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ECUBE LABS CO. & ECUBE LABS
11 CO., LTD

12 **UNITED STATES DISTRICT COURT**
13 **CENTRAL DISTRICT OF CALIFORNIA**
14 **WESTERN DIVISION**

15 **BIG BELLY SOLAR, INC.,**

16 Plaintiff,

17 vs.

18 **ECUBE LABS CO., LTD &**
19 **ECUBE LABS CO.,**

20 Defendants.

Case No. 2:17-cv-05604-R-SS

**DEFENDANT ECUBE LABS CO.,
LTD'S ANSWER AND
AFFIRMATIVE DEFENSES TO
BIG BELLY SOLAR INC.'S
COMPLAINT FOR PATENT
INFRINGEMENT AND
COUNTERCLAIMS FOR
PATENT INFRINGEMENT AND
DECLARATORY RELIEF**

DEMAND FOR JURY TRIAL

1 Defendant Ecube Labs Co., Ltd. (“Ecube (Korea)”) submits this Answer and
2 Affirmative Defenses and Counterclaims responsive to Plaintiff Big Belly Solar,
3 Inc.’s (“Big Belly”) Complaint for Patent Infringement (Dkt. No. 1). Except as
4 expressly admitted below, Ecube denies each and every allegation of the
5 Complaint.

6 **THE PARTIES**

- 7 1. Admitted.
8 2. Admitted.
9 3. Admitted.

10 **JURISDICTION AND VENUE**

11 4. Ecube (Korea) admits that this Court has subject matter jurisdiction
12 over actions arising under 28 U.S.C. §§ 271, et seq. Ecube (Korea) denies that
13 venue is proper in this District because Ecube (Korea) is not subject to personal
14 jurisdiction in California with respect to the specific claims asserted by Big Belly
15 and has not engaged in patent infringement as alleged in the Complaint in this
16 District or elsewhere.

17 5. Ecube (Korea) denies that this Court has personal jurisdiction over
18 Ecube (Korea) and denies that it has committed patent infringement as alleged in
19 the Complaint in this District or elsewhere. Ecube (Korea) does not respond to the
20 remaining allegations in Paragraph 5 because they apply to a different party.
21 Except as expressly admitted, Ecube (Korea) denies the allegations of Paragraph 5
22 regarding Ecube (Korea).

23 **THE PATENTS IN SUIT**

24 6. Ecube (Korea) admits that U.S. Patent No. 7,124,680 (“the ‘680
25 Patent”) is titled “Solar Powered Compaction Apparatus” and bears an issue date of
26 October 24, 2006. Ecube (Korea) further admits that what purports to be a copy of
27 the ‘680 Patent was attached to Big Belly’s Complaint as Exhibit A. Ecube (Korea)
28 affirmatively asserts that Big Belly’s Complaint fails to allege facts sufficient to

1 establish that Big Belly has standing to sue for infringement of the ‘680 Patent.

2 Except as expressly admitted, Ecube (Korea) denies the allegations of Paragraph 6.

3 7. Ecube (Korea) admits that U.S. Patent No. 7,481,159 (“the ‘159
4 Patent”) is titled “Solar Powered Compaction Apparatus” and bears an issue date of
5 January 27, 2009. The ‘680 Patent and ‘159 Patent are collectively referred to
6 herein as the Big Belly Patents-in-Suit. Ecube (Korea) further admits that what
7 purports to be a copy of the ‘159 Patent was attached to Big Belly’s Complaint as
8 Exhibit B. Ecube (Korea) affirmatively asserts that Big Belly’s Complaint fails to
9 allege facts sufficient to establish that Big Belly has standing to sue for
10 infringement of the ‘159 Patent. Except as expressly admitted, Ecube (Korea)
11 denies the allegations of Paragraph 7.

12 **FACTS**

13 8. Admitted.

14 9. Ecube (Korea) admits that it produces the Clean CUBE smart solar-
15 powered waste compaction system. Except as expressly admitted, Ecube (Korea)
16 denies the allegations of Paragraph 9.

17 10. Ecube (Korea) admits that the Clean CUBE product includes
18 photovoltaic panels located on a top surface. Because exposure to sunlight depends
19 on the circumstances of each installation, Ecube (Korea) lacks knowledge or
20 information sufficient to form a belief about the truth of the remaining allegations
21 of Paragraph 10 and on that basis denies them.

22 11. Admitted.

23 12. Admitted.

24 13. Denied.

25 14. Ecube (Korea) admits that the Clean CUBE has a compaction module
26 within the enclosure, which moves up and down. Ecube (Korea) denies the
27 remaining allegations in Paragraph 14.
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COUNT II

(INFRINGEMENT OF U.S. PATENT NO. 7,481,159)

26. Paragraph 26 of the Complaint does not contain any allegations, and therefore no response is required. Ecube (Korea) incorporates its responses to Paragraphs 1 through 25 of this Answer as if fully set forth herein.

27. Ecube (Korea) admits that outside the United States it makes, sells, and offers to sell a product known as the Clean CUBE. Except as expressly admitted, Ecube (Korea) denies remaining allegations of Paragraph 27.

28. Denied.

29. Denied.

30. Denied.

31. Ecube (Korea) admits that it received notice of the ‘159 Patent when Ecube (Korea) waived service of the Complaint in this action. Except as expressly admitted, Ecube (Korea) denies the allegations of Paragraph 31.

32. Ecube (Korea) denies the allegations of Paragraph 32 and specifically denies that Big Belly may reserve any rights to assert patent infringement claims based on any products not identified in the Complaint.

33. Denied.

RESPONSE TO BIG BELLY’S PRAYER FOR RELIEF

Ecube (Korea) denies that Big Belly is entitled to any of the relief requested in its Prayer for Relief.

FIRST DEFENSE

(Failure to State a Claim)

The Complaint fails to state a claim upon which relief can be granted against Ecube (Korea).

SECOND DEFENSE

(Noninfringement)

Ecube (Korea) has not infringed, directly, indirectly, or willfully, any valid

1 and enforceable claim of the Patents-in-Suit.

2 **THIRD DEFENSE**

3 **(Invalidity)**

4 The claims of the Patents-in-Suit are invalid for failure to comply with one or
5 more of the requirements of 35 U.S.C. §§ 101, 102, 103, and 112.

6 **FOURTH DEFENSE**

7 **(Prosecution Estoppel)**

8 By reason of the proceedings in the United States Patent and Trademark
9 Office during the prosecution of the Patents-in-Suit, Big Belly is estopped from
10 construing the claims of the Patents-in-Suit to cover or include, literally or by
11 application of the doctrine of equivalents, the accused products or their use.

12 **FIFTH DEFENSE**

13 **(Ensnarement by Prior Art)**

14 The prior art known before the alleged inventions claimed in the Patents-in-
15 Suit so limits and restricts the scope of the claims of the Patents-in-Suit that
16 Ecube (Korea) cannot be considered to have infringed any claim of the Patents-in-
17 Suit under the doctrine of equivalents.

18 **SIXTH DEFENSE**

19 **(Dedication to Public Domain)**

20 Big Belly has dedicated to the public and is estopped from claiming
21 infringement by all subject matter disclosed in the Patents-in-Suit but not literally
22 claimed therein.

23 **SEVENTH DEFENSE**

24 **(Equitable Doctrines)**

25 Big Belly's claims are barred in whole or in part by the equitable doctrines of
26 unclean hands, estoppel, waiver, acquiescence, and/or other equitable doctrines.

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EIGHTH DEFENSE

(Limitations of Remedies)

Big Belly’s claims for relief are barred in whole or in part by the provisions of 35 U.S.C. §§ 271, 286, and/or 287.

NINTH DEFENSE

(Good Faith)

Ecube (Korea) has engaged in good faith in all activities accused of infringement in the Complaint, thereby precluding Big Belly, even if it prevails, from recovering attorney fees and/or costs under 35 U.S.C. § 285.

TENTH DEFENSE

(Impropriety of Injunctive Relief)

Injunctive relief would be improper in this case at least for the reasons that any alleged injury to Big Belly is not immediate or irreparable, and Big Belly has an adequate remedy at law for any alleged injury.

ELEVENTH DEFENSE

(Lack of Standing)

Big Belly has failed to allege facts sufficient to support a finding that it has standing to bring suit for infringement of the Patents-in-Suit.

PRAYER FOR RELIEF

WHEREFORE, Ecube (Korea) prays that this Court enter judgment on Big Belly’s Complaint as follows:

- A. Dismissing Big Belly’s Complaint with prejudice and ordering that Big Belly is entitled to no relief whatsoever under its Complaint, including without limitation all relief sought in Big Belly’s Prayer for Relief;
- B. Ordering that the Patents-in-Suit are invalid for failure to comply with one or more of the requirements for patentability under 35 U.S.C. §§ 101 et seq.;
- C. Ordering that this is an exceptional case pursuant to 35 U.S.C. § 285 and awarding Ecube (Korea) its attorney fees and costs incurred in this action; and

1 D. Awarding Ecube (Korea) such other and further relief as this Court
2 deems just and proper.

3 **COUNTERCLAIMS**

4 Ecube (Korea) alleges as follows for its Counterclaims against Big Belly:

5 **PARTIES**

6 1. Ecube (Korea) is a Korean corporation with a place of business in
7 Seoul, Republic of Korea.

8 2. Ecube (Korea) is the owner by assignment of all right, title, and interest
9 in and to United States Patent No. 9,821,955 (the “Ecube Patent-in-Suit”), which
10 was duly and validly issued by the United States Patent and Trademark Office on
11 November 21, 2017. A true and correct copy of the Ecube Patent-in-Suit is
12 attached hereto as Exhibit 1

13 3. Big Belly alleges in its Complaint that it is a Delaware corporation with
14 its principal place of business at 150 A Street, Suite 103, Needham, MA 02494.

15 **JURISDICTION AND VENUE**

16 4. Ecube (Korea)’s Counterclaims arise under, inter alia, the patent laws of
17 the United States, Title 35, United States Code, and the Declaratory Judgment Act,
18 28 U.S.C. §§ 2201 et seq. By its Counterclaims, Ecube (Korea) seeks relief for Big
19 Belly’s infringement of the Ecube Patent-in-Suit and a declaratory judgment that
20 the Big Belly Patents-in-Suit are not infringed by Ecube (Korea) and/or are invalid.

21 5. This Court has subject matter jurisdiction over Ecube (Korea)’s
22 Counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a), 1400(b), and 2201 et seq.

23 6. Big Belly voluntarily submitted to the personal jurisdiction of this Court
24 by invoking this Court’s jurisdiction in connection with Big Belly’s Complaint in
25 this action and by virtue of Big Belly’s significant and substantial contacts with this
26 District.

27 7. On information and belief, Big Belly, directly and/or through its
28 distribution network, offers to sell and sells its products in the Central District of

1 California and/or places devices into the stream of commerce with the knowledge
2 and/or reasonable expectation that such devices will be sold and/or used in the
3 Central District of California.

4 8. To the extent that venue in the Central District of California is proper in
5 connection with Big Belly's Complaint, venue in the Central District of California
6 is equally proper for these Counterclaims under 28 U.S.C. §§ 1391 and 1400 and
7 *General Electric Co. v Marvel Rare Metals Co.*, 287 US 430 (1932); *see also*
8 *Leman v. Krentler-Arnold Co.*, 284 U.S. 448, 451. Venue is also proper in the
9 Central District of California pursuant to 28 U.S.C. §§ 1367 and 1391(b)-(c)
10 because Ecube (Korea)'s claims for declaratory relief are compulsory counterclaims
11 to Big Belly's infringement claims in this case.

12 9. Big Belly alleges in its Complaint that Ecube (Korea) is liable for
13 infringement of the Patents-in-Suit, and Ecube (Korea) denies Big Belly's
14 allegations on the basis of non-infringement and/or invalidity of the Patents-in-Suit.
15 Accordingly, there is an actual, justiciable, and substantial controversy, between
16 parties having adverse legal interests regarding the non-infringement and invalidity
17 of the Patents-in-Suit, of sufficient immediacy and reality to warrant the issuance of
18 a declaratory judgment. A judicial declaration of non-infringement and/or
19 invalidity of the Patents-in-Suit is necessary and appropriate to resolve this actual,
20 justiciable, and substantial controversy.

21 **BACKGROUND**

22 10. Ecube (Korea) makes outside the United States the Clean CUBE
23 product that is accused of infringing the Big Belly Patents-in-Suit in this action.

24 11. On July 28, 2017, Big Belly filed its Complaint (Dkt. No. 1) in this
25 action alleging infringement of the Patents-in-Suit in connection with the Clean
26 CUBE product.

27 12. Ecube (Korea) denies Big Belly's allegations of infringement, as set
28 forth in the Answer and Affirmative Defenses above.

1 13. On information and belief, Big Belly makes, uses, sells, and/or offers to
2 sell within the United States a product known as Big Belly 5.

3 14. On information and belief, Big Belly makes, uses, sells, and/or offers to
4 sell within the United States a product known as High Capacity 5 (HC5).

5 **COUNTERCLAIM I**

6 **(Infringement of the Ecube Patent-in-Suit)**

7 15. Ecube (Korea) incorporates by reference as if fully set forth herein the
8 foregoing Counterclaim Paragraphs 1 – 14.

9 16. The Ecube Patent-in-Suit, entitled “Refuse Collection Apparatus,” was
10 duly and validly issued on November 21, 2017. A true and correct copy of the ‘955
11 patent is attached to this Complaint as Exhibit 1.

12 17. Ecube (Korea) is the owner of all right, title, and interest in and to the
13 Ecube Patent-in-Suit, including the right to bring this suit for injunctive relief and
14 past, present, and future damages.

15 18. On information and belief, Big Belly is infringing at least claim 1 of the
16 Ecube Patent-in-Suit pursuant to 35 U.S.C. § 271, directly and/or indirectly,
17 literally or under the doctrine of equivalents, by its activities in connection with
18 making, using, selling, and/or offering for sale in the United States products and
19 services, including but not limited to the Big Belly 5.

20 19. On information and belief, Big Belly is infringing at least claim 1 of the
21 Ecube Patent-in-Suit pursuant to 35 U.S.C. § 271, directly and/or indirectly,
22 literally or under the doctrine of equivalents, by its activities in connection with
23 making, using, selling, and/or offering for sale in the United States products and
24 services, including but not limited to the High Capacity 5.

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1 20. Big Belly's infringing activities have caused and will continue to cause
2 Ecube (Korea) irreparable harm, for which it has no adequate remedy at law, unless
3 Big Belly's infringing activities are enjoined by this Court in accordance with 35
4 U.S.C. § 283.

5 21. Ecube (Korea) has been damaged and continues to be damaged by Big
6 Belly's infringement of the Ecube Patent-in-Suit in an amount to be determined at
7 trial.

8 **COUNTERCLAIM II**

9 **(Declaratory Judgment)**

10 22. Ecube (Korea) incorporates by reference as if fully set forth herein the
11 foregoing Counterclaim Paragraphs 1 – 21.

12 23. Big Belly alleges in its Complaint that it is the owner by assignment of
13 the Big Belly Patents-in-Suit and that Ecube (Korea) infringes the same.

14 24. Ecube (Korea) denies that it infringes, directly or indirectly, any
15 asserted claim of the Big Belly Patents-in-Suit, as alleged in the foregoing Answer
16 and Affirmative Defenses.

17 25. Ecube (Korea) contends that each asserted claim of the Big Belly
18 Patents-in-Suit is invalid for failure to comply with one or more provisions of Title
19 35, United States Code, including without limitation 35 U.S.C. §§ 101, 102, 103,
20 and/or 112, as alleged in the foregoing Answer and Affirmative Defenses.

21 26. An actual, justiciable, and substantial controversy currently exists
22 between Ecube (Korea) and Big Belly with respect to the invalidity and non-
23 infringement of the Big Belly Patents-in-Suit.

24 27. This controversy is of sufficient immediacy and reality to warrant the
25 issuance of a judicial declaration of non-infringement and/or invalidity of the
26 Patents-in-Suit.

1 **PRAYER FOR RELIEF ON ECUBE (Korea)'S COUNTERCLAIMS**

2 WHEREFORE, Ecube (Korea) prays that this Court enter judgment on
3 Ecube (Korea)'s Counterclaims as follows:

4 A. Declaring that Ecube (Korea) has not infringed any valid and
5 enforceable claim of the Big Belly Patents-in-Suit directly, indirectly, or willfully;

6 B. Declaring that the Big Belly Patents-in-Suit are invalid;

7 C. Finding that Big Belly has infringed one or more claims of the Ecube
8 Patent-in-Suit;

9 D. Permanently enjoining Big Belly, its directors, officers, agents,
10 servants and employees, and those acting in privity or in concert with them, and
11 their subsidiaries, divisions, successors and assigns, from further acts of
12 infringement, contributory infringement, or inducement of infringement of the
13 Ecube Patent-in-Suit;

14 E. Awarding Ecube (Korea) all appropriate damages adequate to
15 compensate it for Big Belly's infringement of the Ecube Patent-in-Suit, but in no
16 event less than a reasonable royalty for Big Belly's use of Ecube's patented
17 inventions, including all pre-judgment and post-judgment interest at the maximum
18 rate permitted by law;

19 F. Declaring this case exceptional pursuant to 35 U.S.C. § 285 and
20 awarding to Ecube (Korea) its attorney fees and costs incurred in this matter; and

21 G. Granting Ecube (Korea) such other relief as this Court deems just and
22 proper.
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DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38 and Central District of California L.R. 38-1, Ecube (Korea) demands a trial by jury on all issues so triable.

Dated: November 21, 2017

NIXON PEABODY LLP

By: /s/ Shawn G. Hansen

Shawn G. Hansen (SBN 197033)
Attorneys for Defendant
ECUBE LABS CO., LTD.