

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEBRASKA

PHIL-INSUL CORP., d/b/a IntegraSpec,

Plaintiff,

vs.

AIRLITE PLASTICS, INC., and  
FORMTECH, LLC,

Defendants.

**8:12CV151**

**MEMORANDUM AND ORDER**

This matter is before the court on a motion for a summary judgment of non-infringement filed by defendants Airlite Plastics Co. and Patrick D. Gredys as manager at the time of dissolution and trustee for the members and creditors of Formtech LLC<sup>1</sup> (hereinafter referred to collectively as "Airlite"), [Filing No. 55](#), and on the parties' joint claim construction statement under *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) *aff'd*, 517 U.S. 370 (1996).<sup>2</sup> This is an action for patent infringement under 35 U.S.C. § 1, *et seq.*

Plaintiff Phil-Insul Corp., doing business as IntegraSpec (hereinafter, "IntegraSpec") is the assignee of record for U.S. Patent No. 5,428,933 ("the '933 Patent"). The '933 Patent relates to bidirectional and reversible insulating concrete forms ("ICFs"), which are used in construction of buildings. The patent was issued on July 4, 1995, a reexamination

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<sup>1</sup> The record shows defendant Formtech LLC was a limited liability company that existed under the laws of Nebraska, Limited Liability Company Act, [Neb. Rev. Stat. §§ 21-2601 to 21-2654](#), having a principal place of business at 6110 Abbott Drive, Omaha, Nebraska 68110. [Filing No. 21](#), Defendants' Answer at 2. Formtech LLC was dissolved under the laws of Nebraska, [Neb. Rev. Stat. § 21-2627](#), on February 9, 2011. *Id.* Airlite was the sole member of Formtech LLC. *Id.* Patrick D. Gredys, Vice President/General Manager of Airlite Plastics Co. EPS Division, was manager at the time of dissolution and trustee for the members and creditors of Formtech LLC. *Id.* Formtech has filed pleadings in this case without waiver of its status as a dissolved LLC. *Id.* It contends it is not subject to suit under the laws of Nebraska.

<sup>2</sup> Airlite maintains its position that no claim construction is necessary. See [Filing No. 68](#), Defendant's Brief at 4.

certificate was issued on September 21, 2010, and a second reexamination certificate was issued on July 15, 2014. In its complaint, IntegraSpec alleges that defendant Airlite has manufactured and sold an ICF under the trademark "Fox Blocks" that copies features of the '933 patented form. IntegraSpec contends Fox Blocks ICFs infringe at least Claims 2, 7, 8, 9 and 10 of the '933 Patent.<sup>3</sup>

The claim construction and summary judgment issues are interrelated and dependent on resolution of the issue of whether the claim construction and non-infringement findings in *Phil-Insul Corp. d/b/a IntegraSpec v. Reward Wall Systems, Inc., et al.*, Civil Action No. 8:12-CV-91 (D. Neb.), *aff'd without opinion*, 580 Fed. Appx. 907 (Fed. Cir. 2014) (hereinafter, "Reward Wall") are controlling in this case. If the court grants the defendants' motion, there is no need for claim construction.

## I. BACKGROUND

### A. The Patent

The record shows that the '933 Patent was originally issued on July 4, 1995, with 4 independent claims—claims 1, 11, 17 and 18—and 14 dependent claims. [Filing No. 57-1](#), Evidence Index, Ex. 1, '933 Patent, cols. 6–8. As originally issued, independent Claim 1 of

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<sup>3</sup> Specifically, IntegraSpec accuses two separate ICF product lines of infringement—the Fox Blocks ICFs and the Fox Blocks 1440 ICFs ("Fox 1440 ICFs"). The Fox 1440 ICFs were formerly sold by the Formtech Corporation. See [Filing No. 61-6](#), Evidence Index, Ex. 31, Declaration II of Brad Crosby ("Crosby Decl. II") at 3. Multiple models of Fox Blocks ICFs (Fox Blocks Straight Block, Corner Block, Angle Block, T-Block Short, and the T-Block Long) are accused of infringing Claims 2 and 5 of the '933 Patent and multiple models of Fox 1440 ICFs (the Fox 1440 Straight Block, the Fox 1440 Angle Block, and the Fox 1440 Corner Block) are accused of infringing Claims 2, 4, 5, 19, and 27 of the '933 Patent. [Filing No. 49](#), Amended Rule 26(f) Report at 3; [Filing No. 61-4](#), Evidence Index, Ex. 29, Plaintiff's Disclosure of Asserted Claims & Preliminary Infringement Contentions, Ex. A.

All of the Accused Fox Blocks ICFs have a panel or sidewall with a single row of alternating projections and recesses on their top and bottom edges. See [Filing No. 61-5](#), Evidence Index, Ex. 30, Declaration I of Brad Crosby ("Crosby Decl. I") at 2. All of the Accused Fox 1440 ICFs include projections and recesses that do not each have at least the same volume, and include projections and recesses with differences in volume greater than 10%. See Crosby Decl. II at 3.

the '933 Patent was directed to ICFs in which the interconnecting means on the top and bottom edges of each panel "comprise[d] at least two rows of alternating projections and recesses . . . wherein said recess of one row is adjacent said projection of the other row." *Id.*, '933 Patent, col. 6, ll. 11-15. Claim 2 as originally issued stated only "[a]n insulating construction member according to claim 1, wherein said member is an insulating construction block." *Id.* at col. 6, ll. 23-25.

Claim 19 was added in the first *ex parte* reexamination. See [Filing No. 57-3](#), Evidence Index, Ex. 3, Ex Parte Reexamination Certificate for U.S. Patent No. 5,428,933 issued September 21, 2010 ("First Reexam. Cert.") at 3; [Filing No. 57-6](#), Evidence Index, Ex. 6, File History for Ex Parte Reexamination (Part 3) at 199. The "adjacent" requirement was present in both Claims 1 and 19. [Filing No. 57-3](#), Evidence Index, Ex. 3, First Reexam Cert. at 3.

Accordingly, after the first reexamination, Claim 1 provided as follows, with the added language underlined, removed language bracketed, and phrases using "adjacent" bolded:

In [an] a bi-directional and reversible insulating construction member having substantially planar ends and top and bottom edges and interconnecting means on said top and on said bottom edges, the improvement wherein each said top interconnecting means [comprise] and each said bottom interconnecting means has a pattern, each pattern comprising **at least two longitudinally extending rows of alternating, continuous, immediately adjacent projections and recesses,** extending continuously along the entire length of said top and bottom edges, the end projection in one row flush with at least a portion of one of said end planes, within each said pattern each of said projections and recesses in each one of said at least two rows within said pattern being of substantially the same dimension, wherein within each said pattern said recess of one row is adjacent said projection of the other row, and wherein said interconnecting means patterns on said top and bottom edges are the same and are offset arranged such that said recess of one row in said pattern on said top edge is opposed to said projection of an opposite row [of] in said pattern on said bottom edge; whereby said insulating

construction member can be interconnected with a like member in a bi-directional [or] and reversible manner.

[Filing No. 57-3](#), Evidence Index, Ex. 3, First Reexam Cert. at 3. Claim 2 of the '933 Patent was amended as follows, with the added language underlined and removed language bracketed:

An insulating construction member according to claim 1, wherein said member is an insulating construction block comprising two panels, each of said panels having a pattern on the top and bottom edges, each of said patterns on each of said panels comprising at least one longitudinally extending row of alternating, continuous, immediately adjacent projections and recesses and each of said projections and each of said recesses within each said pattern in said at least one row being of substantially the same dimension.

*Id.*

A second ex parte reexamination certificate was issued in 2014. As reconstituted after that reexamination, Claims 1, 3, 6-10, 12, 17, 18, and 24 were cancelled. [Filing No. 57-7](#), Evidence Index, Ex. 5, Ex Parte Reexamination Certificate at 2.

#### B. The *Reward Wall* Action

IntegraSpec originally filed two patent infringement actions: one against multiple defendants in *Reward Wall* on February 2, 2011, and this action, filed on May 12, 2012. See [Filing No. 1](#), Complaint; [Filing No. 60-2](#), Evidence Index, Ex. 7, *Reward Wall* Complaint. This action was stayed pending the outcome of either the second reexamination proceeding in the Patent and Trademark Office ("PTO") or of the *Reward Wall* action itself. [Filing No. 35](#), Order. While the present action was stayed, the *Reward Wall* case proceeded and ultimately resulted in a finding that the products accused therein did not infringe the '933 Patent, either literally or under the doctrine of equivalents. See *Reward Wall*, No. 8:12-CV-91, Filing No. 215, Memorandum and Order at 14-19; *id.*, Filing No. 253, Memorandum and Order at 18-28.

In *Reward Wall*, the court construed certain terms in the '933 Patent. *Reward Wall*, No. 8:12-CV-91, Filing No. 168, Memorandum and Order Re: Claim Construction ("Claim Construction Order"). The parties had requested an early construction of three claim terms found in both Claim 1 and Claim 19 of the '933 Patent, and agreed that the limitations should be construed the same way in both claims. *Id.* The terms construed were: (1) "adjacent;" (2) "substantially the same dimension;" and (3) "substantially planar ends." *Id.* at 3-4. In its claim construction order, the court relied heavily on the prosecution history in connection with the original application and the on reexamination. *Id.* at 13-29.

Subsequent to claim construction, the defendants in *Reward Wall* filed motions for summary judgments of non-infringement. *Reward Wall*, No. 8:12-CV-91, Filing Nos. 169, 178, and 189, Motions. They argued that the ICFs accused therein did not infringe the '933 Patent because they did not contain the "adjacent" limitation. *Id.* at 9. The "adjacent" limitation in Claim 1 of the '933 Patent, as amended in the first reexamination, states: "wherein within each said pattern said recess of one row is *adjacent* said projection of the other row." Filing No. 57-3, Evidence Index, Ex. 3, First Reexam Cert at 3. The court had construed that limitation to mean "wherein within each said pattern said recess of one row is *next to* said projection of the other row *on the same panel or sidewall.*"<sup>4</sup> *Reward Wall*, No. 8:12-CV-91, Filing No. 168, Claim Construction Order at 12. The court found the accused products did not literally infringe the '933 Patent because there was "no evidence from which a reasonable finder of fact could conclude that the recess of one row is 'next to' a

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<sup>4</sup> The court rejected IntegraSpec's proposed construction, which was "having X and Y axes, the recess in one row along the Y axis alternates with (a) a projection in the same row along the Y axis and (b) a projection in the other row along the x-axis." *Reward Wall*, No. 8:12-CV-91, Filing No. 168, Claim Construction Order at 10, 12-13.

projection of the other row 'on the same panel or sidewall.'" *Reward Wall*, 8:12-CV-91, Filing No. 215 at 10.<sup>5</sup>

In the subsequent motions for summary judgment of non-infringement, the term "substantially the same dimension" (as part of the description of the projections and recesses along the top and bottom edges of the ICF), was central to the issue of alleged infringement under the doctrine of equivalents. See *id.*, Filing No. 206, defendant BuildBlock Systems, LLC's Brief at 11-13; Filing No. 219, defendant Reward Wall System's Brief at 2, 14-21; Filing No. 253, Memorandum and Order at 4. The phrase "substantially the same dimension" had been construed to mean "the same measurable length, breadth, area, and volume, with only minor variations in dimension of up to about 10%."<sup>6</sup> *Id.* at 4; See *id.*, Filing No. 168, Claim Construction Order at 20-27, 31.

In its brief in opposition to the motions, IntegraSpec challenged the claim construction rulings, reasserting the unsuccessful argument it presented in connection with the *Markman* proceedings. See *Reward Wall*, Filing No. 239, IntegraSpec Brief at 24-25. The court noted that the construction of "dimension" was based in part on the prosecution history, which "[made it] clear that the patentee limited the meaning of "substantially the same dimension" to include more than just the longitudinal axis of an ICF," in order to

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<sup>5</sup> The Claim Construction Order and the Memorandum and Order on the first motions for summary judgment were issued by Chief United States District Judge Smith Camp. See *Reward Wall*, No. 8:12-CV-91, Filing No. 215, Memorandum and Order; Filing No. 168, Claim Construction Order. The case was reassigned to the undersigned on December 10, 2012, and the undersigned ruled on a subsequent motion for summary judgment. *Id.*, Filing No. 228, Recusal Order; Filing No. 229, Reassignment Order.

<sup>6</sup> In claim construction, the court had rejected IntegraSpec's contention that the term "dimension" in the limitation "substantially the same dimension," referred only to the linear dimension measured along a projection's or a recess's longitudinal axis. *Reward Wall*, No. 8:12-CV-91, Filing No. 168, Claim Construction Order at 20, 23-26.

distinguish the '933 Patent from the prior art.<sup>7</sup> See *id.*, Filing No. 253, Memorandum and Order at 5-6. The court noted that only infringement under the doctrine of equivalents was at issue, since IntegraSpec had conceded that "given the court's construction of the limitation 'substantially the same dimension,' none of the [remaining accused products] literally infringes the '933 Patent." *Id.* at 14.

The court rejected the defendants' argument that IntegraSpec was estopped from attempting to establish infringement under the doctrine of equivalents, and proceeded to determine whether "the Accused Products fall within the scope of surrender resulting from arguments made by [IntegraSpec] during the prosecution of the Patent." *Id.* at 19. The court noted that the defendants relied primarily on arguments they had presented during the claim construction phase of the action, and found that "in order to gain issuance of the '933 Patent, [IntegraSpec] limited its claims to ICFs with projections and recesses having "the same measurable length, breadth, area, and volume." *Id.* at 22. In light of that finding, the court found that

given the undisputed evidence in the record, no reasonable jury could conclude that the Accused Products have the equivalent to projections and recesses of "substantially the same dimension." In other words, the Accused Products' projections and recesses cannot be characterized as being an equivalent to "substantially the same dimension" without rendering that limitation (as construed by the court) meaningless.

*Id.* at 26. The court rejected IntegraSpec's invitation to abandon the previous construction, and found the Accused Products did not infringe the '933 Patent. *Id.* at 26-27. Thereafter, the court entered a final judgment dismissing IntegraSpec's claims. See *id.*, Filing Nos. 257, Memorandum and Order; 258, Judgment; and 262, Amended Judgment.

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<sup>7</sup> The court noted that "the chief judge's construction of the limitation is the law of the case, and this court will not redefine the limitation to focus solely on the 'length' or 'longitudinal' component of 'dimension.' See *id.*, Filing No. 253, Memorandum and Order at 26.

IntegraSpec appealed the court's decision. See *Id.*, Filing No. 260, Notice of Appeal; *Phil-Insul Corp. v. Reward Wall Systems, Inc.*, No. 14-1078 (Fed. Cir. Nov. 13, 2013). On appeal, IntegraSpec challenged only the court's claim construction, specifically, the construction of the terms "adjacent" and "dimension." Filing No. 60-18, Evidence Index, Ex. 23, IntegraSpec Brief on Appeal at 4; *Phil-Insul Corp. v. Reward Wall Systems, Inc.*, No. 14-1078, Filing No. 28 (Fed. Cir. Dec. 11, 2013) at 4. It did not appeal the orders granting summary judgment in favor of the Reward Wall defendants. See *id.* (framing the issue as "Did the lower court err in its claim construction order of July 19, 2012 . . ."). It argued that the district court's construction of "adjacent" in Claim 1 rendered Claims 2 and 3 redundant and nonsensical. *Id.* at 24.<sup>8</sup>

While the action was pending on appeal—after completion of briefing, but before oral argument—the PTO issued the second *ex parte* reexamination certificate. [Filing No. 57-7](#), Evidence Index, Ex. 5, Ex Parte Reexamination Certificate. The results of that reexamination were: "the patentability of claims 2, 4, 5, 11, 13-16, 19-23 and 25-27 is confirmed. Claims 12, 17 and 18 were previously cancelled. Claims 1, 3, 6-10 and 24 are cancelled." *Id.* at 3. At the time the Federal Circuit rendered its decision, it was aware of the PTO action by virtue of IntegraSpec's filing of an unopposed motion to take judicial notice of the results of the second reexamination of the patent, which the Appeals Court granted. [Filing No. 61-2](#), Evidence Index, Ex. 27, Motion; [Filing No. 61-3](#), Index of Evid.,

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<sup>8</sup> This court's review of the audiotape of oral argument confirms that IntegraSpec did not challenge the noninfringement finding. See *Phil-Insul Corp. v. Reward Wall Systems, Inc.*, No. 14-1078 (Fed. Cir. Nov. 13, 2013), oral argument recording, available at [www.ca9.uscourts.gov/oral-argument-recordings](http://www.ca9.uscourts.gov/oral-argument-recordings). Further, it confirms that IntegraSpec argued that the court severely limited the scope of Claim 1 and in doing so rendered Claim 2 meaningless, the same argument it propounds here. *Id.* The judges appeared to challenge IntegraSpec's "irreconcilable conflict" argument, stating that there were circumstances that "trump" a conflict between claims, including the prosecution history. *Id.*

Ex. 28, Order; *Phil-Insul Corp. v. Reward Wall Systems, Inc.*, No. 14-1078, Filing No. 62 (Fed. Cir. Sept. 15, 2014); *id.*, Filing No. 65 (Fed. Cir. Sept. 22, 2014).

On October 10, 2014, the Federal Circuit issued its order affirming the district court without opinion. See *Reward Wall*, No. 8:12-CV-91, Filing No. 271; *Phil-Insul Corp. v. Reward Wall Systems, Inc.*, No. 14-1078, Filing No. 67, Opinion and Judgment (Fed. Cir. Oct. 10, 2014) (stating only that "[t]his Court affirmed the judgment or decision that was appealed.").

### C. The Present Action

After the stay of the present case was lifted, IntegraSpec moved for claim construction in this case and Airlite opposed the motion, on the basis of collateral estoppel, although it agreed to respond. [Filing No. 53](#), Joint Claim Construction Statement at 1. Airlite then moved for a summary judgment of non-infringement, also on the basis of collateral estoppel. [Filing No. 55](#), Motion.

Airlite argues that this court and the United States Court of Appeals for the Federal Circuit ("Federal Circuit") have already decided, in *Reward Wall*, issues that are dispositive of this case. It contends that IntegraSpec's '933 infringement claim against Airlite's Accused Products is indistinguishable from the infringement allegations leveled at the products in *Reward Wall* that ultimately resulted in a final judgment of non-infringement. Airlite argues that there are no material differences between the products determined to be non-infringing in *Reward Wall* and Airlite's accused products.<sup>9</sup> Airlite contends that IntegraSpec had a full and fair opportunity in *Reward Wall* to litigate infringement of the

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<sup>9</sup> In support of that contention, it submits evidence that was presented and credited in *Reward Wall* and offers a comparison of the Accused Products in each case. See [Filing No. 61-5](#), Ex. 30, Declaration of Brad Crosby I, Exs. A - E; [Filing No. 61-6](#), Ex. 31, Declaration of Brad Crosby II, Exs. A - G; *Reward Wall*, No. 8:12-CV-91, Filing No. 219, defendant Reward Wall Systems, Inc.'s Brief at 14-20; Snider Decl. (Ex. 19.); [Filing No. 56](#), Brief at 2-3, 25, 33 (illustrations).

same patent as to similar, if not identical, products, and thus argues that IntegraSpec is collaterally estopped from re-litigating the infringement issue. It argues that to find in favor of IntegraSpec, the court would have to reject both the claim construction that was affirmed on appeal in *Reward Wall*, and the non-infringement findings based on that claim construction.

In response, IntegraSpec argues that it did not have a full and fair opportunity to litigate the issues in *Reward Wall*, contends that the district court's claim construction in *Reward Wall* was incorrect, and argues that the defense of collateral estoppel is not available in this case because the claim construction was not essential to the court's non-infringement rulings. It urges a contrary construction herein of the same claim terms that were at issue in *Reward Wall*.<sup>10</sup>

At the hearing in this case, counsel for IntegraSpec explained that the "generic subject matter of the claim, is a Construction Member. And according to the specification, a construction member is either a panel or a block," a block [having] two panels." [Filing No. 73](#), Transcript of Proceedings on July 10, 2015 ("Hr'g Tr.") at 6. IntegraSpec now alleges infringement of Claim 2, rather than Claim 1, and argues that Claim 2 was not considered in *Reward Wall*. *Id.* at 8, 10. It concedes however, that although Claim 1 (an independent claim) has been cancelled, in applying Claim 2 (a dependent claim) to the Accused Product, all the limitations of Claim 1 have to be brought forth into Claim 2. *Id.* at 7.

With respect to claim construction, Airlite proposes either essentially the same constructions adopted in *Reward Wall*, or no construction at all. [Filing No. 53](#), Joint Claim Construction Statement. IntegraSpec, on the other hand proposes as follows:

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<sup>10</sup> In particular, the central terms at issue herein are—as in *Reward Wall*—"adjacent," "dimension" and "substantially planar ends." See [Filing No. 53](#), Joint claim Construction Statement at 2-3.

1. in Claim 1 for "wherein within each said pattern said recess of one row is adjacent said projection of the other row," the following:

wherein within each said pattern having X and Y axes, the recess in one row along the Y axis alternates with (a) the projection in the same row along the Y axis and (b) a projection in the other row along the X axis

2. in Claim 1 for "at least two longitudinally extending rows," the following:

at least two longitudinally extending rows located at unspecified locations on the construction member

3. in Claim 1 for "immediately adjacent projections and recesses," the following:

projections and recesses touching one another

4. in Claim 2 for "wherein said member is an insulating construction block comprising two panels, each of said panels having a pattern on the top and bottom edges, each of said patterns on each of said panels comprising at least one longitudinally extending row," the following:

wherein said construction member having at least two longitudinally extending rows of projections and recesses is an insulating construction block comprising two panels, each of said panels having a pattern on the top and bottom edges, each of said patterns on each of said panels comprising at least one longitudinally extending row

5. in Claim 19 for "wherein said recess of one row in each said pattern is adjacent said projection of the other row in the same pattern," the following :

wherein within each said pattern having X and Y axes, the recess in one row along the Y axis alternates with (a) the projection in the same row along the Y axis and (b) a projection in the other row along the X axis

6. in Claims 1 and 19, for "substantially the same dimension," the following:

each of the projections and recesses within each row of a pattern having substantially the same dimension in the longitudinal direction

7. in Claims 1 and 19, for "substantially planar ends," the following:

substantially flat ends

See generally, [Filing No. 53](#), Joint Claim Construction Statement.

IntegraSpec argues that a different construction of the terms is necessary because the claim construction in *Reward Wall* creates an irreconcilable conflict between Claims 1 and 2. [Filing No. 73](#), Hr'g Tr. at 82-85. IntegraSpec argues that this irreconcilable conflict was due to the court's failure to look at the relationship between Claims 1 and 2, stating

if [the court] had looked at claim 2, the -- it would have been apparent that claim 2 is irreconcilably in conflict with claim 1 because claim 1 says both rows on one panel. Claim 2 says there can be one row on each of the two panels. So from our point of view, the Court, when it used the claims as a source for construction, failed to take that into account. And that's one of the errors we believe led to an incorrect claim construction.

[Filing No. 73](#), Hearing Tr. at 10.

II. LAW

A. Markman Standards

Claim construction begins with the language of the claims themselves. [Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.](#), 381 F.3d 1111, 1116 (Fed. Cir. 2004). The words of a claim are generally given their ordinary and customary meaning, which is the meaning that the term would have to a person of ordinary skill in the art at the time of the invention. [Phillips v. AWH Corp.](#), 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). “[T]he usage of [the] term in one claim can often illuminate the meaning of the same term in other claims.” See [Phillips](#), 415 F.3d at 1314.

"The most relevant source [for ascertaining the meaning of a claim] is the patent's specification, which is “the single best guide to the meaning of a disputed term.” [MBO Labs. Inc. v. Becton, Dickinson & Co.](#), 474 F.3d 1323, 1329 (Fed. Cir. 2007) (quoting

*Phillips*, 415 F.3d at 1315). The next most relevant source “is the prosecution history, which . . . directly reflects how the patentee has characterized the invention.” *Id.*

A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers. *Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352, 1357 (Fed. Cir. 2007); see *Zircon Corp. v. Stanley Black & Decker, Inc.*, 452 F. App'x 966, 975 (Fed. Cir. 2011). Where a particular construction of an independent claim would nullify claims that depend from it, the doctrine of claim differentiation creates a presumption that such a construction is improper. See *Liebel–Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004). “[C]laim differentiation is 'not a hard and fast rule and will be overcome by a contrary construction dictated by the written description or prosecution history.’” *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1359 (Fed. Cir. 2012) (quoting *Seachange Int'l, Inc. v. C–COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005)).

#### B. Collateral Estoppel

The general collateral estoppel rules of the regional circuit apply in patent cases. *Novartis Pharm. Corp. v. Watson Labs., Inc.*, 611 F. App'x 988, 997 (Fed. Cir. 2015); *Aspex Eyewear, Inc. v. Zenni Optical Inc.*, 713 F.3d 1377, 1380 (Fed. Cir. 2013) (stating that “[s]ince the criteria of collateral estoppel are not unique to patent issues, on appellate review [the Federal Circuit is] guided by the precedent of the regional circuit.”). *Dana v. E.S. Originals, Inc.*, 342 F.3d 1320, 1323 (Fed. Cir. 2003). In the Eighth Circuit, the term “collateral estoppel” comprehends a variety of more specific doctrines including issue preclusion, the estoppel applicable here. See *Robinette v. Jones*, 476 F.3d 585, 589 (8th Cir. 2007). Issue preclusion has five elements: (1) the party sought to be precluded in the second suit must have been a party, or in privity with a party, to the original lawsuit; (2) the issue sought to be precluded must be the same as the issue involved in the prior action; (3)

the issue sought to be precluded must have been actually litigated in the prior action; (4) the issue sought to be precluded must have been determined by a valid and final judgment; and (5) the determination in the prior action must have been essential to the prior judgment. *Robinette v. Jones*, 476 F.3d 585, 589 (8th Cir. 2007).

A full and fair opportunity to litigate is the touchstone of any preclusion analysis. *Taylor v. Sturgell*, 553 U.S. 880, 892 (2008). The “desire not to deprive a litigant of an adequate day in court” is balanced against the “desire to prevent repetitious litigation of what is essentially the same dispute.” *In re Freeman*, 30 F.3d 1459, 1465 (Fed. Cir. 1994). “It is the issues litigated, not the specific claims around which the issues were framed, that is determinative. Only by focusing on the issues, and examining the substance of those issues, can the second court ascertain whether the patentee had the requisite full and fair chance to litigate . . . in the first suit.” *Westwood Chem., Inc. v. United States*, 525 F.2d 1367, 1372 (Ct. Cl. 1975); see *Marrese v. American Acad. of Orthopaedic Surgeons*, 470 U.S. 373, 390–91, (1985) (“[A] party is precluded from asserting a claim that he had a ‘full and fair opportunity’ to litigate in a prior action.”).

However, for any aspects that may have special or unique application to patent cases, Federal Circuit precedent is applicable. *Zenni Optical*, 713 F.3d at 1323; *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1341 n. 1 (Fed. Cir. 2012) (“[T]he question whether a particular claim in a patent case is the same as or separate from another claim has special application to patent cases, and we therefore apply our own law to that issue.”). “Under the law of the Federal Circuit, an infringement claim in a second suit is the ‘same claim’ as in an earlier infringement suit if the accused products in the two suits are ‘essentially the same.’” *Roche Palo Alto LLC v. Apotex, Inc.*, 531 F.3d 1372, 1379 (Fed. Cir. 2008); see *Reese v. Verizon Cal., Inc.*, No. 2012–1048, 2012 WL 6634227, at \*2 (Fed.

Cir. Dec. 21, 2012) (collateral estoppel applies when the same technology is said to infringe the same patent); *Del Mar Avionics, Inc. v. Quinton Instrument Co.*, 836 F.2d 1320, 1323 (Fed. Cir. 1987) (“The prior determination of certain issues, including the issues of claim construction and of infringement by [one model] and non-infringement by [another model], bars judicial redetermination of those issues”); *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296, 1311–12 (Fed. Cir. 2010) (applying collateral estoppel when “the infringement issue in [the second] case is identical to the one in [the first case],” for the “differences in the facts . . . do not change the fact that the modified rig does not infringe.”).

### C. Precedential Value

Under the Rules of Practice for the Federal Circuit,

The court may enter a judgment of affirmance without opinion, . . . when it determines that any of the following conditions exist and an opinion would have no precedential value: (a) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous; (b) the evidence supporting the jury’s verdict is sufficient; (c) the record supports summary judgment, directed verdict, or judgment on the pleadings; (d) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or (e) a judgment or decision has been entered without an error of law.

[Fed. Cir. R. 36](#) (entry of judgment — judgment of affirmance without opinion); see [Filing No. 61-7](#), Ex. 32, United States Court of Appeals for the Federal Circuit, Rules of Practice at 77-78. Federal Circuit Rule 32.1(b) provides that: “[a]n opinion or order which is designated as nonprecedential is one determined by the panel issuing it as not adding significantly to the body of law.” [Fed. Cir. R. 32.1\(b\)](#) (citing judicial dispositions); see [Filing No. 61-7](#), Ex. 32, United States Court of Appeals for the Federal Circuit, Rules of Practice at 69. That an order lacks precedential value does not mean that it is not binding with respect to the same issue against the same party involving the same patent. See, e.g., *National Classification*

*Comm. v. United States*, 765 F.2d 164, 170 (D.C. Cir. 1985) (“While, as an unpublished opinion, [the court's opinion] has no precedential effect with respect to other parties, it is binding as a final judgment with respect to petitioners.”); *Gowadia v. Internal Revenue Serv.*, 87 F. Supp. 3d 188, 190-91 (D.D.C. 2015) (stating “[r]egardless of the precedential weight to be accorded an unpublished decision of the Court of Appeals . . . it is clearly binding on [a party to that case]”); *Taylor v. Sturgell*, 553 U.S. 880, 892 (2008) (“Issue preclusion . . . bars successive litigation of an issue of fact or law actually litigated and resolved in a valid court determination essential to the prior judgment, even if the issue recurs in the context of a different claim”).

### III. DISCUSSION

The court finds the defendants' motion for summary judgment based on collateral estoppel/issue preclusion should be granted.<sup>11</sup> IntegraSpec has not shown any changed circumstances or presented any evidence or arguments that were not available to it in the earlier action and appeal. The patent claims at issue contain the same "adjacent" and "dimension" terms that were construed in *Reward Wall*. The construction of those terms was dispositive of the issue of non-infringement in that case. Although the earlier case involved Claims 1 and 19 of the '933 Patent, IntegraSpec concedes that Claim 2 contains all of the limitations of the (now-cancelled) Claim 1. The infringement issue litigated in *Reward Wall* is substantively the same as the infringement issue presented herein. Minor differences in the accused products or the selection of additional or different claims of a patent for litigation cannot override the court's earlier construction, affirmed on appeal, and concomitant finding of non-infringement.

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<sup>11</sup> This finding renders claim construction moot.

The court finds the court's earlier claim construction should be afforded preclusive effect. Airlite has established the five factors required for claim preclusion in the Eighth Circuit. See *Robinette*, 476 F.3d at 589. IntegraSpec was a party to the original lawsuit; the claim construction and non-infringement issues are the same as those involved in the prior action; the issues were actually litigated therein, were determined by a valid and final judgment, and the claim construction and infringement determinations in the prior action were essential to the final judgment of non-infringement. *Id.* Notably, the claim construction order is a final judgment by virtue of having been affirmed on appeal and the judgment of non-infringement is a final order in that it was not appealed and appeal time has passed.

The record shows IntegraSpec had a full and fair opportunity to litigate the dispositive claim limitation in the prior proceeding. IntegraSpec fully litigated the meaning of the terms "adjacent" and "dimension" in the first action. Application of the court's construction of the terms in the context of Claims 1 and 19 to the accused products resulted in a finding of non-infringement. The same technology is at issue and the issues of infringement are essentially indistinguishable. That the district court's claim construction was affirmed without opinion is of no consequence to this determination.<sup>12</sup> IntegraSpec was a party to the earlier litigation and the Appeals Court's decision is afforded preclusive effect as to that party. Under the Federal Circuit's rules, the Appeals Court's summary affirmance is an implicit recognition that the district court's claim construction order was based on findings that are not clearly erroneous and the order was entered without an error of law. See *Fed. Cir. R. 36(a) & (e)*. Also, the Federal Circuit was aware of the results of the

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<sup>12</sup> The court finds that IntegraSpec' reliance on *TecSec, Inc. v. International Bus. Machs. Corp.*, 731 F.3d 1336, 1342 (Fed. Cir. 2013), in this regard is misplaced. This case presents the flip-side of the situation presented in *TecSec*. *Id.* at 1343 (stating that the district court had not relied on claim construction in its determination, but that "had that claim construction been essential to sustaining the judgment of noninfringement, the preclusive effect of our Rule 36 judgment would have been undeniable.").

second reexamination, took judicial notice of the PTO's action, and nonetheless affirmed the district court's claim construction.

Though IntegraSpec's argument that the claim construction creates an irreconcilable conflict between Claim 1 and Claim 2 has some appeal in the context of blocks rather than panels, the fact remains that the same argument was presented to, and rejected by, the Court of Appeals. This court is without authority to effectively reverse that finding. Accordingly, the court finds IntegraSpec is bound by the rulings in the earlier case.

Affording preclusive effect to the prior rulings results, as in the earlier action, in a finding that the accused products do not infringe. The accused FoxBlocks ICFs in this case have the same design as the accused Nudera ICFs found to be noninfringing in *Reward Wall*. The accused Fox 1440 ICFs in this case have the same design of projections and recesses on the bottom edges of the sidewalls so that at least each projection (a) does not have the same volume dimension and (b) the variation in volume between altered and unaltered projections is greater than 10% as the accused Reward Wall ICFs that were adjudicated in *Reward Wall* to not include the "substantially same dimension" limitation of Claims 1 and 19 as a matter of law.

In the appeal in *Reward Wall*, IntegraSpec raised only the issue of construction of the "adjacent" and "dimension" limitations in regard to the judgment of non-infringement of the accused Nudura ICFs and accused Reward Wall ICFs. The determination that the accused Nudura ICFs did not include the "adjacent" limitation, and the Reward Wall ICFs did not include substantially the same dimensions were essential to the judgments of non-infringement. For the same reasons stated in connection with the accused Nudura ICFs and Reward Wall ICFs in *Reward Wall*, the court finds Airlite's accused products do not infringe

the '933 Patent.<sup>13</sup> See *Reward Wall*, No. 8:12-CV-91, Filing No. 253, Memorandum and Order at 22-28; *id.*, Filing No. 215, Memorandum and Order at 11-19. Accordingly,

IT IS ORDERED:

1. Defendants' motion for summary judgment ([Filing No. 55](#)) is granted;
2. A judgment of dismissal in conformity with this Memorandum and Order will issue this date.

Dated this 2nd day of March, 2016.

BY THE COURT:

s/ Joseph F. Bataillon  
Senior United States District Judge

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<sup>13</sup> IntegraSpec has not propounded any argument or evidence on the substantive issue of non-infringement. It argues only that the motion for non-infringement is not properly before the court and argues against the application of collateral estoppel. See [Filing No. 63](#), Integraspec Memorandum in Opposition to Defendants' Motion for Summary Judgment at 9, 19-26.