

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

Civil Action No. 1:21-cv-2112-CMA-SKC

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

Plaintiffs,

vs.

THE BURTON CORPORATION, a Vermont company,

Defendant.

**PLAINTIFFS' OPPOSITION TO DEFENDANT'S MOTION FOR LEAVE TO FILE SUR-
REPLY IN OPPOSITION TO PLAINTIFFS' MOTION FOR PRELIMINARY
INJUNCTION**

Plaintiffs Smith Sport Optics, Inc. ("Smith") and Koroyd SARL ("Koroyd") (collectively, "Plaintiffs"), by and through their undersigned counsel, respectfully submit this Opposition to Defendant The Burton Corporation's ("Defendant") Motion for Leave to File Sur-Reply in Opposition to Plaintiffs' Motion for Preliminary Injunction. In support thereof, Plaintiffs state as follows:

INTRODUCTION

Defendant's Motion for Leave to File Sur-reply [ECF 48] and supplemental expert declaration are unwarranted. Defendant has already had ample opportunity to oppose Plaintiffs' Motion for Preliminary Injunction in its 25-page opposition, 3 supporting declarations, totaling 82 pages, along with a total of 32 attached exhibits. Yet, Defendant seeks to have the "last word" on Plaintiffs' Motion for Preliminary Injunction on issues of

validity, which is an opportunity it should not be afforded as the party who lacks the burden of proof. Indeed, Defendant's motion and purported expert declaration are simply an attempt to submit new arguments that it failed to make in its opposition, despite having every opportunity to do so. Plaintiffs did nothing more in their Reply than respond to the arguments raised by Defendant in its opposition brief. This does not constitute new or expanded arguments by Plaintiffs justifying a sur-reply. Therefore, Defendant's transparent effort should be rejected or Plaintiff should be granted leave to file its own final reply brief.

ARGUMENT

It is well accepted that a party bearing the burden of proof gets the first and last word. See e.g., *United States v. Brazier*, 609 F.2d 236, 237-38 (5th Cir. 1980) (in a civil case, the party bearing the burden of proof is entitled to present the final argument). "In the context of a preliminary injunction, while the burden of proving invalidity is with the party attacking validity, the party seeking the injunction retains the burden of showing a reasonable likelihood that the attack on its patent's validity would fail." *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1339 (Fed. Cir. 2003) (internal citations and quotations omitted, emphasis added).

"The 'standard for granting a leave to file a surreply is whether the party making the motion would be unable to contest matters presented to the court for the first time in the opposing party's reply.'" *Ute Indian Tribe of Uintah & Ouray Indian Reservation v. United States*, 145 Fed. Cl. 609, 617 (2019) (quoting *Lewis v. Rumsfeld*, 154 F. Supp. 2d 56, 61 (D.D.C. 2001) (denying the petitioner's motion to file a sur-reply because it did not

involve a new matter but rather an alleged mischaracterization). “Sur-replies are rarely permitted, and only ‘when a party is ‘unable to contest matters presented to the court for the first time’ in the last scheduled pleading.” *Moses v. Dodaro*, 840 F. Supp. 2d 281, 282 n.2 (D.D.C. 2012). Rather, the “court generally grants leave to file a post-reply brief only in extraordinary circumstances after a showing of good cause.” *Cotracom Commodity Trading Co. v. Seaboard Corp.*, 189 F.R.D. 655, 659 (D. Kan. 1999).

Here, Defendant has not shown any “extraordinary circumstances” to be granted relief. Indeed, despite peppering its proposed sur-reply with purported characterizations of Plaintiffs’ reply arguments concerning patent validity as being “new” or having been raised “for the first time” on reply, each of Plaintiffs’ reply arguments were merely responsive to arguments Defendant raised in its opposition brief. Plaintiffs met their initial burden for the Motion by relying on the presumption of validity. Defendant chose to raise questions of invalidity in its opposition brief. (ECF 38 at 10-14). In turn, Plaintiffs countered Defendant’s opposition arguments, nothing more. (See ECF 46 at 4-9). This was to be expected and where the arguments should stop. See, e.g., *Thornton v. Cates*, 2013 WL 2902846, *1 (E.D. Cal. June 13, 2013) (striking plaintiff’s sur-reply “because Defendants did not raise any new arguments in their reply brief, and Plaintiff did not provide any reason that his arguments could not have been made in his opposition...”).

Moreover, Defendant’s sur-reply has nothing to do with any alleged new arguments from Plaintiffs. Indeed, Defendant sought Plaintiffs’ agreement for leave to file a sur-reply before Plaintiffs even filed their Reply. See Email Correspondence, Exhibit A. Either Defendant planned to hold back arguments in its opposition so as to prevent

Plaintiffs from a full opportunity to respond to them, or Defendant knew its opposition arguments were not likely to raise a substantial question of invalidity. Either way, a pre-meditated plan for a sur-reply is grounds for denial. See *Minor v. Donahoe*, 2013 WL 5428718 at n. 3 (N.D. Ohio, Sept. 26, 2013) (denying motion to file sur-reply; “As many courts have observed, surreplies ‘are highly disfavored, as they usually are a strategic effort by the nonmoving party to have the last word on a matter.’”) (citing cases); *In re Enron Corp. Secs.*, 465 F.Supp.2d 687,691 n. 4 (S.D. Tex. 2006) (same). In this case, Defendant’s sur-reply is merely an effort to insert untimely evidence and argument, including a supplemental expert report, that could have been included in the first place. The request should be denied.

At the very least, as the moving parties, Plaintiffs should have the last word on their Motion. Accordingly, if the Court were to grant Defendant leave to file its sur-reply, the Court should accept the response to Defendant’s sur-reply attached hereto as Exhibit B demonstrating how Defendant’s additional arguments still fail to present a substantial question of invalidity with regard to Plaintiffs’ patent, and accordingly Plaintiffs so move.

CONCLUSION

Defendant is improperly using the proposed sur-reply to offer arguments and support that it could have, but did not, include in its Opposition. WHEREFORE, for the reasons stated herein, Plaintiffs respectfully requests the Court deny Defendant’s Motion for Leave to File Sur-Reply. Alternatively, the Court should grant Plaintiffs leave to submit the response attached hereto as Exhibit A to provide Plaintiffs the proper last word.

Respectfully submitted this 13th day of October, 2021.

s/ Gregory S. Tamkin

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY THAT ON October 13, 2021, I caused the foregoing document, titled **PLAINTIFFS' OPPOSITION TO DEFENDANT'S MOTION FOR LEAVE TO FILE SUR-REPLY IN OPPOSITION TO PLAINTIFFS' 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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Exhibit B

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Defendant.

SUR-REPLY IN SUPPORT OF MOTION FOR PRELIMINARY INJUNCTION

Plaintiffs submit this further reply in support of their Motion for a Preliminary Injunction in response to Burton's belated submission of arguments and evidence.

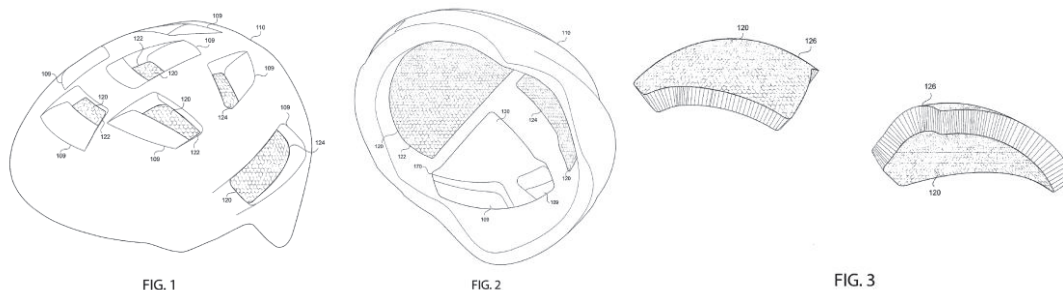
A. Burton's Striker Helmet Arguments Are Improperly Disconnected from the Context of the '373 Patent

Burton and its expert, Dr. Copeland ("Copeland"), again ignore the plain language of claim 1 in arguing the Striker helmet satisfies the claim limitations. Claim 1 of the '373 patent very plainly states that one insert substantially fills one cavity and spans across at least two vents. See '373 patent at claim 1 ("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."). Even accepting Burton's dubious characterization of the hard plastic vent structure of the Striker helmet as a shock absorbing insert, at best the insert fills *two separate cavities* in order to span across two or more vents.

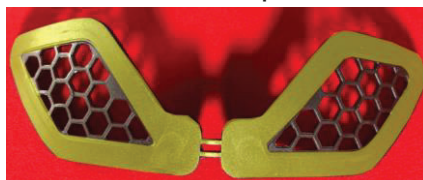
Burton's, and Copeland's, arguments regarding the Striker helmet also suffer from violating the most fundamental cannon of claim construction by focusing "on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc); see also *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001) ("The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose."); *Eon Corp. IP Holdings LLC v. Silver Spring Networks, Inc.*, 815 F.3d 1314, 1320 (Fed. Cir. 2016) ("Although the terms 'portable' and 'mobile' might theoretically, in the abstract, be given such a broad meaning, they cannot be construed that way in the context of the '101 and '491 patents.").

The '373 patent consistently describes and illustrates the shock absorbing insert as an insert made from shock absorbing material that fills a cavity and spans the vent openings *with the shock absorbing material*. For example, as depicted below, the

patent figures consistently illustrate an insert made of the shock-absorbing array of cells that fits within and fills a cavity in the liner of the helmet.



The '373 patent consistently describes the insert of the invention as shaped “relative to a shape of a cavity ... such that the insert must be deformed (e.g., compressed) in order to be removed from the cavity[.]” ’373 patent at 1:65-2:2; *see also id.* at 2:35-37 (“Note that an insert 126 is removed to show a cavity (e.g., an opening, a recess, etc.)”), 2:53-56 (“removing the insert 126 from the cavity 170 requires manually deforming (e.g., compressing) the insert”), 3:35-48 (same); 4:45-5:2 (same), 5:55-64 (same). Construing the “shock absorbing insert” to include the rigid non-shock absorbing frame and struts hidden within the foam liner (colored gold below), dramatically contradicts the context of the ’373 patent:

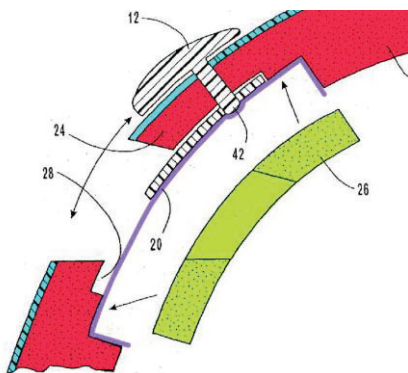


Even if Burton’s belief that the honeycomb portion of the Striker device is “shock absorbing” (an assertion unlikely to prevail at trial), it does not qualify as an insert within the context of the ’373 patent. The honeycomb portion of the Striker device does not “substantially fill[] the cavity such that the shock absorbing insert is visible through and spans across at least a portion of each of the plurality of vents” as required in claim 1. Indeed, the Striker device is not “inserted” in a cavity in the foam liner at all. Rather, the liner is formed around the Striker device. Thus, no portion of the liner is positioned between the “shock absorbing” insert and the helmet shell as claim 1 requires.

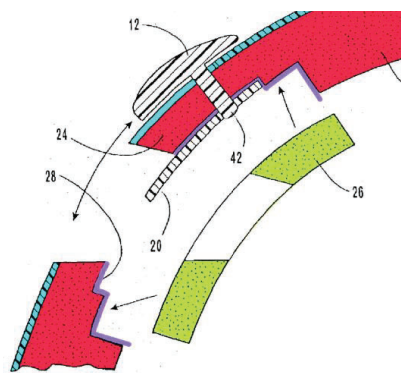
B. Muskovitz is Cumulative of Sundahl

Plaintiffs were correct in characterizing Muskovitz as cumulative to Sundahl. The Patent Office examiner repeatedly rejected the proposed claims arguing that it would have been obvious to replace an insert found in the Sundahl helmet with the honeycomb material taught in the Ferguson reference. *See, e.g.*, 5-17-2017 Office Action (“O.A.”) at 3-4 (ECF 46-8); 12-8-2017 O.A. at 3-4 (ECF 46-9); 3-28-2019 O.A. at 3-4 (ECF 46-10). Plaintiffs distinguished Sundahl by arguing that the mesh insert in Sundahl is not “received within the cavity such that the shock absorbing insert substantially fills the cavity” because the purpose of the mesh screen in Sundahl is “to prevent filling the airflow channels formed in the liner[.]” Kolter Supp. Decl. Ex. 15 at 10. The same argument applies to insert 26 in Muskovitz—the purpose of that insert is to be sized such that it *does not fill* the vent channels. Copeland selectively defines the alleged “cavity” in the Muskovitz reference by ignoring part of the cavity with his purple highlighting as shown below on the left. The claims of Plaintiffs’ ’373 patent ultimately issued over the Sundahl reference despite the Patent Office examiner treating Sundahl *the exact same way* as Burton and Copeland treat Muskovitz here. That is what makes Muskovitz cumulative.

Copeland also ignores the clear gap in the alleged insert in Muskovitz by shading the entire item green, despite the fact that the lack of dotted shading in that area indicates a void that aligns with the vent in the shell and liner above. As shown below on the right, an honest depiction of Muskovitz would have acknowledged the actual cavity formed in the EPS liner, and also would have acknowledged the void in the insert that aligns with the vent in the helmet.



Copeland Decl. at 33-34 (ECF 40)



Muskovitz Fig. 10 (properly shaded)

These oversights by Copeland are not insignificant. As Figure 10 above plainly indicates, the material of insert 26 in Muskovitz does not span across the opening of the vent in the helmet shell. Instead, there is a void in the insert that aligns with the vent opening, such that the insert material would not be visible through the vents. Muskovitz makes this clear by describing Figure 10 as “a cut away front view of one embodiment of the protective helmet according to the present invention in which a removable absorbing material piece fits within a recess located in the inner liner in a matching relationship to create a vent space housing a vent shield.” Muskovitz at ¶0048 (ECF 40-3). Muskovitz also explains that “removable insert 26 is not sized to fill the entire recessed portion of inner liner 18 in order to allow for and provide for the creation of vent space 28.” *Id.* at ¶0088. By its express teachings, Muskovitz *discourages* using an insert that would substantially fill the cavity in the liner, span across the vent, and be visible through the vent. Yet those are all requirements of claim 1 of Plaintiffs’ ’373 patent, which recites, “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.”¹ Burton does not even suggest it would have

¹ Copeland ignores the express teachings in Muskovitz and instead assumes these claim limitations are satisfied by his unsupported color-coding of Figure 10. Such conclusory opinions cannot support a credible case of obviousness. *See TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (“This court’s opinions have repeatedly recognized that conclusory expert testimony is inadequate to support an

been obvious to modify the insert in Muskovitz in a manner that it would substantially fill the cavity and span across and be visible through two or more vents. And even if Burton made such an allegation, such a modification would go against the teachings of Muskovitz. Under such circumstances, Burton is highly unlikely to prevail in proving obviousness by clear and convincing evidence at trial.²

Burton and Copeland cite arguments made by the applicant to distinguish the Sundahl reference.³ But the fact that Plaintiffs ultimately prevailed in distinguishing Sundahl does not mean Muskovitz is not cumulative—it means Muskovitz does not render the claims any less valid than Sundahl did, as explained above.

obviousness determination[.]”).

² See, e.g., *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017) (“[A] showing that a prior art reference teaches away from a given combination is evidence that one of skill in the art would not have been motivated to make that combination to arrive at the claimed invention.”); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”).

³ Burton focuses on arguments made by Plaintiffs in 2015 and 2016, long before the specific claim language at issue was ever presented to the Patent Office. See 2015/10/16 Resp. at 3, 7 (ECF 48-3); 2016/3/8 Resp. at 2, 8 (ECF 48-4). The claims were amended in 2017 and thereafter to recite the features of the invention that ended up in the ’373 patent at issue here. See, e.g., Kolter Supp. Decl. Ex. 13 (2017/2/3 Resp.) at 2; Ex. 14 (2017/8/17 Resp.) at 2; Ex. 15 (2018/3/8 Resp.) at 2.

Respectfully submitted this 13th day of October, 2021.

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