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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

HENRY CHUNG,)	CV 16-08586-RSWL-PLA
)	
Plaintiff,)	ORDER re: Plaintiff's
)	Motion to Dismiss [49];
v.)	Defendants' Motion for
)	Partial Summary Judgment
VAPOROUS TECHNOLOGIES, LLC;)	[47]
CHRISTIAN RADO,)	
)	
Defendants.)	
)	

Currently before the Court is Plaintiff/Counter Defendant Henry Chung's ("Plaintiff") Motion to Dismiss Infringement Action ("Plaintiff's Motion") and Defendants/Counter Claimants Vaporous Technologies, LLC ("VTL") and Christian Rado's ("Rado") (collectively, "Defendants") Motion for Partial Summary Judgment as to Non-Infringement of the '812 Patent ("Defendants' Motion"). Having reviewed all papers submitted pertaining to these Motions, the Court **NOW FINDS AND RULES AS FOLLOWS:** the Court **DENIES** Plaintiff's Motion

1 and **GRANTS** Defendants' Motion.

2 **I. BACKGROUND**

3 **A. Factual Background**¹

4 Plaintiff is an individual residing in Los Angeles
5 County, California. Defs.' Statement of Uncontroverted
6 Facts in Supp. of Defs.' Mot. for Partial Summ. J.
7 ("Defs.' SUF") ¶ 1, ECF No. 48. VTL is a Pennsylvania
8 limited liability company, and Rado is the managing
9 member of VTL. Id. ¶ 2.

10 Plaintiff is the owner of the '812 Patent. Id.
11 ¶ 3. Plaintiff asserts that Defendants' vaporizer
12 products, the J-Pen Blender 2-in-1 Kit, Pal Tank, and
13 11 mm Blender 2-in-1 kit (collectively, the "Accused
14 Products"), infringe Claim 1 of the '812 Patent. Id.

15 ¶ 4. Claim 1 reads,

- 16 A wet scrubbing electronic cigarette comprising:
17 a. an atomizer section having a battery section
18 connection for connection to a battery section,
19 wherein the atomizer section has an atomizer
20 heating section;
21 b. a wet scrubbing section comprising:
22 i. a mouthpiece;
23 ii. a water chamber in fluid communication
24 with the mouthpiece, wherein the water chamber
25 provides for scrubbing of incoming airflow;
26 iii. a tubular air passage assembly held
27 within the water chamber, wherein the tubular
28 air passage assembly is in fluid communication
with the water chamber; and

24 ¹ The Court makes the following factual findings. See C.D.
25 Cal. R. 56-3 ("[T]he Court may assume that the material facts as
26 claimed and adequately supported by the moving party are admitted
27 to exist."). But see Anderson v. Liberty Lobby, 477 U.S. 242,
28 250 (1986) ("There is no requirement that the trial judge make
findings of fact [when granting summary judgment because] the
threshold inquiry [is whether] there are any genuine factual
issues."); Taybron v. City & Cty. of S.F., 341 F.3d 957, 959 n.2
(9th Cir. 2003).

1 c. a battery section powering the atomizer
2 section;
3 wherein the tubular air passage assembly further
4 comprises:
5 a. a ball held within a ball chamber, wherein
6 the ball has an open position and a closed
7 position;
8 b. a ball seat formed on an inside tube;
9 c. an outside tube wherein the inside tube is
10 fitted inside the outside tube, wherein the
11 outside tube connects with the ball chamber;
12 d. an air gap formed at a lower end of the
13 outside tube.

14 Id. ¶ 5.

15 **B. Procedural Background**

16 Plaintiff filed his Complaint [1] against
17 Defendants on November 17, 2016. On January 17, 2017,
18 Defendants filed their Answer [16] and their
19 Counterclaim [17].

20 The Court held a Markman hearing on January 23,
21 2018 to construe the term "water chamber." The Court
22 issued its Order re: Claim Construction on January 25,
23 2018 construing "the term 'water chamber' as a chamber
24 for holding water, not other liquids." Order re: Claim
25 Construction 13:6-8, ECF No. 46.

26 Defendants filed their Motion [47] on April 23,
27 2018. Plaintiff filed his Motion [49] on April 24,
28 2018. The parties timely opposed [54, 55] and replied
[57, 58] to the Motions. Defendants filed their
Objection [59] to Plaintiff's Reply in support of his
Motion to Dismiss, arguing that Plaintiff raised
arguments not discussed or referenced in Defendants'
Opposition.

///

1 finder could return a verdict for the nonmovant.
2 Anderson, Inc., 477 U.S. at 248. The evidence, and any
3 inferences based on underlying facts, must be viewed in
4 the light most favorable to the nonmovant. Twentieth
5 Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327,
6 1328-29 (9th Cir. 1983). In ruling on a motion for
7 summary judgment, the court's function is not to weigh
8 the evidence, but only to determine if a genuine issue
9 of material fact exists. Anderson, 477 U.S. at 255.

10 Where the nonmovant bears the burden of proof at
11 trial, the movant need only prove that there is no
12 evidence to support the nonmovant's case. In re Oracle
13 Corp. Secs. Litig., 627 F.3d 376, 387 (9th Cir. 2010).
14 If the movant satisfies this burden, the burden then
15 shifts to the nonmovant to produce admissible evidence
16 showing a triable issue of fact. Id.; Nissan Fire &
17 Marine Ins. Co. v. Fritz Cos., 210 F.3d 1099, 1102-03
18 (9th Cir. 2000); see also Cleveland v. Policy Mgmt.
19 Sys. Corp., 526 U.S. 795, 805-06 (1999) (quoting
20 Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986)).

21 **B. Discussion**

22 1. Plaintiff's Motion

23 Defendants do not necessarily take issue with the
24 dismissal of Plaintiff's Complaint and instead request
25 that they be named the prevailing party for purposes of
26 filing a motion for attorneys' fees under 35 U.S.C.
27 § 285. However, Defendants still do oppose Plaintiff's
28 Motion. Therefore, while there may not be any legal

1 prejudice to Defendants should the Court dismiss
2 Plaintiff's Complaint, see Smith, 263 F.3d at 976, the
3 Court is bound by the second sentence of Rule 41(a)(2),
4 which permits dismissal "only if [Defendants']
5 counterclaim can remain pending for independent
6 adjudication." The primary issue with dismissing
7 Plaintiff's claim is whether Defendants' counterclaims
8 can remain pending for *independent adjudication*.

9 The Federal Circuit has repeatedly held that if a
10 plaintiff covenants not to sue on a patent, the court
11 is divested of subject matter jurisdiction over a
12 defendant's declaratory judgment counterclaims. See,
13 e.g., King Pharm., Inc. v. Eon Labs., Inc., 616 F.3d
14 1267, 1282 (Fed. Cir. 2010) (holding that a covenant
15 not to sue for infringement "remove[s] any case or
16 controversy that may have existed between the parties
17 at one point"); Benitec Austl., Ltd. v. Nucleonics,
18 Inc., 495 F.3d 1340, 1347 (Fed. Cir. 2007); Microchip
19 Tech. Inc. v. Chamberlain Grp., Inc., 441 F.3d 936, 943
20 (Fed. Cir. 2006) (vacating district court's grant of
21 summary judgment of invalidity because the declaratory
22 judgment plaintiff could "not identif[y] a single legal
23 claim that it believes [the defendant] could have
24 brought against it in the absence of [the] declaratory
25 judgment action"). Here, Plaintiff seeks to dismiss
26 his infringement claim with prejudice. Dismissal with
27 prejudice has the same effect as Plaintiff entering
28 into a covenant not to sue. See Ltd. v. Compal Elecs.

1 Inc. Grp., No. 14CV1688 DMS (KSC), 2015 WL 11570939, at
2 *4 (S.D. Cal. Dec. 11, 2015). Plaintiff would
3 therefore be foreclosed from re-asserting his
4 infringement claim against Defendants. Without the
5 risk of an infringement suit regarding the '812 Patent,
6 "there will no longer be any basis for this Court to
7 continue to exercise jurisdiction over [Defendants']
8 counterclaims for declaratory judgment." In re
9 Rivastigmine Patent Litig., No. 05 MD 1661 (HB) (JCF),
10 2007 U.S. Dist. LEXIS 28576, at *17-18 (S.D.N.Y. Apr.
11 19, 2007); see Highway Equip. Co. v. FECO, Ltd., 469
12 F.3d 1027, 1032 n.1 (Fed. Cir. 2006) ("[T]he covenant
13 [not to sue] may have eliminated the case or
14 controversy pled in the patent-related counterclaims
15 and deprived the district court of Article III
16 jurisdiction with respect to those counterclaims.");
17 Nat'l Prods. v. Gamber-Johnson LLC, No. C07-1985RAJ,
18 2008 U.S. Dist. LEXIS 128463, at *13 (W.D. Wash. Apr.
19 23, 2008) (finding court lacked jurisdiction over
20 declaratory judgment of non-infringement counterclaim
21 when court dismissed plaintiff's patent infringement
22 claims).

23 Accordingly, if the Court dismisses Plaintiff's
24 infringement claim, Defendants' counterclaims cannot
25 remain pending for independent adjudication.

26 Therefore, the Court **DENIES** Plaintiff's Motion.

27 2. Defendants' Motion

28 Defendants move for summary judgment as to non-

1 infringement of the '812 Patent. Courts employ a two-
2 step analysis to determine whether an accused product
3 literally infringes a patent's claims. Telemac
4 Cellular Corp. v. Topp Telecom, Inc., 247 F.3d 1316,
5 1330 (Fed. Cir. 2001). First, the patent's claims must
6 be "construed to determine their scope." Id. "The
7 second step requires a comparison of the properly
8 construed claim to the accused device." Power Mosfet
9 Techs., L.L.C. v. Siemens AG, 378 F.3d 1396, 1406 (Fed.
10 Cir. 2004). "Literal infringement exists when every
11 limitation recited in the claim is found in the accused
12 device." Akzo Nobel Coatings, Inc. v. Dow Chem. Co.,
13 811 F.3d 1334, 1341 (Fed. Cir. 2016). "To support a
14 summary judgment of noninfringement it must be shown
15 that, on the correct claim construction, no reasonable
16 jury could have found infringement on the undisputed
17 facts or when all reasonable factual inferences are
18 drawn in favor of the patentee." TechSearch L.L.C. v.
19 Intel Corp., 286 F.3d 1360, 1371 (Fed. Cir. 2002)
20 (citation omitted). "Thus, the party opposing the
21 motion for summary judgment of noninfringment [sic]
22 must point to an evidentiary conflict created on the
23 record, at least by a counter-statement of a fact set
24 forth in detail in an affidavit by a knowledgeable
25 affiant." Id. at 1372.

26 In their Motion, Defendants focus on the lack of a
27 wet scrubbing section in any of the Accused Products.
28 Specifically, Defendants point to the lack of a water

1 chamber in any of their products. Claim 1 of the '812
2 Patent specifically discloses a water chamber, and
3 thus, to literally infringe the '812 Patent, each of
4 the Accused Products must contain a water chamber. As
5 the Court held in its Claim Construction Order, a water
6 chamber is "a chamber for holding water, not other
7 liquids." Order re: Claim Construction 13:7-8.
8 Defendants provide pictures, including cross-sections,
9 of their products showing the components of each
10 product. Defs.' Mot. for Partial Summ. J. 4-6, ECF No.
11 47. It is clear from these pictures that none of the
12 Accused Products includes a water chamber within the
13 meaning of this Court's claim construction. The
14 Accused Products all include a cigarette oil tank, but
15 these tanks are not meant to hold water. The cigarette
16 oil tanks hold the cigarette oil that is then atomized
17 and turned into the vapor the user inhales. Without a
18 water chamber, the Accused Products cannot literally
19 infringe the '812 Patent.

20 Despite Plaintiff's assertion that Defendants'
21 arguments are conclusory and Defendants' expert's
22 opinions provide no analysis of the structures of
23 Defendants' products, Defendants do not bear the burden
24 of proving infringement. A defendant moving for
25 summary judgment on non-infringement does "not have to
26 support its motion with evidence of non-infringement."
27 Exigent Tech. v. Atrana Sols., Inc., 442 F.3d 1301,
28 1308 (Fed. Cir. 2006) (citing Celotex, 477 U.S. at

1 321). Instead, "nothing more is required than the
2 filing of a summary judgment motion stating that the
3 patentee had no evidence of infringement and pointing
4 to the specific ways in which accused systems did not
5 meet the claim limitations." Id. at 1309.

6 Plaintiff has failed to provide any evidence of
7 infringement sufficient to raise a genuine issue of
8 material fact. Other than argument, the only piece of
9 evidence Plaintiff provides in support of his
10 Opposition is two pictures of the Accused Products, one
11 containing a cross section of the alleged ball chamber
12 and another showing one of the Accused Products broken
13 up into a few of its components. See Decl. of Alan C.
14 Chen, Ex. A, ECF No. 55-2. However, the focus of these
15 pictures is on the alleged ball chamber Plaintiff
16 claims is contained in the Accused Products. Plaintiff
17 claims that this picture shows that the Accused
18 Products contain a water chamber: "the concealed
19 component in the accused devices is designed so, in
20 operation, liquid drips into the area, above the ball,
21 but does not pass the ball, providing for scrubbing of
22 airflow." Pl.'s Opp'n to Defs.' Mot. for Partial Summ.
23 J. ("Pl.'s Opp'n") 4:13-15, ECF No. 55. This argument
24 is meritless; it does not reference a water chamber at
25 all and instead focuses on what Plaintiff alleges is a
26 ball chamber for wet scrubbing of airflow. Even if the
27 Accused Products contain a ball chamber as recited in
28 Claim 1, they still must contain a water chamber to

1 literally infringe every limitation of Claim 1.

2 Further, nowhere in the pictures Plaintiff provides
3 is there a component resembling a water chamber.

4 Plaintiff argues that the Accused Products contain a
5 liquid chamber, and that while the Court construed
6 water chamber to mean a chamber for holding water, the
7 water chamber does not actually need to hold water.

8 Even if this were true, which would go against the
9 Court's clear claim construction, Plaintiff misses the
10 point of the claimed water chamber—to provide a wet
11 scrubbing of the vapor. Per the language of Claim 1,
12 the water chamber must be "in fluid communication with
13 the mouthpiece, wherein the water chamber provides for
14 scrubbing of incoming airflow." Defs.' SUF ¶ 5.

15 Plaintiff does not provide any evidence that the liquid
16 chamber he claims acts as the water chamber is in fluid
17 communication with the mouthpiece or provides any sort
18 of wet scrubbing of the vapor prior to the user
19 inhaling the vapor. Plaintiff is grasping at straws to
20 create a genuine issue of material fact, and the Court
21 cannot rely solely on Plaintiff's arguments in finding
22 one such genuine issue exists. See Kohler v. Bed Bath
23 & Beyond of Cal., LLC, No. EDCV 11-01246 VAP (OPx),
24 2012 U.S. Dist. LEXIS 89368, at *17 (C.D. Cal. June 27,
25 2012) ("No genuine issue of material fact exists if the
26 Court determines that Plaintiff's purported factual
27 disputes fail to actually address Defendant's submitted
28 facts or evidence but instead propound legal arguments

1 as to the merits of the case."); Fed. R. Civ. Proc.
2 56(e) (noting that a nonmoving party must put forth
3 "specific facts" to show that a genuine issue of
4 material fact exists).

5 Because Plaintiff has failed to provide any
6 evidence of a water chamber used to scrub the incoming
7 vapor prior to the user inhaling the vapor, there is no
8 genuine issue of material fact as to literal
9 infringement of Claim 1 of the '812 Patent.

10 Plaintiff also attempts to rely on the doctrine of
11 equivalents to raise a genuine issue of material fact
12 as to infringement. "One way of proving infringement
13 under the doctrine of equivalents is to show, for each
14 claim limitation, that the accused product 'performs
15 substantially the same function in substantially the
16 same way with substantially the same result as each
17 claim limitation of the patented product.'" Brilliant
18 Instruments, Inc. v. GuideTech, LLC, 707 F.3d 1342,
19 1347 (Fed. Cir. 2013) (quoting Crown Packaging Tech.,
20 Inc. v. Rexam Beverage Can Co., 559 F.3d 1308, 1312
21 (Fed. Cir. 2009)). Under the doctrine of equivalents,
22 the court asks "whether an asserted equivalent
23 represents an 'insubstantial difference' from the
24 claimed element, or 'whether the substitute element
25 matches the function, way, and result of the claimed
26 element.'" Deere & Co. v. Bush Hog, LLC, 703 F.3d
27 1349, 1356 (Fed. Cir. 2012) (citation omitted). "If no
28 reasonable jury could find equivalence, then the court

1 must grant summary judgment of no infringement under
2 the doctrine of equivalents." Id.

3 Based on the complete lack of evidence and
4 Plaintiff's reliance on argument only, no reasonable
5 jury could find equivalence between the '812 Patent and
6 the functions of the Accused Products. Plaintiff
7 offers no expert testimony, nor does he provide any
8 evidence to show that the Accused Products have a
9 component that serves the necessary wet scrubbing
10 function. He simply provides a picture of one of the
11 Accused Products broken down into its components.
12 Plaintiff's only argument is that "vapor must pass
13 through liquid after it flows through the tube and
14 passes the ball when the ball is in the open position."²
15 This argument is hard to follow and does not provide
16 evidence that once the cigarette oil is heated in the
17 atomizer, the vapor then passes through some
18 unidentified liquid to cool and clean the vapor. As
19 shown in the pictures both parties provide, the vapor
20 passes through a tube to the mouthpiece. The tube
21 through which the vapor passes does not contain liquid,
22 and Plaintiff does not point to a single container
23 holding liquid through which the vapor must pass before

24
25 ² Plaintiff does not make such an argument in the section of
26 his Opposition addressing the doctrine of equivalents. Rather,
27 in that section, Plaintiff simply states that the Accused
28 Products "provide[] substantially the same function . . . in
substantially the same way . . . [to] provide[] substantially the
same result." Pl.'s Opp'n 7:9-14. Such conclusory argument
cannot create a genuine issue of material fact.

1 the user inhales the vapor. Again, Plaintiff must
2 provide *evidence*, not argument, of how the Accused
3 Products perform the same wet scrubbing function of the
4 '812 Patent.³ Plaintiff has failed to do so, and
5 therefore, no genuine issue of material fact can exist
6 under the doctrine of equivalents.

7 Because Plaintiff has failed to provide any
8 evidence sufficient to raise a genuine issue of
9 material fact as to infringement, either literal or
10 under the doctrine of equivalents, of the '812 Patent,
11 the Court **GRANTS** Defendants' Motion as to non-
12 infringement of the '812 Patent.

13 **III. CONCLUSION**

14 Based on the foregoing, the Court **DENIES**
15 Plaintiff's Motion and **GRANTS** Defendants' Motion.
16 Because the Court has granted summary judgment in favor
17 of Defendants as to non-infringement of the '812
18 Patent, the only claim that remains is Defendants'
19 invalidity counterclaim. Defendants may either
20 continue to pursue this counterclaim or voluntarily
21 dismiss it and move forward with a motion for

22 ///

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26 ³ The Court is not asking Plaintiff to provide significant
27 evidence, or even an expert report, to show the Accused Products
28 perform the wet scrubbing function, but Plaintiff must do more
than provide two photographs showing parts of one of the Accused
Products.

1 attorneys' fees.

2 **IT IS SO ORDERED.**

3 DATED: June 4, 2018

s/ RONALD S.W. LEW

HONORABLE RONALD S.W. LEW
Senior U.S. District Judge

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