

UNITED STATES DISTRICT COURT
Northern District of Indiana
South Bend Division

HEARTLAND RECREATIONAL)
VEHICLES, LLC,)
Plaintiff,)
)
)
)
v.)
)
FOREST RIVER, INC.,)
Defendant.)

CASE NO.: 3:08-cv-490 JD

**MEMORANDUM IN SUPPORT OF
HEARTLAND'S MOTION FOR SUMMARY JUDGMENT**

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STATEMENT OF ISSUES

- I. Can Forest River, Inc. ("Forest River") create an issue of material fact as to whether Heartland Recreational Vehicles, LLC ("Heartland") and its patent attorneys committed inequitable conduct where there is no evidence that any party substantively involved in the prosecution of U.S. Patent No. 7,278,650:
 - a. failed to disclose material information of which they had knowledge to the Patent Office;
 - b. submitted materially false information to the Patent Office; or
 - c. possessed a specific intent to deceive the Patent Office?

- II. Can Forest River create an issue of material fact as to whether Heartland violated the Lanham Act where there is no evidence that:
 - a. a Heartland employee made a misrepresentation while delivering its promotional materials to certain hotels on October 22, 2008;
 - b. a Recreational Vehicle ("RV") dealer could have been confused by Heartland's alleged conduct;
 - c. a Heartland employee made a misrepresentation about the goods Heartland and Forest River offer for sale, i.e. RVs; or
 - d. Forest River suffered monetary damage as a result of actual consumer reliance upon a false statement by Heartland, or that a false statement by Heartland proximately caused Heartland to gain profits?

- III. Can Forest River create an issue of material fact as to whether Heartland committed criminal deception where there is no evidence that:
 - a. a Heartland employee made a misrepresentation while delivering its promotional materials to certain hotels on October 22, 2008;
 - b. Forest River was the target of an alleged fraud; or
 - c. Forest River suffered pecuniary harm as a proximate result of Heartland's alleged conduct?

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I. INTRODUCTION

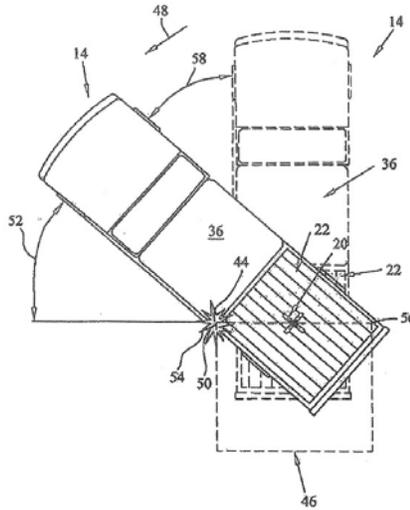
In its Amended Answer, Defenses, and Counterclaims (the "Amended Answer"), Forest River, Inc. ("Forest River") asserts three counterclaims against Heartland Recreational Vehicles, LLC ("Heartland"): (1) inequitable conduct in the prosecution of U.S. Patent No. 7,278,650 (the "'650 patent"); (2) "passing off" or "palming off" in violation of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A); and (3) criminal deception in violation of Ind. Code §§ 35-43-5-3(6) & 34-24-3-1. These counterclaims falsely accuse Heartland of a wide array of deceptive conduct. Ultimately, though, the counterclaims consist of mere conspiracy theories, conjecture, and futile attempts to extend applicable law beyond its clear limits. Because Forest River's counterclaims have no evidentiary or legal basis, the Court should grant Heartland's Motion.

The Federal Rules of Civil Procedure provide that motions for summary judgment should be granted "if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). As the evidence designated by Heartland will demonstrate, no issue of material fact exists with respect to any of Forest River's counterclaims, and Heartland is entitled to summary judgment.

II. HEARTLAND AND ITS ATTORNEYS DID NOT COMMIT INEQUITABLE CONDUCT

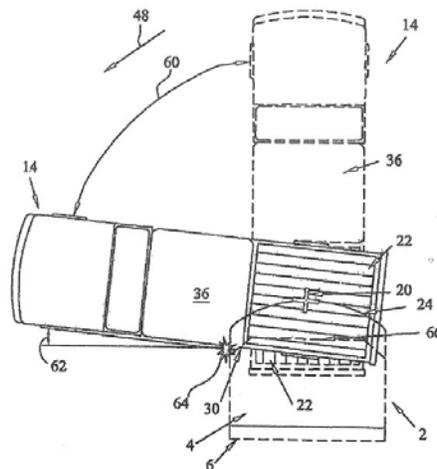
In 2003, five individuals—Brian Brady, Scott Tuttle, John Rhymer, Timothy Hoffman, and Doug Lantz—formed Heartland. Hoping to find a niche in the RV market, Heartland began searching for a way to differentiate its flagship fifth wheel from the competitors' models. The emerging trend of extended cab and short-bed pickup trucks provided the Heartland owners with a perfect opportunity. Because these truck designs brought the front of fifth wheels closer to truck cabs, they significantly reduced a fifth wheel's turning radius. (SOF 6.) All too

often, this reduced turning radius caused the front corner of the fifth wheel to collide with the truck cab, resulting in broken windows, dented cabs, and crunched fiberglass, as shown in Figure 4 of the '650 patent. (*Id.*)



(Exh. H, Fig. 4); (Exh. MM.)

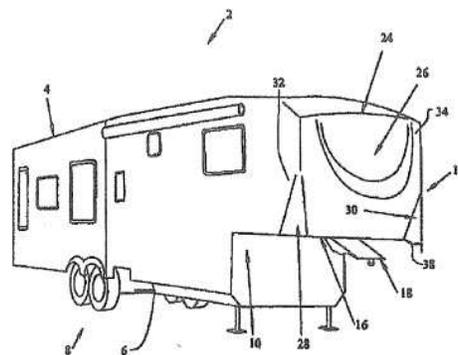
Heartland created a solution to that problem—a unique fifth wheel design featuring a frame and front end cap with notched corners. As shown below, the invention allows for an improved turning radius for RV owners.



(Exh. H, Fig. 5.); (Exh. NN.)

The named Heartland inventors decided to apply for a patent for their invention. Heartland owner Scott Tuttle was assigned the task of procuring the patent, and he acted as the primary liaison between the named Heartland inventors and their patent attorneys. (SOF 4, 16.)

Tuttle provided patent attorney Gregory Cooper with a detailed written description of the invention. "This revolutionary concept involves both rethinking how the steel frame of the 5th wheel is designed, as well as [] how the [] fiberglass front cap design flows in relationship to the frame...By angling the frame back at the corners, and incorporating a sweeping design in the fiberglass front cap that flows back and over that section of the frame...we have essentially 'cut off' the lower corners of the front of the 5th wheel, resulting in a 30%+ increased turning radius." (SOF 7.) As Tuttle's description shows, Heartland's invention contributed an entirely new innovation to the design of fifth wheel RVs. Heartland removed **just enough of the bottom corners** of the trailer's frame and fiberglass cap to improve the turning radius, as shown in the figure below from the '650 patent.



(Exh. H, p. 1)

Heartland's unique design provides all the benefits of an improved turning radius while sacrificing very little of the living space that RV consumers need. The patent application that resulted in the '650 patent included over 30 claims directed to the design of the shell of the fifth

wheel and its frame. (SOF 30.) The '650 patent has only 3 claims, each of which is directed to the frame. (*See* Exh. H, p. 8.) The '650 patent issued on October 9, 2007. (Exh. H, p. 1.)

In an attempt to render the '650 patent (and any future related patents) unenforceable, Forest River has accused Heartland of inequitable conduct. In its Amended Answer and interrogatory responses, Forest River baselessly claims that the named inventors or their highly reputable attorneys, Gregory Cooper and Gerard Gallagher, acted deceptively in nearly every conceivable phase of the patent prosecution process. Both Cooper and Gallagher are currently partners with the law firm of Barnes & Thornburg. (SOF 3, 15.) Inequitable conduct is an exceptionally serious offense with severe penalties for both inventors and attorneys. Therefore, the Federal Circuit requires proof by **clear and convincing evidence** that inventors or their counsel intentionally deceived the Patent Office in order to obtain a patent.

For the reasons outlined below, Forest River cannot create a material issue of fact with respect to its allegation of inequitable conduct.

A. The Inequitable Conduct Standard is Very High¹

"A patent may be rendered unenforceable for inequitable conduct if an applicant, with intent to mislead or deceive the examiner, fails to disclose material information or submits materially false information to the PTO during prosecution." *Digital Control, Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1313 (Fed. Cir. 2006). In order to protect inventors from having their patents rendered unenforceable due to mere careless errors, inattention, or honest misunderstandings that occur during the patent application process, courts have designed an intricate and stringent test to evaluate claims of inequitable conduct.

¹ Recently, the Federal Circuit agreed to a rehearing en banc of its decision in *Therasense Inc. v. Becton, Dickinson & Co.* *See* 374 Fed. Appx. 35 (Fed. Cir. April 26, 2010). The Federal Circuit requested that the parties address the prudence of the current inequitable conduct standard, including whether the Federal Circuit should adopt an inequitable conduct standard more akin to common law fraud. *Id.* at 36. The Federal Circuit has yet to issue its en banc opinion in *Therasense*.

First, Forest River must prove **by clear and convincing evidence** that Heartland either submitted false material information to the Patent Office or deliberately withheld material information from the Patent Office. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008). Information is material if a reasonable examiner would have considered it important in deciding whether to allow the application. *Id* at 1367. Importantly, "[a]n applicant has no duty to disclose a reference to the PTO if it is cumulative of or less material than references already before the examiner." *Rothman v. Target Corp.*, 556 F.3d 1310, 1326 (Fed. Cir. 2009).

In addition to proving the materiality of any omitted or false information by clear and convincing evidence, Forest River must then prove by **clear and convincing evidence** that Heartland's conduct was driven by an intent to deceive the Patent Office. *Digital Control*, 437 F.3d at 1313. The level of intent Forest River must prove by clear and convincing evidence is very high. If a misleading statement or failure to disclose occurs through negligence, oversight, carelessness, an error in judgment, **or even gross negligence**, there is no intent to deceive and there is no inequitable conduct. *Kingsdown Med. Consultants v. Hollister, Inc.*, 863 F.2d 867, 876 (Fed.Cir. 1988). Because Forest River is accusing Heartland of intentionally withholding material information, it must present clear and convincing evidence that Heartland "**made a deliberate decision** to withhold a **known** material reference." *Star Scientific, Inc.*, 537 F.3d at 1366 (quoting *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1181 (Fed. Cir. 1995) (emphasis in original)). In order to meet the clear and convincing standard, an inference of deceptive intent must "be the single most reasonable inference to be drawn from the evidence." *Id*.

"If a threshold level of intent to deceive or materiality is not established by clear and convincing evidence, the district court does not have any discretion to exercise and cannot

hold the patent unenforceable regardless of the relative equities or how it might balance them." *Id.* at 1367. If materiality and intent are each independently shown by clear and convincing evidence, the Court must then make a separate, discretionary decision whether to find inequitable conduct and render the patent unenforceable. In exercising this discretion, the Court must "balance the **substance** of those now-proven facts and all the equities of the case to determine whether the severe penalty of unenforceability should be imposed." *Id.* (emphasis in original).

Forest River cannot prove by clear and convincing evidence that Heartland had actual knowledge of material information and then made a deliberate decision to withhold that material information. Forest River cannot prove by clear and convincing evidence that Heartland knowingly submitted materially false information. Forest River cannot prove by clear and convincing evidence that Heartland at any time possessed the specific intent to mislead or deceive the Patent Office. Accordingly, Forest River cannot create an issue of material fact with respect to its claim of inequitable conduct. Heartland did not commit inequitable conduct and is entitled to summary judgment.

B. There is No Evidence That Heartland or its Attorneys Intended to Deceive the Patent Office

Before analyzing each of Forest River's allegations of inequitable conduct, Heartland emphasizes that there is simply no issue of material fact as to whether Heartland intended to deceive the Patent Office during the prosecution of the '650 patent. At no point in this litigation has a witness for either Heartland or Forest River accused Heartland of attempting to intentionally deceive the Patent Office. On the contrary, the evidence in this case universally shows that no one with a duty of disclosure had any intention to deceive the Patent Office.

Scott Tuttle, the Heartland employee responsible for obtaining the patent, affirms that he did not intentionally lie to the Patent Office, that he did not intentionally deceive the

Patent Office, and that he did not intentionally withhold any references of any type from the Patent Office. (SOF 83.)

Named inventor Doug Lantz affirms that he did not intentionally withhold any prior art from the Patent Office and did not intentionally misrepresent any prior art to the Patent Office; furthermore Lantz has no information indicating that the five original Heartland owners were named as inventors in order to deceive anyone. (SOF 66, 87, 88.)

John Rhymer testified that he believes that the named inventors complied with their duty of disclosure under the Patent Rules. (SOF 20.) Rhymer further testified that he and Tuttle discussed potential examples of prior art, but that he did not consider himself an expert in evaluating prior art and did not believe he could tell Tuttle whether a particular reference constituted prior art. (SOF 21, 45.)

There is no evidence that Brian Brady was aware of any allegedly withheld material prior art, or that he withheld any material prior art. (*see generally* SOF 32-43, 131.).

Forest River did not ask Timothy Hoffman about his knowledge of specific prior art during the patent prosecution or whether he withheld any information with deceptive intent. Hence, there is no evidence supporting a claim that Hoffman committed inequitable conduct.

Heartland attorney Gregory Cooper states that he did not mislead or mischaracterize any fact to the Patent Office in prosecuting the '650 patent. (SOF 91.)

Heartland attorney Gerard Gallagher believes that neither he nor anyone else involved in the prosecution of the '650 patent committed inequitable conduct. (SOF 92.)

Patent law expert Jay Taylor, a retired partner with the law firm of Ice Miller, reviewed the patent prosecution files, the pleadings, and discovery in this matter. In his expert

opinion, there is no evidence that Heartland had any intent to deceive the Patent Office. (*See generally* SOF 104-132.)

Finally, Jeff Babcock, Forest River's 30(b)(6) designee on the topic of inequitable conduct, concedes that Heartland had no intent to deceive the Patent Office. Babcock opines that Heartland did not act "knowingly" in its alleged conduct during the prosecution of the '650 patent. (SOF 97, 98.) Babcock testified that Scott Tuttle, the Heartland employee responsible for gathering information about the invention and providing it to Heartland's attorneys, is a "truthful" individual. (SOF 95.) Babcock testified that Heartland's John Rhymer is "very honest." (*Id.*) When asked whether Rhymer and Tuttle intentionally lied to the Patent Office, Babcock admitted that they "didn't intentionally go out and say 'We're gonna lie to the patent office here and try to prove something here.' I don't think that their scope was broad enough prior to filing that. Then they should've or their attorney should've caught that." (SOF 96.) But even if Heartland or its attorneys failed to "catch" something, Forest River cannot counter Heartland's "I didn't know" with an assertion that they "should have known." *Kingsdown*, 863 F.2d at 875, n. 11, 876. The inequitable conduct defense exists to penalize parties who intentionally deceive the Patent Office, not to punish inventors and attorneys for ignorance or lapses in professional practice and judgment. *Id.* at 876.

The Court can dispose of Forest River's inequitable conduct claim very easily. Because the evidence designated by Heartland clearly demonstrates that all parties, including Forest River, agree that Heartland did not intend to deceive the Patent Office, Heartland is entitled to summary judgment as a matter of law.

C. **None of Forest River's Allegations Support a Finding of Inequitable Conduct**

Forest River's Amended Answer and its answers to Heartland's interrogatories contain numerous unfounded allegations of inequitable conduct. (Exh. K, Am. Ans. ¶¶ 47-56); (Exh. J, Resp. to Interrog. No. 3.) A methodical analysis of each individual allegation by Forest River confirms that Heartland and its attorneys did not commit inequitable conduct. Heartland addresses each allegation in turn.

1. **Heartland's specification was not misleading**

Forest River alleges that Heartland misled the Patent Office with the following statement in the '650 patent specification: "Conventionally, the upper deck of a typical fifth wheel has a rectangular or parallelogram-shape footprint whose forward corners form right angles." (Exh. H); (Exh. K, Am. Ans. ¶ 47.) The statement in Heartland's specification is true. In the context of a patent, "conventionally" merely means "known in the art." (SOF 107.) Heartland provided the Patent Office with U.S. Patent Nos. 6,343,830; 6,860,545, 6,170,903; and 5,746,473. These references all depict upper decks with corners forming right angles. (*See* Exh. H, p. 1, listing disclosed patents); (Exhs. V – Figs. 1 & 2, W – Figs. 1 & 2, X – Figs. 1, 2A & 2B, & Y – Figs. 5 & 6); (SOF 107.) Accordingly, upper decks with rectangular corners are "known in the art," and Heartland's statement was accurate. (SOF 107.)

Forest River also claims Heartland's statement that Figure 9A of its specification depicts prior art is false and misleading. As Jay Taylor noted in his expert report, "the construction shown in Figure 9A of the '650 patent is very similar to the front edge construction shown in Figure 2 of U.S. Patent No. 6,860,545 and Figures 5 & 6 of U.S. Patent No. 5,746,473, thus showing that Figure 9A does depict prior art and was neither false nor misleading." (SOF 107); (Exh. H, Fig. 9A; Exh. W, Fig. 2; Exh. Y, Figs. 5 & 6.)

Neither of the statements referenced by Forest River is false. Additionally, given the veracity of the statements, obviously there can be no evidence that the named inventors or attorneys made them with deceptive intent. These allegations cannot support a finding of inequitable conduct.

2. Heartland was not required to admit the materiality of prior art

Forest River alleges that Heartland violated its duty of candor to the Patent Office by failing to admit that the references cited in its Information Disclosure Statement were material. (Exh. K, Am. Ans. ¶ 48.) There is simply no requirement under either the Patent Act or the Patent Office Rules that an applicant "admit" that disclosed information is either prior art or that it is material. (SOF 108) (citing Patent Rules 1.56, 1.97, and 1.98.) This allegation cannot form the basis of an inequitable conduct finding.

3. There is no clear and convincing evidence that Heartland knew of the Cardinal or Roadmaster fifth wheel trailer frames or withheld them with deceptive intent

Forest River has alleged that the named inventors had knowledge of a Roadmaster fifth wheel trailer frame and a Forest River Cardinal fifth wheel trailer frame, and that Heartland withheld them from the Patent Office with deceptive intent. There is no clear and convincing evidence that either the named inventors or Heartland's attorneys knew of these frames or that they withheld them in order to deceive the Patent Office.

Heartland's Brian Brady does not recall ever seeing the Roadmaster trailer frame. (SOF 41.) Brady testified that he does not know if Roadmaster was ever a competitor with any company for which he worked. (*Id.*) Brady also has no recollection of ever seeing **any** trailers made by Roadmaster. (*Id.*) John Rhymer has never seen an RV similar to the Roadmaster

trailer. (SOF 47.) Upon viewing a sketch of the Roadmaster frame during his deposition, Rhymer did not think that it could have constituted prior art because it is a cargo trailer. (*Id.*)

Similarly, there is no clear and convincing evidence that any of the named inventors had knowledge of the Forest River Cardinal fifth wheel frame. (*See* SOF 57, 116.) Indeed, Heartland is uncertain whether the Cardinal frame even constitutes prior art, as the document Forest River produced depicting this frame contains the word "PROTO," indicating that this may be a prototype that was never used in a trailer offered for sale. (*See* Exh. M.)

Again, Forest River's burden of proof is extremely high. Because Forest River is accusing Heartland of intentionally withholding material information, it must prove by clear and convincing evidence that Heartland "**made a deliberate decision** to withhold a **known** material reference." *Star Scientific*, 537 F.3d at 1366. There is no clear and convincing evidence that Tuttle, Rhymer, Brady, Lantz, Hoffman, or Heartland's attorneys knew of these frames. Forest River may try to show their knowledge and deceptive intent through circumstantial evidence and speculation. But in order to meet the clear and convincing standard, an inference of deceptive intent must "**be the single most reasonable inference to be drawn from the evidence.**" *Id.* (emphasis added.)

Forest River cannot show that Heartland knew of the Roadmaster or Cardinal fifth wheel frames or that they made a conscious decision to withhold these frames in order to deceive the Patent Office. Thus, the non-disclosure of these frames cannot be inequitable conduct.

4. There is no evidence that Heartland knew of or intentionally withheld any other prior art trailers

In addition to its allegations regarding the Roadmaster and Cardinal fifth wheel frames, Forest River accuses Heartland of failing to disclose certain unpatented prior art trailers of which the named inventors supposedly knew. (Exh. K, Am. Ans. ¶ 48.) Forest River

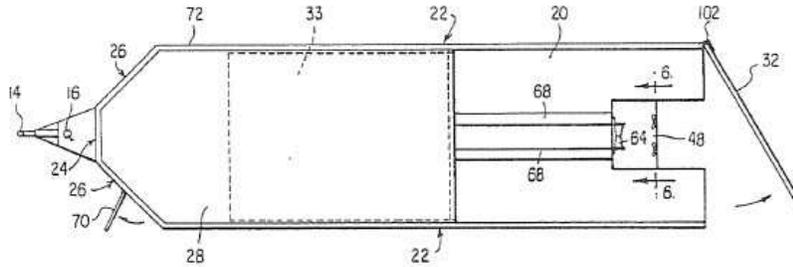
identifies these trailers as: (1) the Eliminator fifth wheel trailer; (2) the Cherokee fifth wheel trailer; (3) a Holiday Rambler fifth wheel trailer; and (4) the Space Craft fifth wheel trailer.

First, there is simply no clear and convincing evidence that the named inventors or attorneys (1) knew of these trailers; (2) recognized them as prior art material to their invention; and then (3) intentionally withheld them in order to deceive the Patent Office. (*See* SOF 38, 39, 40, 51, 52, 56, 71, 75, which collectively outline Heartland's statements regarding these trailers); (SOF 111-114.)

Furthermore, "[a]n applicant has no duty to disclose a reference to the PTO if it is cumulative of or less material than references already before the examiner." *Rothman v. Target Corp.*, 556 F.3d 1310, 1326 (Fed. Cir. 2009). All four of these trailers are cumulative of prior art actually before the examiner prior to the issuance of the patent. *See Molins PLC v. Textron, Inc.* 48 F.3d 1172, 1185 (Fed. Cir. 1995) ("When a reference was before the examiner, whether through the examiner's search or the applicant's disclosure, it cannot be deemed to have been withheld from the examiner.") That prior art includes U.S. Patent No. 4,767,132 (the "Avery Patent"), U.S. Patent Application No. 2002/0003341 (the "Hall Reference"), and DE 3321306 (the "Foreign Publication").² (Exhs. Z, AA, & BB.) These references are depicted below.

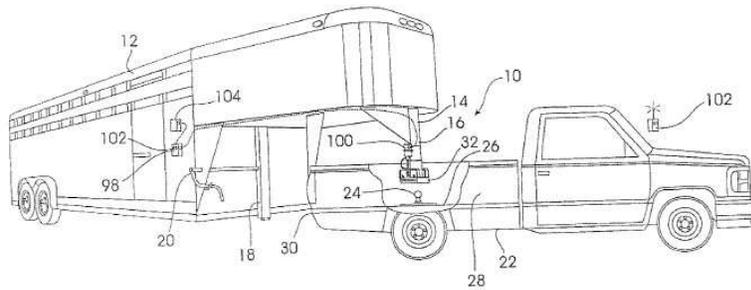
² Specifically, The Avery and Hall references were cited by the examiner in rejecting some of Heartland's claims in the patent application. This shows that the examiner was aware of prior art showing "V" nose and curved corner trailers and fifth wheels. (SOF 111.)

The Avery Patent ("V" nose/Tapered Front End)



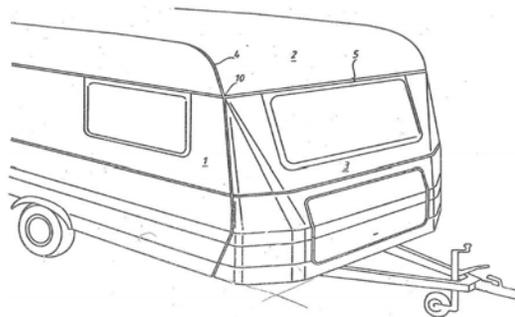
(Exh. Z, p. 1.)

The Hall Reference (Curved Front Corners)



(Exh. AA, p. 1.)

The Foreign Publication (Curved/Slanted Front Corners)



(Exh. BB, Fig. 1.)

As shown in Exhibit J of Heartland's Appendix, the Eliminator has curved front corners. (Exh. J.) This feature is disclosed in the Hall Reference and the Foreign Publication. (SOF 111); (Exhs. AA & BB.)

As shown in Exhibit CC of Heartland's Appendix, the Cherokee has both a "V" nose and curved front corners. (*See* Exh. CC); (SOF 112.) These concepts are disclosed in the three examples of prior art depicted above. (SOF 112.); (*see* Exhs. Z, AA, & BB.)

As shown in Exhibit DD of Heartland's Appendix, the Holiday Rambler has slanted or rounded front corners, which are disclosed in the Hall Reference and the Foreign Publication Reference. (*See* Exhs. DD, AA & BB); (SOF 113.)

As shown in Exhibit EE of Heartland's Appendix, the Space Craft fifth wheel trailer has a "V" nose front, a characteristic disclosed in the Avery Patent and the Hall Reference. (SOF 114); (*see* Exhs. EE, Z, & AA.)

The named inventors had no duty to disclose these cumulative trailers, and even if they did, their failure to do so resulted from a lack of knowledge or skill in evaluating prior art, not deceptive intent. Thus, the allegations regarding the Eliminator, the Cherokee, the Holiday Rambler, and the Space Craft trailers do not support a finding of inequitable conduct.

Finally, it is not clear from the pleadings and interrogatories whether Forest River is contending that the attorneys and named inventors should have disclosed the Shadow Cruiser fifth wheel, the Catalina Coachmen fifth wheel, or the Trail Bay fifth wheel toy hauler.

Regardless, for the sake of completeness, there is no evidence that anyone subject to a duty of disclosure: (1) knew of these references and considered them material to the '650 patent; or (2) withheld them in an attempt to deceive the Patent Office. (*See* SOF 37, 46, 58, 59, outlining named inventors' lack of knowledge regarding these products); (SOF 117, 118, 119.)

Furthermore, these trailers are also cumulative of prior art either disclosed to or otherwise considered by the Patent Office. The Catalina and Trail Bay trailers have a lower portion of the front edge that is sloped or curved upwardly from a lower front edge that has square corners.

(See Exhs. GG, II.) According to Jay Taylor, such construction is disclosed in U.S. Patent Nos. 6,860,545 – Ingram et al. (*see* Exh. W); 6,343,830 – Ingram et al. (*see* Exh. V); 6,231,115 – Crean (*see* Exh. HH); and 5,746,473 – Crean (*see* Exh. Y). (SOF 118, 119.) Jay Taylor also affirms that the Shadow Cruiser has a V nose and sloped front surfaces, which is shown in Avery and the Ingram et al. patents. (SOF 117); (*see* Exhs. FF, Z, V, & W.) Hence, the non-disclosure of these three references also cannot form the basis of inequitable conduct. (SOF 117-119); *Rothman*, 556 F.3d at 1326.

5. Pete Liegl's July 11, 2005 letter was too vague to provide knowledge of any prior art

Forest River contends that a July 11, 2005 letter from Forest River's Pete Liegl to Heartland counsel Gerard Gallagher provided the attorneys and named inventors with knowledge of the Eliminator trailer, and that Gallagher and the named inventors withheld their knowledge of this specific trailer with deceptive intent. (Exh. K, Am. Ans. ¶ 49.) This allegation typifies the baseless nature of Forest River's inequitable conduct allegations. Rather than actually identifying the Eliminator by name or providing a meaningful description, the letter from Liegl merely states that "[q]uite a few years ago there was a **certain recreational vehicle product** that had a similar design to the one in question." (SOF 111); (Exh. F) (emphasis added). This letter is too vague to provide Heartland with knowledge of the Eliminator trailer or any other specific trailer. (*Id.*) Hence, this allegation cannot serve as the basis of an inequitable conduct finding.

6. Forest River baselessly accuses Heartland of deceptive conduct occurring during the prosecution of a subsequent continuation patent, which cannot support a finding of inequitable conduct

Forest River claims that Heartland "secretly" disclosed the Eliminator reference to the Patent Office in a continuing application, did not inform Forest River of or allow Forest River to attend an interview regarding the examination of that continuation application, filed an

improper information disclosure statement after the interview, and did not adequately comply with Rule 1.133(b) in connection with the prosecution of that continuation application. (Exh. K, Am Ans. ¶¶50-52.) Forest River also contends that Heartland improperly added claims to continuation applications SN 11/834,214 and 12/315,894. (Exh. K, Am. Ans. ¶¶ 53 & 54.) Finally, Forest River alleges that on June 24, 2009—nearly two years following the issuance of the '650 patent— Heartland's attorneys declined to inform the Patent Office of false inventorship in connection with a continuation application. (Exh. JJ, Resp. to Interrog. No. 3, p. 6.)

In addition to being false and unfounded, these allegations are also irrelevant to Forest River's claim of inequitable conduct. As a matter of law, conduct occurring in connection with the prosecution of a continuation patent **after** the issuance of the parent patent cannot form the basis of a claim of inequitable conduct with respect to the parent patent. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1370, n. 10 (Fed. Cir. 2008); (SOF 120.)

7. Any errors in inventorship arose through an honest misunderstanding of what it means to be an "inventor"

Forest River alleges that Heartland and its attorneys committed inequitable conduct by naming all five Heartland owners as "co-inventors" of the '650 patent. (Exh. K, Am. Ans. ¶ 55.) At worst, the decision to include all five owners as inventors stemmed from an honest misunderstanding as to the meaning of "inventorship" under the patent laws, not a desire to deceive the Patent Office.

While John Rhymer thought he was the primary inventor of the patent, he testified that he did not think it seemed "right for just my name to be on there. So when the question was asked to me, I answered 'well, I think we should all been on there' . . . It just didn't seem fair that just my name would be on there." (SOF 76.) When asked whether he knew if Scott Tuttle had

discussed the inventorship issue with Heartland's attorneys, Rhymer stated "Meaning having multiple names on there? ... I don't know that was a problem." (SOF 77.)

Scott Tuttle testified that all five owners were listed because "we felt it was a team effort....we were all there for the discussions when we were trying to conceive this...we felt like we all played a part." (SOF 78.) Tuttle also testified to being confused as to the meaning of inventorship, stating that "there may be some gray area in my understanding between what ownership and what inventor, you know, rights and things there are." (SOF 79.)

Doug Lantz considers himself an inventor because of his contributions during many product development meetings, his monetary investment in the firm, his development of the building where the fifth wheels were manufactured, his procurement of computer technology to facilitate the invention, his development of the bill of materials for the company, and his procurement of insurance for Heartland's venture. (SOF 80.) Lantz further testified that he has no information that any of the inventors were named in order to deceive anyone. (SOF 81.)

Also, shortly after the execution of the patent application, all five named inventors assigned their rights to Heartland. (SOF 82.) Consequently, they had no conceivable motive to deceptively include their names on the patent application, for all of them immediately transferred any ownership rights bestowed by inventorship anyway.

Forest River also alleges that Heartland attorney Gregory Cooper should have known that certain named inventors were not actually inventors. But Cooper testified that he informed Scott Tuttle of what it means to be an inventor before Tuttle gave him the list of inventors to include on the provisional application. (SOF 8.) Regardless, Forest River's argument that Cooper "should have known" that the inventorship was wrong amounts to an

accusation of mere negligence or, at worst, gross negligence, neither of which warrants a finding of inequitable conduct. *Kingsdown*, 863 F.2d at 876.

The evidence confirms that any error in the inventorship portion of the '650 patent application occurred through honest mistake, not deceptive intent. (SOF 123.) Thus, Forest River's allegation of imperfect inventorship cannot form the basis of inequitable conduct.

8. The named inventors' alleged failure to read the patent application does not constitute inequitable conduct

Forest River alleges that at least three named inventors executed the Declaration of Inventorship under false pretenses because they did "not read the application sufficiently to understand its content and claims." (Exh. JJ, Resp. to Interrog. No. 3, p. 3.) Forest River also alleges that Heartland's attorneys should have known this fact and should have prevented the application from being prosecuted. (*Id.*) Contrary to Forest River's allegation, Scott Tuttle confirmed that the named inventors did in fact read the application: "I recall that as we sat in a room that different partners of mine were absolutely reviewing it and looking at it...They had it in their hands, they saw it, they read it." (SOF 11.) Furthermore, at least one reported case has found that an inventor's failure to read an application before executing the Declaration does not warrant a finding of either invalidity or inequitable conduct. (SOF 126) (citing *Regents of the Univ. of California v. Howmedica, Inc.*, 530 F.Supp. 846, 853-54, 862 (D.N.J. 1981).

Additionally, no evidence exists to support a claim that Heartland attorney Gregory Cooper knew of any alleged failure to read the application. When Cooper sent the application to the named inventors for execution, he included a transmittal letter. In that letter, he informed the named inventors that "by signing the Declaration, you are declaring that you have reviewed and understood the contents of the application including the patent claims." (SOF 13.) Because the Declaration was signed and returned to him, he had no reason to believe that

the named inventors had not complied with his instructions. Furthermore, because Gerard Gallagher did not assume representation of Heartland until after the Declaration had been signed, he had no reason to question whether the named inventors had read the application. After all, the file transferred to him included both Cooper's transmittal letter and a copy of the named inventors' signed declarations. Hence, the named inventors' alleged failure to read the application does not constitute inequitable conduct.

9. Heartland's attorneys took appropriate steps to gather and disclose information regarding the "nature" of the invention

Forest River claims that Heartland's attorneys failed to sufficiently gather and disclose information regarding the "nature" of the invention. (Exh., JJ, Resp. to Interrog. No. 3, p. 3.) Contrary to Forest River's assertion, Barnes & Thornburg's patent prosecution file contains extensive information, drawings, and photographs provided by Heartland to Gregory Cooper regarding the scope of the invention. (See Exh. B, B&T 02-040.) Furthermore, when Cooper sent the provisional and utility applications to Heartland, he included letters requesting that the named inventors review the applications for errors and submit any proposed changes. (SOF 9, 11); (Exh. B, B&T 043, 080.) These steps were sufficient and appropriate to fulfill Cooper's need to collect and disclose information regarding the "nature" of the invention. (SOF 125.).

10. The attorneys' alleged negligence in gathering and disclosing prior art cannot form the basis of inequitable conduct

Forest River incorrectly claims that Heartland's attorneys failed to gather and disclose information from the named inventors regarding the scope of prior art within the RV industry. (Exh. JJ, Resp. to Interrog. No. 3, pp. 3-4.) While such a claim accuses Heartland's attorneys of mere negligence or gross negligence, the evidence plainly shows that the attorneys did take sufficient steps to gather and disclose any material prior art.

First, in a letter dated April 5, 2005 Gregory Cooper informed the named inventors of their duty of disclosure. Gregory Cooper explained the concept of "prior art" to the Heartland named inventors and asked them to provide him with any examples of prior art. Specifically, Cooper described prior art as "all patent and non-patent publications and other facts that a reasonable examiner may consider to be important to an assessment of patentability of the claimed invention. Such other facts include public demonstrations or sales or offers of sale of products pertaining to the invention and information any of the inventors received from others prior to making the invention." The letter further noted that "[e]ach person involved in the preparation and prosecution of the patent application has an obligation to disclose such publications and facts to the USPTO." (SOF 13.)

Also, Gerard Gallagher testified that he told the named inventors that "anything that was out there, prior patents, publications, products, you know, that were similar to this or achieve a similar purpose or that, you know, someone might consider material, you know, to their invention, it should be brought to our attention and that they should err on the side of disclosing more to us, not less." (SOF 17.)

Finally, as explained by Jay Taylor in his expert report, to the extent that it is Forest River's contention that the named inventors should have disclosed their entire knowledge of the commercially available products in the field of the invention, that contention has been found meritless by the Court of Appeals for the Federal Circuit. (SOF 127) (citing *Upjohn Co. v. Mova Pharmaceutical Corp.*, 225 F.3d 1306, 1315 (Fed. Cir. 2000)).

11. There is no duty of disclosure with respect to "ordinary skill in the art"

Forest River contends that the attorneys committed inequitable conduct by failing to gather and disclose information regarding the level of ordinary skill of designers of travel

trailers and fifth wheels. (Exh. JJ, Resp. to Interrog. No. 3, p. 4.) This allegation has no merit. As explained by Jay Taylor, Rule 1.56 only requires disclosure of material prior art information, and nothing in the Patent Act requires disclosure of information regarding the level of ordinary skill in the art. (SOF 128) (citing Rule 1.56; 35 U.S.C. § 112.) Furthermore, Taylor knows of no reported case finding that a failure to disclose the level of ordinary skill in the art constitutes inequitable conduct. (SOF 128.)

12. There is no duty to disclose information detailing the differences and similarities between the claimed invention and prior art

Forest River next alleges that the Heartland attorneys failed to gather and disclose information regarding the differences and similarities between the claimed invention and prior art. (Exh. JJ, Resp. to Interrog. No. 3, p. 5.) This allegation is meritless. Again, there is no requirement in the Patent Office Rules that inventors or attorneys provide such detailed information. (SOF 129) (explaining rules applicable to disclosure and the duties they create). Thus, this allegation also cannot form the basis of inequitable conduct.

13. The trailer frame is a crucial aspect of Heartland's invention

Forest River also accuses Heartland's attorneys of failing to accurately claim the named inventors' "real" invention. (Exh. JJ, Resp. to Interrog. No. 3, p. 5.) Apparently, Forest River contends that the named inventors did not think that the frame constituted part of their turning radius invention, and that the attorneys should not have sought claims related to the frame. The evidence plainly contradicts this contention.

In providing disclosure information to Gregory Cooper, the named inventors included drawings of the frame. (*See generally* Exh. B, B&T 02-040); (Exh. H). Furthermore, in the written description of the invention provided to Gregory Cooper by Scott Tuttle, Heartland stated that it "has engineered a unique new 5th wheel concept.... This revolutionary concept

involves [] rethinking how **the steel frame of the 5th wheel is designed**.... The first step was cutting off the corners of the upper front section of the frame instead of extending them all the way out at a 90° angle, as is the case in a traditional 5th wheel frame design." (SOF 5, 7); (Cooper Dep. p. 15, ll. 9-25; p. 16, ll. 1-7). Tuttle's description proves that the inventors believed that the frame was an important part of the invention.

14. Heartland's alleged failure to meet the enablement requirements of § 112 cannot form the basis of inequitable conduct

Forest River also contends that the final, amended application prepared by Gerard Gallagher does not enable one of ordinary skill in the art to make and use the invention.

However, because all of the formal § 112 objections to the specification made by the examiner were corrected by the applicant during prosecution and the examiner allowed the patent to issue, the specification is presumed to meet the enablement requirement of § 112. (SOF 130.)

Accordingly, this allegation cannot form the basis of an inequitable conduct finding.

15. Heartland's attorneys disclosed all material prior art of which they knew

There is no evidence that either Gregory Cooper or Gerard Gallagher withheld **any** material prior art of which they had knowledge during the prosecution of the '650 patent, let alone that they did so with deceptive intent. (SOF 132.) Gregory Cooper transferred Barnes & Thornburg's patent prosecution file to Gerard Gallagher before the Information Disclosure Statement was due. (SOF 14-15.) The file transferred to Gerard Gallagher contained copies of patents Cooper apparently located during his prosecution of the patent. (SOF 25.) Although Cooper could not specifically recall how these patents had been obtained, he stated that either Heartland provided the patents, or the patents were found in a formal or informal prior art search. (SOF 24.) Cooper noted that it was unlikely that the patents had been located as a result of a

formal prior art search, however, since there was no record of such a search in Barnes & Thornburg's patent prosecution file. (*Id.*) Gallagher disclosed these patents in the Information Disclosure Statement he filed with the Patent Office. (SOF 24, 25.) Hence, there is no evidence that the attorneys intentionally withheld any prior art in order to deceive the Patent Office.

16. Heartland had no duty to conduct a prior art search

In connection with a discovery motion, Forest River implied that Heartland failed to conduct a sufficiently broad prior art search during the prosecution of the '650 patent. (Mot. to Compel, DE #88, p. 4.) Specifically, Forest River contended that "if the person doing the search was specifically instructed not to look past the 20 year point in time, then whoever gave that instruction was engaged in inequitable conduct by 'cultivating ignorance.'" (*Id.*) That is not true. The Federal Circuit has repeated time and again that **a patent applicant has no duty to perform a search for prior art.** See *Frazier v. Roessel Cine Photo Tech, Inc.*, 417 F.3d 1230, 1238 (Fed. Cir. 2005) (listing cases establishing this proposition). Hence, even if Forest River could show that Heartland performed only a "20 year" search for prior art, that search was still far more than the law requires, and it could not serve as the basis for a finding of inequitable conduct.

In sum, no clear and convincing evidence exists that any of the named Heartland inventors or the Heartland attorneys failed to disclose material information, submitted materially false information, or intended to deceive the Patent Office. Thus, there is no evidentiary or legal basis for a finding of inequitable conduct, and Heartland is entitled to summary judgment. (*See generally* SOF 104-132.)

III. FOREST RIVER'S TRADE SHOW FOR RV DEALERS

On October 22 and 23, 2008, Forest River held a private trade show in Elkhart, Indiana (the "Trade Show"). (SOF 133.) The Trade Show was for Forest River RV dealers only.

(SOF 161.) No retail consumers were invited to the show. (*Id.*) Approximately 260 Forest River dealers from around the country attended the Trade Show. (SOF 134.) Ninety-five percent of these dealers also sell RV products from manufacturers other than Forest River. (SOF 135.) The dealers stayed at hotels in the Mishawaka, Indiana area. Forest River paid for their accommodations. (Exh. K, Am. Ans. ¶ 75.)

Forest River alleges that on or about October 22, 2008, Heartland employees went to these hotels and delivered envelopes containing Heartland promotional materials to the dealers (the "Hotel Incident"). (Exh. K, Am. Ans. ¶¶ 76-77, 86.) These envelopes were marked with a large Heartland logo in the upper corner. (SOF 162.) Forest River does not contend that a **single RV dealer** received false or misleading information. Instead, Forest River alleges that a Heartland employee told a hotel receptionist that he was from Forest River—a contention for which Forest River has no evidence—in order to secure delivery of the materials. Forest River claims that, even though no RV dealers were deceived or confused by Heartland's conduct, the alleged false statement to a hotel receptionist entitles Forest River to damages from Heartland for sales to these dealers. In a futile attempt to find a legal theory supporting its allegations, Forest River has accused Heartland of violating the Lanham Act and committing **criminal** deception.

As discussed below, Forest River has produced no admissible evidence supporting its allegations that Heartland lied while delivering promotional materials to the hotels. However, even if Forest River can somehow create an issue of material fact regarding whether Heartland lied to a hotel employee, Forest River's counterclaims will still fail as a matter of law. Because Forest River cannot show that Heartland made a misrepresentation to a **customer** (i.e., an RV Dealer) about the products it **offers for sale**, or that an RV dealer was confused or

deceived by Heartland's conduct, it cannot prevail on its Lanham Act claim.³ Furthermore, because Forest River cannot show that **Forest River** relied upon a false statement by Heartland in parting with money or property, its criminal deception claim also fails. For the reasons discussed below, Heartland is entitled to summary judgment on Forest River's claims related to the Hotel Incident.

IV. FOREST RIVER'S LANHAM ACT CLAIM FAILS AS A MATTER OF LAW

A. Heartland Did Not Make a False Statement or Misrepresentation of Fact

During discovery, Forest River failed to produce any admissible evidence that Heartland made a false statement while delivering its promotional materials to the hotels. This failure entitles Heartland to summary judgment.

Heartland asked Forest River to "[i]dentify all misrepresentations or untruthful statements alleged to have been made by Heartland in connection with the Hotel Action...." (SOF 151.) Only one allegation Forest River offered in response to this interrogatory, on its face, constitutes a false statement. Forest River alleges that "Heartland told at least the receptionist at the Hyatt Place hotel that the packages were from Forest River and needed to be delivered right away to the dealers since they were important and were needed for a dealer meeting the next day." (SOF 152.) However, Forest River has not named a single witness from the Hyatt Place in its initial or supplemental disclosures. (SOF 153.) Bryan Walczak, the

³ To the extent that Forest River claims that the Hotel Incident is the basis of an unfair competition claim under Indiana state law, that claim fails for the same reasons that Forest River's Lanham Act and criminal deception claims fail. *See Felsher v. Univ. of Evansville*, 755 N.E.2d 589, 598 (Ind. 2001) (noting definition of unfair competition as "any conduct, the natural and probable tendency and effect of which is to deceive the public so as to pass off the goods or business of one person as and for that of another"), *citing Hartzler v. Goshen Churn & Ladder Co.*, 55 Ind. App. 455, 104 N.E. 34, 38 (Ind. App. 1914) ("the true test of unfair competition is whether the acts of defendant are such as are calculated to deceive the **ordinary buyer** under the ordinary conditions which prevail in the particular trade to which the controversy relates.") (emphasis added).

Heartland employee who distributed Heartland's promotional materials at the Hyatt Place, categorically denies engaging in any of the misleading conduct alleged by Forest River. (SOF 138-140, 144-150.) If Forest River cannot produce a credible witness with personal knowledge of facts rebutting Mr. Walczak's affirmations, it follows that it cannot create an issue of material fact as to whether a false statement was made.

Forest River also contends that "Heartland mislead the Country Inn & Suites into thinking the packages were to go along with the Forest River party in part by his mannerisms and in part by having the specific dealer's name on the cover and asking for a call back to pick up the undeliverable packages," and that "Heartland mislead and made false statements to the receptionist at Residence Inn by asking for the room number of the named guests to be looked up and marked on the packages, then evading inquiry about his identity and who the packages were from and if the guests were expecting the packages, and then expressly denying that he knew what the packages were for." (SOF 154-155.) On their face, neither of these allegations constitutes a false designation of origin or a false description or representation.

That said, in order to confirm that Heartland made no misrepresentations at the Country Inn & Suites, Heartland deposed Cindy King, the hotel's general manager, and Kelly Gearhart, the front desk receptionist working at the time that a Heartland employee delivered promotional materials to the hotel. Ms. Gearhart testified that the Heartland employee made no misrepresentations or false statements while delivering the envelopes to the Country Inn & Suites. (SOF 160.)

Furthermore, Heartland had no reason to lie while delivering materials to the Country Inn & Suites. Both Ms. Gearhart and Ms. King testified that the Country Inn & Suites has a policy of delivering packages to its guests regardless of who sends them. (SOF 158.) Ms.

Gearhart testified that she never asks where a package came from before delivering it because "[i]t's not my business...if it came from Frederick's of Hollywood, I wouldn't care. I don't – I just make sure that the customer got it." (*Id.*) According to Ms. King, it would not be normal or appropriate for her employees to decide whether or not a guest should receive a package that had the guest's name on it. (*Id.*) Thus, the testimony of King and Gearhart demonstrates that Heartland had no need to lie in order to secure delivery of its promotional materials.

Forest River has provided no evidence that Heartland lied while delivering its promotional materials to the hotels. Because a misrepresentation is a necessary element to Forest River's Lanham Act claim, Heartland is entitled to summary judgment.

B. The Lanham Act Does Not Govern Conduct That is Irrelevant to Consumers

Forest River's Lanham Act claim attempts to extend the Act's scope beyond matters involving **consumer** confusion or deception. But as the United States Supreme Court has declared, "[t]he words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers." *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32-33 (2003); *see also Bretford Mfg., Inc. v. Smith Sys. Mfg. Corp.*, 419 F.3d 576, 581 (7th Cir. 2005) ("Consumers rather than producers are the objects of the (Lanham Act's) solicitude."). Because Forest River has no evidence that a false representation by Heartland affected the relevant consumers in this case—RV dealers—its Lanham Act claim fails.

Forest River purports to be asserting a "passing off" claim under 15 U.S.C. § 1125(a)(1)(A).⁴ (Forest River's Mem. Opp. Mot. to Dismiss Lanham Act Claim, Dckt. Entry No. 15, pp. 1, 3, 10-12.) This claim alleges that Heartland used a false designation of origin or false

⁴ In this Court's February 18, 2009 Memorandum Opinion & Order, the late Judge Sharp recognized the inherent weaknesses in Forest River's Lanham Act claim, stating that "this Court questions, and indeed doubts, whether Forest River has adequately pled a passing off violation under the Lanham Act..." (Mem. Op. & Order, Dckt. Entry No. 32, p. 7.)

description or representation in connection with goods or services, and that Heartland's conduct was likely to cause confusion about its products among relevant consumers. *Kennedy v. Nat'l Juvenile Detention Ass'n*, 187 F.3d 690, 695-96 (7th Cir. 1999); *Francorp, Inc. v. Siebert*, 2002 WL 731170, at *1 (N.D. Ill. April 24, 2002). In order to limit the scope of the Lanham Act to conduct affecting actual consumers, courts have crafted the following three requirements for Lanham Act claims:

- (1) The alleged false statement must be made to a relevant consumer, and it must be likely to cause confusion among relevant consumers;
- (2) The alleged false statement must be about goods actually offered for sale to relevant consumers; and
- (3) In order for a plaintiff to avoid summary judgment in a suit for damages, a plaintiff must prove that it can recover monetary relief stemming from the false statement.

Forest River's counterclaim contains no allegations that Heartland's alleged conduct affected the relevant class of consumers—RV Dealers—in a way that invokes the protections afforded by the Lanham Act. An application of the facts of this case to the three requirements outlined above demonstrates that Forest River's claim fails as a matter of law.

1. Heartland did not make a false statement or misrepresentation to a relevant customer

Forest River has alleged that Heartland made misrepresentations to hotel employees. However, to succeed on its Lanham Act claim, Forest River must show that Heartland made a misrepresentation **to a customer or potential customer**. *See Keller Med. Specialties Prods. v. Armstrong Med. Indus., Inc.*, 842 F.Supp. 1086, 1092 (N.D. Ill. 1994) (statements not made "to a customer or potential customer" are "[c]learly...outside the policy underlying the Lanham Act.") In an interrogatory, Heartland asked Forest River to "[i]dentify all

misrepresentations or untruthful statements alleged to have been made by Heartland in connection with the Hotel Action...." (SOF 151.) In response, Forest River failed to identify a single misrepresentation made to an RV dealer. (See SOF 152, 154-55.) The absence of any evidence showing that Heartland made a misrepresentation to a relevant customer of Heartland or Forest River entitles Heartland to summary judgment.

2. Because Heartland did not make a false statement or misrepresentation to a relevant customer, no customers could be confused by Heartland's alleged conduct

As a separate, additional element, Forest River must also demonstrate that it was "likely to be damaged as a result of the misrepresentation." *Kennedy*, 187 F.3d 695-96. This element is satisfied "when the plaintiff shows that there is a likelihood of **consumer** confusion as a result of the false representation." *Francorp*, 2002 WL 731170, at *1 (emphasis added). If Forest River cannot identify any misrepresentations made to consumers, it obviously cannot show that consumers were likely to be confused by a misrepresentation.⁵ Consumers cannot be confused by something to which they are utterly oblivious. See *Custom Mfg. & Eng'g, Inc. v. Midway Servs., Inc.*, 508 F.3d 641, 652 (11th Cir. 2007) (summary judgment appropriate on Lanham Act claim where consumers would be very unlikely to see defendant's mark, thus negating possibility of consumer confusion).

Even Jeff Babcock, Forest River's 30(b)(6) deponent with respect to the Hotel Incident, concedes that the RV dealers could not be confused by Heartland's alleged conduct.

⁵ Typically, the Seventh Circuit weighs seven factors in deciding the likelihood of consumer confusion: (1) similarity of the marks; (2) similarity of the products or services; (3) area and manner of concurrent use; (4) degree of care likely to be exercised by consumers; (5) strength of the plaintiff's mark; (6) whether actual confusion exists; and (7) whether the defendant intended to "palm off" his product as that of the plaintiff. *Pure Imagination, Inc. v. Pure Imagination Studios, Inc.*, 2004 WL 2967446, at * 5 (N.D. Ill. 2004). These factors are designed to gauge whether a defendant's misrepresentation is likely to cause a consumer to confuse the defendant's product with the plaintiff's, or vice versa. But where a plaintiff never even alleges that a consumer received a misrepresentation, the possibility of consumer confusion never materializes, and these factors become irrelevant. The futility of applying these factors further proves that Forest River's allegations do not fall within the scope of the Lanham Act.

Babcock admits that the dealers who received promotional materials knew that Heartland and Forest River are separate entities. (SOF 136.) He also admits that when the dealers received the promotional materials, they knew that the materials were from Heartland, not Forest River. (SOF 163.) This is unsurprising, given that the envelopes containing Heartland's promotional materials were marked with a large Heartland logo in the upper corner. (SOF 162.)

Forest River alleges that Heartland made misrepresentations to hotel employees, not customers or potential customers. Obviously, without evidence that Heartland made a misrepresentation to an RV dealer, Forest River cannot show that any RV dealers were confused by a misrepresentation. Forest River's failure to create an issue of material fact on the element of likelihood of consumer confusion entitles Heartland to summary judgment.

3. Heartland did not make a false statement about goods actually offered for sale

The language of 15 U.S.C. § 1125(a)(1)(A) requires a plaintiff to demonstrate that the defendant made a misrepresentation "on or in connection with...goods or services." 15 U.S.C. § 1125(a); *Kennedy*, 187 F.3d at 695. This requires a plaintiff to prove that the defendant made a misrepresentation about the goods of the plaintiff or the defendant. "The Lanham Act does not prohibit false statements generally. It prohibits only false or misleading descriptions or false or misleading representations of fact made about one's own or another's goods or services." *Groden v. Random House, Inc.*, 61 F.3d 1045, 1052 (2nd Cir. 1995).

In this case, the goods of the parties are RVs. Forest River does not allege that Heartland made any misrepresentations about RVs. Instead, Forest River has argued that Heartland's alleged misrepresentation was "in connection with goods" because "all of Heartland's actions complained of were done to directly further the sale of those RVs." (Forest River's Mem. Opp. Mot. to Dismiss Lanham Act Claim, Dckt. Entry No. 15, p. 6). By making this argument,

Forest River attempts to expand the Lanham Act to cover **any** misrepresentation made in the course of business.⁶ Courts have refused to expand the Lanham Act to cover such a broad array of misrepresentations. *See Monoflo Intern., Inc. v. Sahm*, 726 F.Supp 121, 124 (E.D. Va. 1989) (allowing false statements that are not *about* goods or services would "sweep within the [Lanham] Act's ambit almost any misstatement made in the context of a commercial transaction, a result contradicted by the Act's plain meaning and sharply at odds with its application by the courts").

Forest River has also argued that the "goods" in this case are the promotional materials Heartland provided to dealers. (*See* Forest River's Mem. Opp. Mot. to Dismiss Lanham Act Claim, Dckt. Entry No. 15, pp. 5-6.) But the United States Supreme Court has specifically limited the definition of "goods" to those products that a party actually offers for sale. In *Dastar*, the United States Supreme Court determined that the phrase "origin of goods" in § 1125(a) means "the producer of the tangible product **sold in the marketplace.**" *Dastar*, 539 U.S. at 31 (emphasis added). It reiterated later in its opinion that "goods" means "the tangible goods **that are offered for sale.**" *Id.* at 37 (emphasis added).

The case of *Bretford Mfg., Inc. v. Smith Sys. Mfg. Co.*, 286 F.Supp.2d 969 (N.D. Ill. 2003) demonstrates the impact of the *Dastar* decision on Forest River's claims. In *Bretford*, the defendant borrowed the legs from a competitor's table to construct a prototype of a table it was in the process of developing. *Id.* at 970. The defendant then submitted this sample

⁶ Consider the consequences of adopting Forest River's view of the Lanham Act. If a manufacturer made a misrepresentation to a lender to secure financing for additional inventory, the manufacturer's competitors could sue for its profits on the theory that the misrepresentation conceivably "furthered the sale" of the inventory. If a manufacturer lied to a newspaper in order to secure a discount for an ad in the Sunday edition, its competitors could sue for the profits because the advertisement, true as it may be, "furthered the sale" of its goods. These examples, like Forest River's allegations, involve no misrepresentation to a consumer about a good offered for sale. As such, they are simply not the type of claims that the Lanham Act is intended to cover. *See Dastar*, 539 U.S. at 32-33 ("[t]he words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.")

prototype to a customer, the Dallas Independent School District, who in turn placed an order for the final products the defendant eventually offered for sale. *Id.* The competitor alleged that the defendant had committed "reverse passing off" by promoting the legs of the sample table as their own when showing the prototype to the District. *Id.*

Citing the Supreme Court's definition of "goods" in *Dastar*, the *Bretford* Court found the Lanham Act inapplicable to a misrepresentation about the sample prototype **because the sample was not the good eventually offered for sale:**

[T]he sample table was not the good offered for sale. What was offered for sale were the tables later purchased by the District after it had awarded the contract to [defendant]. There was no misrepresentation as to the "origin" of those tables.

Id. at 971. Heartland's promotional materials, like the sample table in *Bretford*, were not "goods that are offered for sale." What Heartland offered for sale were its RVs. Thus, Forest River cannot argue that the promotional materials are "goods" under the Lanham Act. *Id.*; *Dastar*, 539 U.S. at 31, 37.

Forest River does not allege that Heartland made a misrepresentation about RVs, and its allegation that Heartland made a misrepresentation in connection with promotional materials is not cognizable under the law. Thus, Heartland is entitled to summary judgment.

4. Forest River's inability to recover damages entitles Heartland to summary judgment

Two types of monetary relief are typically available in Lanham Act cases: (1) monetary damages resulting from actual consumer reliance upon a misrepresentation; and (2) an award of defendant's profits attributable to the misrepresentation. *See* 15 U.S.C. § 1117; *see generally Lincoln Diagnostics, Inc. v. Panatrex, Inc.*, 2009 WL 3010840, *11 (C.D. Ill. Sept. 16, 2009). Heartland is entitled to summary judgment because Forest River cannot show that: (1)

Forest River suffered monetary harm due to actual consumer reliance upon a false representation; or (2) that a false statement caused Heartland to gain profits. *See L.S. Heath & Son, Inc. v. AT & T Information Sys., Inc.*, 9 F.3d 561, 575 (7th Cir. 1993); *see also Hot Wax, Inc. v. S/S Car Care*, 1999 WL 966094, at *3 (N.D. Ill. Oct. 14, 1999) (collecting Lanham Act cases dismissing claims due to failure to show that conduct caused lost sales or damages).

First, in order for a court to grant Forest River its actual monetary damages, "the plaintiff 'must demonstrate that it has been damaged by **actual consumer reliance on the misleading statements.**" *Heath*, 9 F.3d at 575 (emphasis added). Again, Forest River has not alleged that a misleading statement reached any RV dealers.⁷ If no misleading statement ever reached the dealers, then it is impossible for the dealers to have actually relied upon any misleading statement.⁸ Hence, Forest River cannot recover any actual damages.

For similar reasons, Forest River is not entitled to an accounting of Heartland's profits. It is well-established that a plaintiff is not entitled to profits that are not attributable to a defendant's violation of the Lanham Act. *Mishawaka Rubber & Wollen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 206 (1942); 15 U.S.C. § 1117 (substantially codifying framework outlined in *Mishawaka*). Again, no misrepresentations were ever made to the purchasers, thus negating any possibility that any of Heartland's profits were attributable to a false statement by Heartland.

Furthermore, even under a more attenuated argument that Heartland's alleged misrepresentations set into motion a chain of events that ultimately led Heartland to an RV sale,

⁷ Furthermore, Jeff Babcock, Forest River's 30(b)(6) deponent with respect to the Hotel Incident, testified that Forest River had not even bothered to contact its dealers to see if they had received Heartland's promotional materials or relied upon them in making a purchase from Heartland. (SOF 165.)

⁸ The requirement that a plaintiff must demonstrate actual consumer reliance on a misrepresentation in order to collect monetary damages reinforces Heartland's argument that misrepresentations made to non-customers do not fall within the scope of the Lanham Act. *See* Section IV.B.1, *supra*.

the evidence still precludes an award of Heartland's profits. To show causation, Forest River must demonstrate that a dealer purchasing Heartland products during the relevant time period:⁹ (1) attended the Forest River Trade Show; (2) stayed at a hotel where Heartland engaged in unlawful conduct; (3) received promotional materials from Heartland as a result of Heartland's alleged unlawful conduct; and (4) decided to purchase Heartland products that it would not have otherwise purchased as a proximate result of receiving those materials.

Forest River has apparently been unable to identify any sales caused by Heartland's conduct. In response to an interrogatory requesting that Forest River "[i]dentify each sale you believe to be caused by Heartland's allegedly unlawful conduct at issue in this lawsuit," **Forest River identified no sales.** (SOF 174.)

While Forest River cannot offer evidence of any sales that Heartland made as a result of its alleged conduct, the evidence offered by Heartland indicates that dealers placing orders with Heartland around the relevant time period did so for reasons unrelated to Heartland's alleged conduct in this case.

One dealer that placed orders with Heartland during the relevant time period, Racetrack RV ("Racetrack"), was a very happy customer of Heartland's prior to the Trade Show. (SOF 166.) Heartland had prospected Racetrack with respect to its Eagle Ridge line of products prior to the Trade Show, and Racetrack had indicated that it would like to do more business with Heartland. (*Id.*) Also, Heartland sales employee Bryan Walczak had a long-standing relationship with Racetrack's owner, Kenny Maines, prior to the Hotel Incident. (SOF 167.) But

⁹ Any benefit Heartland derived from the Hotel Incident would have dissipated in early December; every year, in early December, the entire RV Industry convenes at the annual National RV Trade Show in Louisville, Kentucky. (SOF 175.) If Heartland made any sales to dealers beyond this point, they can be attributed to activity at the Louisville Show, not the distribution of promotional materials in connection with the Hotel Incident.

most importantly, Racetrack visited Heartland's facilities on the day of the Hotel Incident **before Heartland employees distributed the promotional materials at Elkhart-area hotels.** (*Id.*)

Campkin's RV ("Campkin's") also placed orders during the relevant time period. Campkin's was a Heartland dealer before the Trade Show. (SOF 169.) Campkin's President, Brad Campkin, states that he was planning to visit Heartland and other RV manufacturers before the Hotel Incident occurred. (*Id.*) He specifically affirms that neither his decision to visit Heartland while he was in Elkhart nor his decision to purchase Heartland products resulted from receiving Heartland promotional materials at his hotel. (*Id.*) According to Campkin, he placed orders with Heartland based on the products themselves, not brochures. (*Id.*)

Another dealer placing orders during the relevant time period, Loveall RV ("Loveall"), had been engaged in a courtship with Heartland for six months prior to the Hotel Incident. (SOF 168.) Heartland had performed multiple "drive-bys" at Loveall and had been on Loveall's lot. Prior to the Hotel Incident, Loveall had shown strong interest in buying Heartland's products. (*Id.*) Hence, the Hotel Incident was not the cause of any sales to Loveall.

Avalon RV ("Avalon") placed orders with Heartland around the relevant time period. However, those orders did not result from the Hotel Incident. Avalon had scheduled an appointment to come visit Heartland's facilities at 11:30 on the morning of October 22, 2008. (SOF 170.) Hence, Avalon planned to visit and did visit Heartland before the Hotel Incident even occurred. Avalon was already a Heartland dealer prior to the Trade Show. (*Id.*) Furthermore, Avalon's purchase of Heartland products approximately a week later did not result from Avalon visiting Heartland's facilities around the time of the Trade Show. (*Id.*) Rather, Avalon made those purchases in order to ensure that they would be manufactured in time for a large RV show in Cleveland, OH that occurs in early January. (*Id.*) If Avalon had waited until

the Louisville show in December to make its RV purchases, it would have jeopardized its chances of having the trailers produced in time for the Cleveland show. (*Id.*)

Prior to the Hotel Incident, Wichita RV called Heartland salesman John Leonard to schedule an appointment to visit Heartland during the Trade Show. (SOF 171.) Hence, Wichita RV made plans to visit Heartland before the Hotel Incident even occurred. Wichita RV was a dealer of Heartland products before the Hotel Incident, and had negotiated with John Leonard for the purchase of several RV units prior to visiting Heartland's facilities at around the time of the Trade Show. (*Id.*)

Forest River deposed two Heartland salesmen, John Leonard and Jack Plummer, who were responsible for obtaining sales for Heartland around the time period relevant to this action. Both Leonard and Plummer stated that they did not participate in the Hotel Incident. (SOF 172.) Leonard and Plummer also said they did not use the list to make sales. (*Id.*)

It is not surprising that the Hotel Incident and Heartland's distribution of promotional materials did not cause dealers to place orders with Heartland. Indeed, Jeff Babcock, Forest River's Vice President of Sales and its 30(b)(6) designee with respect to the Hotel Incident, testified that the mere distribution of promotional materials does not cause dealers to purchase RVs. According to Babcock, providing promotional materials is "not all you have to do...You gotta sell them on the product....You have to talk to the dealer. You have to go through the product. You have to feature benefit the product. You gotta convince the dealer that the product you have sitting in front of him is gonna make him money on his lot." (SOF 164.) These activities—talking to dealers, taking them through the product, etc.—caused any sales and profits Heartland realized around the time of the Hotel Incident, not the distribution of common promotional materials.

In addition, Jeff Babcock offered a further opinion as to why the dealers might have purchased Heartland products. During his 30(b)(6) deposition, he stated that Heartland's very good prices caused the sales, not the delivery of promotional materials. (SOF 173.)

Because there is no evidence that any dealer bought an RV from Heartland as a result of an alleged false statement made to a hotel receptionist (one that the evidence shows never occurred), Forest River cannot recover any monetary remedy. Forest River's lack of monetary remedy entitles Heartland to summary judgment. *L.S. Heath & Son*, 9 F.3d at 575; *see also Hot Wax, Inc.* 1999 WL 966094, at *3.

V. **HEARTLAND IS ALSO ENTITLED TO SUMMARY JUDGMENT ON FOREST RIVER'S CRIMINAL DECEPTION CLAIM**

To prevail on its claim of criminal deception,¹⁰ Forest River must prove that (1) with intent to defraud; (2) Heartland misrepresented their identity or the identity or quality of property; and (3) caused Forest River pecuniary harm. *See* Ind. Code § 35-43-5-3(6); Ind. Code § 34-24-3-1 (outlining Indiana's Victim's Relief Act statute). Furthermore, to recover damages under the Victim's Relief Act, Forest River must show that it was the "target" of an alleged fraud. *See Sanderson v. Brugman*, 2002 WL 31255470, at *5 (S.D. Ind. Sept. 20, 2002); *ABN AMRO Mortgage Group, Inc. v. Maximum Mortgage, Inc.*, 429 F.Supp.2d 1031, 1045 (N.D. Ind. 2006).

¹⁰ In its Memorandum in Opposition to Heartland's "Motion to Dismiss Forest River, Inc.'s Criminal Deception Counterclaim," Forest River contended that it has also stated a claim of criminal mischief under Ind. Code § 35-43-1-2. (*See* Mem. Opp. Mot. to Dismiss Criminal Deception, Dckt. Entry No. 38, p. 1.) While Forest River makes no mention of such a claim in its Amended Answer, the similarities between the two claims render the criminal mischief claim superfluous. Under both statutes, a plaintiff must prove the occurrence of a misrepresentation (or, in criminal mischief, "deception"). Furthermore, to recover on either claim under the Victim's Relief Act, the plaintiff must prove that he or she was the target of a fraud. *See Sanderson*, 2002 WL 31255470, at *5; *ABN AMRO Mortgage Group, Inc.*, 429 F.Supp.2d at 1045 (N.D. Ind. 2006). Finally, to recover under the Victim's Relief Statute, a plaintiff must demonstrate that defendant's conduct caused it to suffer pecuniary loss. *See* Ind. Code § 34-24-3-1. As discussed in the argument related to Forest River's criminal deception claim, Forest River cannot present evidence creating a material issue of fact as to any of these elements, and Heartland is entitled to summary judgment as a matter of law.

For each of the following independent reasons, Heartland is entitled to summary judgment on Forest River's criminal deception claim.

1. Heartland made no misrepresentations in connection with the Hotel Incident

In its Amended Answer, Forest River declares that its criminal deception claim is based on the same facts set forth in support of its Lanham Act claim. (Exh. K, Am. Ans. ¶ 86.) As discussed in Section IV.A above, Forest River can present no admissible evidence that Heartland made a misrepresentation in connection with the Hotel Incident. Because Forest River cannot create an issue of material fact regarding this essential element of its criminal deception claim, Heartland is entitled to summary judgment.

2. Forest River was not the target of an alleged fraud

While case law interpreting criminal deception claims under the Victim's Relief Act is sparse, two relatively recent cases provide guidance beyond the bare language of the statute. Those cases are *Sanderson v. Brugman*, 2002 WL 31255470 (S.D. Ind. Sept. 20, 2002) and *ABN AMRO Mortgage Group, Inc. v. Maximum Mortgage, Inc.*, 429 F.Supp.2d 1031 (N.D. Ind. 2006). The holdings in these two cases demonstrate that Forest River's claim under the Victim's Relief Act fails as a matter of law.

In *Sanderson*, the Court dismissed plaintiff's claims under the Victim's Relief Act because plaintiff "was not the target of any alleged fraud." *Sanderson*, 2002 WL 31255470 at

*5. In its reasoning, the Court stated as follows:

[Plaintiff] was not the target of any alleged fraud, however. **He has not identified any instance in which the Indiana courts have allowed a company to sue a commercial competitor [] for treble damages under this statute on the theory that the competitor used deception to secure a sale from a customer.** Recognizing such a claim would seem to stretch the civil remedy statute well beyond its purpose and to open the door to a broad

vista of new commercial litigation between competitors. Without much clearer signals that the Indiana legislature intended such results, the court finds that [Plaintiff] has failed to state a claim for relief under Ind. Code § 34-24-3-1.

Id. (emphasis added).

Forest River's criminal deception allegation is precisely the type of claim that the *Sanderson* Court refused to recognize.¹¹ A "company" (Forest River) has sued "a commercial competitor" (Heartland) on the theory that the "competitor" (Heartland) used "deception" (misrepresentations made to hotel employees) "to secure a sale from a customer" (to gain assistance in distributing promotional materials to customers). *Id.*

Meanwhile, the *ABN* case demonstrates what a plaintiff must successfully prove in order to recover damages under the Victim's Relief Act. In *ABN*, the Court found that ABN **was** the target of the alleged fraud, because the defendants' "fraudulent scheme was to induce ABN to loan money when it would not otherwise do so." *ABN AMRO, Inc.*, 429 F.Supp.2d at *1045. In making its finding, the Court cited two key allegations: (1) that the plaintiff, ABN, was the intended recipient of the defendants' misrepresentations; and (2) that ABN actually relied upon the misrepresentations in parting with its money. *Id.* at 1037, 1045. Unlike the plaintiff in *ABN*, Forest River has not alleged that it was the intended recipient of any misrepresentation by Heartland, or that it relied upon Heartland's alleged misrepresentations in parting with money. Thus, the key facts cited by the *ABN* Court are plainly absent from Forest River's claim, and Forest River is not the "target of a fraud" for purposes of the Victim's Relief Act.

¹¹ In the *Sanderson* case, the alleged "misrepresentations" made by the defendant at least actually reached consumers. As discussed above, Forest River cannot even demonstrate that a relevant *consumer* was the target of a fraud, i.e. that a consumer was the recipient of a misrepresentation and relied upon that misrepresentation in parting with property or money. Hence, Forest River's claim under the Victim's Relief Act is even weaker than the one rejected in *Sanderson*.

The holding in *Sanderson* is clear: the Victim's Relief Act is not intended to permit commercial competitors to sue each other over deceptive conduct aimed at increasing sales. Instead, as the *ABN* case demonstrates, the statute exists to provide relief to parties who are the intended recipients of misrepresentations, and who actually rely on those misrepresentations in parting with money or property. Because Forest River cannot allege that it was the intended target of a fraud by Heartland, its claim under the Victim's Relief Act cannot survive summary judgment.

3. Forest River cannot show that Heartland's alleged conduct caused it pecuniary harm

In order for the Court to hold Heartland civilly liable under the criminal deception statute, it must find that Heartland's conduct caused Forest River to suffer pecuniary harm. Ind. Code § 34-24-3-1. Again, Forest River has failed to identify a single sale that Heartland gained (and Forest River lost) as a result of Heartland's alleged conduct. *See* Section IV.B.3, *supra*; (SOF 174.) It has also failed to specifically identify any other damage that it suffered as a result of Heartland's conduct. (*Id.*) Because Forest River cannot show that it suffered pecuniary harm as a result of Heartland's alleged conduct, it cannot invoke the benefits of the Victim's Relief Act. Hence, its criminal deception claim fails as a matter of law. Ind. Code § 34-24-3-1.

VI. CONCLUSION

For the reasons stated herein, Heartland did not commit inequitable conduct, did not violate the Lanham Act, and did not commit criminal deception. Because no issue of material fact exists with respect to Forest River's counterclaims, Heartland is entitled to summary judgment as a matter of law.

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CERTIFICATE OF SERVICE

The undersigned counsel for plaintiff Heartland Recreational Vehicles, LLC, hereby certifies that a copy of the foregoing was served upon the following, this 2nd day of November, 2010, by operation of the Court's electronic filing system:

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