

IN THE UNITED STATES DISTRICT COURT
FOR THE
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

GS CLEANTECH CORPORATION,)
)
Plaintiff/Counterclaim Defendant,)
)
vs.)
)
ADKINS ENERGY LLC,)
)
Defendant/Counterclaim Plaintiff.)

Case No. 10 C 4391
Larry J. McKinney

ORDER

Plaintiff GS CleanTech Corporation (“CleanTech”) filed a patent infringement case in the Northern District of Illinois back in 2010. In response to the complaint, as well as denying any infringement and raising other defenses, Adkins Energy LLC (“Adkins”) raised an affirmative defense in which it claimed to have been the beneficiary of a covenant not to sue executed by CleanTech which was violated by the infringement suit. This Court has addressed the affirmative defense twice in prior rulings. First, the Court denied summary judgment on the defense. Secondly, this Court ruled that injunctive relief is the appropriate remedy for breach of a covenant not to sue under Illinois law, which all agree applies in this case.

Currently pending before the Court is Adkins’ request for a trial on the issue of the above mentioned covenant not to sue. Adkins wishes to have the opportunity to prove that the conversation between parties representing CleanTech and Adkins had indeed evidenced that the parties entered into an oral or, as characterized in past pleadings, written covenant in which CleanTech promised not to sue Adkins for patent infringement.

It appears to this Court that such an exercise would invite the Court to opine on an issue that will not impact any current controversy between these parties.

Adkins has prevailed in this patent infringement case having had its Motion for Summary Judgment granted; therefore, there now exists no case or controversy between these parties on the patent. Success on the covenant not to sue affirmative defense could only result in an injunction against a suit that is over. The fact that this case may be appealed is of no moment to this argument. Should the case be reversed and remanded on appeal perhaps the issue should be readdressed, but on the record of this case as it appears today there is no need to determine whether Adkins can prove a covenant not to sue exists as the remedy would be meaningless.

Adkins argues that the trial on the covenant is not irrelevant to the current litigation because a finding of such a covenant would protect it from infringement suits that have not been filed. Adkins wishes the Court to draw the inference that there is an implicit direct threat that it will be sued. This inference Atkins builds upon CleanTech's continuing pursuit of patents that are based upon the patents that were at issue in this case. Adkins points out that CleanTech obtained a patent on similar technology in the face of and despite this Court's ruling on infringement.


CleanTech's continuing pursuit of patents based upon the patents in suit do not give this Court subject matter jurisdiction over patents on which Adkins has not been sued. *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007), requires that Adkins show that the threat of suit is "definite and concrete, touching the legal relations of the parties having adverse legal interests; and that it be real and substantial and admit of

specific relief through a degree of conclusive character, as distinguished from an opinion advising what the law would be upon a hypothetical state of facts.”

This Court has held the patents at issue are invalid and unenforceable. The issuance of new patents by the patent officer that are grounded in the patents at issue does not give CleanTech any traction for further suit. At this stage of this litigation, considering the health of the patents at issue, Adkins cannot prevail on an argument that it is in danger of a real and substantial threat of a suit.

For these reasons Adkins’ request for further trial on the affirmative defense of a violation of a covenant not to sue is **DENIED**. All matters between the parties having been adjudicated, judgment shall be entered accordingly.

IT IS SO ORDERED THIS 20th day of May, 2016.



LARRY J. MCKINNEY, JUDGE
Sitting by Designation
United States District Court
Northern District of Illinois

Electronically distributed to all registered attorneys of record via ECF.