

**UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF FLORIDA**

SYSTEM STORMSEAL PTY LTD and
STORMSEAL USA, LLC,

Plaintiffs/Counterclaim Defendants,

v.

ABC SUPPLY CO., INC., MULE-HIDE
PRODUCTS CO., INC., and STRUCTURAL
WRAP, LLC,

Defendants/Counterclaim Plaintiffs.

C.A. NO. 9:22-cv-81726-AHS

**PLAINTIFFS/COUNTERCLAIM DEFENDANTS SYSTEM STORMSEAL PTY LTD
AND STORMSEAL USA, LLC'S ANSWER TO DEFENDANT/COUNTERCLAIM
PLAINTIFF STRUCTURAL WRAP, LLC'S COUNTERCLAIMS**

Plaintiffs/Counterclaim Defendants System Stormseal Pty Ltd. and Stormseal USA, LLC (collectively, "Stormseal"), hereby answer Defendant/Counterclaim Plaintiff Structural Wrap, LLC's ("Structural Wrap") Counterclaims (the "Counterclaims") against Stormseal as follows:

ANSWER TO COUNTERCLAIMS

1. To the extent that the allegations of Paragraph 1 of the Counterclaims set forth legal conclusions, no response is required. Stormseal admits that the Counterclaims purport to state claims for declaratory judgment of noninfringement and invalidity of one or more claims of U.S. Patent No. 11,168,484 and infringement of one or more claims of United States Patent No. 11,041,312 ("the '312 Patent"), and arise under the patent laws of the United States, Title 35, United States Code, including 35 U.S.C. § 271, and the Declaratory Judgment Act, United States Code, including §§ 2201, 2202. Stormseal denies all other allegations in Paragraph 1.

The Parties

2. Stormseal admits that the Florida Department of State website lists Structural Wrap, LLC as a Florida company with a principal place of business at 8793 SW 131st St., Miami, FL 33176. Stormseal is without sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 2 of the Counterclaims, and therefore denies them.

3. Stormseal is without sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 3 of the Counterclaims, and therefore denies them.

4. Stormseal is without sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 4 of the Counterclaims, and therefore denies them.

5. Stormseal is without sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 5 of the Counterclaims, and therefore denies them.

6. Stormseal is without sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 6 of the Counterclaims, and therefore denies them.

7. Admitted.

8. Admitted.

9. Denied.

Jurisdiction and Venue

10. Stormseal incorporates by reference its responses to Paragraphs 1–9 of their Answer to Counterclaims as if fully set forth herein.

11. To the extent that the allegations of Paragraph 11 of the Counterclaims set forth legal conclusions, no response is required. Stormseal admits that the Counterclaims purport to arise under the patent laws of the United States, Title 35, United States Code, including 35 U.S.C. § 100

et seq. and the Declaratory Judgment Act, United States Code, including §§ 2201, 2202. Stormseal denies all other allegations in Paragraph 11.

12. To the extent that the allegations of Paragraph 12 of the Counterclaims set forth legal conclusions, no response is required. Stormseal does not dispute that this Court has subject matter jurisdiction over Structural Wrap's counterclaims.

13. Stormseal does not contest that it is subject to personal jurisdiction in this District, solely for purposes of this action. Stormseal denies all other allegations in Paragraph 13.

14. Stormseal does not contest that venue is proper in this District. Stormseal denies all other allegations in Paragraph 14.

The '484 Patent

15. Stormseal incorporates by reference its responses to Paragraphs 1–14 of their Answer to Counterclaims as if fully set forth herein.

16. Admitted.

The '312 Patent

17. Stormseal incorporates by reference its responses to Paragraphs 1–16 of their Answer to Counterclaims as if fully set forth herein.

18. Stormseal admits that Exhibit 1 to Structural Wrap's counterclaims appears to be a copy of the '312 Patent. Stormseal denies all other allegations in Paragraph 18.

19. Stormseal admits that the face of the '312 Patent identifies Christopher M. Mouriz, Spiro Naos, and Larry J. Bond as inventors and Structural Wrap, LLC as the assignee. Stormseal denies that the '312 Patent was duly and legally issued, and denies all other allegations in Paragraph 19.

20. Denied.

FIRST CAUSE OF ACTION
(Declaratory Judgment of Non-Infringement of the '484 Patent)

21. Stormseal incorporates by reference its responses to Paragraphs 1–20 of their Answer to Counterclaims as if fully set forth herein.

22. Admitted.

23. Admitted.

24. Denied.

25. Denied.

26. Denied.

27. Denied.

SECOND CAUSE OF ACTION
(Declaratory Judgment of Invalidity of the '484 Patent)

28. Stormseal incorporates by reference its responses to Paragraphs 1–27 of their Answer to Counterclaims as if fully set forth herein.

29. Denied, except that Stormseal does not presently contend that the Court lacks subject matter jurisdiction over Structural Wrap's Second Cause of Action.

30. Denied.

31. Denied.

32. Denied.

THIRD CAUSE OF ACTION
(Alleged Infringement of U.S. Patent No. 11,041,312 Patent)

33. Stormseal incorporates by reference its responses to Paragraphs 1–32 of their Answer to Counterclaims as if fully set forth herein.

34. Denied.

35. Denied.

36. Admitted that Paragraph 36 accurately quotes claim 8 of the '312 Patent. To the extent this Paragraph contains any other factual allegations, Stormseal denies them, and specifically denies that claim 8 is valid or that Stormseal has infringed claim 8.

37. Stormseal admits that Paragraph 37 appears to include excerpted text and images from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 37.

38. Stormseal admits that Paragraph 38 appears to include an excerpted image from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 38.

39. Stormseal admits that Paragraph 39 appears to include excerpted images from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 39.

40. Stormseal admits that Paragraph 40 appears to include an excerpted image from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 40.

41. Stormseal admits that Paragraph 41 appears to include an excerpted image from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 41.

42. Stormseal admits that Paragraph 42 appears to include excerpted images from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 42.

43. Stormseal admits that Paragraph 43 appears to include an excerpted image from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 43.

44. Stormseal admits that Paragraph 44 appears to include an excerpted image from Stormseal's website. Stormseal denies all other factual allegations in Paragraph 44.

45. Stormseal admits that Paragraph 45 appears to include a link to Stormseal's website. Stormseal denies all other factual allegations in Paragraph 45.

46. Denied.

PRAYER FOR RELIEF

To the extent Structural Wrap's Prayer for Relief contains any factual allegations, Stormseal denies them. Stormseal denies that Structural Wrap is entitled to any relief whatsoever from Stormseal, whether sought in the Prayer for Relief or otherwise. Stormseal also denies that Structural Wrap has any valid claim pursuant to 35 U.S.C. § 271, et seq., and denies that it has violated any of the patent laws of the United States with respect to the '312 Patent. Structural Wrap's Prayer for Relief should therefore be denied in its entirety and with prejudice, and Structural Wrap should take nothing from Stormseal.

Stormseal further reserves the right to seek costs and attorney's fees under 35 U.S.C. § 285 and any other applicable law.

JURY DEMAND

Stormseal demands a jury trial on all issues so triable.

DEFENSES AND AFFIRMATIVE DEFENSES

Stormseal alleges and asserts the following defenses and affirmative defenses in response to the allegations in the Counterclaims. Stormseal undertakes the burden of proof only as to those defenses that are deemed affirmative defenses as a matter of law. In addition to the defenses described below, Stormseal reserves all rights to amend or supplement these defenses as additional facts become known.

First Defense – Failure to State a Claim

1. Structural Wrap has failed to state a claim against Stormseal upon which relief can be granted. For example, the Counterclaims lack a factual basis, and fail to make more than bare conclusory allegations regarding non-infringement and invalidity of the '484 Patent.

2. By way of example only, Structural Wrap's Counterclaims fail to identify any direct infringer with respect to any of its claims of direct or indirect infringement.

3. By way of further example, Structural Wrap alleges that "manufacture, use, offer for sale, sale, and/or importation" of the "Stormseal Product" directly infringes claim 8 of the '312 Patent, but Structural Wrap does not allege how manufacture, sale, offer for sale or importation of a product can directly infringe a claim directed to a "method for covering at least a portion of a roof of a structure with an impermeable membrane."

Third Defense – Non-Infringement of the '312 Patent

4. Stormseal has not infringed, directly, jointly, contributorily, or by inducement, any valid or enforceable claim of the '312 Patent, either literally or under the doctrine of equivalents, and has not otherwise committed any acts in violation of 35 U.S.C. § 271, et seq.

Fourth Defense – Invalidity/Ineligibility of the '312 Patent

5. At least the asserted claim of the '312 Patent is invalid, unenforceable, or ineligible for patenting under one or more of the provisions of Title 35 of the United States Code, including but not limited to 35 U.S.C. §§ 101 (subject matter), 102 (anticipation), 103 (obviousness), and/or 112 (indefiniteness, failure to claim the subject matter regarded as the invention, and failure to satisfy the written description and/or enablement requirements), the rules, regulations, and laws pertaining thereto, and/or under other judicially-created bases for invalidity and ineligibility.

6. By way of example only, Stormseal's '484 Patent is prior art to Structural Wrap's '312 Patent and anticipates or renders obvious the asserted claim of the '312 Patent.

Fifth Defense – Prosecution History Estoppel

7. Structural Wrap is estopped from construing any of the claims of the '312 Patent in such a way as may cover, encompass, and/or include Stormseal's products, services, or activities and/or has waived any right to do so by reason of amendment, cancellation, and/or abandonment of claims, and/or admissions, representations, and/or statements made by or on behalf of the applicants, in proceedings before the United States Patent and Trademark Office.

Sixth Defense – Limitations on Damages and Costs

8. Structural Wrap's claims for damages and/or costs are limited under the statutory limitations on damages and/or costs set forth in 35 U.S.C. §§ 286, 287 and/or 288.

Seventh Defense – Waiver, Estoppel, and Unclean Hands

9. Structural Wrap's Counterclaims are barred, in whole or in part, by the equitable doctrines of waiver, estoppel, and/or unclean hands.

Eighth Defense – Sales to the United States Government

10. To the extent any products accused of infringement in this cases are used by and/or manufactured for the United States Government or a person or entity affiliated with the United States Government, Plaintiff's claims with respect to those products cannot be pursued in this Court and are subject to other limitations under 28 U.S.C. § 1498.

Reservation of Additional Defenses

Stormseal's investigation of the matter is ongoing. It reserves all defenses under the Federal Rules of Civil Procedure, the patent laws of the United States, other applicable state and federal laws, and any other defenses, at law or in equity, that may now exist or in the future be available based on discovery and further factual investigation in this case.

REQUESTED RELIEF ON COUNTERCLAIMS

Stormseal respectfully requests this Court:

A. Dismiss all counts of the Counterclaims against Stormseal with prejudice and deny Structural Wrap any relief by way of its Counterclaims;

B. Enter a judgment that Stormseal has not infringed, does not infringe, does not induce infringement of, and does not contribute to the infringement of any valid and enforceable claim of the '312 Patent;

C. Award Stormseal attorney's fees under 35 U.S.C. § 285 along with Stormseal's costs; and

D. Award Stormseal such further relief as this Court may deem just and proper.

Dated: April 10, 2023

DUANE MORRIS LLP

By: /s/ Stephanie Vazquez

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CERTIFICATE OF SERVICE

I hereby certify that on April 10, 2023 a true and correct copy of the foregoing was filed electronically with the Clerk of the Court using the Case Management/Electronic Case Files (“CM/ECF”) System. Notice of this filing will be sent by operation of the Court’s electronic filing system to all parties indicated on the electronic filing receipts. Parties may access this filing through the Court’s system.

/s/ Stephanie Vazquez

Stephanie Vazquez