

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLORADO**

Civil Action No.: 21-cv-02112-CMA-SKC

SMITH SPORT OPTICS, INC., a Delaware company,  
and KOROYD SARL, a Monaco company,

Plaintiffs,

vs.

THE BURTON CORPORATION, a Vermont company,

Defendant.

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**REPLY IN SUPPORT OF MOTION FOR PRELIMINARY INJUNCTION**

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## **TABLE OF CONTENTS**

	<b>Page</b>
I. INTRODUCTION .....	1
II. PLAINTIFFS ARE LIKELY TO SUCCEED ON THE MERITS .....	1
A. Burton’s Helmets Infringe at Least Claims 1-3 and 7 of the ’373 Patent. ....	2
B. Plaintiffs Are Likely To Succeed on Burton’s Invalidity Arguments. ....	4
III. BURTON’S ARGUMENTS AGAINST IRREPARABLE HARM ARE UNAVAILING .....	9
A. Plaintiffs Never Offered Defendant A License.....	9
B. Plaintiffs Did Not Unduly Delay Before Bringing Their Motion.....	10
C. The Existence of Other Potential Infringers Or Competitors Does Not Negate Harm. ....	12
D. There is no Inequitable Conduct and Therefore No Unclean Hands.....	13
E. The Balance of Harm Favors Preserving the Status Quo Ante and Patentee’s Rights.....	14
IV. CONCLUSION.....	15

**TABLE OF AUTHORITIES****Page(s)****Cases**

<i>A.K. by &amp; through Moyer v. Cherry Creek Sch. Dist. No. 5</i> , 2020 WL 2197920 (D. Colo. May 6, 2020).....	11
<i>Am. Dental Ass’n Health Found. v. Bisco Inc.</i> , 24 U.S.P.Q.2d 1524 (N.D. Ill. 1992).....	11
<i>Am. Express Co. v. Am. Express Limousine Serv. Ltd.</i> , 772 F. Supp. 729 (E.D.N.Y. 1991) .....	11
<i>Broadcom Corp. v. Qualcomm, Inc.</i> , 543 F.3d 683 (Fed. Cir. 2008).....	14
<i>Crystal Semiconductor Corp. v. Tritech Microelectronics Int’l, Inc.</i> , 246 F.3d 1336 (Fed. Cir. 2001).....	2
<i>Dayco Prods. v. Total Containment, Inc.</i> , 258 F.3d 1317 (Fed. Cir. 2001).....	2
<i>Dig. Control Inc. v. Charles Mach. Works</i> , 437 F.3d 1309 (Fed. Cir. 2006).....	14
<i>eBay, Inc. v. Bidder’s Edge, Inc.</i> , 100 F. Supp. 2d 1058 (N.D. Cal. 2000).....	10
<i>Enplas Display Device Corp. v. Seoul Semiconductor Co.</i> , 909 F.3d 398 (Fed. Cir. 2018).....	6
<i>Eurand, Inc. v. Mylan Pharms., Inc.</i> , 676 F.3d 1063.....	9
<i>Gillette Co. v. Energizer Holdings, Inc.</i> , 405 F.3d 1367 (Fed. Cir. 2005).....	3
<i>Goannies, Inc. v. Goupair.Com, Inc.</i> , 464 F. Supp. 2d 603 (N.D. Tex. Dec. 2006).....	11
<i>Graphic Packaging Int’l, Inc. v. C.W. Zumbiel Co.</i> , 2012 U.S. Dist. LEXIS 115072 (M.D. Fla. Aug. 14, 2012).....	12

<i>Hasbro, Inc. v. Lanard Toys, Ltd.</i> , 858 F.2d 70 (2d Cir. 1988).....	11
<i>Kettle Range Conservation Grp. v. U.S. Forest Serv.</i> , 971 F. Supp. 480 (D. Or. 1997) .....	11
<i>Life After Hate, Inc. v. Free Radicals Project, Inc.</i> , 410 F.Supp.3d 891 (N.D. Ill. 2019) .....	11
<i>Mangosoft, Inc. v. Oracle Corp.</i> , 2004 U.S. Dist. Lexis 19357 (D.N.H. Sep. 21, 2004) .....	3
<i>Pfizer, Inc. v. Teva Pharms. USA, Inc.</i> , 429 F.3d 1364 (Fed. Cir. 2005).....	12
<i>Polymer Techs., Inc. v. Bridwell</i> , 103 F.3d 970 (Fed. Cir. 1996).....	10
<i>Resqnet.com, Inc. v. Lansa, Inc.</i> , 346 F.3d 1374 (Fed. Cir. 2003).....	2
<i>Robert Bosch, LLC v. Pylon Mfg. Corp.</i> , 659 F.3d 1142 (Fed. Cir. 2011).....	12
<i>Storage Concepts, Inc. v. Incontro Holdings, L.L.C.</i> , 2021 U.S. Dist. LEXIS 86284 (D. Neb. 2021) .....	11
<i>Tinnus Enters., LLC v. Telebrands Corp.</i> , 846 F.3d 1190 (Fed. Cir. 2017).....	2
<i>Titan Tire Corp. v. Case New Holland, Inc.</i> , 566 F.3d 1372 (Fed. Cir. 2009).....	4
<i>Ty, Inc. v. GMA Accessories, Inc.</i> , 132 F.3d 1167 (7th Cir. 1997).....	10
<i>Wang Labs., Inc. v. The Chip Merchant</i> , 1993 U.S. Dist. LEXIS 20012 (S.D. Cal., Sept. 2, 1993).....	11
<i>Windsurfing Int'l, Inc. v. AMF, Inc.</i> , 782 F.2d 995 (Fed. Cir. 1986).....	14
<i>Xantrex Tech. Inc. v. Adv. Energy Indus.</i> , 2008 U.S. Dist. LEXIS 41206 (D. Colo. May 23, 2008).....	14

*York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*,  
99 F.3d 1568 (Fed. Cir. 1996)..... 2

**Statutes**

35 U.S.C. § 102(b)(1) ..... 13

## I. INTRODUCTION

Plaintiffs spent years reshaping and developing the ski and snowboard market with their groundbreaking and now patent-protected helmets using shock absorbing inserts made of Koroyd's lightweight cellular Koroyd® material. Burton does not dispute that it knew about Plaintiffs' '373 patent before launching its infringing helmets earlier this year, but instead mischaracterizes Plaintiffs' demands to stop selling as offers to license. There were no such offers. As the Motion has already shown—and Burton has not rebutted—in the industry, where a sporting goods store is already selling an infringing technology, it will not carry Plaintiffs' product. Burton's sales of infringing helmets is causing and, if not enjoined, will continue to cause irreparable harm. Just as Burton cannot rebut irreparable harm, it cannot counter infringement or raise a real question on validity. Burton attempts to defeat infringement by improperly ignoring the plain language of the '373 patent's claims and improperly reading limitations into the claims that are not there. Its invalidity assertions either ignore limitations that distinguish the '373 patent from the prior art or simply repeat arguments that were already rejected by the patent office during seven years of prosecution. Burton's response does not rebut the strong showing made that Burton has been using Plaintiffs' patented technology in direct competition with Plaintiffs, requiring an injunction before the 2021-22 snow season.

## II. PLAINTIFFS ARE LIKELY TO SUCCEED ON THE MERITS

As demonstrated in Plaintiffs' Motion, including the detailed claim charts provided by engineer David Smith, the accused Merak and Logan helmets satisfy every limitation recited in claims 1-3 and 7 of the '373 patent.<sup>1</sup> See Motion ("Mot.") at 12-15; ECF 6 ("Smith Decl.") at ¶¶21-24; Exs. D, E. And as discussed below, Plaintiffs "will likely withstand" the

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<sup>1</sup> As an initial matter, Plaintiffs need only establish infringement of one claim to prove infringement of the '373 patent. As Burton's arguments in opposition are focused on claim 1, Plaintiffs will limit their arguments here to the same.

challenges to validity raised in Burton's opposition. See *Tinnus Enters., LLC v. Telebrands Corp.*, 846 F.3d 1190, 1202 (Fed. Cir. 2017).

**A. Burton's Helmets Infringe at Least Claims 1-3 and 7 of the '373 Patent.**

Burton asserts two non-infringement arguments, both of which do not withstand even limited scrutiny. First, Burton argues that there is no infringement because there are vents through which the infringing insert cannot be seen. But, the claims do not require all the vents to have an insert visible; the insert must only be visible through at least two vents, which is the case. Claim 1 requires "a shell comprising a plurality of vents including a first vent defining a first opening and a second vent defining a second opening...a shock absorbing insert positioned in and substantially filling the cavity such that the shock absorbing insert is visible through and spans across at least a portion of each of the plurality of vents..." As the Federal Circuit has repeatedly explained, "'plurality,' when used in a claim, refers to two or more items, absent some indication to the contrary." *Dayco Prods. v. Total Containment, Inc.*, 258 F.3d 1317, 1327-28 (Fed. Cir. 2001) (citing *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575 (Fed. Cir. 1996)); *Resqnet.com, Inc. v. Lansa, Inc.*, 346 F.3d 1374, 1382 (Fed. Cir. 2003) (The claim recites "'each of a plurality of fields,' which does not carry the same meaning as 'every field.' Rather, the recitation of 'plurality' suggests the use of 'at least two'"). Thus, "a plurality of vents" is understood to mean "one or more vents." Indeed, claim 1 expressly requires at least two vents—"a first vent" and "a second vent."

However, "a shell comprising a plurality of vents" merely requires the shell to have at least two vents that meet the limitation. *Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc.*, 246 F.3d 1336, 1347 (Fed. Cir. 2001) ("This court has consistently emphasized that the indefinite articles 'a' or 'an,' when used in a patent claim, mean 'one or more' in claims containing open-ended transitional phrases such as

‘comprising.’ Under this conventional rule, the claim limitation ‘a,’ without more, requires at least one.”) (citations omitted). Burton incorrectly argues that all the vents must meet the limitation, not just those of “the plurality.” See *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1371-72 (Fed. Cir. 2005) (“Because the patentee invoked” the transition word “comprising,” “the scope of claim 1 encompasses all safety razors satisfying the elements set forth in claim 1” and “[t]he addition of elements not recited in the claim cannot defeat infringement.”) (vacating denial of preliminary injunction). Because the helmets have “two or more vents” and “each of the plurality of vents” means each of those “two or more vents,”<sup>2</sup> the helmets meet the limitation so long as the insert is visible through those two vents—which is the case here. Mot. at 14-15.

Burton’s second argument fails no better. Claim 1 requires that “the first longitudinal ends of a first plurality of adjacent cells of the array of energy absorbing cells are positioned within a perimeter of the first opening...such that air is able to flow from an exterior side of the helmet...toward an interior of the helmet.” Burton admits that “portions of the cells appear through those vent openings” in its helmets. Opp. at 9-10. Burton also does not dispute that the WaveCel material is positioned such that air is able to flow from the exterior of the helmet to the interior. Burton’s only argument is that “there are **no entire** cell ends (i.e. **entire** triangles) of WaveCel material positioned within a perimeter of the vents.” *Id.* But the word “entire” is not part of the claim language, and thus, not a claim limitation here. Moreover, Burton’s argument focuses on the wrong claim term. The

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<sup>2</sup> The case cited by Burton, *Mangosoft, Inc. v. Oracle Corp.*, is not inconsistent. In that case, the court rejected the patentee’s argument “that ‘each of said plurality’ does not modify the ‘plurality of computers’ that form the system, but instead refers to a smaller subset of computers (i.e., a new plurality).” 2004 U.S. Dist. Lexis 19357, at \*13 (D.N.H. Sep. 21, 2004). Plaintiffs agree, consistent with the court’s reasoning in *Mangosoft*, that “each of the plurality of vents” here modifies “the plurality of vents.” Where Burton is wrong is in how it defines “a plurality of vents” in the first place.

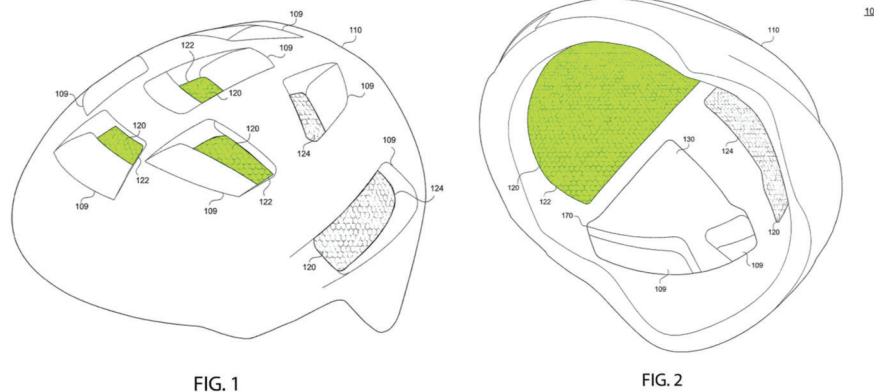


relevant claim language speaks to the “ends” of the cells, not the “cells.” As cell ends appear through the vent openings, Burton’s second non-infringement argument fails.

## B. Plaintiffs Are Likely To Succeed on Burton’s Invalidity Arguments.

### 1. Burton’s Anticipation Argument Based on the Fox Striker Helmet Does Not Raise a Substantial Question of Invalidity.<sup>3</sup>

The Fox Striker Helmet does not disclose several of the limitations of claim 1, and thus cannot anticipate claim 1. First, Claim 1 requires that “the shock absorbing insert...spans across at least a portion of each of the plurality of vents.” For example, Figures 1 and 2 from the ’373 patent, Smith’s Vantage helmet, and Burton’s infringing Merak Helmet all feature “the shock absorbing insert span[ning] across at least a portion of each of the plurality of vents”:



<sup>3</sup> Burton mischaracterizes its burden in presenting validity challenges. Opp. at 5, 11. While Burton does not now have to prove invalidity by the clear and convincing standard that will be imposed at trial, Burton must present a **substantial** question of validity. Raising **any** question is not enough in light of the presumption of validity. “[W]hen analyzing the likelihood of success factor, the trial court, after considering all the evidence available at this early stage of the litigation, **must determine whether it is more likely than not that the challenger will be able to prove at trial, by clear and convincing evidence, that the patent is invalid.**” *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1379 (Fed. Cir. 2009).



#### ANON MERAK HELMET



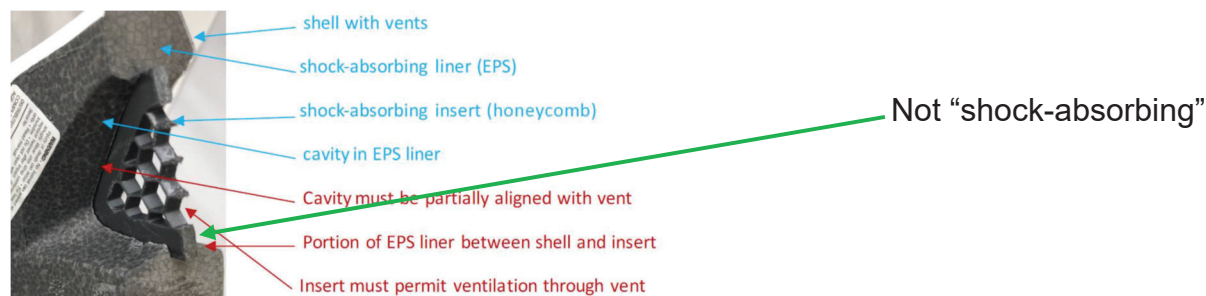
ECF 8 at 22-23 (Figs. 1 and 2 from the '373 patent, highlighting the insert in green); Mot. at 11 (Smith Vantage helmet); Mot. at 15.

We know the “plurality of vents” requires at least two vents (see Section II.A. above), and the insert identified by Burton here does not “span[] across at least a portion of each of the at least two vents.” At best, each insert spans across a single vent. See Opp. at 12 (describing the helmet’s “honeycomb venting *inserts*”). In fact, Dr. Copeland’s invalidity claim chart for the Fox Striker helmet presents no evidence or explanation demonstrating that either of (or both) the honeycomb inserts span across more than a single vent—rather, it just ignores this claim language. ECF 40-10 at 3 (claim element [D].)

Claim 1 also requires that “at least a portion of the shock absorbing liner is positioned between the shell and the shock absorbing insert.” Taking as true Burton’s assertion that the honeycomb structure in the Fox Striker helmet is “shock absorbing”<sup>4</sup>

<sup>4</sup> Burton goes to great lengths in its attempt to prove that the honeycomb inserts are “shock-absorbing” using engineering testing. See Opp. at 12, ECF 39 (Bottlang Decl.) at

(see image below from Opp. at 12), there is no place in the helmet where the shock absorbing liner, *i.e.* the foam piece, is positioned between the shell and the honeycomb portion that is alleged to be shock-absorbing. At best, the liner is positioned between some non-shock-absorbing piece connected to the honeycomb and the shell.



Because it does not disclose every limitation of claim 1 of the '373 patent, the Fox Striker helmet does not anticipate any of claims 1, 3, or 7. *Enplas Display Device Corp. v. Seoul Semiconductor Co.*, 909 F.3d 398, 405 (Fed. Cir. 2018) ("Anticipation requires that a single reference disclose each and every element of the claimed invention.").

## 2. Burton's Obviousness Combinations Do Not Establish a Substantial Question of Invalidity.

Claim 1 of the '373 patent is not obvious in light of the Muskovitz reference, alone or in combination with the Landi or Sajic references.

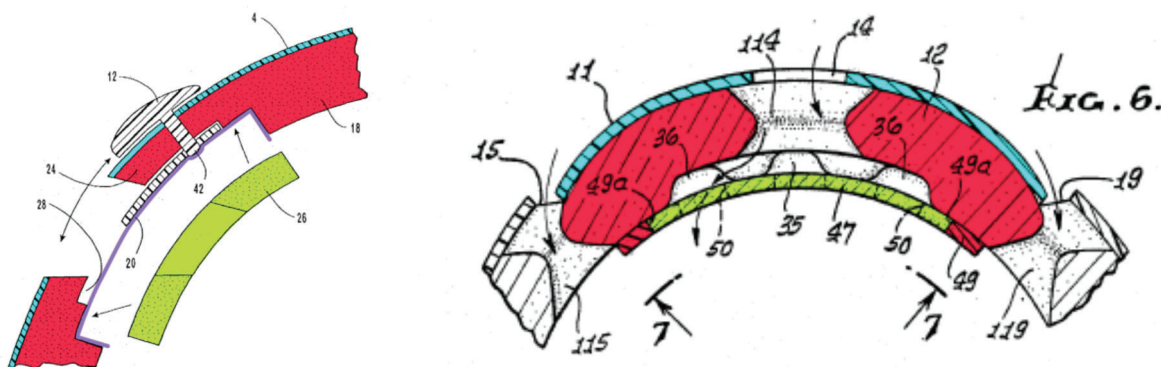
Burton notes that the Muskovitz reference was not cited during prosecution of the '373 patent. Opp. at 12.<sup>5</sup> But Burton fails to acknowledge the over a hundred references

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¶¶ 44-50. While Plaintiffs disagree with the conclusion, it is not necessary to address the testing at this juncture. Plaintiffs do note some clear problems with the testing. For example, Dr. Bottlang stated that he used "U.S. Consumer Product Safety Commission test, Section 1203, to measure the impact on the rear vents with and without the structural honeycomb inserted." *Id.* ¶ 45. He goes on to explain that "[s]pecifically, with the honeycomb inserted, a force of 412g was measured upon impact." *Id.* ¶ 46. But Section 1203.12 (Test Requirements) dictates that "[t]he peak acceleration of any impact shall not exceed 300 g" for "impact attenuation tests." Kolter Decl. Ex. 1 at 3.

<sup>5</sup> Burton seems to suggest Plaintiffs withheld references or failed to disclose references.

that were in front of the examiner during the nearly seven year prosecution of the application that issued as the '373 patent. In fact, at least one reference that was cited repeatedly by the examiner during prosecution discloses the same general elements as the Muskovitz reference (titled "In-Mold Protective Helmet having Integrated Ventilation System"). That Sundahl reference (titled "Bicyclists Helmet with Air Flow and Perspiration Control") was discussed by the examiner in eight different office actions. See Kolter Decl. Exs. 2-9.<sup>6</sup> As is clear from the comparison of Muskovitz (as used in Burton's opposition) and figure 6 of Sundahl, Sundahl discloses the very similar configuration of a shell, liner, insert, and vent:



*Id.* Ex. 10 at Fig. 6. The claims of the '373 patent eventually issued over the examiner's repeated rejections based on the Sundahl reference (including in combination with others). *Id.* Exs. 9 at 4, 11. Thus, the Muskovitz reference is merely cumulative of the prior art already extensively considered by the USPTO alone and in combination with others, and thus presents nothing new with respect to invalidity.

In addition (and as in Sundahl), Muskovitz does not disclose "the shock absorbing insert...span[ning] across at least a portion of each of the plurality of vents." In his claim

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Burton has no support for these inflammatory allegations and they should be disregarded.  
<sup>6</sup> References to "Kolter Decl." are to the Declaration of Erin Kolter, filed herewith.

chart, Dr. Copeland points to the single “gap” between “28” and “24” on the figure above for this limitation. (ECF 40-11 (Ex. K to Copeland Decl.) at 3). As Burton and its expert are only pointing to one, the Insert “26” is not “spanning across” “each” of at least two vents.

With respect to the remaining references cited, references disclosing the use of a honeycomb structure were cited repeatedly by the examiner during prosecution.<sup>7</sup> As such, the “honeycomb” references Burton raises here (Landi and Sajic) are cumulative of the art already before the examiner—Burton is not identifying anything new. In fact, the examiner expressly considered the combination of the Sundahl reference with a Sajic reference<sup>8</sup>: “It would have been obvious ... to modify Sundahl’s teaching of an insert to include Sajic’s teaching of an insert with a honeycomb shape since doing so would give rise to increased energy absorbing performance, and would therefore improve the safety of the device.” Ex. 4 at 5; *see also* Exs. 2-3, 5.<sup>9</sup> The examiner ultimately allowed the claims of the ’373 patent to issue over this combination.<sup>10</sup> Burton is merely presenting the same obviousness arguments that were considered and rejected by the examiner.

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<sup>7</sup> Dr. Copeland admits that Muskovitz does not disclose the shock absorbing insert comprising an array of energy absorbing cells. (ECF 40-11 at 6).

<sup>8</sup> The inventors disclosed the “Sajic” reference relied upon by Burton here (2008/0307568) during prosecution of the ’373 patent, and the examiner considered the same, along with another Sajic reference (U.S. Pat. No. 8,082,599) that was relied upon by the examiner for its alleged “insert with a honeycomb shape” in multiple office actions. Ex.12.

<sup>9</sup> The examiner also considered another “helmet insert made of honeycomb material” in combination with Sundahl. Ex. 7.

<sup>10</sup> And Dr. Copeland’s declaration demonstrates that the prior art teaches away from the ’373 patent claims in that one would not want an insert spanning across vents as a “POSA would further recognize that air vents are generally discouraged in motorcycle helmets because such a vent can weaken the shell of the helmet and there is a risk that a rock or other object could penetrate a vent and cause serious harm.” (ECF 40 ¶119; *see Opp.* at 15).

Additionally, Burton ignores the secondary considerations of nonobviousness in its analysis such as evidence of commercial success or industry praise. *Eurand, Inc. v. Mylan Pharms., Inc.*, 676 F.3d 1063, 1077 (“a district court must always consider any objective evidence of nonobviousness presented in a case.”). Here, Graham Sours, Smith’s V.P. of Product & Merchandising, discussed the resounding commercial success of Smith’s snow sport helmets featuring Koroyd® in the market. (ECF 8 (Sours Decl.) ¶¶ 21-22). Mr. Sours also detailed the extensive industry praise for Smith’s snow sport helmets featuring Koroyd®, and specifically, the patented features of the helmet. *Id.* ¶¶ 16-20. These objective indicia of nonobviousness further demonstrate that Burton’s obviousness invalidity challenges are meritless.

### **III. BURTON’S ARGUMENTS AGAINST IRREPARABLE HARM ARE UNAVAILING**

#### **A. Plaintiffs Never Offered Defendant A License.**

Burton’s main argument against Plaintiffs’ strong showing of irreparable harm set forth in the Motion is that Plaintiffs “expressly indicated [they] would be willing to license the ‘373 patent,” which Burton claims defeats irreparable harm. Opp. at 16. But, even a casual read of the exchanges between the parties shows that there was never any offer to license. Rather, in Exhibit D of the Wakeling declaration [ECF 41-4 at 1], Plaintiffs explained that Burton “may only carry out acts restricted by patent in relation to the Infringing Helmets only after receiving appropriate licence from our client.” That is not an offer; it is a statement confirming that Burton has no right to sell Plaintiffs’ patented products. Importantly, this same letter attached proposed “undertakings” which if accepted, required the cessation of all sales. See *id.* at 6. Moreover, when Plaintiffs discovered sales had occurred, they again demanded immediate cessation as set forth in Exhibit E of the Wakeling declaration (ECF 41-5 at 1). Finally, Exhibit G of the Wakeling declaration nowhere indicates that Plaintiffs were willing to offer a “global license.” (*Cf.*



Opp. at 15 to ECF 41-7). Rather, the letter proposes the same agreement to stop selling.<sup>11</sup>

In any event, an offer to license, even if made, is not by itself enough to defeat a showing of irreparable harm. Rather, offers to license are only inconsistent with irreparable harm when a plaintiff has “engaged in a pattern of granting licenses.” *Polymer Techs., Inc. v. Bridwell*, 103 F.3d 970, 974 (Fed. Cir. 1996). There is neither a pattern here nor any individual offer and thus Burton’s arguments fail.<sup>12</sup>

#### **B. Plaintiffs Did Not Unduly Delay Before Bringing Their Motion.**

Burton argues that Plaintiffs delayed by “six months” before seeking preliminary injunctive relief. Not only is that “six months” inaccurate, but mere “delay” does not negate a showing of irreparable harm. A defendant must show that a plaintiff “unduly delayed.” *Polymer Techs., Inc.*, 103 F.3d at 974 (emphasis added). Here, Plaintiffs spent considerable time attempting to resolve the dispute extra judicially. Burton acknowledges negotiations through March [Opp. at 18] and attaches some of the documents that corroborate the ongoing communications. (See ECF 41-4—7). Courts have routinely rejected delay-based arguments where the parties were involved in negotiations seeking a cessation of sales. See *eBay, Inc. v. Bidder’s Edge, Inc.*, 100 F. Supp. 2d 1058, 1068 (N.D. Cal. 2000) (finding that that any delay caused by the plaintiff’s “good faith efforts to resolve th[e] dispute without judicial intervention” does not negate a finding of irreparable harm).<sup>13</sup>

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<sup>11</sup> Burton also asserts that an oral conversation occurred in which an offer to license was extended. This is also incorrect. In fact, Mr. Wakeling was not a participant on the February 11, 2021 call. Further, in that call, Defendant preempted discussion of any resolution as premature. In any event, no offer to license was extended. See A. Mitten Declaration, at ¶¶ 3-4.

<sup>12</sup> See also *Ty, Inc. v. GMA Accessories, Inc.*, 132 F.3d 1167, 1172 (7th Cir. 1997) (“[N]o case holds, that the mere existence of a license, irrespective of its terms, precludes the grant of a preliminary injunction.”)

<sup>13</sup> *Wang Labs., Inc. v. The Chip Merchant*, 1993 U.S. Dist. LEXIS 20012, at \*9 (S.D. Cal.,

Plaintiffs initiated an action and filed a preliminary injunction motion on July 13, 2021.<sup>14</sup> Preparing materials over the course of April, May and June cannot be considered “undue delay.”<sup>15</sup> In fact courts consistently hold that a 2-4 month period does not constitute undue delay. See *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 79 (2d Cir. 1988) (reversing denial of preliminary injunction, holding delay not unreasonable where plaintiff brought an action seven months after infringing product was released to the market); *Life After Hate, Inc. v. Free Radicals Project, Inc.*, 410 F.Supp.3d 891, 909-10 (N.D. Ill. 2019) (plaintiff’s 14-month delay in seeking preliminary injunctive relief did not defeat its claim of irreparable harm).<sup>16</sup> See also *Storage Concepts, Inc. v. Incontro Holdings, L.L.C.*, 2021 U.S. Dist. LEXIS 86284 (D. Neb. 2021) (finding 6-month delay in bringing injunction during COVID-19 did not vitiate plaintiff’s arguments in favor of

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Sept. 2, 1993) (concluding that 15-month delay was not excessive when plaintiff acted promptly to notify the defendant of its alleged infringement and was attempting to negotiate a settlement); *Am. Dental Ass’n Health Found. v. Bisco Inc.*, 24 U.S.P.Q.2d 1524, 1530 (N.D. Ill. 1992) (finding that irreparable harm existed in spite of any delay in seeking a preliminary injunction “due to [the patentee’s] good faith decision to seek a more inexpensive and economical settlement of [the] litigation”).

<sup>14</sup> The original complaint and preliminary injunction motion were filed in the District of Utah. Rather than incur any delay associated with a venue dispute, Plaintiffs voluntarily dismissed that action and filed this action and their preliminary injunction motion.

<sup>15</sup> Defendant’s reliance on *A.K. by & through Moyer v. Cherry Creek Sch. Dist. No. 5*, 2020 WL 2197920, at \*3 n.1 (D. Colo. May 6, 2020) is unavailing. There, the Court denied request for TRO because plaintiff waited over two months after filing lawsuit to request relief. Similarly, Defendant’s reliance on *Goannies, Inc. v. Goupair.Com, Inc.*, 464 F. Supp. 2d 603, 609 (N.D. Tex. Dec. 2006) is without merit. There, plaintiff waited more than 5 months after filing the lawsuit to seek injunctive relief. Here, unlike both cases, Plaintiffs brought their Motion at the same time as filing this action.

<sup>16</sup> *Am. Express Co. v. Am. Express Limousine Serv. Ltd.*, 772 F. Supp. 729, 737 (E.D.N.Y. 1991) (granting preliminary injunction in trademark case involving 16-month delay); *Kettle Range Conservation Grp. v. U.S. Forest Serv.*, 971 F. Supp. 480, 484 (D. Or. 1997) (rejecting argument that plaintiff’s five month delay was unreasonable and explaining that such a delay is “[o]bviously ... categorically distinct from a five-year delay”).



irreparable harm). The time to file is not grounds for defeating irreparable harm.

**C. The Existence of Other Potential Infringers Or Competitors Does Not Negate Harm.**

Burton cannot evade an injunction merely because there are other possible infringers. There is no requirement that a patentee sue all infringers at the same time. *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1151 (Fed. Cir. 2011) (citing *Pfizer, Inc. v. Teva Pharms. USA, Inc.*, 429 F.3d 1364, 1381 (Fed. Cir. 2005) (explaining that a patentee need not sue all infringers at once. “Picking off one infringer at a time is not inconsistent with being irreparably harmed.”) (internal citations committed)). Burton’s argument that the failure to bring an action against Trek in 2016 defeats irreparable harm is a *non sequitur*. The ‘373 Patent did not issue until August 2020. (ECF 7 at ¶ 17). Plaintiffs had no ability to pursue any action against Trek, a company focused on the bike industry, prior to issuance and as discussed above, Plaintiffs can choose who to sue and when. What matters is that the parties are direct competitors in Plaintiff Smith’s main industry – the snow sports industry. See *Graphic Packaging Int’l, Inc. v. C.W. Zumbiel Co.*, 2012 U.S. Dist. LEXIS 115072 at \*5 (M.D. Fla. Aug. 14, 2012) (finding irreparable harm even though a limited number of other companies compete in the market for similar products). In any event, Burton has failed to produce any evidence showing that there are other infringers in the snow sports market, which is a considerable component of Plaintiffs’ business compared to the bike industry.

But even then, Burton does not rebut any of the evidence presented concerning price erosion, loss of goodwill, damage to business reputation or loss of business opportunities other than to criticize the example concerning Trek. However, the Trek example shows what happens in the sporting goods industry when an infringing technology is introduced – that infringing helmet technology prevents sales and the

development of goodwill. As long as the Trek helmet with the WaveCel® technology remains in the store, Plaintiffs' product will not be sold. This example applies equally to Burton. Store owners and consumers focus on the technology; Burton's infringing technology is making an impact. (See ECF 7 (Lloyd Decl.) at ¶ 66; ECF 8 (Sours Decl.) at ¶¶ 35-38).<sup>17</sup>

**D. There is No Inequitable Conduct and Therefore No Unclean Hands.**

Burton argues that Plaintiffs are not entitled to equitable relief because "key prior art was not disclosed to the PTO during prosecution," constituting unclean hands. Opp. at 23-24). In support of this argument, Burton relies on a 2013 video of the Protos helmet. There was, however, no failure to disclose the Protos helmet. 35 U.S.C. § 102(b)(1), which Burton ignores, expressly provides that "a disclosure made 1 year or less before the effective date of a claimed invention **shall not be prior art to the claimed invention under subsection (a)(1)** if the disclosure was made by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor." Burton admits that the video was available on April 12, 2013—less than one year before the '373 Patent application was filed, and published by the same entity to whom the patent was assigned – Koroyd. (ECF 22 at 8; ECF 8 at n 1).

Further, to assert inequitable conduct, Burton must establish that the '373 patent would not have issued had the alleged prior art been disclosed. There is no duty to disclose prior art that is cumulative of something already disclosed. See *Dig. Control Inc.*

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<sup>17</sup> In response to Plaintiffs' arguments that the similarity of Burton's features and products to the patented products causes irreparable harm, Burton argues that unclaimed allegations or unpatented features cannot be the basis of irreparable harm. Of course, it cites no cases for this proposition. In any event, the point of Plaintiffs' arguments is that the consuming public recognizes that the products are similar. The similarities show that Burton is attempting to target the same customers, increasing the irreparable harm being caused.

*v. Charles Mach. Works*, 437 F.3d 1309, 1319 (Fed. Cir. 2006) (“However, a withheld otherwise material prior art reference is not material for the purposes of inequitable conduct if it is merely cumulative to that information considered by the examiner.”).

**E. The Balance of Harm Favors Preserving the Status Quo Ante and Patentee’s Rights.**

Burton’s argument that the “status quo” is to be preserved is a game of misdirection designed to strip Plaintiffs of their rights duly granted by the USPTO. The relevant status quo is the “last uncontested status between the parties which preceded the controversy until the outcome of the final hearing.” *Xantrex Tech. Inc. v. Adv. Energy Indus.*, 2008 U.S. Dist. LEXIS 41206, at \*35 (D. Colo. May 23, 2008). The status quo here is the status prior to the initial notice of dispute – a time when Burton had not yet sold any infringing products.

Here, granting an injunction will maintain that *status quo ante* as Plaintiffs, not Burton, will continue to furnish their patented technology to customers. Meanwhile, despite Burton’s attempt to twist the status quo analysis to benefit it as the infringer, an injunction is highly unlikely to put Burton out of business because its business and revenue are based on other products than just helmets. But even if an injunction were to have such an effect, courts have consistently held that “[o]ne who elects to build a business on a product found to infringe cannot be heard to complain if an injunction against continuing infringement destroys the business so elected.” *Broadcom Corp. v. Qualcomm, Inc.*, 543 F.3d 683, 704 (Fed. Cir. 2008) (quoting *Windsurfing Int’l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1003, n.12 (Fed. Cir. 1986)). Stopping future sales will simply return the parties to the *status quo ante* and not allow Burton to continue to benefit from its infringing conduct. Of course, the public benefits by stopping infringement. The balance of the harms and the public interest favor granting an injunction to protect against

an infringer.

#### **IV. CONCLUSION**

For the foregoing reasons and the reasons presented in Plaintiffs' opening motion, Plaintiffs respectfully request that this Court grant this motion and enter a preliminary injunction against Burton.

Respectfully submitted this 29th day of September, 2021.

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**ATTORNEYS FOR PLAINTIFFS**

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY THAT ON September 29, 2021, I caused the foregoing document, titled **REPLY IN SUPPORT OF MOTION FOR PRELIMINARY INJUNCTION**, to be electronically filed with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

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