

No. 23-1142

IN THE
Supreme Court of the United States

TARUN N. SURTI,

Petitioner,

v.

FLEET ENGINEERS, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

Respondent submits that the four questions presented by Petitioner mischaracterize the factual record and provide no issues that must be resolved by this Court. Respondent presents no questions to this Court.

**PARTIES TO THE PROCEEDING AND
RULE 29.6 STATEMENT**

Fleet Engineers, Inc. (“Respondent”) was plaintiff in the District Court proceedings. Mudguard Technologies, LLC (“Mudguard”) and Mr. Tarun Surti (“Respondent”) were the Defendants in the District Court proceedings, however default was entered against Mudguard in 2014.

Pursuant to Rule 29.6, Respondent Fleet Engineers, Inc. states that it is subsidiary of Tramec Sloan LLC, a division of Tramec LLC. No publicly held corporation or other publicly held entity owns 10% or more of Fleet’s stock.

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OPINIONS BELOW

The Federal Circuit's August 15, 2023, opinion (Pet. App. 1-27) is available at 2023 U.S.P.Q.2D (BNA) 952, 2023 U.S. App. LEXIS 21178, 2023 WL 5219773.

The Federal Circuit's order denying Petitioner's request for an *en banc* review was issued on September 21, 2023, and is unreported.

JURISDICTION

Respondent does not dispute this Court's jurisdiction over this case pursuant to 28 U.S.C. § 1254 but denies that this case satisfies the standard set forth in Supreme Court Rule 10.

COUNTERSTATEMENT OF THE CASE

The origins of this dispute can be summarized succinctly. In April 2010, Petitioner approached Respondent and asked Respondent to offer for sale Petitioner's mudflap product that was called "V-Flap." *District Court Doc. 1-1, Page ID#23*. Respondent initially agreed to do so, but after a series of testing failures and other issues, the business relationship between Petitioner and Respondent was terminated in September 2010. *District Court Doc. 1-1, Page ID#33*. Two years later, Respondent introduced its independently designed mudflap product, the "AeroFlap."

Through counsel, Petitioner corresponded with Respondent and levied accusations of patent infringement against Respondent. *District Court Doc. 1-2, PageID#35-36*. Respondent disagreed with the allegations

and its counsel provided reasons that Respondent did not infringe and why Petitioner's patent may be invalid. *District Court Doc. 1-3, PageID#57-60.*

Apparently dissatisfied with the response received from Respondent, and rather than filing a patent infringement lawsuit, Petitioner sent an email blast to his customers and others in the trucking industry, claiming that purchasers and users of Respondent's product were in "violation of our patent" and stating Respondent had been served with a "Cease and Desist" notice. *District Court Doc. 1-4, PageID#66-67.* This correspondence disturbed and upended numerous of Respondent's customer relationships, leading Respondent to file a declaratory judgment action in the Western District of Michigan in October 2012.

Respondent asked the District Court for findings that: (1) the AeroFlap product did not infringe Petitioner's patent, (2) Petitioner's patent was invalid, and (3) Petitioner and his company, Mudguard, were liable for tortious interference due to their communications to the market. *District Court Doc. 1.* Petitioner and Mudguard, both initially represented by counsel, filed counterclaims for: (1) patent infringement, (2) breach of contract, and (3) misappropriation of trade secrets. *District Court Doc. 8.*

During the pendency of this matter at the District Court, Mudguard was found to be in default, and a default judgment was later entered against it as to Respondent's tortious interference claim. *District Court Doc. 70, 255, 256.* Respondent voluntarily dismissed its tortious interference claim against Petitioner. *District Court Doc. 255.* Petitioner remained a party to the action and proceeded *pro se.*

In June 2017, the District Court resolved the parties' cross-motions for summary judgment and found Respondent was entitled to summary judgment of non-infringement and dismissal of Petitioner's counterclaims for breach of contract and misappropriation of trade secrets. *District Court Doc. 236*. The District Court further found that Petitioner was entitled to dismissal of Respondent's claims for patent invalidity. *District Court Doc. 236*. Final judgment was entered in 2018 and Petitioner appealed to the Federal Circuit. The Federal Circuit affirmed-in-part and vacated-in-part, reversing the District Court's grant of summary judgment to Respondent on its non-infringement claim and affirming the grant of summary judgment to Respondent as to Petitioner's breach of contract and misappropriation of trade secret claims. (Pet. App. 93-95)

On remand to the District Court, a jury trial was held in October 2021. At trial, Petitioner advanced claims of patent infringement, contributory infringement, and induced infringement. Petitioner requested damages in the form of lost profits and asked the jury to find that Petitioner's infringement had been willful. The District Court gave much leniency to Petitioner throughout the trial, even allowing Petitioner to reopen his case in chief after Petitioner had rested without offering for admission any exhibits that were introduced during his case.

The District Court granted Judgment as a Matter of Law to Respondent on Petitioner's claims of contributory and induced infringement because Petitioner had not introduced any evidence to support those claims during his case in chief. *District Court Doc. 368*. The remainder of Petitioner's claims went to the jury, who found Respondent liable for patent infringement as to some of its products

and awarded Petitioner a reasonable royalty of 4% on sales of those products, but found Petitioner was not entitled to recover lost profits and denied Petitioner's claim that Respondent had committed willful infringement. *District Court Doc. 370*.

The parties filed post-trial motions. Petitioner requested the District Court (1) amend the Judgment as a Matter of Law and find there was induced or contributory infringement; (2) amend the jury verdict to expand the products that were found to infringe; (3) amend the jury verdict to find Respondent's infringement was willful; (4) award Petitioner lost profits; (5) increase the jury's awarded royalty rate; (6) award Petitioner attorney fees; and (7) enter a permanent injunction. The District Court denied Petitioner's motions. Petitioner appealed to the Federal Circuit, and on August 15, 2023, the Federal Circuit affirmed the findings from the District Court. (Pet. App. 27)

REASONS FOR DENYING THE PETITION

The Court should deny the Petition. Pursuant to Supreme Court Rule 10, "[r]eview on a writ of certiorari is not a matter of right, but of judicial discretion" and will only be granted for "compelling reasons." The questions asserted by Petitioner are not compelling reasons. Examples of compelling reasons include that "a United States court of appeals has entered a decision in conflict with the decision of another United States court of appeals on the same important matter," "a state court of last resort has decided an important federal question in a way that conflicts with the decision of another state court of last resort or of a United States court of appeals,"

or “ a state court or a United States court of appeals has decided an important question of federal law that has not been, but should be, settled by this Court, or has decided an important federal question in a way that conflicts with relevant decisions of this Court.” Sup. Ct. R. 10. Petitioner does not identify any such situation here because he cannot. The Federal Circuit has reviewed the questions raised in Petitioner’s Petition and has agreed with the District Court. This affirmance does not rise to the level of a “compelling reason” to grant certiorari.

I. Petitioner’s Questions are Not Properly Before This Court and the Petition Does Not Comply with This Court’s Rules

Petitioner asks this Court to intervene regarding what he believes is an incorrect result in this single case based on factual findings made by the jury and the District Court. “This issue, which has few if any ramifications beyond the instant case, does not satisfy any of the criteria for the exercise of this Court’s discretionary jurisdiction. “ *Bartlett v. Stephenson*, 535 U.S. 1301, 1304, 122 S. Ct. 1751, 1753 (2002) (*citing* Sup. Ct. R. 10). In addition, Petitioner’s Questions 3 and 4 were decided by the Federal Circuit in 2019 on the first appeal in this case. (Pet. App. 61-64.) As a result, they are no longer timely brought to this Court. *See*, Supreme Court Rule 13.

The Petition also does not comply with Supreme Court Rule 14(4), which states that “[t]he failure of a petitioner to present with accuracy, brevity, and clarity whatever is essential to ready and adequate understanding of the points requiring consideration is sufficient reason for

the Court to deny a petition.” Sup. Ct. R. 14(4). While Respondent understands that Petitioner has proceeded *pro se* in this matter for many years and puts forth his best effort with court filings, the Petition is not accurate or clear and does not provide a “ready and adequate understanding of the points.”

The Petition states that “[t]his Court is the final hope for the Pro Se Petitioner/Defendant to secure the ‘Defenseless Patent Owners Rights in America’ guaranteed under our patent laws that has been aggressively violated by the ‘Corporate Bullies, such as the Respondent’ ...” (Pet. 7) This is not a clear articulation of how any of the decisions made by the District Court were an abuse of discretion, but rather is simply an expression of discontent with the jury’s verdict and decisions of the District Court. Petitioner claims that this Court “needs to reestablish the criteria of ‘Infringement,’ (Pet. 3) but offers no compelling justification for this Court to overturn its past decisions. Petitioner’s Petition should be denied for these reasons alone.

II. Petitioner’s Question 1 is Nothing More Than a Grievance with Proper Decisions by the District Court

The first question posed by Petitioner asserts that the District Court “erred in denying proper compensation, including ‘Cease and Desist order.’” (Pet. i) As this Court has held, a finding of infringement does not automatically entitle a patent holder to a permanent injunction.

A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that

remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.

eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 391, 126 S. Ct. 1837, 1839 (2006). Here, the Federal Circuit properly applied the law and found the District Court did not err in finding that Petitioner was not irreparably harmed, but rather could be properly compensated monetarily. (Pet. App. 23-25) Petitioner has identified no error in the application of law by either the District Court or the Federal Circuit.

A. The Abuse of Discretion Standard

Denial of a motion for a permanent injunction is reviewed on appeal for an abuse of discretion. *eBay*, 547 U.S. at 391. “[D]eference [to the trial court] ... is the hallmark of abuse-of-discretion review.” *Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 143 (1997). “To meet the abuse-of-discretion standard, the appellant must show that the district court made ‘a clear error of judgment in weighing relevant factors or in basing its decision on an error of law or on clearly erroneous factual findings.’” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 918 F.3d 1368, 1382 (Fed. Cir. 2019) (quoting *Bayer CropScience AG v. Dow Agrosciences LLC*, 851 F.3d 1302, 1306 (Fed. Cir. 2017)); see also *Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.*, 572 U.S. 559, at 563 n.2 (2014). “In matters of judicial discretion, especially with respect to litigation procedures, the appellate court

should exercise restraint in substituting its view for that of the judge who was on the spot.” *Romag Fasteners, Inc. v. Fossil, Inc.*, 866 F.3d 1330, 1346 (Fed. Cir. 2017) (citing *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1468 (Fed. Cir. 1997)).

B. The District Court Did Not Err by Denying a Permanent Injunction

Petitioner has made no showing to this Court, or the Federal Circuit, how the District Court made a clear error of judgment in weighing relevant factors or based its decision on an error of law or on clearly erroneous factual findings. *SRI*, 918 F.3d at 1382. The Federal Circuit affirmed that the District Court “did not err in determining that [Petitioner’s] injury was compensable through the reasonable royalty awarded by the jury.” (Pet. App. 24) Petitioner has not demonstrated to any court, including the District Court, how he has suffered *irreparable* harm and that monetary damages are inadequate compensation for how he has been injured. To the contrary, Petitioner argues that he is entitled to additional monetary compensation.

C. Petitioner was Not Entitled to An Award of Lost Profits and the Royalty Rate Awarded by the Jury was Reasonable

While not specifically articulated in the question, Petitioner presents multiple arguments in the Petition regarding additional monetary damages to which he believes he is entitled. Petitioner states that he could receive a “net damage award of \$25,713 ...” (Pet. 8) The jury awarded Petitioner a 4% reasonable royalty on the sales of the “Group A” products, which amounted to

\$228,000. *District Court Doc. 370, 378*. To reach his lower “net damage” amount, Petitioner deducts from the jury award the judgment that was entered against Mudguard. This results in the “net damage” award of \$25,713. While this math is correct, any reduction in Petitioner’s recovery due to the tortious interference of Mudguard is not attributable to Respondent and does not serve as a basis to adjust a properly calculated jury verdict for a reasonable royalty.

Petitioner is a non-practicing entity and does not personally produce products under the patent, and thus has suffered no lost profits. (Pet. App. 19) The Federal Circuit agreed with Respondent that “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.” (Pet. App. 19) While Petitioner was permitted to argue to the jury a theory that he should be entitled to recover Respondent’s profits from sale of the products that were found to infringe, this argument was unpersuasive to the jury. “The jury’s finding that [Petitioner] was not entitled to lost profits was therefore supported by substantial evidence.” (Pet. App. 19)

In a new and novel argument, Petitioner asserts that after a finding of infringement, a patent owner should be able to “freely negotiate a proper compensation.” (Pet. 7) Petitioner cites no basis in law for such a theory of damages calculation post-jury verdict. To the extent Petitioner wished to “freely negotiate” a royalty with Respondent, there were ample opportunities to do so during the pendency of this matter. Instead, Respondent rolled the dice on a jury verdict and did not get the outcome he desired and now makes an emotional plea asking this Court to intervene. Petitioner has made no arguments

that show how the District Court's ruling falls outside the bounds of reasonable judgment, is based on incorrect legal principles, or is unsupported by substantial evidence.

D. The Jury's Verdict of No Willful Infringement is Well Supported

Petitioner states that “[t]his Court needs to decide whether the damage award ... is proper or not after knowing the fact that Respondent engaged in “Willful & Egregious Conduct ...” (Pet. 19-20) The jury made a finding that there was no willful infringement, and Petitioner asserts the District Court should have reversed that finding. “[I]t is the responsibility of the jury--not the court--to decide what conclusions should be drawn from evidence admitted at trial. A reviewing court may set aside the jury's verdict on the ground of insufficient evidence only if no rational trier of fact could have agreed with the jury.” *Cavazos v. Smith*, 565 U.S. 1, 2, 132 S. Ct. 2, 4 (2011). The Federal Circuit found that the “jury was free to weigh the relevant evidence” and that even contrary evidence “does not mean that the jury's finding of no willfulness was unsupported by substantial evidence.” (Pet. App. 21) Petitioner has brought nothing new to this Court to show why the jury verdict of no willful infringement should be disturbed.

E. The District Court Did Not Abuse Its Discretion in Not Awarding Enhanced Damages

Turning next to whether the District Court abused its discretion in not awarding Petitioner enhanced damages, the answer is “no.” The Patent Act establishes that “the court may increase the damages up to three times the

amount found or assessed.” 35 U.S.C. § 284 (emphasis added). “Awards of enhanced damages under the Patent Act over the past 180 years establish that they are not to be meted out in a typical infringement case, but are instead designed as a ‘punitive’ or ‘vindictive’ sanction for egregious infringement behavior.” *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 579 U.S. 93, 103, 136 S. Ct. 1923, 1932 (2016). Any decision on whether to award enhanced damages is to be reviewed on appeal for an abuse of discretion. *Id.*, at 563.

Petitioner asks this Court if the District Court erred when it “rejected award of triple damages when it concluded, against all undisputable evidences of obviousness to PHOSITA, that the infringement was not willful, wanton and egregious.” (Pet. 24) Petitioner then provides a recitation of facts that were previously before both the District Court and the Federal Circuit and makes no attempt at identifying how the District Court made ‘a clear error of judgment in weighing relevant factors or in basing its decision on an error of law or on clearly erroneous factual findings.’” *SRI*, 918 F.3d at 1382. Instead, Petitioner is simply asking this Court for a now-third bite at the apple, something he is not entitled to have.

F. The District Court Did Not Abuse Its Discretion in Not Awarding Attorney’s Fees

Petitioner next asks this Court if the District Court erred when it “prematurely and falsely awarded the Respondent \$15,579.58 in attorney’s fees¹, however,

1. Respondent has not been awarded any attorney’s fees in this case.

refused the Patentee a reimbursement of \$150,000 in attorney fees, for decade long litigation, that the Petitioner had incurred.” (Pet. 28)

The Patent Act establishes that the court “in exceptional cases may award reasonable attorney fees to the prevailing party.” 35 U.S.C. § 285. “Exceptional” has been defined as “simply one that stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.” *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S 545, 554 (2014). In finding a case to be exceptional, there must be a determination that a party’s “conduct, isolated or otherwise, is such that when considered as part of and along with the totality of circumstances, the case is exceptional.” *Intellectual Ventures I LLC v. Trend Micro Inc.*, 944 F.3d 1380, 1384 (Fed. Cir. 2019). The case must be looked at as a whole. *Id.* at 1383. Any decision on whether to award attorney’s fees is to be reviewed on appeal for an abuse of discretion. *Halo Elecs.*, 579 U.S. at 107, *citing Highmark*, 572 U.S., at 560-561.

Petitioner has submitted zero facts in support of this question and no law for his theory that a *pro se* party who did not incur legal fees should be awarded attorney’s fees under 35 U.S.C. § 285. Petitioner has represented himself *pro se* since 2015 and has incurred no legal fees since that time. Petitioner has introduced nothing into the record to show that he paid legal fees prior to that time. In fact, the record is clear that Petitioner’s prior legal counsel withdrew because he had *not* paid them. Petitioner makes no attempt at identifying that the District Court made

‘a clear error of judgment in weighing relevant factors or in basing its decision on an error of law or on clearly erroneous factual findings.’” *SRI*, 918 F.3d at 1382.

While Petitioner may disagree with the amount of monetary damages awarded to him by the jury in this matter, such a disagreement does not give rise to a proper appeal to this Court.

III. Petitioner’s Question 2 is Not Properly Before This Court Because the Jury’s Verdict was Based on Substantial Evidence

Petitioner’s second question verges on incomprehensible. Petitioner asks:

Whether the Court erred when it granted a ‘non-infringement’ judgment under ‘Doctrine of equivalent’ by relying on non-infringing elements while neglecting the undisputable intrinsic evidences of infringing elements.

(Pet. i)

At trial, the accused infringing products were divided into “Group A” and “Group B.” The jury found that there was direct infringement as to the “Group A” products and not for the “Group B products.” The jury next found that the infringement for the “Group A” products was not under the doctrine of equivalents. *District Court Doc. 370*. Following trial, Respondent filed a two-page motion under Rule 59 asking the Court to “complete, alter or amend an unfinished judgment by the jury” and find that the Group B products infringed under the doctrine of equivalents

District Court Doc. 374. Petitioner’s argument at that time was based on the District Court’s construction of the phrase “vertically extending.” The District Court denied Petitioner’s motion as “functionally seek[ing] reconsideration of the claim construction opinion issued in December 2013.” *District Court Doc. 391*. Petitioner appealed to the Federal Circuit which found that “[t]he jury’s finding that the Group B products do not infringe under the doctrine of equivalents was therefore supported by substantial evidence.” (Pet. App. 18)

As best Respondent understands Petitioner’s argument to this Court, he is presenting three different scenarios through which he believes the District Court should have found the Group B products to infringe and that the District Court abused its discretion by not overturning the jury’s verdict of non-infringement for the “Group B” products.

A. The District Court Did Not Err by Not Overturning the Jury’s Verdict of Non-Infringement

Petitioner asks this Court to reverse the jury’s finding of non-infringement, but has failed to show that there was insufficient evidence for the jury’s verdict. *Cavazos*, 565 U.S. at 2. Petitioner has made no showing to this Court, or the Federal Circuit, how the jury’s verdict was unfounded and that the District Court made a clear error of judgment in not overturning it. *SRI*, 918 F.3d at 1382.

While Petitioner claims that the Federal Circuit “adversely decided non-infringement of Respondent Group-B mud flaps ...”, he misconstrues the record. (Pet. 11) In 2019, the Federal Circuit reversed a finding of

summary judgment of non-infringement and remanded to the District Court for the jury to resolve a factual question of whether the Group B products infringed. (Pet. App. 4-5, 61). This factual finding was then made by the jury in its trial verdict. On appeal post-trial, the Federal Circuit found that there was sufficient evidence to support the jury's finding of non-infringement.

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.*

(Pet. App. 17-18)

Petitioner failed to direct the District Court, the Federal Circuit, or this Court to any such evidence in the record. Why? Because it does not exist. Petitioner's arguments to any court on this subject are also devoid of any attempt to demonstrate how the Group B products infringe under the Doctrine of Equivalents.

The Federal Circuit did not adversely decide anything; it affirmed the jury's verdict that was reached after hearing all of the evidence at trial and weighing the credibility of witness testimony. While Petitioner cites to a "triple identify test," (Pet. 11, n.3) no testimony was

introduced at trial regarding such a test. No evidence was provided for how the Group B products were infringing under the Doctrine of Equivalents.

B. The District Court Did Not Err by Not Finding That “Infringement Begins at the Point of Manufacturing”

Petitioner states “[t]he Federal Circuit Court totally ignored the undisputable fact that infringement first begins at the point of manufacturing.” (Pet. 13) Petitioner then summarizes Respondent’s manufacturing process and claims that “if the Court had followed the Jury’s unanimous verdict than both Group A and Group B are directly infringing ...” (Pet. 13) Petitioner has presented this Court with no legal authority for his theory that “infringement begins at the point of manufacturing.” Further, Petitioner never advanced this argument to the District Court or the Federal Circuit as a basis for finding that the Group B products infringed. Therefore, Petitioner has waived this argument.

C. The District Court Did Not Abuse Its Discretion by Finding Claim 19 Was Not in Dispute

Petitioner states that this Court needs to make a factual finding if Claim 19 of the patent-in-suit is infringed. (Pet. 16) Claim 19 was not an asserted claim in the litigation. Petitioner purports to provide a summary of the litigation proceedings below regarding amendment of the pleadings and identification of the asserted claims, however it is littered with errors.

Petitioner states that his Second Amended Counterclaims (*District Court Doc. 115*) reads “Declaring

that Plaintiff has directly infringed, contributorily infringed, and induced infringement of one or more claims of '755 patent, including claim 19." (Pet. 14) The actual Second Amended Counterclaims does not include the "including claim 19" language.

B. Declaring that Plaintiff has directly infringed, contributorily infringed, and induced infringement of one or more claims of the '755 reissue Patent;
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District Court Doc. 115.

Petitioner states that "the District Court ignored Surti's request to amend 'validity' and 'infringement' of Surti's reissued '755 patent and its newly added claims, including claim 19." (Pet. 15) There is no citation to the record for this assertion, and Respondent is unaware of any ruling by the District Court not permitting an amendment of the asserted claims. To the contrary, Petitioner *never* asked the District Court for leave to amend the identification of asserted claims.

Petitioner states the "Court made a legal error when it disallow[ed] the second amended complaint of the Petitioner." (Pet. 15) There is no citation to the record for this assertion, and Respondent is unaware of any ruling by the District Court not permitting an amended filing by Petitioner.

Following the first appeal to the Federal Circuit in this matter, the District Court required briefing from the parties regarding the identification of the claims at issue. The District Court then issued an order clarifying claims "1, 2, 5, 8, 9, and 13" were the properly asserted claims. *District Court Doc. 306.* Petitioner raised that determination in the post-trial appeal to the Federal

Circuit, which held that “[t]he 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.” (Pet. App. 11)

Again, Petitioner has failed to provide this Court with any evidence or argument that the District Court made ‘a clear error of judgment in weighing relevant factors or in basing its decision on an error of law or on clearly erroneous factual findings.’” *SRI*, 918 F.3d at 1382.

IV. Petitioner’s Questions 3 and 4 Are Not Properly Before This Court Because They Were Decided by the Federal Circuit in 2019

Petitioner’s third and fourth questions both relate to whether the District Court erred by entering judgment against Mudguard on Respondent’s tortious interference claim. Petitioner previously raised the issues of Questions 3 and 4 to the Federal Circuit and they were resolved in 2019.

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.

(Pet. App. 63)

A decision rendered in 2019 cannot be appealed to this Court five years later. Sup. Ct. R. 13. Following resolution of these questions by the Federal Circuit in 2019, they were not re-presented to the District Court in the original or a revised form. “This Court has considered issues

not raised in the courts below only in ‘exceptional cases or particular circumstances . . . where injustice might otherwise result.’” *Newport v. Fact Concerts*, 453 U.S. 247, 275 n.4, 101 S. Ct. 2748, 2764 (1981), quoting *Hormel v. Helvering*, 312 U.S. 552, 557, 61 S. Ct. 719, 721 (1941). This is not such a case.

A. Mudguard Is Not a Non-Related Third Party and Petitioner’s Publication Was Not Notice Under 35 U.S.C. § 287

Mudguard is not a “non-related third party.” It is a company formed by Petitioner’s wife and Petitioner has held himself out as the sole representative of Mudguard. Petitioner affirmed at trial that “you cannot separate the Mudguard entity from me because, as you know, your Honor, I have been involved from the Day 1 representing both the Mudguard as well as myself.” *District Court Doc. 394, PageID.4040; Trial Transcript*, page 10, lines 11-14.

In his argument, Petitioner claims that this Court “needs to decide whether [Petitioner] posting a public notice, required under 35 U.S.C. §287, be considered as a protection of his patent rights or ‘Tortious Interference with Business (Michigan law)’ because all individual patent owners in the USA are dependent on the clarification of this law.” (Pet. 17) Respondent submits that the law is clear and there is no question to be resolved by this Court.

(B)A written notification from the patent holder charging a person with infringement shall specify the patented process alleged to have been used and the reasons for a good faith belief that such process was used. The patent holder shall include in the notification such information

as is reasonably necessary to explain fairly the patent holder's belief, except that the patent holder is not required to disclose any trade secret information.

35 U.S.C. § 287(5)(B).

The communication Petitioner and Mudguard made in 2012 was not a "public notice" as required by 35 U.S.C. § 287 but was email that identified itself as an "Open Letter To The User of Aero-Flap mudflap by Fleet Engineers," signed by Petitioner and sent by Mudguard to Mudguard's contact list. *District Court Doc. 1, ¶¶43-45, Doc. 1-4, Doc. 1-5.*



This communication, along with others, was tortious interference with Respondent's business relationships, and was the subject of Respondent's claim in the Complaint filed October 19, 2012. *Id.* None of these communications meet the standards of 35 U.S.C. § 287(5)(B) for providing notice of infringement to an alleged infringer. Petitioner's communication did not identify the patent accused of infringement, let alone any reasons for a good faith belief that a patented product or process was used by the accused infringer.

B. Judgment Against Mudguard was Proper

Petitioner finally asks this Court to find that default judgment should not have been entered against Mudguard on the tortious interference claim but should have been entered against Respondent. (Pet. i) For the reasons stated above, any question regarding the entry of default judgment against Mudguard was resolved by the Federal Circuit in 2019 and cannot be brought before this Court.

CONCLUSION

For the foregoing reasons, the Petition for Certiorari should be denied.

Respectfully submitted,

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