

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 Owners.

Case IPR2022-00354
Patent No. 10,736,373

**PATENT OWNERS SMITH SPORT OPTICS' AND
KOROYD SARL'S SURREPLY TO BURTON'S REPLY TO
PATENT OWNERS' PRELIMINARY RESPONSE**

June 16, 2022

Patent Owners (“PO”) respectfully submit this sur-reply to Burton’s Reply arguments.

I. The Proposed Combination Fails to Achieve Muskovitz’s Central Aims

Burton does not directly deny three pillars of PO’s Preliminary Response (“POPR”) argument: (1) that Muskovitz states, *ad nauseum*, its goal of providing a helmet design with a ventilation system which, “[i]n a closed position . . . ambient air is not allowed to flow through into the interior of protective helmet 10.” (Ex. 1005, [0100] (emphasis added); *see also id.*, [0010], [0080], [0112]; POPR at 28-29); (2) that Muskovitz achieves this goal by providing an actuating ventilation system to optionally seal openings in the helmet; and (3) that Burton’s proposed modification of Muskovitz opens a “slotted portion” of the helmet to airflow when the actuator is moved to what should be the “closed” position. *See* POPR 28-33. Because the POPR revealed this fatal flaw in Burton’s obviousness combination, Burton recasts its Petition, Muskovitz, and the POPR in a new light. Regardless, even Burton’s new position fails.

First, Burton mischaracterizes Muskovitz as if the intent of the invention is only to modify airflow in the front-facing ports while keeping other vents perpetually open. Reply, 1-2. To do so, Burton cites half a sentence of Muskovitz describing Figure 2 (without ellipses), omitting critical language that, in full context, contradicts Burton’s point. Reply at 1 (citing Ex. 1005, [0076]). The complete passage reads:

Although the preferred embodiment includes a ventilation system that allows the user to only modify the air flow through the front facing ventilation port 6, **this is not meant to be limiting in any way, as the ventilation system of the present invention may be designed to modify or adjust air flow through any or all of ventilation ports 6 incorporated within protective helmet 10.**

Ex. 1005, [0076] (emphases added). Thus, Muskovitz encourages use of the actuating mechanism to control the flow of air into the helmet—“for any or all” vents, because a POSITA would know that resort to prior art plugs for all but two ventilation ports is not desirable. *See id.* at [0010] (manual attachment of accessories to helmet “is cumbersome and time consuming . . . during the sporting event or activity.”). Burton agrees on this point. Petition at 66. The fatal and dispositive point made in the POPR is that Burton’s proposed modification of Muskovitz would defeat the central purpose of the actuator assembly design—*i.e.*, in the closed position, air would still flow through *that area of the helmet*. POPR at 28-33. Burton’s argument that there may be other open vents in the helmet is beside the point. Burton does not contest that its proposed combination would defeat the stated purpose of the adjustable vent mechanism with respect to those specific vents.

Next, without denying that it is a natural result, Burton argues that it is “mere speculation” that air would flow through the slotted portion in the Petition’s proposed modification. Reply at 2. This is not speculation; it is the obvious conclusion from reading Muskovitz and the Petition. Ex. 1005, [0007] (helmets have openings in the shell/liner to allow air flow); *id.* Figs. 2, 10 (slotted portion 14

is an opening in the shell and aligned with an opening in the liner); Petition at 31, 35 (proposed combination has only an unsealed honeycomb core between user and the slotted opening); POPR at 28-33 (same).

Burton also complains that Muskovitz' insert member 26 is not expressly described as a wind block to prevent air from entering through slotted portion 14 when in the "closed" position. Reply at 2-3. But Burton has already acknowledged this apparent wind-shielding property of insert member 26. *See* Petition at 24 ("To allow air flow into the interior of the helmet, portions of the Muskovitz insert member 26 aligned with corresponding vent openings are removed..."); *see also* Ex. 1005 at [0088], [0119-0120] (insert may be EPS or other closed-cell foams).

Finally, Burton alleges that the POPR improperly relies on dimensions depicted in the figures. Reply at 3-4. These arguments are incorrect and inapposite. Patent Owners have not relied in any way on "the precise proportions" (Reply at 3) of any Muskovitz figures. The fact that moving the Muskovitz vent shield to the "closed" position will open the "slotted portion" space to air flow—thereby frustrating the purpose of the vent shield—is true regardless of the precise dimensions of the slotted portion. POPR at 28-33.

Conceding this, Burton argues that a POSITA would use "ordinary creativity" to overcome this fatal flaw in its proposed combination by altering the design of (1) the slot, (2) the opening in the liner, (3) the actuator, and/or (4) the vent shield to

prevent airflow into the helmet. Reply at 3-4. Were any of these solutions so ordinary, one or more would have been set forth in the Reply, the Petition, or the 112-page declaration of Mr. Copeland. None was. Instead, Burton expects the Board to use the Reply as a prompt from which to imagine a way one might “proportion” aligned openings in a shell and helmet liner that would (1) maintain desired functionality while (2) preventing wind from passing therethrough when using a honeycomb insert. In short, the Board and PO are left to speculate how one would make these changes, and why such changes would be ordinary. This is pure hindsight analysis and falls far short of Burton’s burden. *Veterinary Orthopedic Implants, Inc. v. Depuy Synthes Products, Inc.*, IPR2019-01332, Paper 17 at 41-44 (Jan. 22, 2020) (declining institution where “it appears that the proposed change . . . would be inconsistent with [a reference’s] stated objectives” and “Petitioner does not persuasively explain why the ordinary artisan would, absent hindsight, have made the proposed changes . . . in spite of the inconsistencies.”).

II. Patent Owners Correctly Identify Critical Flaws in the Petition

Burton asserts the POPR introduced and then attacked a strawman argument—that one would remove sandwich panels from a honeycomb core of the Sajic Patent, then insert that core in place of insert member 26, without any abutment by the helmet liner on the face(s) of the honeycomb core. Reply at 4-6. This is a cherry-picked misreading of the POPR, which acknowledges that the outer portions

of the Sajic honeycomb core will abut the foam liner in the proposed combination helmet. *See* POPR at 29-31.

In reality, the POPR correctly points out the following facts, none of which are controverted in the Petition or Reply: (1) the prior art consistently teaches the importance of resilient outer layers/panels to allow for beneficial use of a honeycomb core (POPR at 45-46); (2) in all embodiments disclosed in all Sajic References, the honeycomb core is abutted by resilient sandwich panels, rigid foam, and/or an outer shell (*id.* at 10-14); (3) in the “insert” embodiment of the Sajic Application, the honeycomb core is usually abutted on all sides by rigid foam (and, in turn, a rigid shell), but is implemented in one embodiment with foam on all but one side, and never spans a cavity/vent. Ex. 2001 ¶¶102-05.

Accordingly, a combination of Muskovitz and the honeycomb core of the Sajic Application has the same problem which PO identified during prosecution in response to the examiner’s combination of Sundahl and the Sajic Patent: “There is no evidence” in the Petition “that it would be advisable or practical to use only the core material 20 without it being [abutted by a resilient supporting material] or that the core material 20 would provide a useful function if placed in a cavity with the upper and lower sides of the core not being supported,” as is the case in the vented areas of the proposed combination. *See* Ex. 1002 at 466-67. Burton’s proposed motivations are simply not in the Sajic Application, and Muskovitz and other prior

art discourage such use. *See* POPR at 36-39, 47-50; Ex. 2001 ¶¶115-17 (Muskovitz calling for large aperture in insert member aligned with ventilation ports).

Burton’s final argument alleges PO conceded that the Sajic Patent discloses “a core material, which is specifically designed to avoid the risk of global buckling,” and that this an admission of the propriety of the Petition’s arguments. Ex. 1002 at 466; *see* Reply at 6. Once again, Burton’s selective quoting ignores the full content of PO’s arguments. PO clearly described how the Sajic Patent achieves this result: “In this regard, Sajic describes a specific method of forming a sandwich panel which sandwiches the core material . . . between two skins . . . [the core] being supported by a skin.” Ex. 1002 at 466. Again, Burton provides no basis other than improper hindsight to believe that the Sajic honeycomb core would be expected to beneficially operate as proposed in the Petition—spanning open space in a vented area of a helmet without supportive outer abutting materials in that area. Neither the Petition nor the Reply remedy this glaring omission, or provide any reason to depart from the Examiner’s well-founded withdrawal of this same invalidity argument.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on June 16, 2022, the forgoing was served via email on the counsel of record for the Petitioner at:

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