

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

ITW GLOBAL TIRE REPAIR INC.,

Plaintiff,

vs.

Case No. 18-7165

HOPKINS MANUFACTURING
CORPORATION,

JURY TRIAL DEMANDED

Defendant.

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff, ITW Global Tire Repair, Inc. (“ITWGTR”), for its Complaint against defendant Hopkins Manufacturing Corporation (“Hopkins”), states as follows:

NATURE OF THE ACTION

1. This is an action for patent infringement arising under the patent laws of the United States, 35 U.S.C. §271 et seq., to enjoin infringement and obtain damages resulting from Hopkins’ unauthorized manufacture, use, sale or offer to sell within the United States and/or importation into the United States of products that infringe one or more claims of United States Patent No. 7,388,041 (“the ‘041 patent”). ITWGTR seeks injunctive relief to prevent Hopkins from continuing to infringe the ‘041 patent and seeks a recovery of monetary damages resulting from Hopkins’ infringement of the ‘041 patent.

2. This action for infringement involves Hopkins’ manufacture, use, sale or offer to sell within the United States and/or importation into the United States of infringing products

related to puncture sealants for tires, including “VALVE THRU ATV/OFF-ROAD TIRE SEALANT (“Accused Product”).

PARTIES

3. ITWGTR is a corporation organized and existing under the laws of the State of California. ITWGTR’s principal place of business is located at 125 Venture Drive, Suite 210, San Luis Obispo, California 93401.

4. ITWGTR offers a full range of automatic and semi-automatic tire repair solutions that employ the latest technologies and offer the consumer simplicity and intuitive use. For over two decades, ITWGTR has introduced alternative solutions to the spare tire that have been embraced by retailers and consumers in the aftermarket automotive space in the United States and elsewhere, and adopted by leading global original equipment manufacturers.

5. Upon information and belief, Hopkins is a corporation organized and existing under the laws of the State of Kansas, with its principal place of business located at 428 Peyton Street, Emporia, Kansas 66801. Hopkins is registered to do business in Illinois and has a regular and established place of business in the Northern District of Illinois, including an operational and marketing facility located at 6700 Wildlife Way, Long Grove, Illinois 60047, which the company calls “Hopkins – Illinois” on its LinkedIn page.

JURISDICTION AND VENUE

6. ITWGTR’s claim for patent infringement against Hopkins arises under the patent laws of the United States, 35 U.S.C. §§1 et seq., including 35 U.S.C. §§271 and 281. This Court has original subject matter jurisdiction over this suit pursuant to 28 U.S.C. §§1331 and 1338(a).

7. Hopkins is subject to personal jurisdiction in this district because, upon information and belief, Hopkins regularly conducts business in this judicial district, including,

among other things, making, using, selling or offering to sell its products to customers located in this district, including the Accused Product. Upon information and belief, Hopkins has committed and continues to commit acts of patent infringement within this judicial district, and has and continues to harm ITWGTR in this judicial district by, among other things, the sale of the Accused Product which infringe the '041 patent.

8. Venue is proper in this judicial district under 28 U.S.C. § 1400(b) because, upon information and belief, Hopkins is registered to do business in the State of Illinois, has a regular and established place of business in this judicial district, as described above, and has committed acts of infringement within this judicial district by offering to sell and selling the Accused Product at retail establishments in this judicial district, as well as actively encouraging the use of the Accused Product in this judicial district.

BACKGROUND OF INVENTION

9. ITWGTR is a leading innovator in tire sealant technology and its tire sealant products are market leaders, commanding significant shelf space in leading retailers of automotive products such as Walmart, Auto Zone, Pep Boys and Advance Auto Parts.

10. When a puncture occurs in a tire, a puncture sealing agent is frequently used to seal the punctured portion from the inside, ensuring the airtightness of the tire so that the tire can be refilled with air.

11. Prior to ITWGTR's invention claimed in the '041 patent, known puncture sealing agents typically contained ethylene glycol or propylene glycol as an anti-freezing agent. When such sealing agents were stored for the long term, particles in the sealing agent would aggregate near the surface resulting in a creamy material that would clog the outlet of the tire sealant container, making it difficult to extrude the agent into the tire and hindering the puncture sealing

operation. ITWGTR's invention, among other things, prevents the formation of the clogging material and thus improves the long-term shelf life stability of the sealing agent. Moreover, ITWGTR's use of glycerin as an anti-freezing agent enables the smooth flow of the tire sealant at very low temperatures.

12. ITWGTR manufactures and sells various tire sealant products using its patented technology, including products sold under registered trademark "Slime". ITWGTR's tire sealant products containing the patented formulation are sold online and in retail outlets for automotive supplies in the United States, including such retail outlets in this judicial district.

**COUNT I
INFRINGEMENT OF U.S. PATENT NO. 7,388,041**

13. Plaintiff incorporates by reference the allegations contained in paragraphs 1 through 12 above as if fully set forth herein.

14. The '041 patent was issued on June 17, 2008 and is in full force and effect.

15. ITWGTR is the assignee of, owns all right, title and interest in, and has standing to sue for infringement of the '041 patent, entitled "Puncture Sealing Agent for a Tire, and Process for Producing the Same". A true and correct copy of the '041 patent is attached hereto as Exhibit A and incorporated herein by reference.

16. Upon information and belief, Hopkins makes, uses, sells, offers to sell the Accused Product within the United States and/or imports the Accused Product into the United States. Photographs of the Accused Product and product labeling are attached as Exhibit B and incorporated herein by reference.

17. Claim 1 of the '041 recites:

A puncture sealing agent, comprising:

A rubber latex comprising one of a natural rubber and a synthetic rubber mixed with a glycerin anti-freezing agent wherein a ratio of the glycerin anti-freezing agent to the total weight of the puncture sealing agent composition is between 5 and 75% by weight.

18. Upon information and belief, the Accused Product is a puncture sealing agent that is offered for sale and sold and used as a tire repair solution, and which contains rubber latex comprising a natural and synthetic rubber mixed with an anti-freezing agent that includes glycerin, with the glycerin in a ratio to the total weight of the puncture sealing agent of between 5 and 75% by weight.

19. Hopkins, by making, using, selling, offering to sell within the United States and/or importing into the United States the competing Accused Product, has infringed and continues to infringe, directly and/or indirectly, either literally and/or under the doctrine of equivalents, at least claim 1 of the '041 patent.

20. In addition, Hopkins actively induces others to infringe claims of the '041 patent, including claim 1, in violation of 35 U.S.C. §271(b).

21. Because ITWGTR has marked and continues to mark its competitive tire sealant products made, sold and used under the '041 patent, Hopkins, upon and information and belief, has actual knowledge of the '041 patent and the claims therein. Alternatively, Hopkins was willfully blind to the claims of the '041 patent despite a high probability that one or more claims covered features of ITWGTR's competitive tire sealant products, but took deliberate actions to avoid learning of that fact.

22. Despite its actual or constructive knowledge of the '041 patent, Hopkins, through its marketing, promotion and sales of the Accused Product, also intentionally induced acts that constituted infringement.

23. In manufacturing, offering for sale, selling and intentionally and actively encouraging the use of the Accused Product in the United States, Hopkins emulated and copied features of ITWGTR's competitive tire sealant solutions, including those claimed by the '041 patent.

24. Hopkins has been and continues to encourage others (e.g., distributors, retailers, customers and end users) to directly infringe the '041 patent with knowledge or willful blindness of that infringement, for example by importing, making, advertising, marketing, selling, offering to sell, supporting, distributing and actively encouraging the use of such products, including the Accused Product, in a way that infringes the '041 patent. These other persons directly infringe the '041 patent.

25. Indeed, Hopkins intends to aggressively promote and offer for sale the Accused Product to retailers and customers of tire sealant solutions at the upcoming 2018 AAPEX industry trade show in Las Vegas, Nevada, which will take place at the end of October 2018. The AAPEX trade show is one of the largest trade shows for participants in the aftermarket automotive parts and supplies industry.

26. The full extent of Hopkins' infringement is not presently known to ITWGTR. Products manufactured, sold, offered for sale and/or imported into the United States other than the Accused Product might also infringe one of more claims of the '041 patent.

27. Hopkins's infringement is willful given its knowledge of the '041 patent and its continuous and intentional infringement of the '041 patent in disregard of ITWGTR's rights.

26. Hopkins's infringement of the '041 patent has damaged and continues to cause damage to ITWGTR. ITWGTR is entitled to recover damages adequate to compensate it for such infringement by Defendant, including lost profits and/or a reasonable royalty.

27. ITWGTR is in compliance with 35 U.S.C. §287.

PRAYER FOR RELIEF

WHEREFORE, ITWGTR respectfully requests that this Court enter judgment against Hopkins and against its respective subsidiaries, successors, parents, affiliates, officers, directors, agents, servants, employees, and all other persons in active concert or participation with it, as follows:

1. That Hopkins has infringed one or more claims of the '041 patent pursuant to 35 U.S.C. §271;
2. Preliminarily and permanently enjoining Hopkins as well as its respective agents, servants, officers, directors, employees and all persons acting in concert with them from infringing the '041 patent pursuant to 35 U.S.C. §283;
3. An award to ITWGTR of damages to which it entitled as a consequence of Hopkins's infringement of the '041 patent and which are available under 35 U.S.C. §284, together with pre-judgment interest from the date the infringement began;
4. A determination that Hopkins's infringement is willful and accordingly awarding ITWGTR enhanced damages in accordance with 35 U.S.C. §284;
5. A declaration that this case is exceptional pursuant to 35 U.S.C. §285 and awarding to ITWGTR its reasonable attorney's fees, expenses and costs in this action;
6. An award to ITWGTR of post-judgment interest on the foregoing amounts at the maximum rate recoverable by law; and
7. An award to ITWGTR of such other and further relief as this Court deems just and proper.

DEMAND FOR JURY TRIAL

ITWGTR hereby demands a trial by jury on all issues so triable.

Dated: October 26, 2018.

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