

**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 RESPONSIVE CLAIM CONSTRUCTION BRIEF

TABLE OF CONTENTS

I. INTRODUCTION	1
II. BACKGROUND	1
A. The ‘203 Patent	1
B. The Positions of the Parties.....	2
III. LEGAL STANDARDS	2
IV. DISPUTED CLAIM PHRASE: “ROTATING THE RING FILTER INSERT RELATIVE TO THE FILTER HOUSING”	4
A. Hengst’s Construction is Supported by the Language of the Specification and Claims	5
B. Champion’s Construction is at Odds with the Language of the Specification and Claims	7
V. CONCLUSION.....	9

TABLE OF AUTHORITIES

Cases

<i>ACTV, Inc. v. Walt Disney Co.</i> , 346 F.3d 1082 (Fed. Cir. 2003).....	3
<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996)	2
<i>Multiform Desiccants, Inc. v. Medzam, Ltd.</i> , 133 F.3d 1473 (Fed. Cir. 1998)	4
<i>Not Dead Yet Mfg., Inc. v. Pride Sols., LLC</i> , 2015 WL 5829761 (N.D. Ill. Oct. 5, 2015)	7
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	3, 5, 6
<i>Source Vagabond Sys. Ltd. v. Hydrapak, Inc.</i> , 753 F.3d 1291 (Fed. Cir. 2014)	4
<i>Standard Oil Co. v. Am. Cyanamid Co.</i> , 774 F.2d 448 (Fed. Cir. 1985).....	3
<i>Teleflex, Inc. v. Ficosa N. Am. Corp.</i> , 299 F.3d 1313 (Fed. Cir. 2002).....	3
<i>Vitronics Corp. v. Conceptoronic, Inc.</i> , 90 F.3d 1576 (Fed. Cir. 1996)	3, 4

I. INTRODUCTION

In this action, Plaintiff Hengst SE (“Hengst” or “Plaintiff”) asserts that Defendant Champion Laboratories, Inc. (“Champion” or “Defendant”) is infringing claims of its U.S. Patent No. 9,023,203 (the “‘203 Patent”). Exhibit A to Champion’s Opening Claim Construction Brief [30-2]. Pursuant to Local Patent Rule (“LPR”) 4.2, Plaintiff, by and through its undersigned counsel, submits the following response to Champion’s Opening Claim Construction Brief. *See* Champion’s Opening Claim Construction Brief [30].

II. BACKGROUND

A. The ‘203 Patent

The ‘203 Patent is directed towards a ring filter insert for use in an oil filter of an internal combustion engine. [30-2] at col. 1, ln. 5-24. An issue found in some filter inserts of the prior art is that “an operator must actively establish the correct rotational position” of the filter insert during installation due to a blocking element on the filter insert. [30-2] at col. 3, ln 43-47. The ‘203 Patent addresses this issue:

“By rotating the ring filter insert about itself, which might be necessary, the positioning means guide the [eccentric] blocking element arranged thereon to the outlet in an engagement-compatible manner as soon as the positioning means come into contact with each other. Special attention of the operator, who installs the filter insert, is not required hereby, whereby installation errors are virtually eliminated.”

[30-2] at col. 3, ln 6-13. Specifically, the ‘203 Patent provides a ring filter insert having positioning means which allow for “the filter insert [to be] brought into its engagement-compatible rotational position for the [eccentric] blocking element relative to the outlet.” [30-2] at col. 3, ln 31-35.

In other words, the invention has a self-alignment feature not previously disclosed in the prior art. This feature thereby requires minimal effort on the part of an individual to manually

install the filter insert into the engine, which in turn exponentially reduces the risk of installation errors.

B. The Positions of the Parties

Pursuant to LPR 4.1(b), the parties identified the following claim terms and phrases in asserted Claim 15 for construction: (1) panel; and (2) rotating the ring filter insert relative to the filter housing. Though originally disputed, Champion has since agreed that the recitation “panel” in Claim 15 should be construed as a “covering structure formed from one or more elements.” *See* [30] at p. 4, footnote 3. Accordingly, Hengst respectfully requests that the Court adopt the parties’ agreed construction for the term “panel” in Claim 15 as a “covering structure formed from one or more elements.”

Thus, “rotating the ring filter insert relative to the filter housing” is the only remaining disputed phrase of Claim 15. For the reasons detailed below, the Court should reject Champion’s proposed constructions and adopt Hengst’s proposed construction: “twisting or spinning at least a portion of the ring filter insert relative to the filter housing.” The table below identifies the disputed claim phrase and the parties’ respective proposed constructions.

Disputed Phrase	Hengst’s Construction	Champion’s Construction
“rotating the ring filter insert relative to the filter housing” (Claim 15)	Twisting or spinning at least a portion of the ring filter insert relative to the filter housing	Rotating the ring filter insert, which comprises the hollow-cylindrical filter material body surrounded on front sides by top and bottom front panels, relative to the filter housing

III. LEGAL STANDARDS

Claim construction is a question of law for the Court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996). Claim terms “are generally given their ordinary and customary

meaning.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). “[T]he ordinary and customary meaning . . . is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005). A person of ordinary skill in the art is assumed to read the claim term in the context of the entire patent. *Id.*

“[T]he claims define the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim.” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002) (cleaned up); *see also Phillips*, 415 F.3d at 1312. The context in which a term appears in a claim is instructive, and “[b]ecause claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.” *Phillips*, 415 F.3d at 1314. “Differences among claims can also be a useful guide in understanding the meaning of particular claim terms.” *Id.*

Moreover, “[t]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims.” *Id.* at 1315 (quoting *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985)). In addition, “the prosecution history can often inform the meaning of the claim language.” *Phillips*, 415 F.3d at 1317.

“While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms.” *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003). Moreover, “it is well established that when a general term is used to introduce a concept that is further defined more narrowly, the general term must be understood in the context

in which the inventor presents it.” *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Finally, extrinsic evidence, such as dictionaries and expert testimony, may be used only if the intrinsic evidence alone is insufficient to determine the meaning of the claim terms. *Vitronics*, 90 F.3d at 1583.

IV. DISPUTED CLAIM PHRASE: “ROTATING THE RING FILTER INSERT RELATIVE TO THE FILTER HOUSING”

Champion requests the Court to improperly add language to claim 15 in order to support its proposed construction. Specifically, Claim 15 does not recite “rotating the entire ring filter insert,” ([30] at p. 1) and this Court should not redraft the claim. *See Source Vagabond Sys. Ltd. v. Hydrapak, Inc.*, 753 F.3d 1291, 1299–300 (Fed. Cir. 2014) (“an ‘analysis’ that adds words to the claim language [without support in the intrinsic evidence] in order to support a claim of infringement does not follow standard canons of claim construction”) (internal quotations omitted). Hengst’s construction is supported by the Specification and Claims and should be interpreted consist with same.

As will be also discussed, Champion’s proposed construction also incorrectly describes the structure of the filter insert where it omits the “eccentric blocking element.” *See* [30] at p. 4. Thus, Champion’s construction fails to consider that the entire purpose of the filter insert’s rotation is to bring the eccentric blocking element of the filter insert into its necessary position. As such, the Court should instead adopt Hengst’s proposed construction because the Specification of the ‘203 Patent makes clear that the purpose of the claimed rotation is to align the eccentric blocking element within the housing, and the surrounding language in Claim 15 confirms Hengst’s position.

A. Hengst's Construction is Supported by the Language of the Specification and Claims

"The specification is, thus, the primary basis for construing the claims." *Phillips*, 415 F.3d at 1314. As the Specification repeatedly describes and shows in the Figures, the claimed rotation occurs such that the eccentric blocking element of the filter insert is aligned with the eccentric opening in the housing. For example, the Specification states rotation occurs when "the positioning means guide the blocking element arranged thereon to the outlet in an engagement-compatible manner as soon as the positioning means come into contact with each other." [30-2] at col. 3, ln 6-11.

The Specification also discloses the following:

"The engagement-compatible merging of blocking element and outlet is possible with the minimally possible rotation of the ring filter insert, because the latter must perform maximally half a rotation. This once again facilitates and speeds up the installation of the filter insert into the filter housing." ([30-2] at col. 3, ln. 21-26);

"...it is attained with this that the filter insert is brought into its engagement-compatible rotational position for the blocking element relative to the outlet virtually solely by means of the force of gravity." ([30-2] at col. 3, ln. 31-35);

"Independent on the rotational position, which the filter insert 2 has at the onset of being inserted into the filter housing 10, the inclined plane 3 and the nose 4 as positioning means bring the ring filter insert 2 accurately into the engagement-compatible rotational position, in which the blocking element 24 is brought into engagement with the seat 14." ([30-2] at col. 7, ln. 17-22); and,

"When the filter insert 2 encompasses a rotational position, which does not match for the engagement of the blocking element 24 with the corresponding seat 14 in response to the installation of the filter insert 2, the nose 4 initially impacts the inclined plane 3, here one of its partial planes 3.1 or 3.2. In response to a further downwards movement, the front panel 22 is inevitably brought into the correct rotation." ([30-2] at col. 8, ln. 38-42).

The Specification therefore supports Hengst's proposed construction that "rotating the ring filter insert relative to the filter housing" means twisting or spinning at least a portion of the ring

filter insert relative to the filter housing.

Indeed, the surrounding claim language affirms Hengst's proposed construction. *See ACTV, Inc.*, 346 F.3d at 1088 (Fed. Cir. 2003) ("the context of the surrounding words of the claim also must be considered"). Claim 15 is shown below with the relevant surrounding claim language highlighted.

15. 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, an eccentric blocking element arranged on the bottom front panel for engaging an eccentric opening in the filter housing, 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, 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, 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, the first positioning means being one of embodied and arranged on an inner circumference of the ring filter insert.

[30-2] at col. 17, ln. 37-59.

As shown above, Claim 15 refers to the engagement between the eccentric blocking element and the opening on three separate instances, including the clause immediately preceding the disputed claim phrase. Specifically, the entire clause of Claim 15 which contains the dispute phrase states as follows:

...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,***

[30-2] at col. 17, ln. 53-57 (emphasis added).

Thus, the Claim (and Specification) makes clear that rotation allows for the alignment eccentric blocking element of the filter insert.

A person of ordinary skill in the art would understand the Specification's emphasis on the alignment of the eccentric blocking element and recognize that the eccentric blocking element is the essential portion of the filter insert that is to be rotated. Indeed, this Court in *Not Dead Yet Mfg., Inc. v. Pride Sols., LLC*, 2015 WL 5829761, at *15 (N.D. Ill. Oct. 5, 2015) addressed a claim construction “dispute over whether the patent requires the entire plate member, as opposed to a portion of the plate member” to be “above” a pair of holes. This Court construed the disputed claim phrase to mean that a portion of the plate member was required to be above said pair of holes, where the claim language did not specifically recite the entire plate member. *Id.*

Similar to *Not Dead Yet Mfg., Inc.*, Claim 15 here does not explicitly state that the entire ring filter insert must be rotated relative to the filter housing. The Specification and surrounding language of Claim 15 clearly requires only that a portion of the filter insert, *i.e.* the eccentric blocking element, be rotated relative to the filter housing. In other words, rotating at least the eccentric blocking element, or a portion of the filter element, is rotating the filter element. This construction best aligns with the language of the Claim and is supported by the Specification.

B. Champion's Construction is at Odds with the Language of the Specification and Claims

Champion's proposed claim construction fails to sufficiently describe the structure of the filter insert and ignores the essential feature of the filter insert that must be aligned.

Claim 15 is directed towards a ring filter insert generally having three positively recited structural components: a hollow-cylindrical filter material body, an eccentric blocking element, and first positioning means. These positively recited structural components are shown below.

15. 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, an eccentric blocking element arranged on the bottom front panel for engaging an eccentric opening in the filter housing, 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, 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, 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, the first positioning means being one of embodied and arranged on an inner circumference of the ring filter insert.

[30-2] at col. 17, ln. 37-59.

Champion's proposed construction, "rotating the ring filter insert, which comprises the hollow-cylindrical filter material body surrounded on front sides by top and bottom front panels, relative to the filter housing," includes only the filter insert's hollow-cylindrical filter material body. [30] at p. 4. Thus, Champion's structural description of the filter insert omits the fundamental element, *i.e.* the eccentric blocking element, that needs to be aligned. No person of ordinary skill in the art would interpret the disputed claim phrase in such a way that the rotation is independent of or unrelated to the eccentric blocking element.

In fact, by ignoring the eccentric blocking element, Champion's description of the filter insert's structure actually aligns with Hengst's position. That is, Champion's construction omits two of the positively recited elements (the eccentric blocking element and first positioning means) of the claimed filter element. Therefore, by only referring to some of the features of the filter insert, Champion argues that only a portion of the filter insert rotates, *i.e.* the hollow-cylindrical

filter material body surrounded on front sides by top and bottom front panels, as opposed to all of the elements of the filter insert. This inconsistent logic renders Champion's proposed construction faulty.

In sum, because Hengst's proposed construction is consistent with the intrinsic evidence, it should be adopted by the Court.

V. **CONCLUSION**

Accordingly, the Court should adopt Hengst's proposed construction for the reasons detailed above.

Dated this 4th day of June 2024.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on the 4th day of June 2024, I will electronically file the foregoing with the Clerk of the Court using the CM/ECF system. The CM/ECF system will send a “Notice of E-Filing” to the attorneys of record in this case.

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