

## **Jetaire Patents Axed After Fla. Judge Backs Magistrate Report**

By **Ryan Harroff**

*Law360 (August 12, 2024, 6:33 PM EDT)* -- A Florida federal judge invalidated three "fuel tank ignition mitigation technology" patents held by Jetaire Aerospace LLC and granted its competitor AerSale Inc. an early win over the infringement claims Jetaire brought against it, fully adopting a magistrate judge's recommendation that the patents be axed under the on-sale bar.

U.S. District Judge Darrin P. Gayles of the Southern District of Florida overruled Jetaire Aerospace's objections to the April report and recommendations by U.S. Magistrate Judge Edwin G. Torres, agreeing with Judge Torres in the court's order on Friday that because the aviation company had been selling a product that incorporated all three of the patents-at-issue for more than a year before seeking patent protection, those patents must be invalid.

Jetaire Aerospace sued AerSale in 2020 claiming that the company had infringed three patents for technology used in Jetaire Aerospace's "Invicta Kit," which gave planes "a method and system of accomplishing ignition mitigation using reticulated polyurethane safety foam in coordinated shapes to fill the fuel tanks," according to the complaint.

AerSale brought counterclaims alleging the patents-at-issue were invalid and that it therefore did not infringe any valid intellectual property rights. Judge Gayles ruled on those counterclaims on Friday. Judge Gayles, adopting Judge Torres' recommendation, granted AerSale declaratory judgment that it did not infringe the three patents and invalidated those same patents.

According to the order, Jetaire Aerospace's arguments against Judge Torres' recommendation failed for multiple reasons, including that it had waived its right to argue a distinction between different types of claims in the patents-in-suit and incorrectly asserting its Invicta Kits were not sold as a "commercial offer" that would make the on-sale bar apply.

Judge Gayles said Jetaire Aerospace waited until after Judge Torres made his recommendation to argue for a distinction between method and apparatus claims in its patents, which waived its right to make that argument.

As for the "commercial offer" issue, the order states the company improperly relied on testimony from an AerSale executive who said JetAire Aerospace's Invicta Kits were poorly designed and asserted that the poor design was evidence the kits were an experimental, not commercial venture.

"Jetaire fails to cite any authority that supports the proposition that, because a purchaser does not like a

product, it follows that the primary purpose of the offer was for experimental use," the order states.

The court directed AerSale to submit a proposed final judgment in its favor within two weeks of the Friday order.

Counsel for AerSale did not immediately respond to requests for comment. Counsel for Jetaire declined to comment.

The patents-in-suit are U.S. Patent Nos. 9,849,998; 10,633,109; and 10,800,541.

Jetaire is represented by Marcos Daniel Jiménez and Sofia Manzo of León Cosgrove Jiménez LLP and James F. McDonough III, Jonathan R. Miller, Travis E. Lynch, Jonathan L. Hardt, C. Matthew Rozier and Kristin M. Whidby of Rozier Hardt McDonough PLLC.

AerSale is represented by Amelia Toy Rudolph, Shawn Rafferty, Valerie S. Sanders, Scott A. Penner and Regis C. Worley Jr. of Eversheds Sutherland.

The case is Jetaire Aerospace LLC v. AerSale Inc., case number 1:20-cv-25144, in the U.S. District Court for the Southern District of Florida.

--Additional reporting by Adam Lidgett. Editing by Nicole Bleier.