

APPENDIX

APPENDIX TABLE OF CONTENTS

	Page
Circuit Court Opinion, August 15, 2023	App. 1
District Court Order, June 17, 2022.....	App. 28
District Court Order, October 6, 2021.....	App. 34
District Court Order, February 25, 2021	App. 36
District Court Order, March 25, 2020	App. 46
Circuit Court Opinion, February 25, 2019.....	App. 51
District Court Opinion and Order, June 8, 2017	App. 65
Circuit Court Order Denying Rehearing, Sep- tember 21, 2023.....	App. 96

App. 1

NOTE: This disposition is nonprecedential.

United States Court of Appeals
for the Federal Circuit

FLEET ENGINEERS, INC.,
Plaintiff-Cross-Appellant

v.

MUDGUARD TECHNOLOGIES, LLC,
Defendant

TARUN SURTI,
Defendant-Appellant

2022-2001, 2022-2076

Appeals from the United States District Court for
the Western District of Michigan in No. 1:12-cv-01143-
PLM, Judge Paul L. Maloney.

Decided: August 15, 2023

GEORGE THOMAS WILLIAMS, III, McGarry Bair PC,
Grand Rapids, MI, for plaintiff-cross-appellant.

TARUN SURTI, Brentwood, TN, pro se.

App. 2

Before MOORE, *Chief Judge*, LOURIE and STOLL, *Circuit Judges*.

PER CURIAM.

Tarun Surti appeals from decisions of the United States District Court for the Western District of Michigan in which he was awarded damages for infringement of U.S. Patent RE44,755 (the “’755 patent”)¹ by Fleet Engineers, Inc., but was denied other claimed relief. *See Fleet Eng’rs, Inc. v. Mudguard Techs., LLC*, No. 1:12-cv-01143, 2021 WL 9057803 (W.D. Mich. Oct. 19, 2021).

In particular, Surti appeals from (1) a decision excluding certain evidence from trial, (2) an order narrowing the issues of infringement to a subset of the asserted claims, (3) grants of judgment as a matter of law (“JMOL”) in favor of Fleet on claims of induced and contributory infringement, (4) portions of the jury verdict on infringement and damages, (5) failure to award attorney fees, and (6) failure to grant a permanent injunction.

Fleet cross-appeals, asserting that (1) the district court erred in not additionally granting JMOL in its

¹ The ’755 patent is a reissue of U.S. Patent 8,146,949 (the “’949 patent”), the original patent of interest in this case. The asserted claims of the ’949 patent are identical to corresponding claims in the reissued ’755 patent. The original filings by the parties in this litigation predated the reissue, and thus some of the underlying record and arguments refer to the ’949 patent as the asserted patent. We refer to the asserted patent using the reissue number.

App. 3

favor on Surti's claims of direct infringement and that (2) the jury verdict on direct infringement was not supported by substantial evidence.

For the following reasons, we *affirm*.

BACKGROUND

Surti and Fleet have been locked in acrimonious litigation over mudflaps and Surti's '755 patent for over a decade.

The '755 patent relates to a "mud flap for preventing spray from the wheel of a vehicle on a wet roadway from impairing the vision of drivers of other vehicles." '755 patent, col. 1 ll. 12–15. Traditional mudflaps are often constructed from solid panels of rubber material. *Id.* col. 1 ll. 21–27. As a vehicle moves, air resistance can cause the mudflap to lift or "sail," allowing a spray of water and debris to reduce the visibility of the driver behind the vehicle equipped with the mudflap. *Id.* col. 1 ll. 16–27. The mudflaps described in the '755 patent purport to solve that problem using a series of vertical slots or channels through which air can flow. The invention thus purports to "separate[] air, water and road debris thrown up by a tire or wheel and direct[] the water and debris to the ground while allowing the air to pass through the air outlets." *Id.* col. 4 ll. 19–22. Claim 1 of the '755 patent recites:

1. A mudflap for preventing spray from a wheel of a vehicle on a wet roadway from impairing the vision of drivers of other vehicles, comprising a vertically extending flap which

App. 4

is mounted to the rear of the wheel with a front side of the flap facing the wheel and a rear side facing away from the wheel, a plurality of laterally spaced, vertically extending vanes defining a plurality of vertically extending channels on the front side of the flap for directing water and debris from the wheel in a downward direction toward the ground and not to the rear or sides of the flap, and vertically extending slotted openings in the channels of a size permitting air to pass through the openings to the rear of the flap and preventing water and debris from doing so.

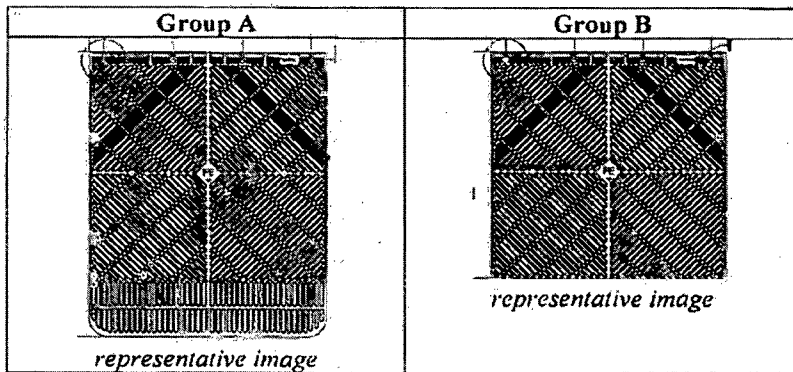
Id. col. 4. ll. 40–52.

This case is now on its second appeal. Our decision in the first appeal, which provides a more fulsome summary of the facts and procedural history through 2019, set forth how Fleet, a manufacturer of products for the trucking industry, brought an action seeking a declaratory judgment that its mudflaps do not infringe the '755 patent, and that the patent was invalid. *See Fleet Eng'rs, Inc. v. Mudguard Techs., LLC*, 761 F. App'x 989 (Fed. Cir. 2019) ("*Fleet I*"). Surti counterclaimed, asserting claims of patent infringement, breach of contract, and misappropriation of trade secrets. After the parties filed cross-motions for summary judgment, the district court granted Fleet's motion of noninfringement as well as finding it not liable for an alleged breach of contract and misappropriation of trade secrets. J.A. 422–46. Surti appealed and we held that unresolved factual issues precluded summary judgment on the issue of direct infringement. *Fleet I*, 761 F. App'x

at 992–94. We also affirmed the court’s finding that Surti failed to present evidence of a contract between Surti and Fleet, and thus upheld summary judgment on the contract-based claims. *Id.* at 994. Finally, we held that the district court did not err in granting summary judgment in favor of Fleet on the claim for misappropriation of trade secrets. *Id.* at 994–95.

On remand, a jury evaluated infringement of claims 1, 2, 5, 8, 9, and 13 of the ’755 patent by two subsets of Fleet products, referred to as the Group A and Group B products. *See* J.A. 53–54. Both product groups, shown below, include openings that are angled at approximately 45 degrees, separated into four quadrants. The Group A products further contain vertical ridges and openings at or near the bottom of the mud-flap, while the products in Group B do not.

ACCUSED PRODUCTS



J.A. 53.

App. 6

At the close of evidence, but before the verdict, Fleet moved for JMOL on Surti's claims of direct, induced, contributory, and willful infringement. J.A. 942-46. The district court granted Fleet's motion as to induced and contributory infringement, holding that there was no evidence in the record to support either theory of liability, but declined to enter JMOL as to direct infringement and willfulness. J.A. 1091-92. The jury ultimately found that although Fleet's Group B products did not infringe the asserted claims of the '755 patent, the Group A products did. J.A. 54. That infringement, however, was not found to be willful. *Id.*, 56. The jury declined to award lost profits and instead awarded damages based on 4% of the gross sales of the Group A products, amounting to an award of \$228,000. J.A. 1, 57. Surti appealed. Fleet cross-appealed.

We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

Surti raises multiple challenges on appeal. He first contends that the decision excluding certain evidence from trial constituted an abuse of discretion. In addition, he challenges an order narrowing the infringement issues to a subset of claims in the '755 patent. He further asserts that JMOL, granted in Fleet's favor on claims of induced and contributory infringement, was in error. He also contends that portions of the jury verdict on infringement and damages were unsupported by substantial evidence. Finally, he challenges the denial of attorney fees as well as the failure

to enter a permanent injunction. Fleet's cross-appeal asserts that the district court erred in not additionally granting JMOL in its favor on Surti's claims of direct infringement and that the jury verdict on direct infringement was not supported by substantial evidence. We address each argument in turn.

I

We turn first to Surti's assertion that the district court's exclusion of witness testimony and evidence was an abuse of discretion. According to Surti, the court "blocked [evidence pertaining to] the history of the case prior to the litigation date," including testimony from Surti himself, as well as from a mold manufacturer, an injection molder, and an engineer who designed original part drawings. *See* Appellant's Br. ¶ 4; *see also* J.A. 709–11 (Surti's evidentiary motion), J.A. 5–8 (order denying Surti's evidentiary motion).

We review evidentiary rulings under the law of the regional circuit, here the Sixth Circuit. *See SSL Servs., LLC v. Citrix Sys., Inc.*, 769 F.3d 1073, 1082 (Fed. Cir. 2014). Under Sixth Circuit law, evidentiary decisions are reviewed for abuse of discretion and should only be reversed if they have caused more than harmless error. *McCombs v. Meijer, Inc.*, 395 F.3d 346, 358 (6th Cir. 2005). "An abuse of discretion occurs if the district court relies on clearly erroneous findings of fact, applies the wrong legal standard, misapplies the correct legal standard when reaching a conclusion, or makes a clear error of judgment." *Miller v. Countrywide Bank*,

App. 8

N.A., 708 F.3d 704, 707 (6th Cir. 2013) (internal quotation marks omitted).

Under that standard, Surti's arguments can best be understood as asserting that the district court made a clear error of judgment in excluding evidence. According to Surti, the excluded testimony and evidence was "very important for the Jury to know." Appellant's Br. ¶ 4. Abuse of discretion, however, is a highly deferential standard. And a party's opinion that excluded evidence was relevant, or even important, is insufficient to overturn a court's decision excluding that evidence. As the court explained, the identities of the witnesses that Surti wished to testify on his behalf were not disclosed until years after close of discovery and his additional excluded evidence did not appear to be relevant to the asserted claims of patent infringement. *See* J.A. 6–8. We agree and see no clear error of judgment. We therefore conclude that it was not an abuse of discretion for the court to exclude those witnesses and that evidence from the record.

II

Surti next asserts that the district court erred in narrowing the infringement inquiry to only six of the '755 patent's 25 claims. In particular, according to Surti, the court "totally ignored" his "pleading for his '755 claim no. 19 that was properly filed and timely identified." Appellant's Br. ¶ 5. Fleet does not substantively address that issue in its response.

It is clear, however, that the district court did not ignore claim 19. Rather, it thoroughly evaluated the filings to identify the asserted claims after we suggested it do so in *Fleet I*. See 761 F. App'x at 993–94; J.A. 659–62. Moreover, although Surti refers to his assertion of claim 19 as “timely identified,” that cannot be the case, because, as discussed below, claim 19 did not exist before the deadlines to amend the pleadings or the chart of asserted claims passed.

Surti's allegation amounts to a suggestion that the district court abused its discretion in declining to amend the scheduling order to allow for the assertion of claim 19. But a scheduling order may only be modified “for good cause and with the judge's consent.” Fed. R. Civ. P. 16(b)(4). “The primary measure of Rule 16's good cause standard is the moving party's diligence in attempting to meet the case management order's requirements.” *Inge v. Rock Fin. Corp.*, 281 F.3d 613, 625 (6th Cir. 2002) (internal quotation marks omitted). “We review for abuse of discretion a district court's decision to amend its scheduling order to allow a late filing.” *Andretti v. Borla Performance Indus., Inc.*, 426 F.3d 824, 830 (6th Cir. 2005).

At the outset of this litigation, the district court issued a Case Management Order (“CMO”) setting a March 1, 2013 deadline for motions to amend the pleadings. See District Court Docket No. 13 at 1. The CMO also required Surti to “file and serve a disclosure, listing each claim of the patents-in-suit that [he] contends have been infringed.” *Id.* ¶ 3.a. Surti subsequently timely filed a disclosure asserting that Fleet

“infringed claims 1, 2, 5, 8, 9, and 13” of the ’949 patent. *See* District Court Docket No. 20 at 1. The CMO further required the parties to provide a “comprehensive chart” denoting “all claims of each patent-in-suit that [Surti] will contend at trial has been infringed.” CMO ¶ 3.c; *see also* District Court Docket No. 27 at 2 (confirming Fleet’s understanding that Surti asserted infringement of ’949 patent claims 1, 2, 5, 8, 9, and 13). By mid-2013, the deadlines to amend the pleadings and the CMO, and the deadline to submit the chart of asserted claims had all passed, although the CMO allowed the parties to further “amend or modify the disclosures in the chart for good cause shown.” CMO ¶ 3.c.

Thereafter, on February 11, 2014, the ’949 patent reissued as the ’755 patent. J.A. 104. Claims 1, 2, 5, 8, 9, and 13 were not amended during reissue and remained unchanged, although the ’755 patent further contains claims not originally present in the ’949 patent, including claim 19. *Compare* J.A. 102–03 (’949 patent claims 1–17) *with* J.A. 112–13 (’755 patent claims 1–25). Fleet subsequently moved to amend its complaint to reference the reissued patent, and the district court found that good cause existed to do so. *See* District Court Docket No. 98 at 1–3. As the court explained, “[a]llowing Fleet Engineers to amend the complaint would not cause [Surti] prejudice as the claims in the amended complaint are identical to the claims in the original complaint, albeit against the reissue patent instead of the original patent.” *Id.* at 3.

At no time did either party move to update the CMO or the chart of asserted claims to include

App. 11

additional claims added in the reissue patent, nor was there any attempt at showing good cause to do so. However, in filings made in September and October 2015, Surti asserted that Fleet had also infringed claim 19 of the '755 patent. J.A. 1321; *see also* District Court Docket No. 199 at 14 (referring to “asserted claims 1 and 19”); *Fleet I*, 761 F. App’x at 993–94 (noting the apparent confusion that these filings raised as to which claims were being asserted). The district court subsequently issued an order clarifying that claims 1, 2, 5, 8, 9, and 13 were the only properly asserted claims. J.A. 476. As the court explained, “Surti’s attempt to bring [c]laim 19 into the dispute through his motion for summary judgment and his response to Fleet Engineers’ motion is improper.” *Id.*; *see also id.* at 661–62.

We agree. The CMO clearly required Surti to have moved for an amendment to add claim 19 to the dispute, and to support that motion with a showing of good cause. He did not do so. The district court therefore did not abuse its discretion in determining that claims 1, 2, 5, 8, 9, and 13 were the only claims in dispute.

III

We next turn to the district court’s decisions regarding granting JMOL. Surti asserts that JMOL, entered in Fleet’s favor on claims of induced and contributory infringement (*see* J.A. 9, 1091), was granted in error. Fleet, in its cross-appeal, asserts that the court erred

in not further granting JMOL to Fleet on Surti's claims of direct infringement.

We review decisions on motions for JMOL under the law of the regional circuit, here the Sixth Circuit. *See SSL Servs.*, 769 F.3d at 1082. Under Sixth Circuit law, a district court's decision to grant JMOL is reviewed *de novo*. *Hanover Am. Ins. Co. v. Tattooed Millionaire Entm't, LLC*, 974 F.3d 767, 779 (6th Cir. 2020). "Judgment as a matter of law may only be granted if, when viewing the evidence in a light most favorable to the non-moving party, giving that party the benefit of all reasonable inferences, there is no genuine issue of material fact for the jury, and reasonable minds could come to but one conclusion in favor of the moving party." *Barnes v. City of Cincinnati*, 401 F.3d 729, 736 (6th Cir. 2005), *cert. denied*, 546 U.S. 1003 (2005).

According to Surti, Fleet "engaged in an 'induced infringement' when they co[n]tracted the manufacturing of" the Group A and B mudflaps "to the [m]old maker, Viking Tool & Engineering, and injection molder, H S Die & Engineering." Appellant's Br. ¶ 3; *see also id.* ¶ 4 (asserting that the district court "failed to recognize that [Fleet] engaged in 'induced infringement' by engaging [a] third party to manufacture the infringing mud flap").

A claim of induced infringement requires a showing not only of direct infringement, but further "that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another's infringement." *Enplas Display Device Corp. v. Seoul*

App. 13

Semiconductor Co., Ltd., 909 F.3d 398, 407 (Fed. Cir. 2018) (citation omitted); *see also C.R. Bard, Inc. v. Advanced Cardiovascular Sys., Inc.*, 911 F.2d 670, 675 (Fed. Cir. 1990) (defining induced infringement under 35 U.S.C. § 271(b) as “actively and knowingly aiding and abetting another’s direct infringement”).

As the district court earlier found when it granted JMOL with respect to induced infringement, there was no evidence in the record that Fleet knowingly induced a third party to infringe the ’755 patent with a specific intent to encourage another’s infringement. *See* J.A. 9, 1091. Surti has not pointed to any evidence in the record that the district court overlooked or misinterpreted in coming to that determination. Without a genuine issue of material fact on that matter, we conclude that the court did not err in granting JMOL in Fleet’s favor as to induced infringement.

A claim of contributory infringement requires a showing of a sale, or an offer to sell, “a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use.” 35 U.S.C. § 271(c); *Nalco Co. v. Chem-Mod, LLC*, 883 F.3d 1337, 1356 (Fed. Cir. 2018).

Just as the district court found in granting JMOL with respect to induced infringement, the court further

found that Surti introduced no evidence that Fleet had sold a component of a patented combination such that it could be held liable for contributory infringement. *See* J.A. 9, 1091. Surti has not pointed to any evidence in the record that the district court overlooked or misinterpreted in coming to that determination. Moreover, there is no evidence in the record supporting a conclusion that either the Group A or Group B mudflaps were components or material parts of a patented whole as required under § 271(c). Without a genuine issue of material fact, we conclude that the court did not err in granting JMOL in Fleet's favor as to contributory infringement.

In its cross-appeal, Fleet asserts that the district court erred in not granting JMOL in its favor on Surti's claims of direct infringement. In particular, Fleet asserts that neither its Group A nor its Group B products have "a plurality of laterally spaced, vertically extending vanes defining a plurality of vertically extending channels on the front side of the flap" as required by the claims of the '755 patent. *See* Appellee's Br. 70–79; J.A. 112–13 (providing the asserted claims). Fleet also argues that, although its Group A products have vertical slots at the bottom edge of the mudflap, the "slots do not define vertically extending channels to route water down the face of the mudflap and off the bottom of the mudflap" and that "[n]one of the slotted openings (vertical or otherwise) prevent water and debris from passing through them." Appellee's Br. at 75–77.

Fleet asserted the same arguments in its original motion for summary judgment, and the district court

did originally grant Fleet's motion as to direct infringement. See J.A. 438–45. However, we overturned that grant of summary judgment in *Fleet I*. As we explained then, a genuine issue of material fact existed as to whether or not Fleet's products comprise the claimed vanes, *Fleet I*, 761 F. App'x at 992, as well as whether or not Fleet's products meet the "vertically extending" limitations, *id.* at 993. Fleet has provided no argument or evidence to suggest that these genuine issues of material fact did not still exist when it moved for JMOL. Instead, as it did in its motion for JMOL, Fleet argues on appeal that "there was substantial evidence introduced at trial" that its products do "not block water impinging upon [the] face" of the mudflap, but rather allow water and debris "to pass through the openings." Appellee's Br. at 76. Yet as the district court correctly identified when it denied Fleet's JMOL motion, the claims do not require that all water and debris be completely blocked from passing through the mudflap. J.A. 45. Rather, "[s]ome water and debris might pass through the slotted openings." *Id.*

Whether or not Fleet's products comprised vanes and vertical openings that prevented a sufficient amount of water and debris from passing through the mudflap such that they infringed Surti's patent was a question of fact for the jury. Given the existence of those genuine issues of material fact, the district court did not err in declining to grant JMOL in Fleet's favor as to direct infringement.

IV

We next turn to the parties' assertions that portions of the jury verdict are unsupported by substantial evidence. Surti contends as such for the verdicts of noninfringement by the Group B products, the decision not to award lost profits, and the finding of a lack of willful infringement. In its cross-appeal, Fleet asserts that the jury's finding of infringement by the Group A products was unsupported by substantial evidence.

"A determination of infringement, both literal and under the doctrine of equivalents, is a question of fact, reviewed for substantial evidence when tried to a jury." *TI Grp. Auto. Sys. (N. Am.), Inc. v. VDO N. Am., LLC*, 375 F.3d 1126, 1133 (Fed. Cir. 2004).

Surti first asserts that the jury verdict that Fleet's Group B products did not infringe the asserted '755 patent claims was unsupported by substantial evidence. According to Surti, because the jury found that the Group A products infringed, it should have also found that the Group B products infringed. Appellant's Br. ¶ 3. The Group A and Group B products differ from one another in that only the Group A products contain vertical ridges and openings at or near the bottom of the mudflap. *See* J.A. 24, 53. Fleet responds that the jury could have reasonably come to its conclusion of noninfringement by the Group B products in view of (1) the absence of a vane, defined as "a relatively thin, rigid structure, like a blade, that is attached to another structure or surface," (2) the absence of vertical channels or slots, or (3) openings that are not "of a size to

permit air to pass through the openings to the rear of the flap and preventing water and debris from doing so.” Appellee’s Br. at 30. We agree with Fleet that the jury’s determination that Group B products did not directly infringe the ’755 patent was supported by substantial evidence. In particular, the jury reasonably could have found that the Group B products lack the vertically extending vanes, channels, and slotted openings required by the claims.

Surti further argues that even if the Group B products lacked the express structures recited in the ’755 patent claims, the jury still should have found infringement under the doctrine of equivalents. Appellant’s Br. ¶¶ 3, 6; *see also* J.A. 54 (Verdict Form, finding that the Group B products did not infringe the asserted claims of the ’755 patent either “literally or under the doctrine of equivalents”).

In determining equivalence, “[a]n analysis of the role played by each element in the context of the specific patent claim . . . inform[s] the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element.” *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40–41 (1997). A patent owner must provide “particularized testimony and linking argument as to the ‘insubstantiality of the differences’ between the claimed invention and the accused device or processes, or with respect to the function, way, result test when such evidence is presented to support a finding of infringement under the doctrine

of equivalents.” *Tex. Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed. Cir. 1996). “Such evidence must be presented on a limitation-by-limitation basis.” *Id.*

Surti does not explain how the Group B products would have infringed under such a standard, or why the jury’s verdict of noninfringement lacks substantial evidence support. Fleet again argues that, at the very least, the jury could have reasonably found that the Group B products lack the vertically extending vanes, channels, and slotted openings required by the claims even when evaluated under the doctrine of equivalents. Appellee’s Br. at 48–53. In particular, Fleet points to the district court’s construction of “vertically extending” as it pertains to the vanes, channels, and slotted openings of the mudflap to mean “perpendicular or at a 90 degree angle to the road surface.” *Id.*; see also J.A. 215. It is undisputed that the Group B products comprise four quadrants with vanes, channels, and slotted openings all oriented at diverging 45-degree angles. A reasonable jury could have found that components oriented at a 45 degree angle are not equivalent to components oriented at 90 degrees. The jury’s finding that the Group B products do not infringe the asserted claims under the doctrine of equivalents was therefore supported by substantial evidence.

Surti next asserts that the jury verdict that he was not entitled to lost profits was not supported by substantial evidence. See Appellant’s Br. ¶¶ 2 (asserting error from “[d]enial of proper damages award”), 3

(asserting, generally, that the “damage awards should be calculated accordingly using proper formula and proper laws”), 6 (requesting that we “[a]ward the damages based on Surti being a manufacturing comp[er]titor who lost profit that he could have made by selling the product to the Plaintiff or to the industry”). According to Fleet, however, the jury should not have even been presented with the question of lost profits because Surti was a non-practicing entity who had no lost profits. Appellee’s Br. at 53–55. We agree with Fleet.

Surti never assigned his patent to any company, including Mudguard, where he served as president. See J.A. 156. Nor is there any evidence to suggest that Surti entered into any licensing agreement that could have provided the right to recover lost profits at trial. Moreover, Surti has made no attempt to satisfy the *Panduit* factors, which require a showing of (1) a demand for the patented product, (2) the absence of acceptable non-infringing substitutes, (3) its manufacturing and marketing capability to exploit the demand, and (4) the amount of profit it would have made. *Rite-Hite Corp. v. Kelley Co., Inc.*, 56 F.3d 1538, 1545 (Fed. Cir. 1995) (citing *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156 (6th Cir. 1978)). The jury’s finding that Surti was not entitled to lost profits was therefore supported by substantial evidence.

Finally, Surti asserts that the jury verdict finding that Fleet’s infringement was not willful was not supported by substantial evidence. See Appellant’s Br. ¶¶ 2, 4, 6. “Whether infringement is willful is a question of

fact, and the jury's determination as to willfulness is therefore reviewable under the substantial evidence standard." *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 822 (Fed. Cir. 1992) (citations omitted). Willful infringement must be proven by clear and convincing evidence and is determined by the totality of circumstances. *Id.*

Surti asserts that, not only was Fleet's conduct "willful and wanton," but further that he should have been awarded treble damages in view of that conduct. Appellant's Br. ¶¶ 2, 6. Fleet responds that the jury's finding of no willful infringement was supported by substantial evidence. In particular, Fleet notes that the actions to which Surti points to make his assertions of willful conduct occurred two years before the asserted patent first issued. Appellee's Br. at 56–58. Although, as the district court observed, the evidence establishes that Fleet was aware of Surti's patent application, J.A. 30, "[t]o willfully infringe a patent, the patent must exist and one must have knowledge of it. . . . [A]n application is no guarantee any patent will issue. . . . What the scope of claims in patents that do issue will be is something totally unforeseeable." *State Indus., Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed. Cir. 1985).

The evidence adduced at trial, at best, may demonstrate Fleet's knowledge of Surti's patent issuing after Fleet was already selling its Group A products. Yet, even so, knowledge of the asserted patent and evidence of infringement, although necessary, is not sufficient for a finding of willfulness. *Bayer Healthcare LLC v.*

Baxalta Inc., 989 F.3d 964, 987 (Fed. Cir. 2021). Rather, willfulness requires deliberate or intentional infringement. *Eko Brands, LLC v. Adrian Rivera Maynez Enters., Inc.*, 946 F.3d 1367, 1378 (Fed. Cir. 2020). The jury was free to weigh the relevant evidence of record, which included evidence suggesting that Fleet intended to avoid patent infringement. Moreover, even if some evidence existed to draw the opposite conclusion, that does not mean that the jury's finding of no willfulness was unsupported by substantial evidence.

In its cross-appeal, Fleet argues that the jury verdict that its Group A products infringe the '755 patent was not supported by substantial evidence. Appellee's Br. at 76–79. To support that claim, Fleet repeats the arguments that it made in challenging the district court's decision not to award JMOL in Fleet's favor as to direct infringement. In particular, Fleet argues that the Group A products do not have vanes, vertically extended channels, or slotted openings to prevent the passage of water and debris through the mudflap as recited in the asserted claims.

As construed by the district court, however, the "vanes" required by the claims are "relatively thin, rigid structure[s], like a blade, that [are] attached to another structure or surface." J.A. 442–43. Neither party has challenged that construction on appeal. As we found in *Fleet I*, a reasonable jury could conclude that the corresponding structures in Fleet's products are relatively thin and rigid and are attached as protrusions from the rear wall of the mudflap's channels. *Fleet I*, 761 F. App'x at 992. We further found that a

reasonable jury could find that the presence of some channels vertically extending across the bottom of the Group A products may satisfy the claims. *Id.* at 993. Moreover, Fleet’s arguments ignore that the claims do not require complete blockage of water and debris from passing through the mudflap’s openings. *See* J.A. 218–20 (Claim Construction Order, noting that the “specification explicitly anticipates that some water and debris may pass through the slotted openings”). A reasonable jury could have found that the Group A products prevent sufficient amounts of water and debris from passing through, such that they directly infringe the asserted claims.

Fleet’s arguments on appeal amount to a mere disagreement with the jury’s findings. Such disagreement is insufficient to overturn a jury verdict that was otherwise supported by substantial evidence.

V

Surti also appeals the district court’s finding that this case was not exceptional and did not merit an award of attorney fees, as well as the court’s decision denying Surti’s request for a permanent injunction. Appellant’s Br. ¶¶ 2, 6.

A district court may, in exceptional cases, award reasonable attorney fees to the prevailing party under 35 U.S.C. § 285. *See Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 548–51 (2014) (interpreting the phrase “exceptional cases” and setting forth basic guidelines for determining whether or

not a request for attorney fees in patent infringement cases may be granted). We review a district court's decision not to award attorney fees under § 285 for abuse of discretion. *Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.*, 572 U.S. 559, 560–61 (2014).

As set forth by the district court, Surti has been proceeding *pro se* since 2015 and has provided no evidence of legal fees incurred before that date. J.A. 36–39. Instead, the record reflects that the two attorneys who represented Surti between 2013 and 2015 withdrew from the case after not being paid for their work. J.A. 246. Surti also failed to demonstrate that Fleet litigated this case in an unreasonable manner, asserted any plainly frivolous claims, or made any frivolous legal arguments during the course of this litigation causing the case to be exceptional. We therefore conclude that the court did not abuse its discretion in determining not to award Surti attorney fees under § 285.

Regarding the requested permanent injunction, Surti asserts that the district court erred in its decision to deny issuing a cease-and-desist order against Fleet. Appellant's Br. ¶¶ 2, 6. "The decision to grant or deny permanent injunctive relief is an act of equitable discretion by the district court, reviewable on appeal for abuse of discretion." *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 391 (2006).

The district court held that Surti did not provide sufficient evidence to support the issuance of a permanent injunction. J.A. 18–22; *see also* *TEK Global, S.R.L. v. Sealant Sys. Int'l, Inc.*, 920 F.3d 777, 792 (Fed. Cir.

2019) (quoting *eBay*, 547 U.S. at 391) (setting forth the factors considered in determining whether or not to issue an injunction).

A finding of infringement does not automatically entitle a patent holder to a permanent injunction. *eBay*, 547 U.S. at 391–93. Although Surti may have suffered an injury from the sale of an infringing product, that injury was not one of irreparable harm. *See Robert Bosch LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1149 (Fed. Cir. 2011) (holding that, in the context of patent infringement cases, there is no presumption of irreparable harm when a party establishes liability for patent infringement). The district court did not err in determining that Surti’s injury was compensable through the reasonable royalty awarded by the jury.

In deciding Surti’s motion for injunctive relief, the district court did not expressly address two of the *eBay* factors: the balance of the hardships between the claimant and the infringer and whether or not an injunction would serve the public interest. *See eBay*, 547 U.S. at 391. However, Surti did not independently argue those factors. *See* J.A. 21–22. The court therefore did not abuse its discretion in declining to issue a permanent injunction based only on the first two *eBay* factors.

Moreover, the purpose of an injunction is to prevent future infringement. *See Bio-Rad Lab’ys, Inc. v. 10X Genomics Inc.*, 967 F.3d 1353, 1377–78 (Fed. Cir. 2020). There is no evidence in the record that Fleet continues to sell the infringing products. *See* J.A. 22. It

was therefore not an abuse of discretion for the district court to have held that, without evidence of future harm, Surti had not sufficiently established entitlement to injunctive relief.

VI

Surti additionally makes passing references to trade secrets and various contract violations. Appellant's Br. ¶¶ 3, 6. Those issues were previously raised and decided by the district court years ago. We then affirmed those decisions in *Fleet I*. See 761 F. App'x at 994–95. The facts, law, and parties involved remain unchanged, and as Surti received a “full and fair” opportunity to litigate those claims, “the contemporary law of collateral estoppel leads inescapably to the conclusion that” Surti is collaterally estopped from relitigating those issues. See *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 332–33 (1979); see also *id.* at 326 (“Collateral estoppel, like the related doctrine of *res judicata*, has the dual purpose of protecting litigants from the burden of relitigating an identical issue with the same party or his privy and of promoting judicial economy by preventing needless litigation.”).

Surti also makes passing references to other holdings involving damages and district court actions, such as allegedly “block[ing] the discussion of the opinion of the Federal Court as well as its own Claim Construction Opinion” that he desires to be reviewed on appeal. Appellant's Br. ¶¶ 4, 6. He further raises arguments that were not presented at the district court level, such

as that he is entitled to additional damages “based on the mental stress this litigation has caused” him. *Id.* ¶¶ 2–4.

We recognize that Surti is not an attorney and that he is not fully acquainted with court rules and appellate procedures. However, the United States Supreme Court and the Sixth Circuit Court of Appeals have instructed courts to enforce procedural rules even against *pro se* litigants who are not familiar with them. *See, e.g., McNeil v. United States*, 508 U.S. 106, 113 (1993) (holding that the Court “never suggested that procedural rules in ordinary civil litigation should be interpreted so as to excuse mistakes by those who proceed without counsel”); *Pilgrim v. Littlefield*, 92 F.3d 413, 416 (6th Cir. 1996) (noting that “the lenient treatment generally accorded to *pro se* litigants has limits”).

Our law is well established that an argument must be properly raised in a party’s opening brief in order to be considered on appeal. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006). Appeals to this court further operate under a general principal of forfeiture in view of a “failure to make timely assertion of the right before a tribunal having jurisdiction to determine it.” *Boeing Co. v. United States*, 968 F.3d 1371, 1380 (Fed. Cir. 2020) (quoting *Yakus v. United States*, 321 U.S. 414, 444 (1944)). Because Surti failed to raise the remainder of his arguments adequately in his opening brief or at the district court prior to this appeal, we consider those arguments forfeited.

App. 27

CONCLUSION

We have considered both parties' remaining arguments and find them unpersuasive. For the foregoing reasons, we *affirm*.

AFFIRMED

COSTS

No costs.

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

FLEET ENGINEERS, INC.,)	No. 1:12-cv-1143
Plaintiff,)	Honorable
-v-)	Paul L. Maloney
TARUN SURTI and)	(Filed Jun. 17, 2022)
MUDGUARD TECHNOLOGIES)	
Defendants.)	

**ORDER DENYING MOTION FOR
CEASE AND DESIST ORDER**

Defendant and Counter-Plaintiff Tarun Surti filed a motion for a cease-and-desist order. (ECF No. 371.) Because Surti has not met the requirements for injunctive relief, the Court will deny his motion.

In October 2012, Plaintiff and Counter-Defendant Fleet Engineers filed a complaint seeking a declaration of non-infringement, a declaration of invalidity and asserting a claim for tortious interference with business relations. Fleet later filed an amended complaint to account for a reissue patent. (ECF No. 99 Compl.) Surti, then represented by counsel, filed second-amended counterclaims. (ECF No. 115.) Surti asserted claims for patent infringement, breach of contract, and misappropriation of trade secrets. In his prayer for relief, Surti requested, among other things, a permanent injunction against Fleet against further acts of infringement of his reissue patent. (PageID.994.)

In October 2021, the Court held a trial on the patent infringement counterclaims, the only claims that remained in the lawsuit. The verdict form asked the jury to consider two sets of accused products, Group A and Group B. The jury found that the products in Group A directly infringed Surti's patent and found that the product in Group B did not infringe Surti's patent. (ECF No. 370.) The jury declined to award lost profits and instead awarded damages based on 4% of the gross sales of the Group A products. The Court later issued an order establishing the amount of damages. (ECF No. 379.)

Following the verdict, Surti, now proceeding without counsel, filed a motion for a cease-and-desist order. (ECF No. 371.) This Court must liberally construe the pleadings and other filings of pro se parties. *Boswell v. Mayer*, 169 F.3d 384, 387 (6th Cir. 1999). In his motion, Surti acknowledges that he may have made some errors because of his unfamiliarity with the law. (PageID.3948.) He then states that he "expect[s] the Court to ignore or correct" his errors. This expectation exceeds the liberal construction a court must allow for pro se parties. As Fleet observes in its response, Surti failed to follow several procedural requirements found in the Local Rules. And, Surti does not cite any legal authority. The Court ordered Fleet to file a response, which it did (ECF No. 376.) Fleet, not Surti, sets forth the legal requirements for a permanent injunction. In his reply brief, Surti does not dispute those requirements. Nor does he provide any evidence that he can meet those requirements.

Surti's request for a cease-and-desist order functionally asks the Court for a permanent injunction prohibiting Fleet from manufacturing, selling and using products that infringe his patent. The Patent Act permits a court to grant injunctive relief to prevent the violation of any right secured by a patent. 35 U.S.C. § 283. A claimant must establish four factors to obtain a permanent injunction: (1) the claimant has suffered an irreparable injury; (2) the remedies available at law, like monetary damages, are inadequate to compensate for the injury; (3) the balance of the hardships between the claimant and the infringer weigh in favor of the injunction; and (4) the injunction would serve the public interest. *TEK Global, S.R.L. v. Sealant Sys. Int'l, Inc.*, 920 F.3d 777, 792 (Fed. Cir. 2019) (quoting *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 391 (2006)). A finding of infringement does not automatically entitle a patent holder to a permanent injunction. *See eBay*, 547 U.S. at 391-93 (rejecting the general rule that, in patent infringement cases, court will issue a permanent injunction against patent infringement absent extraordinary circumstances). "The decision to grant or deny permanent injunctive relief is an act of equitable discretion by the district court[.]" *Id.* at 391.

Courts treat permanent injunctions as drastic and extraordinary remedies "which should not be granted as a matter of course" when a less drastic remedy will suffice. *Apple Inc. v. Samsung Elecs. Co., Ltd.*, 735 F.3d 1352, 1359 (Fed. Cir. at 2013) (quoting *Monsanto Co. v. Geertson Seed Farms*, 561 U.S. 139, 165-66 (2010)). "The purpose of an injunction is to prevent future

violations[.]” *United States v. W.T. Grant Co.*, 345 U.S. 629, 633 (1953); *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 449 F. App’x 923, 932 (Fed. Cir. 2011) (“The purpose of a permanent injunction is to prevent future infringement rather than to compensate a patentee for past infringement or to punish an infringer for past infringement.”) (citation omitted). Although courts frequently describe the first element in the past tense, “has suffered,” because injunctive relief is designed to prevent future violations, for the first element courts do consider whether the claimant will suffer irreparable injury without the requested injunction. *See Bio-Rad Labs., Inc. v. 10X Genomics Inc.*, 967 F.3d 1353, 1377-78 (Fed.Cir. 2020) (“To prove irreparable injury, a patentee must show ‘that absent an injunction, it will suffer irreparable harm,’”) (quoting *Apple Inc. v. Samsung Elecs. Co.*, 695 F.3d 1370, 1374 (Fed. Cir. 2012)).

Surti has not put forth sufficient evidence to show that he has suffered irreparable harm or that he will suffer irreparable harm without a permanent injunction. Surti did not address this element in his initial brief. That omission alone provides a sufficient basis for denying this motion. After Fleet outlined the elements necessary for a permanent injunction, Surti attempts to establish irreparable injury in his reply brief. (ECF No. 402 Surti Reply at 3 PageID.4564.) Surti does not support any of his assertions with evidence.

Although the Court need not consider Surti’s late attempt to show irreparable harm, in an abundance of caution the Court addresses the arguments Surti

advances for irreparable injury and for inadequate remedies. First, simply using the phrase “irreparable injury” does not suffice to establish an irreparable injury. Second, Surti’s arguments about the burden on Mudguard do not establish that Surti suffered an irreparable injury. Fleet brought its third claim for tortious interference against Mudguard, a claim on which it has prevailed. Fleet did not bring patent claims against Mudguard. Third, Surti argues that he did not engage in tortious interference. This assertion does not establish irreparable harm. And, the Court granted Fleet’s motion to dismiss the tortious interference claim against Surti. (ECF No. 255.) Litigation costs are not something a court can consider when determining irreparable injury for the purpose of a permanent injunction. *ActiveVideo Networks, Inc. v. Verizon Communications, Inc.*, 694 F.3d 1312, 1337 (Fed. Cir. 2012). Fourth, Surti argues the Court erred in granting judgment to Fleet. This argument does not establish irreparable injury.

Turning to Surti’s assertions about inadequate remedies, Surti argues that the 4% royalty is inadequate. The Court assumes Surti’s reference to the lost profits calculation in the expert report is his attempt to show that the royalty rate awarded by the jury is inadequate. A difference between two the measures of damages—lost profits and royalties—does not establish that one or other is an inadequate remedy. While Surti suffers injury from the sale of an infringing product, his injury is compensable through damages

calculated either as lost profits or a reasonable royalty or some combination of the two.

Finally, the Court notes that Surti has neither argued nor established that Fleet continues to sell patent infringing mudflaps following the jury verdict. While this Court cannot ignore the jury's conclusion that Fleet infringed Surti's patent through past sales of Group A products, that finding by itself does not warrant an injunction.

Because Surti has not established irreparable harm or that his remedies at law are inadequate, the Court can deny the motion for a cease-and-desist order without considering the other two factors. *See Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, 809 F. App'x 965, 976 (Fed. Cir. 2020) ("Because we affirm the district court's conclusion on irreparable injury and adequacy of monetary damages, we need not reach the district court's conclusions on balance of harms and public interest.") (citing *Nichia Corp. v. Everlight Americas, Inc.*, 855 F.3d 1328, 1340 (Fed. Cir. 2017)).

For these reasons, the Court **DENIES** Surti's motion for a cease-and-desist order. (ECF No. 371.)
IT IS SO ORDERED.

Date: June 17, 2022

/s/ Paul L. Maloney
Paul L. Maloney
United States District Judge

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

FLEET ENGINEERS, INC.,)	
Plaintiff,)	No. 1:12-cv-1143
-v-)	Honorable
TARUN SURTI and)	Paul L. Maloney
MUDGUARD TECHNOLOGIES, LLC,)	(Filed Oct. 6, 2021)
Defendants.)	

ORDER GRANTING IN PART
FLEET ENGINEERS' RULE 50 MOTION

During the trial and at the close of Mr. Surti's proofs, Fleet Engineers made a motion for judgment at a matter of law under Rule 50. Ruling from the bench, the Court granted the motion in part and took portions of the motion under advisement.

For the reasons explained from the bench, the Court **GRANTS IN PART** Fleet Engineers' motion and will dismiss any claim by Mr. Surti for patent infringement based on a theory of inducement and will dismiss any claim by Mr. Surti for patent infringement based on a theory of contributory infringement. On the record at trial, no evidence supports either theory of liability. The Court has taken under advisement Fleet Engineers' motion as it concerns the means for calculating damages.

App. 35

IT IS SO ORDERED.

Date: October 6, 2021 /s/ Paul L. Maloney
Paul L. Maloney
United States District Judge

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

FLEET ENGINEERS, INC.,)	No. 1:12-cv-1143
Plaintiff,)	Honorable
-v-)	Paul L. Maloney
MUDGUARD TECHNOLOGIES, LLC)	
and TARUN SURTI.)	
Defendants.)	

ORDER

(Filed Feb. 25, 2021)

The disputes remaining in this lawsuit concern Defendant Tarun Surti's counterclaims for patent infringement. In this order, the Court addresses two pending motions and a third request for Court action contained in a document filed as a response to an order. (ECF Nos. 300, 306 and 309.)

I.

Some background is necessary. In June 2017, this Court resolved cross motions for summary judgment, granting in part Plaintiff Fleet Engineer's motion for summary judgment. (ECF No. 236.) The Court found that Plaintiff's mudflap, the AeroFlap, did not infringe Surti's patent. After judgment entered, Surti filed an appeal. In February 2019, the Federal Circuit Court of Appeals reversed the part of this Court's opinion

finding no infringement. *Fleet Eng'rs, Inc. v. Mudguard Techs., LLC*, 761 F. App'x 989 (Fed. Cir. 2019).

In granting summary judgment, the district court determined that the AeroFlap does not contain three limitations of the RE '755 patent claims. First, the district court held that the AeroFlap does not have the claimed "vanes" because the channels are formed from depressions in the surface of its mudflap, rather than from vanes that protrude from the surface. Second, it held that these depressions in the AeroFlap do not prevent water and debris from passing through slotted openings. Third, to the extent the AeroFlap has the claimed "vanes," "channels," or "slotted openings," it held that they are not "vertically extending." The district court's analysis of these limitations was erroneous.

Id. at 992. After finding no error in the manner in which this Court construed the term "vanes," the Federal Circuit explained the errors.

We agree with Mr. Surti, however, that a genuine issue of material fact exists as to whether the AeroFlap has the claimed vanes. The district court based its conclusion that the AeroFlap does not have "vanes" on the fact that its channels are created from depressions in the front surface of the mud flap, rather than structures that protrude from a surface. Though AeroFlap's vanes are flush with the front surface of the mud flap, a reasonable jury could conclude that they protrude from the rear wall of the channels. The construction of

the vanes does not require that the vanes protrude from all other surfaces on the mud flap. Moreover, in making its determination that the accused mud flap does not have vanes, the district court at times compared the accused product to Mr. Surti's commercial embodiment (V-Flap) rather than the claim limitations. The district court's analysis of whether AeroFlap's "depressions" performed the claimed functions of the "channels" also focused on a comparison of the accused product to Mr. Surti's V-Flap. "[I]nfringement is determined on the basis of the claims, not on the basis of a comparison with the patentee's commercial embodiment of the claimed invention." *Int'l Visual Corp. v. Crown Metal Mfg. Co.*, 991 F.2d 768, 772 (Fed. Cir. 1993) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1578 (Fed. Cir. 1984)). On remand, the district court should assess infringement by comparing the accused products to the invention as claimed, not to Mr. Surti's product.

We also agree with Mr. Surti that there was a genuine issue of fact which precluded summary judgment as to the "vertically extending" limitation. Mr. Surti argues that AeroFlap's lower section has "vertically extending" channels and slotted openings. While the district court relied on the fact that "[t]he majority of the structures on Fleet's mud flap are at a 45 degree angle." It is undisputed that two out of three of the accused products identified as part of No. 033-08002 and 033-08004, also have vertically extending channels and slotted openings at the bottom. During claim

construction, the parties disputed whether the term “vertically extending vanes defining a plurality of vertically extending channels” requires the channels to extend the length of the mud flap without interruption. The district court concluded that it does not, as there is “no length requirement for either the vane or the channel.” According to this construction, the vertical extensions do not have to span the entire mud flap in order for infringement to exist. As the claims at issue are open-ended “comprising” claims, the presence of unclaimed elements (such as vanes or channels at an angle) does not necessarily negate infringement. We conclude that a reasonable jury could find the presence of *some* channels that are vertically extending across the bottom of the AeroFlap may satisfy this limitation.

Id. at 992-93 (italics in original; citations to and quotations from the district court opinion omitted).

In addition to erring in the analysis of the claim limitations in the patent, the Federal Circuit noted confusion between this Court and the parties as to what claims are at issue. *Id.* at 993. When Surti filed this lawsuit and the Court conducted the claims construction phase of patent litigation, the Court and the parties addressed the claims in the original patent '949. Since then, Surti obtained a reissue patent, '755, that contains additional claims. In Plaintiff's brief supporting its motion for summary judgment, it argued that the additional claims in the reissue patent '755 were not part of this litigation. (ECF No. 226 at 16

PageID.2627.) In his brief, Surti requested summary judgment for claims 1 and 19, the latter did not appear in the original patent and only appears in the reissue patent. (ECF no. 192 at 15 PageID.2034.) In resolving the cross motions, the Court did not address Plaintiff's argument that only the claims that were part of the original '949 patent were in dispute. The Court did, however, reference language appearing in the added claims when discussing claim language.

Following the Federal Circuit's opinion, in May 2019, this Court ordered (ECF No. 284) Plaintiff to file a motion to clarify the patent claims in dispute, which it did in June 2019 (ECF No. 285). After Surti filed his response in August 2019, the Court issued an order in March 2020 identifying the patent claims in this lawsuit. (ECF No. 299.) In short, when the parties identified the claims in dispute early in this litigation, Surti had not obtained the reissue patent and none of the added claims in the reissue patent existed. The Court's case management order set forth procedures for amending the claims in dispute. Surti never filed any motion to amend the claims at issue in this lawsuit. The Court concluded that only the claims that were included in both the original patent and the reissue patent, the claims identified early in this lawsuit by both parties, are the claims in dispute.

II.

With this background, the Court turns to Defendant Surti's requests for Court action.

A. Motion for Summary Judgment (ECF No. 300)

Surti requests summary judgment on his patent infringement claims for claims 1, 2, 5, 8, 9, and 13. Surti reserves the right to appeal this Court's exclusion of the new claims in the reissue patent.

The Court will deny Surti's motion. The earlier opinion and order which was appealed resolved cross motions for summary judgment. For the patent infringement claims, this Court granted Plaintiffs motion and denied Surti's motion. On appeal, the Federal Circuit identified this Court's errors and concluded that genuine issues of material fact exist for whether (1) the AeroFlap has "vanes" and (2) lower section of some AeroFlap commercial embodiments infringe on the "vertically extending" limitation. Because a genuine issue of material fact exists for those two issues, this Court erred said the Circuit in granting Plaintiff summary judgment. Those same genuine issues of material fact now preclude this Court from granting Surti summary judgment on those issues. Because a genuine issue of material fact exists, neither party is entitled to summary judgment on the issues of whether (1) the AeroFlap has vanes and (2) the lower section of some AeroFlaps infringe on the vertically extending limitation. *See* Fed. R. Civ. P 56(a).

The Court concludes a genuine dispute of material fact also exists for the other error identified by the Federal Circuit, whether the AeroFlap's "depressions" perform the same function as the "channels" in Surti's patent. In the earlier opinion, this Court found that,

without vanes, the AeroFlap could not have channels. (ECF No. 236 at 23 PageID.2836.) Were Surd to establish at trial that Plaintiff's AeroFlap has vanes, then the AeroFlap might also have channels. The genuine issue of material fact for the existence of vanes identified by the Federal Circuit therefore also creates a similar dispute for the existence of channels in Plaintiff's AeroFlap. In its reply brief for its earlier motion for summary judgment, Plaintiff included external evidence which disputed whether the depressions in the AeroFlap performed the same function as the channels in the patent. (ECF No. 203 at 6-8 PageID.2517-19.) That question also remains.

Accordingly, the Court will deny Surti's motion for summary judgment. (ECF No. 300.) With this conclusion, the Court need not resolve Plaintiff's argument that the motion was improper and filed in violation of the Court's scheduling orders.

B. Motion to Expedite (ECF No. 309)

The Court appreciates Surti's desire to have these disputes resolved in a timely manner. As the Court explained in an earlier motion to expedite, over the past several years, this District lost an active judge; one senior-status judge to retirement, and one senior judge withdrew from the case draw, which increased the caseload for the remaining three judges. The added burden on the active judges affected many of the cases pending in the Western District of Michigan, including this one. Only recently did the Senate confirm the

individual nominated to the bench. That said, the Local Rules identify the proper basis for requesting expedited resolution of a pending motion. *See* W.D. Mich. LCivR 7.1(e). Because the Court has resolved Surti's motion for summary judgment, his motion to expedite will be dismissed as moot.

C. Motion for Reconsideration

After this Court issued the Order Clarifying Patent Claims In Dispute (ECF No. 299), Surti filed a response (ECF No. 306). The document has not been filed or docketed as a motion. Surti does, however, request Court action in the document. The Court interprets the document as a motion for reconsideration.

Under the Local Rule of Civil Procedure for the Western District of Michigan, a court may grant a motion for reconsideration when the moving party demonstrates both a "palpable defect" by which the Court and parties have been misled and a showing that a different disposition of the case must result from the correction of the mistake. W.D. Mich. LCivR 7.4(a). The decision to grant or deny a motion for reconsideration under this Local Rule falls within the district court's discretion. *See Evanston Ins. Co. v. Cogswell Props., LLC*, 683 F.3d 684, 691 (6th Cir. 2012) (citation omitted). The palpable defect standard does not expand the authority of the district court to reconsider an earlier order; it is merely consistent with a district court's inherent authority. *See Tiedel v. Northwestern Michigan Coll.*, 865 F.2d 88, 91 (6th Cir. 1988). The Sixth Circuit

has held that “[d]istrict courts have inherent power to reconsider interlocutory orders and reopen any part of a case before entry of final judgment” *In re Saffady*, 524 F.3d 799, 803 (6th Cir. 2008) (quoting *Mallory v. Eyrich*, 922 F.2d 1273, 1282 (6th Cir. 1991)). A party seeking reconsideration of an interlocutory order must show (1) an intervening change in the controlling law, (2) new evidence previously not available, or (3) a need to correct error to prevent manifest injustice. *Louisville/Jefferson Cty. Metro Gov’t v. Hotels.com, L.P.*, 590 F.3d 381, 389 (6th Cir. 2009) (citing *Rodriguez v. Tennessee Laborers Health & Welfare Fund*, 89 F.App’x 949, 959 (6th Cir. 2004)).

Surti has not identified a palpable defect, a change in the law, new evidence, or a need to prevent manifest injustice. The circuit court noted that this Court and the parties were confused about what claims were in dispute. The circuit court was correct. After reviewing the record, this Court concluded that only the claims that were part of the original patent ’949 that were contained in the reissue patent ’755 were in dispute. (ECF No. 299.) The Court explained that when the parties identified the claims in dispute early in this litigation, the added claims in the reissue patent did not exist. The case management order provided a mechanism for amending the claims in dispute. Surti never requested leave to amend those claims. Surti’s pro se status does not relieve him of the responsibility to follow the procedural rules. Referring to a claim not previously identified (Claim 19) in his motion for summary judgment does not put that claim into play in this

App. 45

lawsuit. The Court will deny Surti's motion for reconsideration.

For these reasons, the Court **DENIES** (1) Surti's motion for summary judgment (ECF No. 300) and his motion for reconsideration (ECF No. 306). The Court **DISMISSES** as moot Surti's motion for expedited consideration. (ECF No. 309).

IT IS SO ORDERED.

Date: February 25, 2021 /s/ Paul L. Maloney
Paul L. Maloney
United States District Judge

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

FLEET ENGINEERS, INC.,)
) No. 1:12-cv-1143
) Plaintiff,)
) Honorable
-v-) Paul L. Maloney
MUDGUARD TECHNOLOGIES, LLC)
and TARUN SURTI,) (Filed Mar. 25, 2020)
)
) Defendants.)

ORDER CLARIFYING
PATENT CLAIMS IN DISPUTE

This matter comes back to the Court on remand from the Federal Circuit Court. In its Opinion, the Federal Circuit ordered this Court to determine which patent claims are in dispute. Plaintiff Fleet Engineers filed a motion to establish the patent claims. (ECF No. 285.) Defendant Tarun Surti filed a motion asking for expeditious resolution of the matter.¹ (ECF No. 298.)

Fleet Engineers filed the lawsuit seeking a declaration of non-infringement. Through counsel, Surti filed a counterclaim asserting that Fleet Engineers infringed his patent. The Court issued a Case Management

¹ The Court appreciates Surti's request that the matter be resolved expeditiously. Most litigants in this District are aware that the Court lost to retirement two senior status judges and one district judge in the past three years. The three remaining district judges are diligently working to address all matters that are brought to the bench.

Order (CMO) establishing deadlines for the claim construction issues, which included a requirement that the parties collaborate on creating and filing a comprehensive chart identifying, among other things, “all claims of each patent-in-suit that plaintiff will contend at trial has been infringed[.]” (ECF No. 13 CMO ¶ 3.3. PageID.124.) The CMO further stated that the parties “may amend or modify the disclosures in the chart for good cause shown.” (*Id.*) Unless the disclosures in the claim construction process were later amended, the parties “shall be bound at trial by their disclosures.” (*Id.* ¶ 3.d. PageID.124.)

When Fleet Engineers filed this lawsuit, Surti had a patent on a mud flap, Patent No. ‘949. On February 11, 2014, Surti obtained a reissue patent for his mud flap. The reissue patent (‘755) contains twenty-five claims. The first seventeen claims are the same as the claims in the ‘949 patent. The reissue patent includes an additional eight claims, Claim 18-25. Surti filed his statement of claims on April 1, 2013, before the reissue patent issued. (ECF No. 20.) The parties filed their joint statement of claims and defenses on June 17, 2013, before the reissue patent issued. (ECF No. 27.) Obviously, neither Surti’s statement of claims nor the joint chart identifies Claim 19 as a patent claim in dispute.

Surti’s second amended counterclaim constitutes the controlling pleading for Surti’s claim for infringement. (ECF No. 115.) When the second amended counterclaim was filed, Surti was represented by counsel, albeit different counsel from when the lawsuit started.

The second amended counterclaim alleges that Fleet Engineers infringed the reissue patent. (*Id.* PageID.941.) The second amended counterclaim does not identify which patent claims were infringed.

The parties filed cross motions for summary judgment. In its motion for summary judgment, Fleet Engineers argued that the disputed patent claims were 1,2, 5, 8, 9, and 13 of the reissue patent, '757. (ECF No. 187-1 Pl. Br. PageID.1861.) Fleet Engineers explained that "Surti and Mudguard never supplemented their claim assertion with any additional or fewer claims." (*Id.*) Now proceeding without the benefit of counsel, in his own motion, Surti asserted that Fleet Engineer's mud flap infringed both Claim 1 and Claim 19 of the reissue patent. (ECF No. 192 Def. Br. at 14-17 PageID.2032-36.) Fairly characterized, these pages largely contain pictures and quotes from the reissue patent. Surti makes references to the infringement of Claim 19 in his declaration (ECF No. 193 ¶ 43 PageID.2053-54) and in his response to Fleet Engineers' motion (ECF No. 199 PageID.2415).

The patent claims in this dispute are Claims 1,2, 5, 8, 9, and 13 of the reissue patent, '757. Claim 19 of the reissue patent is not in dispute. The CMO required the parties to identify the disputed claims, which they did. Claim 19 was not included; at the time Claim 19 did not exist. The CMO provides a mechanism for amending the claims in dispute. Surti has never requested leave to amend the claim construction issues. Surti's attempt to bring Claim 19 into the dispute

through his motion for summary judgment and his response to Fleet Engineers' motion is improper.

The Federal Circuit noted that courts are supposed liberally construe pleading filed by pro se parties (ECF No. 278 Opinion at 8 PageID.3349), a statement which Surti relied upon in his response to Fleet Engineers' motion to clarify (ECF No. 296 at 2 PageID.3450). The liberal pleadings standard, however, has limits. The United States Supreme Court has cautioned that the rules does not relieve a pro se litigant of the obligation to follow a court's procedural rules:

we have never suggested that procedural rules in ordinary civil litigation should be interpreted so as to excuse mistakes by those who proceed without counsel. As we have noted before, "in the long run, experiences teaches that strict adherence to the procedural requirements specified by the legislature is the best guarantee of evenhanded administration of the law."

McNeil v. United States, 508 U.S. 106, 113 (1993) (quoting *Mohasco Corp. v. Silver*, 447 U.S. 807, 826 (1980)). "[T]he lenient treatment generally accorded to pro se litigants has limits," *Pilgrim v. Littlefield*, 92 F.3d 413, 416 (6th Cir. 1996), and pro se parties must "follow the same rules of procedure that govern other litigants," *Nielson v. Price*, 17 F.3d 1276, 1277 (10th Cir. 1994). *Accord Arunachalam v. Apple, Inc.*, ___ F. App'x ___, 2020 WL 729658, at *2 (Fed. Cir. Feb. 13, 2020) ("Dr. Arunachalam, though pro se, is required to follow the Federal Rules of Civil Procedure the same as every

other party that litigates in federal court.”). The CMO Issued in this lawsuit set forth a mechanism and a requirement for amending the patent claims in dispute. Surti has not followed the procedural mechanism for amending the claims in dispute.

Accordingly, Fleet Engineers’ motion to establish claims in dispute (ECF No. 285), is **GRANTED**. Having granted the motion, Surti’s motion, Surti’s motion to resolve the matter expeditiously (ECF No. 298) is **DISMISSED AS MOOT**.

IT SO ORDERED.

Date: March 25, 2020 /s/ Paul L. Maloney
Paul L. Maloney
United States District Judge

App. 51

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

FLEET ENGINEERS, INC.,
Plaintiff-Appellee

v.

MUDGUARD TECHNOLOGIES, LLC,
Defendant

TARUN SURTI,
Defendant-Appellant

2018-2351

Appeal from the United States District Court for
the Western District of Michigan in No. 1:12-cv-01143-
PLM, Chief Judge Paul L. Maloney.

Decided: February 25, 2019

GEORGE THOMAS WILLIAMS, III, McGarry Bair PC,
Grand Rapids, MI, for plaintiff-appellee.

TARUN SURTI, Brentwood, TN, pro se.

Before LOURIE, BRYSON, and MOORE, *Circuit
Judges.*

PER CURIAM.

Tarun Surti appeals from a decision of the U.S. District Court for the Western District of Michigan granting summary judgment in favor of Fleet Engineers, Inc. on his claims of infringement of U.S. Patent No. RE44,755, breach of contract, and misappropriation of trade secrets. We hold that the district court properly granted summary judgment as to the breach of contract and misappropriation of trade secrets claims. We vacate the grant of summary judgment of noninfringement and remand for further proceedings.

BACKGROUND

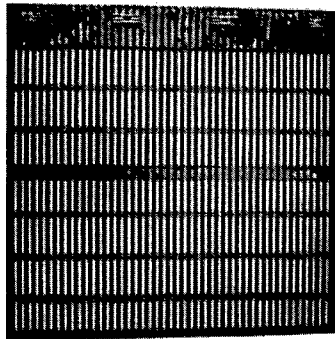
Mr. Surti is the inventor and owner of the RE'755 patent and the president of Mudguard Technologies. The RE'755 patent relates to "a mud flap for preventing spray from the wheel of a vehicle on a wet roadway from impairing the vision of drivers of other vehicles." RE'755 patent at 1:12–15. According to the specification, the invention "separates air, water and road debris thrown up by a tire or wheel and directs the water and debris to the ground while allowing the air to pass through the air outlets." *Id.* at 4:19–22. Claim 1 of the RE'755 patent recites (emphasis added):

1. A mudflap for preventing spray from a wheel of a vehicle on a wet roadway from impairing the vision of drivers of other vehicles, comprising a vertically extending flap which is mounted to the rear of the wheel with a front side of the flap facing the wheel and a

App. 53

rear side facing away from the wheel, *a plurality of laterally spaced, vertically extending vanes defining a plurality of vertically extending channels* on the front side of the flap for directing water and debris from the wheel in a downward direction toward the ground and not to the rear or sides of the flap, and *vertically extending slotted openings in the channels of a size permitting air to pass through the openings to the rear of the flap and preventing water and debris from doing so.*

Fleet develops, manufactures, and sells after-market products for the trucking industry. In July 2010, Mudguard and Fleet entered into a "Distributor Agreement" for Mr. Surti's mud flap, the V-Flap, shown below. J.A. 312, 500.

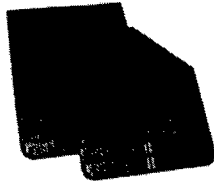


J.A. 435. A few months later, the Distributor Agreement was terminated. In February 2012, Fleet introduced its own mud flap, the AeroFlap. There are three different configurations of the AeroFlap, shown below.

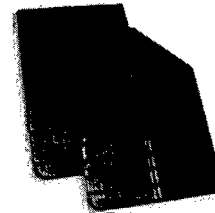
App. 54



Part No. 033-08001



Part No. 033-08002



Part No. 033-08004

J.A. 444.

In April 2012, U.S. Patent No. 8,146,949 issued with Mr. Surti as the sole named inventor and owner. In June, Mr. Surti sent Fleet a letter through counsel asserting that the AeroFlap infringed claims of the '949 patent. Mr. Surti also informed some of Fleet's customers that the AeroFlap was an infringing product.

In October 2012, Fleet sought a declaratory judgment of noninfringement and invalidity and asserted a state-law claim for tortious interference with business relationships. Mr. Surti, proceeding pro se, counterclaimed for patent infringement, breach of contract, and misappropriation of trade secrets. During the early stages of litigation, Mr. Surti indicated in his Statement of Claims Infringed and Infringing Products that he was asserting claims 1-2, 5, 8-9, and 13 of the '949 patent, but he expressly reserved the right to supplement the disclosures in that Statement. A couple weeks prior, Mr. Surti filed for a reissuance of the '949 patent, which reissued as the RE'755 patent on February 11, 2014. The RE'755 patent did not alter the originally issued claims 1-17, but added claims 18-25. Fleet amended its pleading to assert that "it does not

infringe any valid claim of the [RE]’755 reissue patent.” J.A. 294. Mr. Surti amended his counterclaim to assert infringement of “the claims of the [RE]’755 reissue [p]atent.” J.A. 395. However, no amended Statement of Claims Infringed and Infringing Products was ever filed.

The district court entered default judgment against Mudguard. The remaining parties cross-moved for summary judgment. The district court granted summary judgment on noninfringement. It also granted summary judgment that Fleet did not breach a contract with Mr. Surti or misappropriate Mr. Surti’s trade secrets. On motion from Fleet, the district court dismissed Fleet’s claims as to invalidity of the RE’755 patent claims with prejudice and tortious interference against Mr. Surti without prejudice.

Mr. Surti appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review a grant of summary judgment according to the law of the regional circuit, here the Sixth Circuit. *Microsoft Corp. v. Geotag, Inc.*, 817 F.3d 1305, 1313 (Fed. Cir. 2016). The Sixth Circuit reviews a grant of summary judgment de novo. *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 919 (6th Cir. 2003). “Summary judgment is proper where there exists no issue of material fact and the moving party is entitled to judgment as a matter of law.” *Id.* at 920 (citing Fed. R. Civ. P. 56). We construe “all reasonable factual inferences in favor

of the nonmoving party.” *Id.* “[S]ummary judgment will not lie if the dispute about a material fact is genuine, that is, if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

I. PATENT INFRINGEMENT

While we are sympathetic to the fact that the district court is handling a complex patent case involving a pro se patent owner, the district court erred in granting summary judgment of noninfringement. In granting summary judgment, the district court determined that the AeroFlap does not contain three limitations of the RE’755 patent claims. First, the district court held the AeroFlap does not have the claimed “vanes” because its channels are formed from depressions in the surface of its mud flap, rather than from vanes that protrude from the surface. Second, it held these depressions in the AeroFlap do not prevent water and debris from passing through slotted openings. Third, to the extent the AeroFlap has the claimed “vanes,” “channels,” or “slotted openings,” it held they are not “vertically extending.” The district court’s analysis of these limitations was erroneous.

As an initial matter, we see no error in the district court’s construction of “vane.” The court defined “vane” as “a relatively thin, rigid structure, like a blade, that is attached to another structure or surface.” J.A. 29. It clarified that this means “a vane must protrude or rise from the rear wall of the mud flap.” J.A. 30. The

specification describes vanes as “protruding” and having a rounded front edge and tapered lateral surfaces that “direct air, water and debris into the channels.” ’755 patent at 2:30–34, 3:21. It further states that “[t]he vanes stiffen the flap and minimize the curl-up to enhance the downward flow of the water and debris.” *Id.* at 4:27–29. This description is consistent with the district court’s construction.

We agree with Mr. Surti, however, that a genuine issue of fact exists as to whether the AeroFlap has the claimed vanes. The district court based its conclusion that the AeroFlap does not have “vanes” on the fact that its channels are created from depressions in the front surface of the mud flap, rather than structures that protrude from a surface. Though AeroFlap’s vanes are flush with the front surface of the mud flap, a reasonable jury could conclude that they protrude from the rear wall of the channels. The construction of vanes does not require that the vanes protrude beyond all other surfaces on the mud flap. Moreover, in making its determination that the accused mud flap does not have vanes, the district court at times compared the accused product to Mr. Surti’s commercial embodiment (V-Flap) rather than the claim limitations. *See* J.A. 31 (noting that the V-Flap “contains a series of structures that look very much like wiper blades for the windshield of a car (vanes), which are all attached to a flat panel (rear wall) creating channels” before concluding that the AeroFlap does not have “thin, blade-like structures”); *see also id.* (stating in its doctrine-of-equivalents analysis that “[w]hen compared side-by-side, the

cross sections of the two mud flaps are substantially different”). The district court’s analysis of whether AeroFlap’s “depressions” perform the claimed functions of the “channels” also focused on a comparison of the accused product to Mr. Surti’s V-Flap. See J.A. 32 (concluding that “[u]nlike [Mr.] Surti’s mud flap, where the channel allows the water and debris to flow down the face of the mud flap, Fleet’s depressions trap the water and debris”). “[I]nfringement is determined on the basis of the claims, not on the basis of a comparison with the patentee’s commercial embodiment of the claimed invention.” *Int’l Visual Corp. v. Crown Metal Mfg. Co.*, 991 F.2d 768, 772 (Fed. Cir. 1993) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1578 (Fed. Cir. 1984)). On remand, the district court should assess infringement by comparing the accused products to the invention as claimed, not to Mr. Surti’s product.

We also agree with Mr. Surti that there was a genuine issue of fact which precluded summary judgment as to the “vertically extending” limitation. Mr. Surti argues Aero-Flap’s lower section has “vertically extending” channels and slotted openings. While the district court relied on the fact that “[t]he majority of the structures on Fleet’s mud flap are at a 45 degree angle,” J.A. 32, it is undisputed that two out of the three accused products, identified as Part Nos. 033-08002 and 033-08004, also have vertically extending channels and slotted openings at the bottom. During claim construction, the parties disputed whether the term “vertically extending vanes defining a plurality of

vertically extending channels” requires the channels to extend the length of the mud flap without interruption. The district court concluded that it does not, as there is “no length requirement for either the vane or the channel.” J.A. 263. According to this construction, the vertical extensions do not have to span the entire mud flap in order for infringement to exist. As the claims at issue are open-ended “comprising” claims, the presence of unclaimed elements (such as vanes or channels at an angle) does not necessarily negate infringement. We conclude that a reasonable jury could find that the presence of *some* channels that are vertically extending across the bottom of the AeroFlap may satisfy this limitation.

We note that there also appears to be confusion between the court and the parties as to which claims are at issue. Before the RE’755 patent issued, Mr. Surti indicated in his Statement of Claims Infringed and Infringing Products that he was asserting claims 1–2, 5, 8–9, and 13 of the ’949 patent. Following the issuance of RE’755, Mr. Surti amended his counterclaim and asserted infringement of “the claims of the [RE]’755 re-issue [p]atent.” J.A. 395. And in his summary judgment briefing below, Mr. Surti specifically discussed infringement of claims 1 and 19 of the RE’755 patent. In contrast, Fleet took the position that the originally asserted claims of the ’949 patent were the only claims at issue in the litigation. There is no agreement as to representative claims.

It is not entirely clear from the district court's summary judgment opinion which claims it considered. The decision notes that claims 18–25, which were added in the RE'755 patent, are consistent with its claim construction order addressing disputed terms in the '949 patent claims. The opinion also focuses for non-infringement on limitations that only appear in claims 18 and 25. *See* J.A. 32 (discussing whether the AeroFlap's depressions “substantially prevent” or “prevent a majority of the water and debris collected in them from passing through the slotted openings”). At another point, however, it notes that claims 1, 5, 9, and 13 all require vertically extending vanes, channels, and slotted openings, even though claims 2 and 8, which were undisputedly asserted, and claims 18, 21, and 25 also contain these limitations. Finally, the opinion never addresses infringement of claim 19, one of the claims specifically briefed below.

Without deciding infringement as to this claim, we note that at least claim 19 appears to lack each of the limitations that formed the basis for granting summary judgment. Courts are required to liberally construe pleadings filed pro se. *Erickson v. Pardus*, 551 U.S. 89, 94 (2007). Under this standard, Mr. Surti's amended counterclaim could be treated as asserting all newly issued claims of the RE'755 patent, including claim 19, which he specifically argued in his summary judgment briefing and which the district court did not address. On remand, the district court should determine which claims are being asserted and conduct its

infringement analysis with regard to each of those claims and their respective limitations.

In light of the above errors, we vacate the grant of summary judgment of noninfringement and remand for further proceedings consistent with this opinion.

II. BREACH OF CONTRACT

Mr. Surti appeals the grant of summary judgment in favor of Fleet on his breach of contract claim. Under Michigan law, Mr. Surti must establish the existence of a valid contract with Fleet. *Miller-Davis Co. v. Ahrens Constr., Inc.*, 495 Mich. 161, 178 (2014). The two contracts in the record, a “Confidentiality and Non-Compete Agreement” and a “Distributor Agreement,” are between Fleet and Mudguard, not Mr. Surti. Because Mr. Surti has failed to present evidence of a contract between him and Fleet, an essential element of his claim, summary judgment was appropriate.

III. MISAPPROPRIATION OF TRADE SECRETS

Mr. Surti appeals the grant of summary judgment in favor of Fleet on his misappropriation of trade secrets claim. Mr. Surti asserted misappropriation of trade secrets related to intellectual property, manufacturing, and marketing. The district court granted summary judgment for three reasons. First, Mr. Surti cannot raise a claim on behalf of Mudguard. Second, he failed to identify with sufficient specificity which of his trade secrets were misappropriated. Third,

information disclosed in the RE'755 patent is not a trade secret.

We agree that summary judgment was appropriate. Under Michigan law, "misappropriation" of a trade secret includes:

(i) Acquisition of a trade secret of another by a person who knows or has reason to know that the trade secret was acquired by improper means.

(ii) Disclosure or use of a trade secret of another without express or implied consent by a person who did 1 or more of the following:

(A) Used improper means to acquire knowledge of the trade secret.

(B) At the time of disclosure or use, knew or had reason to know that his or her knowledge of the trade secret was derived from or through a person who had utilized improper means to acquire it, acquired under circumstances giving rise to a duty to maintain its secrecy or limit its use, or derived from or through a person who owed a duty to the person to maintain its secrecy or limit its use.

(C) Before a material change of his or her position, knew or had reason to know that it was a trade secret and that knowledge of it had been acquired by accident or mistake.

Mich. Comp. Laws. § 455.1902(b). “[A]n alleged trade secret must be identified clearly, unambiguously, and with specificity.” *Compuware Corp. v. IBM*, 259 F. Supp. 2d 597, 605 (E.D. Mich. 2002) (internal quotation marks omitted). The only information that Mr. Surti identifies with sufficient specificity is related to his design for his mud flap, which was included in his patent application, which published on March 3, 2011, nearly a year prior to Fleet introducing the AeroFlap. Information is not a trade secret unless “efforts that are reasonable under the circumstances” are used “to maintain its secrecy.” Mich. Comp. Laws § 455.1902(d)(ii). Placing that information in a patent application is a failure to use such reasonable efforts. *See Foster v. Pitney Bowes Corp.*, 549 F. App’x 982, 989 (Fed. Cir. 2013) (applying a similar requirement under Pennsylvania law). We thus affirm the grant of summary judgment as to the misappropriation of trade secret claim.

IV. TORTIOUS INTERFERENCE IN BUSINESS RELATIONS

Mr. Surti attempts to appeal the judgment against Mudguard for tortious interference with business relations. But Mudguard is not an appellant. Mr. Surti cannot appeal on behalf of Mudguard. Thus, the judgment against Mudguard must stand.

App. 64

CONCLUSION

For the foregoing reasons, we vacate the district court's grant of summary judgment of noninfringement, remand for further proceedings, and otherwise affirm.

**AFFIRMED-IN-PART, VACATED-IN-PART,
AND REMANDED**

COSTS

No costs.

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

FLEET ENGINEERS, INC.,)	No. 1:12-cv-1143
Plaintiff,)	
)	Honorable
-v-)	Paul L. Maloney
TARUN SURTI and MUDGUARD)	(Filed Jun. 8, 2017)
TECHNOLOGIES, LLC,)	
Defendants.)	

**OPINION AND ORDER GRANTING IN PART
PLAINTIFF'S MOTION FOR
SUMMARY JUDGMENT AND GRANTING
IN PART DEFENDANT'S MOTION
FOR SUMMARY JUDGMENT**

Patents are complex legal documents. In *Topliff v. Topliff*, 145 U.S. 146, 171 (1892), Justice Brown commented that “[t]he specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy[.]” Similarly, patent litigation often presents difficult legal and technical issues. Some eighty years later, Justice White noted that some lower courts had “stated that patent litigation can present issues so complex that legal minds, without appropriate grounding in science and technology, may have difficulty in reaching decision.” *Blonder-Tongue Labs., Inc. v. Univ. of Illinois Found.*, 402 U.S. 313, 331 (1971) (citations omitted). Further exacerbating the unique challenges that patent law poses for attorneys and

judges, between 2005 and 2015, the United States Supreme Court reversed the Federal Circuit Court of Appeals' interpretation of the law in patent cases in 22 of the 27 cases accepted for review, with the trend continuing through 2017. Steven Seidenberg, *Patent Tension The Federal Circuit and the Supreme Court Continue Their Tug-of-War Over Interpretations of Patent Law*, ABA Journal, Jan. 2016 (Westlaw).

It should come as no surprise then that individuals untrained in the law, even those with scientific or technical background, face arduous challenges when forced into a patent lawsuit. Such is the case here, as Defendant Tarun Surti, whose patent is the subject of this lawsuit, proceeds without an attorney. And, as predicted by Professor John Golden, “[a] practical concern with such an option would be that, given the general complexity of patent litigation and sheer volume of written material that it can involve, pro se representation might severely compromise hopes for success.” John M. Golden, *Litigation in the Middle: The Context of Patent-Infringement Injunctions*, 92 Tex. L. Rev. 2075, 2093 (2014).

This matter comes before the Court on cross motions for summary judgment. (ECF No. 185 – Fleet; ECF No. 191 – Surti.) Surti holds a reissue patent for a mud flap. Fleet Engineers makes a mud flap. Surti believes Fleet’s mud flap infringes his patent. Fleet initiated this lawsuit in 2012, after Surti sent letters to Fleet’s customers alleging that the Fleet mud flap infringed his patent. Since the onset of this lawsuit, Surti and his corporate entity, Mudguard Technologies, have

retained two different intellectual property attorneys. Those attorneys each requested leave to withdraw, which this Court granted. Surti is now proceeding without counsel. Because Mudguard Technologies must be represented by counsel, and because no attorney filed an appearance after the first two withdrew, after several warnings, Mudguard Technologies has been defaulted. Although this Court must liberally interpret pro se filings, see *Owens v. Keeling*, 461 F.3d 763, 776 (6th Cir. 2006), *Boswell v. Mayer*, 169 F.3d 384, 387 (6th Cir. 1999), the Court cannot make arguments on Surti's behalf.

I.

In Fleet's first amended complaint (ECF No. 99), it requests a declaratory judgment of non-infringement, a declaratory judgment of invalidity, and a state-law claim for tortious interference with business relationships. Surti, then represented by counsel, filed counterclaims for patent infringement, breach of contract, and misappropriation of trade secrets. (ECF No. 115.) Fleet moves for summary judgment on its own patent claims and on all of Surti's counterclaims. (ECF No. 185.) In Surti's motion, he requests the Court dismiss Fleet's invalidity claim against his patent and also that the Court find that Fleet's mud flap infringes his patent.¹

¹ In his motion and brief, Surti does not specifically address the reasons Fleet asserts for patent invalidity. Surti does address those arguments in his response to Fleet's motion. Both of the reasons for invalidity, indefiniteness, and obviousness, are questions of law.

(ECF No. 191.) Both motions are fully briefed.² A hearing on the motions occurred on May 15, 2017.

Summary judgment is appropriate only if the pleadings, depositions, answers to interrogatories and admissions, together with the affidavits, show there is no genuine issue of material fact and that the moving party is entitled to a judgment as a matter of law. Fed. R. Civ. P. 56(a) and (c); *Payne v. Novartis Pharms. Corp.*, 767 F.3d 526, 530 (6th Cir. 2014). The burden is on the moving party to show that no genuine issue of material fact exists, but that burden may be discharged by pointing out the absence of evidence to support the nonmoving party's case. Fed. R. Civ. P. 56(c)(1); *Holis v. Chestnut Bend Homeowners Ass'n*, 760 F.3d 531, 543 (6th Cir. 2014). The facts, and the inferences drawn from them, must be viewed in the light most favorable to the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986) (quoting *Matsushita Elec. Indust. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986)). Once the moving party has carried its burden, the nonmoving party must set forth specific facts in the record showing there is a genuine issue for

² Surti complains that Fleet's brief in response to his motion, and Fleet's reply in support of its own motion, were filed after the time period expired. Surti served his motion and his response by mail. See Fed. R. Civ. P. 5(b)(2)(C). At the time, the Federal Rules added three days to the time to respond when service was made by mail. See Fed. R. Civ. P. 6(d). For both Fleet's response and reply, the deadline, which included three additional days, occurred on a Saturday, and Fleet therefore had until the following Monday to file the relevant document. See Fed. R. Civ. P. 6(a)(C). Under Rule 6, both of Fleet's response and reply were timely filed.

trial. *Matsushita*, 475 U.S. at 574; *Jakubowski v. Christ Hosp., Inc.*, 627 F.3d 195, 200 (6th Cir. 2010) (“After the moving party has met its burden, the burden shifts to the nonmoving party, who must present some ‘specific facts showing that there is a genuine issue for trial.’”) (quoting *Anderson*, 477 U.S. at 248). In resolving a motion for summary judgment, the court does not weigh the evidence and determine the truth of the matter; the court determines only if there exists a genuine issue for trial. *Tolan v. Cotton*, 134 S. Ct. 1861, 1866 (2014) (quoting *Anderson*, 477 U.S. at 249). The question is “whether the evidence presents a sufficient disagreement to require submission to the jury or whether it is so one-sided that one party must prevail as a matter of law.” *Anderson*, 477 U.S. at 251–252.

II.

The background for this lawsuit has been summarized in previous opinions. For context, the Court provides a brief review. Plaintiff Fleet develops, manufactures, and sells after-market products for the trucking industry. Defendant Tarun Surti is an engineer and the president of Defendant Mudguard Technologies. In September 2009, Surti filed a patent application for a mud flap, which issued in April 2012, Patent No. 8,146,949. In July 2010, Mudguard and Fleet entered into a distributor agreement for Surti’s mud flap, the V-Flap. The agreement was terminated several months later. Fleet then began to develop its own mud flap, the AeroFlap, which it introduced at a trade show in February 2012. In June 2012, through

counsel, Surti sent Fleet a letter asserting that the AeroFlap infringed Surti's patent. By September 2012, Fleet became aware that Surti had sent letters to some of Fleet's customers alleging that the AeroFlap was an infringing product. Fleet then filed this lawsuit.

On December 10, 2013, this Court issued a Claim Construction Opinion. (ECF No. 60.) In that Opinion, the Court interpreted and gave meaning to four disputed phrases: (1) vertically extending; (2) vertically extending vanes defining a plurality of vertically extending channels; (3) vertically extending slotted openings in the channels of a size permitting air to pass through the openings of the rear of the flap and preventing water and debris from doing so; and (4) which permit air to pass from the channels through the flap and prevent water and debris from doing so.

On March 18, 2013, Surti filed for a reissuance of his '949 patent. The US Patent Office reissued the patent on February 11, 2014, the RE '755 patent. The reissued patent contains the first 17 claims from the '949 patent, and adds new claims 18 through 25. The RE '755 patent replaces the '949 patent. Generally, the added claims in the RE '755 patent indicate that some water and debris may pass through the slotted openings. The added claims are consistent with this Court's Claim Construction Opinion. Fleet filed an amended complaint to address the reissue patent, rather than the original patent.

III.

In Count 2 of their counterclaims, Defendants assert a claim for breach of contract. The counterclaim identified two separate agreements: (1) a distributor agreement dated July 20, 2010, and (2) a confidentiality and noncompete Agreement dated April 27 or 28, 2010. (ECF No. 115 Counterclaim ¶¶ 76 and 77 PageID.942.) The distributor agreement was filed as an attachment to Fleet's initial complaint. (ECF No. 1-1 Distributor Agreement PageID.25-31.) Fleet filed the confidentiality and noncompete agreement as an exhibit to its motion for summary judgment. (ECF No. 226-5 PageID.2679-80.) The copy of the confidentiality agreement filed with the Court is not signed. However, both parties have admitted that an agreement was reached. (ECF No. 101 Def. Ans. to Compl. ¶ 20 PageID.848; ECF No. 116 Pl. Ans. to Counterclaim ¶ 77 PageID.948.) Both agreements are between Fleet Engineers and Mudguard Technologies. Surti was not a party to either contract.

Fleet is entitled to summary judgment of the counterclaim for breach of contract. Under Michigan law, the party asserting breach of contract must establish the existence of a valid contract, a breach of the contract by the other party, and damages resulting from the breach. *Miller-Davis Co. v. Ahrens Constr., Inc.*, 848 N.W.2d 95, 104 (Mich. 2014). Fleet has established that the two agreements identified in the counterclaim were between Fleet and Mudguard. Surti has not established that he had any valid contract with Fleet, an essential element of his counterclaim. And, because

Surti did not have any contract with Fleet, Fleet could not breach a contract with Surti. Additionally, Mudguard Technologies has been defaulted and cannot maintain its counterclaim.

IV.

In Count 3 of their counterclaims, Defendants assert a claim for misappropriation of trade secrets. Defendants describe their trade secrets as including

supplier lists, customer lists, know-how, manufacturing techniques, process flow charts with process controls documented, control plans with critical characteristics identified, multifaceted product design and process failure mode and effect analysis, and process set-up and operation procedures and controls.

(ECF No. 115 Counterclaims ¶ 82 PageID.943.) Defendants claim that Fleet misappropriated these secrets and used them to develop products that compete with Defendants' products. (*Id.* ¶ 87 PageID.943.)

Michigan has adopted the Uniform Trade Secrets Act, Michigan Compiled Laws §§ 445.1901, *et seq.* The statute defines "misappropriation" as "either of the following:"

- (i) Acquisition of a trade secret of another by a person who knows or has reason to know that the trade secret was acquired by improper means.

App. 73

(ii) Disclosure or use of a trade secret of another without express or implied consent by a person who did 1 or more of the following:

(A) Used improper means to acquire knowledge of the trade secret.

(B) At the time of disclosure or use, knew or had reason to know that his or her knowledge of the trade secret was derived from or through a person who had utilized improper means to acquire it, acquired under circumstances giving rise to a duty to maintain its secrecy or limit its use, or derived from or through a person who owed a duty to the person to maintain its secrecy or limit its use.

(C) Before a material change of his or her position, knew or had reason to know that it was a trade secret and that knowledge of it had been acquired by accident or mistake.

Mich. Comp. Laws § 445.1902(b). "Trade secret" is defined as

information, including a formula, pattern, compilation, program, device, method, technique, or process, that is both of the following:

(i) Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use.

(ii) Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

Id. § 445.1902(d). For the misappropriation of trade secrets, a claimant must prove (1) the existence of a trade secret, (2) the defendant's acquisition of the trade secret in confidence, and (3) the defendant's unauthorized use of the trade secret. *Polytorx, LLC v. Univ. of Michigan Regents*, No. 318151 and 320989, 2015 WL 2144800, at *6 (Mich. Ct. App. May 7, 2015) (per curiam unpublished opinion) (citing *Stromback v. New Line Cinema*, 384 F.3d 283, 302 (6th Cir. 2004)).

Fleet is entitled to summary judgment on the misappropriation of trade secrets counterclaim. First, Surti cannot raise a misappropriation claim on behalf of Mudguard Technologies. Assuming, for the sake of argument only, that Mudguard Technologies has a viable claim, the entity has been defaulted and cannot maintain the counterclaim. Second, Surti's response generally fails to identify, with sufficient specificity, which of his trade secrets were misappropriated. The Sixth Circuit has stated that "Michigan courts have found that an alleged trade secret must be identified 'clearly, unambiguously, and with specificity.'" *Utilase, Inc. v. Williamson*, 188 F.3d 510, 1999 WL 717969, at *6 (6th Cir. Sept. 10, 1999) (unpublished table opinion) (citation omitted). In his response, Surti asserts that he owns the "IP related trade secrets." (ECF No. 199 PageID.2420.) Surti asserts that both he and Mudguard jointly own the "manufacturing and marketing related trade secrets." (*Id.*) These broad descriptions of a potential trade secret fail to provide the required detail and specificity.

Third, Surti cannot base his misappropriation claim on his patent. As part of his response, Surti argues that the incorporation of vanes, channels and slotted openings into Fleet's Aero flap is clear proof of a misappropriation of his trade secret. But, the design of Surti's mud flap is not a secret; the patent is publically recorded and the mud flap itself is offered for sale. *See Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 475 (1974) ("The subject of a trade secret must be secret, and must not be of public knowledge or of a general knowledge in the trade or business."). Trade secret law "does not offer protection against discovery by fair and honest means, such as by independent invention, accidental disclosure, or by so-called reverse engineering, that is by starting with the known product and working backwards to divine the process which aided in its development or manufacture." *Id.* at 476. Even if Fleet has manufactured a mud flap that resembles Surti's patent, that evidence does not create a genuine issue of material fact for Surti's misappropriation of trade secrets claim.

V.

In Count 2 of its complaint, Fleet requests a declaration that Surti's patent is invalid. Fleet argues the reissue patent is invalid for two reasons, indefiniteness and obviousness. Surti perfunctorily requests the Court grant summary judgment and find that his patent is valid.

A.

Fleet argues Surti's patent is invalid because it contains inherently contradictory terms as part of its claims.

Patent indefiniteness is a question of law. *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1341 (Fed. Cir. 2015). Patent definiteness is required by statute, 35 U.S.C. § 112. In *Nautilus*, the United States Supreme Court clarified the standard for evaluating definiteness. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

A patent is indefinite “if its claims, read in the light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable clarity, those skilled in the art about the scope of the invention.” *Nautilus* [], 134 S.Ct. at 2124. The definiteness requirement must take into account the inherent limitations of language. “Some modicum of uncertainty . . . is the ‘price for ensuring the appropriate incentives for innovation.’” *Id.* at 2128 (quoting *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 732 (2002)). On the other hand, “a patent must be precise enough to afford clear notice of what is claimed, thereby appris[ing] the public of what is still open to them.” *Id.* at 2129 (internal quotation marks and citations omitted).

Teva Pharm., 789 F.3d at 1340–41 (alterations in original). “The definitiveness requirement . . . mandates

clarity, while recognizing that absolute precision is unattainable.” *Nautilus*, 134 S. Ct. at 2129. A claim does not satisfy the statutory requirement for definitiveness “if its language ‘might mean several different things and no informed or confident choice is available among the contending definitions.’” *Media Rights Techs., Inc. v. Capital One Fin. Corp.*, 800 F.3d 1366, 1371 (Fed. Cir. 2015) (citing *Nautilus*, 134 S. Ct. at 2130 n.8).

Fleet argues that RE ‘755 contains contradictory language and concludes that the patent is therefore invalid for indefiniteness. Specifically, Fleet argues that, in Claims 1 and 2, the mud flap is described as allowing air to pass through openings in the mud flap, but water and debris are prevented from doing so. In Claim 18, the mud flap is described as allowing air to pass through openings, while a majority of the water and debris are prevented from doing so. Finally, in Claim 25, the mud flap is described as allowing air to pass through the openings, while substantially preventing water and debris from doing so. Fleet asserts the patent is indefinite because it claims to (1) prevent water and debris from passing through openings, (2) prevent a majority of water and debris from passing through openings, and also (3) substantially prevent water and debris from passing through openings. Alternatively, Fleet argues the patent is indefinite because it fails to quantify how much water and debris could pass through the openings.

Fleet has not established that the patent is indefinite. First, Fleet’s argument here ignores what the

Court has already determined. This Court has twice rejected Fleet's assertion that the word "prevent" in the claim section of the patent means that absolutely no water or debris may pass through the slotted opening. In the claim construction phase, Fleet asserted that the words "prevent" and "preventing" in the claim required the mud flap to stop all water from passing through the openings. The Court rejected that interpretation. Notably, the Court pointed to the specification, which "explicitly anticipates that some water and debris may pass through the slotted openings." (Claim Construction Opinion at 13 PageID.398.) Thus, the words "prevent" or "preventing," as used in the claim, do not require the mud flap to stop all water and debris from passing through the slotted openings. The Court also denied Fleet's motion for reconsideration on the issue. (ECF No. 71.)

Second, adding the word "substantially" to modify the word "preventing" in patent the claim does not necessarily render the patent indefinite. "Expressions such as 'substantially' are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention." *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed Cir. 2002). Words of degree or approximation, like "substantially" are "ubiquitous in patent claims" and "have been accepted in patent examination and upheld by the courts." *Andrew Corp. v. Gabriel Elecs., Inc.*, 847 F.2d 819, 821 (Fed. Cir. 1988); e.g., *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1546-47 (Fed.

Cir. 1984) (“Beckman attacks the claims as indefinite, primarily because ‘close proximity’ is not specifically or precisely defined. As stated in the district court’s Memorandum Decision, ‘to accept Beckman’s contention would turn the construct of a patent into a mere semantic quibble that serves no useful purpose.’”) (citation omitted). Words like “substantially” are “descriptive terms commonly used in patent claims to ‘avoid a strict numerical boundary to the specified parameter.’” *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367 (Fed. Cir. 2001).

Third, the Court notes that a similar argument was raised in another patent case, and also rejected. In *Brandt Industries, Limited v. Harvest International Corporation*, No. C15-4049-LTS, 2016 WL 1452402 (N.D. Iowa, Apr. 13, 2016), the district court issued an opinion interpreting a patent for a belt-guide attachment for a conveyer belt used in farming equipment. The invention prevented a rotating belt from moving side to side and rubbing against parts of the machine. The defendant noted that claim 1 in the patent used the phrase “to prevent,” while claim 10 in the patent used the phrase “to substantially prevent.” *Id.* at *17. The defendant argued that there must be some difference between the two phrases and asserted that the former phrase, without the word “substantially,” must mean “absolutely prevent.” *Id.* The defendant argues that without the distinction, the claims would be rendered indefinite. The court rejected the defendant’s construction. Reviewing Federal Circuit opinions, the court concluded that where a patent does not provide

a standard for imposing a precise construction for the term, it is error for a court to do so. *Id.* at *18 (citations omitted). The same reasoning applies here, as Surti's patent does not provide a standard for measuring how much water may pass through the slotted openings.

Finally, Plaintiff argues the claim does not quantify how much water is allowed to pass through the slotted openings. This argument is not persuasive. Plaintiff cannot point to any portion of the claim language that would suggest or infer that a measured quantity is necessary to the invention. *See, e.g., Polymer Indus. Prods. Co. v. BridgestoneFirestone, Inc.*, 10 F. App'x 812, 818 (Fed. Cir. 2001) ("Since the claim language makes no attempt to quantify the reduction in adhesion, quantification of the amount of cord that projects above the rubber surface of the bladder is not required, either for infringement of validity analysis."). The Court will not conclude the patent is indefinite for a reason not supported by the claim language. And, it would be an error for this Court to impose a standard for quantifying the amount of water allowed to pass through the slotted openings.³ *See Brandt Indus.*, 2016 WL 1452402, at *18.

³ Surti's response to this argument is one example of where his lack of legal background creates problems. Surti summarizes the dimensions of the slotted openings and discusses the surface area of his mud flap, comparing the area of material to the area of the openings. Surti's discussion is not responsive to Fleet's argument. The Court may, however, reject Fleet's argument because its premise is inconsistent with this Court's earlier opinion and because the legal conclusion Fleet proposes is not warranted by the language of the patent.

Because indefiniteness is a question of law, and because this Court concludes Surti's patent is not indefinite for the reasons identified by Fleet, the Court will dismiss Fleet's claim for invalidity based on indefiniteness.

B.

Fleet argues Surti's patent is invalid because the invention was obvious under the prior art.

Patent invalidity for obviousness is a legal determination. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)). The factual determinations underlying an obviousness determination are reviewed for clear error. *Proctor & Gamble Co. v. Teva Pharm. USA, Inc.*, 566 F.3d 989, 993 (Fed. Cir. 2009).

Under the Patent Act, a patent "may not be obtained, . . . , if the differences between the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains." 35 U.S.C. § 103. "A party seeking to invalidate a patent based on obviousness must demonstrate 'by clear and convincing evidence that a skilled artisan would have been motivated to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *Proctor & Gamble*, 566 F.3d at 994 (citation omitted). Obviousness of a patent requires the court to

consider four factual inquiries: (1) the scope and content of the prior art, (2) differences between claims and prior art, and (3) the level of ordinary skill in pertinent art, and (4) objective indicia of non-obviousness, also called secondary considerations. *Id.* (citing *Graham*, 383 U.S. at 17). Here, the parties do not address the secondary considerations.

For Fleet's obviousness argument, it makes the assumption that the vanes in Surti's patent do not protrude from the front face of the mud flap.⁴ Fleet argues that if the vanes do not protrude, then the prior art, the Andersen Patent No. '717 (ECF No. 28-1), anticipated the invention. Fleet argues that the strands in the Andersen patent and the vanes in the Surti patent are the same.

Surti argues that the critical feature of his invention is the creation of a channel. In Surti's patent, a channel is created between the vanes by adding a rear wall. The slotted openings in Surti's patent are smaller than the space between the vanes on either side of the channel. The Andersen patent lacks the rear wall and thus no channel is created. The openings in the Andersen patent are the entire space between the vanes or strands.

Fleet is not entitled to summary judgment on its claim that Surti's patent is invalid for obviousness.

⁴ Fleet advances arguments in the alternative. For the obviousness argument, Fleet assumes that the vanes do not protrude. For its non-infringement argument, Fleet assumes that the vanes do protrude.

The Court first considers the prior art. For Fleet's obviousness claim, two prior patents must be described, the Nakayama '318 patent and the Andersen '717 patent.

The Nakayama '318 patent issued in 1993. (ECF No. 23-2.) The Nakayama mud flap was made from two pieces, a front member with openings and a back member which collects the water that passes through the openings. The patent describes how the front member or panel would be attached to the back member, with space or a membrane between the two. The front panel is described in various embodiments and in various configurations. In Claim 1, the front panel is described as "being comprised of a plurality of horizontally spaced vertically extending members and vertically spaced laterally extending members interconnected with the vertically extending members to form a network and the openings are spaces defined by the network." (ECF No. 23-2 Col. 6 Lines 65-68 - Col. 7 Lines 1-2 PageID.212-13.) Basically, the front panel is a grid of vertical and horizontal ribs, with openings between the parallel ribs. The water passes through the front panel and is caught by the back panel.

The Andersen '717 patent issued in 2005. (ECF No. 28-1.) The Andersen mud flap is a mesh panel of "strands" that run either horizontally or vertically. The plurality of strands are held together by several strands that run perpendicular, either horizontally or vertically, to the plurality. The strands have spaces between them forming openings through which air could pass while a majority of the water and debris is

deflected by the front surface of the strands. The patent contains several embodiments of the invention. For several of the embodiments, the strands are described as having sides that are perpendicular or parallel to the axes. Other embodiments describe one or both of the sides of the strands having an 80 degree angle. Unlike the Nakayama patent, the Andersen patent is a single flap or panel or member.

The differences between the Nakayama and Andersen patents and Surti's patent are material, and a person ordinarily skilled in the pertinent art would not conclude that Surti's mud flap was obvious under the prior art. Surti's patented invention is different from the prior art because of the rear wall, which, in combination with the sides of the vanes, forms a channel. In both the Nakayama and the Andersen patent, the gap between the ribs (members for Nakayama and strands for Andersen) creates the openings. The openings begin where the side of each rib ends. In Surti's patent, the ribs (vanes) form the two sides of a channel. The bottom of the channel is formed by a rear wall. The slotted openings are narrower than the width of the channel formed by the vanes. The Andersen patent lacks a rear wall to form a channel. The rear wall in the Nakayama patent is a separate piece and does not have any slotted openings.

Fleet's reasoning ignores how the openings are formed in the Andersen patent, as opposed to the Surti patent. Fleet is correct that the openings can be narrowed in the Andersen patent. By changing the angle of the side or sides of each strand or the space between

the strands, the slotted openings can be narrowed. But, changing the angle of the side of the strand does not create a channel. The sides of Surti's vanes, in combination with the rear wall, create a channel. A person of ordinary skill in the prior art, considering the Andersen patent, would not consider the addition of a rear wall as obvious.

Because obviousness under the prior art is a question of law, and because this Court concludes Surti's patent is not obvious under the prior art, the Court will dismiss Fleet's claim for invalidity for obviousness. Taking the evidence in the record in the light most favorable to Fleet, the Court concludes there are no genuine issues of material fact relevant to Fleet's obviousness argument.

VI.

In Count 1, Fleet requests a declaration of non-infringement. In its motion, Fleet requests summary judgment on its claim for non-infringement. In Count 1 of his counterclaims, Surti asserts that Fleet's Aero-flap infringes on his patent. In his motion, Surti requests summary judgment on his infringement counterclaim.

Infringement determinations entail a two-step process. "First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process." *Absolute Software, Inc. v. Stealth Signal, Inc.*, 659 F.3d 1121, 1129 (Fed. Cir. 2011). The first step, claim construction, is a question of law, while

the second step, the determination of whether the properly construed claims read on the accused device, is a question of fact. *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1326 (Fed. Cir. 2006); *Hilgraeve Corp. v. Symantec Corp.*, 265 F.3d 1336, 1341 (Fed. Cir. 2001) (citations omitted). When the alleged infringer files a motion for summary judgment for non-infringement, summary judgment may be granted where the patent holder's proof does not create a genuine issue of material to satisfy the legal standard for infringement. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991).

To prove infringement, the patent holder must show that the accused product uses each element of a claim, either literally or under the doctrine of equivalents. *Cheese Sys. Inc. v. Tetra Pak Cheese and Powder Sys., Inc.*, 725 F.3d 1341, 1348 (Fed. Cir. 2013). For literal infringement, the claimant must show that every limitation set forth in a claim is "found in an accused product, exactly." *Microsoft Corp. v. GeoTag, Inc.*, 817 F.3d 1305, 1313 (Fed. Cir. 2016) (quoting *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed. Cir. 1995)); see *Akzo Nobel Coatings, Inc. v. Dow Chem. Co.*, 881 F.3d 1334, 1341 (Fed. Cir. 2016) ("Literal infringement exists when every limitation recited in the claim is found in the accused device."). For infringement under the doctrine of equivalents, the claimant must show the accused device includes an equivalent for each literally absent claim limitation. *Dawn Equip. Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1015 (Fed. Cir. 1998). The Federal Circuit has outlined two

methods by which a court may apply the test for equivalence. *Voda v. Cordis Corp.*, 536 F.3d 1311, 1326 (Fed. Cir. 2008). “Under the insubstantial differences test, [a]n element in the accused device is equivalent to a claim limitation only if the differences between the two are insubstantial.” *Id.* (quoting *Honeywell Int’l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1139 (Fed. Cir. 2004)). Whether the differences are substantial or insubstantial are determined from the perspective of one of ordinary skill in the art. *Eagle Comtronics, Inc. v. Arrow Commc’n Labs., Inc.*, 305 F.3d 1303, 1315 (Fed. Cir. 2002). “Alternatively, under the function-way-result test, an element in the accused device is equivalent to a claim limitation if it ‘performs substantially the same function in the substantially the same way to obtain substantially the same result.’” *Voda*, 536 F.3d at 1326 (quoting *Schoeil v. Regal Marine Indus., Inc.*, 247 F.3d 1202, 1209-10 (Fed. Cir. 2001)).

For its non-infringement claim, Fleet assumes that Surti’s invention requires vanes that protrude from the face of the mud flap. Fleet argues that its mud flap does not have any vanes. Fleet filed an expert report to support its claim for non-infringement. (ECF No. 189-1 Thomas Young Report PageID.1997-2004.) Fleet’s expert, Thomas Young, states that one of the reasons Fleet’s mud flap does not infringe on Surti’s patent is because the Fleet mud flap does not have any vanes. (*Id.* PageID.2002.) Instead, the Fleet mud flap has a flat surface area with depressions. (*Id.*)

Based on the arguments presented in the motion and briefs, Fleet is entitled to summary judgment on

its claim for non-infringement. Surti's cross-motion for summary judgment for infringement must be denied. For the purpose of Fleet's motion, the facts must be viewed in the light most favorable to Surti. For Surti's motion, the facts must be viewed in the light most favorable to Fleet. Generally, this Court finds there are no disputed issues of fact.

Fleet's mud flap does not infringe Surti's patent because Fleet's mud flap does not have vanes. A vane is a critical and defining element of Surti's patent. The word "vane" is used throughout the claims in Surti's patent. The sides of the vanes define and create the channels, another critical and defining element of the patent.

Some context is necessary at this point. The record contains some discussion by Fleet about what the word "vane" means, but little discussion of the meaning of the word by Surti. The problem started with the Joint Comprehensive Statement of Claim Construction Issues, a document filed on behalf of both parties in April 2013. (ECF No. 19.) In that document, the word "vane" was not identified as a disputed term. In its claim construction brief, Fleet, for the first time, raised arguments about what a vane is. Fleet argued that a vane must protrude outwardly, a characteristic or description rather than a definition. (ECF No. 28 PageID.268.) Fleet asked the Court to construe the word "vane" as "something that protrudes beyond the body of the mud flap." (*Id.* at PageID.281.) Surti objected to this construction, arguing in part that Fleet had not previously indicated that it intended to ask for a construction of

the term. (ECF No. 35 at 4 PageID.323.) The Court agreed that Fleet's request to construe the term was not timely. (Claim Construction Opinion at 12 PageID.397.) The Court also noted, as dicta, that Fleet's argument relied on a description of an embodiment of the mud flap, which should not be read as imposing a limitation on the claim. (*Id.*) When the meaning of the term "vane" has resurfaced, Surti has repeatedly relied on the Court's Claim Construction Opinion.⁵

Fleet requested the Court reconsider the decision not to construe the word "vane." (ECF No. 66.) For the first time, Fleet offered a definition of the word "vane" as a blade, plate or sail usually attached radially to a rotating wheel or drum.⁶ (*Id.* at 7 PageID.440.) Fleet argued that it would not be possible to have a vane that did not protrude from the front side of the mud flap. (*Id.* at 8 PageID.441.) In declining to reconsider the Claim Construction Opinion, the Court conceded that, "[t]o the extent the issue may affect later stage of the case, the issue may be dealt with at that later stage." (ECF No. 71 Order at 4 PageID.454.)

For the purpose of the cross motions, the term "vane" must be now be defined. Fleet has again raised the issue. And, the first step in the process for determining infringement requires a court to construe

⁵ (*E.g.*, ECF No. 192 Surti's brief in support PageID.2024-25 and 2029; ECF No. 199 Surti's response to Fleet's motion PageID.2409.)

⁶ Fleet offered a similar definition of "vane" in its response to Surti's motion for summary judgment. (ECF No. 201 at 12 n.7 PageID.2502.)

terms. At no point in this litigation has Surti offered a definition or a construction of the term “vane.” Generally, a “vane” is a relatively thin, rigid structure, like a blade, that is attached to another structure or surface.⁷ In Surti’s mud flap, the vanes are attached to the rear wall, and the combination of vanes and rear wall form the channels. This definition of “vane” is consistent with the ordinary and custom meaning of the word as it is understood by a person of ordinary skill in the art. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005). This meaning is entirely consistent with the intrinsic evidence in the record concerning the patent. And, nothing in the patent suggests the author intended the term means something else. Weighing in favor of concluding that the term “vane” has an ordinary and well-understood meaning, the patent contains very little description of the vanes.⁸

Construing the term in this manner, Fleet is correct that a vane must protrude or rise from the rear wall of the mud flap. That the vane protrudes describes

⁷ *See Vane*, Webster’s New Universal Unabridged Dictionary (2d 2003); *Vane*, American Heritage Dictionary (3d Ed. 1996); *see also* Collins Dictionary (online visited June 5, 2017); The Free Dictionary (online visited June 5, 2017); Oxford English Dictionary (online visited June 5, 2017).

⁸ Claim 24 in the Reissue Patent (Col. 6 Lines 41-45 PageID.2746) contains the same general description as the embodiment (Col. 2 Lines 38-44 PageID.2744). The distance between the vane peaks and the height of the vanes are described. In the description of the embodiment, the patent states that “it will be understood vanes can have any degree of taper and height that will funnel the air, water, and debris into the channels[.]” (*Id.*)

the orientation of the vane relative to a surface, the rear wall; that the vane protrudes does not define what the vane is. Accordingly, construing a vane as a thin, rigid structure like a blade and describing the vane as protruding from the rear wall does not read a requirement into the claim from the description of the embodiment.⁹ It is the nature of a vane to protrude from the surface to which it is attached.

Without dispute, Surti's mud flap has vanes. The claim language requires the mud flap to have vanes. The description in the embodiment states that the vanes "extend . . . from the front side of the panel[.]" (Col. 2 Lines 40-41 PageID.2744.) Figures 2-6 (PageID.2740), Figure 8 (PageID.2742), and Figures 10-13 (PageID.2743) all show a vane, a thin structure that rises, extends or protrudes from the rear wall on the front side of the mud flap. The parties also provided the Court with examples of both mud flaps. Acknowledging that it is an oversimplification, Surti's mud flap contains a series of structures that look very much like wiper blades for the windshield of a car (vanes), which are all attached to a flat panel (rear wall) creating channels. The rear wall panel contains slots that are narrower in width than the space between the blades or vanes.

⁹ To the extent this conclusion is at odds with what the Court concluded in the Claim Construction Opinion, the Court retains inherent discretion to reconsider any previous finding before final entry of judgment. See *In re Saffady*, 524 F.3d 799, 803 (6th Cir. 2008) (quoting *Mallory v. Eyrich*, 922 F.2d 1273, 1282 (6th Cir. 1991)).

Without dispute, Fleet's mud flap contains no thin, blade-like structures. The absence of any of vane-like structures means that Fleet's mud flap does not literally infringe on Surti's patent. The front surface (and back surface) of Fleet's mud flap is flat. Rather than having vanes rising, extending or protruding from some surface, Fleet's mud flap forms channels, of a sort, by creating depressions in the flat surface of its mud flap. By forming channels through depressions, Fleet's mud flap does not have a surface to which any vane-like structures are attached.

Fleet's mud flap does not infringe Surti's patent under the doctrine of equivalents. Fleet's mud flap does not include a structure that, under the doctrine of equivalents, could be considered a vane. When compared side-by-side, the cross sections of the two mud flaps are substantially different. (ECF No. 199 Surti's Response PageID.2410.) No relatively thin, blade-like structure is apparent in the cross section of Fleet's mud flap. Fleet's mud flap does not contain any structures that protrude from a surface, reinforcing the conclusion that the mud flap does not have any vanes. And, without vanes, Fleet's mud flap cannot have channels.

The depressions in Fleet's mud flap do not perform the same function as the channels in Surti's mud flap. Although the depressions may trap water and debris, the depressions do not prevent, substantially prevent, or prevent a majority of the water and debris collected in them from passing through the slotted openings. Unlike Surti's mud flap, where the channel allows the

water and debris to flow down the face of the mud flap, Fleet's depressions trap the water and debris. Fleet has further established that its mud flap does not prevent, substantially prevent, or prevent a majority of the water and debris from passing through the slotted openings in its mud flap. (ECF No. 203 Reply at 6-8 PageID.2517-19.)

Fleet's mud flap does not infringe on Surti's patent for another reason. To the extent Fleet's mud flap contains any vanes, channels or slotted openings, those structures are not vertical. Claims 1, 5, 9, and 13 all require the structures to be "vertically extending." This Court interpreted the word "vertically" to mean perpendicular to the road surface. (Claim Construction Opinion at 10-11 PageID.395-96.) The majority of the structures on Fleet's mud flap are at a 45 degree angle; they are not vertical or perpendicular to the surface of the road. Because the structures are at a 45 degree angle, the structures do not prevent water and debris from being deflected to the sides of the mud flap. To the extent the structures do direct water and debris at all, the water and debris would be pushed to the sides of the mud flap, and not toward the bottom of the mud flap.

VII.

On the record before the Court, Fleet is entitled to summary judgment on all but its claims that Surti's patent, RE '755, is invalid. Fleet has established that Surti does not have a breach of contract counterclaim,

as he never had a contract with Fleet. Fleet has demonstrated that Surti cannot maintain a misappropriation of trade secrets counterclaim because his patent cannot provide the basis for a trade secret. Fleet has also correctly stated the law that Surti cannot bring either counterclaim on behalf of his corporation, Mudguard Technologies. Default has entered against the corporate entity. Finally, Fleet has established that its mud flap does not infringe Surti's patent, literally or under the doctrine of equivalents. Fleet's mud flap does not contain any vanes, a critical component of Surti's patent. Fleet, however, has not demonstrated that Surti's patent is invalid, either for indefiniteness or obviousness.

On the same record, Surti's is entitled to summary judgment on Fleet's claims that his patent, RE '755, is invalid. The claims in Surti's patent are not indefinite for any of the reasons advanced in Fleet's motion. And, the patent is not obvious under the prior art. Surti has not, however, established that Fleet's mud flap infringes his patent. During this litigation, Surti has never asked the Court to define or otherwise construe the word "vane," a term used throughout the claims in his patent. Fleet, on the other hand, has raised the issue on multiple occasions. While the Court declined Fleet's initial attempt to construe the term, Fleet's latest motion requires the Court to define or construe what the word "vane" means in the patent. And, as defined or construed, Fleet's mud flap does not include any structure resembling a vane.

App. 95

ORDER

For the reasons provided in the accompanying Opinion, (1) Fleet Engineering's Motion for Summary Judgment (ECF No. 185) is **GRANTED IN PART and DENIED IN PART**, and (2) Tarun Surti's Motion for Summary Judgment (ECF No. 191) is **GRANTED IN PART and DENIED IN PART**. Fleet is entitled to summary judgment on its request for a declaration that its mud flap, the AeroFlap, does not infringe on Surti's patent, RE '755. Fleet is also entitled to dismissal of Surti's counterclaims for breach of contract and misappropriation of trade secrets. Surti is entitled to the dismissal of Fleet's claims that his patent is invalid.

IT IS SO ORDERED.

Date: June 8, 2017 /s/ Paul L. Maloney
Paul L. Maloney
United States District Judge

App. 96

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

FLEET ENGINEERS, INC.,
Plaintiff-Cross-Appellant

v.

MUDGUARD TECHNOLOGIES, LLC,
Defendant

TARUN SURTI,
Defendant-Appellant

2022-2001, 2022-2076

Appeals from the United States District Court for
the Western District of Michigan in No. 1:12-cv-01143-
PLM, Judge Paul L. Maloney.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

Before MOORE, *Chief Judge*, LOURIE, DYK, PROST,
REYNA, TARANTO, CHEN, HUGHES, STOLL, CUNNINGHAM,
and STARK, *Circuit Judges*.¹

PER CURIAM.

¹ Circuit Judge Newman did not participate.

App. 97

ORDER

Tarun N. Surti filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue September 28, 2023

FOR THE COURT

[SEAL]

September 21, 2023

Date

/s/ Jarrett B. Perlow

Jarrett B. Perlow
Clerk of Court
