

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

HENGST SE,

Plaintiff,

v.

CHAMPION LABORATORIES, INC.,

Defendant.

Case No. 23-cv-00794

Judge Sara L. Ellis

Magistrate Judge Heather K. McShain

PLAINTIFF’S FINAL INFRINGEMENT CONTENTIONS

Pursuant to Scheduling Order [20] and Local Patent Rule (“LPR”) 3.1(a)(2), Plaintiff Hengst SE (“Hengst” or “Plaintiff”), by and through its undersigned counsel, submits the following final infringement contentions to Defendant Champion Laboratories, Inc. (“Champion” or “Defendant”), including by reference the attached exhibit.

Hengst submits these contentions based upon currently available information. Hengst has not completed discovery of this matter and reserves the right to amend in light of discovery from Defendant.

A. Identification of Infringed Claims

Hengst alleges that claims 15-17, 19, 23-25, 28, and 30 of U.S. Patent No. 9,023,203 (the “’203 Patent”) are infringed by and through Defendant’s actions.

B. Identification of Accused Products

Hengst alleges that Defendant’s filter insert with the part identification number LP6044 (the “Accused Product”) infringes the ‘203 Patent. Defendant manufactures, distributes, promotes, and/or offers to sell and sells in the Accused Product in the United States. Defendant literally

and/or under the doctrine of equivalents, directly and/or indirectly, infringes the claims of the ‘203 Patent, including through its promotional and sales activities.

C. Infringement Claim Chart

Exhibit A, which is incorporated by reference as if fully set forth herein, includes a claim chart that provides more detailed explanations of the bases for Hengst’s infringement contentions. *See generally* HE027978-HE027987, CL000001, CL000537-CL000913, and CL004034-CL008470

D. Literal Infringement And Infringement Under Doctrine of Equivalents

Claims 15-17, 19, 23-25, 28, and 30 of the ‘203 patent are literally infringed by Defendant’s acts of making, using, and selling the Accused Product as explained in the attached **Exhibit A**. Hengst alternatively alleges that the asserted claims are under the doctrine of equivalents as explained in the attached **Exhibit A**. Hengst, reserves the right to supplement these contentions as discovery progresses.

E. Indirect Infringement

Of the asserted claims, claims 15, 23-25, 28, and 30 are directly infringed by making, using, selling, and/or offering to sell the Accused Product. In addition, claims 15-17, 19, 23-25, 28, and 30 of the ‘203 patent are indirectly infringed by the Accused Product under induced infringement and/or contributory infringement when the Accused Product is used by an end user. These claims of the ‘203 patent are indirectly infringed by third parties that purchased the Accused Product and installed the Accused Product in a liquid filter made or authorized by Plaintiff. Moreover, Defendant knew of the ‘203 patent or was willfully blind as to the ‘203 patent. *See* CL007761. With respect to induced infringement, Defendant acted with the intent to encourage the third party infringement of the above-mentioned claims of the ‘203 patent. Specifically, Defendant instructs

the purchasers and users of the Accused Products to install the Accused Products in the liquid filter made or authorized by Plaintiff. *See* Champion Response to Hengst's Request for Admission No. 6. Finally, with respect to contributory infringement, there is no substantial non-infringing use of the Accused Product. Hengst reserves the right to supplement these contentions as discovery progresses.

F. Priority Date

The priority date of each claim of the '203 patent is at least as early as December 10, 2009.

G. Willful Infringement

On information and belief, Defendant's infringement of the '203 patent has been, and continues to be, willful because Defendant, with knowledge of the '203 patent, has continued to infringe despite the objectively high likelihood that these actions are infringing. Further, this objectively high risk was either known by Defendant or should have been known by Defendant due to the obvious nature of the infringement.

In particular, the Accused Products were specifically designed to be used in liquid filters made or authorized by Plaintiff and knowing that Plaintiff's liquid filter and filter insert were patented. As admitted by Champion, "the LP6044 was intended to be installed into a filter made by Hengst." Champion Response to Hengst's Request for Admission No. 3. Moreover, Champion was aware of the '203 patent since at least January 2, 2019. *See* CL007761; *see generally* CL000537-CL000913 and CL004034-CL008470.

H. Practice of the Claimed Invention

The Hengst Model E830H D366 oil filter insert embodies the claims of the '203 patent. The Hengst products are sufficiently marked under 35 U.S.C. § 287.

Dated this 16th day of January 2024.

Respectfully submitted,

s/ Patrick J. Smith

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CERTIFICATE OF SERVICE

I hereby certify that on the 16th day of January 2024, I electronically served the foregoing document on all counsel of record for the parties in this matter via email at the below email addresses:

Dave Nelson (davenelson@quinnemanuel.com)

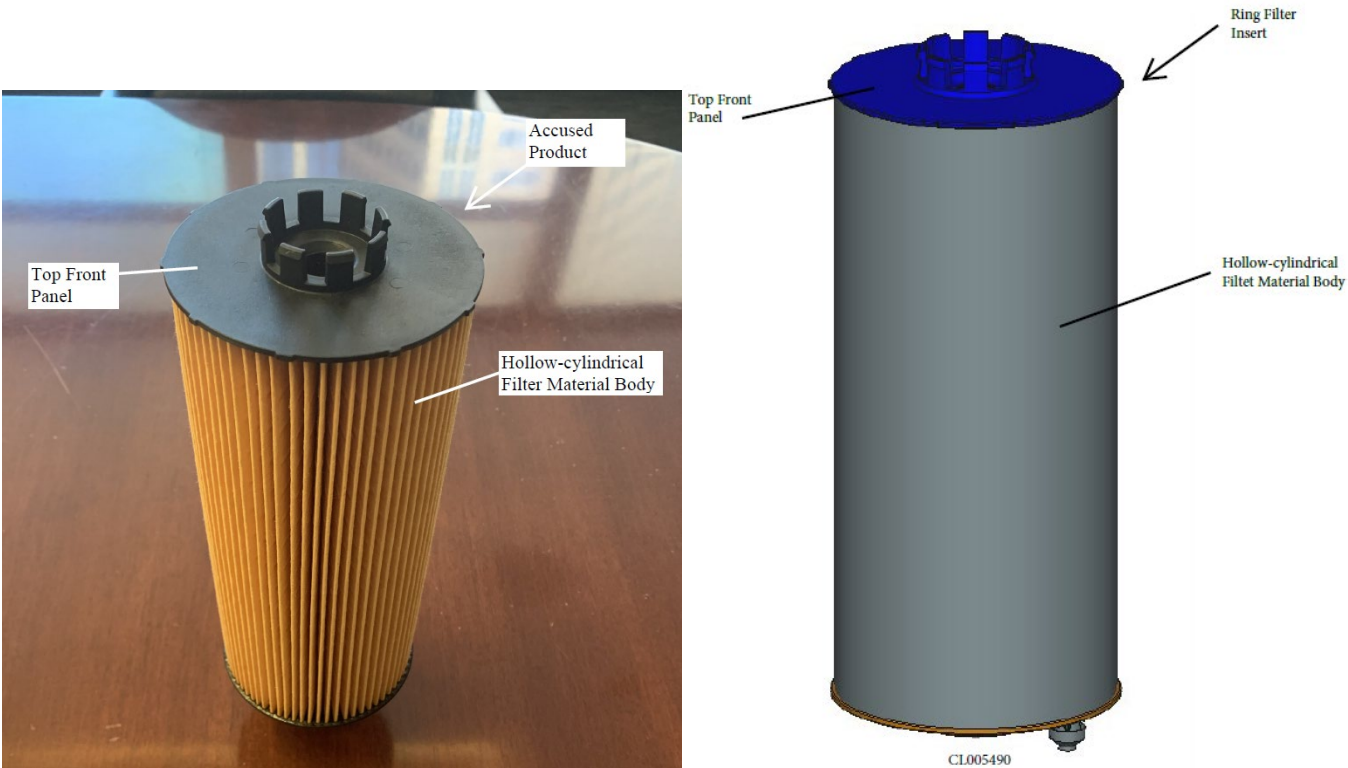
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s/ Patrick J. Smith

EXHIBIT A

U.S. Patent No. 9,023,203 Claim Chart

Claim 15 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
A ring filter insert for a liquid filter, comprising: a hollow-cylindrical filter material body surrounded on front sides by top and bottom front panels and which can be replaceably arranged in a filter housing,	 Fig. 1: Accused Product Ring Filter Insert

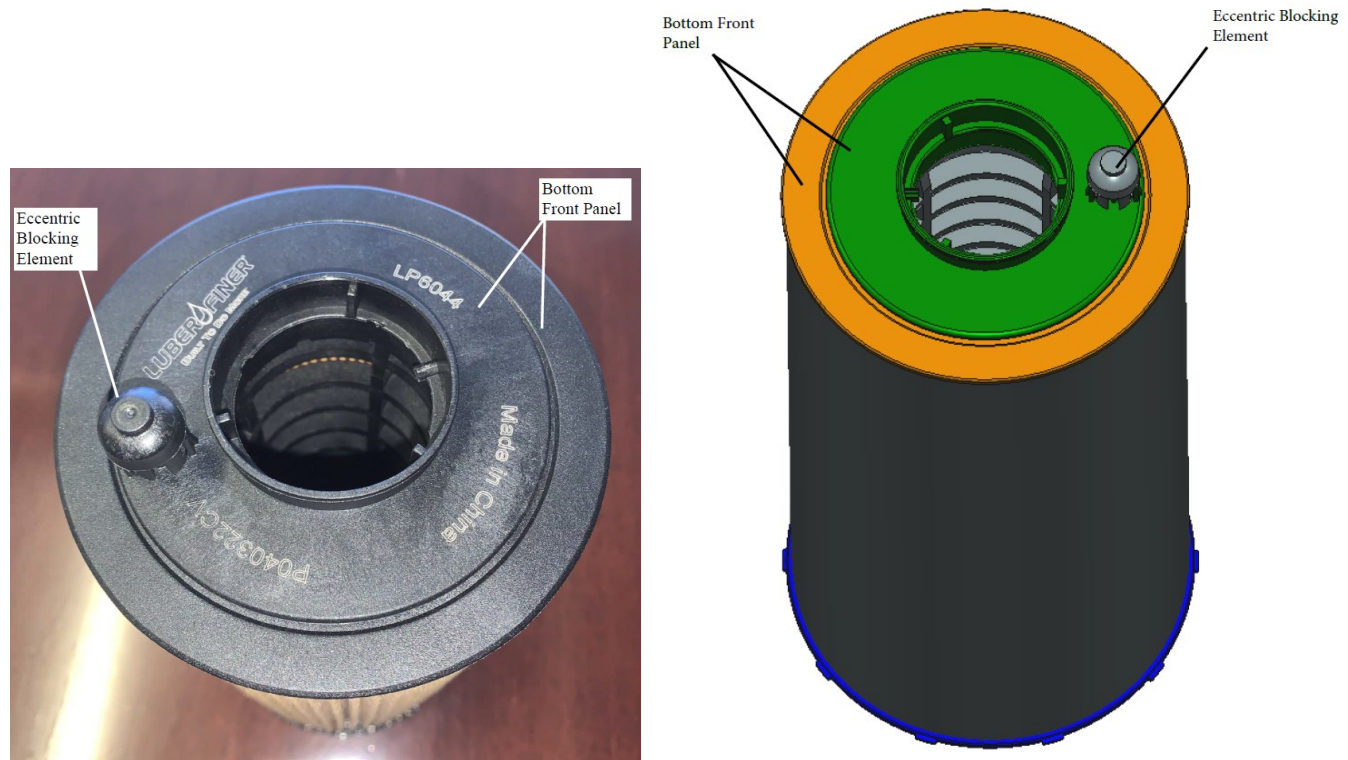


Fig. 2: Accused Product Bottom View

Fig. 1 shows the Accused Product, and Fig. 2 shows a bottom view of the Accused Product. As shown in Figs. 1-2, the Accused Product filter insert includes a hollow-cylindrical filter material body, a top front panel, a bottom front panel.

Champion admitted “that the LP6044 was intended to be installed into a filter made by Hengst.” Response to Hengst’s Request for Admission No. 3; *see also* Response to Hengst’s Request for Admission Nos. 6 and 7, CL004043, CL005492, and HE027982. Thus, the Accused Product can be replaceably arranged in said filter housing.

	Based on the foregoing, Hengst asserts this element is literally infringed. However, to the extent that the bottom front panel is construed to include only a unitary panel element, the above-identified rotating panel element (green element) and the cover panel element (orange element) form an equivalent to the claimed bottom front panel because said elements achieve the same function (surrounding the filter inset and receiving the pipe nozzle), in the same way (sealing the bottom of the hollow cylindrical filter material body and comprising an opening to receive a pipe nozzle), to achieve the same result (a sealed filter material body and coupled to the pipe nozzle).
an eccentric blocking element arranged on the bottom front panel for engaging an eccentric opening in the filter housing,	Fig. 2: Accused Product Bottom View

	The above Fig. 2 shows the eccentric blocking element of the Accused Product arranged on the bottom front panel. Champion admitted “that the LP6044 was intended to be installed into a filter made by Hengst.” <u>Response to Hengst’s Request for Admission No. 3</u>; <i>see also</i> <u>Response to Hengst’s Request for Admission Nos. 6 and 7</u>. Thus, the eccentric blocking element of the Accused Product is provided for engaging an eccentric opening in said filter.
first positioning means on the ring filter insert, which interact with second positioning means on the filter housing when the ring filter insert is inserted into the filter housing and which are arranged to bring the blocking element into engagement with the eccentric opening,	Fig. 3: Accused Product Positioning Means Fig. 3 shows the Accused Product first positioning means on the ring filter insert. The first positioning means are provided to interact with second positioning means on a filter housing when the ring filter

	insert is inserted into the filter housing. As shown in Figs. 4A-B and 5, the first positioning means are arranged to bring the blocking element into engagement with the eccentric opening. Champion admitted “that the LP6044 was intended to be installed into a filter made by Hengst.” <u>Response to Hengst’s Request for Admission No. 3</u>; <i>see also</i> <u>Response to Hengst’s Request for Admission Nos. 6 and 7</u>. Thus, the first positioning means are provided for interacting with second positioning means on said filter when the ring filter insert is inserted into said filter housing. In being provided for interacting with second positioning means, the first positioning means are arranged to bring the blocking element into engagement with the eccentric opening. <u>CL004043</u>, <u>CL005492</u>, and <u>HE027982</u>; <i>see generally</i> <u>CL000537-CL000913</u> and <u>CL004034-CL008470</u>.
the first positioning means being one of an inclined plane and a protruding nose, with the second positioning means being the other of the inclined plane and the protruding nose,	As shown in Fig. 3 (above), the first positioning means of the Accused Product comprise a protruding nose. Champion admitted “that the LP6044 was intended to be installed into a filter made by Hengst.” <u>Response to Hengst’s Request for Admission No. 3</u>; <i>see also</i> <u>Response to Hengst’s Request for Admission Nos. 6 and 7</u>. Thus, the Accused Product protruding nose is provided to interact with an inclined plane. <i>See</i> Fig. 5 (below).

the inclined plane and the nose arranged to be moved in relation to each other in such a way that they slide along each other and bring the blocking element into engagement with the eccentric opening, by rotating the ring filter insert relative to the filter housing,

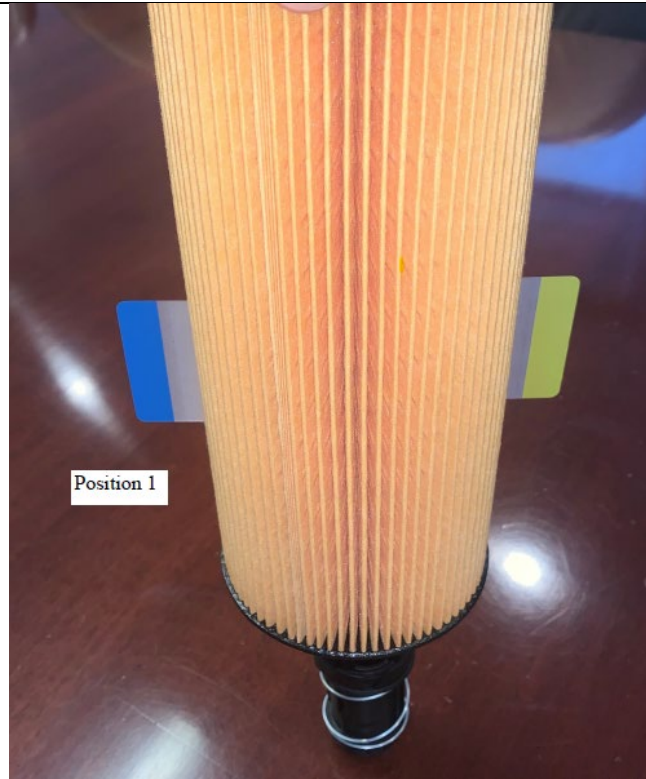


Fig. 4A

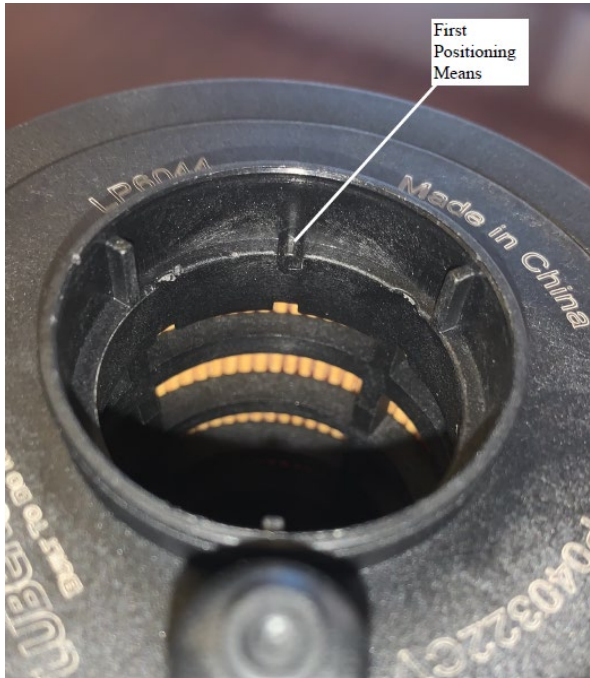
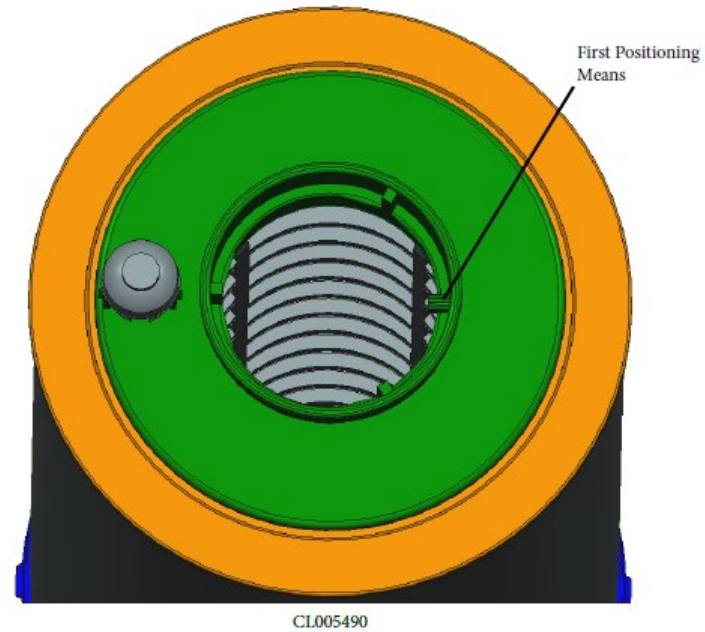


Fig. 4B

The above Figs. 4A-B show the Accused Product ring filter insert before (Fig. 4A) and after (Fig. 4B) the Accused Product is installed on a centerpipe from a housing. As shown above, the protruding nose slides along an inclined plane to bring the blocking element into engagement with the eccentric opening by rotating the ring filter insert relative to the filter housing. In the Accused Product, the rotation of the ring filter insert relative to the filter housing is demonstrated in the document production of both Champion and Hengst. See [CL004043](#), [CL005492](#), and [HE027982](#).

The claim does not require the entire ring filter insert to be rotated. Moreover, rotation of the bottom front panel portion is rotation of the ring filter insert, because the bottom front panel is part of the ring filter insert. To the extent only the bottom front panel rotates, the rotation of the bottom front panel, as a part of the ring filter insert, is a rotation of the ring filter insert.

Based on the foregoing, Hengst asserts this element is literally infringed. However, if it were not found to be literally infringed, the rotation of the bottom front panel is an equivalent to rotation of the entire

	ring filter insert because it achieves the same function (rotation to align the eccentric blocking element), in the same way (protruding nose and inclined planes slidingly engaged), to achieve the same result (proper alignment of the eccentric blocking element within a filter housing). More specifically, both designs are intended to provide for proper alignment of the eccentric blocking element with an eccentric opening of a filter. Both utilize a protruding nose and an inclined planes to achieve this rotation. Additionally, both rotate the eccentric blocking element of the filter insert to obtain the proper orientation and to ensure the filter is aligned and operable.
the first positioning means being one of embodied and arranged on an inner circumference of the ring filter insert.	As shown in Fig. 3, reproduced below, the first positioning means are arranged on an inner circumference of the ring filter insert.  A close-up photograph of a black plastic ring filter insert. The insert has a central opening with a yellow mesh. A label 'First Positioning Means' with a pointer indicates a small protrusion on the inner circumference of the ring. The text 'LP8044' and 'Made in China' are visible on the outer rim.  A cross-sectional diagram of the accused product. It shows a green outer ring with an orange inner ring. A central grey mesh is visible. A label 'First Positioning Means' with a pointer indicates a small protrusion on the inner circumference of the green ring. The text 'CL005490' is visible at the bottom. Fig. 3: Accused Product Positioning Means

Claim 16 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
The ring filter insert according to claim 15, wherein the inclined plane is formed by two partial planes which run towards each other in opposite directions and which in each case extend across half of an inner circumference of the ring filter insert.	Fig. 5: Filter Housing Part When the Accused Product filter insert is installed, the inclined plane of the filter part shown in Fig. 5 interacts with the Accused Product so as to indirectly infringe the '203 Patent. The above Fig. 5, shows that an inclined plane is formed by two partial planes which run towards each other in opposite directions and which in each case extend across half of the outer circumference of the filter housing part.

Claim 17 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
The ring filter insert according to claim 15, including a guide for the nose which runs in an axial direction and is connected to a lower end of the inclined plane.	 Nose Guide Fig. 6: Filter Housing Part When the Accused Product filter insert is installed, the nose guide of the filter housing part shown in Fig. 5 interacts with the Accused Product so as to indirectly infringe the '203 Patent. The above Fig. 6

	shows the guide for the nose which runs in an axial direction and is connected to a lower end of the inclined plane. Champion admitted “that the LP6044 was intended to be installed into a filter made by Hengst.” <u>Response to Hengst’s Request for Admission No. 3</u>; <i>see also</i> <u>Response to Hengst’s Request for Admission Nos. 6 and 7</u>. Thus, the nose of the Accused Product is provided for a guide which runs in the axial direction of said filter.
Claim 19 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
The ring filter insert according to claim 15, wherein the inclined plane is formed by one of a radially protruding rib and step which forms a contact surface for the nose on one of an upper or lower side thereof.	When the Accused Product filter insert is installed, the inclined plane of the filter part shown in Fig. 5 interacts with the Accused Product so as to indirectly infringe the ‘203 Patent. Figs. 5-6 show the inclined plane formed as one of a radially protruding rib and step. When the first and second positioning means engage as shown in Fig. 4A-4B, this forms a contact surface for the nose on one of an upper and lower side thereof.

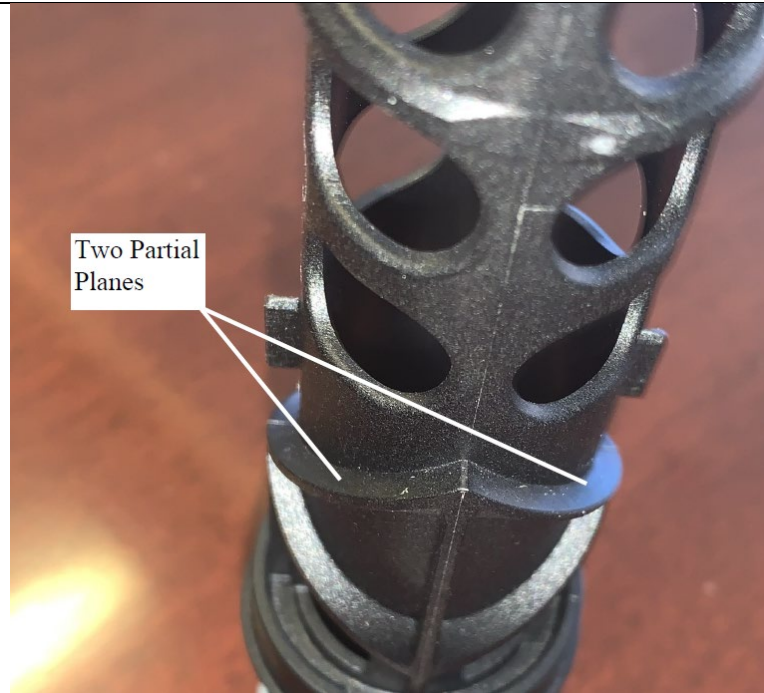


Fig. 5: Filter Housing Part



Fig. 6: Filter Housing Part

**Claim 23 of U.S. Patent
No. 9,023,203**

**Accused Product
(LP6044)**

The ring filter insert according to claim 15, wherein the nose is formed integrally with the bottom front panel of the ring filter insert.

As shown in Fig. 3, reproduced below, the protruding nose is formed integrally with the bottom front panel of the Accused Product ring filter insert.

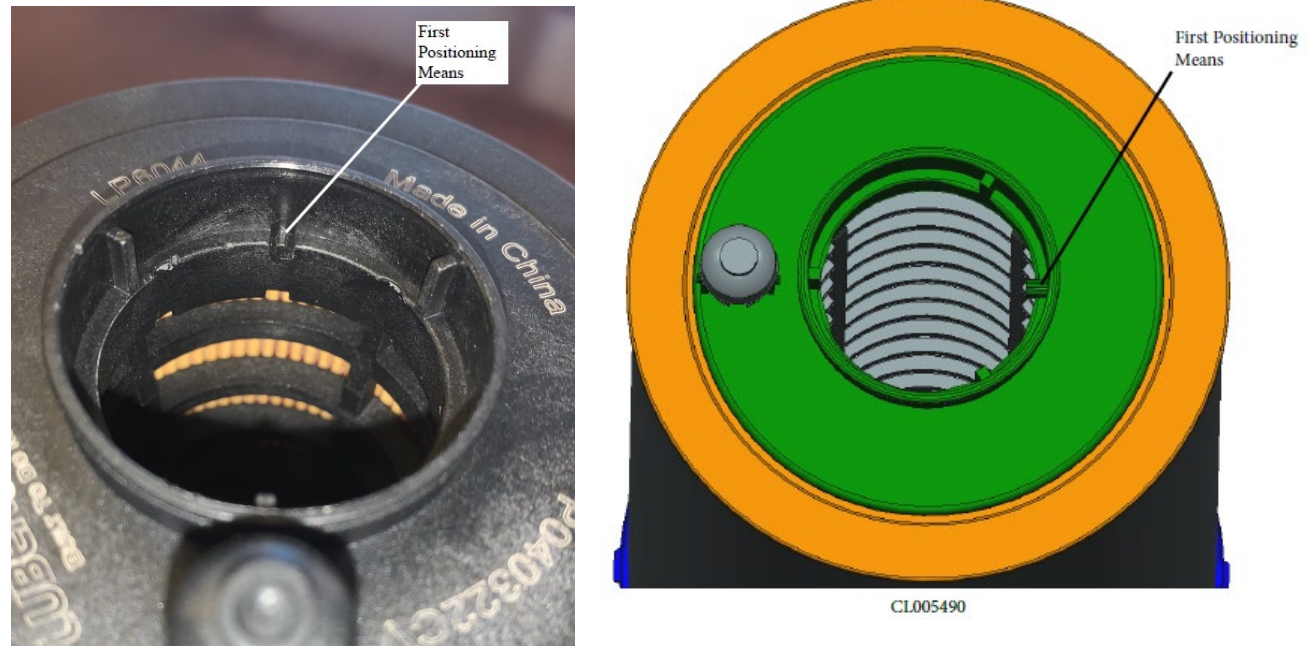


Fig. 3: Accused Product Positioning Means

Claim 24 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
The ring filter insert according to claim 15, wherein the blocking element is one of a radially sealing valve element, an axially sealing valve element, and a radially sealing plug which is one of rigidly connected to the lower front panel and rigidly arranged on the lower front panel.	Fig. 7: Accused Product Blocking Element As shown in the above Fig. 7, the blocking element is an axial sealing valve element. The blocking element is rigidly connected or rigidly arranged to the lower front panel. At least a portion of the blocking element is integrally formed, and therefore is rigidly arranged on the lower front panel.
Claim 25 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
The ring filter insert according to claim 15, wherein the blocking element is an axially sealing valve element	As shown in the above Fig. 7, the blocking element is an axial sealing valve element which is elastically arranged on the bottom front panel such that “longitudinal tolerances are compensated.” ‘203 Patent Specification, col. 8, ln. 2-4. Fig. 8 demonstrates the axial movement of the eccentric blocking element.

which is elastically arranged on the bottom front panel.

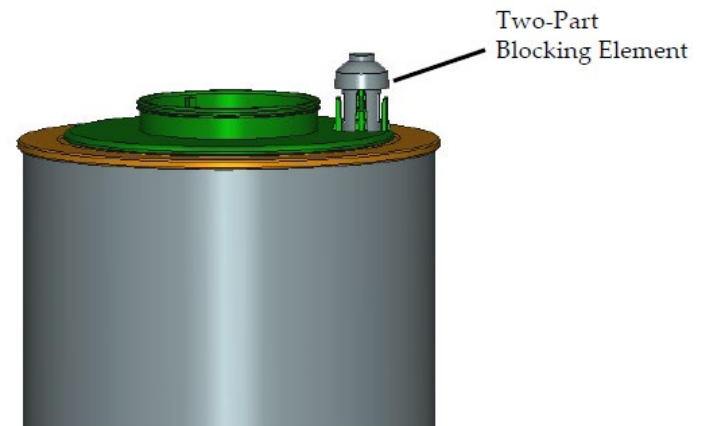


Fig. 7: Accused Product Eccentric Blocking Element

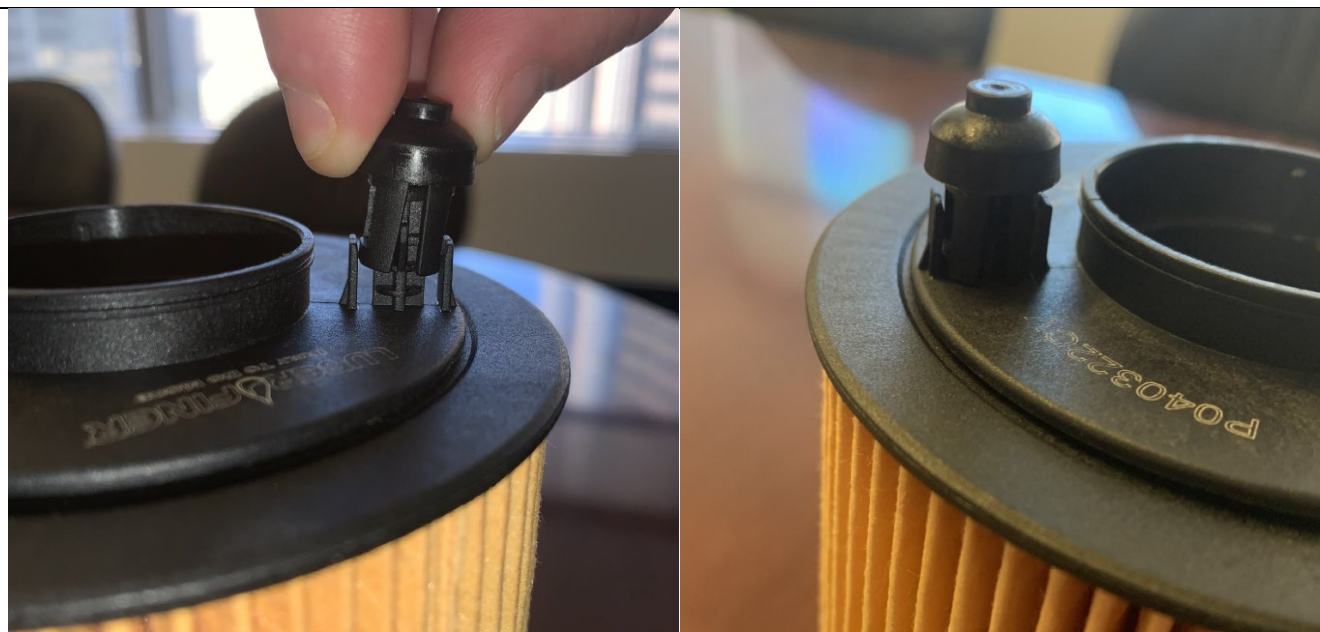
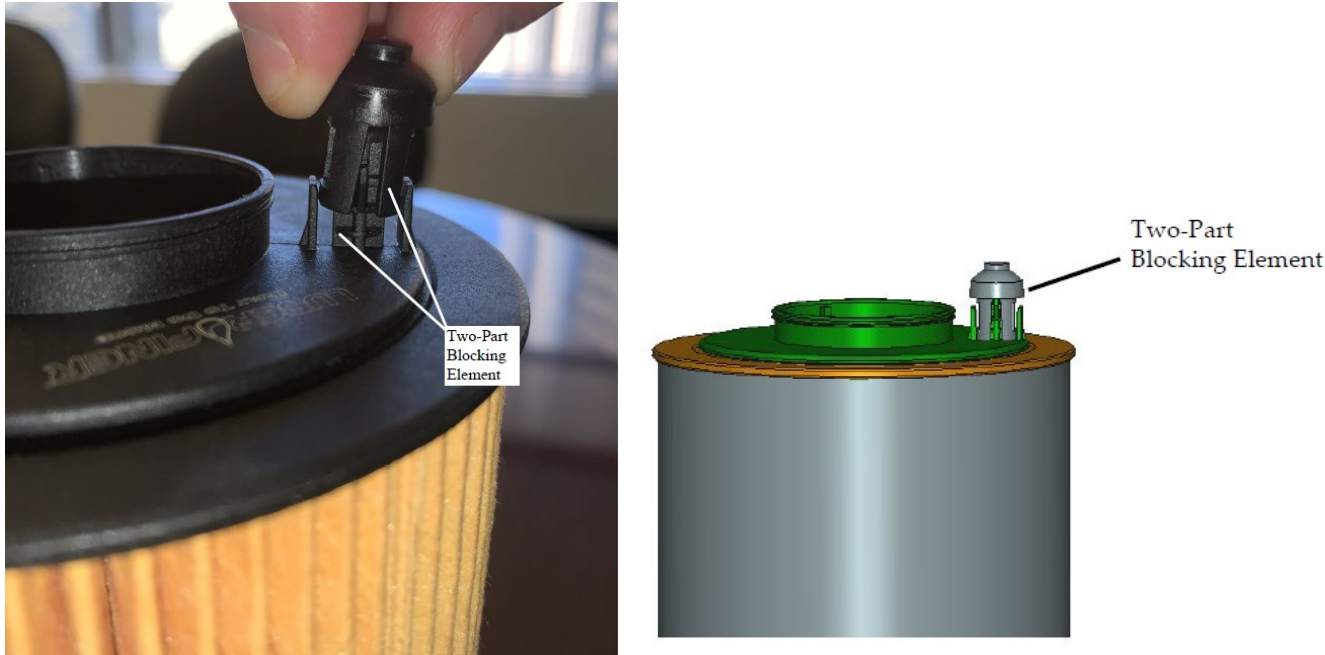


Fig. 8: Accused Product Axially Sealing Valve Element

Claim 28 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
The ring filter insert according to claim 15, wherein the blocking element is formed from two parts, the two parts of the blocking element being engaged with each other in a manner allowing a compensation of radial dimension tolerances and angle errors.	As shown in Fig. 7, reproduced below, the blocking element is formed from two parts. The two-part blocking element is provided to allowing a compensation of radial dimension tolerances and angle errors during installation.  Fig. 7: Accused Product Eccentric Blocking Element
Claim 30 of U.S. Patent No. 9,023,203	Accused Product (LP6044)
The ring filter insert according to claim 15, wherein the protruding nose protrudes radially.	As shown in Fig. 3, reproduced below, the protruding nose of the Accused Product ring filter insert protrudes radially.

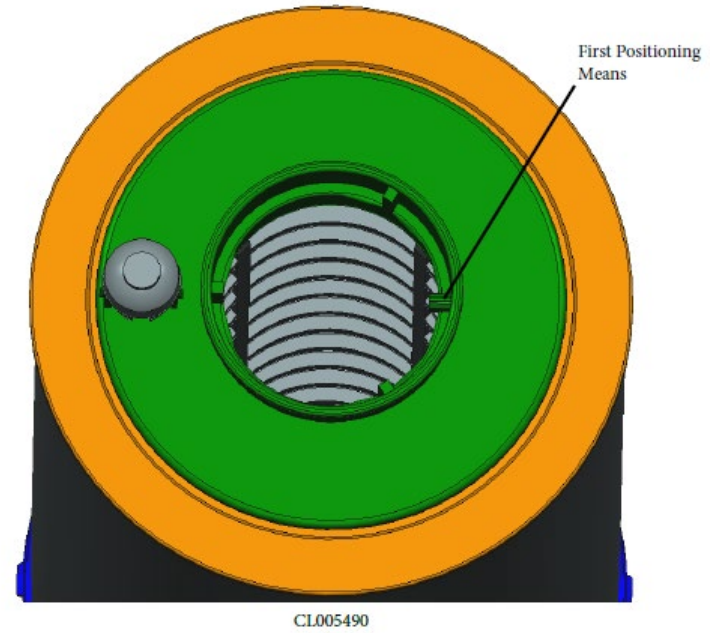
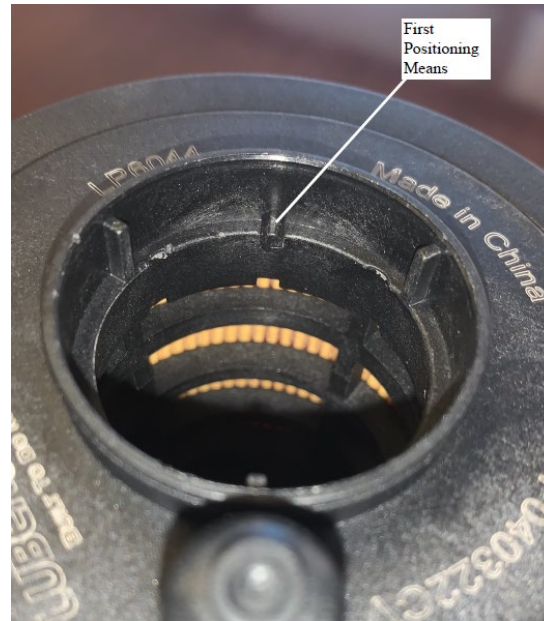


Fig. 3: Accused Product Positioning Means