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Paper No. ____

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BURTON CORPORATION,
Petitioner,

v.

SMITH SPORT OPTICS, INC. AND KOROYD SARL,
Patent Owner.

Case No. IPR2022-00354

Patent No. 10,736,373

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE¹**

¹ Emphasis added unless otherwise noted.

TABLE OF CONTENTS

I.	PO’S ALLEGED LEAKAGE ARGUMENT FAILS	1
1.	Muskovitz’s Helmet Allows Air Flow Into the Helmet Interior When Vents are Closed <u>By Design</u>	1
2.	PO Mischaracterizes Muskovitz’s Insert Member 26.....	2
3.	PO Improperly Relies on Proportions in Patent Drawings that a POSA Would <u>Not</u>	3
II.	PO’S ALLEGED “FAILURE OF THE CORE” ARGUMENTS FAIL	4
1.	The Petition’s Combination Increases Protection for the Muskovitz Helmet	4
2.	PO’s Strawman Arguments are Irrelevant	5

TABLE OF AUTHORITIES

CASES

<i>FMC Technologies v. OneSubSea IP</i> , IPR2016-00495, Paper 28 (June 19, 2017)	3
<i>Hockerson-Halberstadt, Inc. v. Avia Group Int’l</i> , 222 F.3d 951, 55 USPQ2d 1487 (Fed. Cir. 2000).....	3
<i>In re Wright</i> , 569 F.2d 1124 (C.C.P.A. 1977).....	3
<i>KSR International Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	4

Smith's (PO) preliminary response (POPR) alleges that a POSA would not have used Sajic's inserts in Muskovitz's helmet because (1) air would allegedly leak into the helmet via Sajic's inserts and defeat the central purpose of Muskovitz, and (2) A POSA would not have used Sajic's inserts positioned across vent openings due to the risk of localized core failure. Both allegations are wrong.

I. PO'S ALLEGED LEAKAGE ARGUMENT FAILS

PO's allegations (POPR, 28-33) that using the Sajic's inserts would have resulted in air leaking through slot 14 and preventing the wearer from being able to control air flow into the helmet fail for multiple reasons enumerated below.

1. Muskovitz's Helmet Allows Air Flow Into the Helmet Interior When Vents are Closed By Design

In alleging that Petition's combination would have "defeated the central purpose of Muskovitz" (POPR, 29), PO redraws Muskovitz's patent figures to speculate that air would leak into the helmet interior via slot 14 preventing control of air flow into the helmet. However, Muskovitz is explicit that for the preferred embodiment of FIG. 2 that PO redraws, the "ventilation system [] allows the user to *only* modify the air flow through the front facing vent ports 6." Muskovitz, [0076]. The majority of the vent ports 6 cannot be adjusted so that air enters the helmet interior *by design* even when the two front vents ports are closed.

Even if some leakage could occur (which is mere speculation, per § I.2 below), there is no evidence or reason to believe it would make any noticeable

difference to the wearer or impact her ability to adjust air flow into the helmet given that the helmet is designed to have the majority of the vents open at all times, and not to seal off the helmet as PO alleges. Muskovitz, [0076].

Indeed, PO's allegation that Muskovitz teaches that "sealing off ambient airflow... is a serious concern on cold ski days" (POPR, 31-32) cites to [0010]—Muskovitz's description of drawbacks of a *prior art* invention—and ignores that Muskovitz discloses that when it is "imperative to retain as much body heat as possible, such as in cold weather situations," Muskovitz teaches swapping in an interchangeable stopper or plug that "completely blocks ambient air from entering into the interior of the protective helmet," *instead* of relying on the adjustable vent shield. Muskovitz, [0033], [0102].

2. PO Mischaracterizes Muskovitz's Insert Member 26

Muskovitz nowhere discloses that air would or could enter through slot 14, let alone pass through liner 18 underneath it. To support the allegation that air "*might* enter through slotted portion 14 when the vent shield 20 is in a closed position" (POPR, 29), PO alleges that Muskovitz's insert member 26 is not taught as "even contributing to the shock absorbing performance of the helmet" (POPR, 34, Ex. 2001, ¶ 110), but is instead intended to "act as a wind block" (Ex. 2001, ¶¶ 109, POPR, 29), despite Muskovitz's explicit disclosure that insert member 26 comprises "shock absorbing material" ([0087]) and in disclosure that the PO omits,

refers to this insert as a “removeable shock absorbing piece” ([0020], [0072]).

Muskovitz says nothing about insert member 26 being a wind block or anything about unwanted air entering slot 14 or liner 18 that would need to be blocked.

3. PO Improperly Relies on Proportions in Patent Drawings that a POSA Would Not

PO relies entirely on inferences based on *redrawing* patent figures to speculate that air would leak into the helmet. Muskovitz does not disclose the dimensions of slot 14 in the outer shell, nor is the width of the opening through inner liner 18 even depicted. PO’s speculative arguments based on the precise proportions illustrated in Muskovitz’s patent drawings and PO’s own re-renderings cannot be relied upon. *Hockerson-Halberstadt*, 222 F.3d 951, 956 (“it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue”); *In re Wright*, 569 F.2d 1124, 1127 (“Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.”).

Indeed, a POSA implementing the Petition’s combination would not have used Muskovitz’s patent drawings as a blueprint, but would have employed ordinary creativity in dimensioning the helmet components, making any necessary modification to prevent any unwanted air flow. *FMC Technologies*, IPR2016-00495, Paper 28, 38 (a POSA of ordinary creativity would “make any necessary

additional modifications” when combining references) *citing KSR* at 421.

Specifically, a POSA would have readily known to dimension slot 14 and/or the opening through liner 18 to reduce or eliminate any unwanted airflow and/or to dimension the actuator or vent shield behind elongated member 42 to block slot 14 and/or the opening in liner 18, respectively.

II. PO’S ALLEGED “FAILURE OF THE CORE” ARGUMENTS FAIL

PO allegations (POPR, 35-37, 44-49) that Sajic’s inserts would not have been used across vent openings ignores the Petition’s combination (*see e.g.*, Petition, 17-35) and instead attacks its own strawman mischaracterizations of the Petition’s combination based on modifying conventional “sandwich panel” configurations not relied upon in the Petition.

1. The Petition’s Combination Increases Protection for the Muskovitz Helmet

Contrary to PO’s mischaracterization, the Petition does not propose positioning Sajic’s inserts with “no abutting layer, foam, or shell on either side of the core” (POPR, 36), but instead positions Sajic’s inserts within and abutting Muskovitz’s shock absorbing liner 18 and underneath outer shell 4. Petition, 20-21 (showing the significant footprint of the insert member), 23 (discussing the improved impact absorption across the vent where Muskovitz’s helmet had *none*). Indeed, the Petition’s combination provides each layer that PO says is needed to “avoid[] localized failure of the core” (POPR, 36)—i.e., an “abutting shock

absorbing foam which was in turn placed inside a rigid shell.” Ex. 2001, ¶ 104.

Petition’s combination does not remove *any* protection from the Muskovitz helmet, but instead provides the superior protection of Sajic’s inserts (Sajic, [0106]-[0107], [0123]) everywhere that Muskovitz’s insert member 26 provided protection with *additional* protection across vent openings where insert member 26 provided no impact absorbing material **at all** (Petition, 20-21, 23)—*increasing* protection against the alleged “localized impact that might lead to user injury.”

2. PO’s Strawman Arguments are Irrelevant

PO pays lip service (POPR, 11-13) to the fact that the Petition’s Sajic reference (which PO calls the “Sajic Application”) describes a different embodiment than the Sajic Patent (i.e., using Sajic’s energy absorbing tubes as an *insert* to improve impact absorption for helmets that use conventional foam liners), but every challenge to Petition’s combination argues irrelevantly that a POSA would not have modified conventional sandwich-panel configurations, best demonstrated by PO’s repeated erroneous allegations (POPR, 10, 36, 44-46) that the examiner considered the “functionally identical” (id., 46) combination during prosecution and withdrew its rejections for the same reasons argued in the POPR.

Both the references applied (Sundhal and the Sajic Patent) and the arguments made during prosecution were materially different. The Petition simply does not rely on the Sajic Patent or sandwich panels, but relies on the Sajic

Application, which notably provides the very teaching PO said the Sajic Patent lacked (*see* underlining in prosecution arguments reproduced on page 45 of the POPR)—i.e., the “practical” and “useful function” of employing Sajic’s core material outside of the sandwich panel configuration as an *insert* positioned in a cavity of a foam liner to improve the impact attenuation of a protective helmet—just as the Petition provides Sajic’s inserts within and abutting Muskovitz’s liner 18 and under shell 4 to achieve the same benefit. Petition, 17-23, 27-35.

Regarding prosecution arguments, PO argued that “Sajic discloses *a core material*, which is specifically designed to *avoid* the risk of global buckling (i.e., compression)” (Ex. 1002, 466) to make the *different* argument that Sajic’s core material was unsuitable to replace Sundhal’s perspiration absorbing pad designed to be quickly removed and repeatedly wrung out. Ex. 1002, 465-467—which a full read with context omitted from PO’s excerpt on page 45 makes abundantly clear. Replacing Sundhal’s perspiration absorbing pad 47 attached to another pad 49 with Sajic’s core material in sandwich panel form is not remotely the Petition’s combination. *See also* Petition 80-82 for additional material differences.

Notably, in prosecution (see above quote), PO correctly points to the design of Sajic’s core material *itself* as avoiding global buckling, contradicting PO’s arguments that Sajic’s inserts (using same material with angled tubes) in Petition’s combination would be vulnerable over the vent openings. POPR, 36.

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Respectfully submitted,
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on June 10, 2022, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Patent Owner, upon the following:

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