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5 UNITED STATES DISTRICT COURT
6 WESTERN DISTRICT OF WASHINGTON
7 AT SEATTLE

8 EKO BRANDS, INC.,
9 Plaintiff,
10 v.
11 ADRIAN RIVERA MAYNEZ
12 ENTERPRISES, INC., and ADRIAN RIVERA,
13 Defendants.

Case No. C15-522RSL

ORDER GRANTING IN PART
PLAINTIFF’S MOTION FOR
SUMMARY JUDGMENT

14 This matter comes before the Court on “Eko Brands’ Motion for Summary Judgment.”
15 Dkt. # 47. Plaintiff seeks a determination that claims 5, 6, 8, 10, 18, 19, and 20 of U.S. Patent
16 No. 8,720,320 (“the ‘320 patent) are invalid for failing to meet the written description
17 requirement of 35 U.S.C. § 112, because they are anticipated by prior art under 35 U.S.C. § 102,
18 and because they were obvious under 35 U.S.C. § 103. Plaintiff also seeks a declaration that its
19 products do not infringe the ‘320 patent because they do not have “passageways” as that term
20 was construed by the Court. Having reviewed the memoranda, declarations, and exhibits
21 submitted by the parties,¹ the Court finds as follows:

22 **A. INVALIDITY**

23 Plaintiff’s requests for a declaration of invalidity based on the written description
24 requirement and/or anticipation are not properly before the Court. Until it filed this motion for
25

26 ¹ The issues that are properly before the Court can be decided on the papers submitted. Plaintiff’s
request for oral argument is DENIED.

1 summary judgment, plaintiff's sole argument in favor of invalidating the '320 patent was based
2 on 35 U.S.C. § 103. Neither the First Amended Complaint nor plaintiff's invalidity contentions
3 mentioned § 112 or § 102, and the only facts alleged and arguments made involved obviousness
4 under various references. Plaintiff argues that the failure to plead written description and
5 anticipation as grounds for a finding of invalidity should not preclude consideration of those
6 arguments because defendants have long known that the '320 patent was susceptible to attack on
7 those grounds. The fact that defendants could imagine causes of action that plaintiff might have
8 asserted against them – but did not -- is not dispositive. Plaintiff chose not to assert written
9 description or anticipation in its complaint, did not put defendants on notice that they intended to
10 pursue those grounds for invalidation, and allowed this case to proceed through discovery based
11 on the claims that were actually asserted. A claim cannot be raised for the first time in a motion
12 for summary judgment.

13 The issue is whether plaintiff should be permitted to amend its complaint at this point in
14 the proceeding. Because the deadline for amending pleadings has passed, plaintiff must establish
15 good cause for a modification of the case management deadlines under Fed. R. Civ. P. 16(b)(4)
16 and show that amendment is appropriate under Fed. R. Civ. P. 15(a). Prejudice – or the lack
17 thereof – is simply one element that the Court must consider when determining whether
18 amendment is appropriate. In the absence of a properly supported motion to amend that applies
19 the correct analytical framework, the Court declines to consider the unpled invalidity claims.

20 With regards to obviousness, plaintiff's motion rests entirely on a brief statement of law
21 and Dr. Lars Howle's opinion that various claims of the '320 patent are obvious in light of
22 specified combinations of prior art. Dkt. # 47 at 24-25. Defendants responded with their own
23 expert's testimony, identifying specific elements of the claims that Mr. Phillips, as one skilled in
24 the art, believes are not rendered obvious by the prior art cited by Dr. Howle. Plaintiff made no
25 effort to respond to or criticize Mr. Phillips' analysis. Rather, plaintiff merely asserts its right to
26 rely upon expert testimony to establish obviousness and again cites to Dr. Howle's report. The

1 record therefore consists of little more than conflicting expert opinions regarding what one
2 skilled in the art would have found to be obvious at the time the invention was made. While
3 some of Mr. Phillips' explanations for why defendants' invention would not have been obvious
4 are questionable, there are clearly disputed issues of fact regarding the scope and content of the
5 prior art, how the prior art matches up against the claims, and the relevant knowledge of one
6 skilled in the art. The Court declines to analyze these facts or to consider secondary
7 considerations without input and guidance from the parties. See Crocs, Inc. v. Int'l Trade
8 Comm'n, 598 F.3d 1294, 1308 (Fed. Cir. 2010) ("Obviousness is a question of law based on
9 underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of
10 ordinary skill in the art; (3) the differences between the prior art and the claimed invention; and
11 (4) the extent of any objective indicia of non-obviousness.").

12 **B. INFRINGEMENT**

13 During the claim construction phase of this litigation, defendants urged a construction of
14 the term "passageway" that was based primarily on its purpose, namely a "way through which
15 the brewed beverage exits the container." Dkt. # 34 at 21. The Court found that this construction
16 repeated the concept of flow out of the receptacle that was separately stated in the claim and
17 failed to include concepts of narrowness, length, and connection that are part of the term
18 "passageway." The term was construed as "a narrow space of some depth or length connecting
19 one place to another. Dkt. # 42 at 12. The Court expressly stated that, "[t]o the extent ARM
20 Enterprises' proposed construction would encompass a receptacle that had no bottom or that
21 utilized a broad, thin mesh, it is rejected." Dkt. # 42 at 12.

22 Plaintiff's products utilize a broad, thin mesh or micro-punched steel filter to allow the
23 brewed beverage to exit the receptacle. They do not, therefore, contain the claimed
24 "passageway." Given the Court's construction of the term, this result should have be patently
25 obvious and defendants should have withdrawn their infringement claims. Instead, defendants'
26 expert creatively opines that the opening in which the mesh or punched steel filter is affixed is

1 the claimed passageway because one dimension of the opening is narrow compared to the other,
2 it has some depth or length, and it provides connection between the inside of the receptacle and
3 the outside. Dkt. # 48-9 at ¶¶ 25-31. No reasonable person looking at the cut-out openings on the
4 side of the plastic or steel Ekobrew devices would describe them as passageways. First, those
5 openings are filled with a mesh or steel filter – any passage that occurs goes through the tiny
6 holes in the filter, not through the cut-out itself. Mr. Phillips’ preferred “passageway” is actually
7 filled with an item that the Court has already determined is not a passageway. Even if the mesh
8 or steel filters were removed and the openings in the sidewalls stood empty, there are myriad
9 other words that a reasonable person would use to describe that feature (such as opening, gap, or
10 hole) that would better represent its breadth and comparative size than would the word
11 “passageway.” Mr. Phillips may have used the concepts that define a passageway – namely
12 narrowness, length, and connection – in his description of these openings, but that does not make
13 them passageways and no reasonable person would so find.

14 Finally, the Court rejects defendants’ doctrine of equivalents argument. Although the
15 passageway claimed in the ‘320 patent performs the function of allowing brewed beverages to
16 exit the receptacle, the term itself includes concepts of shape and size that are not subsumed by
17 its function and cannot simply be ignored.

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19 For all of the foregoing reasons, plaintiff’s motion for summary judgment (Dkt. # 47) is
20 GRANTED in part. Plaintiff is entitled to a declaration that its accused products do not infringe
21 the ‘320 patent because they do not contain a “passageway.” Plaintiff has not, however, shown
22 that the ‘320 patent was obvious as a matter of law and has not properly pled invalidity on
23 written description and/or anticipation grounds.

1 Dated this 17th day of August, 2016.

2 *Robert S. Lasnik*

3 Robert S. Lasnik

4 United States District Judge

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