloc 2017 LLC*, No. CV 19-1096-CFC, 2020 WL 3035647, at *2 (D. Del. June 5, 2020) (internal quotation marks and footnotes omitted, emphasis added).

Further, Federal Rule of Civil Procedure 12(b)(1) allows a court to dismiss an action for lack of subject-matter jurisdiction where the plaintiff lacks standing. *Ballentine v. United States*, 486 F.3d 806, 810 (3d Cir. 2007). The Federal Circuit has held that manufacturers do not “have a right to bring [] declaratory judgment action[s] solely because their customers have been sued for direct infringement.” *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 904 (Fed. Cir. 2014). This is especially true where the patent owner in the first-filed action “makes no mention of [the declaratory judgment plaintiff] in its Complaint at all.” *Bambuser AB v. SITO Mobile R&D IP, LLC*, No. CV 23-21757, 2024 WL 4024174, at *4 (D.N.J. Sept. 3, 2024).

IV. ARGUMENT

A. AFS's Complaint Should Be Dismissed Pursuant to the First-to-File Rule

1. AFS's Complaint Is Duplicative Over the Texas Action

At the outset, there can be no doubt that the first-to-file rule applies. The subject matter of this action is identical to the Texas Action. Both suits involve the same, sole patent: the '422 Patent. *See* D.I. 1, ¶ 20. *See B+W v. Fuji*, D.I. 1, ¶ 38; *see also Samsung Elecs.*, 2022 WL 3027312, at *3 (“In this case, I decline to exercise jurisdiction over the [portion of the litigation involving] patents that were originally filed in the Texas Action.”). Further, the two actions involve the same accused products. The products accused in the Texas Action are “any recyclable shrink sleeve labels sold by Fuji Seal [(i.e., Fuji)] *in connection with American Fuji Seal* that utilize . . . recyclable, light-blocking shrink sleeve label technology.” Ex. 3 at 3 (emphasis added). AFS makes clear that the accused products in this action are the same: “B+W later told American Fuji Seal that it would need a license to sell certain of American Fuji Seal’s shrink sleeve labels (‘Accused Products’).” D.I. 1, ¶ 11. Putting aside whether AFS’s allegations are accurate or relevant (because B+W ultimately discussed a potential license with Fuji executives, and was informed that such executives were necessary to resolution of the dispute),⁴ AFS’s allegations demonstrate that the only accused products in this action are recyclable heat shrink labels with a light-blocking component—the exact same accused products as in the first-filed case, whose manufacture, development, use, and sale are performed in concert with Fuji and Nestlé. Since both cases involve the same patent and the same accused products, it is plain that the first-to-file rule should apply to “avoid[] duplicative litigation over the same subject matter.” *Roadie, Inc. v.*

⁴ Despite the fact that resolution of this factual dispute has no bearing on the merits of this motion, B+W notes that AFS’s factual allegations are not entitled to any deference because this portion of the motion is not brought pursuant to Rule 12(b) or (c). *See infra*, n. 5.

Baggage Airline Guest Servs., Inc., No. CV 17-1079, 2017 WL 11506886, at *2 (D. Del. Nov. 2, 2017); *GPNE*, 497 F. Supp. 2d at 589–90 (“Since the two cases both involve the same facts and the same patent, trying the matter in two different courts would defeat the reasoning behind the first-to-file rule.”)

That AFS is a different (albeit wholly owned and related) entity than Texas Defendant Fuji makes no difference here. This Court has long recognized that “the first-filed rule [applies] to litigation that involves the same subject matter, not necessarily the same parties.” *USA Video Tech.*, 520 F.Supp.2d at 585. Instructively, in *Time Warner v. USA Video Tech.*, the patent owner sued TWI in the Eastern District of Texas, alleging infringement of one patent. *Id.* at 581. Two months later, an entity related to TWI named TWC brought a declaratory judgment action over that same patent in this District. *Id.* at 581, n. 10. The patent owner replaced TWI with TWC in the Texas action. *Id.* TWC argued that the first-to-file rule should not apply due to the different parties, including by “assert[ing] that the Texas case was not the first-filed action” “[b]ecause TWC was not listed as a party at the time the time it was filed.” *Id.* at 584. This Court disagreed:

TWC reasons that because it was not named as an original party in the Texas litigation, that its alleged infringement of the ’792 patent could not have been the subject of the Texas suit. In essence, TWC is arguing that the subject matter of the initial complaint in Texas litigation is not the same as the Delaware litigation because TWC was not originally named as a party. This argument is inconsistent with Third Circuit precedent which holds that ***first-filed rule applies if the subsequently filed action involves different parties***. TWCs interpretation of the first-filed rule would encourage rather than discourage duplicative suits, which would defeat the purpose of the rule.

Id. at 586–87 (citations and quotation marks omitted, emphasis added). Further, the Court found that the first-to-file rule applied because “both the Texas litigation and the present case deal with the ***same subject matter***” in that both suits “concern[ed] the alleged infringement ***of the same patent***” and “share[d] ***the same facts*** and deal with the ***same allegedly infringing products***.” *Id.*

at 586 (citation and internal quotation omitted, emphases added). Accordingly, the differences between the parties are irrelevant in the present case. Finding otherwise would encourage duplicative lawsuits. *See id.*

Even stronger here is the significant overlap between AFS and Fuji, which owns 100% of AFS. D.I. 4. AFS does not dispute that it is merely an “overseas office” of Fuji, or that AFS’s own CEO is an “Executive Officer” of Fuji. Ex. 21. AFS also does not have its own website apart from Fuji’s website, which states that “Staff of the Intellectual Property Division visit each Business base to exchange opinions with idea proposers and managers.” Ex. 5 at 12. *See Rovi Corp. v. Haier Grp. Corp.*, No. CV 11-1140 (KAJ), 2013 WL 4534641, at *1, *4 (D. Del. Aug. 23, 2013) (finding agency relationship where parent and subsidiary had overlapping directors, parent wholly owned subsidiary, parent and subsidiary shared similar names, and parent owned all IP); *see also* Pollard Decl., ¶¶ 2–3 (no allegations of incorrect parties).

2. No Exception to the First-to-File Rule Applies

No exception to the first-to-file rule applies here, as AFS cannot carry its burden to establish a “compelling circumstance[]” that would preclude application of the first-to-file rule. *Roku*, 2021 WL 5299247, at *4.

a. There is No Gamesmanship, Forum Shopping, or Bad Faith

“Gamesmanship,” “wasteful forum shopping,” or “bad faith” can provide a basis for an exception to the first-to-file rule, but there is no evidence of that here. *Candid Care Co. v. Smiledirectclub, LLC*, No. CV 20-1764-CFC, 2021 WL 3269092, at *3 (D. Del. July 30, 2021); *GPNE*, 497 F. Supp. 2d at 590. AFS does not make any allegations of gamesmanship, forum shopping, or bad faith in its complaint. *See generally* D.I. 1.

b. The Customer Suit Exception Does Not Apply

The customer suit exception does not apply here, as it is limited to circumstances where

“later filed litigation brought by the *manufacturer of infringing goods*” may “take precedence over an infringement suit by the patentee against customers of the manufacturer.” *Citrix Sys., Inc. v. Parallel Networks Licensing, LLC*, No. CV 19-2005-LPS, 2020 WL 2309073, at *9 (D. Del. May 8, 2020) (emphasis added), *report and recommendation adopted sub nom. Citrix Sys., Inc. v. Parallel Networks Licensing, LLC*, No. CV 19-2005-LPS, 2020 WL 8079822, at *1 (D. Del. June 4, 2020). This is because “[t]he customer suit exception is based on the manufacturer’s presumed greater interest in defending its actions against charges of patent infringement; and to guard against possibility of abuse.” *Kahn v. Gen. Motors Corp.*, 889 F.2d 1078, 1081 (Fed. Cir. 1989). In other words, the customer suit exception applies only “where the first suit is filed against a customer who is simply a reseller of the accused goods, while the second suit is a declaratory judgment action brought by the manufacturer of the accused goods.” *Id.* (emphasis added). And particularly relevant to this analysis is “whether the Manufacturer is the sole source of infringing products.” *Pragmatus Telecom, LLC v. Advanced Store Co.*, No. CV 12-088-RGA, 2012 WL 2803695, at *3 (D. Del. July 10, 2012). As explained in further detail below, none of these circumstances is present here, and the customer suit exception does not apply.

i. B+W Sued the Manufacturer in Texas

The policy justification for the customer suit exception—that a manufacturer who has not been sued has an interest in defending itself against infringement claims—is inapplicable here because B+W *did* sue the manufacturer in the Texas Action: Fuji. *See Kahn*, 889 F.2d at 1081; Ex. 1. B+W’s complaint in the Texas Action alleges that “Fuji Seal [International] manufactures the Accused Products.” *Id.*, ¶ 18.

Moreover, Fuji’s own website establishes that Fuji manufactures the accused products. Fuji’s website shows that it has U.S.-based offices and factories at least in Bardstown, Kentucky and Newton, North Carolina, and describes these facilities as “Our Global Locations,” while

referring to AFS as merely an “overseas office.” Exs. 6, 22. Similarly, Fuji’s 2023 annual investor report expressly calls the Bardstown factory “**our** Kentucky factory.” Ex. 7 at 28 (emphasis added). *See also* Ex. 8 (Fuji describing the “Emissions Trends and Reduction Efforts” of “[t]he Bardstown plant”). These facilities manufacture the Accused Products. *See* Exs. 9, 10.

Moreover, Fuji’s 2024 annual investor report states that Satoru Kawasaki is Fuji’s “Executive Officer (in charge of the American region).” Ex. 5 at 42. Fuji’s latest Notice of Director Personnel released on June 20, 2024 confirms the same. Ex. 11. Mr. Kawasaki’s LinkedIn page lists his location as “Bardstown, Kentucky.” Ex. 12. Fuji’s 2024 financial report further reports the revenues from “Shrink Labels” sold in the Americas, further indicating that Fuji is the manufacturer of these accused shrink labels. Ex. 13, at 21. In light of these statements taken from Fuji’s own website and public documents, it is clear Fuji thus manufactures the Accused Products. Accordingly, there is no need for AFS to “defend[] its actions against charges of patent infringement” in duplicative litigation in a different forum. *Kahn*, 889 F.2d at 1081.

Further, even if AFS is one source of infringing products,⁵ the exhibits and evidence above establish that AFS is not the “sole source of infringing products” as would be required to trigger the customer-suit exception. *See* Exs. 4, 9, 10; *Pragmatus Telecom*, 2012 WL 2803695, at *3 (“The three factors used to determine applicability of the Customer Suit Exception [include] whether the **Manufacturer is the sole source of infringing products.**”) (emphasis supplied) (citation omitted).

⁵ To the extent AFS argues that its allegations must be taken as true—namely, allegations that AFS is involved in the manufacture and supply of the Accused Products (D.I. 1, ¶¶ 10, 16)—AFS is incorrect because this portion of the motion is not brought pursuant to Rule 12(b) or 12(c). Courts in the Third Circuit routinely take such allegations as true only in the context of 12(b) and 12(c) motions. *See, e.g., Pinker v. Roche Holdings Ltd.*, 292 F.3d 361, 368 (3d Cir. 2002) (12(b)(2)); *Bockman v. First Am. Mktg. Corp.*, 459 F. App’x 157, 159 (3d Cir. 2012) (12(b)(3)); *Phillips v. Cnty. of Allegheny*, 515 F.3d 224, 231 (3d Cir. 2008) (12(b)(6)); *Jurimex Kommerz Transit G.M.B.H. v. Case Corp.*, 65 F. App’x 803, 805, 804 (3d Cir. 2003) (12(b)(7)); *Foreman v. Lowe*, 261 F. App’x 401, 403 (3d Cir. 2008) (12(c)).

Indeed, even if AFS's sparse allegation that it "manufactured and supplied [the] Accused Products to Nestlé" (D.I. 1, ¶ 16) is true, AFS does not dispute that both Fuji was also involved in (and controlled) that manufacture. Thus, AFS's pleading is insufficient as a matter of law to trigger the customer-suit exception and its duplicative second-filed case must be dismissed.

ii. Nestlé Is Not Merely a Customer or Reseller

The customer suit exception may apply when the alleged customer is "simply a reseller of the accused goods" (*Kahn*, 889 F.2d at 1081) but that is not the case here. Nestlé, the "customer" identified in the Texas Action, is no mere customer or consumer of the Accused Products. Rather, unlike circumstances where the customer suit exception applies, Nestlé is heavily involved in manufacturing the Accused Products, as demonstrated below by exhibit evidence.⁶ *See also* D.I. 1, ¶ 12. Specifically, Nestlé itself confirms that it took an active role in the research, design, testing, and use of the accused products, including with the following statements:

- "***Nestlé is converting*** its Nesquik ready-to-drink portfolio to a new recyclable shrink sleeve label made with light-blocking print technology that is compatible with the U.S. recycling stream, helping make the bottle easier for consumers to recycle."
- "***Nestlé is working across its portfolio*** to make all of its packaging recyclable or reusable, yet the path to a circular economy for food and beverage packaging comes with unique considerations."
- "***Developing a recyclable solution*** for the brand's shrink sleeve posed a significant technical challenge, as ready-to-drink Nesquik requires its sleeves to be light-blocking."
- "***When Nestlé first set out to transition*** its Nesquik bottles to a recyclable sleeve in 2019, there was no recyclable solution available in market yet that also leveraged the light-blocking features required for the product."
- "'Packaging protects food and beverages and helps ensure our products remain high-quality for our consumers,' said Chastity McLeod, VP Sustainability, Nestlé North America. 'It was essential to find a solution that would maintain the quality and shelf life of the product, while

⁶ Courts routinely consider facts laid out in exhibits in the context of a motion to dismiss based on the first-to-file rule. *See, e.g., Nexon*, 2020 WL 3035647, at *4; *Commc'ns Test Design*, 367 F. Supp. 3d at 353 n. 1.

also offering the benefit of making recycling the bottle easier for consumers. ***Our teams are constantly innovating*** to extend the use of packaging materials as a valuable resource that can be leveraged again—This innovation is a big step forward as we continue to drive progress on Nestlé’s packaging ambitions across our U.S. portfolio.”

- “***Five Years of [Nestlé] R&D*** to Bring the Solution to Life”
- “Multiple tests were conducted to ensure the technical viability across all seven Nesquik ready-to-drink flavors. This included ***light transmittance tests*** across more than 20 candidate materials, product shelf life studies, and the completion of plastics recyclability tests to ensure the new shrink sleeve and inks would remain compatible with the U.S. recycling system—these tests included ensuring the sleeved bottle would sort correctly when arriving at local recycling material recovery facilities (MRFs), and testing the sleeve inks to ensure they wash-off, so that the bottle and sleeve material have the ability to be turned into recycled plastic for future use.”
- “***Nestlé also conducted factory trials*** to ensure the new sleeve would run effectively on its factory production lines, making adjustments to optimize both the shrink sleeve and existing factory equipment throughout the process.”
- “***The team also trialed*** multiple different iterations of shrink sleeve artwork and ink combinations to ensure the new sleeve maintained Nesquik’s authentic look and feel.”
- “‘Our beverage division continues to be a leader in delivering high-quality, innovative products for our consumers, while also driving progress on Nestlé’s sustainability ambitions,’ said Daniel Jung, President of Nestlé USA’s beverage division. ‘It’s exciting to see ***Nesquik at the forefront*** of this packaging innovation. Making our products easier to recycle is important to our customers and consumers, and a key step in helping chart a path to a circular economy for packaging.’”

Ex. 4 (emphases added). Nestlé made similar statements in a video advertisement purporting to demonstrate its role in developing of the accused products. In fact, Nestlé’s Business Director described Nestlé’s development of the accused products as follows:

- “This was a really challenging process. The new sleeve ***took nearly five years to develop*** with multiple tests along the way to make sure that the light blocking inks are compatible with the U.S. recycling system.”

See <https://www.youtube.com/watch?v=EZz8pgrFI4c> at 0:32–0:45. Accordingly, Nestlé’s own actions make clear that Nestlé is “more than a mere reseller of goods” such that the “‘customer suit’ exception is inapplicable.” *Apeldyn Corp. v. Sony Corp.*, 852 F. Supp. 2d 568, 576 (D. Del.

2012) (finding customer suit exception did not apply where alleged customer issued press releases detailing its own efforts to “customize[]” the accused products).

c. AFS Is Not a Necessary or Desirable Party in the Texas Action

A limited exception to the first-to-file rule exists where the court presiding over the first-filed action would not be able to obtain “jurisdiction over all necessary or desirable parties.” *Futurewei*, 737 F.3d at 708 (modifications and citation omitted).⁷ To the extent AFS argues that the *Nexon* case shows that its absence from the Texas Action provides a basis for departing from the first-to-file rule, AFS is incorrect because *Nexon*’s reasoning does not apply here. *See Nexon*, 2020 WL 3035647. In *Nexon*, this Court held that a specific party absent from the first-filed suit “is a desirable if not necessary party” where that party submitted “unrebutted sworn declarations” that “[it] **alone** developed and manufactures the accused [] technology.” *Id.* at *4 (emphasis added). This reasoning does not apply to AFS. As explained above, Fuji (not AFS) developed the accused technology. Fuji’s 2024 Integrated Report for investors shows that it develops “[t]echnological advances” in “environmentally friendly labels” (or “light-blocking labels”) and “RecShrink.” Ex. 5 at 10. And in the Texas Action, B+W accused exactly this technology—and identified Fuji as the manufacturer—by accusing “any recyclable shrink sleeve labels sold by [Fuji] in connection with American Fuji Seal that utilize . . . recyclable, light-blocking shrink sleeve label technology **such as [Fuji]’s RecShrink with light-blocking technology.**” *See* Ex. 3 at 3 (emphasis added). Further, even if AFS is one source of infringing products, the exhibits and evidence above establish that AFS did not “**alone** develop[] and manufacture[] the accused [] technology.” *Nexon*, 2020 WL 3035647, at *4 (emphasis added). In sum, AFS is not a necessary

⁷ Courts have held that this inquiry is limited to personal jurisdiction. *See, e.g., Cisco Sys., Inc., v. Synqor, Inc.*, No. CIV.A. 11-86, 2011 WL 1326062, at *3 (D. Del. Apr. 1, 2011).

and desirable party to the first-filed action. *See* Exs. 3, 5.

d. The Convenience Factors Do Not Favor Delaware

The convenience factors may form the basis for an exception to the first-to-file rule, but here they do not. *See Jumara v. State Farm Ins. Co.*, 55 F.3d 873, 878–80 (3d Cir. 1995) (listing transfer factors). Further, “[u]nless the balance of transfer factors favors keeping the case in the second-filed court, there are no compelling circumstances to justify such an exception” to the first-to-file rule. *In re Nitro Fluids L.L.C.*, 978 F.3d 1308, 1311 (Fed. Cir. 2020).

Plaintiff’s and Defendants’ Choices of Fora: B+W and AFS made their forum choices as plaintiffs. Neither jurisdiction is where any party is headquartered or otherwise physically situated. The fact that both parties are incorporated in Delaware should be of limited weight—the Court should not give AFS’s (months-delayed) decision to file suit here as much weight as B+W’s decision to file suit in Texas when AFS is the second-filer. *See In re Link_A_Media Devices Corp.*, 662 F.3d 1221, 1223–24 (Fed. Cir. 2011); *see also Samsara Inc. v. Motive Techs., Inc.*, No. CV 24-84 (MN), 2024 WL 3822981, at *4 (D. Del. Aug. 14, 2024) (finding convenience factors favored another forum even though plaintiff and defendant were incorporated in Delaware). On balance, these factors do not favor an exception to the first-to-file rule.

Whether Claims Arose Elsewhere: “[A]s to this factor, this Court typically focuses on the location of the production, design and manufacture of the accused instrumentalities.” *Samsara*, 2024 WL 3822981, at *4 (quotations omitted). This factor does not favor an exception to the first-to-file rule because the Accused Products and ’422 Patent were not developed in Delaware, no relevant witnesses reside here, and the Accused Products are sold nationwide. *See id.*

Convenience of the Parties: The Court considers three factors in determining the convenience of the transferee forum: “(1) the parties’ physical location; (2) the parties’ logistical and operational costs of traveling to litigate in Delaware, as opposed to the proposed transferee

district; and (3) the relative ability of each party to bear these costs in light of its size and financial standing.” *Samsara*, 2024 WL 3822981, at *5. The parties’ physical location does not favor an exception to the first-to-file rule, especially because Nestlé advertises having an office in the Eastern District of Texas. *Papst Licensing GmbH & Co. KG v. Lattice Semiconductor Corp.*, 126 F. Supp. 3d 430, 441 (D. Del. 2015) (noting that this factor favored the non-Delaware jurisdiction even though the plaintiff in the Delaware action was a Delaware corporation because “the plaintiff . . . had an office [i]n the transferee district”) (citation omitted). Moreover, the parties’ logistical and operational costs should not weigh in favor of an exception to the first-to-file rule. There is no evidence that proceeding in this action will be any less expensive than proceeding in the Texas Action, but it is undeniable that costs will be twofold for both sides if both actions go forward. Third, all parties involved in both actions are large firms, so the relative ability of the parties to bear costs also does not favor an exception to the first-to-file rule. *Id.* at 440–41. Additionally, Nestlé and Fuji have counsel who have appeared in Texas.

Convenience of the Witnesses: “This factor carries weight ‘only to the extent that the witnesses may actually be unavailable for trial in one of the fora.’” *Samsara*, 2024 WL 3822981, at *5 (quoting *Jumara*, 55 F.3d at 879). This factor does not favor an exception to the first-to-file rule because Nestlé’s witnesses, who are crucial to B+W’s infringement claims, are likely unavailable in this action. AFS’s witnesses, while potentially unavailable in the Texas Action, may be less crucial to B+W’s infringement claims.

Location of Relevant Evidence: “[T]he Court gives weight to this factor only to the extent that the files [and other evidence] could not be produced in the alternative forum.” *Id.* (internal quotation marks omitted). All documentary evidence is equally available in either district, but Nestlé advertises having an office in the Eastern District of Texas, which may hold physical

evidence. Ex.15. *See Allen Med. Sys., Inc. v. Mizuho Orthopedic Sys., Inc.*, No. CV 21-1739-CFC, 2022 WL 1046258, at *3 (D. Del. Apr. 7, 2022). This factor does not favor an exception to the first-to-file rule, and shows that the Eastern District of Texas is a favorable forum.

Practical Considerations: This factor is aimed at “practical considerations that could make the trial easy, expeditious, or inexpensive[.]” *Jumara*, 55 F.3d at 879. AFS waited months after B+W first-filed in Texas to file this follow-on action. In the Texas Action, a schedule has already been entered; a *Markman* hearing has been set; a trial date has been set; a discovery order, protective order, and e-discovery order have been entered; and the parties have begun engaging in discovery. *See B+W v. Fuji* D.I. 12, 14, 15 (E.D. Tex.). None of these milestones has happened here. Additionally, dismissing or staying this case would ““eliminat[e] the cost associated with local counsel in Delaware.”” *Samsara*, 2024 WL 3822981, at *6 (quoting *Papst*, 126 F. Supp. 3d at 444). Accordingly, this factor weighs in favor of the first-filed action.

Administrative Difficulties: This factor should weigh in favor of the first-filed action and against an exception to the first-to-file rule because the judges in the Eastern District of Texas have a lighter caseload and can therefore offer a much faster time to trial. *See Samsara* 2024 WL 3822981, at *6. The average number of cases per judge in the District of Delaware is 396 and the average number of cases per judge in the Eastern District of Texas is 383. *See* Exs. 16, 17, 18. The median time to trial in the District of Delaware is 832 days and the median time to trial in the Eastern District of Texas is 628 days. Exs. 19, 20.

Local Interests: This factor does not favor an exception to the first-to-file rule. While this District does have an interest in adjudicating disputes between its corporate citizens, Nestlé advertises that it maintains an office in the Eastern District of Texas. *Papst*, 126 F. Supp. 3d at 445 (this factor favors the non-Delaware forum where a party had a presence in that forum). Ex. 15.

Remaining Factors: The remaining factors are either neutral or not applicable. In sum, none of the applicable factors favors an exception to the first-to-file rule, and several factors provide reasons why the first-filed forum is favorable to resolve this dispute. AFS thus cannot establish a compelling circumstance to depart from the first-to-file rule.

3. Public Policy Would Best Be Served By Proceeding Only with the Texas Action

“[T]he first-to-file rule is a doctrine of federal comity, intended to avoid conflicting decisions and promote judicial efficiency.” *Candid Care*, 2021 WL 3269092, at *2 (internal quotation marks omitted). Judicial efficiency would best be served by proceeding with only the Texas Action. As detailed above, the Texas Action has already made substantial progress. Moreover, there is a likelihood of conflicting decisions if both actions proceed. *See id.* Further, proceeding with the Texas Action be more efficient since B+W would not be forced to undertake slow and costly third-party discovery from Nestlé.

B. This Court Should At Least Stay this Case Until EDTX Rules on the First-to-File Issue

As a further alternative, this Court should defer to the Eastern District of Texas on the first-to-file issue and stay this case pending the Eastern District of Texas’s resolution of a motion to enjoin prosecution of this case, which is forthcoming. *See Neste Oil OYJ v. Dynamic Fuels, LLC*, No. CV 12-1744-GMS, 2013 WL 3353984, at *1 (D. Del. July 2, 2013) (“A decision to stay litigation lies within the sound discretion of the court and represents an exercise of the court’s ‘inherent power to conserve judicial resources by controlling its own docket.’”) (citation and quotation omitted). Courts regularly do exactly this. *See, e.g., Cellectis S.A. v. Precision Biosciences, Inc.*, 881 F. Supp. 2d 609, 613 (D. Del. 2012).

C. This Case Should Be Dismissed for Lack of Subject Matter Jurisdiction

The Court should dismiss this case for lack of standing. Federal Rule of Civil Procedure

12(b)(1) allows a court to do exactly this. *Ballentine*, 486 F.3d at 810. To make this determination, “[t]he threshold question for declaratory judgment jurisdiction is ‘whether the facts alleged, under all the circumstances, show that there is a **substantial controversy**, between parties having adverse legal interests, of sufficient immediacy and reality’” *Bambuser*, 2024 WL 4024174, at *3 (quoting *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007)).

Federal Circuit precedent makes clear that no substantial controversy exists in this case. In *Microsoft Corp v. DataTern, Inc.*, the Federal Circuit held that manufacturers do not “have a right to bring [] declaratory judgment action[s] solely because their customers have been sued for direct infringement[.]” *Microsoft*, 755 F.3d 899 at 904; *see also id.* (“Appellees cannot seek a declaration from a New York court on behalf of customers . . . where a suit against these very same customers on all the same issues was *already* underway in a Texas court.”) (italics in original).

Likewise in *Bambuser*, the patent owner (Sito) sued an accused infringer (SFA) for patent infringement in the Western District of Texas based on SFA’s use of technology supplied by Bambuser. *See Bambuser*, 2024 WL 4024174 at *1. In response, Bambuser filed a declaratory judgment action in the District of New Jersey against Sito. *See id.* In the first-filed action, “Sito . . . makes no claims accusing Bambuser of direct infringement” and “makes no mention of Bambuser in its Complaint at all.” *Id.* at *4. Accordingly, and citing *Microsoft*, the court found that “Bambuser’s Complaint and other submissions do not sufficiently show that there is a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment,” and granted Sito’s motion to dismiss under Fed. R. Civ. P. 12(b)(1). *Id.* at *1.

Here, similarly to the patent owner in *Bambuser*, B+W sued Nestlé (AFS’s alleged customer) in the first-filed Texas Action. *See Ex. 1.* And similarly to the *Bambuser* plaintiff, AFS filed this declaratory judgment action solely based on the first-filed lawsuit against Nestlé. *See D.I.*

1, ¶¶ 12–18. Just as the first-filed action in *Bambuser* made no mention of Bambuser, B+W’s first filed complaint in the Texas Action has no claims accusing AFS of direct infringement and, in fact, makes no mention of AFS at all. *See generally* Ex. 1; *Bambuser*, 2024 WL 4024174 at *4. Thus, just as the Federal Circuit found in *Microsoft*, AFS cannot seek a declaration from this Court (on behalf of its alleged customer, Nestlé) where a suit against that very same customer on all the same issues is already underway in the Texas Action. *See Microsoft*, 755 F.3d at 904. Additionally, AFS’s stray allegation that B+W approached AFS asking for a license (D.I. 1, ¶ 11) is of no import. In fact, the *Bambuser* court rejected this exact argument: “Bambuser also invokes negotiations with Sito for a global license for Bambuser’s customers. To the extent this off-handed remark is relevant, the Court notes that these negotiations do not appear to rise to the level of a ‘protracted negotiation process’ that might have supported jurisdiction.” *Bambuser*, 2024 WL 4024174 at *4, n. 3 (quoting *Microsoft*, 755 F.3d at 906).

Moreover, to the extent AFS argues that subject-matter jurisdiction exists for its declaratory judgment action based on *induced* infringement (which AFS did not allege in its complaint), AFS is incorrect. In fact, the *Microsoft* court stated “we do not agree” that a “suit[] against [a manufacturer’s] customers automatically gives rise to a case or controversy regarding induced infringement” when there is no evidence that the manufacturer “encouraged the acts accused of direct infringement[.]” *Microsoft*, 755 F.3d at 904–05. Here, there are no claims that AFS encouraged the use of the ’422 Patent that would have led to Nestlé’s direct infringement—in fact, as stated above, B+W’s complaint in the Texas Action does not have claims against AFS and does not mention AFS, let alone evidence showing AFS’s inducement of others’ infringement.

V. CONCLUSION

For the foregoing reasons, the Court should grant this Motion and provide one of the requested forms of relief.

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December 10, 2024

CERTIFICATE OF SERVICE

I hereby certify that on December 10, 2024, I caused the foregoing to be electronically filed with the Clerk of the Court using CM/ECF, which will send notification of such filing to all registered participants.

I further certify that I caused copies of the foregoing document to be served on December 10, 2024, upon the following in the manner indicated:

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