IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No. 1:23-cv-00313

FOX FACTORY, INC.,

Plaintiff,

v.

SRAM, LLC,

Defendant.

DEFENDANT SRAM, LLC'S
PRELIMINARY INVALIDITY CONTENTIONS

Pursuant to this Court's March 16, 2023 Order (Doc. No. 88) and D.C.Colo.LPtR 8 and 9, Defendant SRAM, LLC ("SRAM") hereby provides Plaintiff FOX Factory, Inc. ("Fox") its Preliminary Invalidity Contentions regarding the patents-in-suit, namely, U.S. Patent Nos. 9,739,331 ("the '331 patent") and 8,550,223 ("the '223 patent") (collectively "the Asserted Patents"), along with the document production accompanying SRAM's Preliminary Invalidity Contentions.

I. PRELIMINARY MATTERS

Discovery in this case is ongoing. SRAM anticipates that the subject matter of its Preliminary Invalidity Contentions will be the subject of fact and expert discovery. SRAM's investigation and analysis are not yet complete. SRAM's Preliminary Invalidity Contentions are based on SRAM's information, knowledge, and belief as of the date of these Contentions, which information, knowledge, and belief are based on the limited information currently

available to SRAM, and the limited discovery conducted to date. SRAM reserves the right to amend its Preliminary Invalidity Contentions to the full extent permitted by the Federal Rules of Civil Procedure, the Patent Local Rules, and the Court's Rules and Orders, including any Scheduling Orders in this case. SRAM also reserves its right to amend its answer to rebut any additional allegations that Fox may make with respect to infringement, validity, claim construction, and other pertinent matters in this case.

Specifically, invalidity positions not included in these Preliminary Invalidity Contentions may be uncovered as SRAM continues its investigation. Furthermore, as of the date of these Preliminary Invalidity Contentions, discovery has yet to conclude and SRAM expressly reserves the right to supplement or amend these Contentions with new matter not raised here in response to any additional discovery.

To the extent that SRAM analyzes the elements and applies the asserted claims, SRAM does not intend in any way to endorse or support Fox's or any other claim constructions or interpretations of the Asserted Patents. Further, these Preliminary Invalidity Contentions are not to be construed as an admission that any asserted claims are infringed by SRAM's products or technology, and nothing herein should be deemed or understood to represent, limit, or prejudice the claim constructions that SRAM has advanced in this matter.

SRAM makes this disclosure without waiving its right to object to the disclosure of information protected by the attorney-client privilege, attorney work-product doctrine, the common interest privilege, or any other applicable privilege or immunity. SRAM believes that its Preliminary Invalidity Contentions do not contain any such information and none of these privileges or immunities has been waived. To the extent that the inclusion of any information

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in these Preliminary Invalidity Contentions is asserted to be a waiver of any such privilege or immunity, including the protection from discovery of information protected under the attorney-client privilege, attorney work-product doctrine, the common interest privilege, or any other applicable privilege or immunity, any such alleged waiver is unintentional and inadvertent and SRAM reserves the right under the Federal Rules of Evidence, the rules of this Court, and the law to contest any such assertion and to seek appropriate relief therefrom.

SRAM also reserves its right to object to the production or disclosure of any testimony, information, document, data compilation, or tangible thing on the basis of any valid objection, including, without limitation, any privilege or immunity, the work-product doctrine, relevance, materiality, undue burden, or any other appropriate grounds. SRAM reserves the right to allege the invalidity of the claims of the Asserted Patents on bases other than those disclosed herein. SRAM's Preliminary Invalidity Contentions should be further understood with reference to the charts and figures accompanying these contentions, attached as Exhibits hereto. The statements made in the attached exhibits are by way of non-limiting examples only, and SRAM reserves the right to rely upon additional teachings and disclosures, including drawings from prior art or other references to establish knowledge of a person of ordinary skill in the art or other background information. SRAM further reserves the right to rely upon expert testimony, treatises, published industry standards, and similar documents to demonstrate the knowledge of one of ordinary skill in the relevant art.

These Preliminary Invalidity Contentions do not represent, and should not be understood as describing, SRAM's position regarding the construction of any claim language in the asserted claims of the Asserted Patents. Moreover, these Preliminary Invalidity Contentions are made

without prejudice to any position that SRAM may take with respect to claim construction. SRAM further reserves the right to supplement these Preliminary Invalidity Contentions following any claim construction order from this Court or for other good cause, and reserves the right to introduce and use such supplemental materials at trial.

For the avoidance of doubt, SRAM reserves all right to supplement these Preliminary Invalidity Contentions. Such contentions may be supplemented by discovery in this matter from the inventor(s), the prosecuting attorneys, third parties, Fox, or any other source; expert disclosures (Fox's and SRAM's) and related expert opinions and discovery; any claim construction in this matter; depositions and other testimony; and any new understanding or comprehension of the claims, evidence, or other aspect of this matter.

II. SRAM'S PRELIMINARY INVALIDITY CONTENTIONS

Claims 1-8 of the '331 patent and claims 1-9, 11-15, and 19 of the '223 patent[1] are invalid in view of prior art under 35 U.S.C. §§ 102, 103, and 112 (pre-AIA).[2] The charts in the

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[1] As an initial matter, SRAM notes that Fox has asserted infringement of claims 1-8 of the '331 patent and claims 1-9, 11-15, and 19 of the '223 patent (the "Asserted Claims") in its March 16, 2023 Amended Infringement Contentions. SRAM's Preliminary Invalidity Contentions are limited to the Asserted Claims. To the extent the Court allows Fox to assert any claims other than the above, SRAM reserves its right to supplement its contentions to include any additional claims and assert any additional prior art or arguments to address those claims.

[2] Fox has asserted on page 9 of its Amended Infringement Contentions that the Asserted Claims "of the '331 patent are entitled to a priority date at least as early as May 9, 2012, as stated on the face of the patent." Further, Fox has asserted on page 7 of its Infringement Contentions that the Asserted Claims "of the '223 patent are entitled to a priority date at least as early as May 9, 2008, as stated on the face of the patent." Fox bears the burden of proving any priority date, and to date, Fox has provided no evidence that it is entitled to the benefit of any priority application, or to any particular priority date. To the extent the Court allows Fox to assert earlier priority dates, SRAM reserves its right to respond, including by supplementing its contentions to include additional prior art and arguments. In any event, based on these representations in Fox's

Exhibits hereto (corresponding respectively to the asserted claims of the '331 and '223 patents) clearly identify each item of prior art that anticipates or renders each claim obvious, including the specific location in the items of prior art of each limitation of each asserted claim. The Preliminary Invalidity Contentions and the charts attached hereto further include: (1) an explanation, including the relevant statutory language, of how the item qualifies as prior art; (2) where anticipation is alleged, identification of each item of prior art and an explanation of how it anticipates the asserted claim; (3) where obviousness is alleged, identification of each item of prior art or combination of items of prior art, and, separately for each item of prior art or combination of items of prior art, an explanation of how the item or combination of items renders the asserted claims obvious; and (4) a statement explaining any other grounds of invalidity of any asserted claims.

A. Identification of Prior Art

The following items of prior art anticipate or render obvious each Asserted Claim of the Asserted Patents. Each of the references listed in the charts below is prior art under 35 U.S.C. §§ 102 and 103 (pre-AIA). The identified prior art references and systems below disclose the limitations of the Asserted Claims of the Asserted Patents explicitly, inherently, or as part of an obviousness combination, and may also be relied upon to show the state of the art at the relevant times. SRAM may also rely upon persons identified as inventors of the prior art patents, authors of the prior art publications, individuals with personal knowledge of prior art systems, and/or others as they become identified through further discovery. In addition, SRAM may rely upon

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infringement contentions, SRAM's Preliminary Invalidity Contentions rely on the pre-America Invents Act ("AIA") versions of applicable statutes.

the facts as developed in discovery of prior invention or derivation of the alleged inventions claimed in the Asserted Patents.

For the '331 patent:

Patent Number / Prior Art Description	Country of Origin	Date of Issue/Publication	Applicable Statutory Ground(s) for Invalidity
Japanese Patent No. JP2004345366A	Japan	Published Dec. 9, 2004	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 7,624,752 B2	United States	Issued Dec. 1, 2009	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 6,371,263 B1	United States	Issued Apr. 16, 2002	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
European Patent App. Pub. No. EP0979772A2	European Union	Published Feb. 16, 2000	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
Japanese Patent No. S52-156051U	Japan	Published Nov. 26, 1977	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 4,145,067	United States	Issued Mar. 20, 1979	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 2,708,112	United States	Issued May 10, 1955	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 7,231,939 B1	United States	Issued June 19, 2007	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 6,592,136 B2	United States	Issued July 15, 2003	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
Japanese Patent No. S59-016291U	Japan	Published Jan. 31, 1984	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 565,572	United States	Issued Aug. 11, 1896	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)

Patent Number / Prior Art Description	Country of Origin	Date of Issue/Publication	Applicable Statutory Ground(s) for Invalidity
U.S. Patent No. 764,131 A	United States	Issued July 5, 1904	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 1,174,168 A	United States	Issued March 7, 1916	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)

For the '223 patent:

Prior Art	Country of Origin	Date of Issue/Publication	Applicable Statutory Ground(s) for Invalidity
U.S. Patent No. 6,558,430 B1	United States	Issued May 6, 2003	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 5,405,407	United States	Issued April 11, 1995	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
UK Patent App. Pub. No. GB2377254A	United Kingdom	Published January 8, 2003	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 7,703,586 B2	United States	Issued April 27, 2010	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 2,853,974	United States	Issued September 30, 1958	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)
U.S. Patent No. 8,162,112 B2	United States	Filed February 11, 2008; claims priority to Provisional App. No. 60/889,050 filed February 9, 2007; issued Apr. 4, 2012	35 U.S.C. §§ 102(e), 103 (pre-AIA)
U.S. Patent No. 6,360,857 B1	United States	Issued March 26, 2002	35 U.S.C. §§ 102(a), 102(b), 103 (pre-AIA)

B. Invalidity Based on Prior Art

The claim charts in the Exhibits hereto identify how the prior art listed above reads on or renders obvious the limitations in each of the Asserted Claims. The charts cite exemplary portions of the prior art references that disclose particular limitations of the Asserted Claims, but the citations are informative, not exhaustive or limiting. SRAM intends to rely on each reference in its entirety, including uncited portions. A person of ordinary skill in the art at the time of the invention ("POSITA")[3] would read a prior art reference as a whole and in the context of the state of the art. Therefore, SRAM may rely on uncited portions of the prior art references, other publications, and the general state of the art to aid the understanding of the cited portions of the prior art references and to establish the motivation to modify or combine cited references.

The chart below is a summary of the grounds for invalidity in view of the prior art for the '331 patent, further set forth in the Exhibits attached hereto:

[3] According to its filings, Fox contends that the definition of a person of ordinary skill in the art at the time of the earliest possible filing date for the '331 patent is (1) a Bachelor's degree in Mechanical Engineering or an equivalent degree, and 1-2 years of experience in design work related to bicycle technology involving the transmission of forces between components and operation of fluid or pneumatic components, or (2) at least a Master's degree in Mechanical Engineering or an equivalent degree with a focus on design of mechanical elements, and a good understanding of mechanical design principles. (Doc. No. 71-02 at 4-5; Doc. No. 89-19 at 3.) SRAM disagrees with this definition and contends that a person skilled in the art at the relevant times for the '331 patent would be more properly described as a person with a degree in Mechanical Engineering and at least three-years' experience in vehicle suspension technology, or a Master's degree in Mechanical Engineering with a concentration in design of vehicle suspension technology. (Doc. No. 82-1 at 5-6.)

Asserted Claims	Grounds for Invalidity	Exhibit No.
1–5, 7, 8	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,592,136 B2 in view of U.S. Patent No. 7,231,939 B1, with or without Japanese Patent No. S52-156051U	1
5, 6	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,592,136 B2 in view of U.S. Patent No. 7,231,939 B1 and European Patent App. Pub. No. EP0979772A2, with or without Japanese Patent No. S52-156051U	1
1–5	Anticipated by Japanese Patent No. JP2004345366A	2
4	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. JP2004345366A	2
1–8	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. JP2004345366A in view of U.S. Patent No. 7,231,939 B1, U.S. Patent No. 7,624,752 B2, or U.S. Patent No. 565,572	2
1–6	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. JP2004345366A in view of U.S. Patent No. 764,131 A or U.S. Patent No. 1,174,168 A	2
1–3, 5	Anticipated by Japanese Patent No. S52-156051U	3
1–8	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. S52-156051U in view of U.S. Patent No. 7,231,939 B1, U.S. Patent No. 7,624,752 B2, or U.S. Patent No. 565,572	3
1–6	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. S52-156051U in view of U.S. Patent No. 764,131 A or U.S. Patent No. 1,174,168 A	3

Asserted Claims	Grounds for Invalidity	Exhibit No.
5, 6	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. S52-156051U in view of European Patent App. Pub. No. EP0979772A2, and further in view of U.S. Patent No. 7,231,939 B1, U.S. Patent No. 7,624,752 B2, U.S. Patent No. 565,572, U.S. Patent No. 764,131 A, or U.S. Patent No. 1,174,168 A	3
1–3, 5	Anticipated by U.S. Patent No. 4,145,067	4
1–3, 5	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 4,145,067 in view of U.S. Patent No. 2,708,112	4
1–8	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 4,145,067 in view of U.S. Patent No. 7,231,939 B1, with or without U.S. Patent No. 2,708,112	4
5	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 4,145,067 in view of European Patent App. Pub. No. EP0979772A2, with or without U.S. Patent No. 2,708,112	4
5, 6	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 4,145,067 in view of U.S. Patent No. 7,231,939 B1 and European Patent App. Pub. No. EP0979772A2, with or without U.S. Patent No. 2,708,112	4
1, 2	Anticipated by U.S. Patent No. 6,371,263 B1	5
1–5, 7, 8	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,371,263 B1 in view of U.S. Patent No. 7,624,752 B2 or U.S. Patent No. 565,572	5
1–5	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,371,263 B1 in view of U.S. Patent No. 764,131 A or U.S. Patent No. 1,174,168 A	5

Asserted Claims	Grounds for Invalidity	Exhibit No.
5, 6	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,371,263 B1 in view of U.S. Patent No. 7,624,752 B2, U.S. Patent No. 565,572, U.S. Patent No. 764,131 A, or U.S. Patent No. 1,174,168 A	5
1–5, 7	Anticipated by Japanese Patent No. S59-016291U	6
5	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. S59-016291U or Japanese Patent No. S59-016291U in view of European Patent App. Pub. No. EP0979772A2	6
1–8	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. S59-016291U in view of U.S. Patent No. 7,231,939 B1	6
5, 6	Rendered Obvious under 35 U.S.C. § 103 by Japanese Patent No. S59-016291U in view of U.S. Patent No. 7,231,939 B1 and European Patent App. Pub. No. EP0979772A2	6

The chart below is a summary of the grounds for invalidity in view of the prior art for the '223 patent, further set forth in the Exhibits attached hereto:

Asserted Claims	Grounds for Invalidity	Exhibit No.
1–5, 9, 11–15, 19	Anticipated by UK Patent App. Pub. No. GB2377254A	7
4	Rendered Obvious under 35 U.S.C. § 103 by UK Patent App. Pub. No. GB2377254A	7
1–5, 9, 11–15, 19	Rendered Obvious under 35 U.S.C. § 103 by UK Patent App. Pub. No. GB2377254A in view of U.S. Patent No. 7,703,586 B2	7

Asserted Claims	Grounds for Invalidity	Exhibit No.
6–8	Rendered Obvious under 35 U.S.C. § 103 by UK Patent App. Pub. No. GB2377254A in view of U.S. Patent No. 6,558,430 B1 and/or U.S. Patent No. 5,405,407, with or without U.S. Patent No. 7,703,586 B2	7
1–4, 11–15, 19	Anticipated by U.S. Patent No. 2,853,974	8
1–4, 11–15, 19	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 2,853,974 in view of U.S. Patent No. 7,703,586 B2	8
5–9	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 2,853,974 in view of U.S. Patent No. 6,558,430 B1, with or without U.S. Patent No. 7,703,586 B2	8
6–8	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 2,853,974 in view of U.S. Patent No. 6,558,430 B1 and U.S. Patent No. 5,405,407, with or without U.S. Patent No. 7,703,586 B2	8
1–5, 9, 11–15, 19	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,360,857 B1 in view of UK Patent App. Pub. No. GB2377254A	9
6–8	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,360,857 B1 in view of UK Patent App. Pub. No. GB2377254A and U.S. Patent No. 6,558,430 B1 and/or U.S. Patent No. 5,405,407	9
1–9, 11–15, 19	Anticipated by U.S. Patent No. 6,558,430 B1	10
6–8	Rendered Obvious under 35 U.S.C. § 103 by U.S. Patent No. 6,558,430 B1 in view of U.S. Patent No. 5,405,407	10
19	Anticipated by U.S. Patent No. 8,162,112 B2	11

In the specific statements above, to the extent the prior art, alone or in the combinations indicated, lacks any specific limitation exactly, the claims are obvious over the prior art under the following standard from the Supreme Court:

> When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 421 (2007).

> With regard to the proposed combinations, the following standard applies: When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417.

All of the combinations set forth above involve references in analogous fields of art.

C. Invalidity Based on 35 U.S.C. § 112

The Asserted Claims of the Asserted Patents fail to satisfy 35 U.S.C. § 112. As set forth below, SRAM provides the following grounds of invalidity of the Asserted Claims for lack of written description and/or enablement under 35 U.S.C. § 112 ¶ 1 and indefiniteness under 35 U.S.C. § 112 ¶ 2. The deficiencies that render the certain claims invalid for lack of written description and/or enablement under 35 U.S.C. § 112 ¶ 1 and indefiniteness under 35 U.S.C. § 112 ¶ 2 also infect and thus invalidate the claims depending therefrom.

These grounds are identified based on knowledge in SRAM's possession at this time. Further investigation may uncover additional grounds for invalidity under § 112, and SRAM reserves the right to supplement these disclosures to include all such additional grounds as appropriate. For example, SRAM reserves the right to amend these initial invalidity contentions to provide additional grounds of invalidity under § 112 in response to any contentions or positions that Fox may subsequently disclose, or subsequent claim construction proposals or rulings.

While SRAM's Preliminary Invalidity Contentions seek to provide alternative theories of invalidity, they are not, and should in no way be seen as, admissions or adoptions as to any particular claim scope or construction, or as any admission that any particular element is met any particular way. SRAM reserves the right to supplement or otherwise amend its contentions after the Court's claim construction ruling, if Fox amends or alters its infringement contentions in any way, or after SRAM has obtained meaningful discovery from the inventor(s), the prosecuting attorneys, third parties, Fox, or any other source.

35 U.S.C. § 112, ¶ 1 provides that a patent specification "shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make, and use the same[.]" The Federal Circuit has held that this language creates two closely related, yet separate requirements: (i) a written description of the invention ("written description") and (ii) a written description of the manner and process of making and using the invention ("enablement"). *See Ariad Pharms., Inc. v. Eli Lilly Co.*, 598 F.3d 1336, 1344 (Fed. Cir. 2010) (en banc).

To comply with the written description requirement of 35 U.S.C. § 112, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor possessed the claimed invention. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). "An applicant demonstrates that he was in possession of the invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the invention." *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). "[T]he written description inquiry looks to the four corners of the specification to discern the extent to which the inventor(s) had possession of the invention as broadly claimed. The knowledge of ordinary artisans may be used to inform what is actually in the specification, but not to teach limitations that are not in the specification, even if those limitations would be rendered obvious by the disclosure in the specification." *Rivera v. Int'l Trade Comm'n*, 857 F.3d 1315, 1322–23 (Fed. Cir. 2017) (citations omitted).

The specifications of the Asserted Patents do not reasonably convey to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the claimed priority date or the filing date of the applications leading to the Asserted Patents.

To satisfy the definiteness requirement of 35 U.S.C. § 112, ¶ 2, the claims must particularly point out and distinctly claim the subject matter that the inventors regarded as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the Asserted Claims when read in light of the specification. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014) (Section 112(2) "require[s] that a patent's claims, viewed

in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with ***reasonable certainty***") (emphasis added).

The specifications of the Asserted Patents do not inform one of ordinary skill in the art about the scope of the invention with reasonable certainty.

The '331 patent – Invalidity Under 35 U.S.C. § 112, ¶ 1

For the '331 patent, at least the following limitations lack written description under 35 U.S.C. § 112, ¶ 1 based on SRAM's current understanding of the Asserted Claims, which are based in part on Fox's apparent claim constructions:

(1) "an upper bushing attached to and positioned adjacent to said lower leg seal" in claim 1

Claim 1 of the '331 patent is invalid under 35 U.S.C. § 112, ¶ 1 for lack of written description because the specification does not reasonably convey to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date of the application. For example, the specification does not disclose "an upper bushing attached to and positioned adjacent to said lower leg seal" as SRAM understands the apparent plain and ordinary construction of that phrase. Nowhere in the text of the '331 patent specification or figures is a bushing shown or described as being attached to a seal. Instead, FIG. 4 shows an intervening foam ring (125) between the seal (135) and the bushing (120). Further, the only disclosure of a bushing in the specification does not include this limitation: "FIG. 2 shows a cross-section of the air bleed assembly (300) and the vent hole (154) between the seal (not shown) and the upper bushing (120) (or behind foam ring (125))." '331 patent at col. 4, lines 17-19. Thus, a POSITA would not understand that the inventors had possession of the claimed invention.

(2) "wherein said sealed position seals between said die-cast feature and said lower fork" in claim 1

Claim 1 of the '331 patent is invalid under 35 U.S.C. § 112, ¶ 1 for lack of written description because the specification does not reasonably convey to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date of the application. For example, the specification does not disclose a seal "between said die-cast feature and said lower fork" as SRAM understands the apparent plain and ordinary construction of that phrase. Nowhere in the text of the '331 patent specification or figures is a seal shown or described as being between a die-cast feature of a lower fork and a lower fork. Instead, FIG. 3 shows a button (150) and an air bleed assembly (300) formed on a lower fork tube (118) and lower fork (104). Further, the only disclosure of a die-cast feature in the specification does not include this limitation: "FIG. 3 shows the air bleed assembly **300** including button **150** positioned on a die-cast feature of the lower leg. Pressing the button **150** equalizes the air pressure in the fork/shock assembly with the local ambient air pressure." '331 patent at col. 4, lines 13–16. Thus, a POSITA would not understand that the inventors had possession of the claimed invention.

The '223 patent – Invalidity Under 35 U.S.C. § 112, ¶ 1

For the '223 patent, at least the following limitations lack written description under 35 U.S.C. § 112, ¶ 1 based on SRAM's current understanding of the Asserted Claims, which are based in part on Fox's apparent claim constructions.

(1) "a fluid flow path formed in the bottom out cup" in claim 1; "a second fluid flow path within the bottom out cup" in claim 9; and "an adjustable fluid flow path formed in the cup" in claim 11

Claims 1, 9, and 11 of the '223 patent are invalid under 35 U.S.C. § 112, ¶ 1 for lack of written description because the specification does not reasonably convey to a POSITA that the inventor had possession of the claimed subject matter as of the filing date of the application. For example, the specification does not disclose any path "formed in the bottom out cup," "within the bottom out cup," or "formed in the cup" as SRAM understands the apparent plain and ordinary construction of that phrase. Nowhere in the text of the '223 patent specification or figures is a path formed in or within the bottom out cup. Instead, the figures show, and the specification describes, a number of paths formed between the bottom out cup and portions of the damper chamber. For example, FIGS. 3A and 3B show a number of paths (e.g., 301, 302) formed outside of the bottom out cup (275). Thus, a POSITA would not understand that the inventors had possession of the claimed invention.

(2) "a fluid flow path formed between the cup and the primary compression chamber; wherein the capacity of the fluid flow path is adjustable" in claim 13

Claim 13 of the '223 patent is invalid under 35 U.S.C. § 112, ¶ 1 for lack of written description because the specification does not reasonably convey to a POSITA that the inventor had possession of the claimed subject matter as of the filing date of the application. For example, the specification does not disclose multiple adjustable flow paths from a bottom out cup to a compression chamber. Nowhere in the text of the '223 patent specification or figures are there multiple adjustable flow paths formed in or within the bottom out cup. Instead, the figures show, and the specification describes, a single path formed between the bottom out cup

and portions of the damper chamber that is adjustable. For example, FIGS. 3A and 3B show such a path. Thus, a POSITA would not understand that the inventors had possession of the claimed invention.

The '331 patent – Invalidity Under 35 U.S.C. § 112, ¶ 2

For the '331 patent, at least the following limitations are indefinite under 35 U.S.C. § 112, ¶ 2 based on SRAM's current understanding of the Asserted Claims, which are based in part on Fox's apparent claim constructions:

(1) The terms "said lower fork tube" and "said upper fork tube" have no antecedent basis in claim 1 and are indefinite, along with the terms "said lower fork" in claims 3, 5, 6, and 8.

As a result of the lack of an antecedent basis, it is not possible to discern whether the terms "lower fork" and "lower fork tube" are used interchangeably in the '331 patent claims, or are used to describe separate and distinct features. And if these terms refer to separate and distinct features, the relationship between the "lower fork" and the "lower fork tube" is unclear, at best. Further, the scope of these two, equally valid interpretations varies considerably. Presumably a "lower fork" would include multiple "lower fork tubes," as shown in the figures of the '331 patent. Thus, the claims may refer to any of the multiple fork tubes. On the other hand, if "lower fork" and "lower fork tubes" have the same meaning, the claim limitations are limited to describing only a single section of fork lowers. As a result, claim 1's scope is indefinite at least because the claim cannot be understood with sufficient specificity. Claims 3, 5, 6, and 8 also refer to "said lower fork," which term suffers from the same lack of clarity described for claim 1.

Accordingly, claim 1, along with claims 3, 5, 6, and 8, is invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

(2) The term "wherein said fluid passage and said manually operable valve are located at a distance from an oil bath lubrication within said lower fork, such that when said manually operable valve is in said second position, most, if not all of said oil bath lubrication remains within said lower fork and such that when trapped air pressure inside said lower fork, that is higher than a local ambient air pressure outside of said suspension fork or shock absorber, is relieved most, of said oil bath lubrication that is within said lower fork remains within said lower fork" in claim 1 is indefinite.

Claim 1 of the '331 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification. In the specification of the '331 patent and the relevant file history, there is no test or means for determining whether a given fork meets this limitation. This term is undefined and dependent on several unspecified factors including the orientation of the fork when opening the valve, the design of the interior of the fork, the amount of oil used in the fork, the amount of oil required by the fork, etc. Forks may be set up in a myriad of ways, some of which may cause some leakage of oil, others which may not. For example, if one were to operate SRAM's pressure relief valve while the fork is placed in certain positions, much of the oil will leak from the fork. But in other positions, the oil will not leak. Additionally, forks may be filled with differing amounts of oil, meaning that some amounts might result in infringement

while others do not. This lack of a test or means for determining infringement renders claim 1 of the '331 patent indefinite.

As an independent basis for invalidity of claim 1, the claim is indefinite because the amount of oil that must remain to meet this limitation—"most, if not all"—lacks any means for determining if the limitation is met or not by a given product. There is simply no way for a person of ordinary skill in the art at the time of the invention to determine how much oil may leak before "most" of the oil is no longer retained, let alone any way to determine what is meant by this limitation with any sort of precision, or reasonable certainty. As a result, Fox's competitors have no way of determining infringement, and Fox would have no consistent way of showing infringement. Without any means for determining how the claim may be infringed, claim 1 of the '331 patent is invalid for being indefinite.

Accordingly, claim 1 is invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

(3) The term "an activation position placing said manually operable valve into said first position; and a deactivation position placing said manually operable valve into said second position, and whereupon when in said activation position, the trapped air pressure in said lower fork is equalized with the local ambient air pressure" in claim 3, along with the use of "activation position" and "deactivation position" in claims 4, 6, 7, and 8, is indefinite.

Claim 3 of the '331 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in

light of the specification. Specifically, claim 3 is indefinite for ***conflating*** the first and second positions between claims 1 and 3. First, claim 1 requires the first position to be the closed position ("said manually operable valve having a first position substantially closing said fluid passage"). Next, claim 3 requires that the activation position be the first position ("an activation position placing said manually operable valve into said first position"), which should be the closed position according to claim 1. Claim 3, however, also requires that trapped air within the lower fork tube equalize with ambient air pressure when the valve activator is in the activation position ("whereupon when in said activation position, the trapped air pressure in said lower fork is equalized with the local ambient air pressure"). This is not possible because the valve cannot be closed while simultaneously allowing trapped air within the lower fork tube to equalize with ambient air pressure. The valve cannot be simultaneously in the closed and open positions. Claims 4, 5, and 7 also refer to the problematic "activation position" and "deactivation position," which terms suffer from the same lack of clarity described for claim 3.

Accordingly, claim 3 is invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

(4) The term "substantially closing" in claim 1 is indefinite.

Claim 1 of the '331 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification. In the specification of the '331 patent and the relevant file history,

there is no test or means for determining whether a given fork meets this limitation. This term is undefined and dependent on several unspecified factors including how much air is allowed to leak, the allowed rate of leakage, etc. The amount of sealing provided by any valve may vary considerably, as would be understood by a person of ordinary skill in the art. For example, some forms of sealing may prevent a major escape of gas while allowing small amounts of gas to leak out over time. The same may be true for oil, especially oil under pressure. There is no way for a person of ordinary skill in the art at the time of the invention to determine how much sealing is required for the valve to be "substantially closing" the fluid passage. Based on the '331 patent and its file history, there is simply no way to determine what is meant by this limitation with any sort of precision. As a result, Fox's competitors have no way of determining infringement, and Fox would have no consistent way of showing infringement. Without any means for determining how the claim may be infringed, claim 1 of the '331 patent is invalid for being indefinite.

Accordingly, claim 1 is invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

(4) The term "outermost edge" in claim 1 is indefinite.

Claim 1 of the '331 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

Specifically, it is unclear what is meant by the term "outermost edge." This term in not used in the '331 patent's specification or the relevant file history. This term does not have a defined meaning in the art. The plain and ordinary meaning of the term could be limited to requiring that the related seal be formed on the edge of the lower fork tube itself, or it may possibly include some undefined distance therefrom. In the case of the latter, neither the claims, nor the '331 patent specification, nor the file history provide any means for determining how close to the edge of the lower fork tube falls within the scope of the term. Thus, there is no means for determining which definition applies nor how a proximate definition would be measured.

Accordingly, because SRAM cannot determine the meaning of the term, and the intrinsic evidence does not offer any clarification, this term is indefinite.

(5) The term "oil bath lubrication" in claim 1 is indefinite.

Claim 1 of the '331 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

Specifically, it is unclear what is meant by the term "oil bath lubrication." This term's use in the '331 patent's specification is merely to show that there is oil in the lower fork tubes. *See*, *e.g.*, '331 patent at FIG. 4 (showing oil bath 140). This term does not have a defined meaning in the art. The plain and ordinary meaning of the term would be merely a bath of oil, wherein the oil is capable of providing lubrication. However, some oil in shock systems may be used as a damping fluid. It is unclear if this term is intended to be limited to some given

purpose, or if any oil would meet the scope of the term. Accordingly, because SRAM cannot determine the meaning of the term, and the intrinsic evidence does not offer any clarification, this term is indefinite.

(6) The term "said trapped air pressure does not by-pass into or out of said lower fork" in claim 8 is indefinite.

Claim 8 of the '331 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

Specifically, it is unclear what is meant by the term "said trapped air pressure does not by-pass into or out of said lower fork" at least because "trapped air pressure" cannot "by-pass into" the fork. This term is not used in its full form in the '331 patent's specification. This term does not have a defined meaning in the art. The '331 patent specification does discuss "trapped air," which is air that is held within the fork. That pressure is within the fork itself, and therefore, cannot travel from outside of the fork into the fork. The concept of air that is trapped by the fork moving into the fork is a contradiction and is nonsensical.

Accordingly, because a POSITA cannot determine the meaning of the term, and the term itself is contradictory and nonsensical, this term is indefinite.

(7) The term "said sealing o-ring" in claim 8 is indefinite.

As a result of the lack of an antecedent basis, it is not possible to discern the scope of "said sealing o-ring" as recited/claimed in claim 8 of the '331 patent. The term is introduced in claim 6, but claim 8 does not depend therefrom. Without an antecedent basis, it is not possible to determine if this limitation is modifying the scope of any previous term, or if it is an ambiguous

introduction of a new claim element. As a result, claim 8's scope is indefinite at least because the claim cannot be understood with sufficient specificity.

Accordingly, claim 8 is invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

The '223 patent – Invalidity Under 35 U.S.C. § 112, ¶ 2

For the '223 patent, at least the following limitations are indefinite under 35 U.S.C. § 112, ¶ 2 based on SRAM's current understanding of the Asserted Claims, which are based in part on Fox's apparent claim constructions:

(1) The terms "wherein the capacity of the fluid flow path is adjustable" in claim 1; "wherein the capacity of the flow path" in claim 2; and "wherein the capacity of the fluid flow path is adjustable" in claim 13 are indefinite.

Claims 1, 2, and 13 of the '223 patent are indefinite because they fail to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification. Specifically, these claims refer to the "capacity" of a passage—the fluid flow path—being adjustable, presumably with varying the cross-sectional area of an obstruction within the passage. A POSITA could not determine what is intended by this limitation with reasonable certainty because the term "capacity" has no particular meaning within the art, is undefined, and, depending on the fluid within the passage, the amount of material flowing through the passage will depend on a number of factors, including temperature, volume, density, pressure, and other factors, such that a POSITA cannot understand the scope

and bounds of the claim when read in light of the specification. The '223 patent specification does not discuss any "capacity" or use this term, and thus, the '223 patent specification does not provide any guidance.

Accordingly, claims 1, 2, and 13 are invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

(2) The term "wherein the volume of fluid traveling through the fluid path is user-adjustable" in claim 8 is indefinite.

Claim 8 of the '223 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification. Specifically, these claims refer to the "volume" of fluid traveling within a passage—the fluid flow path—being adjustable, presumably with varying the cross-sectional area of an obstruction within the passage. A POSITA could not determine what is intended by this limitation with reasonable certainty because the term "volume" does not have a particular meaning within the art, which meaning would refer to either (1) the amount of three-dimensional space occupied by an object or material, or (2) or the amount of material/matter within such a defined three-dimensional space. In a shock absorber, the interior volume of any fluid path is fixed and is not user adjustable. On the other hand, the amount of material flowing through those three-dimensional spaces is dependent on factors including temperature, volume, density, pressure, and other factors. As a result, the volume of fluid may or may not be

adjustable by the user. As a result, this claim limitation does not have a precise meaning that can be reasonably certain to a POSITA.

Accordingly, claim 8 is invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

(3) The terms "the path formed in the shaft" in claim 5; "the path" in claim 7; "the fluid path" in claim 8; "wherein the capacity of the fluid flow path is adjustable" in claim 13; and "flow path" in claim 14 are indefinite.

Claims 5, 7, 8, 13, and 14 of the '223 patent are indefinite because they fail to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification. Specifically, these claims each refer to a "path," "fluid path," or "flow path," but each claim includes more than one element called a "path" or "flow path." The use of these terms in each of claims 5, 7, 8, 13, and 14 is undefined as to which of the multiple paths is limited by the new limitations. A POSITA could not determine what is intended by this limitation with reasonable certainty because the terms may refer to different earlier-stated elements, such that a POSITA cannot understand the scope and bounds of the claim when read in light of the specification.

Accordingly, claims 5, 7, 8, 13, and 14 are invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because they fail to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

(4) The term "bottom out cup formed at an end of the compression portion" in claim 1 is indefinite.

Claim 1 of the '223 patent is indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification. Specifically, there is no means or test for determining if a given "bottom out cup" is sufficiently close to the end of a given compression portion to be considered to be "formed at [that] end" as recited/claimed. As a result, a POSITA would not know with reasonable certainty what this claim term means in context.

Accordingly, claim 1 is invalid under 35 U.S.C. § 112, ¶ 2 as indefinite because it fails to particularly point out and distinctly claim the subject matter the inventors regard as their alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the claim when read in light of the specification.

For these reasons and those set forth in the attached charts, SRAM denies that any of the Asserted Claims of the Asserted Patents are valid and therefore cannot be infringed by SRAM.

DATED: April 27, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on April 27, 2023, the foregoing document was served upon counsel of record via email transmission to the following:

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