

pursuant to Federal Rule of Civil Procedure 12(b)(6), seeking dismissal of: (1) Oxygenator’s claims of direct infringement based on Tennant’s manufacturing and sale of its products; (2) Oxygenator’s allegations of pre-notification indirect infringement in counts 1 through 4; (3) Oxygenator’s allegation of willful infringement and corresponding request for pre-notification enhanced damages in count 5; and (4) Oxygenator’s request for permanent injunctive relief. Tennant’s motion will be denied.

## I

This case concerns Tennant’s alleged infringement of three patents owned by Oxygenator—U.S. Patent Nos. RE45,415 (“the ’415 patent”), RE47,092 (“the ’092 patent”), and RE47,665 (“the ’665 patent”) (collectively, “the patents-in-suit”). *See* Am. Compl., Exs. A–C [ECF Nos. 9-1–9-3]. The history and issue dates of the patents-in-suit, rather than the claims contained therein, are most relevant to Tennant’s motion. In 2003, Aqua Innovations, Inc., a research and development company, applied for a patent on its flow-through oxygenators and methods of oxygenating flowing water. Am. Compl. ¶ 9 [ECF No. 9]. The application was granted and U.S. Patent No. 6,689,262 (“the ’262 patent”) was issued to Aqua Innovations on February 10, 2004. *See id.*; <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnehtahtml%2FPTO%2Fsearch-bool.html&r=1&f=G&l=50&col=AND&d=PTXT&s1=6,689,262.PN.&OS=PN/6,689,262&RS=PN/6,689,262>. The ’262 patent is the parent patent to the three patents-in-suit. *See* Am. Compl., Exs. A–C. In 2008, Oxygenator “was formed to commercialize” the technology created by Aqua Innovations, and Aqua Innovations assigned its patent rights to Oxygenator on August 8, 2008. *Id.* ¶ 10. A pending application

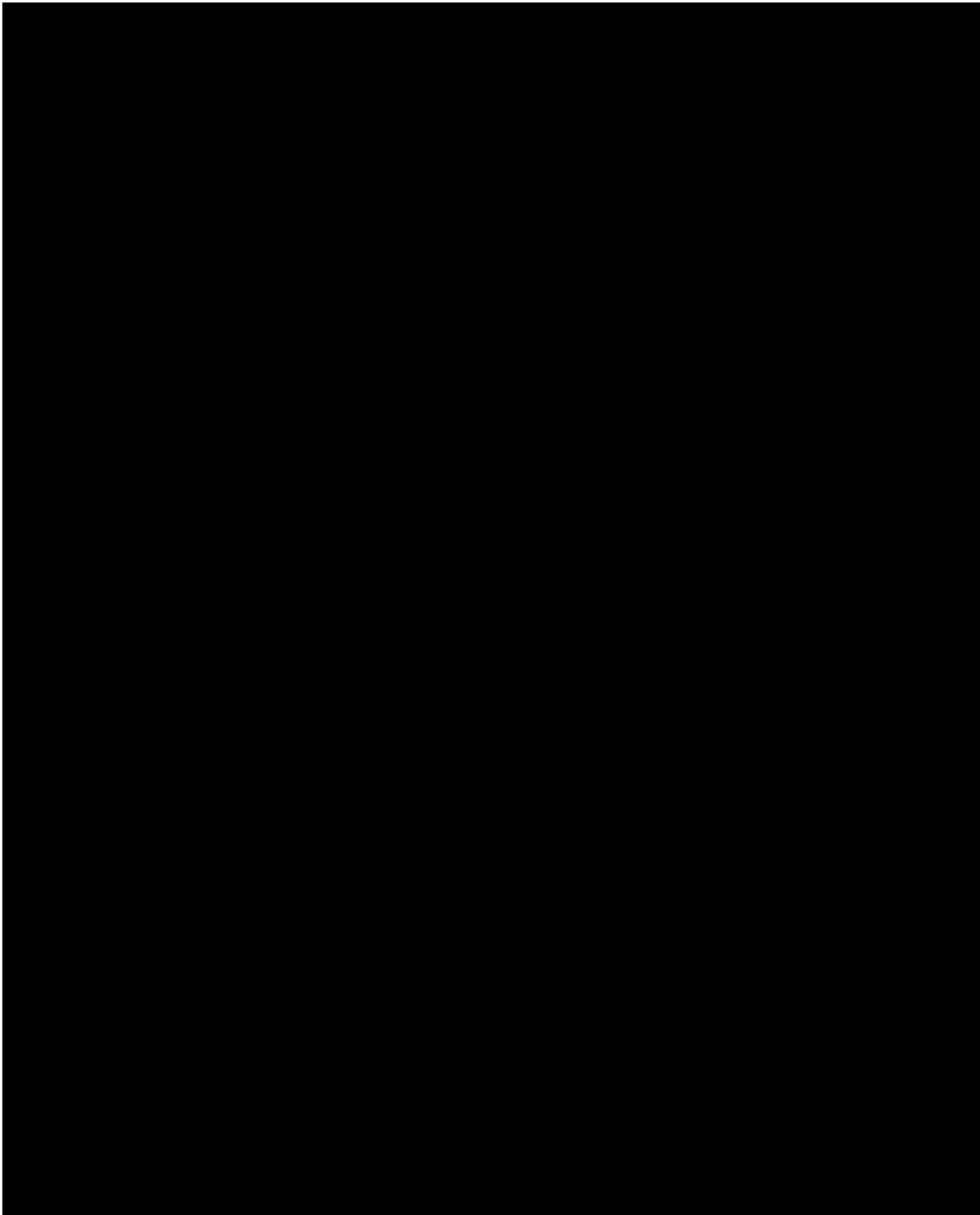
for another patent also was assigned to Oxygenator, and that patent, U.S. Patent No. 7,670,495 (“the ’495 patent”), was issued on March 2, 2010. Louwagie Decl., Ex. 1 [ECF No. 22-1]. Each of the patents-in-suit is a reissue of the ’495 patent. Am. Compl., Exs. A–C; *see* Mem. in Supp. at 2 [ECF No. 13]. The ’415 patent was issued on March 17, 2015, the ’092 patent was issued on October 23, 2018, and the ’665 patent was issued on October 29, 2019. Am. Compl., Exs. A–C.

Tennant’s alleged awareness of Oxygenator’s patents dates to January 19, 2007, when Tennant applied for its own patent (which was ultimately granted) for a “method and apparatus for generating, applying, and neutralizing an electrochemically activated liquid.” Louwagie Decl., Ex. 2 [ECF No. 22-2]. In its application, Tennant explained that part of its apparatus, a sparging device, “include[d] a commercially available oxygenator . . . . For example, oxygenator can include the OXYGENATOR Bait Keeper available from Aqua Innovation, Inc. of Bloomington, Minn., which is described in more detail in Senkiw U.S. Pat. No. 6,689,262.” *Id.* at 19:43–49. Tennant provided no other examples of oxygenators. *See id.* In 2008, Tennant began equipping many of its commercial floor scrubbers with ec-H<sub>2</sub>O<sup>TM</sup> electrolysis modules for oxygenating water and selling them as a “green” alternative to other scrubbers that required the use of chemicals. Am. Compl. ¶¶ 13, 20, 22. Tennant purchases the electrolysis modules from a third party. Mem. in Supp. at 3.

In 2010, Oxygenator approached Tennant with an offer to license its technology. Am. Compl. ¶ 26. On July 27, 2010, representatives from Oxygenator met with Tennant’s General Counsel and Director of Global Technology and Advanced Products. *Id.* After the meeting, Oxygenator emailed Tennant information about its technology and included

an attachment referencing “3 issued U.S. patents, 5 utility patent applications, and 10 provisional applications.” *Id.* ¶ 27. The attachment included links to the three issued patents (the ’262 parent patent, the ’495 patent, and one other) and three published patent applications. *Id.* One week later, Oxygenator issued a press release advertising an exclusive opportunity to license its patented technology for use in cleaning and sanitization. *Id.* ¶ 28, Ex. J [ECF No. 9-10]. The press release stated that Oxygenator would be accepting inquiries and offers until September 17, 2010. *Id.*, Ex. J. Oxygenator sent the press release to members of Tennant’s management team. *Id.* ¶ 28. The Parties continued to exchange emails, but, on September 2, Tennant informed Oxygenator that it would not bid on its technology. *Id.* ¶ 29; Mem. in Opp’n at 6 [ECF No. 21]. One month later, Oxygenator provided license pricing information to Tennant, and Tennant again declined to license Oxygenator’s technology. Am. Compl. ¶ 29.

Oxygenator next communicated with Tennant on September 20, 2019, when Oxygenator’s counsel sent Tennant’s Senior Vice President and General Counsel a letter informing them that Tennant was infringing on the ’415 and ’092 patents and on allowed claims in its forthcoming ’665 patent, for which Oxygenator had paid the issue fee. *Id.* ¶¶ 53, 78, 105, 123; Louwagie Decl., Ex. 3 [ECF No. 22-3]. After Tennant did not respond, Oxygenator commenced this lawsuit. ECF No. 1; Mem. in Supp. at 4. Oxygenator asserts five claims in its amended complaint: direct and indirect infringement of the ’415 patent (cylindrical electrode products) (Count 1); direct and indirect infringement of the ’415 patent (plate electrode products) (Count 2); direct and indirect infringement of the ’092 patent (Count 3); direct and indirect infringement of the ’665



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