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**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

ZOOMESSENCE, INC.,

Plaintiff,

v.

MCCORMICK & COMPANY, INC., FONA
INTERNATIONAL, LLC, and FONA
TECHNOLOGIES, LLC,

Defendants.

Case No. 2:25-cv-1240-JRG

JURY TRIAL DEMANDED

**DEFENDANTS’ P.R. 3-3 AND 3-4
INVALIDITY CONTENTIONS**

McCormick & Company, Inc. (“McCormick”), FONA International, LLC, and FONA Technologies, LLC (together, “FONA”) (collectively, “Defendants”) hereby provide the following Preliminary Invalidity Contentions (“Contentions”) to Plaintiff ZoomEssence, Inc. (“Plaintiff” or “ZoomEssence”) for U.S. Patent Nos. 9,551,527 (the “’527 patent”) and 9,332,776 (the “’776 patent”) (collectively, the “Asserted Patents”).

I. PRELIMINARY STATEMENT AND RESERVATION OF RIGHTS

In its Infringement Contentions dated March 12, 2026, ZoomEssence asserted the following claims (the “Asserted Claims”):

- The ’527 patent: claims 1–21, 26, 29–31;
- The ’776 patent: claims 1–3, 7–12, 16, 19.

Defendants do not provide any Contentions directed to claims that ZoomEssence has not asserted for purposes of infringement. To the extent ZoomEssence may be permitted to assert additional claims in the future, Defendants reserve all rights to disclose new or supplemental contentions regarding such claims. Because the same claim scope must apply for both

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air is . . . supplied into the drying chamber by a blower” and “water evaporated from the droplets enters the heated air as the atomized liquid droplets dry to form solid particles.” *Id.* Further yet, the ’776 patent admits that “[t]he dried powder leaves the dryer chamber . . . and is carried to a cyclone separator, which removes the dried particles . . . and deposits [them] into a collection container.” *Id.*

At least these admissions collectively disclose every structural element of the ’776 Asserted Claims except the specific “within about 5%” retention limitation of claim 1 (and its narrower species in claims 7–9) and the “does not vary by more than about 5% during aging” limitation of claim 10 (and its narrower species in claim 16). Defendants accordingly contend that the ’776 Asserted Claims are invalid in view of AAPA alone and/or AAPA in combination with any of the references identified in Sections III.B, III.C, III.E, and III.F that disclose the retention or aging-stability limitations. The AAPA chart is attached as Exhibit B-08.

E. Prior Art Systems and/or Knowledge

The Asserted Claims are invalid under 35 U.S.C. §§ 102 and/or 103 based on prior art items offered for sale or publicly used or known or prior inventions, such as prior art products, including systems/powders embodying any alleged inventions or structures described in, and/or any knowledge disclosed by or referred to in, any of the prior art patents or prior art publications identified above in Sections III.B, III.C, and III.D. Because Defendants have not yet completed discovery in this case, Defendants reserve the right to supplement these Contentions with facts, documents, or other information learned at a later point through third-party discovery or further investigation. For example, Defendants expect to receive documents from additional third parties either through informal requests or under subpoenas that are believed to have knowledge, documentation, and/or corroborating evidence concerning some of the prior art listed above and below and/or additional prior art. These third parties include without limitation the authors,

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inventors, or assignees of the references listed in these Contentions. In addition, Defendants reserve the right to assert invalidity under other sections of 35 U.S.C. § 102 to the extent that discovery or further investigation yields information forming the basis for such invalidity.

Moreover, all of the systems and products listed below qualify as prior art to each of the Asserted Patents under at least pre-AIA 35 U.S.C. §§ 102(a)/(b). Such systems and products were known, used, offered for sale, and/or sold in the United States prior to the appropriate priority date corresponding to each of the Asserted Patents.

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Prior Art Knowledge in the Art
General knowledge of spray-drying processes, equipment, and formulations known to persons of ordinary skill in the art prior to September 27, 2010, as reflected in the prior art references and systems identified in Sections III.B, III.C, and III.E and in the Applicant Admitted Prior Art in the '776 patent specification (Section III.D).
Knowledge that high-solids, low-water content slurries, modified-starch carriers, and low-temperature or dehumidified drying air improve retention of volatile active ingredients during spray drying, as reflected in the prior art references and systems identified in Sections III.B, III.C, III.D, and III.E.

The Federal Circuit has held that “[t]he proper test for the public use prong of the [pre-AIA] § 102(b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited.” *See Invitrogen Corp. v. Biocrest Mfg. L.P.*, 424 F.3d 1374, 1380 (Fed. Cir. 2005). Additionally, the on-sale bar of § 102(b) is triggered when the invention is both (1) the subject of a commercial offer for sale not primarily for experimental purposes and (2) ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67 (1998). Each of the systems and products listed above meets these criteria.

The above discussion is not exclusive. Defendants reserve the right to rely on both the listed products as well as other products that may become known and/or relevant during the course of this matter. Defendants also reserve the right to rely on forthcoming testimony and/or declarations from third-party witnesses.

Any citation to one or more of these prior art references, or other prior art references regarding any method or system, should be construed to constitute not only a citation to the prior art reference itself but also a reference to the system itself. Discovery is ongoing in this case, and Defendants will supplement these Contentions if and when more information becomes available. Accordingly, Defendants reserve the right to modify, amend, and/or supplement these contentions as information becomes available from non-parties.

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and/or invalidity issues, different ones of the charted prior art references in the Exhibits may be of greater or lesser relevance and different combinations of these references may be implicated. Given the uncertainty, the charts may reflect alternative applications of the prior art against the Asserted Claims.

Citations to particular excerpts from the prior art are likewise exemplary and not exhaustive of the evidentiary support for the invalidity of the Asserted Patents contained in and/or concerning a particular piece of prior art. Defendants may rely on uncited portions of the prior art references, other documents or operational systems, the “Background of the Invention” and other relevant portions of the Asserted Patents, the prosecution histories of the Asserted Patents (including all cited references) and their related patents and applications, and forthcoming fact and expert testimony to provide context to aid in understanding the prior art reference and/or the cited portions of the references. Where Defendants cite to a particular figure in a reference, the citation encompasses the caption and description of the figure and any text relating to or discussing the figure. Likewise, where Defendants cite text referring to a figure, the citation includes the figure as well (and vice versa).

A. Prior Art Under 35 U.S.C. § 102

Defendants contend that at least the primary prior art references identified below, by themselves, anticipate the Asserted Claims:

Exhibits	Primary References and/or Systems
A-01, B-01	J. Adamiec & D. Kalemba, Microencapsulation of Peppermint Oil During Spray-Drying (“Adamiec”)
A-02, B-02	U.S. Patent No. 4,276,312 to Merritt (“Merritt”)
A-03, B-03	U.S. Patent No. 6,482,433 to DeRoos et al. (“DeRoos”)

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Exhibits	Primary References and/or Systems
A-04, B-04	U.S. Patent Application Publication No. 2010/0068268 to Rahmouni et al. (“Rahmouni”)
A-05, B-05	PCT International Publication No. WO 91/17821 to Skelbaek et al. (“Skelbaek”)
A-06, B-06	A. Soottitantawat et al., Influence of Emulsion and Powder Size on the Stability of Encapsulated D-Limonene by Spray Drying (“Soottitantawat”)
A-07, B-07	U.S. Patent Application Publication No. 2005/0003004 to Vehring et al. (“Vehring”)
A-08	U.S. Patent No. 7,186,293 to Cunningham et al. (“Cunningham”)
B-08	Applicant Admitted Prior Art (“AAPA”)
B-09	A. C. Bertolini et al., Stability of Monoterpenes Encapsulated in Gum Arabic by Spray-Drying (“Bertolini”)
B-10	F. M. Goycoolea et al., *Immunological and Functional Properties of the Exudate Gum from Northwestern Mexican Mesquite (*Prosopis spp.) in Comparison with Gum Arabic (“Goycoolea”)
B-11	N. Motlekar et al., Optimization of Experimental Parameters for the Production of LMWH-Loaded Polymeric Microspheres (“Motlekar”)
B-12	Defendants’ prior-art powders as described in Section III.E (“Prior Art Powders”)
B-13	U.S. Patent No. 7,488,503 to Porzio et al. (“Porzio”)
B-14	European Patent No. 1 435 797 to Subramaniam et al. (“Subramaniam”)
B-15	Baranauskiene, et al., Flavor Retention of Peppermint (<i>Mentha piperita</i> L.) Essential Oil Spray-Dried in Modified Starches During Encapsulation and Storage. (“Baranauskiene”)
B-16	Apintanapong, et al., The Use of Spray Drying to Microencapsulate 2-Acetyl-1-pyrroline, a Major Flavour Component of Aromatic Rice, International Journal of Food Science and Technology, 2003, 38, 95-102 (“Apintanapong”)
B-17	Reineccius et al., “Developments in Gum Acacias for the Encapsulation of Flavors,” Chapter 14 of <u>Encapsulation and Controlled Release of</u>

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Exhibits	Primary References and/or Systems
	<u>Food Ingredients</u> , American Chemical Society 1995, pp 161-168 (“Reineccius”)
B-18	U.S. Patent. Application Publication No. 2009/0048206 to Watanabe et al. (“Watanabe”)
B-19	Yoshii, et al., Flavor Release from Spray-dried Maltodextrin/Gum Arabic or Soy Matrices as a Function of Storage Relative Humidity, <i>Innovative Food Science & Emerging Technologies</i> 2 (2001) pp. 55-61 (“Yoshii”)
B-20	Soottitantawat, et al., Effect of Water Activity on the Release Characteristics and Oxidative Stability of D-Limonene Encapsulated by Spray Drying, <i>J. Agric. Food Chem.</i> 2004, 52, pp. 1269-1276 (“Soottitantawat 2004”)

Specifically, Defendants contend that at least the references and/or systems in the table above independently anticipate the Asserted Claims under pre-AIA 35 U.S.C. §§ 102(a), (b), (e), (f) and/or (g) and/or AIA 35 U.S.C. §§ 102(a)(1), (a)(2), as set forth in the charts attached as:

- Exhibits A-01 through A-08 for the asserted claims of the ’527 patent; and
- Exhibits B-01 through B-20 for the asserted claims of the ’776 patent.

Where an asserted prior art reference in any attached claim charts relies on a claim of priority to assert a critical reference date under pre-AIA 35 U.S.C. § 102 *et seq.* (including pre-AIA § 102(e)), compliance with pre-AIA 35 U.S.C. § 112, first paragraph, or 35 U.S.C. § 112(a), is shown in an appendix to a given claim.

These charts, however, are exemplary. The claimed features are similarly described and suggested in other places (including in all of the documents cited during prosecution of each piece of prior art), and also were present when prior-art systems practicing the described prior art were used before the application that ultimately led to the Asserted Patents. Thus, where patents or other printed materials are disclosed, Defendants reserve the right to also rely on those materials

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[REDACTED]

[REDACTED]

B. Indefiniteness Under 35 U.S.C. § 112 ¶ 2

35 U.S.C. § 112, ¶ 2 requires that a patent claim “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. Claim terms that fail to inform those skilled in the art “with reasonable certainty . . . about the scope of the invention” fail the definiteness requirement of 35 U.S.C. § 112, ¶ 2. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Defendants contend that, at least under ZoomEssence’s actual and/or apparent application of the claims, the Asserted Claims of the Asserted Patents fail to distinctly claim what the inventors regard as their alleged invention.

Each of the asserted claims is invalid as indefinite under 35 U.S.C. § 112 because they fail to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. In particular, the following limitations, read in light of the intrinsic evidence, fail to inform those skilled in the art with reasonable certainty about the scope of the claimed inventions:

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1. ’527 Patent

- **Claim 1:** “dried powder”
- **Claim 1:** “less than 100° C.”
- **Claims 1, 6-8, 18:** “slurry”
- **Claims 2-5:** “weight loss of the ingredient in the method does not exceed [5 / 3 / 2 / 1] wt %”
- **Claim 9:** “the air is not heated in the method”
- **Claim 14:** “the air is fed into the drying chamber at an ambient temperature of the drying chamber”
- **Claims 29-31:** “the method is conducted so that the dried powder when subjected to aging at elevated temperature of 95° F. for 1000 hours does not lose more than [5 / 4 / 3]% of the weight of the ingredient therein”

2. ’776 Patent

- **Claims 1, 10:** “principle molecular types”
- **Claims 1, 10:** “a desirable food, flavor, fragrance, medicament, and pigment”
- **Claim 1:** “final active ingredient” / “initial active ingredient”
- **Claims 1, 7-9:** “within about [5 / 3 / 2 / 1]% of a weight percentage”
- **Claims 10, 16:** “does not vary by more than about [5 / 3]% during aging”

VI. DOCUMENT PRODUCTION

Pursuant to Patent Rule 3-4, Defendants are concurrently producing the prior art identified in these Invalidity Contentions, but Defendants are not required to produce the prior art in the file histories of the Asserted Patents.