

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

TMC FUEL INJECTION SYSTEM, LLC	:	CIVIL ACTION
	:	
v.	:	
	:	
FORD MOTOR COMPANY	:	NO. 12-4971

NORMA L. SHAPIRO, J.

APRIL 20, 2016

MEMORANDUM OPINION

Before the court are the Motion for Summary Judgment of Non-Infringement of Ford Motor Company (“Ford”), the opposition brief of TMC Fuel Injection System, LLC (“TMC”), and both parties’ supplemental briefs. Because Ford’s accused vehicles use a pressure regulator and the court accepts the Patent Trial and Appeal Board (“PTAB”) conclusion that the prosecution history of U.S. Patent No. 7,318,414 (“the ‘414 patent”) states an express disclaimer of pressure regulators from the system, Ford’s Motion for Summary Judgment of Non-Infringement will be granted.

I. BACKGROUND

TMC, the owner of the ‘414 patent, filed this action against Ford on August 29, 2012. TMC alleges Ford is infringing claims 38 and 40 of the ‘414 patent. The court issued a claim construction opinion on January 13, 2014. Ford filed a Motion for Summary Judgment of Non-Infringement on May 20, 2014.

Ford filed two petitions for *inter partes* review of claims 38 and 40 with the PTAB of the United States Patent and Trade Office (“PTO”) and, on June 27, 2014, the PTAB instituted an *inter partes* review proceeding under 35 U.S.C. § 318(a) to determine the validity of claims 38 and 40. The court stayed the action pending disposition of the *inter partes* review proceeding.

The PTAB issued a final *inter partes* review opinion on June 22, 2015. The court held oral argument on August 24, 2015, and the parties filed supplemental briefs on summary judgment.

II. DISCUSSION

A. Jurisdiction

The court has subject-matter jurisdiction under 28 U.S.C. §§ 1331; this action arises under 35 U.S.C. §§ 101, *et seq.* Personal jurisdiction and venue are uncontested.

B. Standard of Review

Summary judgment must be granted when "the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." FED. R. CIV. P. 56(A). Summary judgment is as appropriate in a patent action as in any other action. *Barmag Barmer Maschinenfabrik v. Murata Mach., Ltd.*, 731 F.2d 831, 835 (Fed. Cir. 1984). Whether a product infringes a patent is a question of fact. *Dayco Prods., Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 1324 (Fed. Cir. 2001). Summary judgment "can only be granted if, after viewing the alleged facts in the light most favorable to the non-movant, there is no genuine issue whether the accused device is encompassed by the claims." *Id.*

C. The '414 Patent

The '414 patent describes an automobile fuel injection system used to supply fuel from a tank to its engine.¹ Fuel is typically pumped from the tank to the engine through a pipe called a fuel rail.² Excess fuel in an engine is generally pumped back into the tank.³ Two common methods to regulate the amount of fuel going into the engine to prevent heated fuel from returning to the tank are: (1) varying the speed of the fuel pump; and (2) using a pressure regulator.⁴

Claims 38 and 40 of the '414 patent are substantially similar. Claim 38 is reproduced below:

A fuel injection system for delivering pressurized fuel from a fuel supply to fuel injectors of an engine which uses a fuel recirculation loop to minimize or eliminate the need of a hot fuel return line and a low pressure regulator

¹ TMC's Claim Construction Brief (paper no. 40) at 4.

² *Id.*

³ *Id.* at 5.

⁴ *Id.*

comprising:

1. a fuel supply,
2. a fuel rail in fluid communication with at least one fuel injector,
3. a fuel pump having an outlet and an inlet, the inlet being connected to the fuel supply and driven at a substantially constant speed,
4. a main fuel supply line connected from the outlet of the fuel pump to the fuel rail in fluid communication with the [sic] at least one fuel injector,
5. a fuel return path with flow constraint, connected from some location in the main fuel supply line, including the outlet of the fuel pump, avoiding fuel rail to some location in the fuel supply including the inlet of the fuel pump, allowing fuel recirculation to stabilize the pump operation, and creating stable fuel pressure.⁵

D. Ford's Accused Vehicles

Ford's vehicles allegedly infringing claims 38 and 40 use a fuel injection system to deliver pressurized fuel from a fuel supply to fuel injectors of an engine.⁶ They use a pressure regulator in the fuel delivery module to create a largely constant pressure in the fuel system.⁷

E. The *Inter Partes* Review Opinion

In an *inter partes* review proceeding under 35 U.S.C. § 318(a), a petitioner must prove by a preponderance of the evidence⁸ that one or more claims of a patent are unpatentable under 35 U.S.C. § 102⁹ or § 103.¹⁰ 35 U.S.C. §§ 311, 316(e) (2012 & 2013). There are other grounds for

⁵ U.S. Patent No. 7,318,414 (paper no 1, Ex. A) at 17.

⁶ Ford's Pretrial Memorandum (paper no. 83) at 6.

⁷ *Id.* at 7.

⁸ This is less onerous than the district court's clear and convincing standard of proof for invalidity claims. *Microsoft Corp v. i4i Ltd. P'Ship*, 131 S. Ct. 2238, 2242 (2011).

⁹ "A person shall be entitled to a patent unless- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention." 35 U.S.C. § 102(a)(1)-(2).

¹⁰ "A patent for a claimed invention may not be obtained . . . if the differences between the claimed invention and the prior art are such that 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.

alleging patent invalidity in a civil action, *i.e.*, 35 U.S.C. § 112,¹¹ but only sections 102 and 103 may be raised in an *inter partes* review. 35 U.S.C. § 311. In a civil action arising under 28 U.S.C. § 1338, the petitioner is estopped from raising invalidity claims that were or could have been considered by the PTAB. 35 U.S.C. § 315 (2012).

District courts generally give deference to PTAB *inter partes* review decisions based on the PTAB's specialized patent knowledge and expertise. *Pride Mobility Prods. Corp. v. Permobil, Inc.*, No. 13-01999, 2013 WL 8445809, at *3 (E.D.Pa. Aug. 14, 2013); *Old Reliable Wholesale, Inc. v. Cornell Corp.*, 635 F.3d 539, 548 (Fed. Cir. 2011) (“[T]he PTO has acknowledged expertise in evaluating prior art and assessing patent validity.”); 35 U.S.C. § 6(a) (acknowledging the “legal knowledge and scientific ability” of the PTAB patent judges). The final *inter partes* review opinion may be appealed to the Court of Appeals for the Federal Circuit. 35 U.S.C. § 141 (2012).

In its final *inter partes* review opinion, the PTAB held Ford failed to prove claims 38 and 40 are unpatentable over the prior art patents cited by Ford in this action.¹² Upon reviewing TMC's notes and remarks to the PTO and appeal brief to the PTAB, the PTAB also found the '414 patent's “prosecution history states an express disclaimer of pressure regulators and incremental regulation means of any type from the system.”¹³

F. Ford's Motion for Summary Judgment of Non-Infringement

In its notes and remarks to the PTO and appeal brief to the PTAB, TMC repeatedly, unequivocally stated its system does not use a pressure regulator¹⁴ and distinguished its invention from prior art using a pressure regulator.¹⁵ The court accepts the PTAB conclusion that claims 38 and 40 cannot cover a system with a pressure regulator because the prosecution history states

¹¹ "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention." 35 U.S.C. § 112(a).

¹² Final Inter Partes Review Decision (paper no. 128) at 42.

¹³ *Id.* at 15-23.

¹⁴ Prosecution History of U.S. Patent No. 7,318,414, (“Prosecution History”) (paper no. 38) at DOCs 171, 279, 287, 290, 338, 370, 494, 497.

¹⁵ *Id.* at DOCs at 169, 171, 288-290, 369-70, 402, 502-03.

an express disclaimer of pressure regulators.

In its claim construction opinion, the court concluded the language of claim 38, “[m]inimize or eliminate the need of . . . a low pressure regulator,” supports the position that a pressure regulator may be present because “[t]o minimize or eliminate the need for a component is not equivalent to the elimination of that component altogether.”¹⁶ The court reached this conclusion by examining only the words of the claims and the specification.¹⁷ The court did not consider the prosecution history; when construing claims, district courts “should also consider the patent’s prosecution history,” *Trustees of Columbia Univ. in City of New York v. Symantec Corp.*, 811 F.3d 1359, 1362-63 (Fed. Cir. 2016) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005)). The court amends its construction of the claims to exclude pressure regulators of any type from the system.

Ford’s accused vehicles use a pressure regulator.¹⁸ Because claims 38 and 40 cannot cover systems with a pressure regulator, the claims do not cover Ford’s accused vehicles. TMC’s infringement claim will be dismissed.

III. CONCLUSION

Ford’s Motion for Summary Judgment of Non-Infringement will be granted. An appropriate Order follows.

¹⁶ January 13, 2014, Memorandum (paper no. 55) at 8.

¹⁷ *Id.* at 7.

¹⁸ Ford’s Pretrial Memorandum (paper no. 83) at 6-7; TMC’s Pretrial Memorandum (paper no. 64) at 12.

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v.	:	
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FORD MOTOR COMPANY	:	NO. 12-4971

ORDER

AND NOW, this 20th day of April, 2016, after consideration of the Motion for Summary Judgment of Non-Infringement of Ford Motor Company (“Ford”), the opposition brief of TMC Fuel Injection System, LLC (“TMC”), both parties’ supplemental briefs, and the Patent Trial and Appeal Board decision dated June 22, 2015, and for the reasons stated in the accompanying memorandum of today’s date, it is **ORDERED** that:

1. Ford’s Motion for Summary Judgment of Non-Infringement (paper no. 86) is **GRANTED**.
2. TMC’s Motion to Exclude Opinion of Ford’s Expert Dr. Gregory Davis (paper no. 62) is **DENIED AS MOOT**.
3. TMC’s Motion to Exclude Opinion of Ford’s Expert Michael H. Chase (paper no. 63) is **DENIED AS MOOT**.
4. Ford’s Motion in Limine to Exclude the Opinions of Walter Bratic and Gerard Muller (paper no. 80) is **DENIED AS MOOT**.
5. Ford’s Motion in Limine to Exclude the Expert Report and Testimony of Gerard Muller (paper no. 81) is **DENIED AS MOOT**.
6. Ford’s Motion to Strike TMC’s New Infringement Contention (paper no. 82) is **DENIED AS MOOT**.
7. Ford’s Daubert Motion to Exclude the Expert Report and Testimony of Walter Bratic (paper no. 85) is **DENIED AS MOOT**.
8. Ford’s Motions in Limine (paper no. 87) is **DENIED AS MOOT**.
9. TMC’s Motion to Exclude Ford from Introducing Testimony from the Inventor Regarding the Meaning of the Claims (paper no. 99) is **DENIED AS MOOT**.
10. TMC’s Motion to Exclude Ford from Mentioning that Third-Party Companies did not Agree to License the Patent-in-Suit (paper no. 100) is **DENIED AS MOOT**.
11. TMC’s Motion to Preclude Ford from Introducing Evidence Concerning Ford Vehicles Not Accused of Infringement (paper no. 101) is **DENIED AS MOOT**.

12. The Clerk of Court shall mark this case **CLOSED**.

/s/ Norma L. Shapiro

Norma L. Shapiro
United States District Judge