

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

WALTER KIDDE PORTABLE EQUIPMENT
INC.,

Plaintiff,

v.

FIRST ALERT, INC. AND BRK BRANDS,
INC.,

Defendants.

Civil Action No. 6:22-cv-566-ADA

JURY TRIAL DEMANDED

**PLAINTIFF WALTER KIDDE PORTABLE
EQUIPMENT INC.'S AMENDED ANSWER TO DEFENDANTS
FIRST ALERT, INC. AND BRK BRANDS, INC.'S COUNTERCLAIMS**

Walter Kidde Portable Equipment Inc. ("Kidde") files this Amended Answer to Defendants First Alert, Inc. ("First Alert") and BRK Brands, Inc.'s ("BRK") (collectively, "Defendants") Counterclaims as follows. To the extent not specifically admitted herein, the allegations of the Counterclaims are denied.

THE PARTIES

1. Kidde is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and, on that basis, denies them.

2. Kidde is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and, on that basis, denies them.

3. Kidde is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and, on that basis, denies them.

4. Kidde is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and, on that basis, denies them.

5. Kidde is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and, on that basis, denies them.

6. Kidde is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and, on that basis, denies them.

7. Kidde is without knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and, on that basis, denies them.

8. Admitted.

JURISDICTION AND VENUE

9. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that the Counterclaims purport to be actions that arise under the Patent Laws of the United States, 35 U.S.C. §§ 1 et seq. Kidde further admits that the United States District Court for the Western District of Texas has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

10. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that it does not contest personal jurisdiction for the purpose of this action.

11. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that it does not contest venue for the purpose of this action.

FACTUAL BACKGROUND

12. Admitted.

13. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that a justiciable controversy exists between the parties as to Kidde's claims as well as Defendants' Counterclaims.

14. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde denies the allegations in this paragraph.

COUNT ONE
(INVALIDITY OF U.S. PATENT NO. 7,123,158)

15. Kidde incorporates its responses to the allegations set forth in each preceding paragraph of Defendants' Counterclaims.

16. Admitted.

17. Denied.

18. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that a justiciable controversy exists between the parties as to Kidde's claims as well as Defendants' Counterclaims.

19. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that Defendants' Counterclaims seek a judgment that the '158 Patent is invalid, but denies that the '158 Patent is invalid.

COUNT TWO
(INVALIDITY OF U.S. PATENT NO. 7,525,445)

20. Kidde incorporates its responses to the allegations set forth in each preceding paragraph of Defendants' Counterclaims.

21. Admitted.

22. Denied.

23. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that a justiciable controversy exists between the parties as to Kidde's claims as well as Defendants' Counterclaims.

24. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that Defendants' Counterclaims seek a judgment that the '445 Patent is invalid, but denies that the '445 Patent is invalid.

COUNT THREE
(INVALIDITY OF U.S. PATENT NO. 8,791,828)

25. Kidde incorporates its responses to the allegations set forth in each preceding paragraph of Defendants' Counterclaims.

26. Admitted.

27. Denied.

28. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that a justiciable controversy exists between the parties as to Kidde's claims as well as Defendants' Counterclaims.

29. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that Defendants' Counterclaims seek a judgment that the '828 Patent is invalid, but denies that the '828 Patent is invalid.

COUNT FOUR
(INVALIDITY OF U.S. PATENT NO. 7,403,128)

30. Kidde incorporates its responses to the allegations set forth in each preceding paragraph of Defendants' Counterclaims.

31. Admitted.

32. Denied.

33. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that a justiciable controversy exists between the parties as to Kidde's claims as well as Defendants' Counterclaims.

34. To the extent that the allegations in this paragraph set forth legal conclusions, no response is required. To the extent that a response is required, Kidde admits that Defendants' Counterclaims seek a judgment that the '828 Patent is invalid, but denies that the '828 Patent is invalid.

DEMAND FOR RELIEF

Kidde denies that Defendants are entitled to any relief as alleged or otherwise.

JURY DEMAND

This paragraph sets forth Defendants' demand for a jury trial to which no response is required.

AFFIRMATIVE DEFENSES TO DEFENDANTS' COUNTERCLAIMS

Pursuant to Federal Rule of Civil Procedure 8(c), Kidde, without waiver, limitation, or prejudice, hereby asserts the following affirmative defense to Defendants' counterclaims:

FIRST AFFIRMATIVE DEFENSE
(ASSIGNOR ESTOPPEL)

35. Defendants are estopped from asserting invalidity of the '445 and '158 Patents based on the doctrine of assignor estoppel. *See* Fed. R. Civ. P. 8(c)(1); *Semiconductor Energy Lab. Co., Ltd. V. Nagata*, 706 F.3d 1365, 1370 (Fed. Cir. 2013). Specifically, Joseph G. DeLuca is the named inventor of both the '445 Patent and the '158 Patent and he executed an oath or declaration asserting that he was an original inventor of the claimed invention and that the applications claimed new and useful inventions and improvements to the subject matter. Defendants are estopped from challenging the validity of the '445 and '158 Patents because they are or were parties in privity with Mr. DeLuca at all relevant times.

Dated: May 30, 2023

Respectfully submitted,

FISH & RICHARDSON P.C.

By: /s/ Aamir A. Kazi

David M. Hoffman
Texas Bar No. 24046084
hoffman@fr.com
111 Congress Avenue, Suite 810
Austin, TX 78701
Tel: (512) 472-5070
Fax: (512) 320-8935

Aamir A. Kazi (*admitted in W.D. Tex*)
GA Bar No. 104235
kazi@fr.com
Wonjoon Chung (*pro hac vice*)
GA Bar No. 396468
chung@fr.com
1180 Peachtree Street NE, 21st Floor
Atlanta, GA 30309
Tel: (404) 892-5005
Fax.: (404) 892-5002

Michael F. Autuoro (*admitted in W.D. Tex*)
autuoro@fr.com
Scott M. Flanz (*pro hac vice*)
flanz@fr.com
Times Square Tower, 20th Floor
New York, NY 10036
Tel.: (212) 765-5070
Fax: (212) 258-2291

**COUNSEL FOR PLAINTIFF,
WALTER KIDDE PORTABLE EQUIPMENT INC.**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a) on May 30, 2023, and was served via CM/ECF on all counsel of record.

/s/ Aamir A. Kazi

Aamir A. Kazi