

**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

JOINT STATUS REPORT

In furtherance of the Minute Entry dated February 13, 2023 [9], Plaintiff Hengst SE (“Hengst” or “Plaintiff”), by and through its undersigned counsel, and Defendant Champion Laboratories, Inc. (“Champion” or “Defendant”) (collectively “Parties”), by and through its undersigned counsel, submit this Joint Status Report.

(1) Nature of the Case

A. Attorneys of Record

Hengst SE is represented by Kevin W. Guynn (lead counsel), Patrick J. Smith, Justin T. Joseph, and Andrew D. Burnham from Greer, Burns & Crain, Ltd in Chicago, Illinois. Defendant Champion Laboratories, Inc. is represented by David A. Nelson (lead counsel), James M. Glass, and Mathew D. Robson from Quinn Emanuel Urquhart & Sullivan, LLP in New York, New York.

B. Nature of Claims Asserted

Plaintiff states as follows: Hengst claims that Champion is making, using, selling, offering for sale, and/or importing a replaceable filter insert that infringes one or more claims of United

States Patent No. 9,023,203 (the “’203 Patent”), which is owned by Hengst. The filter insert is used in a filter that is for oil in a vehicle.

Defendant states as follows: Champion denies that it or its products infringe any valid and enforceable claim of the ’203 Patent.

C. Major Legal and Factual Issues Anticipated in this Case

The Parties anticipate the legal and factual issues in this case will relate to Champion’s liability or lack of liability for patent infringement, any corresponding damages amount, and the validity and enforceability of the ’203 Patent.

D. State the Relief Sought

Plaintiff states as follows: Hengst seeks a declaration that Champion has infringed the ’698 Patent. Hengst seeks such damages as it shall prove at trial against Champion that is adequate to compensate Hengst for infringement of the ’203 Patent, with prejudgment and post-judgment interest. Hengst seeks trebled damages for the willful, deliberate, and intentional infringement by Champion as alleged in the Complaint [1] in accordance with 35 U.S.C. § 284. Hengst further seeks injunctive relief, attorney’s fees, costs, and other further relief as deemed proper by the Court.

Defendant states as follows: Defendant contends that it does not infringe any claim of the ’203 Patent, and that the claims of the ’203 Patent are invalid and unenforceable. Accordingly, Defendant contends that Plaintiff is not entitled to any relief sought in the Complaint or otherwise.

(2) Basis for Federal Jurisdiction

This court has original subject matter jurisdiction over the claims in this action pursuant to 28 U.S.C. §§ 1331 and 1338.

(3) Status of Service

On February 13, 2023, Champion waived service of a summons. [10]. Champion confirmed that on February 9, 2023, it was in receipt of the request to waive service. [10].

(4) Consent to Proceed Before a United States Magistrate Judge

The Parties have informed their clients about the possibility of proceeding before the assigned Magistrate Judge. The Parties do not unanimously consent to proceed before a Magistrate Judge.

(5) Motions

A. Pending Motions

There are currently no pending motions in this matter.

B. State Whether Defendant Anticipates Responding to the Complaint by Filing an Answer or by Means of Motion

Defendant currently anticipates submitting an Answer to the Complaint.

(6) Case Plan

A. Proposed Discovery Plan

1. General Type of Discovery Needed

The Parties anticipate taking discovery on Champion's sales of the allegedly infringing product, Champion's knowledge of the patent-in-suit, Hengst's conception of the alleged invention, claim construction, and discovery regarding the invalidity and unenforceability of the asserted patent. The Parties may also seek third-party discovery regarding prior art. Such discovery will potentially be electronic discovery.

2. Proposed Discovery Plan and Case Schedule

The parties propose the following pretrial case schedule:

Event	Agreed Dates
Date for Rule 26(a)(1) Disclosures	May 8, 2023
First Date by Which to Issue Written Discovery	May 24, 2023
Close of Fact Discovery	December 26, 2023
Expert Disclosure Report Deadline	To be determined by ruling date
Expert Discovery Completion Date	To be determined by ruling date
Deadline for Filing of Dispositive Motions	To be determined by ruling date

B. Trial

A jury trial is requested, and the Parties anticipate that 5-7 days will be required for a trial.

(7) Status of Settlement Discussions

A. Settlement Discussions

Prior to the present lawsuit being filed, the Parties had some discussions regarding another patent dispute, but they did not discuss settlement.

B. Status of Settlement Discussions

Prior to the present lawsuit being filed, the Parties had some discussions regarding another patent dispute, but they did not discuss settlement.

C. Whether The Parties Request a Settlement Conference.

The Parties do not request a settlement conference at this time.

Dated this 4th day of April 2023.

Respectfully submitted,

/s/ Justin T. Joseph

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HENGST SE,

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CHAMPION LABORATORIES, INC.,

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Case No. 23-cv-00794

Judge Sara L. Ellis

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LOCAL PATENT RULE SCHEDULING ORDER

In furtherance of Local Patent Rule 1.2, Plaintiff Hengst SE (“Hengst” or “Plaintiff”), by and through its undersigned counsel, and Defendant Champion Laboratories, Inc. (“Defendant”) (collectively “Parties”), by and through their undersigned counsel, submit this scheduling order.

1. The following persons participated in a Rule 26(f) conference on April 4, 2023, by telephone:

Patrick J. Smith and Justin T. Joseph representing Hengst; and,
Matthew Robson, representing Defendant.

2. Initial Disclosures.

The Parties will complete, by **May 8, 2023**, the initial disclosures required by Rule 26(a)(1), assuming that the Defendant files an Answer to the Complaint by April 10, 2023.

3. Disclosures and Discovery Pursuant to Local Patent Rules.

The Parties acknowledge that the requirements of the Local Patent Rules apply to this case.

4. Additional Discovery Plan.

The Parties propose the following in addition to the discovery plan and schedules addressed in the Local Patent Rules:

(a) <Maximum number of interrogatories by each party to another party, along with the dates the answers are due.>

The Parties agree that this number shall be 25 and answers shall, unless agreed or ordered otherwise, be due 30 days after service of the interrogatories.

(b) <Maximum number of requests for admission, along with the dates responses are due.>

The Parties agree that this number shall be 100 and answers shall, unless agreed or ordered otherwise, be due 30 days after service of the requests for admission.

(c) <Maximum number of factual depositions by each party.>

The Parties agree that this number shall be 8.

(d) <Limits on the length of depositions, in hours.>

The Parties agree that this number shall be 6 hours (on the record).

(e) Discovery is permitted with respect to claims of willful infringement and defenses of patent invalidity or unenforceability not pleaded by a party, where the evidence needed to support these claims or defenses is in whole or in part in the hands of another party.

5. Alternative Discovery Plan.

The Parties propose a discovery plan that follows that provided in the Local Patent Rules, but for a 2 week extension on the deadline for LPR 2.1 and Rule 26(a)(1) initial disclosures.

6. Other Dates:

(a) <Dates for supplementations under Rule 26(e).>

28 days after a claim construction ruling (see schedule below).

(b) <A date if the parties ask to meet with the court before a scheduling order.>

None.

(c) <Requested dates for pretrial conferences.>

March 2025 (based on Claim Construction Order)

(d) <Final dates for the plaintiff to amend pleadings or to join parties.>

October 14, 2023

(e) <Final dates for the defendant to amend pleadings or to join parties.>

November 14, 2023

(f) <Final dates for submitting Rule 26(a)(3) witness lists, designations of witnesses whose testimony will be presented by deposition, and exhibit lists.>

30 days before trial.

(g) <Final dates to file objections under Rule 26(a)(3).>

14 days after service of Rule 26(a)(3) information that is being objected to.

7. Other Items:

(a) <State the prospects for settlement.>

The Parties have not had any settlement discussions.

(b) <Identify any alternative dispute resolution procedure that may enhance settlement prospects.>

Currently, none.

(c) Communications between a party's attorney and a testifying expert relating to the issues on which he/she opines, or to the basis or grounds in support of or countering the opinion, are subject to discovery by the opposing party only to the extent provided in Rule 26(b)(4)(B) and (C).

(d) In responding to discovery requests, each party shall construe broadly terms of art used in the patent field (e.g., “prior art”, “best mode”, “on sale”), and read them as requesting discovery relating to the issue as opposed to a particular definition of the term used. Compliance with this provision is not satisfied by the respondent including a specific definition of the term in its response and limiting the response to that definition.

(e) The Parties **agree** the video “The Patent Process: An Overview for Jurors” or any subsequent version of same distributed by the Federal Judicial Center, should be shown to the jurors in connection with its preliminary jury instructions.

(f) The Parties **agree** that the provisions of Sections 3A, B and C of the America Invents Act concerning the revisions to 35 U.S.C. §§ 102 and 103 **do not** apply to all patents-in-suit in this case.

(g) Per Local Patent Rule 3.5, advise with respect to each patent in suit (1) whether the patent is eligible to be challenged at the USPTO by each defendant, (2) what form such a challenge may take (inter parties review, post grant review, covered business method review, ex parte reexamination, etc.), (3) the earliest and latest date such a challenge is permitted to be made for each defendant, (4) whether the patents in suit have been the subject of prior USPTO reviews and, if so, the status of the same, and (5) any other prior litigation history of the patents in suit and the status of the same.

For U.S. Pat. No. 9,023,203, the only patent-in-suit:

- (1) is eligible to be challenged at the USPTO by the Defendant;
- (2) possible challenges include inter parties review and ex parte reexamination;
- (3) any challenge may be brought now, and the deadline for Defendant to bring an inter partes review is February 9, 2024;
- (4) there have been no prior USPTO reviews of the patent-in-suit; and,
- (5) there has been one (1) prior lawsuit involving the patent-in-suit (N.D. Il. 22-cv-06134) which was dismissed without prejudice on February 22, 2023 and re-filed as the present case.

(h) Each party that has a drug or biologic application pending with the Food and Drug Administration (“FDA”) that is the basis of the pending case, shall provide a copy of all correspondence between itself and the FDA pertaining to the application to each party asserting infringement, or set forth the basis of any claim that any such correspondence is not discoverable, no later than fourteen (14) days after the date it sends same to the FDA or receives same from the FDA.

Not applicable.

(i) Other items – Local Patent Rules Schedule

1	Answer to Complaint		4/10/2023
2 (LPR 2.1)	Initial Disclosures	28 days from Answer	5/8/2023
3 (LPR 2.2)	Initial Infringement Contentions	14 days after Initial Disclosures (#2)	5/22/2023
4 (LPR 2.3)	Initial Non-Infringement, Unenforceability and Invalidity Contentions	14 days after Initial Infringement Contentions (#3)	6/5/2023
5 (LPR 2.5)	Initial Response to Non-Infringement and Invalidity Contentions	14 days after Initial Non-Infringement and Invalidity Contentions (#4)	6/20/2023
6 (LPR 3.1.a)	Final Infringement Contentions	a. (List) Within 19 weeks after Initial Infringement Contentions (#3)	List: 10/2/2023
		b. (Table) Within 21 weeks after Initial Infringement Contentions (#3)	Table: 10/16/2023
7 (LPR 3.1.b)	Final Unenforceability and Invalidity Contentions	Same time as Final Infringement Contentions above	10/16/2023
8 (LPR 3.2)	Final Non-Infringement, Contentions	28 days after Final Infringement Contentions (#6b)	11/13/2023

9 (LPR 3.2)	Final Enforceability and Validity Contentions	28 days after Final Infringement Contentions (#6b)	11/13/2023
10 (LPR 4.1.a.)	Exchange Claim Construction Lists, Terms, etc.	14 days from Final Contentions (#8)	11/27/2023
11 (LPR 4.1.b)	Meet and confer on Claim Terms	7 days from Exchange of Claim Terms (#10)	12/4/2023
12 (LPR 1.3)	Close of Fact Discovery	28 days from Exchange of Claim Terms (#10)	12/26/2023
13 (LPR 4.2.a.)	Defendant's Opening Claim Construction Brief	35 days after exchange of Terms (#10)	1/2/2024
14 (LPR 4.2.b.)	Joint Appendix	35 days after exchange of Terms (#10)	1/2/2024
15 (LPR 4.2.c.)	Plaintiff's Responsive Claim Construction Brief	28 days after Opening Claim Construction (#13)	1/30/2024
16 (LPR 4.2.d.)	Defendant's Reply Claim Construction Brief	14 days after Responsive Claim Construction Brief (#15)	2/13/2024
17 (LPR 4.2.f)	Joint Claim Construction Chart	7 days after Reply Claim Construction Brief (#16)	2/20/2024
18 (LPR 4.3)	Claim Construction Hearing	28 days after Reply Claim Construction Brief (#16)	To be determined by Court
19 (LPR 5.1.b.)	Expert Witness Disclosures	28 days after Claim Construction Ruling or close of discovery after claim construction ruling	To be determined by ruling date
20 (LPR 5.1.c)	Rebuttal Expert Witness Disclosures	28 days after Initial Expert Witness Disclosures (#19)	To be determined by ruling date
21 (LPR 5.2.)	Depositions of Expert Witnesses	28 days after Rebuttal Expert Witness Disclosures (#20)	To be determined by ruling date

22 (LPR 6.1)	Dispositive Motions	28 days after scheduled date for end of Expert discovery (#21)	To be determined by ruling date
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Dated this 4th day of April 2023.

Respectfully submitted,

/s/ Justin T. Joseph

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**UNITED STATES DISTRICT COURT
FOR THE Northern District of Illinois – CM/ECF NextGen 1.7.1.1
Eastern Division**

HENGST SE

Plaintiff,

v.

Case No.: 1:23-cv-00794

Honorable Sara L. Ellis

Champion Laboratories, Inc.

Defendant.

NOTIFICATION OF DOCKET ENTRY

This docket entry was made by the Clerk on Monday, April 10, 2023:

MINUTE entry before the Honorable Sara L. Ellis: The Court strikes the status date set for 4/11/2023 and resets it to 3/22/2024 at 10:00 a.m. for the claim construction hearing. The Court sets the following discovery schedule: initial disclosures are due by 5/8/2023; initial infringement contentions are due by 5/22/2023; initial non-infringement, unenforceability and invalidity contentions are due by 6/5/2023; initial response to non-infringement and invalidity contentions is due by 6/20/2023; final infringement contentions are due by 10/2/2023 (list) and 10/16/2023 (table); final unenforceability and invalidity contentions are due by 10/16/2023; final non-infringement contentions are due by 11/13/2023; final enforceability and validity contentions are due by 11/13/2023; parties to exchange claim construction terms by 11/27/2023; parties to meet and confer on claim terms by 12/4/2023; and fact discovery closes on 12/26/2023. Defendant's opening claim construction brief is due by 1/2/2024; Plaintiff's response is due by 1/30/2024; and Defendant's reply is due by 2/13/2024. The joint claim construction chart is due by 2/20/2024. Mailed notice(rj,)

ATTENTION: This notice is being sent pursuant to Rule 77(d) of the Federal Rules of Civil Procedure or Rule 49(c) of the Federal Rules of Criminal Procedure. It was generated by CM/ECF, the automated docketing system used to maintain the civil and criminal dockets of this District. If a minute order or other document is enclosed, please refer to it for additional information.

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