

THE HONORABLE RONALD B. LEIGHTON

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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON AT TACOMA

Westech Aerosol Corporation, (a Washington Corporation),

Plaintiff,

v.

ITW Polymers Sealants North America Inc. (a Texas Corporation),

Defendant.

Civil Action No. 3:17-cv-05068

AMENDED COMPLAINT

JURY TRIAL DEMANDED

The Plaintiff, Westech Aerosol Corporation (“Westech”), for its complaint against Defendant, ITW Polymers Sealants North America Inc. (“ITW”), requesting damages, an injunction, and other relief, alleges as follows:

I. NATURE OF THE ACTION

1. This is an action for infringement of United States Patent No. 7,705,056 (“the ’056 patent”) under 35 U.S.C. §§ 271 *et. seq.*

II. PARTIES

2. The Plaintiff, Westech Aerosol Corporation, is a corporation organized and existing under the laws of the State of Washington, with a principal place of business in Kitsap County,

1 WA.

2 3. Defendant, ITW Polymers Sealants North America Inc. (“ITW”), is a corporation
3 organized and existing under the laws of the State of Texas, with a principal place of business in
4 or near Irving, Texas.
5

6 **III. JURISDICTION AND VENUE**
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8 4. This action arises under the Patent Act, 35 U.S.C. §§ 1 et. seq. This court has
9 jurisdiction over the subject matter of this complaint under 28 U.S.C. §§ 1331 and 1338(a).
10

11 5. Defendant has placed infringing products into the stream of commerce by shipping
12 those products into this judicial district or by knowing that such products would be shipped into
13 this judicial district by one or more distributors.
14

15 6. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1400(b) and 28
16 U.S.C. § 1391(b) because defendant ITW has committed acts of infringement in this judicial
17 district and is subject to personal jurisdiction in this judicial district.
18

19 **IV. GENERAL ALLEGATIONS**
20

21 7. Entitled “Aerosol Adhesive and Canister-Based Aerosol Adhesive System,” the
22 ’056 patent was duly and legally issued on April 27, 2010. A true and correct copy of the ’056
23 patent is attached hereto as Exhibit 1.
24

25 8. The ’056 patent issued in the name of the inventor, Dr. David Carnahan (“Dr.
26 Carnahan”). Dr. Carnahan is a named inventor on several U.S. patents. In 1981, Dr. Carnahan
27 earned a B.S. in mathematics and chemistry from Northland College. In 1982, Dr. Carnahan earned

1 an M.S. in business administration from Michigan Technological University. In 1986, Dr.
2 Carnahan earned a PhD from Emory University.

3 9. Beginning in 1991, Dr. Carnahan developed products for a small, privately held
4 distribution company named C.J.'s Distributing, Inc. While working for C.J.'s Distributing, Inc.,
5 Dr. Carnahan developed a line of profitable adhesive products under the brand STA'-PUT. This
6 line of adhesive products grew in sales from less than \$1,000,000 in 1991 to over \$12,000,000 by
7 1997 and the business built in connection with the brand STA'PUT was sold in 1998 to an entity
8 known as TACC International Corp. ("TACC"). TACC's assets, including certain adhesive
9 formulations that were developed by Dr. Carnahan and sold under the brand STA'-PUT, were
10 purchased by ITW's parent corporation and operated by ITW's parent corporation as a separate
11 business unit called "ITW-TACC" until April 2013, when the business was combined with others
12 to form ITW.
13
14

15 10. Dr. Carnahan founded Westech in Bremerton, Washington. Westech designs,
16 manufactures, and sells aerosol adhesives, including those that are low in volatile organic
17 compounds ("VOCs"). Over the years, Westech's low VOC aerosol adhesives have enjoyed
18 market acceptance and industry recognition.
19

20 11. Westech is the owner of all right, title, and interest in and to the '056 patent
21 including all claims for infringement of the '056 patent.
22

23 12. Claim 1 of the '056 patent claims a novel and non-obvious aerosol adhesive canister
24 system including a gas cylinder canister, a hose, a spray gun, a hydrocarbon propellant, and an
25 aerosol adhesive comprising a solvent mixture selected to have volatility characteristics for
26 producing a specific spray pattern, a polymeric base in said solvent mixture, and a compressed gas
27

1 dissolved in the solvent mixture.

2 13. On information and belief, Defendant ITW sells the following aerosol adhesive
3 products that are believed to infringe at least claim 1 of the '056 Patent because they contain all
4 elements of claim 1 of the '056 patent either literally or under the doctrine of equivalents: STA'-
5 PUT SP80 Canister Adhesive (hereinafter "the ITW Accused Product"). On information and
6 belief, the ITW Accused Product is available in canisters of various sizes and the ITW Accused
7 Product is available in different colors. All canister sizes and all colors of the ITW Accused
8 Product are accused of infringing the '056 Patent as alleged herein because the adhesive mixture,
9 solvent mixture, and propellants for the ITW Accused Product are not believed to differ
10 substantially between the various sizes and colors.
11

12
13 14. The ITW Accused Product is an aerosol adhesive canister system designed to
14 deliver an aerosol adhesive onto a substrate by spraying an aerosol adhesive through an attached
15 hose and spray gun. The ITW Accused Product includes a canister containing a hydrocarbon
16 propellant and an aerosol adhesive comprising a solvent mixture selected to have volatility
17 characteristics for producing a specific spray pattern, a polymeric base in said solvent mixture, and
18 a compressed gas dissolved in the solvent mixture.
19

20
21 15. In 2006, ITW-TACC, expressed interest in purchasing Westech. At this time, one
22 of ITW-TACC's general managers, Gary Hovan, visited Westech's facility. Mr. Hovan reviewed
23 Westech's operations and confidential business information, including confidential product
24 formulations and intellectual property. Mr. Hovan reviewed pending patent applications including
25 the patent application that issued as the '056 patent. ITW-TACC made an offer to purchase
26 Westech, but Westech declined the offer.
27

1 16. On information and belief, ITW has known of the '056 patent since at least as early
 2 as August 28, 2012. At or around this time, a representative of Westech, namely Victoria Fox,
 3 contacted ITW-TACC regarding a proposed merger or acquisition with or of Westech. At this
 4 time, Ms. Fox provided ITW-TACC information about Westech's assets, including information
 5 regarding Westech's two issued patents (which at that time included the '056 patent) and the low
 6 VOC adhesive products covered by those patents, as well as one pending patent application. This
 7 information was provided to J. Craig Waters who was ITW-TACC's General Manager at the time.
 8 Ms. Fox spoke to Mr. Waters and he confirmed receipt of Westech's business information
 9 including the information regarding Westech's patents and pending patent application.
 10

11 17. On information and belief, a number of current or former employees of ITW or
 12 ITW-TACC, including but not limited to Fred Walnut, Gary Hovan, J. Craig Waters, and Mike
 13 Dincolo, are aware of Dr. Carnahan's past work in research and product-development for TACC,
 14 and his continued work in that field for Westech, including Dr. Carnahan's work to develop and
 15 patent a new line of low VOC adhesive products for Westech. Furthermore, one or more of these
 16 employees have visited Westech's booth at industry tradeshow after the '056 Patent issued.
 17

18
 19 **V. CAUSES OF ACTION**

20
 21 Infringement of the '056 Patent by ITW Polymers Sealants North America Inc.

22 18. Westech incorporates the allegations in paragraphs 1-17 of this complaint.
 23

24 19. Defendant ITW has directly infringed at least claim 1 of the '056 patent by selling
 25 the ITW Accused Product in violation of 35 U.S.C. § 271(a).
 26

27 20. Defendant ITW has actively induced infringement of at least claim 1 of the '056

1 patent in violation of 35 U.S.C. § 271(b) by causing others to sell or use the ITW Accused Product
2 with knowledge and intent that such sale or use will directly infringe at least claim 1 of the '056
3 patent. For example, ITW has sold canisters containing all of the same ingredients identified above
4 in connection with the ITW Accused Product (i.e., canisters containing a hydrocarbon propellant
5 and an aerosol adhesive comprising a solvent mixture selected to have volatility characteristics for
6 producing a specific spray pattern, a polymeric base in said solvent mixture, and a compressed gas
7 dissolved in the solvent mixture), specifically intending that these canisters will be combined with
8 a hose and a gun, and resold or used in a manner that directly infringes at least claim 1 of the '056
9 patent.
10

11 21. ITW publishes and distributes detailed instructions for its resellers and users
12 instructing resellers and users how to combine a canister containing all of the same ingredients
13 identified above in connection with the ITW Accused Product (i.e., a canister containing a
14 hydrocarbon propellant and an aerosol adhesive comprising a solvent mixture selected to have
15 volatility characteristics for producing a specific spray pattern, a polymeric base in said solvent
16 mixture, and a compressed gas dissolved in the solvent mixture) with a hose and a gun in a manner
17 that directly infringes at least claim 1 of the '056 patent.
18

19 22. On information and belief, Defendant ITW has contributed to the infringement of
20 the '056 patent in violation of 35 U.S.C. § 271(c) by selling a component of an infringing
21 combination, namely a canister containing all of the same ingredients identified above in
22 connection with the ITW Accused Product (i.e., a canister containing a hydrocarbon propellant
23 and an aerosol adhesive comprising a solvent mixture selected to have volatility characteristics for
24 producing a specific spray pattern, a polymeric base in said solvent mixture, and a compressed gas
25 dissolved in the solvent mixture) with knowledge that this component constitutes a material part
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27

1 of the invention, that this component was especially made or especially adapted for use in an
2 infringement, and that this component is not a staple article or commodity of commerce suitable
3 for substantial non-infringing use.

4
5 23. A canister containing all of the same ingredients identified above in connection
6 with the ITW Accused Product (i.e., a canister containing a hydrocarbon propellant and an aerosol
7 adhesive comprising a solvent mixture selected to have volatility characteristics for producing a
8 specific spray pattern, a polymeric base in said solvent mixture, and a compressed gas dissolved
9 in the solvent mixture) is a material part of the invention claimed in claim 1 of the '056 patent
10 because all that is required to directly infringe claim 1 is to combine the canister with a hose and
11 a gun.

12
13 24. A canister containing all of the same ingredients identified above in connection
14 with the ITW Accused Product (i.e., a canister containing a hydrocarbon propellant and an aerosol
15 adhesive comprising a solvent mixture selected to have volatility characteristics for producing a
16 specific spray pattern, a polymeric base in said solvent mixture, and a compressed gas dissolved
17 in the solvent mixture) is especially made or especially adapted for use in an infringement because
18 it was made or adapted to be combined with a hose and the gun in a manner that directly infringes
19 at least claim 1 of the '056 Patent.

20
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22 25. A canister containing all of the same ingredients identified above in connection
23 with the ITW Accused Product (i.e., a canister containing a hydrocarbon propellant and an aerosol
24 adhesive comprising a solvent mixture selected to have volatility characteristics for producing a
25 specific spray pattern, a polymeric base in said solvent mixture, and a compressed gas dissolved
26 in the solvent mixture) is not a staple article or commodity of commerce suitable for substantial
27

1 non-infringing use because it has no other use than to be combined with a hose and a gun in a
2 manner infringing at least claim 1 of the '056 patent.

3 26. On information and belief, the infringement by ITW of the '056 patent as alleged
4 herein has been willful because it has continued since ITW had knowledge of the '056 patent and
5 because ITW continued after it knew or should have known that it was infringing the '056 patent.
6

7 27. As a direct result of ITW's infringement as alleged herein, Westech has suffered
8 irreparable injury such that remedies available at law are inadequate to compensate for that injury.
9

10 28. Considering the balance of hardships between the Plaintiff and Defendant, a
11 remedy in equity is warranted.
12

13 29. The public interest would not be disserved by a permanent injunction against
14 further sales by ITW of the ITW Accused Product.
15

16 30. Westech has marked its products embodying at least one claim of the '056 patent
17 in compliance with 35 U.S.C. § 287 by including the word "patented" on labels affixed to such
18 products together with the patent number continuously since at least as early as September 20,
19 2016.
20

21 **VI. PRAYER FOR RELIEF**

22
23 WHEREFORE, Westech Aerosol Corporation prays for relief against ITW Polymers
24 Sealants North America Inc. as follows:
25

26 A. that the court enter judgment that the '056 patent is infringed the ITW Accused
27 Product and that Westech is entitled to an award of damages in an amount to be proven at trial but

1 in no event less than a reasonable royalty;

2 B. that the court enter judgment that the '056 patent is infringed the ITW Accused
3 Product and that Westech is entitled to an award of damages in an amount to be proven at trial but
4 in no event less than a reasonable royalty;

5
6 C. that the court enter judgment that the '056 patent is not invalid;

7
8 D. that the court permanently enjoin Defendant ITW from any further acts of direct
9 infringement of the '056 patent, including enjoining any further manufacture, sale, offers for sale,
10 and use by Defendant of the ITW Accused Product;

11
12 E. that the court permanently enjoin Defendant ITW from any further acts of indirect
13 infringement of the '056 patent, including enjoining any further acts of inducement and
14 contributory infringement;

15
16 F. that the court treble damages and award reasonable attorney's fees and costs
17 pursuant to 35 U.S.C. § 285;

18
19 G. that the court order an accounting of all sales not presented at trial and award
20 damages for any such sales; and

21
22 H. that the court enter such additional and further relief as it deems just and proper.

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24 **VII. JURY DEMAND**

25 Plaintiff demands a trial by jury of all claims so triable.
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DATED this 10th day of April, 2017.

LOWE GRAHAM JONES^{PLLC}

s/Mark P. Walters

Mark P. Walters, WSBA No. 30,819
Ellen M. Bierman, WSBA No. 23,224
Lawrence D. Graham, WSBA No. 25,402
Walters@LoweGrahamJones.com
EllenB@LoweGrahamJones.com
Graham@LoweGrahamJones.com

701 Fifth Avenue, Suite 4800
Seattle, Washington 98104
T: 206.381.3300
F: 206.381.3301

Attorneys for Plaintiff Westech Aerosol Corporation

CERTIFICATE OF SERVICE

I hereby certify that on April 10, 2017, I caused the foregoing document to be served on the following counsel of record by the method/s indicated:

PARTY/COUNSEL	METHOD OF SERVICE
<p>Noelle L. Chung, WSBA No. 51377 TOUSLEY BRAIN STEPHENS PLLC</p> <p>1700 Seventh Avenue, Suite 2200 Seattle, Washington 98101</p> <p>Phone: (206) 682-5600 Fax: (206) 682-2992 Email: nchung@tousley.com</p> <p><i>Attorneys for Defendant ITW Polymers Sealants North America Inc.</i></p>	<p><input type="checkbox"/> Via Hand-Delivery <input type="checkbox"/> Via U.S. Mail <input checked="" type="checkbox"/> Via CM/ECF System <input checked="" type="checkbox"/> Via E-mail</p>
<p>Courtland Reichman, Pro hac vice (CA Bar No. 268873) Kunwar Singh, Pro hac vice (CA Bar No, 251821) MCKOOL SMITH, P.C.</p> <p>255 Shoreline Drive, Suite 510 Redwood Shores, CA 94065</p> <p>Phone: (650) 394-1400 Telecopier: (650) 394-1422 Email: creichman@mckoolsmith.com Email: ksingh@mckoolsmith.com</p> <p><i>Attorneys for Defendant ITW Polymers Sealants North America Inc.</i></p>	<p><input type="checkbox"/> Via Hand-Delivery <input type="checkbox"/> Via U.S. Mail <input checked="" type="checkbox"/> Via CM/ECF System <input checked="" type="checkbox"/> Via E-mail</p>
<p>Matthew Tyler Cameron, Pro hac vice (TX Bar No. 24097451) MCKOOL SMITH, P.C.</p> <p>300 West 6th Street, #1700 Austin, TX 78701</p> <p>Phone: (512) 692-8752 Telecopier: (512) 692-8744 Email: mcameron@mckoolsmith.com</p>	<p><input type="checkbox"/> Via Hand-Delivery <input type="checkbox"/> Via U.S. Mail <input checked="" type="checkbox"/> Via CM/ECF System <input checked="" type="checkbox"/> Via E-mail</p>

<i>Attorneys for Defendant ITW Polymers Sealants North America Inc.</i>	
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Dated this 10th day of April, 2017.

LOWE GRAHAM JONES PLLC

s/Laurie Gero
Laurie Gero, Paralegal