

United States District Court
Northern District of California

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

SEALANT SYSTEMS INTERNATIONAL,
INC, et al.,

 Plaintiffs,

 v.

TEK GLOBAL, S.R.L., et al.,

 Defendants.

Case No. [5:11-cv-00774-PSG](#)

**ORDER DENYING MOTION FOR
SUMMARY JUDGMENT ON
INVALIDITY**

(Re: Docket No. 368)

In 2013, this court invalidated as obvious United States Patent No. 7,789,110.¹ The court held that an ordinarily skilled artisan would be motivated to combine U.S. Patent Application Pub. 2003/0056851 (“Eriksen”) and Japanese Patent No. 2004-338159 (“Bridgestone”) to practice the ’110 patent and each of its asserted claim limitations.² The Federal Circuit reversed, holding that under the proper construction of “cooperating with,” neither reference disclosed an “additional hose cooperating with” a tire.³ Having corrected this court’s claim construction error, the appellate court remanded the issue of obviousness because Defendants had not “had an opportunity to make a case for invalidity in light of this court’s claim construction.”⁴ Defendants Sealant Systems International, Inc. and ITW Global Tire Repair now renew their obviousness

¹ See Docket No. 134 at 5-18.

² See id.

³ See Docket No. 357, Sealant Systems Int’l., Inc. v. TEK Global, S.R.L., 616 Fed. App’x 987, 993-96 (Fed. Cir. 2015).

⁴ Id. at 996.

1 challenge in the form of a renewed motion for summary judgment.⁵ Defendants return with
2 Eriksen and Bridgestone in hand, as well as a third reference: United States Patent No. 4,498,515
3 (“Holtzhauser”).⁶ Having reviewed the parties’ papers and considering their additional arguments
4 at last week’s hearing, the court DENIES Defendants’ motion.

5 **First**, genuine issues of material fact remain regarding the combination of Eriksen and
6 Holtzhauser. To be sure, the Federal Circuit agreed with this court and the parties that Eriksen
7 discloses all the limitations in disputes except “a three-way valve” and “an additional hose.”⁷ But
8 even if Holtzhauser solves this problem for Defendants—which itself is a hotly contested issue⁸—
9 a reasonable jury could find that it creates others, especially in light of Defendants’ burden of
10 proving invalidity by clear and convincing evidence. In particular, Plaintiffs’ own expert Randall
11 King acknowledges that Holtzhauser disclosed a remote-controlled onboard tire inflation system
12 rather than a portable repair kit like what the ’110 patent discloses.⁹ One might reasonably
13 question an ordinarily skilled artisan’s motivation to combine such references to practice that
14 which is claimed.

15 **Second**, the Federal Circuit has already considered and rejected obviousness in light of the
16 combination of Eriksen and Bridgestone. Defendants are correct that the appellate court gave
17 them another chance to challenge the ’110 patent’s validity.¹⁰ But they ignore completely that the
18 Federal Circuit already took it upon itself to say what Bridgestone does and does not teach, as well

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20 ⁵ See Docket Nos. 368, 101.

21 ⁶ See Docket No. 368 at 2-3.

22 ⁷ Sealant Sys. Int’l, 616 Fed. App’x at 994; see also Caldwell v. Unified Capital Corp. (In re
23 Rainbow Magazine, Inc.), 77 F.3d 278, 281 (9th Cir. 1996) (“The law of the case doctrine states
24 that the decision of an appellate court must be followed in all subsequent proceedings in the same
25 case.”).

26 ⁸ See, e.g., Docket No. 376-1 at ¶¶ 71-74, 78-79.

27 ⁹ See Docket No. 376-3 at 80:23-81:19; Docket No. 376-1 at ¶ 70.

28 ¹⁰ See Sealant Sys. Int’l, 616 Fed. App’x at 996.

1 as the motivation to combine Eriksen with this reference. It said, without qualification and after
2 specifically considering the same sections that Defendants point to now, that “neither Bridgestone
3 nor Eriksen teach[es] the use of ‘an additional hose [] cooperating with’ the tire.”¹¹ It also held
4 that “**even if** a skilled artisan would be motivated to combine the two references,” the combination
5 would not produce the claimed invention.¹² Whatever other references might have been relied on
6 for the missing limitation following remand, the law of the case prevents any second-guessing by
7 this court.

8 **SO ORDERED.**

9 Dated: May 31, 2016

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11 PAUL S. GREWAL
12 United States Magistrate Judge

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25 _____
26 ¹¹ Id.

27 ¹² Id. at 95-96 (emphasis added).