

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO

CLIFFORD A. LOWE, *et al.*,

Plaintiffs,

vs.

SHIELDMARK, INC., *et al.*,

Defendants.

:
:
:
:
:
:
:
:

Case No. 1:19-cv-748

OPINION & ORDER

[Resolving Doc. 145]

JAMES S. GWIN, UNITED STATES DISTRICT JUDGE:

For the following reasons, the Court **DENIES** Plaintiffs' motion for judicial recusal pursuant to 28 U.S.C. § 144, 28 U.S.C. § 455(a), and 28 U.S.C. § 455(b)(1).

Sixth Circuit precedent establishes:

Under either § 144 or § 455, "[r]ecusal is mandated ... only if a reasonable person with knowledge of all the facts would conclude that the judge's impartiality might reasonably be questioned." *Easley*, 853 F.2d at 1356 (citations omitted). "A bias sufficient to justify recusal must be a personal bias as distinguished from a judicial one, arising out of the judge's background and association and not from the judge's view of the law." *United States v. Story*, 716 F.2d 1088, 1090 (6th Cir.1983) (internal quotes and citations omitted). Recusal is required if the judge demonstrates personal bias and/or personal knowledge of disputed evidentiary facts from an extrajudicial source other than his participation in the case. *United States v. Hartsel*, 199 F.3d 812 (6th Cir. 1999), *cert. denied*, 529 U.S. 1070 (2000).¹

And, "A judge's prejudice or bias may [. . .] arise during the course of current or prior proceedings."²

In support of their motion seeking recusal, Plaintiffs mostly rely upon Court statements at a recent status conference. In those statements, the Court questioned the reasoning of the Court of Appeals's *Markman* construction.³ The Court regrets that Plaintiffs' perceived bias

¹ *United States v. Surapaneni*, 14 F. App'x 334, 337 (6th Cir. 2001).

² *United States v. Lanier*, 748 F. App'x 674, 676–77 (6th Cir. 2018) (citations omitted).

³ Unless there are special circumstances, court reporters do not attend status conferences but they are "on-call" should their assistance become necessary.

Case No. 1:19-cv-748
Gwin, J.

from these comments. While the Court disagreed with the appellate court's decision, the Court recognizes that it is bound by the Court of Appeals mandate. Plaintiffs' contention that the Court signaled "a proclivity to again rule for Defendants"⁴ at the conference is unfounded.

The Court also recognizes that it mistakenly said during the status conference that Defendants' expert substitution motion had been fully briefed. After the conference, the Court asked Plaintiffs to file an opposition. The Court considered those filings and then issued a written order and opinion.⁵

Plaintiffs also point to the Court's disagreements with Plaintiffs' recommended post-remand trial scheduling order.⁶ That Plaintiffs believe the Court did not adequately take into account the Local Patent Rules is not grounds for recusal.

In addition, Plaintiffs suggest portions⁷ of the *Markman* hearing evince the Court's bias.⁸ The Court has reviewed the hearing transcript and disagrees. Although the parties did not submit briefing on means-plus-function, the Court asked whether means-plus-function applied to better understand the claims. Ultimately, the Court did not offer means-plus-function analysis in the claim construction order. Separately, the Court did express frustration with Plaintiffs' counsel for his phrasing of an argument during that hearing, but this was a minor issue in a substantive hour-and-a-half-long proceeding.

⁴ Doc. 145-1 at 3.

⁵ Doc. 134.

⁶ Doc. 131.

⁷ The Court's questions on means-plus-function came from the '664 patent itself. Independent Claim 1 describes, in part: "1. A floor marking tape adhered to a floor wherein the floor marking tape establishes a boundary on the floor; the combination comprising" '664 Patent, col. 5 ll. 2-4. Although the parties did not claim the patent as a means-plus-function patent, the claims gave some implication that they might be in means-plus-function format.

⁸ Doc. 64.

Case: 1:19-cv-00748-JG Doc #: 152 Filed: 06/29/22 3 of 3. PageID #: 5872

Case No. 1:19-cv-748
Gwin, J.

Lastly, Plaintiffs allege that the Court's position with the Kathleen M. O'Malley American Inn of Court is the source of certain bias. The Court does not completely understand this argument. However, as discussed above, the Court has no investment—personal or otherwise—in the outcome of this case, and the association with the Inn of Court presents no conflict of interest, or other appropriate recusal grounds.

IT IS SO ORDERED

Dated: June 29, 2022

/s/ James S. Gwin
JAMES S. GWIN
UNITED STATES DISTRICT JUDGE

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO

CLIFFORD A. LOWE, <i>et al.</i> ,	:	
	:	Case No. 1:19-cv-748
Plaintiffs,	:	
vs.	:	OPINION & ORDER
	:	[Resolving Docs. 148 & 169]
SHIELDMARK, INC., <i>et al.</i> ,	:	
	:	
Defendants.	:	

JAMES S. GWIN, UNITED STATES DISTRICT JUDGE:

With this opinion, the Court primarily considers whether Plaintiffs Clifford Lowe and InSite Solutions, LLC (“Insite North Carolina”) continue to have standing for this patent infringement lawsuit.

When Plaintiffs first brought this case, Lowe owned the relevant patent and InSite North Carolina owned an exclusive license. But in December 2021, and while Plaintiffs’ appeal was pending before the U.S. Court of Appeals for the Federal Circuit, Lowe sold his patent ownership to InSite North Carolina. Then, a week later, InSite North Carolina gave InSite Delaware—not a party in this case—a paid-up, permanent, and irrevocable, but non-exclusive, license.

InSite North Carolina’s license to InSite Delaware made no restrictions on InSite Delaware’s ability to sublicense the patent. While acknowledging that Lowe had earlier given InSite North Carolina all patent rights, Lowe alleges that InSite North Carolina granted Plaintiff Lowe a right to continue this litigation.

Because the Court finds that Plaintiffs Lowe and InSite Solutions, LLC (“InSite North Carolina”) do not have this patent’s exclusionary rights, they lack standing to continue this

Case No. 1:19-cv-748
Gwin, J.

three-year-old patent infringement case, and the Court **DISMISSES** this action for lack of subject matter jurisdiction.

For alternative dismissal grounds, the Court **GRANTS** Defendants' patent invalidity summary judgment motion.¹

I. Background

The Plaintiffs and Defendants compete in the industrial floor marking tape field. This case began in 2019, when Plaintiffs Lowe and InSite North Carolina sued Defendants ShieldMark, Inc., Advanced Plastics, Inc., and Crown Equipment Corporation. Plaintiffs alleged the infringement of Patent No. 10,214,664 ("664 Patent"). Defendants counterclaimed that the '664 Patent is invalid. Defendants denied any infringement.

After issuing a *Markman* decision, this Court gave Defendants summary judgment after the Court construed the '664 Patent as including elements that both sides acknowledged were not present in the alleged infringing products. Plaintiffs disagreed with the Court's *Markman* construction of the '664 Patent and took an appeal.

On appeal, the U.S. Court of Appeals for the Federal Circuit disagreed with this Court's *Markman* construction.² The Federal Circuit found this Court's patent interpretation incorrectly used the '664 Patent's specifications to put limits on the broader '664 Patent's claims. The Court of Appeals then vacated in part, remanded in part and affirmed in part this Court's earlier rulings.³

¹ Cf. *Golden Eye Media USA, Inc. v. Evo Lifestyle Prod. Ltd.*, No. 2021-2096, 2022 WL 2232517, at *3 (Fed. Cir. June 22, 2022) (addressing additional argument "in the interest of thoroughness" and because court was "not the court of last resort"). However, in light of the Court's conclusion that Plaintiffs lack standing, the Court declines to address the Lanham Act summary judgment issue in this opinion.

² Doc. 110.

³ Doc. 110.

Case No. 1:19-cv-748
Gwin, J.

Shortly after the Federal Circuit mandate issued, Plaintiffs filed a Fourth Amended Complaint⁴ that re-alleged an earlier-made Lanham Act claim that Plaintiffs had voluntarily dismissed before taking the appeal.⁵

On remand, the Court ordered supplemental summary judgement briefing on Defendants' unresolved patent invalidity counterclaim.

While that briefing was in progress, Defendants found that Plaintiff Lowe had arguably sold the '664 Patent. Defendants argued that the Court should dismiss this action because of a change in the '664 Patent's ownership.⁶

During earlier discovery, Defendants had requested discovery of all '664 Patent ownership materials.⁷ Despite its Rule 26 obligation to update discovery, Plaintiffs had not provided any amended discovery responses describing Lowe's ownership sale.⁸ The Court then ordered Plaintiffs to produce relevant ownership documents.⁹

In addition, although the documents revealed that there was a change in the '664 Patent's ownership while Plaintiffs' appeal was pending before the Federal Circuit, Plaintiffs did not tell the Federal Circuit that there was an ownership change.

Now that the parties completed supplemental invalidity and standing briefing and the Court conducted oral argument,¹⁰ the Court resolves these issues below.

II. Article III Standing

⁴ Doc. 127.

⁵ Doc. 126.

⁶ Doc. 150.

⁷ Doc. 169 at 11.

⁸ *Id.*

⁹ Doc. 159.

¹⁰ The Court conducted video oral argument on August 15, 2022.

Case No. 1:19-cv-748
Gwin, J.

Patents include various rights that can be divided and assigned, or retained in whole or part.¹¹ As the inventor, Lowe initially held all the rights but he alienated some or more of them through transfers, assignments, and licenses. However, “[w]hile parties are free to assign some or all patent rights as they see fit based on their interests and objectives, this does not mean that the chosen method of division will satisfy standing requirements.”¹²

In a patent infringement lawsuit, “[t]he touchstone of constitutional standing [. . .] is whether a party can establish that it has an exclusionary right in a patent that, if violated by another, would cause the party holding the exclusionary right to suffer legal injury.”¹³ Exclusionary rights “involve the ability to exclude others from practicing an invention or to forgo activities that would normally be prohibited under the patent statutes.”¹⁴

The right to exclude needs be measured for each defendant.¹⁵ A plaintiff may have standing to sue some infringers but not others. If the accused infringer has or may obtain a license from a third party, the patent infringement plaintiff does not have exclusionary rights against that infringer, and does not have standing to sue that arguable infringer.¹⁶

The issue presented here is properly described as mootness: “[t]he question of whether the [c]ourt *loses* jurisdiction over a case where a plaintiff has standing at the outset.”¹⁷ Additionally, under Supreme Court precedent, “[t]he party invoking federal jurisdiction bears the burden of establishing [standing].”¹⁸

¹¹ See *Morrow v. Microsoft Corp.*, 499 F.3d 1332, 1341 n.8 (Fed. Cir. 2007).

¹² *Id.*

¹³ *WiAV Sols. LLC v. Motorola, Inc.*, 631 F.3d 1257, 1265 (Fed. Cir. 2010).

¹⁴ *Lone Star Silicon Innovations LLC v. Nanya Tech. Corp.*, 925 F.3d 1225, 1234 (Fed. Cir. 2019) (internal citations omitted).

¹⁵ See *WiAV Sols. LLC*, 631 F.3d at 1267.

¹⁶ See *Alfred E. Mann Found. For Sci. Rsch. v. Cochlear Corp.*, 604 F.3d 1354, 1361 (Fed. Cir. 2010) (citing *Speedplay, Inc. v. Bebop, Inc.*, 211 F.3d 1245, 1251 (Fed. Cir. 2000)).

¹⁷ *Pi-Net Int'l, Inc. v. Focus Bus. Bank*, 2015 WL 1538259, at *2 (N.D. Cal. Apr. 6, 2015).

¹⁸ *Lujan v. Defs. of Wildlife*, 504 U.S. 555, 561 (1992).

Case No. 1:19-cv-748
Gwin, J.

A. Factual Background

i. Fourth Amended Complaint

On June 6, 2022, Plaintiffs Lowe and InSite North Carolina filed the Fourth Amended Complaint.¹⁹ In that complaint, Plaintiffs alleged:

Lowe is the owner of all rights, title, and interest in and to the '664 Patent. [InSite North Carolina] is an exclusive licensee under the '664 Patent engaged in the manufacture, distribution and sales of floor marking tape pursuant to its license and under the name "Superior Mark." Lowe and [InSite North Carolina] share rights of enforcement and recovery under the '664 Patent.²⁰

Plaintiffs now acknowledge that the Fourth Amended Complaint does not accurately reflect the June 6, 2022, patent-in-suit ownership.²¹

The Court describes the recently disclosed patent ownership documents below.

ii. The Patent Rights Assignment (Lowe to InSite North Carolina)

On December 9, 2021, Lowe signed a contract with InSite North Carolina.²² In that contract, Lowe "[sold], assign[ed], convey[ed] and transfer[red]" to InSite North Carolina his "*entire right, title, and interest*" in the '664 Patent.²³ Lowe also convey[ed] all of [his] rights arising under [. . .] any [. . .] United States laws [. . .], *including but not limited to any cause(s) of action and damages accruing prior to this assignment.*"²⁴

iii. The Patent License Agreement (InSite North Carolina to InSite Delaware)

¹⁹ See Doc. 126.

²⁰ Doc. 127 at 3.

²¹ Doc. 176 at 12.

²² Doc. 169-1.

²³ *Id.* at PageID #: 6065.

²⁴ *Id.* (emphasis added).

Case No. 1:19-cv-748
Gwin, J.

One week later, on December 16, 2021, InSite North Carolina entered into a license agreement with InSite Solutions, LLC of Delaware (“InSite Delaware”).²⁵ InSite Delaware has never entered an appearance as a party in this case.

With the December 16, 2021 agreement, InSite North Carolina gave InSite Delaware:

[A] worldwide, *non-exclusive, fully transferable, fully sublicensable (through multiple tiers), royalty-free, fully paid-up, perpetual, irrevocable, and non-terminable license* under [‘664 Patent] to practice any methods or systems described in or claimed by the [‘664 Patent], and to make, have made, use, sell, and otherwise distribute, offer to sell, or import and export any technology, products or services described in or claimed, in whole or in part, by the [‘664 Patent].²⁶

InSite North Carolina also granted to InSite Delaware an “exclusive option” to purchase the ‘664 Patent for no additional cost.²⁷ If InSite Delaware exercises the option, InSite North Carolina agreed to give InSite Delaware “all causes of action (whether known or unknown or whether currently pending, filed, or otherwise).”²⁸

Also in the December 16, 2021 agreement between InSite North Carolina and InSite Delaware, InSite Delaware “acknowledges and agrees that Lowe [. . .] and [InSite North Carolina] retain the exclusive rights to elect to maintain, control, and settle [this litigation]. Lowe and [InSite North Carolina] also retain the exclusive rights to enforce the [‘664 Patent] for recovery of damages for infringement prior to [December 16, 2021].”²⁹

iv. InSite North Carolina’s Alleged Exclusive License to Lowe

²⁵ Doc. 169-2.

²⁶ *Id.* at PageID # 6071 (Section 2.1) (emphasis added).

²⁷ *Id.* (Section 2.2).

²⁸ *Id.*

²⁹ *Id.* (Section 2.3).

Case No. 1:19-cv-748
Gwin, J.

According to Plaintiffs' brief, InSite North Carolina "granted Lowe the exclusive right to continue to assert infringement against alleged infringers of the '664 Patent during his [InSite North Carolina's] ownership of the '664 Patent, expressly including against ShieldMark."³⁰ Plaintiffs say that the InSite North Carolina-InSite Delaware agreement gives evidence of this license.³¹ Although Plaintiffs do not cite a specific provision, they presumably refer to the above-described section regarding the right to control this action. They also say that the license agreement was not in writing.³² They do not affirmatively state that there was an oral agreement.

B. Analysis

i. Plaintiff Lowe

Plaintiff Lowe no longer has standing for this lawsuit. In the Lowe-InSite North Carolina agreement, Lowe gave up his entire interest in the '664 Patent, including all causes of action. The Court finds Lowe's arguments that he re-gained his ability to pursue this lawsuit unpersuasive. And, even if InSite North Carolina could transfer InSite North Carolina's right to sue Defendants, the transfer would not give Lowe standing because InSite North Carolina had given Insite Delaware an unfettered ability to destroy InSite North Carolina's ability to exclude.

First, the Court finds that Lowe has not met his burden in proving that he is an exclusive licensee of the '664 Patent.³³ Although Lowe correctly notes that a license

³⁰ Doc. 176 at 7.

³¹ *Id.*

³² *Id.*

³³ *Cf. W. Elec. Co. v. Pacent Reproducer Corp.*, 42 F.2d 116, 119 (2d Cir. 1930) (exclusive license agreement as including "the promise that the grantor will give no further licenses.").

Case No. 1:19-cv-748
Gwin, J.

agreement need not be in writing,³⁴ Lowe has not presented adequate evidence that an exclusive license agreement exists.³⁵ He does not even affirmatively allege there was an oral exclusive license agreement. Lowe says that the InSite North Carolina-InSite Delaware agreement references Lowe's exclusive license, but it only references Lowe's purported ability to control this litigation, which is different from an exclusive license.

Additionally, the Court notes that InSite North Carolina's December 16, 2021 *non-exclusive license* grant to InSite Delaware would conflict with InSite Delaware's alleged earlier grant of an *exclusive license* to Lowe. This supports the Court's finding that Lowe's exclusive license agreement does not exist or Plaintiffs' failed to sufficiently establish it to meet their burden here.³⁶

Second and more importantly, to the extent that Lowe maintained any right to continue this litigation, the right to sue—on its own—is not enough to satisfy the constitutional standing requirement. In *Morrow v. Microsoft Corp.*,³⁷ the Federal Circuit found that a plaintiff with a claimed "right to sue infringers" did not have standing when a different entity owned the patent and owned the "right to sell the patent, grant exclusive and nonexclusive licenses, grant the right to sublicense, or transfer any of the rights."³⁸

Lowe sits in the same position as the *Microsoft* General Unsecured Creditors' Liquidating Trust ("GUCLT"). In *Microsoft*, the GUCLT had received "claims for . . . infringement of [the predecessor's] intellectual property rights." As in *Microsoft*, a party

³⁴ *Waymark Corp. v. Porta Sys. Corp.*, 334 F.3d 1358, 1364 (Fed. Cir. 2003).

³⁵ *Cf. Visioneer, Inc. v. KeyScan, Inc.*, 626 F. Supp. 2d 1018, 1025 (N.D. Cal. 2009) (finding insufficient evidence that license existed).

³⁶ Because Lowe explicitly conveyed "any cause(s) of action," Doc. 169-1 at PageID # 6065, this case is distinguishable from *MIS Sys. Corp. v. Hysitron, Inc.*, 2008 WL 11463565, at *2 (D. Minn. Dec. 1, 2008)).

³⁷ 499 F.3d 1332 (Fed. Cir. 2007).

³⁸ *Id.* at 1342.

Case No. 1:19-cv-748
Gwin, J.

loses standing where “the exclusionary rights have been separated from the right to sue for infringement.”³⁹ Since Lowe has kept no exclusionary rights in the ‘664 Patent, even if he did keep the right to prosecute this action, he does not have standing.

ii. Plaintiff InSite North Carolina

Since InSite North Carolina retained legal title to the ‘664 Patent, the question here is “whether the patent owner transferred away sufficient rights to divest it of any right to sue.”⁴⁰

As described in *Alfred E. Mann Found. for Sci. Rsch. v. Cochlear Corp.*,⁴¹ patent owners can give certain license rights away while keeping others. The *Mann* Court looked to an earlier Federal Circuit case establishing that when a patent owner gives up “all substantial rights” to an exclusive licensee, “the licensee becomes the owner of the patent for standing purposes and gains the right to sue on its own.”⁴² In that scenario, only the licensee has standing to sue; “the licensor may not.”⁴³

To determine whether the “licensor has transferred away sufficient rights to render an exclusive licensee the owner of a patent,” the *Mann* court gave a list of non-exhaustive factors that courts should consider. The Court wrote:

Of course, transfer of the exclusive right to make, use, and sell products or services under the patent is vitally important to an assignment. [. . .]. We have also examined the scope of the licensee’s right to sublicense, the nature of license provisions regarding the reversion of rights to the licensor following breaches of the license agreement, the right of the licensor to receive a portion of the recovery in infringement suits brought by the licensee, the duration of the license rights granted to the licensee, the ability of the licensor to supervise and control the licensee’s activities, the

³⁹ *Id.*

⁴⁰ *Alfred E. Mann Found. For Sci. Rsch. v. Cochlear Corp.*, 604 F.3d 1354, 1359 (Fed. Cir. 2010).

⁴¹ 604 F.3d 1354 (Fed. Cir. 2010).

⁴² *Id.* at 1359–60 (discussing *Aspex Eyewear, Inc. v. Miracle Optics, Inc.*, 434 F.3d 1336 (Fed.Cir.2006)).

⁴³ *Id.* at 1360.

Case No. 1:19-cv-748

Gwin, J.

obligation of the licensor to continue paying patent maintenance fees, and the nature of any limits on the licensee's right to assign its interests in the patent. [. . .]. Frequently, though, the nature and scope of the exclusive licensee's purported right to bring suit, together with the nature and scope of any right to sue purportedly retained by the licensor, is the most important consideration. [. . .]. It does not, however, preclude such a finding if the licensor's right to sue is rendered illusory by the licensee's ability to settle licensor-initiated litigation by granting royalty-free sublicenses to the accused infringers.⁴⁴

Even though the *Mann* court was considering a situation in which a patent owner gives an exclusive license, unlike the non-exclusive license InSite North Carolina gave to InSite Delaware, the same logic applies. Here, the Court's determination (as discussed below) is that InSite North Carolina transferred "all substantial rights" to InSite Delaware.⁴⁵ And although InSite Delaware is positioned as the "owner" for standing purposes, InSite Delaware cannot sue because InSite Delaware holds only a non-exclusive license.

The Court finds that InSite Delaware would not have standing to sue after considering the factors described in the *Mann* decision.

To start, although InSite North Carolina or Lowe may control this litigation, that right is illusory since InSite North Carolina did not keep any authority over InSite Delaware's right to issue sublicenses. Multiple conditions of the InSite North Carolina-InSite Delaware agreement show that InSite Delaware could sublicense without restriction. Nothing in the agreement limits InSite Delaware's grant of sublicenses. And nothing limits InSite Delaware's ability to grant a license to Defendants.⁴⁶ Rather, InSite's Delaware

⁴⁴ *Id.* at 1360–1361.

⁴⁵ *Cf. Uniloc 2017 LLC v. Google LLC*, 508 F. Supp. 3d 556, 565 (N.D. Cal. 2020) (quoting *Mann*, 604 F.3d at 1359) ("The determination of a 'patentee' is an all-or-nothing proposition: a patent has only one 'patentee' at a given time and cannot have 'multiple separate owners.'").

⁴⁶ *Cf. Uniloc 2017 LLC*, 508 F. Supp. 3d at 568 (determining that non-party's ability to sublicense to defendants defeated standing).

Case No. 1:19-cv-748
Gwin, J.

sublicense is “fully transferable, fully sublicensable [. . .], perpetual, irrevocable, and non-terminable.”⁴⁷

Furthermore, the InSite North Carolina-InSite Delaware agreement says that: “[InSite North Carolina] retain[s] the exclusive rights to enforce [the ‘664 Patent] for recovery of damages for infringement *prior* to [December 16, 2021].”⁴⁸ By implication, this contract provision means that InSite North Carolina gave up its patent enforcement rights *after* December 16, 2021.

Lastly, the InSite North Carolina - InSite Delaware agreement gives InSite Delaware a paid-up license with no future financial obligations to InSite North Carolina. The unrecallable InSite Delaware license also goes against InSite North Carolina’s continued standing. The license is “royalty-free” and “fully-paid up.”⁴⁹ The agreement also provides InSite Delaware a no-cost option to purchase title to the ‘664 Patent, upon which “all causes of action” would transfer to InSite Delaware.⁵⁰

C. Dismissal with Prejudice

The Federal Circuit has held that “dismissal with prejudice is generally inappropriate where the standing defect can be cured.”⁵¹ But here, the Court finds that both Plaintiffs lack standing—and pleading different facts will not change that result. This Court’s ruling flows from the Court’s analysis of the underlying patent ownership documents. And because InSite Delaware is third-party nonexclusive licensee, any amendment to include

⁴⁷ Doc. 169-2 at 2 (Section 2.1).

⁴⁸ Doc. 169-2 at 3 (Section 2.3) (emphasis added).

⁴⁹ Doc. 169-2 at 2 (Section 2.1).

⁵⁰ *Id.* at 2–3 (Section 2.2).

⁵¹ *Sicom Sys., Ltd. v. Agilent Techs., Inc.*, 427 F.3d 971, 980 (Fed. Cir. 2005); *see also Great Lakes Intell. Prop. Ltd. v. Sakar Int’l, Inc.*, 516 F. Supp. 2d 880, 893 (W.D. Mich. 2007).

Case No. 1:19-cv-748
Gwin, J.

InSite Delaware would not cure the standing defect.⁵² Accordingly, the Court dismisses this case with prejudice.

III. Invalidity

In the alternative, the Court would grant summary judgment to Defendants on the grounds that the '664 Patent is invalid as anticipated by U.S. Patent 6,120,395 ("Dorenbusch").

A. '664 Patent Construction

The Federal Circuit explained and construed the '664 Patent as follows:

[The] '664 Patent is directed to an improved floor marking tape. The specification explains that existing tape was "prone to being caught on floor cleaning devices or skids." '664 Patent, col. 1 ll. 28–30. The patented invention purports to solve that problem by disclosing tape with features that prevent it from "unintentional lifting and delamination" from the floor. *Id.* Abstract. The "[t]ape 10 generally includes a body 20 having an upper surface 22 and a lower surface 24." *Id.* col. 2 ll. 19–24. The body has a "pair of lateral edges" that are "smoothly beveled," thus "prevent[ing] tape 10 from being unintentionally lifted." *Id.* col. 1 ll. 42–43; col. 2 ll. 23–27.

[. . .]

Claims 1 and 11 are the only independent claims. Claim 1 reads as follows:

1. A floor marking tape adhered to a floor wherein the floor marking tape establishes a boundary on the floor; the combination comprising:

a floor having an uppermost surface; the uppermost surface of the floor configured to support personnel and equipment thereupon;

a floor marking tape having a body that has an upper surface and a lower surface; the lower surface facing the uppermost surface of the floor to which the floor marking tape is adhered

⁵² *Cf. id.* at 976 (citing *Rite-Hite Corp. v. Kelley Co., Inc.*, 56 F.3d 1538, 1552 (Fed. Cir. 1995)) ("A nonexclusive license confers no constitutional standing on the licensee to bring suit or even to join a suit with the patentee because a nonexclusive licensee suffers no legal injury from infringement.").

Case No. 1:19-cv-748
Gwin, J.

such that the body of the floor marking tape is disposed above the uppermost surface of the floor;

the body of the floor marking tape having a longitudinal direction;

the body of the floor marking tape having first and second *lateral edge portions* disposed in the longitudinal direction; each of the first and second *lateral edge portions* having an upper surface and a lower surface;

each of the first and second *lateral edge portions* having a width defined in a direction perpendicular to the longitudinal direction;

the upper surface of each *lateral edge portion* comprising an extension of the upper surface of the body;

the lower surface of each *lateral edge portion being a flat coplanar extension* of the lower surface of the body;

the entire body of each *lateral edge portion* being tapered with the upper surface of the first *lateral edge portion* extending to the lower surface of the first *lateral edge portion* and the upper surface of the second *lateral edge portion* extending to the lower surface of the second *lateral edge portion*;

each of the first and second *lateral edge portions* having a maximum height that is less than its width; and

an adhesive securing the lower surface of the body to the uppermost surface of the floor to establish a boundary.

Id. col. 5 ll. 2–36 (emphases added).

Claim 11 similarly recites a “a floor marking tape adhered to a floor” with a “body” and tapered “*lateral edge portions.*” *Id.* col. 6 ll. 1–36 (emphasis added).

Claims 10 and 20 depend from claims 1 and 11, respectively. They each recite that the tape has “a *central body portion* disposed between the first and second lateral edge portions.” *Id.* col. 5 ll. 61–67 (emphasis added); col. 6 ll. 61–67 (emphasis added).

Case No. 1:19-cv-748
Gwin, J.

All of the remaining asserted claims depend from one of the above noted independent claims.⁵³

The Federal Circuit “adopt[ed] Lowe’s construction” of three disputed claim terms.⁵⁴

Accordingly, this Court construes these claim terms consistent with the Federal Circuit construction:

- ***Lateral edge portion*** to mean “a portion of the tapered edges of the tape body[;]”⁵⁵
- ***Lower surface of each lateral edge portion being a flat coplanar extension of the lower surface of the body*** to mean “the bottom surfaces of the lateral edge portions are flat, lie in the same plane, and define an extension of the lower surface of the body[;]”⁵⁶ and
- ***Central body portion*** to mean the “portion of the tape that extends along and on each side of the body’s centerline.”⁵⁷

B. Legal Standard

A court will grant a motion for summary judgment “if 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.”⁵⁸ There is a genuine dispute as to a material fact when the “evidence is such that a reasonable jury could return a verdict for the nonmoving party.”⁵⁹

Patents are presumed valid.⁶⁰ This presumption can only be overcome by clear and convincing evidence.⁶¹ “Thus, a moving party seeking to invalidate a patent at summary

⁵³ Doc. 110 at 3–5.

⁵⁴ *Id.* at 16.

⁵⁵ *Id.* at 11.

⁵⁶ *Id.* at 14.

⁵⁷ *Id.* at 16.

⁵⁸ Fed. R. Civ. P. 56(a).

⁵⁹ *Petfer v. Stephens*, 880 F.3d 256, 262 (6th Cir. 2018) (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)).

⁶⁰ See 35 U.S.C. § 282(a).

⁶¹ *Eli Lilly & Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 962 (Fed. Cir. 2001).

Case No. 1:19-cv-748
Gwin, J.

judgment must submit such clear and convincing evidence of invalidity so that no reasonable jury could find otherwise.”⁶²

C. Anticipation

Under Federal Circuit precedent, “[a] patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention.”⁶³ “[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.”⁶⁴ For prior art to anticipate a claim, “it must be sufficient to enable one with ordinary skill in the art to practice the invention.”⁶⁵ And, Federal Circuit decisions acknowledge that a prior art reference need not use the same language as a patent claim.⁶⁶

D. Dorenbusch

Dorenbusch concerns a temporary spot marker used on a floor surface like a basketball court.⁶⁷

Dorenbusch purports to solve the problem of players tripping on the tape,⁶⁸ and accordingly, specifies that the makers have specific edges:

To further aid in making the sport marker non-interfering, all peripheral edges are beveled downwardly to present a gently rising edge area. Preferably, the peripheral edges are angled downwardly towards the floor to create an about 30 degree to about 60 degree angles to the horizontal.⁶⁹

⁶² *Id.*

⁶³ *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003); *see also Encyclopaedia Britannica, Inc. v. Alpine Elecs. of Am., Inc.*, 609 F.3d 1345, 1349 (Fed. Cir. 2010) (“While anticipation is a question of fact, it may be decided on summary judgment if the record reveals no genuine dispute of material fact.”).

⁶⁴ *Id.*

⁶⁵ *Minn. Mining & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1301 (Fed. Cir. 2002).

⁶⁶ *See, e.g., In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009).

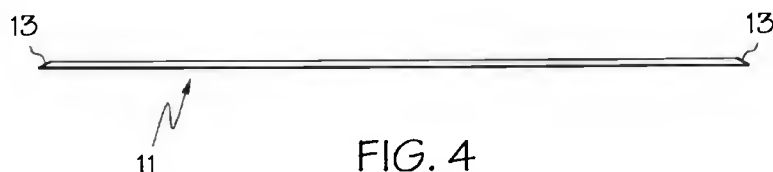
⁶⁷ Doc. 77-2, col 1:11–28.

⁶⁸ *Id.* col 2: 54–56.

⁶⁹ *Id.* col. 2:60–65.

Case No. 1:19-cv-748
Gwin, J.

The Dorenbusch marker is depicted in the below Figure 4, which is “a side elevational view” of the Dorenbusch marker.⁷⁰



Additionally, Dorenbusch discusses using an adhesive on the underside of the marking tape but does not require an adhesive bottom surface. Dorenbusch teaches that: “[A] thin layer of adhesive can be applied to the underside of each spot marker.”⁷¹

And, the Dorenbusch claim 1 reads:

[E]ach said individual spot marker further having (i) a substantially flat low profile with a thickness of from about 100 mils to about 300 mils, (ii) peripheral edges beveled downwardly at an about 30 degree to about 60 degree angle to the horizontal, (iii) a non-slip bottom surface for resisting lateral forces, and (iv) a textured top surface, whereby each said individual spot marker when placed on the surface resists lateral forces to remain in place yet is readily lifted from the surface for movement to another area or storage.⁷²

E. Analysis

Defendants argue that Dorenbusch anticipates the at-issue ‘664 Patent claims. In a chart, Defendants allege that every element of the asserted claims is found in Dorenbusch.⁷³

⁷⁰ *Id.* col. 2:3–4. Figure 6 similarly depicts the side-view of a differently shaped marker. See *id.* at col. 2:7–8.

⁷¹ *Id.* col. 3:15–16.

⁷² *Id.* col. 4:7–16. Claims 7 and 11 both include the same claim elements.

⁷³ Doc. 135-1.

Case No. 1:19-cv-748
Gwin, J.

Both in the initial⁷⁴ and post-remand summary judgment briefing,⁷⁵ the only '664 Patent claim element Plaintiffs contend that Dorenbusch does not teach is: "the upper surface of each *lateral edge portion* [comprises] an extension of the upper surface of the body."⁷⁶ Plaintiffs say this is evident from Dorenbusch Figure 4 (reproduced above), which shows that "the edges 13 are sharply cut and are separate and distinct from the top surface of the marker, rather than being an extension of the top surface as required by the claims of the '664 Patent."⁷⁷ Plaintiff Lowe provides a declaration that offers the same observations based on Figure 4.⁷⁸ Plaintiffs argue that this is an important functional difference because the '664 Patent's "smooth transition at the edge" keeps a tape in place when heavy industrial equipment is dragged over it.⁷⁹

The Court finds Plaintiffs' argument unpersuasive. Even accepting Plaintiffs' construction of the claim that "the upper surface of each *lateral edge portion* [comprises] an extension of the upper surface of the body," to mean that "the upper surface of each lateral edge portion is an extension of the upper surface of the body which is tapered such as to extend to the lower surface of the first lateral edge portion,"⁸⁰ the Dorenbusch patent teaches the edge portion by clear and convincing evidence.

Put simply, nothing in Dorenbusch suggests that there are "four separate and distinct surfaces." To the contrary, Dorenbusch teaches that "all peripheral edges are beveled downwardly to present a *gently rising edge area*."⁸¹ In this context, the phrase "beveled

⁷⁴ Doc. 80 at PageID # 4121–4122.

⁷⁵ Doc. 155 at PageID # 5906–07.

⁷⁶ This element is in both independent claims 1 and 11.

⁷⁷ Doc. 80 at PageID # 4121; Doc. 155 at PageID # 5906.

⁷⁸ Doc. 80-10 at PageID # 4163 ¶ 7.

⁷⁹ Doc. 155 at PageID # 5906.

⁸⁰ *Id.*

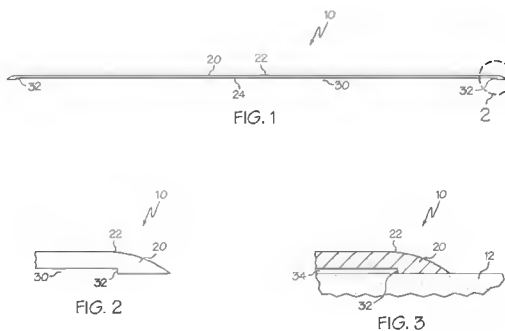
⁸¹ Doc. 77-2, col. 2:61–62 (emphasis added).

Case No. 1:19-cv-748
Gwin, J.

downwardly” is synonymous with the Federal Circuit’s construction of *lateral edge portion*, meaning “the tapered edges of the tape body”—or even more simply, an edge that gets thinner as it approaches the floor.

Further, Plaintiffs’ interpretation of Dorenbusch would require that the lateral edges be angled at roughly 90 degrees since Plaintiffs say Dorenbusch’s edges are “sharply cut” and comprise a “distinct surface[].” However, this argument disregards Dorenbusch’s specification and claim language. Dorenbusch says, “the peripheral edges are angled downwardly towards the floor to create an about 30 degree to about 60 degree angle to the horizontal.”⁸² Dorenbusch also adds that “all peripheral edges are beveled downwardly to present a *gently rising edge area*.”⁸³ Plaintiffs provided no argument related to these Dorenbusch aspects.

It is true that Dorenbusch Figure 4 (reproduced above) does not depict the sloped ‘664 edge that is depicted below in ‘664 Patent Figures 1, 2 and 3.⁸⁴



But Dorenbusch Figure 4 does not depict a sharp slope as Plaintiffs allege; rather, the drawing does not zoom in on the edge portion.

⁸² *Id.* col. 2:63–65.

⁸³ *Id.* col. 2:62 (emphasis added).

⁸⁴ Doc. 44-1, figs. 1–3.

Case No. 1:19-cv-748
Gwin, J.

Finally, Plaintiffs say that Dorenbusch is not prior art because of the different intended uses of the Dorenbusch markers and the '664 Patent floor tape. In particular, Plaintiffs point out that the Dorenbusch system is meant to be easily lifted after being used,⁸⁵ while the '664 specification describes a tape that is less easily rearrangeable.⁸⁶ But this argument distracts from the proper anticipation inquiry, which turns on whether Dorenbusch discloses the claim elements and whether a person skilled in the art would infer the '664 Patent from Dorenbusch. And on that matter, the Court finds that Dorenbusch and the '664 Patent have similar intended uses: A marking that does not slip when in use but is nonetheless not permanent. The '664 Patent teaches a tape that is meant to avoid "unintentional lifting;"⁸⁷ this suggests that the '664 Patent tape may be lifted intentionally.

IV. Other Summary Judgment Issues and Sanctions

Having determined that Plaintiffs lack standing and that the '664 Patent is invalid based on Dorenbusch, the Court declines to address the remaining issues on summary judgment in this opinion. The Court also declines to impose sanctions on Plaintiffs at this time, but Defendants may later renew their motions.

V. Conclusion

The Court **DISMISSES** this action for lack of subject matter jurisdiction with prejudice. In the alternative, the Court **GRANTS** Defendants' patent invalidity summary judgment motion.

⁸⁵ Doc. 77-2, col. 1:29-34.

⁸⁶ Doc. 155 at PageID #: 5907 (citing Doc. 44-1, *Abstract*).

⁸⁷ Doc. 44-1, *Abstract*.

Case: 1:19-cv-00748-JG Doc #: 191 Filed: 08/23/22 20 of 20. PageID #: 6301

Case No. 1:19-cv-748
Gwin, J.

IT IS SO ORDERED

Dated: August 23, 2022

s/ James S. Gwin
JAMES S. GWIN
UNITED STATES DISTRICT JUDGE

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO

CLIFFORD A. LOWE, *et al.*,

Plaintiffs,

vs.

SHIELDMARK, INC., *et al.*,

Defendants.

OPINION & ORDER

[Resolving Doc. 213, 215, 216, 217]

JAMES S. GWIN, UNITED STATES DISTRICT JUDGE:

Plaintiffs Lowe and Spota LLC (formerly Insite Solutions, LLC) sue Defendants ShieldMark Inc., Advanced Plastics, Inc., and Crown Equipment Corporation for patent infringement and, in the alternative, false advertising under the Lanham Act.¹ Defendants counterclaim, arguing that Plaintiffs' inequitable conduct has made their patent invalid.²

On August 23, 2022, the Court granted Defendants' motion for summary judgment on Plaintiffs' patent infringement claim after finding that Plaintiffs lack standing and that the patent forming the basis of Plaintiffs' infringement claim is invalid.³ The Court did not rule on either Plaintiffs' Lanham Act claim or Defendants' inequitable conduct counterclaim.

Now, each side moves for summary judgment on Plaintiff's Lanham Act false advertising claim.⁴

Because Plaintiff's Lanham Act claim fails as a matter of law, the Court **DENIES** Plaintiff Spota LLC's summary judgment motion and **GRANTS** summary judgment for Defendants as to Plaintiff's false advertising claim.

¹ Doc. 127.

² Doc. 147.

³ Doc. 191.

⁴ Doc. 213; 215. While Plaintiff Lowe is also listed as a movant on Doc. 213, Plaintiff Spota LLC clarified in its reply brief that it included Lowe's name in error and that it moved alone for summary judgment. See Doc. 216 at PageID #: 6739, n.2.

Case No. 1:19-cv-748
Gwin, J.

I. LEGAL STANDARD

a. Summary Judgment Standard

“Summary judgment is appropriate when the court is satisfied ‘that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.’”⁵ “The burden of showing the absence of any such genuine issue rests with the moving party.”⁶ Indeed, “the plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial.”⁷

b. False Advertising under the Lanham Act

A plaintiff has two avenues by which they can prove their Lanham Act false advertising claim: they must show that the defendant made commercial advertising statements that were either literally false, or that were true or ambiguous but misleading to actual consumers.⁸

Literally false. Showing that a “defendant's advertising communicated a ‘literally false’ message to consumers [...] is the preferred route for Lanham Act claimants, since courts presume that consumers were actually deceived upon a showing of literal falsity.”⁹

Misleading. Alternatively, a plaintiff can “show that the defendant's messaging was misleading, even if not literally false. To prevail on this theory, however, the claimant must prove that a significant portion of reasonable consumers were actually deceived by the

⁵ *Lincoln Elec. Co. v. Nat'l Standard, LLC, Corp.*, 2012 WL 2130954, at *3 (N.D. Ohio June 12, 2012) (citing Fed. R. Civ. P. 56(c)).

⁶ *Id.* (quotation marks omitted).

⁷ *Celotex Corp. v. Catrett*, 477 U.S. 317, 322–23 (1986).

⁸ *Wysong Corp. v. APN, Inc. (17-1975)*, 889 F.3d 267, 270–71 (6th Cir. 2018) (citation omitted).

⁹ *Id.*

Case No. 1:19-cv-748
Gwin, J.

defendant's messaging. Lanham Act claimants usually do so with consumer surveys."¹⁰

Certain types of statements are too hyperbolic or vague to serve as the basis for a false advertising claim. Statements that amount to "non-actionable puffery come[] in at least two possible forms: (1) an exaggerated, blustering, and boasting statement upon which no reasonable buyer would be justified in relying; or (2) a general claim of superiority over comparable products that is so vague that it can be understood as nothing more than a mere expression of opinion."¹¹

In evaluating whether a statement is false or misleading, courts take the context of the statement into account.¹²

II. DISCUSSION

Plaintiff says that it is entitled to summary judgment because Defendant ShieldMark¹³ made advertising statements about ShieldMark's Mighty Line Floor Tape that, when read in proper context, are literally false.

Specifically, Plaintiff argues that Defendant's advertisements include three false statements. These statements are:

1. Mighty Line Floor Tape's "[b]eveled edge tape can take a beating from industrial wheel traffic";¹⁴
2. "Mighty Line Floor Tape withstands industrial brush scrubbers, forklifts, and heavy

¹⁰ *Id.* (citation and quotation marks omitted) (emphasis in original).

¹¹ *Pizza Hut, Inc. v. Papa John's Int'l, Inc.*, 227 F.3d 489, 497 (5th Cir. 2000) (quotation marks omitted).

¹² *Clorox Co. Puerto Rico v. Proctor & Gamble Com. Co.*, 228 F.3d 24, 39 (1st Cir. 2000) (finding that the statement "Whiter is not possible," which by itself would be mere puffing, was a specific and measurable statement of fact when read in the context of other statements inviting consumers to compare defendant's product to competitor bleach and detergent products).

¹³ Although this case and the instant motions involve multiple defendants, Plaintiff's false advertising claim relates specifically to statements made by Defendant ShieldMark. Throughout the rest of this order, the Court uses the singular "Defendant" to refer to Defendant ShieldMark unless otherwise stated.

¹⁴ Doc. 127-4 at PageID #: 5290.

Case No. 1:19-cv-748
Gwin, J.

industrial wheel traffic”;¹⁵

3. Mighty Line Floor Tape’s “[b]eveled edges increase durability for forklift traffic.”¹⁶

Plaintiff views these statements as necessarily false because Defendant ShieldMark admitted earlier in this litigation that Mighty Line Floor Tape is susceptible to being “unintentionally lifted [off the floor] when a 2-by-4 block of wood is swept across the tape,” and that “[i]f a 2-by-4 lifts up the tape, then a cleaning device, forklift or skid would also do so.”¹⁷ In Plaintiff’s view, a tape that unintentionally lifts when passed over by a forklift or other industrial machinery cannot “take a beating” from or “withstand” such machinery, nor have “increase[d] durability.”

Although none of the Defendants raised the issue, the Court notes that Plaintiff does not allege that Defendants Advanced Plastics and Crown Equipment made any false advertising statements. Those Defendants are thus entitled to summary judgment. What’s more, the Court disagrees with Plaintiff’s characterization of Defendant ShieldMark’s statements as literally false and finds that ShieldMark’s statements were non-actionable puffery.

ShieldMark’s statements about its tape are too vague to be actionably false. Under the Lanham Act, defendants can never be liable for “[b]ald assertions of superiority or general statements of opinion” because these are mere puffery.¹⁸ Rather, a plaintiff must show that a defendant made a “specific and measurable claim[] capable of being proved false or of being reasonably interpreted as a statement of objective fact.”¹⁹

¹⁵ *Id.* at PageID #: 5291.

¹⁶ *Id.* at PageID #: 5292.

¹⁷ Doc. 213 at PageID #: 6728 (quoting Doc. 77-1 at PageID #: 3285).

¹⁸ *Pizza Hut*, 227 F.3d at 496 (cleaned up).

¹⁹ *Id.*

Case No. 1:19-cv-748
Gwin, J.

None of ShieldMark's statements are sufficiently specific or measurably false to be actionable.

How well must a floor tape perform to be considered capable of "taking a beating" or "withstand[ing]" industrial machinery? Surely a tape that disintegrates almost instantly is not one that has "increase[d] durability." But at the same time, no reasonable consumer would expect the tape to last forever, perfectly unaltered, in the face of any or every condition. Defendant's statements make no measurable promises other than that Mighty Line Floor Tape probably falls somewhere between tape that disintegrates at the lightest touch and tape strong enough to survive a nuclear bomb.

Nor is the Court persuaded by Plaintiff's argument that Defendant's statements become verifiably false when taking into account Defendant's admission that the tape unintentionally lifts. For one thing, there is no literal falsity because "take a beating," "durability," and "withstand[]" do not directly describe a tape's ability to resist unintentional lifting. Those terms can just as easily refer to a tape's ability to resist abrasion, discoloration, or deformation when forklifts and other machines pass over it.²⁰

And Plaintiff does not identify any instances of Defendant explicitly telling consumers that its tape does not unintentionally lift. If anything, Defendants' ads work against Plaintiff. The same ad that claims that Mighty Line Floor Tape "withstands" industrial machinery also touts: "Mighty Line Floor Tape is thick, tough, and the special Mighty Line formula helps resist abrasion."²¹ That ad further states that Mighty Line Floor Tape can "change workflow area quickly and easily."²² Thus, the ad itself suggests both that durability here means

²⁰ See Doc. 217 at PageID #: 6858.

²¹ Doc. 127-4 at PageID #: 5291.

²² *Id.*

Case: 1:19-cv-00748-JG Doc #: 219 Filed: 03/16/23 6 of 6. PageID #: 6989

Case No. 1:19-cv-748
Gwin, J.

resistance to abrasion, and that Mighty Line tape can be easily lifted to configure different traffic patterns.

Finally, even if Defendant's statements were actionable statements of fact rather than mere puffery, the statements are at most ambiguous but misleading, rather than literally false. A Plaintiff who bases a false advertising claim on statements that are ambiguous but misleading must show that consumers were actually deceived.²³ Plaintiff has submitted no such evidence.²⁴ Thus, Plaintiff "fails to make a showing sufficient to establish the existence of an element essential to [its] case."²⁵

III. CONCLUSION

For the reasons stated above, the Court **DENIES** summary judgment to Plaintiff and **GRANTS** summary judgment to Defendants.

IT IS SO ORDERED.

Dated: March 16, 2023

/s/ James S. Gwin
JAMES S. GWIN
UNITED STATES DISTRICT JUDGE

²³ *Wyson*, 889 F.3d at 271.

²⁴ See Doc. 215 at PageID #: 6743, n. 3.

²⁵ *Celotex*, 477 U.S. at 323 (1986).

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO

CLIFFORD A. LOWE, *et al.*,

Plaintiffs,

vs.

SHIELDMARK, INC., *et al.*,

Defendants.

OPINION & ORDER

[Resolving Doc. 199, 203, 218, 223]

JAMES S. GWIN, UNITED STATES DISTRICT JUDGE:

This Court previously granted summary judgment for Defendants ShieldMark Inc., Advanced Plastics, Inc., and Crown Equipment Corporation on Plaintiffs Lowe and Spota LLC's patent infringement and Lanham Act false advertising claims.¹ Defendants counterclaim for attorneys' fees and costs under § 285 of the Patent Act, and alternatively move for fees and costs under both Fed. R. Civ. P. 37 for discovery sanctions and the Court's inherent power to impose sanctions.²

Defendants seek fee awards on three grounds. First, Defendants say they should receive all fees and costs for litigating Plaintiffs' patent infringement claim because Plaintiff Lowe engaged in inequitable conduct before the Patent and Trademark Office ("PTO"). Second, in the alternative, Defendants seek costs and fees incurred in the patent infringement portion of this action from December 2021 onwards. In seeking costs and fees, Defendants argue that Plaintiffs prolonged litigation of the infringement claim by concealing that in December 2021, they transferred away their exclusionary rights in the patent and thereby relinquished their Article III standing. Third, Defendants ask for fees and costs incurred when

¹ Doc. 191, 219.

² Doc. 203, 218.

Case No. 19-cv-748
Gwin, J.

in July 2022, Defendants had to move to seal a Plaintiff expert report that contained information Defendants had marked as highly confidential.³

The Court finds that Plaintiffs acted in bad faith to hide their loss of standing, and that they violated their obligation to protect Defendants' confidential information. Accordingly, the Court will **GRANT IN PART** Defendants' motion as to fees and costs incurred after December 2021 for the patent litigation and for the motion to seal and will **DENY IN PART** Defendants' motion as to patent litigation fees incurred before December 2021.⁴

I. BACKGROUND

The Court has already summarized the background of this case in other orders.⁵ Briefly, Plaintiffs Lowe and Spota LLC compete with Defendants in the industrial floor-tape market. Plaintiffs sued Defendants alleging that Defendants' floor tape infringed on Plaintiffs' tape patent and that Defendants' tape did not conform to how Defendants described the tape in their advertising.

When this litigation commenced, Plaintiff Lowe owned the relevant '664 patent.⁶ But in early December 2021, Lowe sold his patent to Plaintiff Spota LLC (then d/b/a Insite Solutions North Carolina).⁷ Then, on December 16, 2021, Spota LLC granted nonparty Insite Delaware a permanent, irrevocable, non-exclusive and royalty-free license under the patent. Crucially, because the license was both "fully transferable" and "fully sub-licensable," it

³ *Id.*

⁴ After the Court granted summary judgment for Defendants on Plaintiffs' Lanham Act claim, Plaintiffs on April 14, 2023, filed a Notice of Appeal to the Federal Circuit. (Doc. 222). Then, on April 20, 2023, Plaintiffs asked the Court to clarify whether their appeal was premature or whether the Court's Lanham Act order, in combination with the Court's previous patent-infringement summary judgment order, created a final, appealable judgment. (Doc. 223). Because this order disposes of the final, outstanding counterclaim at issue in this case, the Court DENIES Plaintiffs' motion to clarify as moot.

⁵ Doc. 191, 219.

⁶ Doc. 191 at PageID #: 6282.

⁷ *Id.* at PageID #: 6287.

Case No. 19-cv-748
Gwin, J.

eliminated Spota's power to exclude Defendants under the patent. Thus, by December 2021, both Lowe and Spota had relinquished their exclusionary power under the patent and their standing to enforce the patent.⁸

In discovery, Defendants had previously requested Plaintiffs produce all '664 patent ownership and licensing materials.⁹ But despite Plaintiffs' Rule 26 obligation to supplement discovery, Plaintiffs did not amend their discovery responses or production to disclose the ownership and licensing changes.¹⁰ In fact, Plaintiffs filed a Fourth Amended Complaint that specifically misrepresented the ownership and licensing status of the patent.¹¹ As a result, Plaintiffs' standing issue did not come to light until around seven months later, when Defendants independently discovered the ownership change.

When Defendants discovered the sale and confronted Plaintiffs about it, Plaintiffs initially refused to produce the new ownership and licensing agreements. Defendants were forced to move to compel production, and in July 2022, the Court ordered Plaintiffs to file *inter alia* all available documents related to any ownership transfer of the '664 patent; all documents related to any licensing of the '664 patent; and all documents related to Plaintiff Lowe's authority to prosecute '664 patent claims.¹² These productions culminated in Defendants moving for and the Court granting summary judgment on Plaintiffs' patent infringement claim. Because they had transferred the '664 patent right to exclude, the Court found they lost standing.

Separately, in July 2022, Plaintiffs publicly filed an expert report that cited to

⁸ *Id.* at PageID #: 6285.

⁹ *Id.* at PageID #: 6284.

¹⁰ *Id.*

¹¹ Doc. 127 at PageID #: 5259.

¹² Doc. 154.

Case No. 19-cv-748
Gwin, J.

information from documents that Defendants had marked as highly confidential and for Attorneys' Eyes Only. Defendants moved to seal the expert report and to implement a protective order,¹³ and on July 27, 2022, the Court granted the protective order motion.¹⁴

II. DISCUSSION

A. Jurisdiction

As a preliminary matter, the Court notes that it has subject matter jurisdiction to decide Defendants' fees counterclaim.

Plaintiffs argue to the contrary, contending that the Court lost jurisdiction over Defendants' § 285 counterclaim when it dismissed Plaintiffs' patent infringement claim.

But a § 285 counterclaim confers subject matter jurisdiction independent of an initial patent infringement claim. Indeed, in *H.R. Technologies, Inc. v. Astechnologies, Inc.*, the Federal Circuit held that a district court that dismissed a plaintiff's patent infringement suit for lack of standing had erred in also dismissing the defendant's counterclaims for § 285 attorneys' fees.¹⁵

The panel in *Astechnologies* wrote:

The standing defect, however, had no effect on the remaining counterclaims. Regardless of patent ownership, it was not improper for [defendant] to assert the counterclaims of unfair competition, tortious interference with business relations, and section 285 attorney fees against [plaintiff].¹⁶

¹³ Doc. 162, 172.

¹⁴ Doc. 174.

¹⁵ 275 F.3d 1378, 1386 (Fed. Cir. 2002).

¹⁶ *Id.* Several district courts have found that they cannot award fees under § 285 to a party who obtains a dismissal *without* prejudice, because dismissal without prejudice is not final and does not render the moving party a "prevailing party." See, e.g., *Waterblasting Techs., Inc. v. Blasters, Inc.*, 2018 WL 791263 (M.D. Fla. Feb. 7, 2018); *Polyzen, Inc. v. RadiaDyne, LLC*, 2017 WL 5005990 (E.D.N.C. Nov. 2, 2017). These cases are not relevant here because the Court's patent summary judgment order dismissed Plaintiffs' patent infringement claim *with* prejudice after finding their standing issue incurable.

Case No. 19-cv-748
Gwin, J.

Thus, the Court keeps jurisdiction to hear Defendants' fees counterclaim.¹⁷

B. Timeliness

The Court also finds that Defendants' fees motion was timely filed.

Fed. R. Civ. P. 54(d)(2)(B) directs parties to file motions for attorneys' fees no later than 14 days after entry of judgment. Plaintiffs argue that Defendants' motion is untimely because Defendants should have moved for fees within 14 days of the Court granting partial summary judgment for Defendants on Plaintiffs' patent claim on August 23, 2022.

But unless a court has severed its order under Rule 54(b), an order granting only partial summary judgment is not a final judgment that triggers the 14-day window.¹⁸ Plaintiffs repeat an argument that this Court and the Federal Circuit have both already rejected, namely that the Court severed the patent issue and that its summary judgment order was a final order. Because this was not the case, Defendants' motion is not untimely.

C. Defendants' § 285 Counterclaim

1. Legal Standard

"An award of attorneys' fees under § 285 is intended to compensate the prevailing party for costs that it would not have incurred but for the conduct of the losing party and is within the sound discretion of the district court."¹⁹ Awarding fees is a two-step inquiry: the district court must determine "whether there is clear and convincing evidence that a case is

¹⁷ Plaintiffs bafflingly have repeatedly cited to *Astechnologies* to support their argument that the Court lacks jurisdiction over Defendants' fees claim. (Doc. 208 at PageID #: 6704; Doc. 223 at PageID #: 7012, n. 1). As demonstrated above, *Astechnologies* directly contradicts Plaintiffs' position. See also *Highway Equip. Co. v. FECO, Ltd.*, 469 F.3d 1027, 1032–33 (Fed. Cir. 2006) ("Highway Equipment first argues that the district court erred in retaining jurisdiction over FECO's request for attorney fees under 35 U.S.C. § 285 because, once Highway Equipment gave FECO a pre-verdict covenant not to sue on the patent infringement issues, the court lost Article III subject matter jurisdiction over the patent-based fee request. We disagree. Under our precedent, the district court correctly retained jurisdiction over FECO's claim for attorney fees under 35 U.S.C. § 285.").

¹⁸ *DeShiro v. Branch*, 183 F.R.D. 281, 284 (M.D. Fla. 1998).

¹⁹ *Campbell v. Spectrum Automation Co.*, 601 F.2d 246, 251 (6th Cir. 1979).

Case No. 19-cv-748
Gwin, J.

exceptional,” and if so, “whether an award of attorney fees is justified.”²⁰

A prevailing party may prove that a case is exceptional “by showing: inequitable conduct before the PTO; litigation misconduct; vexatious, unjustified, and otherwise bad faith litigation; a frivolous suit or willful infringement.”²¹

2. Inequitable Conduct

Defendants argue that from the outset, Plaintiff Lowe’s inequitable conduct before the PTO tainted this litigation.

“Inequitable conduct occurs when a patent applicant intentionally does not disclose to the PTO information that is material to their patent application.”²² Material information includes “any information that a reasonable examiner would be substantially likely to consider important in deciding whether to allow an application to issue as a patent.”²³ At the summary judgment stage, courts evaluate inequitable conduct based on whether a patent applicant (1) knew of highly material information, (2) knew or should have known that the information was material, and (3) has not credibly explained why they withheld that information from the PTO.²⁴

Here, Defendants argue that Plaintiff Lowe knew and did not disclose to the PTO that Defendant ShieldMark used to make a patented, prior art floor tape called DuraStripe. DuraStripe, like the ‘664 tape, is an industrial floor tape with unique beveled edges.²⁵ Lowe was indisputably familiar with DuraStripe when he applied for the ‘664 patent in 2015: he

²⁰ *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1372–73 (Fed. Cir. 2009).

²¹ *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp.*, 267 F.3d 1370, 1380 (Fed. Cir. 2001).

²² *M. Eagles Tool Warehouse, Inc. v. Fisher Tooling Co.*, 439 F.3d 1335, 1339 (Fed. Cir. 2006).

²³ *GFI, Inc. v. Franklin Corp.*, 265 F.3d 1268, 1274 (Fed. Cir. 2001).

²⁴ *Ferring B.V. v. Barr Lab’ys, Inc.*, 437 F.3d 1181, 1191 (Fed. Cir. 2006).

²⁵ Doc. 203 at PageID #: 6502.

Case No. 19-cv-748
Gwin, J.

worked as a DuraStripe distributor from 2004–2011.²⁶

Despite his familiarity with DuraStripe, Lowe submitted minimal information about the tape to the PTO. He provided a photograph depicting DuraStripe and Defendant ShieldMark’s current floor-tape product, Mighty Line, sitting side by side, and he provided a description of that photograph which read: “Photograph showing profiles of two floor-tapes; the left-hand tape was on sale in the United States prior to April 2004; the right-hand tape is on sale in 2018.”²⁷ Nothing he submitted identified DuraStripe by name or patent number.

Lowe argues that he satisfied his obligation to disclose DuraStripe when he submitted the photograph, and that he was not required to “interpret” the photograph for the examiner. He cites to cases finding that a “patent examiner is capable of independently evaluating the material before him, so the representations as to how to interpret that material cannot be the basis for a finding of inequitable conduct.”²⁸ The Court is skeptical of the extent to which these cases apply, as they all appear to involve scenarios where the Patent Office had enough information to identify the prior art at issue.

Although a close question, the Court nevertheless does not find that Lowe engaged in inequitable conduct rising to a level that merits a fee award. Lowe did not hide the existence of DuraStripe or the possibility of prior art entirely—he noted to the patent office that the photograph contained a tape on sale since 2004. Because there was some limited effort to disclose, Defendants have not established by clear and convincing evidence that Lowe intended to and did withhold material information.

²⁶ *Id.*

²⁷ *Id.* at PageID #: 6501. Although Lowe first applied for the ‘664 patent in 2015, it was not issued until 2019—hence Lowe’s submission of a photograph noting that there was a floor tape on sale as late as 2018.

²⁸ See, e.g., *Exergen Corp. v. Brooklands Inc.*, 290 F. Supp. 3d 113, 124 (D. Mass. 2018) (cleaned up).

Case No. 19-cv-748
Gwin, J.

3. Litigation Misconduct

Even if the Court declines to award Defendants fees based on inequitable conduct, the Court still has discretion under § 285 to award Defendants fees based on other litigation misconduct that the Court finds to be “exceptional.”

The Court will not repeat the entirety of its previous summary judgment order. Suffice to say that by December 16, 2021, the day that Plaintiff Spota LLC licensed the ‘664 patent to Insite Delaware, Plaintiffs knew that Defendants had previously requested production of any documents relating to ownership and licensing of the ‘664 patent.²⁹ They knew that back in July 2019, their only responses to Defendants’ requests for production on ownership had been that there were “no responsive documents.”³⁰ Plaintiffs knew that there now were, in fact, responsive documents. Finally, Plaintiffs knew that under Fed. R. Civ. P. 26(e)(1)(A), they had a duty to supplement their prior discovery responses in a “timely manner.”

Instead, Plaintiffs (1) took no initiative to supplement their productions; (2) refused to produce the ownership and license documents when confronted by Defendants; and (3) filed a Fourth Amended Complaint in which Plaintiffs explicitly misrepresented to Defendants and to this Court the status of the patent.

Indeed, the Fourth Amended Complaint, filed six months after the ownership and licensing transfers occurred, blatantly misrepresented that “Lowe is the owner of all rights, title, and interest in and to the ‘664 patent. InSite is an exclusive licensee under the ‘664 patent [...]. Lowe and InSite share rights of enforcement and recovery under the ‘664 patent.”³¹

²⁹ Doc. 169-3 at PageID #: 6089.

³⁰ *Id.*

³¹ Doc. 127 at PageID #: 5259.

Case No. 19-cv-748
Gwin, J.

Plaintiffs argue that they did not “hide” Lowe’s sale of the patent to Spota LLC because the agreement was publicly available, as evidenced by the fact that Defendants eventually discovered it.³²

To quote a fellow district court:

How absurd! The Federal Rules do not shield publicly available documents from discovery merely because of their accessibility. A limitation of this nature would lead to patently absurd consequences. Indeed, it would require litigants to scour the public domain for nuggets of information [...]—a task that is as Herculean as it is nonsensical.³³

And Plaintiffs’ argument is particularly unconvincing considering Plaintiffs’ explicit misrepresentations. Plaintiffs not only failed to disclose information that they had a duty to disclose, but actively misrepresented to Defendants and to the Court the ‘664 patent’s status.

Finally, Plaintiffs argue that it should not have mattered whether they disclosed the ownership and licensing transfers because the transfers would have had no impact on the litigation had this Court not erroneously determined that Plaintiffs now lack standing.³⁴ In other words, Plaintiffs lament that the transfers would have been irrelevant if only the Court had not found them dispositive. But the transfers did prove dispositive, and Plaintiffs’ failure to timely disclose those transfers prevented Defendants from moving for summary judgment sooner.

Thus, Plaintiffs’ actions strongly support an inference of bad faith and a finding of

³² Doc. 220 at PageID #: 6992.

³³ *Shatsky v. Syrian Arab Republic*, 312 F.R.D. 219, 223–24 (D.D.C. 2015). *See also Martino v. Kiewit New Mexico Corp.*, 600 F. App’x 908, 911 (5th Cir. 2015) (“[E]ven if a document is publicly available or in the opposing party’s possession, a party must still disclose it under Rule 26(a)(1)(A) to provide notice of evidence central to its claims or defenses.”).

³⁴ Doc. 220 at PageID #: 6993.

Case No. 19-cv-748
Gwin, J.

litigation misconduct. The Court finds that there is a direct “causal connection”³⁵ between Plaintiffs’ conduct and the fees and costs that Defendants incurred in litigating Plaintiffs’ patent claim from December 2021 onwards, and it will award those expenses to Defendants.

D. The Court’s Inherent Power to Sanction

The Court notes that its inherent power to craft sanctions also serves as an alternative basis to award Defendants the above patent litigation fees. The “assessment of attorney’s fees is undoubtedly within a court’s inherent power,” particularly “when a party has acted in bad faith, vexatiously, wantonly, or for oppressive reasons.”³⁶ These inherent powers are not displaced by a statute’s sanctions scheme, and likewise “can be invoked even if procedural rules exist which sanction the same conduct.”³⁷

E. Fees for Defendants’ Motion to Seal

Defendants ask for the fees and costs they incurred when they needed to seek the sealing of an expert report that they say Plaintiffs should have filed under seal in the first instance. At the time that Plaintiffs filed the report, there was no protective order in place. But the parties were subject to—and Defendants say Plaintiffs violated—the confidentiality-designation and disclosure provisions in this district’s Local Patent Rule 2.2.

Ordinarily, Fed. R. Civ. P. 37(b) governs discovery sanctions. But Rule 37(b)(2)(C) only addresses awarding attorneys’ fees when a party violates a “discovery order.” The plain language of Rule 37 does not appear to encompass sanctions for violations of local discovery rules. Nevertheless, the Court’s inherent power to craft sanctions “extends to a full range of litigation abuses,” in part because that power exists to “fill in the interstices” that sanctions

³⁵ *In re Rembrandt Techs. LP Pat. Litig.*, 899 F.3d 1254, 1280 (Fed. Cir. 2018).

³⁶ *Chambers v. NASCO, Inc.*, 501 U.S. 32, 45–46 (1991).

³⁷ *Id.* at 46–48.

Case No. 19-cv-748
Gwin, J.

statutes and rules do not cover.³⁸ Thus, the Court will consider whether sanctions under that inherent power are merited here.

Local Patent Rule 2.2 instructs:

Pending entry of a protective order, discovery and disclosures deemed confidential by a party shall be produced to the adverse party for the eyes of outside counsel of record only, marked "Attorney's Eyes Only Subject to Protective Order." The discovery and disclosures so marked shall be used solely for purposes of the pending case and shall not be disclosed to the client or any other person.

Despite L.P.R. 2.2's restrictions on disclosure, Plaintiffs publicly filed an expert report that disclosed information Defendants had marked as Attorney's Eyes Only.³⁹

Plaintiffs argue that filing the report did not violate L.P.R. 2.2 because the information disclosed was already in the public domain. Plaintiffs are correct that some—but not all—of the information disclosed could be found in public records.⁴⁰

But parties are not automatically free to disclose information marked confidential simply because that information can also be found in the public domain.⁴¹ And the plain language of L.P.R. 2.2 makes no such exception.

So, the Court will award Defendants fees and costs arising from litigating Plaintiffs' disclosure.

F. Reasonableness of Fee Awards

Once a court determines that a party is entitled to a fee award, it must determine a

³⁸ *Id.* at 46.

³⁹ Doc. 218 at PageID #: 6911–6912.

⁴⁰ The Court agrees that a previous litigation had already disclosed certain of Defendant ShieldMark's royalty rate terms. But that earlier filing did not identify the specific licensee who had agreed to those rates. And, contrary to Plaintiffs' assertions, ShieldMark does not appear to have publicly disclosed its exact sales figures.

⁴¹ See e.g., *Doherty v. State Farm Gen. Ins. Co.*, 2020 WL 2510642, at *4 (C.D. Cal. Mar. 4, 2020) (Defendant violated protective order because the order did not explicitly permit Defendant to disclose information marked Highly Confidential when that information "might be available in some form on the Internet.").

Case No. 19-cv-748
Gwin, J.

reasonable amount to award.⁴² The court starts with a strong presumption that the proper amount is the “number of hours reasonably expended on the litigation multiplied by a reasonable hourly rate.”⁴³ But the “product of reasonable hours times a reasonable rate does not end the inquiry. There remain other considerations that may lead the district court to adjust the fee upward or downward,”⁴⁴ including the attorneys’ “customary fee[s]”; “the amount involved and the results obtained”; and “the experience, reputation, and ability of the attorneys.”⁴⁵

Here, Defendants are entitled to reasonable fees and costs incurred in defending against Plaintiffs’ patent infringement claim from December 2021 onwards. Likewise, the Court awards Defendants the reasonable fees and costs incurred in seeking redress for Plaintiffs’ improper disclosures. So, the Court will examine whether Defendants’ requested amounts are based on a reasonable number of hours and reasonable rates.

Based on the fee tables Defendants submitted, they seek:

1. \$213,765 for litigating Plaintiffs’ patent infringement claim.⁴⁶
2. \$4,750 for the disclosure issue.

The Court finds that Defendants have provided sufficient detail in their fee tables to establish reasonable hours. The entries identify specific tasks, specific people with whom

⁴² *Bldg. Serv. Loc. 47 Cleaning Contractors Pension Plan v. Grandview Raceway*, 46 F.3d 1392, 1401 (6th Cir. 1995).

⁴³ *Id.*

⁴⁴ *Hensley v. Eckerhart*, 461 U.S. 424, 434 (1983).

⁴⁵ *Paschal v. Flagstar Bank*, 297 F.3d 431, 435 (6th Cir. 2002). *See id.* for additional factors generally considered.

⁴⁶ Defendants’ fee tables only list patent litigation fees for May 2022, rather than December 2021, onwards. This is because in June 2021, this Court granted summary judgment for Defendants. Plaintiffs still had standing at that time, and they appealed the summary judgment decision. The case remained inactive at the district-court level until April 2022, when the Federal Circuit reversed that initial summary judgment decision and remanded the case to this Court.

Case No. 19-cv-748
Gwin, J.

Defendants' attorneys conferred (such as co-counsel) and their topics of conversation, etc.⁴⁷

Defendants have also removed from the tables time deemed duplicative and time spent on other claims, such as Plaintiffs' Lanham Act claim and Defendants' inequitable conduct counterclaim.

As to the reasonableness of Defendants' attorneys' rates, Defendants have submitted a report from the American Intellectual Property Law Association to establish that their attorneys' \$400/hour rate is below the average for intellectual property lawyers in the Midwest with similar levels of experience.⁴⁸ Of the four lawyers claiming fees, one has 10 years of experience in intellectual property, while the other three each have between 23 – 29 years of experience.⁴⁹

Looking at the report, Defendants correctly identify \$421/hour as the mean billing rate for IP lawyers in the Midwest across all experience levels.⁵⁰ But the median is only \$390.⁵¹ On the other hand, if the Court looks at billing rates based on years of practice, the proposed \$400/hour rate is well below the national median (\$500) for attorneys with 25–34 years of experience, and nearly identical to the national median (\$398) for attorneys with 10–14 years of experience.⁵² Reasonable billing rates in this case thus fall within a range from \$390–\$500. Accordingly, the Court finds Defendants' \$400/hour rate reasonable.

Finally, Plaintiffs did not object to Defendants' proposed rates, and the only objection that they raised to the reasonableness of Defendants' hours calculation was that Defendants

⁴⁷ See, e.g., Doc. 218-1 at PageID #: 6932 (6/17/22 entry for 2.8 hours describing attorney's work reading court order, conferring with co-counsel by phone, reading and drafting emails, researching possible experts, etc.)

⁴⁸ *Id.* at PageID #: 6922, 6971. Defendants rely on the rates for the "Other Central" category, which provides rates for the Midwest excluding the Chicago and Minneapolis-St. Paul metro areas.

⁴⁹ *Id.* at PageID #: 6922–25.

⁵⁰ The Court uses the term Midwest here to refer to the "Other Central" category.

⁵¹ *Id.* at PageID #: 6971.

⁵² *Id.*

Case No. 19-cv-748
Gwin, J.

also protracted this action by staying it for over a year while the parties proceeded before the PTO's Patent Trial and Appeal Board.⁵³ Since Defendants have not sought to recover fees for those proceedings, the Court finds this objection beside the point.

III. CONCLUSION

The Court **GRANTS IN PART** Defendants' motion as to fees and costs incurred after December 2021 for the patent litigation and for the motion to seal and **DENIES IN PART** Defendants' motion as to patent litigation fees incurred before December 2021. Defendants are awarded \$213,765 for litigating Plaintiffs' patent infringement claim and \$4,750 for fees and costs arising from Plaintiffs' violation of L.P.R. 2.2.⁵⁴

IT IS SO ORDERED.

Dated: April 21, 2023

s/ James S. Gwin
JAMES S. GWIN
UNITED STATES DISTRICT JUDGE

⁵³ Doc. 220 at PageID #: 6998–7000.

⁵⁴ Unrelatedly, the Court also **DENIES** as moot Plaintiffs' motion to strike Defendants' response to the Court's August 26, 2022 Opinion and Order. (Doc. 199). Plaintiffs moved to strike Defendants' response on the grounds that the Court's partial summary judgment order deprived it of jurisdiction to order Defendants to file a response. This argument was rejected by the Federal Circuit when it dismissed Plaintiffs' appeal. (See Doc. 212). As previously stated above, the Court also **DENIES** as moot Plaintiffs' recent motion to clarify. (Doc. 223).

**IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO**

CLIFFORD A. LOWE)	
)	
PLAINTIFF,)	CASE NO.: 1:19-CV-748
v.)	
)	JUDGE JAMES S. GWIN
SHIELDMARK INC., et al.,)	
)	ORDER
DEFENDANTS.)	

The Court entered an Opinion and Order on August 23, 2022, March 16, 2023 and April 21, 2023. Accordingly, the Court dismisses this case pursuant to Rule 58 of the Federal Rules of Civil Procedure.

IT IS SO ORDERED.

Dated: April 21, 2023

s/ James S. Gwin
JAMES S. GWIN
UNITED STATES DISTRICT JUDGE