

PATENT ASSIGNMENT

Electronic Version v1.1
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SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	Final Judgment rendered by Judge David C. Godbey in the U.S. District Court Northern District of Texas Dallas Division
CONVEYING PARTY DATA	
Name	Execution Date
Ga-Rew Corporation	01/30/2013
RECEIVING PARTY DATA	
Name:	Dehn's Innovations, LLC
Street Address:	4421 Black Otter Trail
City:	Dallas
State/Country:	TEXAS
Postal Code:	75287
PROPERTY NUMBERS Total: 1	
Property Type	Number
Patent Number:	6883732
CORRESPONDENCE DATA	
Fax Number:	5128538801
<i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i>	
Email:	jpitre@intprop.com
Correspondent Name:	Jackie Pitre
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Address Line 4:	Austin, TEXAS 78746
ATTORNEY DOCKET NUMBER:	6274-00400
NAME OF SUBMITTER:	Eric B. Meyertons
Total Attachments: 17 source=Judgment_GaRew_Hasegawa#page1.tif source=Judgment_GaRew_Hasegawa#page2.tif source=Judgment_GaRew_Hasegawa#page3.tif source=Judgment_GaRew_Hasegawa#page4.tif	

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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

Dehn's Innovations LLC

Plaintiff,

V.

**Total Import Solutions, Inc. d/b/a
Nanoskin Car Care Products, Ga-Rew
Corp., Kaga Hasegawa, an
Individual, and Steven Levy,
an Individual**

Defendants.

Civil Action No.

3:11-cv-3042

JURY TRIAL DEMANDED

FINAL JUDGMENT AS TO DEFENDANTS GA-REW CORP. AND KAGA HASEGAWA

The Court hereby makes the following findings of fact and conclusions of law, and enters the following judgment.

FINDINGS OF FACT

1. Plaintiff Dehn’s Innovations, LLC (hereinafter “Dehn”) is a Texas limited liability company with its principal place of business at 4421 Black Otter Trail, Dallas, Texas 75287.

2. Defendant Ga-Rew Corporation (hereinafter, “Ga-Rew”) is a Japanese corporation with its principal place of business at 2-18-10, Nishiogi Minami, Suginami-ku, Tokyo, 167-0053, Japan. Defendant Kaga Hasegawa (hereinafter, “Inventor”) is an individual residing in Japan at 2-18-10, Nishiogi Minami, Suginami-ku, Tokyo, 167-

0053, Japan. Ga-Rew and Inventor are collectively referred to herein as “Ga-Rew/Inventor”.

3. Jurisdiction is proper in this Court pursuant to 28 U.S.C. §§ 1331 and 1338 because this action, at least in part, is an action for patent infringement and arises under the Patent laws of the United States, Title 35 of the United States Code. Jurisdiction also exists pursuant to 28 U.S.C. § 1332(a) because complete diversity of citizenship exists between the parties and the amount in controversy exceeds the sum or value of \$75,000, exclusive of interest and costs. This Court has jurisdiction over any Texas state law claims under principles of pendent, ancillary, and supplemental jurisdiction, 28 U.S.C. §§ 1338(a) and (b) and 1367(a).

4. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), (d), and 1400(b) because, *inter alia*, one or more of the acts of infringement complained of took place in this district and the State of Texas.

5. Dehn is a manufacturer and marketer of automobile related products that are sold throughout the United States as well as internationally.

6. On or about February 27, 2001, Japanese patent application no. 2001-052618 (the “Japanese Patent Application”) was filed by or on behalf of the inventor, Kaga Hasegawa (the “Inventor”). The Japanese Patent Application was never published, and did not mature into a patent in Japan.

7. On or about February 27, 2002, Mr. Shigeki Ueta, a Japanese patent attorney with the firm of Ueta International Patent Office in Tokyo, Japan, (the “Japanese Patent Attorney”) sent a patent application to be filed in the United States claiming priority to the underlying Japanese Patent. This U.S. patent application No. 10/084,629

claims priority to the Japanese Patent Application, and subsequently matured into U.S. Patent No. 6,883,732 B2, referred to herein as the “ ‘732 Patent.”

8. On or about March 28, 2002, an inventor’s declaration and an assignment were sent to the Japanese Patent Attorney for signature by the Inventor. The Japanese Patent Attorney was asked to review the documents to be sure that he understood them, and, if the documents were correct, to then have them executed by the appropriate people.

9. On or about September 25, 2002, the Japanese Patent Attorney forwarded the inventor’s declaration and the assignment for the ‘732 Patent. Ga-Rew/Inventor have agreed to not contest that the inventor’s declaration and the assignment were signed by the Inventor, and the Inventor assigned, in 2002, all rights in the Japanese Patent to a Japanese company by the name of “Need Brain Co., Ltd.” (“Need Brain”). Need Brain is also listed as an applicant for the Japanese Patent Application.

10. The assignment of the ‘732 Patent to Need Brain was recorded with the U.S. Patent and Trademark Office (“USPTO”) on or about October 21, 2002. This assignment has been publicly available since shortly after it was filed in the USPTO in late October 2002.

11. The ‘732 Patent issued on or about April 26, 2005, and the listed assignee of this patent is Need Brain. Notice of such issuance was sent to the Japanese Patent Attorney on May 9, 2005, and again on June 13, 2005.

12. Need Brain subsequently assigned, for value, the ‘732 Patent to Auto Wax Co., Inc. (“Auto Wax”) and in this assignment Need Brain warranted that it had the full right to convey the ‘732 Patent to Auto Wax. On or about November 14, 2005, the assignment of the ‘732 Patent from Need Brain to Auto Wax was sent to the USPTO for

filing. The recordation of the assignment was sent by the USPTO to counsel for Auto Wax on or about March 30, 2006.

13. On or about October 17, 2006, the '732 Patent was assigned, for value, from Auto Wax to Illinois Tool Works, Inc. ("ITW"), and this assignment was recorded in the USPTO.

14. Finally, on or about February 4, 2011, the '732 Patent was assigned, for value, from ITW to Dehn, and this assignment was likewise recorded in the USPTO.

15. After the assignment of the '732 Patent, Dehn engaged in negotiations with defendant Total Import Solutions, Inc. d/b/a Nanoskin Car Care Products ("Total Import Solutions"). Total Import Solutions requested a license to the inventions set forth in the '732 Patent.

16. Dehn ultimately declined to license the inventions in the '732 Patent to Total Import Solutions.

17. In October 2011, after Dehn refused to license the inventions in the '732 Patent to Total Import Solutions, one or more Defendants filed a purported assignment, in the USPTO, from the Inventor to one or more Defendants. Ga-Rew/Inventor have agreed to not contest that this assignment is null and void.

18. As the foregoing indicates, the Japanese Patent Attorney requested that a U.S. patent application be filed claiming priority to the Japanese Patent Application. Ga-Rew/Inventor have agreed to not contest that the U.S. patent application, which matured into the '732 Patent, was assigned in 2002 to Need Brain by the Inventor, which is the same company that is listed as an applicant for the Japanese Patent Application. Ga-Rew/Inventor have agreed to not contest that the '732 Patent was duly and legally issued

to Need Brain. The face of the '732 Patent identifies Need Brain as the owner of the '732 Patent.

19. Over the course of approximately six (6) years from the date of issuance of the '732 Patent, several subsequent assignments of the '732 Patent were made to purchasers for value (*e.g.*, Need Brain to Auto Wax, Auto Wax to ITW, and ITW to Dehn).

20. The Inventor attended a trade show in Las Vegas a few months after the '732 Patent issued in April 2005. The Inventor met Mr. Dennis Dehn at this trade show and was shown products covered by the '732 Patent that were being offered for sale at the trade show. The Inventor was shown a copy of the '732 Patent in 2005 and knew in 2005 that the '732 Patent listed Need Brain as the owner of the '732 Patent on the first page of the '732 Patent. The Inventor also knew in 2005 that the '732 Patent had been assigned to Auto Wax Company from Need Brain. At no time during the approximate (10) years from the filing of the application for the Japanese Patent, to the assignment of the '732 Patent from ITW to Dehn, did the Inventor or anyone else claim that the original assignment from the Inventor to Need Brain (or anyone else along the chain of title) was invalid or ineffective.

21. Dehn had no knowledge of any alleged invalidity or ineffectiveness of the assignment from the Inventor to Need Brain when Dehn acquired rights via assignment from ITW. Ga-Rew/Inventor have agreed to not contest that the assignments to all parties in the chain of title from the Inventor to Need Brain to Auto Wax to ITW to Dehn were valid, proper, correct, and supported by adequate consideration.

22. As a result, Dehn is a good faith purchaser of all rights in and to the '732 Patent, without notice as to any invalidity or defect in the chain of title to the '732 Patent.

23. Based on his knowledge and belief in his rights in and to the '732 Patent, Dehn has expended a great deal of time, energy and money into expanding the business for the inventions contained in the '732 Patent, and has created a successful and growing business based upon the rights obtained in and to the '732 Patent.

24. Ga-Rew/Inventor have not ever paid for the filing fees, U.S. attorney's fees, maintenance fees, or any other costs to file, prosecute, and maintain the '732 Patent.

25. Ga-Rew/Inventor have sold, made, imported, and/or used products that infringe upon Dehn's rights in and to the '732 Patent (hereinafter referred to as the "Infringing Products").

26. Defendants sell the Infringing Products in a wide range of locations. Defendants seek generally to sell the Infringing Products to retailers, distributors, dealers, and/or the general public, including the general public in the State of Texas and this District. Defendants have sold Infringing Products in the State of Texas and this District.

27. The activities of the Defendants with regard to their sales, importation, manufacture and/or use of the Infringing Products are and have been without authorization from Dehn.

28. At least as early as 2003, Dehn began using the trademark TORNADOR in connection with his products and services.

29. Dehn's TORNADOR mark was registered with the United States Patent and Trademark Office under Reg. No. 3553562, which was issued on or about December 30, 2008.

30. Inventor and Ga-Rew have, without authorization from Dehn, used the TORNADOR mark in connection with their website located at www.ga-rew.com as well as on videos they have posted on YouTube.

31. Any finding of fact that is deemed to be a conclusion of law is hereby adopted as such.

CONCLUSIONS OF LAW

Ga-Rew/Inventor have agreed to not contest the following conclusions of law:

32. This is an action to determine ownership and infringement of the '732 Patent. The '732 Patent was duly and validly issued in the name of the Need Brain, and duly and validly assigned to subsequent purchasers of value, and recorded with the USPTO.

33. Dehn is a good faith purchaser of all rights in and to the '732 Patent, without notice of any alleged defect or invalidity in the assignments or chain of title to the '732 Patent.

34. The purported assignment obtained by and filed in October 2011 that allegedly creates rights in the '732 Patent in favor of one or more Defendants is, as between Ga-Rew/Inventor and Dehn, null and void.

35. As between Ga-Rew/Inventor and Dehn, Dehn is the rightful owner of the '732 Patent and all intellectual property rights therein.

36. Dehn is a successor-in-interest to Need Brain with respect to the '732 Patent and the inventions disclosed therein, by virtue of the various assignment documents referenced herein.

37. As the successor-in-interest to Need Brain with respect to the inventions at issue, the patent at issue and the assignment of rights therein, Dehn is a third party beneficiary of the contract between Ga-Rew/Inventor and Need Brain.

38. Ga-Rew/Inventor are estopped from challenging Dehn's ownership of the '732 Patent, by virtue of the fact that the Inventor's assignment to Need Brain has been of public record for approximately ten (10) years, and the subsequent assignments from Need Brain to Auto Wax, from Auto Wax to ITW, and from ITW to Dehn are unchallenged. Ga-Rew/Inventor are also barred under the appropriate statute of limitations from asserting ownership in and to the '732 Patent.

39. Ga-Rew/Inventor have infringed Dehn's TORNADOR trademark by selling and/or offering for sale spray gun products under the same trademark. Dehn's TORNADOR trademark is valid and enforceable.

40. Defendants' spray gun products are covered by the '732 Patent. The '732 Patent is valid and enforceable.

41. The patent and trademark rights of Dehn are not barred or limited by laches, waiver, estoppel, or fraud.

42. This Judgment shall finally conclude and dispose of this litigation as to Ga-Rew/Inventor and Dehn, and issue preclusion, claim preclusion, res judicata, and collateral estoppel effect shall apply in future litigation or Patent and Trademark Office proceedings related to the '732 Patent or the TORNADOR trademark. Ga-Rew/Inventor and Dehn and

this Court explicitly intend such issue preclusion, claim preclusion, res judicata, and collateral estoppel effects to extend to the issues of claim construction, validity, and enforceability regarding all claims of the '732 Patent or the TORNADOR trademark.

43. Any Conclusion of Law that is deemed to be a Finding of Fact is hereby adopted as such.

IT IS FOUND, ORDERED, ADJUDGED, AND DECREED that, as between Ga-Rew/Inventor and Dehn:

1. Dehn is the sole owner of all rights in and to the '732 Patent, and none of the Defendants have any rights in and to the '732 Patent. The USPTO is ordered to correct the assignment records to reflect that, as to Ga-Rew/Inventor and Dehn, Dehn is the sole owner in and to the '732 Patent.

2. Ga-Rew/Inventor and their parents, subsidiaries and associated companies, and the officers, agents, servants, employees, successors, and assigns of any of them, and all other persons in active concert or participation with any of them who receive actual notice of this Judgment (including the manufacturers and suppliers of their products) are hereby permanently restrained and enjoined during the unexpired term of the '732 Patent from directly, contributorily, or by inducement, making, causing to be made, using or causing to be used, selling or causing to be sold, offering for sale or causing to be offered for sale, and importing or causing to be imported in or into the U.S., any device, apparatus, system, or process that is covered, either literally or by the doctrine of equivalents, by any claim of the '732 Patent, including but not limited to the Ga-Rew/Inventor's spray gun products, and any other spray gun products which are not substantially different from Ga-Rew/Inventor's spray gun products, and not originating with or purchased from Dehn.

3. Ga-Rew/Inventor and their parents, subsidiaries and associated companies, and the officers, agents, servants, employees, successors, and assigns of any of them, and all other persons in active concert or participation with any of them who receive actual notice of this Judgment, are hereby permanently restrained and enjoined from:

(a) using the TORNADOR mark or any colorable imitation thereof in the U.S. on or in connection with goods and/or services not originating with Dehn, other than as may be allowed pursuant to license terms with Dehn; and,

(b) advertising, distributing, importing, manufacturing, offering for sale or selling any goods or services in or into the U.S. using the TORNADOR mark or any colorable imitation thereof on or in connection with goods and/or services not originating with or purchased from Dehn, other than as may be allowed pursuant to license terms with Dehn.

4. This Court retains exclusive jurisdiction of this action for the purpose of ensuring compliance with this Judgment.

5. No appeal shall be taken by any party from this Judgment, the right to appeal being expressly waived by all parties.

6. Final Judgment shall be entered pursuant hereto, forthwith, without further notice.

7. Each party to bear their own costs and attorneys' fees.

8. All other relief not expressly granted herein is denied.

The Clerk is directed to enter this final judgment forthwith.

Signed March 15, 2013.



David C. Godbey
United States District Judge

ACKNOWLEDGED AND AGREED:

Kaga Hasegawa

Signature: 長谷川可賀
Printed Name: KAGA HASEGAWA
Date: 2013/1/30

STATE OF CALIFORNIA §
COUNTY OF ORANGE *see attached* §
§

BEFORE ME, the undersigned authority, on this 30th day of January, 2013, personally appeared Kaga Hasegawa, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he executed the same for the purposes and consideration therein expressed, in the capacity stated, and as the act and deed of said corporation.

Notary Public

My Commission Expires: _____

GA-REW CORP.

Signature: 長谷川可賀
Printed Name: KAGA HASEGAWA
Title: Representative Director and President
Date: 2013/1/30

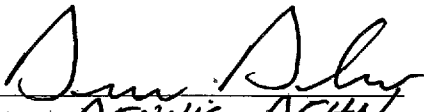
STATE OF CALIFORNIA §
COUNTY OF ORANGE *see attached* §
§

BEFORE ME, the undersigned authority, on this 30th day of January, 2013, personally appeared Kaga Hasegawa, known to me to be the person and officer whose name is subscribed to the foregoing instrument and acknowledged to me that he executed the same for the purposes and consideration therein expressed, in the capacity stated, and as the act and deed of said corporation.

Notary Public

My Commission Expires: _____

DEHN'S INNOVATIONS, LLC

Signature: 
Printed Name: DENNIS DEHN
Title: PRESIDENT
Date: 1-30-2013

STATE OF CALIFORNIA §
COUNTY OF ORANGE *see attached* §
§

BEFORE ME, the undersigned authority, on this 30th day of January, 2013, personally appeared Dennis Dehn, known to me to be the person and officer whose name is subscribed to the foregoing instrument and acknowledged to me that he executed the same for the purposes and consideration therein expressed, in the capacity stated, and as the act and deed of said corporation.

Notary Public

My Commission Expires: _____

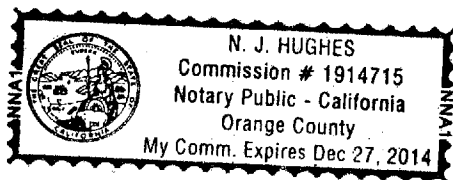
STATE OF CALIFORNIA)
) ss.
COUNTY OF ORANGE)

On January 30, 2013, before me, N. J. Hughes, Notary Public, notary public, personally appeared KAGA HASEGAWA, who proved to me on the basis of satisfactory evidence to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

I certify under PENALTY OF PERJURY under the laws of the State of California that the foregoing paragraph is true and correct.

WITNESS my hand and official seal.

[SEAL]





Signature

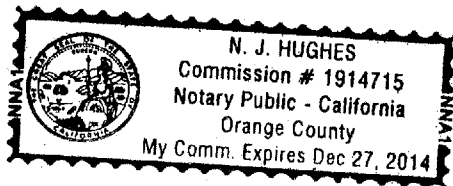
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WITNESS my hand and official seal.

[SEAL]



N. J. Hughes
Signature

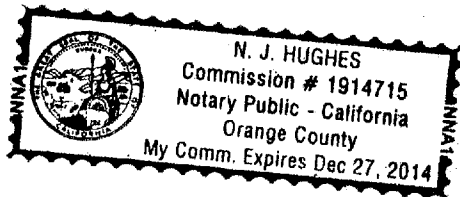
STATE OF CALIFORNIA)
) ss.
COUNTY OF ORANGE)

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I certify under PENALTY OF PERJURY under the laws of the State of California that the foregoing paragraph is true and correct.

WITNESS my hand and official seal.

[SEAL]



Signature N. J. Hughes


Reviewed as to form:

Respectfully submitted,



Eric B. Meyertons
Texas State Bar No. 14004400
Dwayne K. Goetzel
Texas State Bar No. 08059500
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**ATTORNEY FOR KAGA HASEGAWA
AND GA-REW CORP.**