

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HILTI AKTIENGESELLSCHAFT,

Plaintiff,

v.

SPECIFIED TECHNOLOGIES INC.,

Defendant.

C.A. No. 1:22-cv-01248-CFC

**SPECIFIED TECHNOLOGIES, INC.’S ANSWER TO COMPLAINT FOR
PATENT INFRINGEMENT, DEFENSES, AND COUNTERCLAIMS**

Defendant Specified Technologies Inc. (“STI”) hereby answers the Complaint for Patent Infringement (“Complaint”) of Plaintiff Hilti Aktiengesellschaft (“Hilti”) as follows. Except as expressly alleged, averred, or admitted, STI denies each and every allegation of the Complaint.

RESPONSE TO INTRODUCTORY PARAGRAPH

1. STI admits that Hilti filed a Complaint for patent infringement against STI with a demand for a jury trial. STI denies that it has infringed any of Hilti’s asserted patents.

RESPONSE TO PARAGRAPH REGARDING NATURE OF THE ACTION

2. STI admits that Hilti’s Complaint asserts claims for patent infringement arising under the patent laws of the United States. The remainder of this paragraph

states legal conclusions that require no response. STI denies that it has infringed any of Hilti's asserted patents or that Hilti is entitled to any of the remedies specified under 35 U.S.C. §§ 281, 283-285, or under any other applicable provision or law.

RESPONSE TO PARAGRAPHS RELATING TO THE PARTIES

3. STI lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3.

4. STI lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 4.

5. STI admits the allegations of paragraph 5.

RESPONSE TO ALLEGATIONS REGARDING JURISDICTION AND VENUE

6. STI admits that this Court has original federal question jurisdiction over the subject matter of actions for patent infringement. STI otherwise denies that any patent infringement occurred, or that Hilti is entitled to any damages or relief in this action.

7. STI admits that it is incorporated in Delaware. STI denies that it has committed acts of patent infringement in Delaware or in any other State. The remainder of paragraph 7 states a legal conclusion that requires no response.

8. STI admits that it is incorporated in Delaware. The remainder of paragraph 8 states a legal conclusion that requires no response.

RESPONSE TO ALLEGATIONS REGARDING THE PATENTS-IN-SUIT

9. STI denies that Hilti is “a world leader and innovator across a variety of technical industries” and that Hilti has a “history of innovation.” STI admits that Hilti purports to own U.S. Patent Nos. 10,295,088, 10,663,090, 11,242,946, 10,267,036, 10,774,528, 10,641,417, 11,137,091, 10,596,399 and 10,610,711 (the “Patents-in-Suit”). STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 9.

10. STI admits that a document purporting to be U.S. Patent No. 10,295,088 (the “’088 Patent”) is attached to the Complaint as Exhibit 1 and that the face of the document indicates that it is titled “Device for Passing Pipes or Cables Through an Opening in a Building.” STI admits that the document indicates that the ’088 Patent issued on May 21, 2019, but denies that the ’088 Patent was duly and legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 10.

11. STI admits that a document purporting to be U.S. Patent No. 10,663,090 (the “’090 Patent”) is attached to the Complaint as Exhibit 2 and that the face of the document indicates that it is titled “Device for Passing Pipes or Cables Through an Opening in a Building.” STI admits that the document indicates that the ’090 Patent issued on May 26, 2020, but denies that the ’090 Patent was duly and

legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 11.

12. STI admits that a document purporting to be U.S. Patent No. 11,242,946 (the “’946 Patent”) is attached to the Complaint as Exhibit 3 and that the face of the document indicates that it is titled “Device for Passing Pipes or Cables Through an Opening in a Building.” STI admits that the document indicates that the ’946 Patent issued on February 26, 2022, but denies that the ’946 Patent was duly and legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 12.

13. STI admits that a document purporting to be U.S. Patent No. 10,267,036 (the “’036 Patent”) is attached to the Complaint as Exhibit 4 and that the face of the document indicates that it is titled “Universal Joint Sealing Tape for Different Profile Dimensions and Seal Arrangement Having Such a Joint Sealing Tape.” STI admits that the document indicates that the ’036 Patent issued on April 23, 2019, but denies that the ’036 Patent was duly and legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 13.

14. STI admits that a document purporting to be U.S. Patent No.

10,774,528 (the “’528 Patent”) is attached to the Complaint as Exhibit 5 and that the face of the document indicates that it is titled “Universal Joint Sealing Tape for Different Profile Dimensions and Seal Arrangement Having Such a Joint Sealing Tape.” STI admits that the document indicates that the ’528 Patent issued on September 15, 2020, but denies that the ’528 Patent was duly and legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 14.

15. STI admits that a document purporting to be U.S. Patent No. 10,641,417 (the “’417 Patent”) is attached to the Complaint as Exhibit 6 and that the face of the document indicates that it is titled “Fire Protection Sleeve.” STI admits that the document indicates that the ’417 Patent issued on May 5, 2020, but denies that the ’417 Patent was duly and legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 15.

16. STI admits that a document purporting to be U.S. Patent No. 11,137,091 (the “’091 Patent”) is attached to the Complaint as Exhibit 7 and that the face of the document indicates that it is titled “Fire Protection Sleeve.” STI admits that the document indicates that the ’091 Patent issued on October 5, 2021, but denies that the ’091 Patent was duly and legally issued by the United States Patent

and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 16.

17. STI admits that a document purporting to be U.S. Patent No. 10,596,399 (the “’399 Patent”) is attached to the Complaint as Exhibit 8 and that the face of the document indicates that it is titled “Firestop Collar.” STI admits that the document indicates that the ’399 Patent issued on March 24, 2020, but denies that the ’399 Patent was duly and legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 17.

18. STI admits that a document purporting to be U.S. Patent No. 10,610,711 (the “’711 Patent”) is attached to the Complaint as Exhibit 9 and that the face of the document indicates that it is titled “Firestop Collar.” STI admits that the document indicates that the ’711 Patent issued on April 7, 2020, but denies that the ’711 Patent was duly and legally issued by the United States Patent and Trademark Office. STI lacks knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 18.

RESPONSE TO COUNT ONE
(ALLEGED INFRINGEMENT OF THE ’088 PATENT)

19. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

20. STI denies the allegations of paragraph 20.

21. STI admits that paragraph 21 recites claim 1 of the '088 Patent.

22. STI denies the allegations of paragraph 22.

23. STI admits that Exhibit 10 is a copy of a product data sheet for the EZ Path® Series 44+ Fire Rated Pathway. STI further admits that Exhibit 10 states the following: “The EZ Path® Series 44+ Fire Rated Pathway is a pathway device designed to allow cables to penetrate fire-rated walls and floors without the need for firestopping. This device features a built-in fire and smoke sealing system that automatically adjusts to the amount of cables installed.”

24. STI admits that the image shown in paragraph 24 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway> and on the document attached to the Complaint as Exhibit 14. STI denies that it infringes or has ever infringed the '088 Patent.

25. STI admits that the image shown in paragraph 25 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI denies that it infringes or has ever infringed the '088 Patent.

26. STI admits that the image shown in paragraph 26 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI denies that it infringes or has ever infringed the '088 Patent.

27. STI admits that the image shown in paragraph 27 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI

denies that it infringes or has ever infringed the '088 Patent.

28. STI admits that the image shown in paragraph 28 appears on <https://www.stifirestop.com/ez-path> and on the document attached to the Complaint as Exhibit 15. STI denies that it infringes or has ever infringed the '088 Patent.

29. STI admits that the image shown in paragraph 29 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway> and on the document attached to the Complaint as Exhibit 14. STI denies that it infringes or has ever infringed the '088 Patent.

30. STI denies that it infringes or has ever infringed the '088 Patent. The remainder of the allegations of paragraph 30 require no response. To the extent a response is required, STI denies the allegations.

31. STI denies the allegations of paragraph 31.

32. STI denies the allegations of paragraph 32.

RESPONSE TO COUNT TWO
(ALLEGED INFRINGEMENT OF THE '090 PATENT)

33. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

34. STI denies the allegations of paragraph 34.

35. STI admits that paragraph 35 recites claim 1 of the '090 Patent.

36. STI denies the allegations of paragraph 36.

37. STI admits that the image shown in paragraph 37 appears on

<https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway> and on the document attached to the Complaint as Exhibit 14. STI denies that it infringes or has ever infringed the '090 Patent.

38. STI admits that the image shown in paragraph 38 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway> and on the document attached to the Complaint as Exhibit 14. STI denies that it infringes or has ever infringed the '090 Patent.

39. STI admits that the image shown in paragraph 39 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI denies that it infringes or has ever infringed the '090 Patent.

40. STI admits that the image shown in paragraph 40 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI denies that it infringes or has ever infringed the '090 Patent.

41. STI admits that the image shown in paragraph 41 appears on <https://www.stifirestop.com/ez-path> and on the document attached to the Complaint as Exhibit 15. STI denies that it infringes or has ever infringed the '090 Patent.

42. STI denies that it infringes or has ever infringed the '090 Patent. The remainder of the allegations of paragraph 42 require no response. To the extent a response is required, STI denies the allegations.

43. STI denies the allegations of paragraph 43.

44. STI denies the allegations of paragraph 44.

RESPONSE TO COUNT THREE
(ALLEGED INFRINGEMENT OF THE '946 PATENT)

45. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

46. STI denies the allegations of paragraph 46.

47. STI admits that paragraph 47 recites claim 1 of the '946 Patent.

48. STI denies the allegations of paragraph 48.

49. STI admits that the image shown in paragraph 49 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway> and on the document attached to the Complaint as Exhibit 14. STI denies that it infringes or has ever infringed the '946 Patent.

50. STI admits that the image shown in paragraph 50 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI denies that it infringes or has ever infringed the '946 Patent.

51. STI admits that the image shown in paragraph 51 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI denies that it infringes or has ever infringed the '946 Patent.

52. STI admits that the image shown in paragraph 52 appears on <https://www.stifirestop.com/products/ez-path-series-44-fire-rated-pathway>. STI denies that it infringes or has ever infringed the '946 Patent.

53. STI admits that the image shown in paragraph 53 appears on <https://www.stifirestop.com/ez-path> and on the document attached to the Complaint as Exhibit 15. STI denies that it infringes or has ever infringed the '946 Patent.

54. STI admits that the image shown in paragraph 54 appears on <https://www.stifirestop.com/ez-path>. STI denies that it infringes or has ever infringed the '946 Patent.

55. STI admits that the image shown in paragraph 55 appears on <https://www.stifirestop.com/ez-path>. STI denies that it infringes or has ever infringed the '946 Patent.

56. STI denies that it infringes or has ever infringed the '946 Patent. The remainder of the allegations of paragraph 56 require no response. To the extent a response is required, STI denies the allegations.

57. STI denies the allegations of paragraph 57.

58. STI denies the allegations of paragraph 58.

RESPONSE TO COUNT FOUR
(ALLEGED INFRINGEMENT OF THE '036 PATENT)

59. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

60. STI admits that paragraph 60 recites claim 1 of the '036 Patent. STI denies the remainder of the allegations of paragraph 60.

61. STI denies the allegations of paragraph 61.

62. STI admits that the document attached to the Complaint as Exhibit 11 includes the language quoted in paragraph 62.

63. STI admits that the document attached to the Complaint as Exhibit 11 includes the language quoted in paragraph 63. STI denies that it infringes or has ever infringed the '036 Patent.

64. STI admits that the image shown in paragraph 64 appears on <https://www.stifirestop.com/products/ttg-track-top-gasket> and on Exhibit 16. STI denies that it infringes or has ever infringed the '036 Patent.

65. STI admits that the image shown in paragraph 65 appears on <https://www.stifirestop.com/products/ttg-track-top-gasket>. STI denies that it infringes or has ever infringed the '036 Patent.

66. STI admits that the document attached to the Complaint as Exhibit 12 includes the language quoted in paragraph 66. STI denies that it infringes or has ever infringed the '036 Patent.

67. STI admits that the document attached to the Complaint as Exhibit 12 includes the language quoted in paragraph 67. STI denies that it infringes or has ever infringed the '036 Patent.

68. STI admits that the image shown in paragraph 68 appears on Exhibit 12 and that Exhibit 12 is titled "Technology Update." STI denies that it infringes or has ever infringed the '036 Patent.

69. STI denies that it infringes or has ever infringed the '036 Patent. The remainder of the allegations of paragraph 69 require no response. To the extent a response is required, STI denies the allegations.

70. STI denies the allegations of paragraph 70.

71. STI denies the allegations of paragraph 71.

RESPONSE TO COUNT FIVE
(ALLEGED INFRINGEMENT OF THE '528 PATENT)

72. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

73. STI denies the allegations of paragraph 73.

74. STI admits that paragraph 74 recites claim 1 of the '528 Patent.

75. STI denies the allegations of paragraph 75.

76. STI denies the allegations of paragraph 76.

77. STI admits that the document attached to the Complaint as Exhibit 11 includes the language quoted in paragraph 77. STI denies that it infringes or has ever infringed the '528 Patent.

78. STI admits that the image shown in paragraph 78 appears on <https://www.stifirestop.com/products/ttg-track-top-gasket> and on Exhibit 16.

79. STI admits that the image shown in paragraph 79 appears on <https://www.stifirestop.com/products/ttg-track-top-gasket>. STI denies that it infringes or has ever infringed the '528 Patent.

80. STI admits that the image shown in paragraph 80 appears on <https://www.stifirestop.com/products/ttg-track-top-gasket>. STI denies that it infringes or has ever infringed the '528 Patent.

81. STI admits that the document attached to the Complaint as Exhibit 12 includes the language quoted in paragraph 81 and is titled "Technology Update." STI further admits that the image shown in paragraph 81 appears on Exhibit 12. STI denies that it infringes or has ever infringed the '528 Patent.

82. STI admits that the document attached to the Complaint as Exhibit 12 includes the language quoted in paragraph 82 and is titled "Technology Update." STI denies that it infringes or has ever infringed the '528 Patent.

83. STI admits that the document attached to the Complaint as Exhibit 12 includes the language quoted in paragraph 83 and is titled "Technology Update." STI denies that it infringes or has ever infringed the '528 Patent.

84. STI admits that the image shown in paragraph 84 appears on Exhibit 12 and that Exhibit 12 is titled "Technology Update." STI denies that it infringes or has ever infringed the '528 Patent.

85. STI denies that it infringes or has ever infringed the '528 Patent. The remainder of the allegations of paragraph 85 require no response. To the extent a response is required, STI denies the allegations.

86. STI denies the allegations of paragraph 86.

87. STI denies the allegations of paragraph 87.

RESPONSE TO COUNT SIX
(ALLEGED INFRINGEMENT OF THE '417 PATENT)

88. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

89. STI denies the allegations of paragraph 89.

90. STI admits that paragraph 90 recites claim 1 of the '417 Patent.

91. STI denies the allegations of paragraph 91.

92. STI admits that the document attached to the Complaint as Exhibit 13 includes the language quoted in paragraph 92.

93. STI admits that the document attached to the Complaint as Exhibit 13 includes the language quoted in paragraph 93. STI denies that it infringes or has ever infringed the '417 Patent.

94. STI admits that the images shown in paragraph 94 appear in Exhibit 13 to the Complaint.

95. STI admits that the images shown in paragraph 95 appear in Exhibit 13 to the Complaint. STI denies that it infringes or has ever infringed the '417 Patent.

96. STI admits that the images shown in paragraph 96 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device> and on Exhibit 17 to the Complaint. STI denies that it infringes or has ever infringed the '417 Patent.

97. STI denies that it refers to the component Hilti characterizes as a

“bottom thin gray area” as an “intumescent curtain.” STI admits that the accused Retrofit Device includes a reciprocal component to the portion Hilti characterizes as a “bottom thin gray area” that is not depicted in the Complaint. STI denies that it infringes or has ever infringed the ’417 Patent.

98. STI admits that the images shown in paragraph 98 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’417 Patent.

99. STI denies that it refers to the component Hilti characterizes as a “bottom thin gray area” as an “intumescent curtain.” STI admits that the accused Retrofit Device includes a reciprocal component to the portion Hilti characterizes as a “bottom thin gray area” that is not depicted in the Complaint. STI denies that it infringes or has ever infringed the ’417 Patent.

100. STI admits that the images shown in paragraph 100 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’417 Patent.

101. STI admits that the images shown in paragraph 101 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’417 Patent.

102. STI admits that the images shown in paragraph 102 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it

infringes or has ever infringed the '417 Patent.

103. STI admits that the images shown in paragraph 103 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the '417 Patent.

104. STI admits that the images shown in paragraph 104 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the '417 Patent.

105. STI admits that the document attached to the Complaint as Exhibit 13 includes the language quoted in paragraph 105. STI denies that it infringes or has ever infringed the '417 Patent.

106. STI denies that it infringes or has ever infringed the '417 Patent. The remainder of the allegations of paragraph 106 require no response. To the extent a response is required, STI denies the allegations.

107. STI denies the allegations of paragraph 107.

108. STI denies the allegations of paragraph 108.

RESPONSE TO COUNT SEVEN
(ALLEGED INFRINGEMENT OF THE '091 PATENT)

109. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

110. STI denies the allegations of paragraph 110.

111. STI admits that paragraph 111 recites claim 1 of the '091 Patent.

112. STI denies the allegations of paragraph 112.

113. STI admits that the document attached to the Complaint as Exhibit 13 includes the language quoted in paragraph 113. STI denies that it infringes or has ever infringed the '091 Patent.

114. STI admits that the images shown in paragraph 114 appear in Exhibit 13 to the Complaint.

115. STI admits that the images shown in paragraph 115 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device> and on Exhibit 17 to the Complaint. STI denies that it infringes or has ever infringed the '091 Patent.

116. STI denies that it refers to the component Hilti characterizes as a “bottom thick gray area” as a “leakage block.” STI admits that the accused Retrofit Device includes a reciprocal component to the portion Hilti characterizes as a “bottom thick gray area” that is not depicted in the Complaint. STI denies that it infringes or has ever infringed the '091 Patent.

117. STI admits that the images shown in paragraph 117 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the '091 Patent.

118. STI denies that it refers to the component Hilti characterizes as a “bottom thin gray area” as an “intumescent curtain.” STI admits that the accused Retrofit Device includes a reciprocal component to the portion Hilti characterizes as

a “bottom thin gray area” that is not depicted in the Complaint. STI denies that it infringes or has ever infringed the ’091 Patent.

119. STI admits that the images shown in paragraph 119 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’091 Patent.

120. STI admits that the images shown in paragraph 120 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’091 Patent.

121. STI admits that the images shown in paragraph 121 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’091 Patent.

122. STI admits that the images shown in paragraph 122 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’091 Patent.

123. STI admits that the images shown in paragraph 123 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’091 Patent.

124. STI admits that the document attached to the Complaint as Exhibit 13 includes the language quoted in paragraph 124. STI denies that it infringes or has ever infringed the ’091 Patent.

125. STI denies that it infringes or has ever infringed the '091 Patent. The remainder of the allegations of paragraph 125 require no response. To the extent a response is required, STI denies the allegations.

126. STI denies the allegations of paragraph 126.

127. STI denies the allegations of paragraph 127.

RESPONSE TO COUNT EIGHT
(ALLEGED INFRINGEMENT OF THE '399 PATENT)

128. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

129. STI denies the allegations of paragraph 129.

130. STI admits that paragraph 130 recites claim 1 of the '399 Patent.

131. STI denies the allegations of paragraph 131.

132. STI admits that the document attached to the Complaint as Exhibit 13 includes the language quoted in paragraph 132. STI denies that it infringes or has ever infringed the '399 Patent.

133. STI admits that the images shown in paragraph 133 appear in Exhibit 13 to the Complaint.

134. STI admits that the images shown in paragraph 134 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device> and on Exhibit 17 to the Complaint. STI denies that it infringes or has ever infringed the '399 Patent.

135. STI denies that it refers to the component Hilti characterizes as a

“bottom thin gray area” as an “intumescent curtain.” STI admits that the accused Retrofit Device includes a reciprocal component to the portion Hilti characterizes as a “bottom thin gray area” that is not depicted in the Complaint. STI denies that it infringes or has ever infringed the ’399 Patent.

136. STI admits that the images shown in paragraph 136 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the ’399 Patent.

137. STI admits that the images shown in paragraph 137 appear on Exhibit 13 to the Complaint. STI denies that it infringes or has ever infringed the ’399 Patent.

138. STI admits that the images shown in paragraph 138 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device> and on Exhibit 17 to the Complaint. STI denies that it infringes or has ever infringed the ’399 Patent.

139. STI admits that the document attached to the Complaint as Exhibit 18 is an installation guide for the EZ Path® Retrofit Device (including model numbers EZDR200 and EZDR400). STI further admits that the images shown in paragraph 139 appear on Exhibit 18. STI denies that it infringes or has ever infringed the ’399 Patent.

140. STI admits that the images shown in paragraph 140 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device> and on Exhibit 17 to

the Complaint. STI denies that it infringes or has ever infringed the '399 Patent.

141. STI admits that the document attached to the Complaint as Exhibit 18 is an installation guide for the EZ Path® Retrofit Device (including model numbers EZDR200 and EZDR400). STI further admits that the images shown in paragraph 141 appear on Exhibit 18. STI denies that it infringes or has ever infringed the '399 Patent.

142. STI admits that the images shown in paragraph 142 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device> and on Exhibit 17 to the Complaint. STI denies that it infringes or has ever infringed the '399 Patent.

143. STI denies that it refers to the component Hilti characterizes as a “bottom thin gray area” as an “intumescent curtain.” STI admits that the accused Retrofit Device includes a reciprocal component to the portion Hilti characterizes as a “bottom thin gray area” that is not depicted in the Complaint. STI denies that it infringes or has ever infringed the '399 Patent.

144. STI denies that it infringes or has ever infringed the '399 Patent.

145. STI admits that the images shown in paragraph 145 appear on <https://www.stifirestop.com/products/ez-path-retrofit-device>. STI denies that it infringes or has ever infringed the '399 Patent.

146. STI denies that it infringes or has ever infringed the '399 Patent.

147. STI admits that the document attached to the Complaint as Exhibit 19

is a copy of a Product Data Sheet for the EZ Path® Cable Tray Retrofit Device. STI denies that paragraph 147 accurately quotes from Exhibit 19.

148. STI admits that the language quoted in paragraph 148 appears on <https://www.stifirestop.com/products/ez-path-cable-tray-retrofit-device> and on the document attached to the Complaint as Exhibit 20. STI denies that it infringes or has ever infringed the '399 Patent.

149. STI admits that the images shown in paragraph 149 appear on Exhibit 19.

150. STI admits that the language quoted in paragraph 150 appears on the document attached to the Complaint as Exhibit 19. STI denies that it infringes or has ever infringed the '399 Patent.

151. STI admits that the video at <https://youtu.be/Q8GWNhw-yrM> states “Insert intumescent foam center piece” at 42 seconds into the video. STI denies that it infringes or has ever infringed the '399 Patent.

152. STI admits that the image shown in paragraph 152 appears on <https://www.stifirestop.com/products/ez-path-cable-tray-retrofit-device> and on the document attached to the Complaint as Exhibit 20. STI denies that it infringes or has ever infringed the '399 Patent.

153. STI admits that the language quoted in paragraph 153 appears in the document attached to the Complaint as Exhibit 19. STI further admits that the

images shown in paragraph 153 appear on the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '399 Patent.

154. STI admits that the image shown in paragraph 154 appears in the video at <https://youtu.be/Q8GWNhw-yrM> at 47 seconds into the video. STI denies Hilti's allegations regarding the contents of the video at 0:45-0:56, as the video depicts a computer generated animation rather than an actual Cable Tray Retrofit Device. By way of further response, STI denies that it infringes or has ever infringed the '399 Patent.

155. STI admits that the images shown in paragraph 155 appear on the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '399 Patent.

156. STI admits that the images shown in paragraph 156 appear on the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '399 Patent.

157. STI admits that the language quoted in paragraph 157 appears in the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '399 Patent.

158. STI admits that the images shown in paragraph 158 appear on the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '399 Patent.

159. STI admits that the image shown in paragraph 159 appears on <https://www.stifirestop.com/products/ez-path-cable-tray-retrofit-device> and on the document attached to the Complaint as Exhibit 20. STI denies that it infringes or has ever infringed the '399 Patent.

160. STI denies that it infringes or has ever infringed the '399 Patent. The remainder of the allegations of paragraph 160 require no response. To the extent a response is required, STI denies the allegations.

161. STI denies the allegations of paragraph 161.

162. STI denies the allegations of paragraph 162.

RESPONSE TO COUNT NINE
(ALLEGED INFRINGEMENT OF THE '711 PATENT)

163. STI repeats and incorporates by reference its responses to paragraphs 1-18 above as if fully set forth herein.

164. STI denies the allegations of paragraph 164.

165. STI admits that paragraph 165 recites claim 1 of the '711 Patent.

166. STI denies the allegations of paragraph 166.

167. STI admits that the language quoted in paragraph 167 appears on <https://www.stifirestop.com/products/ez-path-cable-tray-retrofit-device> and on the document attached to the Complaint as Exhibit 20. STI denies that it infringes or has ever infringed the '711 Patent.

168. STI admits that the images shown in paragraph 168 appear on Exhibit

19.

169. STI admits that the image shown in paragraph 169 appears on <https://www.stifirestop.com/products/ez-path-cable-tray-retrofit-device> and on the document attached to the Complaint as Exhibit 20. STI denies that it infringes or has ever infringed the '711 Patent.

170. STI admits that the language quoted in paragraph 170 appears on the document attached to the Complaint as Exhibit 19. STI denies that it infringes or has ever infringed the '711 Patent.

171. STI admits that the video at <https://youtu.be/Q8GWNhw-yrM> states “Insert intumescent foam center piece” at 42 seconds into the video. STI denies that it infringes or has ever infringed the '711 Patent.

172. STI admits that the language quoted in paragraph 172 appears in the document attached to the Complaint as Exhibit 19. STI further admits that the images shown in paragraph 172 appear on the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '711 Patent.

173. STI admits that the image shown in paragraph 173 appears in the video at <https://youtu.be/Q8GWNhw-yrM> at 47 seconds into the video. STI denies Hilti's allegations regarding the contents of the video at 0:45-0:56, as the video depicts a computer generated animation rather than an actual Cable Tray Retrofit Device. By way of further response, STI denies that it infringes or has ever infringed the '711

Patent.

174. STI admits that the images shown in paragraph 174 appear on the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '711 Patent.

175. STI admits that the language quoted in paragraph 175 appears in the document attached to the Complaint as Exhibit 21. STI denies that it infringes or has ever infringed the '399 Patent.

176. STI admits that the image shown in paragraph 176 appears in the video at <https://youtu.be/Q8GWNhw-yrM> at 47 seconds into the video. STI denies Hilti's allegations regarding the contents of the video at 0:45-0:56, as the video depicts a computer generated animation rather than an actual Cable Tray Retrofit Device. By way of further response, STI denies that it infringes or has ever infringed the '711 Patent.

177. STI admits that the image shown in paragraph 177 appears on <https://www.stifirestop.com/products/ez-path-cable-tray-retrofit-device> and on the document attached to the Complaint as Exhibit 20. STI denies that it infringes or has ever infringed the '711 Patent.

178. STI denies that it infringes or has ever infringed the '711 Patent. The remainder of the allegations of paragraph 178 require no response. To the extent a response is required, STI denies the allegations.

179. STI denies the allegations of paragraph 179.

180. STI denies the allegations of paragraph 180.

RESPONSE TO HILTI'S PRAYER FOR RELIEF

Defendants deny that Hilti is entitled to any of the relief it is seeking in this action.

JURY DEMAND

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, STI hereby respectfully requests a trial by jury of all issues so triable.

DEFENSES

STI, while reserving its rights to assert other applicable defenses as this action proceeds, presently asserts the following defenses to the Complaint.

FIRST DEFENSE

(Failure to State a Cause of Action)

1. The Complaint fails to state a claim upon which relief can be granted.

SECOND DEFENSE

(Failure to Name Inventors)

2. Plaintiff has failed to name all inventors of the Patents-in-Suit, thereby rendering them invalid.

THIRD DEFENSE

(Non-Infringement)

3. Defendants have not infringed, willfully or otherwise, directly or indirectly, any valid claim of the Patents-in-Suit.

FOURTH DEFENSE
(Invalidity)

4. One or more claims of the Patents-in-Suit are invalid for failure to comply with the statutory requirements for valid patents, namely Title 35 of the United States Code, including but not limited to §§ 102, 103, and/or 112. Additional grounds for invalidity are set forth in greater detail in Counts 1-9 of the Counterclaims below.

FIFTH DEFENSE
(Prosecution History Estoppel and/or Prosecution Disclaimer)

5. Hilti's claims are barred in whole or in part by the doctrines of prosecution history estoppel and/or prosecution disclaimer because of admissions, amendments, arguments, or statements made to the United States Patent and Trademark Office during the prosecution of the applications leading to, or related to, the issuance of the Patents-in-Suit.

SIXTH DEFENSE
(Ensnarement)

6. To the extent Hilti alleges that the claims of the Patents-in-Suit are infringed under the doctrine of equivalents, such a position would ensnare the prior art, including but not limited to the prior art references discussed in Counts 1-9 of the Counterclaims below.

SEVENTH DEFENSE
(Unclean Hands)

7. Hilti is barred from receiving some or all of the relief sought by reason of the doctrine of unclean hands.

EIGHTH DEFENSE
(Right to Assert Additional Defenses)

8. STI presently has insufficient knowledge or information on which to form a belief as to whether there may be additional, as yet unstated, defenses. Thus, subject to discovery in this action, STI expressly reserves its right to assert additional defenses as appropriate.

PRAYER FOR RELIEF

WHEREFORE, STI respectfully prays the Court grant the following relief:

- (1) That Hilti take nothing by its suit;
- (2) That judgment be entered in favor of STI;
- (3) That the Patents-in-Suit be declared not infringed, invalid and/or unenforceable;
- (4) That the Court finds this to be an exceptional case;
- (5) That STI be awarded its costs of suit, including reasonable attorneys' fees under 35 U.S.C. § 285 and/or to the extent permissible by law; and that STI be awarded such other and further relief as the Court may deem just and proper.

COUNTERCLAIMS

THE PARTIES

1. Counterclaimant Specified Technologies Inc. (“STI”) is a corporation organized and existing under the laws of the State of Delaware with headquarters located at 210 Evans Way, Somerville, New Jersey 08876.

2. Upon information and belief, as alleged in the original Complaint, Counterdefendant Hilti Aktiengesellschaft (“Hilti”) is a corporation organized under the laws of Liechtenstein, with its principal place of business at Feldkircherstrasse 100, P.O. Box 333, 9494 Schaan, Principality of Liechtenstein.

JURISDICTION AND VENUE

3. These Counterclaims arise under the patent laws of the United States, 35 U.S.C. § 101 *et seq.* This Court has subject matter jurisdiction over the Counterclaims pursuant to 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

4. This Court has personal jurisdiction over Hilti, and venue is proper in this Judicial District, because Hilti has invoked the jurisdiction of this Court by filing its original Complaint in this Court. Moreover, upon information and belief, Hilti purposefully directs its activities toward this forum. Hilti markets, advertises, offers to sell, sells and distributes infringing products, as described below, throughout the United States, including the District of Delaware. In addition, venue is proper in this District pursuant to 28 U.S.C. § 1391. *See* 28 U.S.C. § 1391(c)(3)

("[A] defendant not resident in the United States may be sued in any judicial district....").

BACKGROUND

A. STI's History of Innovation and Issued U.S. Patents

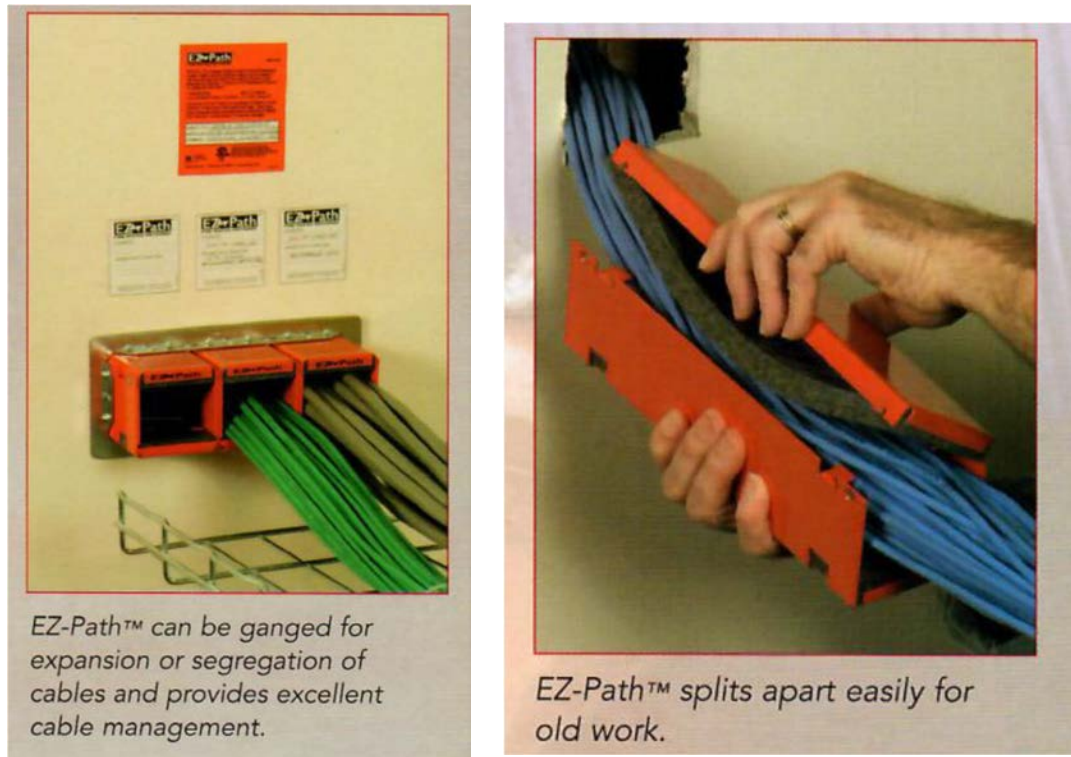
5. STI was founded in a garage in New Jersey in 1990 by Charbel H. Tagher and the late James Stahl Sr., with Mr. Tagher primarily running the business side of the operation and Mr. Stahl primarily providing the engineering know-how. Mr. Tagher continues to manage STI as its President, alongside James Stahl Sr.'s son, James P. Stahl Jr., who currently serves as VP & General Manager, Engineering & Emerging Businesses. See Declaration of James P. Stahl Jr. ("Stahl Decl.") (attached as Exhibit 1), ¶ 4.

6. STI develops fire protection systems that help stop the spread of fire, smoke, and hot gases. For over 30 years, STI's team has worked with the construction industry to create solutions to firestopping problems—for example, STI's SpecSeal® and EZ Path® product lines. STI's products and systems offer firestop solutions for all types of new construction and retrofit applications. See Stahl Decl. (Ex. 1), ¶¶ 3, 5.

7. STI released the first generation of its EZ Path® Fire-Rated Pathway device in 2002. Since then, STI has continued to refine its fire-rated cable pathway devices. Attached as Exhibit 2 is a true and correct copy of an STI document titled

“Evolution of Cable Firestopping.” *See also* Stahl Decl. (Ex. 1), ¶¶ 9, 10.

8. Some of the earliest versions of STI’s EZ Path® product are featured in STI’s brochures from 2003:



See Exhibit 41 (2003 STI Brochure). This early EZ Path® product is similar in many ways to the current version of the EZ Path®, which Hilti alleges infringes the asserted '088, '090, and '946 Patents.

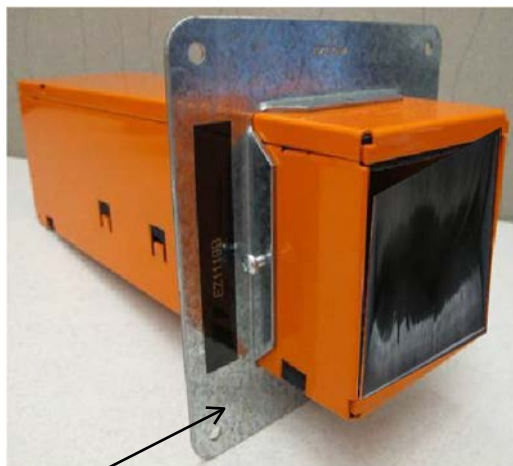
9. STI owns numerous foreign and U.S. patents that cover its products. For example, some of STI’s earliest patents directed to its early firestopping devices include U.S. Patent No. 6,732,471, “Intumescent Firestopping Apparatus,” which issued on May 11, 2004, and U.S. Patent No. 7,373,761, “Self-Adjusting

Intumescent Firestopping Apparatus,” which issued on May 20, 2008.

10. Throughout the years, STI has continued to use the U.S. patent system to protect its inventions. For example, on October 13, 2015, the U.S. Patent & Trademark Office granted U.S. Patent No. 9,157,232, titled “Adjustable Head-of-Wall Insulation Construction for Use with Wider Wall Configurations.” And on December 4, 2018, the U.S. Patent & Trademark Office issued U.S. Patent No. 10,143,868, titled “Cable Firestopping Apparatus.” As discussed further below, Hilti infringes these patents by making, using, selling, offering for sale, and/or importing various accused products, including its CFS-TTS Firestop Top Track Seal and CFS-MSL Modular Fire Sleeve products.

B. STI’s Sales of Prior Art Products in 2012 and 2013

11. In 2012, STI began selling a product called the EZD44T, the “European EZ Path 44+.” The European EZ Path 44+ is shown below:



See Exhibit 3 (11/6/12 PowerPoint “EZD44T Quality Control Procedure”); Stahl

Decl. (Ex. 1), ¶¶ 12, 13.

12. Significantly, as discussed in detail in Counterclaim Counts 1-3 below, this European EZ Path 44+ product had nearly identical components as the accused EZ Path product that Hilti alleges are covered by claim 1 of the '088 Patent, '090 Patent, and '946 Patent. Stahl Decl. (Ex. 1), ¶ 14.

13. An invoice dated November 30, 2012 shows sales of the European EZ Path 44+ product. A true and correct copy of this November 30, 2012 invoice is attached hereto as Exhibit 4. See also Stahl Decl. (Ex. 1), ¶ 15. Because the European EZ Path 44+ product was sold before December 9, 2013, the earliest priority date¹ of the '088 Patent, '090 Patent, and '946 Patent, it is prior art to those patents.

14. In addition, in 2013, STI began selling a product called the EZ Path Marine MDM300 ("Marine 300") and EZ Path Marine MDM400 ("Marine 400"). The Marine 300 and Marine 400 products are shown below:

¹ References herein to the "earliest priority date(s)" or "priority date(s)" of the Hilti Patents-in-Suit are in no way to be construed as admissions that the Hilti Patents-in-Suit are actually entitled to those priority dates. Rather, STI uses the terms "earliest priority date(s)" and "priority date(s)" herein for the sake of convenience, simply to refer to the earliest identified priority date(s) on the various applications and their lineage Hilti may claim to be entitled to.



See Exhibit 5 (May 2013 STI Marine Firestop brochure); Stahl Decl. (Ex. 1), ¶ 16.

15. Significantly, as discussed in detail in Counterclaim Counts 1-3 below, the Marine 300 and Marine 400 products had nearly identical components as the accused EZ Path product that Hilti alleges is covered by claim 1 of the '088 Patent, '090 Patent, and '946 Patent. Stahl Decl. (Ex. 1), ¶ 18.

16. An invoice dated June 28, 2013 shows sales of the STI Marine 300 and Marine 400 products. A true and correct copy of this June 28, 2013 invoice is attached hereto as Exhibit 6. See also Stahl Decl. (Ex. 1), ¶ 19. Because the Marine 300 and Marine 400 products were sold before December 9, 2013, the earliest priority date of the '088 Patent, '090 Patent, and '946 Patent, they are prior art to those patents.

17. Therefore, as explained further below in Counterclaim Counts 1-3, the asserted claims of the '088 Patent, '090 Patent, and '946 Patent are invalid under 35 U.S.C. § 102 because the claimed invention was on sale, actually sold, described

in printed publications, in public use, and/or were otherwise available to the public before the earliest priority date of those patents. Simply put, STI did it first.

Count 1: Declaration of Invalidity of U.S. Patent No. 10,295,088

18. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

19. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '088 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '088 Patent is valid, and specifically alleges that STI infringes claim 1 of the '088 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Series 44+ Fire Rated Pathway (the "EZ Path Pathway"). STI contends that each asserted claim of the '088 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

20. The '088 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

A) The '088 Patent is invalid under 35 U.S.C. § 102 – on sale bar, printed publication, public use.

21. At least claim 1 of the '088 Patent is invalid under 35 U.S.C. § 102 because STI's Marine 300, Marine 400, and European EZ Path 44+ products were

on sale, actually sold, described in printed publications, in public use, and/or were otherwise available to the public before December 9, 2013, the earliest priority date of the '088 Patent.

22. As explained above in paragraphs 11-17, the Marine 300, Marine 400, and European EZ Path 44+ products are prior art to the '088 Patent because they were sold before December 9, 2013, the earliest priority date of the '088 Patent. See Exhibit 4 (11/30/12 invoice) and Exhibit 6 (6/28/13 invoice); see also Stahl Decl. (Ex. 1), ¶¶ 12, 16.

23. As discussed further below, the Marine 300, Marine 400, and European EZ Path 44+ products that STI sold in 2012 and 2013 have nearly identical components as the accused EZ Path product that Hilti alleges are covered by claim 1 of the '088 Patent. See Stahl Decl. (Ex. 1), ¶¶ 14, 18. Any minor differences between the components of STI's prior art products and the accused EZ Path product are insignificant and have no bearing on the question of whether STI's prior art products anticipate claim 1 of the '088 Patent or on whether they invalidate any other asserted patent claim.

24. Claim 1 of the '088 Patent recites:

1. A device, comprising:

a sleeve-like housing comprising a passage channel that is open at opposite ends;

a curtain extending inwards from a wall of the passage channel; and

a flexible material mounted in the passage channel at a location spaced from the curtain and coated with an intumescent material, wherein the device is suitable for passing a pipe or cable through an opening in a building and the curtain at least partially bends in a through-direction of the passage channel when a pipe or cable is in the device, and wherein the curtain comprises at least one selected from the group consisting of an inorganic fiber and an organic fiber.

25. Based on the below image, Hilti alleges that “the EZ Path Pathway is a device” that “includes a sleeve-like housing comprising a passage channel that is open at opposite ends, namely the orange galvanized steel pathway shown in the below image”:



See Complaint ¶¶ 24-25.

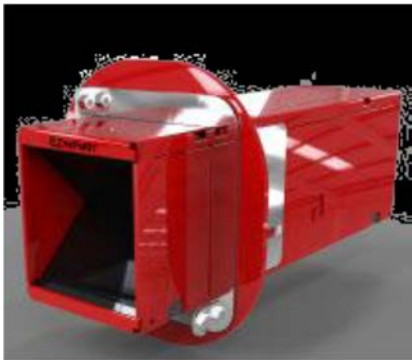
26. Given Hilti’s allegation that the accused EZ Path product practices these limitations of claim 1 of the ’088 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice these limitations.

27. For example, the STI Marine Firestop brochure, dated May 2013, includes photographs of the Marine 300 and Marine 400 products that are virtually

identical to the photograph of the accused EZ Path product that Hilti included in paragraphs 24-25 of its Complaint:



Compare Complaint ¶ 24 and May 2013 STI Marine Firestop brochure:

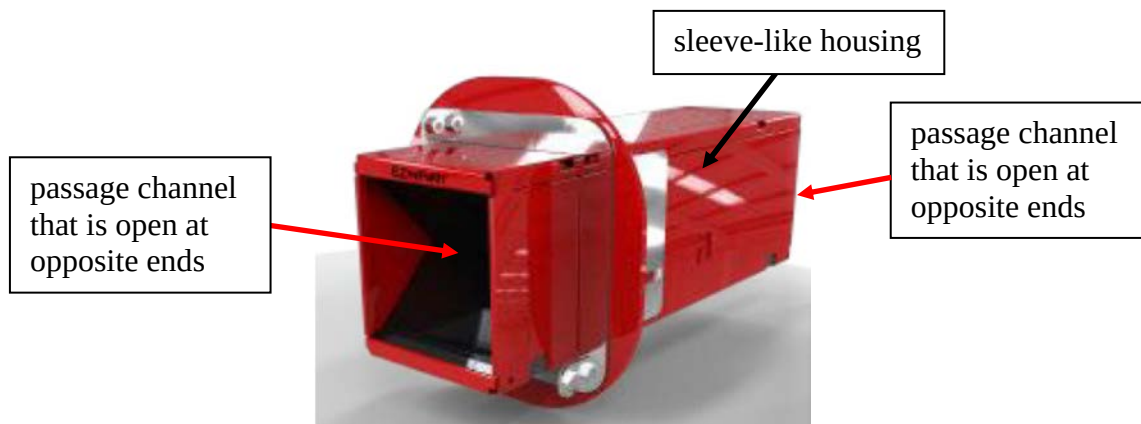
Complaint ¶ 24 (accused EZ Path)	Prior art Marine 300/400 product shown in May 2013 STI Marine Firestop brochure
	

A true and correct copy of the May 2013 STI Marine Firestop brochure is attached hereto as Exhibit 5. See also Stahl Decl. (Ex. 1), ¶ 17.

28. The May 2013 STI Firestop Brochure was publicly available in or

around May 2013. Printed copies of the May 2013 STI Firestop Brochure were circulated to more than 1,000 of STI's customers and potential customers before December 2013. Stahl Decl. (Ex. 1), ¶ 17.

29. The below photo from the May 2013 STI Marine Firestop brochure (with added annotations) identifies the features of the Marine 300 and Marine 400 products that correspond to these elements of claim 1 of the '088 Patent according to Hilti's apparent understanding of the claim:



See Exhibit 5 (May 2013 Marine Firestop brochure).

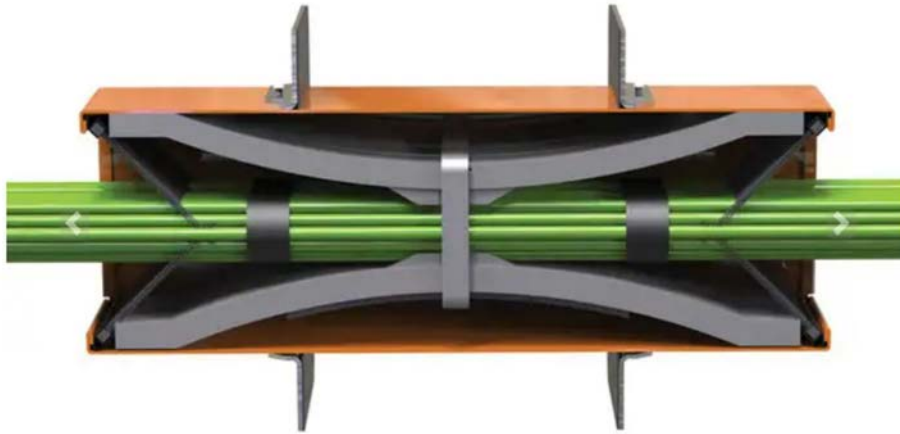
30. In addition, a PowerPoint presentation dated November 6, 2012, titled “EZD44T Quality Control Procedure,” includes photographs of the European EZ Path 44+ product that are virtually identical to the photograph of the accused EZ Path product that Hilti included in paragraphs 24-25 of its Complaint:

Complaint ¶ 24 (accused EZ Path)	Prior art European EZ Path 44+ product shown in 11/6/12 PowerPoint
	

A true and correct copy of the November 6, 2012 PowerPoint presentation titled “EZD44T Quality Control Procedure” is attached hereto as Exhibit 3. *See also* Stahl Decl. (Ex. 1), ¶ 13.

31. Therefore, to the extent the accused EZ Path product is a “device” that “includes a sleeve-like housing comprising a passage channel that is open at opposite ends,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily are also devices that “include[] a sleeve-like housing comprising a passage channel that is open at opposite ends.”

32. Based on the below image, Hilti alleges that “the EZ Path Pathway includes a curtain extending inwards from a wall of the passage channel, namely the two brushes on the left and/or right side of the housing shown in the below image”:

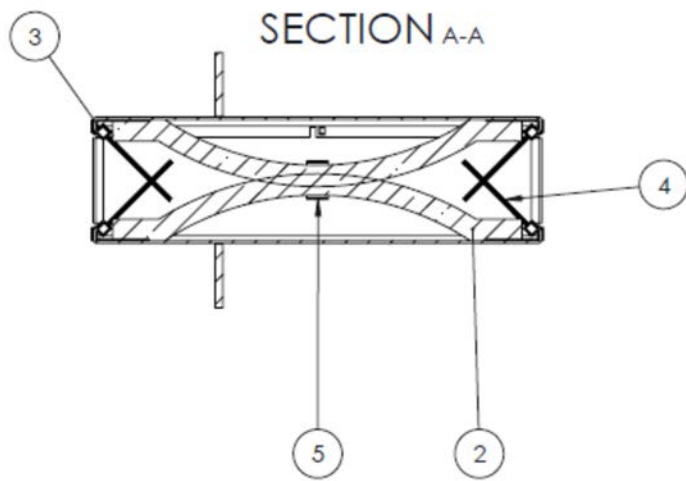


See Complaint ¶ 26.

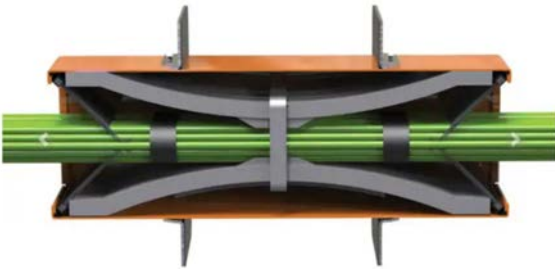
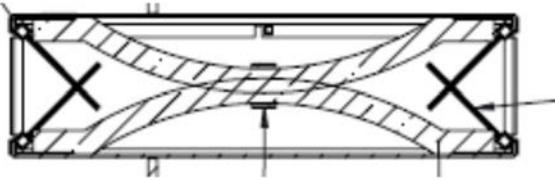
33. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’088 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

34. The below image is an excerpt from an engineering drawing of the Marine 300 product dated August 13, 2013. The engineering drawing accurately depicts the Marine 300 product that was sold prior to December 9, 2013. See Stahl Decl. (Ex. 1), ¶ 20. The cross section of the Marine 300 product shown in this August 2013 engineering drawing is nearly identical to the cross section of the

accused EZ Path product shown in paragraph 26 of Hilti's Complaint.



Compare Complaint ¶ 26 and 8/13/13 engineering drawing:

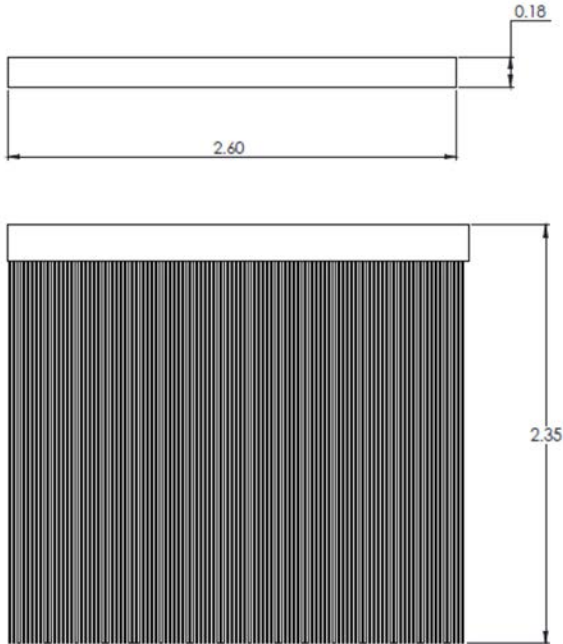
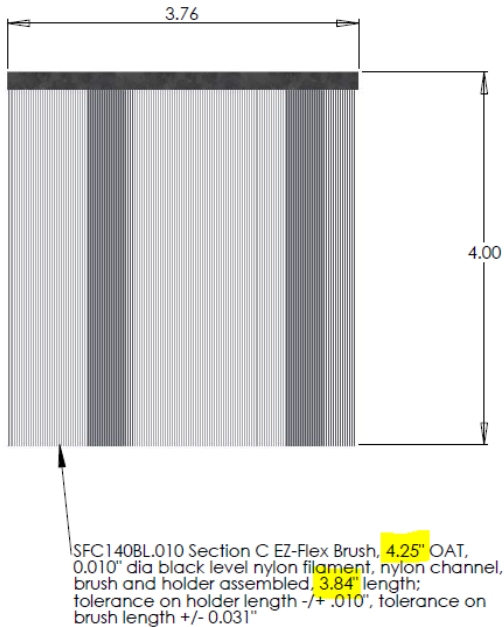
Complaint ¶ 26 (accused EZ Path)	Prior art Marine 300 product shown in 8/13/13 engineering drawing
	

A true and correct copy of the August 13, 2013 engineering drawing of the Marine 300 product is attached hereto as Exhibit 7.

35. Item number 4 in the August 13, 2013 engineering drawing corresponds to part number MP1711, "EZ Flex Section C Brush - 2.35" OAT, 2.60" length, 0.010" diam black nylon filament, nylon channel." Apart from very minor

differences in size, these brushes on the Marine 300 product are otherwise identical to the brushes of the accused EZ Path product that Hilti alleges are “curtain[s] extending inwards from a wall of the passage channel.” See Exhibit 7; Stahl Decl. (Ex. 1), ¶ 21.

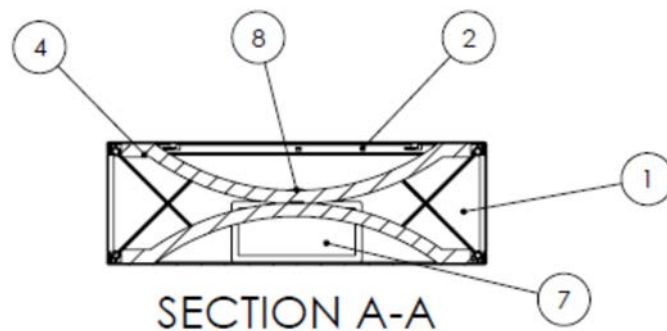
36. The part number of the brush on the accused EZ Path is MP1354, as shown on Exhibit 44. The engineering drawings of the brushes show the minor differences in dimensions between the Marine 300 brushes (part number MP1711 – Exhibit 43, p. 2) and the accused EZ Path brushes (part number MP1354 – Exhibit 43, p. 1), as illustrated and highlighted below:

Marine 300 brushes, Part No. MP1711 (Exhibit 43, p. 2)	Accused EZ Path brushes, Part No. MP1354 (Exhibit 43, p. 1)
	

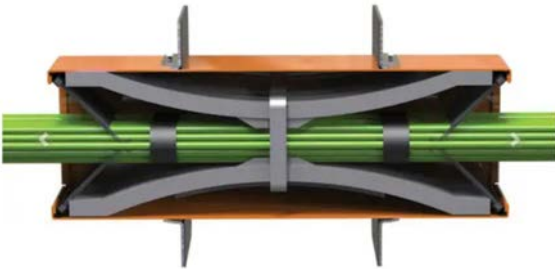
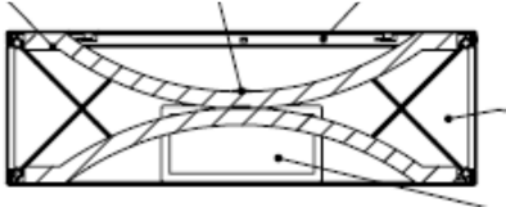
See Exhibit 43; Exhibit 44; Stahl Decl. (Ex. 1), ¶ 21.

37. The Marine 300 and accused EZ Path products have brushes of slightly different sizes because the products differ slightly in size; the accused EZ Path is a larger device than the Marine 300. The brushes are scaled to fit the size of the particular product. Apart from being slightly different in size, the brushes on the Marine 300 and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 21.

38. The below image is an excerpt from an engineering drawing of the Marine 400 product dated March 1, 2013. The engineering drawing accurately depicts the Marine 400 product that was sold prior to December 9, 2013. See Stahl Decl. (Ex. 1), ¶ 24. The cross section of the Marine 400 product shown in this March 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 26 of Hilti's Complaint.



Compare Complaint ¶ 26 and 3/1/13 engineering drawing:

Complaint ¶ 26 (accused EZ Path)	Prior art Marine 400 product shown in 3/1/13 engineering drawing
	

A true and correct copy of the March 1, 2013 engineering drawing of the Marine 400 product is attached hereto as Exhibit 8.

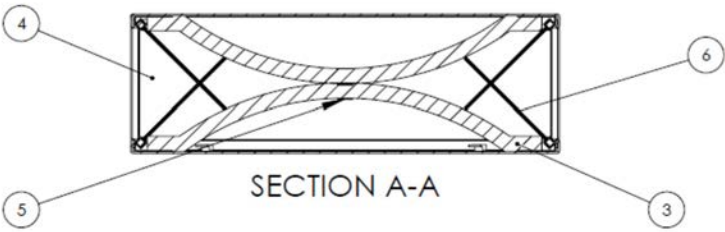
39. The image below is another excerpt from the March 2013 engineering drawing of the Marine 400 product.



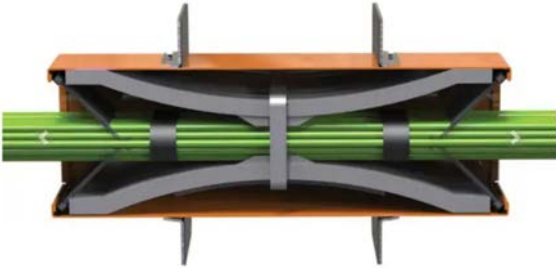
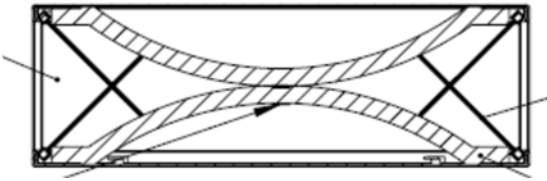
Item number 5 on the drawing corresponds to part number MP1354, “EZ Flex Section C Brush - 4.25" OAT, 3.84" length, 0.010" diam black nylon filament, nylon channel.” These brushes on the Marine 400 product have the same part number as, and are identical to, the brush of the accused EZ Path product that Hilti alleges is a “curtain extending inwards from a wall of the passage channel.” As shown on the engineering drawing of the accused EZ Path (Exhibit 44), the brush also has part

number MP1354. See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); Exhibit 44; Stahl Decl. (Ex. 1), ¶ 25.

40. The below image is an excerpt from an engineering drawing of the European EZ Path 44+ product dated September 12, 2012. The engineering drawing accurately depicts the European EZ Path 44+ product that was sold prior to December 9, 2013. See Stahl Decl. (Ex. 1), ¶ 27. The cross section of the European EZ Path 44+ product shown in this September 2012 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 26 of Hilti’s Complaint.



Compare Complaint ¶ 26 and 9/12/12 engineering drawing:

Complaint ¶ 26 (accused EZ Path)	Prior art European EZ Path 44+ product shown in 9/12/12 engineering drawing
	

A true and correct copy of the engineering drawing of the European EZ Path 44+ product dated September 12, 2012 is attached hereto as Exhibit 9.

41. Item number 6 in the September 12, 2012 engineering drawing corresponds to part number MP1354, “EZ Flex Section C Brush - 4.25" OAT, 3.84" length, 0.010" diam black nylon filament, nylon channel.” See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012). These brushes on the European EZ Path 44+ product have the same part number as, and are identical to, the brush of the accused EZ Path product that Hilti alleges is a “curtain extending inwards from a wall of the passage channel.” As shown on the engineering drawing of the accused EZ Path (Exhibit 44), the brush also has part number MP1354. See Exhibit 9; Exhibit 44; Stahl Decl. (Ex. 1), ¶ 28.

42. In addition, the photograph below is from a 2013 PowerPoint presentation pertaining to the European EZ Path 44+ product. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “curtain extending inwards from a wall of the passage channel” in paragraph 26 of its Complaint.



A true and correct copy of the EZ PATH 44T 2013 PowerPoint is attached hereto as Exhibit 10; Stahl Decl. (Ex. 1), ¶ 30.

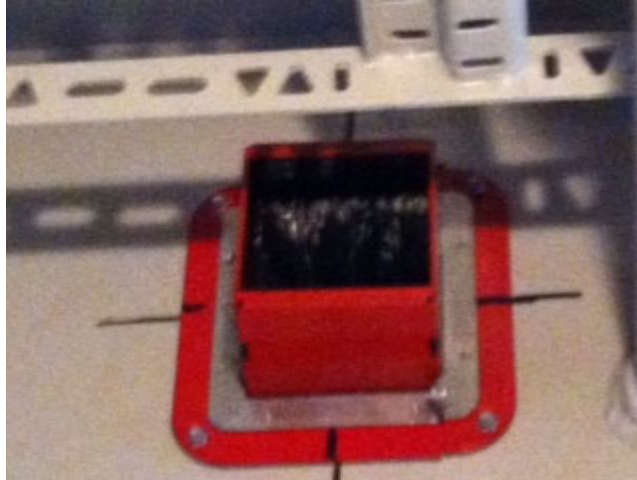
43. The metadata on this PowerPoint slide indicates the following: “Content created 2/26/13 7:50 AM.” See Exhibit 11 (metadata for EZ PATH 44T 2013 PowerPoint); Stahl Decl. (Ex. 1), ¶ 32. Therefore, the document was created before the earliest potential priority date of the ’088 Patent.

44. As another example, the photograph below is from a PowerPoint presentation dated November 6, 2012, titled “EZD44T Quality Control Procedure,” pertaining to the European EZ Path 44+ product. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “curtain extending inwards from a wall of the passage channel” in paragraph 26 of its Complaint.



See Exhibit 3 (11/6/12 PowerPoint “EZD44T Quality Control Procedure”); Stahl Decl. (Ex. 1), ¶ 33.

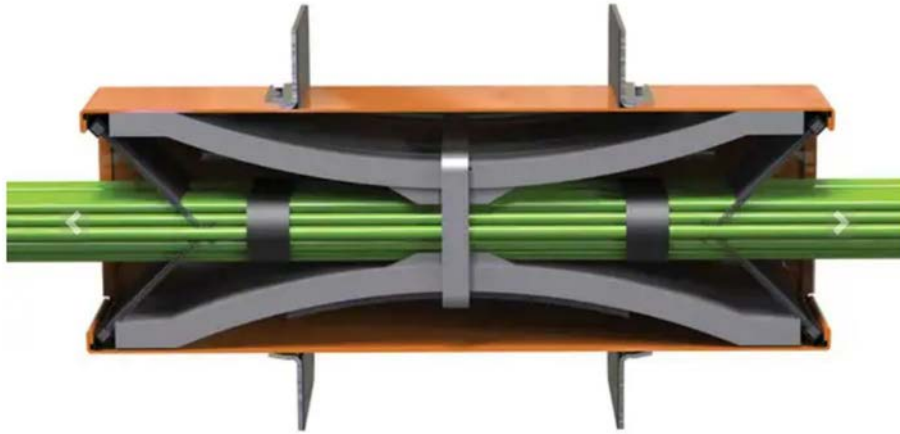
45. In addition, the below photograph, which is attached to an email dated August 9, 2013, shows a Marine 300 product installed on a vessel built at Bollinger Shipyard. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “curtain extending inwards from a wall of the passage channel” in paragraph 26 of its Complaint.



A true and correct copy of the August 9, 2013 email with attached photographs of the Marine 300 product installed on a vessel built at Bollinger Shipyard is attached hereto as Exhibit 12. See also Stahl Decl. (Ex. 1), ¶ 35.

46. Therefore, to the extent the accused EZ Path product includes a “curtain extending inwards from a wall of the passage channel,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also include a “curtain extending inwards from a wall of the passage channel.”

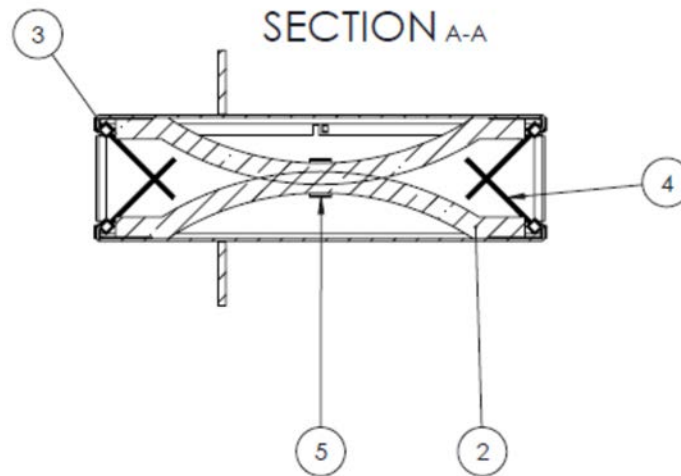
47. Based on the below image, Hilti alleges that “the EZ Path Pathway includes a flexible material mounted in the passage channel at a location spaced from the curtain and coated with an intumescent material, namely the gray intumescent pads shown in the below image”:



See Complaint ¶ 27.

48. Given Hilti's allegation that the accused EZ Path product practices this limitation of claim 1 of the '088 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

49. The below image is an excerpt from an engineering drawing of the Marine 300 product dated August 13, 2013. The cross section of the Marine 300 product shown in this August 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 27 of Hilti's Complaint.

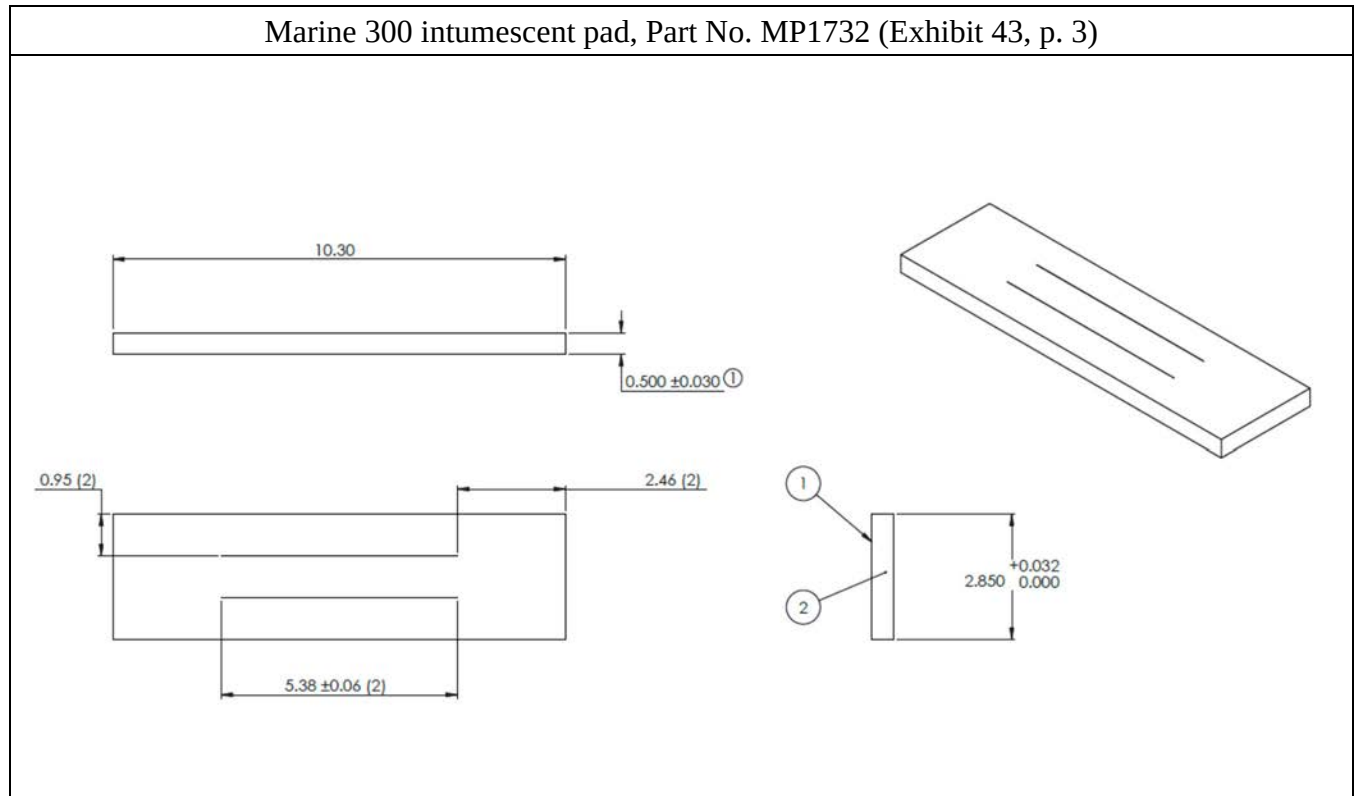


See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); see also ¶ 34 above.

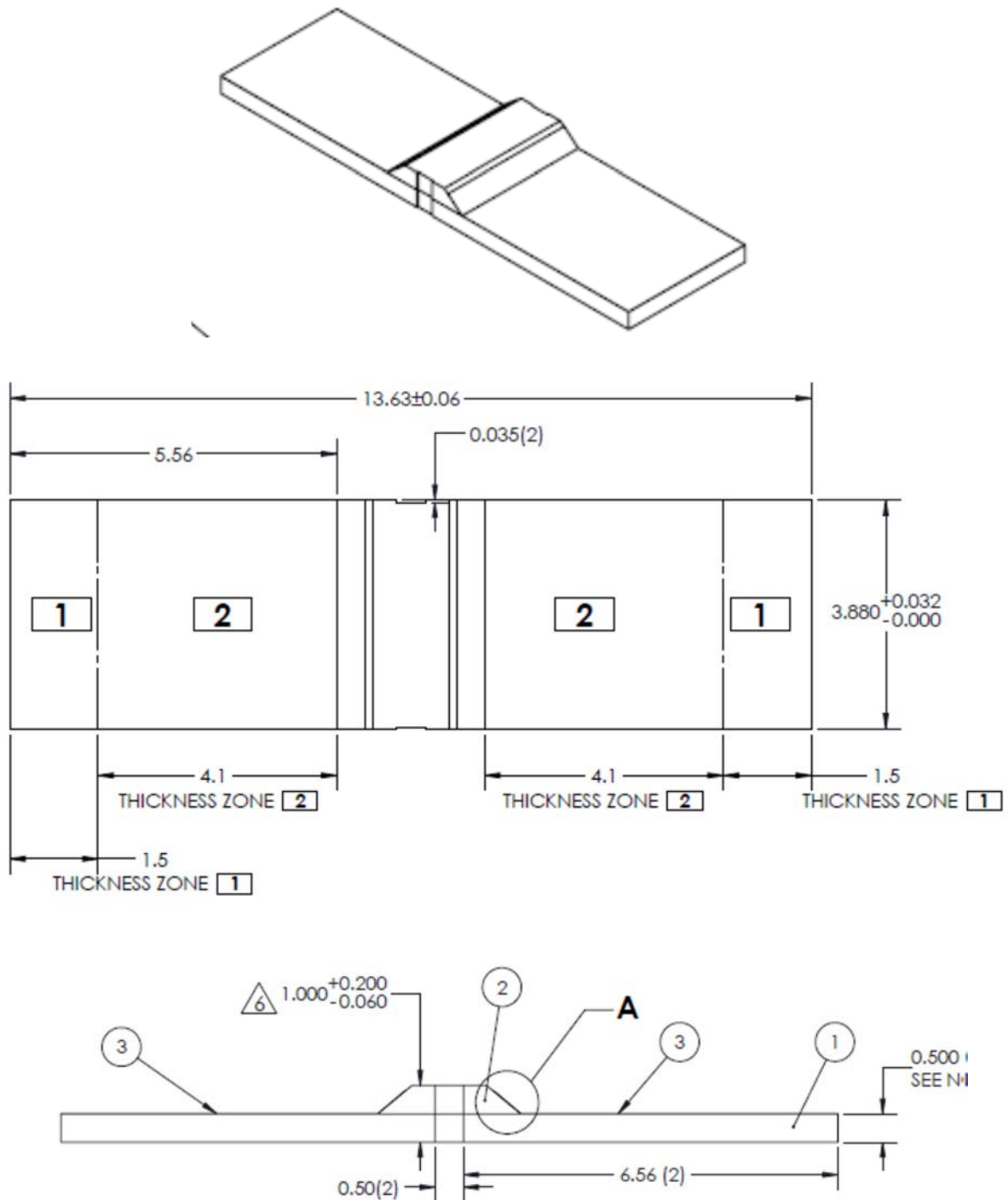
50. Item number 2 in the August 13, 2013 engineering drawing corresponds to part number MP1732, “EZ Path 300 Marine Intumescent Foam Pad.” See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013). Apart from some minor variations—for example, in size and tolerances—these intumescent foam pads on the Marine 300 product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “flexible material mounted in the passage channel at a location spaced from the curtain and coated with an intumescent material.” Stahl Decl. (Ex. 1), ¶ 23.

51. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the

intumescent pads show the minor variations in size and tolerances between the Marine 300 intumescent pads (part number MP1732 – Exhibit 43, p. 3) and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)

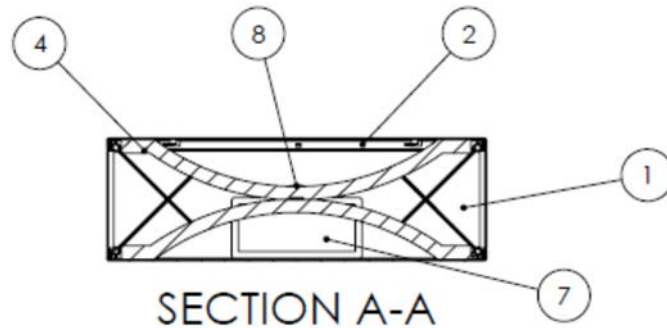


See Exhibit 43, Exhibit 44, and Exhibit 45; see also Stahl Decl. (Ex. 1), ¶ 23.

52. The Marine 300 and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size; the accused EZ Path is a larger device than the Marine 300. The pads are scaled to fit the size of the particular product. In addition, slight differences in the pads—for instance, the two parallel score lines on the MP1732 intumescent pad and the slight notch or indentation on the side of the MPASSY767 intumescent pad—are attributable to the evolution of the manufacturing process for these pads. For example, notches were added to the pads to make the assembly process easier. In addition, a small component, identified as Item No. 2 in the engineering drawing of the intumescent pad of the accused EZ Path (Exhibit 45), was added as an additional remedial sealing component to help reduce air leakage. Apart from being slightly different in size, having minor cosmetic differences, and having slight differences in their tolerances, the intumescent pads on the Marine 300 and accused EZ Path are otherwise identical. Stahl Decl. (Ex. 1), ¶ 23.

53. The below image is an excerpt from an engineering drawing of the Marine 400 product dated March 1, 2013. The cross section of the Marine 400 product shown in this March 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 27 of Hilti's

Complaint.

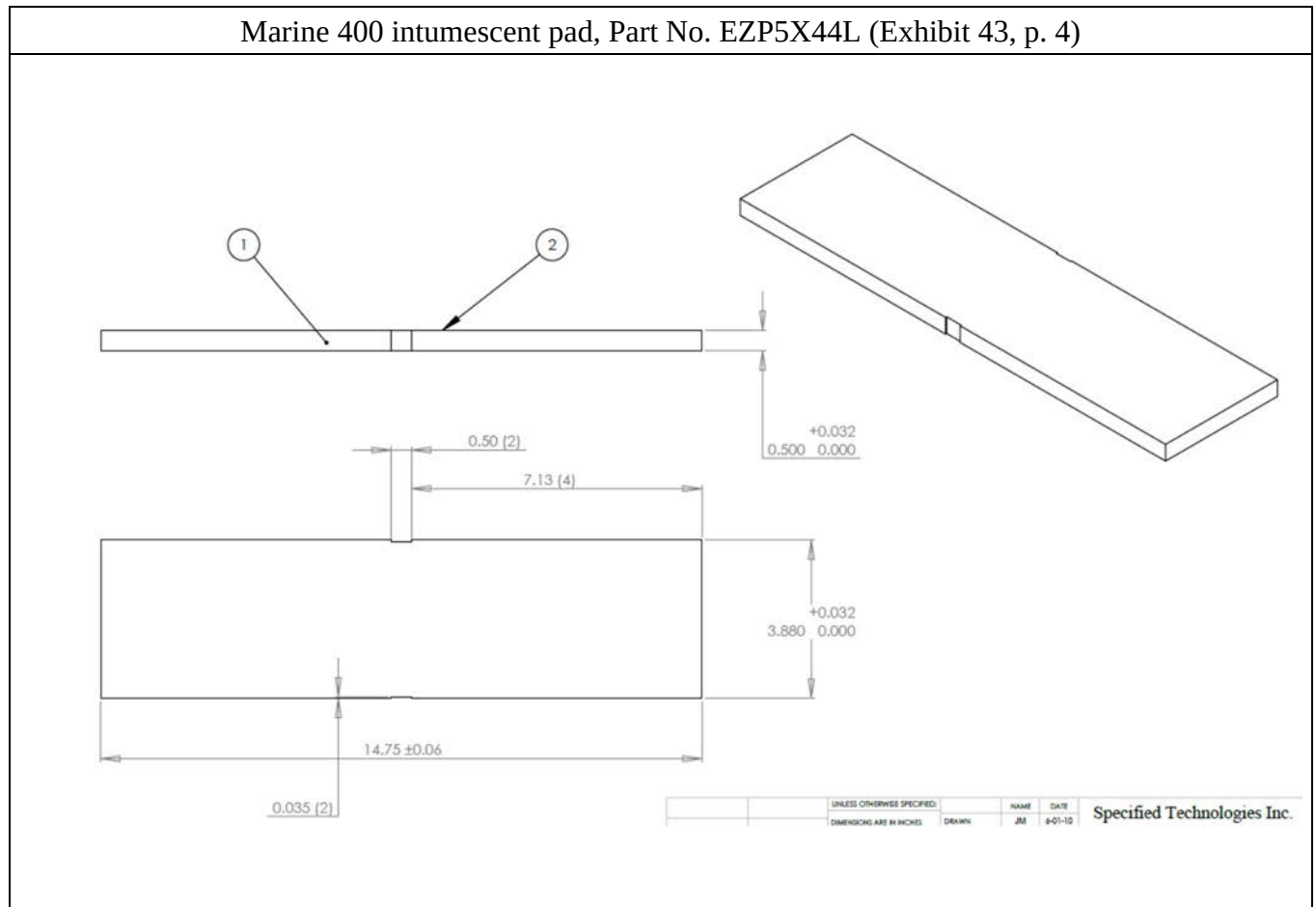


See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); see also ¶ 38 above.

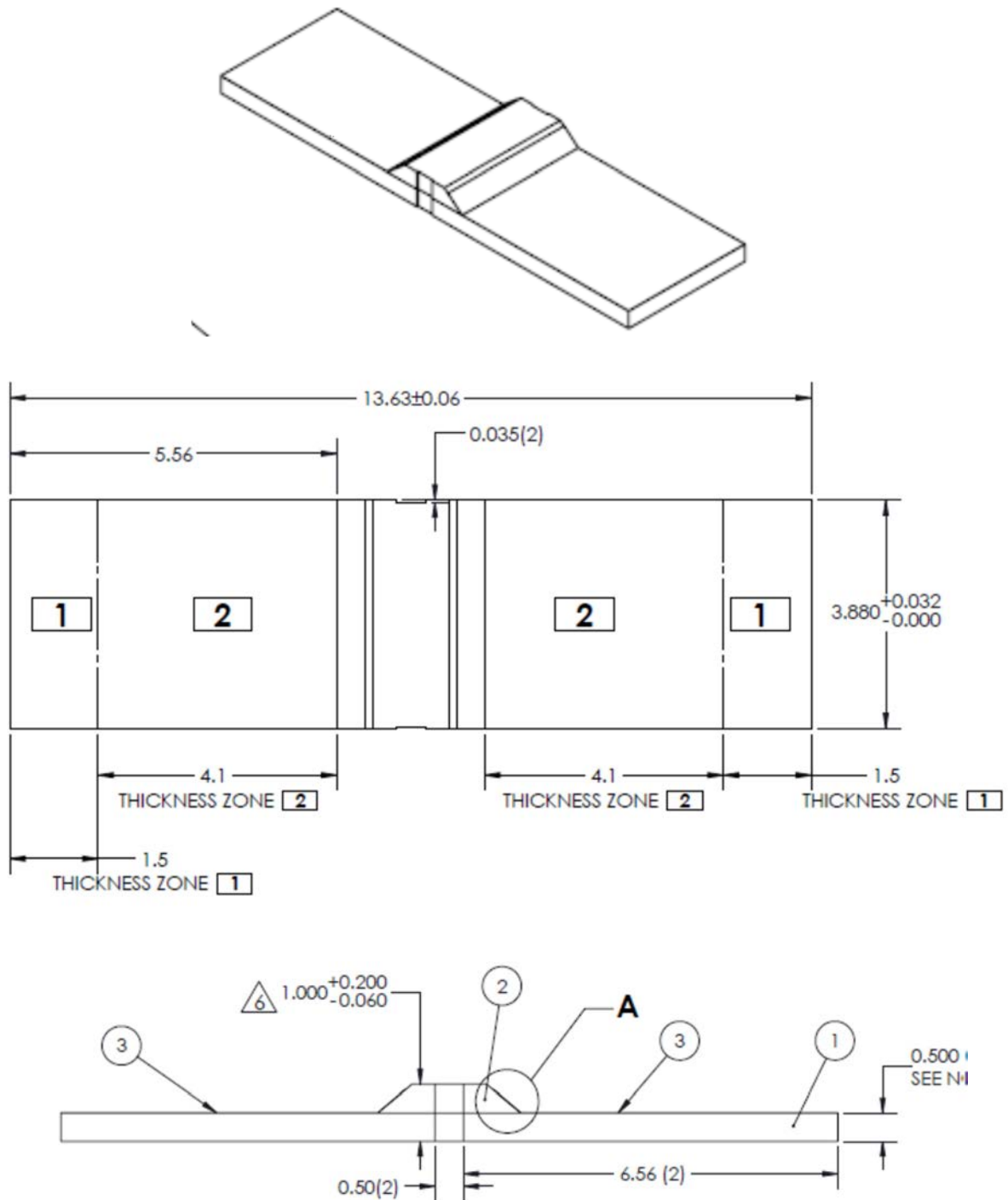
54. Item number 4 on the March 1, 2013 engineering drawing corresponds to part number EZP5X44L, “EZ Path 400 Marine Fire Rated Pathway Intumescent Foam Pad.” See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013). Apart from some minor variations—for example, in size and tolerances—these intumescent foam pads on the Marine 400 product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “flexible material mounted in the passage channel at a location spaced from the curtain and coated with an intumescent material.” Stahl Decl. (Ex. 1), ¶ 26.

55. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the

Marine 400 intumescent pads (part number EZP5X44L – Exhibit 43, p. 4) and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)

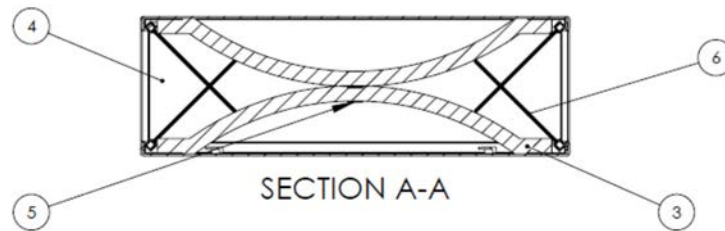


See Exhibit 43, Exhibit 44, Exhibit 45; Stahl Decl. (Ex. 1), ¶ 26.

56. The Marine 400 and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size. The pads are scaled to fit the size of the particular product. The pads also differ slightly in that the intumescent pad of the accused EZ Path has an additional small component, identified as Item No. 2 on Exhibit 45, that was added as an additional remedial sealing component to help reduce air leakage. Apart from being slightly different in size, having a minor cosmetic difference, and having slight differences in their tolerances, the intumescent pads on the Marine 400 and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 26.

57. In addition, the May 2013 STI Marine Firestop brochure indicates that STI's Marine Fire Rated Pathways, including the Marine 300 and Marine 400 products, are "comprised of compressible foam pads installed to form an arch." See Exhibit 5 (May 2013 STI Marine Firestop brochure, at 4).

58. The below image is an excerpt from an engineering drawing of the European EZ Path 44+ product dated September 12, 2012. The cross section of the European EZ Path 44+ product shown in this September 2012 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 27 of Hilti's Complaint.

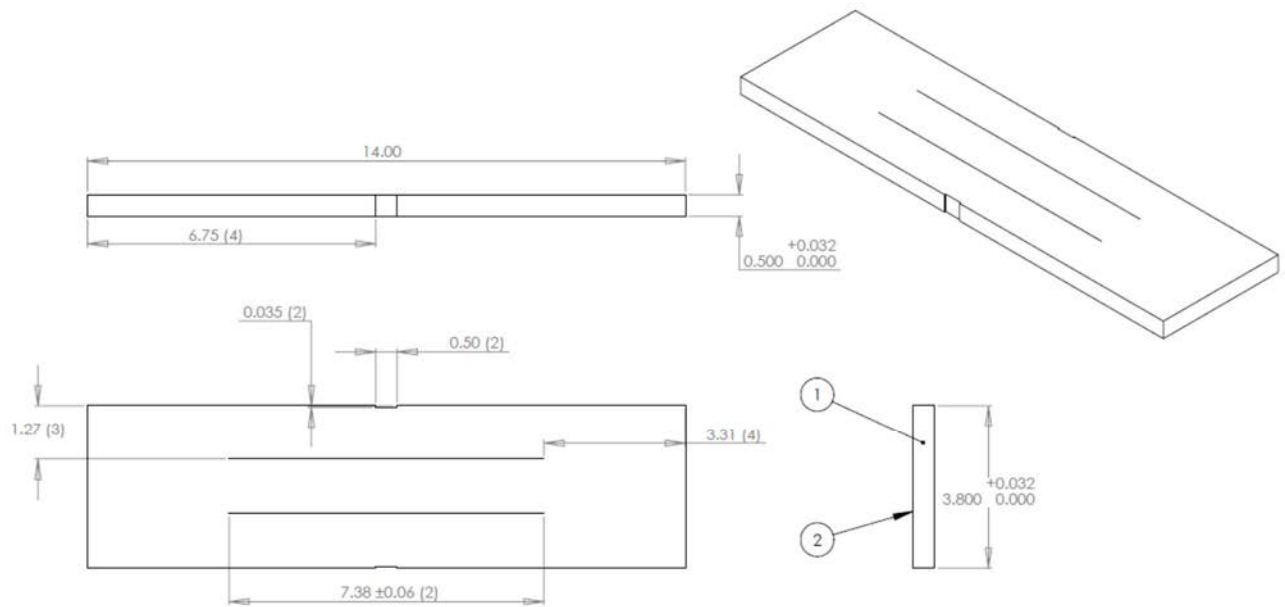


See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012); *see also* ¶ 40 above.

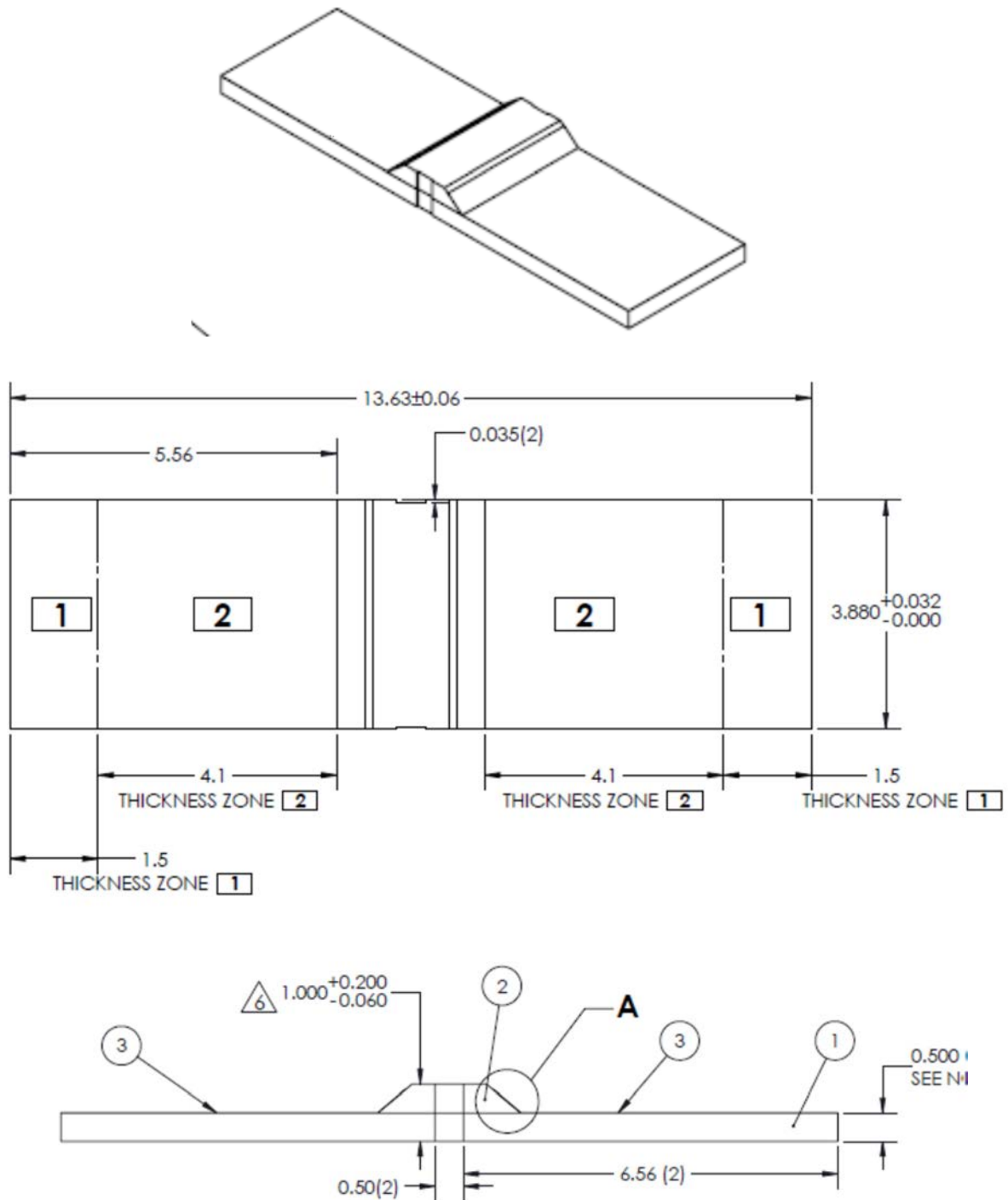
59. Item number 3 in the September 12, 2012 engineering drawing corresponds to part number MP1258, “Series 44+ Europe EZ Path Intumescent Foam Pad.” See Exhibit 9. Apart from some minor variations—for example, in size and tolerances, these intumescent foam pads on the European EZ Path 44+ product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “flexible material mounted in the passage channel at a location spaced from the curtain and coated with an intumescent material.” See Stahl Decl. (Ex. 1), ¶ 29.

60. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the European EZ Path 44+ intumescent pads (part number MP1258 – Exhibit 43, p. 5) and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:

European EZ Path 44+ intumescent pad, Part No. MP1258 (Exhibit 43, p. 5)



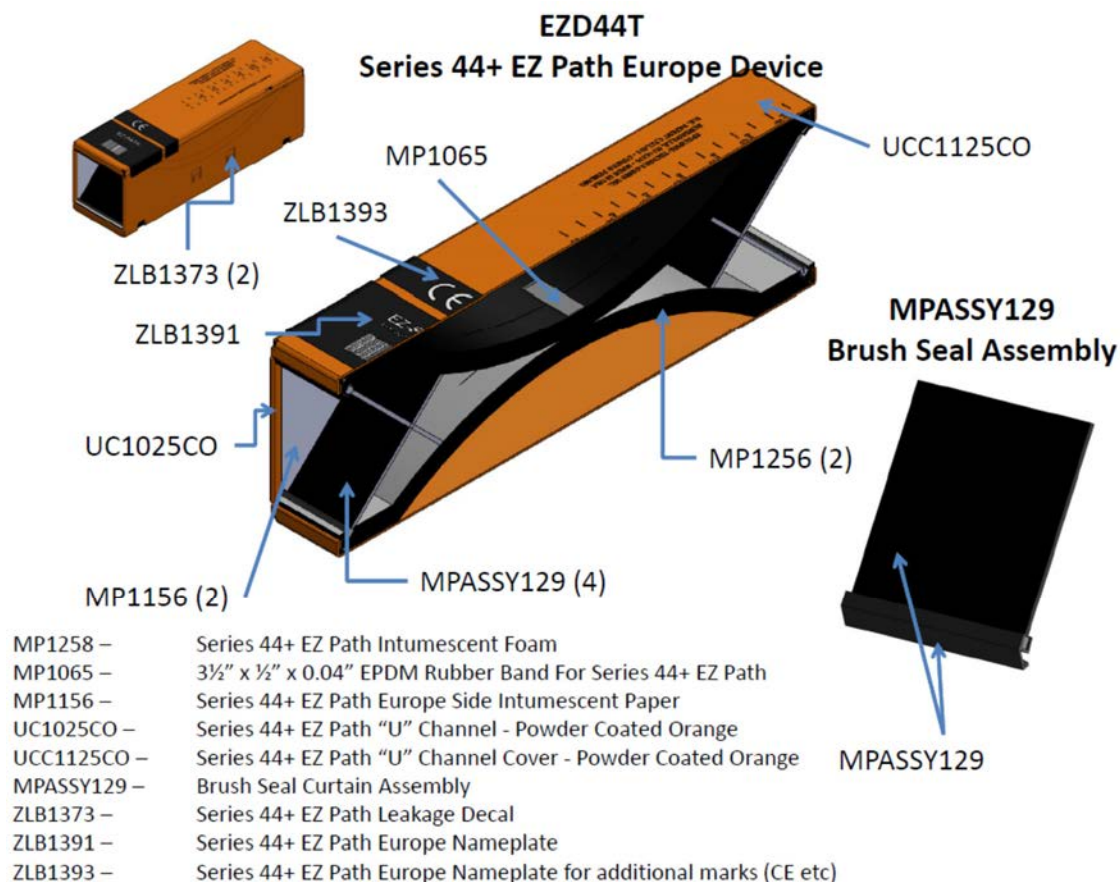
Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)



See Exhibit 43, Exhibit 44, Exhibit 45; Stahl Decl. (Ex. 1), ¶ 29.

61. The European EZ Path 44+ and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size. The pads are scaled to fit the size of the particular product. The pads also differ slightly in that the European EZ Path 44+ intumescent pads have two parallel score lines (which the intumescent pads of the accused EZ Path do not have), and the accused EZ Path intumescent pads have a small component (identified as Item No. 2 on Exhibit 45) that was added as an additional remedial sealing component to help reduce air leakage (which the European EZ Path 44+ intumescent pads do not have). Apart from being slightly different in size, having minor cosmetic differences, and having slight differences in their tolerances, the intumescent pads on the European EZ Path 44+ and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 29.

62. In addition, a PowerPoint slide depicting a CAD representation of the European EZ Path 44+ product clearly shows the foam intumescent pads, identified as part no. MP1258:



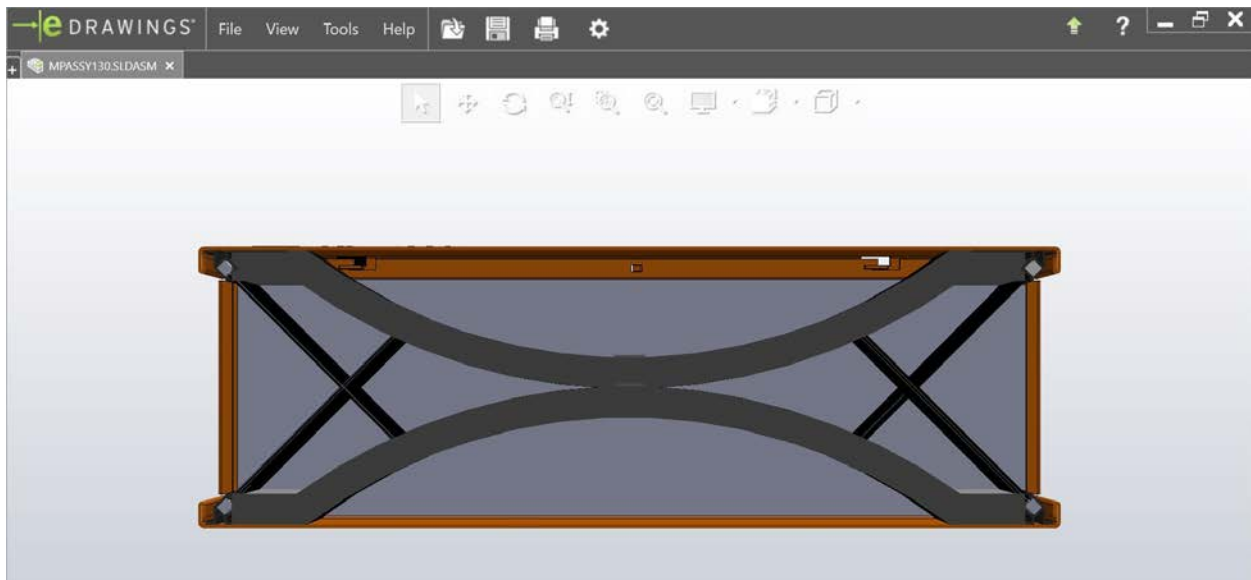
A true and correct copy of this PowerPoint slide, titled EZD44T.pptx, is attached hereto as Exhibit 13. The notation on the drawing – MP1256 – is a typographical error. The correct part number, as indicated in the list below the CAD rendering and on the September 12, 2012 engineering drawing, is MP1258. See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012); Stahl Decl. (Ex. 1), ¶ 37.

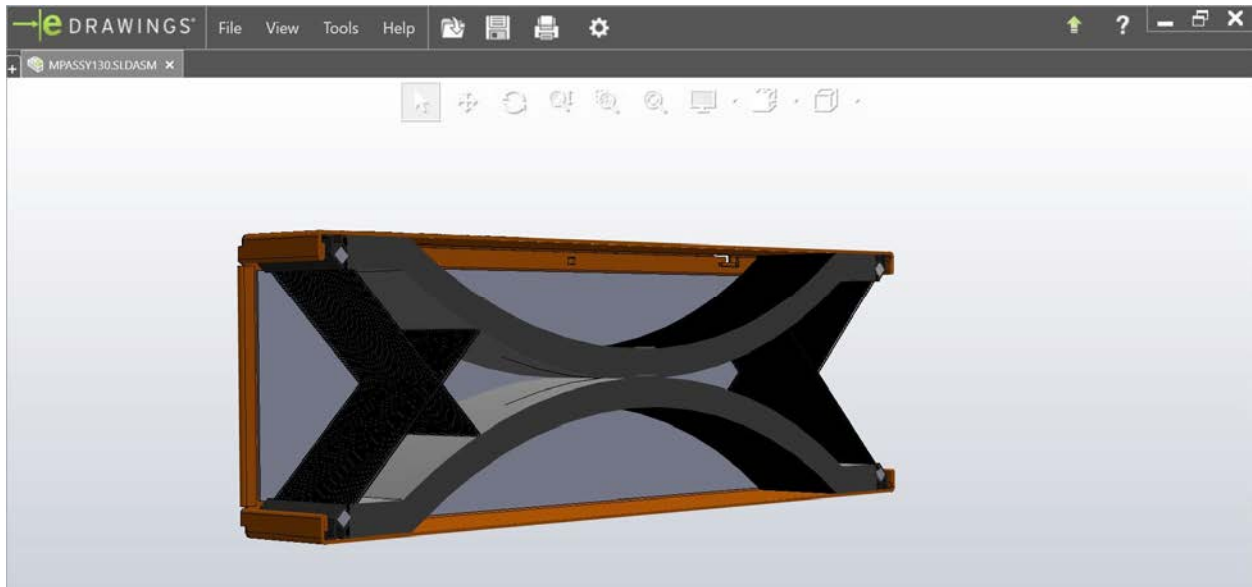
63. The metadata on this PowerPoint slide indicates the following: "Content created 2/27/12 9:08 AM" and "Date last saved 9/11/12 2:16 PM." See Exhibit 14 (metadata for EZD44T.pptx). See Stahl Decl. (Ex. 1), ¶ 38. Therefore,

the document was created before the earliest priority date of the '088 Patent.

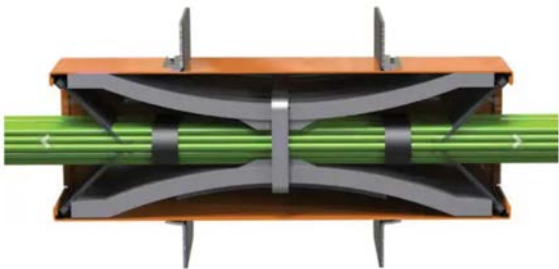
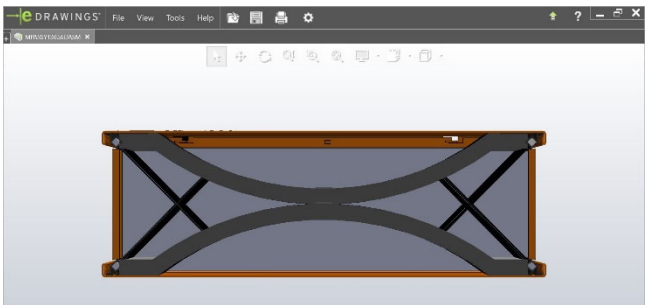
64. Additionally, 3D SolidWorks files that were created by STI before the earliest priority date of the '088 Patent show the various components of the prior art products that were on sale, sold, described in printed publications, in public use, and/or were otherwise available to the public before the earliest priority date of the '088 Patent.

65. For example, the below excerpt of a 3D SolidWorks file shows two cross-sectional views of the prior art European EZ Path 44+ product:





See Exhibit 15 (3D SolidWorks image of European EZ Path 44+ product). These 3D images are virtually identical to the cross-sectional image of the accused EZ Path 44+ product shown in paragraph 27 of the Complaint. Compare Complaint ¶ 27 and 3D SolidWorks image of European EZ Path 44+ product (Ex. 15):

Complaint ¶ 27 (accused EZ Path)	3D SolidWorks image of prior art European EZ Path 44+ product
	

66. Exhibit 15 is a compilation of screenshots taken from a SolidWorks Assembly file of the European EZ Path 44+ viewed using the eDrawings program. The source data for the interactive 3D model shown is the SolidWorks Assembly file for the European EZ Path 44+ that was created on July 16, 2012. Exhibit 15 is a true and accurate representation of the European EZ Path 44+ as it appeared in 2012, with the exception of a minor change in 2021 to the brush seal holder used in the product, as discussed further below. Declaration of Julio Lopes (“Lopes Decl.”) (Exhibit 16), ¶¶ 4, 6, 8.

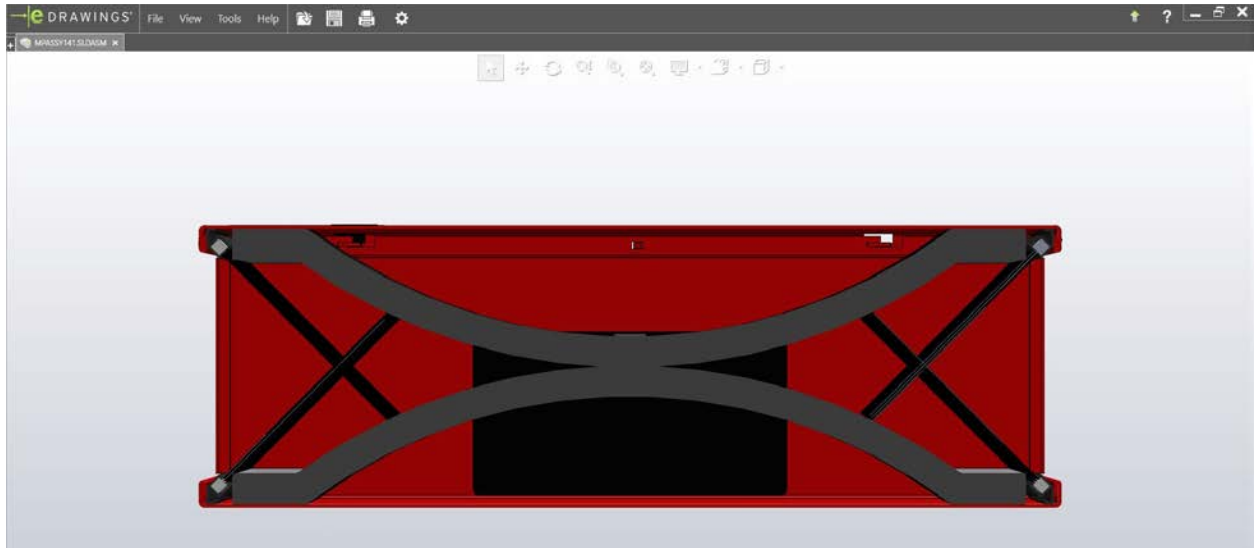
67. The metadata for this 3D SolidWorks image indicates that it was created on July 16, 2012—more than one year before the earliest priority date of the ’088 Patent. See Exhibit 15 at p. 15. The metadata also indicates that the file was modified on March 15, 2021. See *id.* As shown in a revised engineering drawing for the European EZ Path 44+ product, and reproduced below, this March 15, 2021 modification was merely a minor change to the brush holder used in the product—i.e., the plastic strip that holds the brushes in place. This was the only change made to the drawing since July 16, 2012.

REVISIONS				
REV.	DESCRIPTION	DATE	MODIFIED BY	APPROVED
1	Replace existing brush holders with MP2360 and MP2362 EZD44S2 brush holders.	3/15/2021	SAF	DC

See Exhibit 17, a true and correct copy of an engineering drawing reflecting the

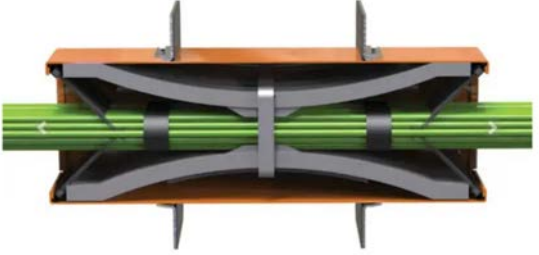
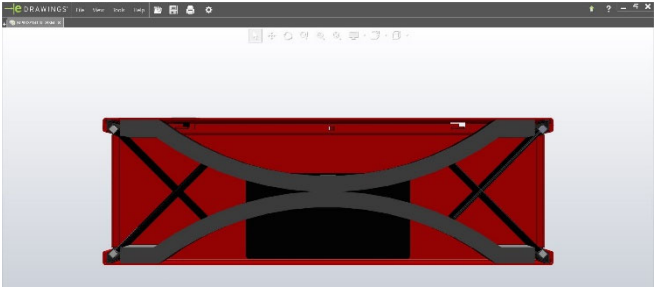
3/15/21 revision to the European EZ Path 44+ product; *see also* Lopes Decl. (Ex. 16), ¶¶ 6-9.

68. In addition, the below excerpt of a 3D SolidWorks file shows two cross-sectional views of the prior art Marine 400 product:



See Exhibit 18 (3D SolidWorks image of Marine 400 product). These 3D images

are virtually identical to the cross-sectional image of the accused EZ Path 44+ product shown in paragraph 27 of the Complaint. *Compare* Complaint ¶ 27 and 3D SolidWorks image of Marine 400 product (Ex. 18):

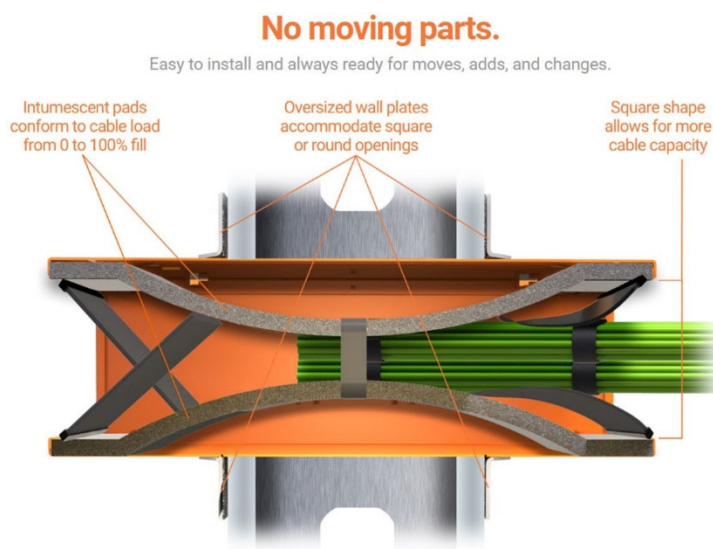
Complaint ¶ 27 (accused EZ Path)	3D SolidWorks image of prior art Marine 400 product
	

69. Exhibit 18 is a screenshot taken from a SolidWorks Assembly file of the Marine 400 viewed using the eDrawings program. The metadata for this 3D SolidWorks image indicates that it was created on September 24, 2012. *See* Exhibit 18 at p. 3. This SolidWorks Assembly file of the Marine 400 has not been changed since September 24, 2012. The source data for the interactive 3D model shown is the SolidWorks Assembly file for the Marine 400 that was created on September 24, 2012. Exhibit 18 is a true and accurate representation of the Marine 400 as it appeared by June 28, 2013. *See* Lopes Decl. (Ex. 16), ¶¶ 10-12.

70. Therefore, to the extent the accused EZ Path product includes a “flexible material mounted in the passage channel at a location spaced from the

curtain and coated with an intumescent material,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also include a “flexible material mounted in the passage channel at a location spaced from the curtain and coated with an intumescent material.”

71. Based on the below image, Hilti alleges that “the EZ Path Pathway is suitable for passing a pipe or cable through an opening in a building and the curtain at least partially bends in a through direction of the passage channel when a pipe or cable is in the device, as shown at the right side of the below image”:



See Complaint ¶ 28.

72. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’088 Patent, Hilti is necessarily admitting that the prior

art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

73. First, based on Hilti’s allegations pertaining to the accused EZ Path product, the prior art Marine 300, Marine 400, and European EZ Path 44+ products are necessarily also “suitable for passing a pipe or cable through an opening in a building.” For example, the May 2013 STI Marine Firestop brochure, which pertains to the Marine 300 and Marine 400 products, states that “cables pass through the device.” See Exhibit 5 (May 2013 STI Marine Firestop brochure, at 4).

74. In addition, the below photograph, which is attached to an email dated August 9, 2013, shows a Marine 300 product installed on a vessel built at Bollinger Shipyard. The photograph shows cables passing through an opening in a building—in this case, a wall in a ship—via the housing of the Marine 300 product.



See Exhibit 12 (August 9, 2013 email attaching photographs of Marine 300 product installed on vessel built at Bollinger Shipyard); Stahl Decl. (Ex. 1), ¶ 36.

75. In addition, the below photograph from a 2013 PowerPoint pertaining to the European EZ Path 44+ product shows cables passing through an opening in a wall via the housing of the product.



See Exhibit 10 (EZ PATH 44T 2013 PowerPoint); Stahl Decl. (Ex. 1), ¶ 31.

76. Second, based on Hilti’s allegations pertaining to the accused EZ Path product, the prior art Marine 300, Marine 400, and European EZ Path 44+ products also have a “curtain [that] at least partially bends in a through direction of the passage channel when a pipe or cable is in the device.” Each of these products included brushes made of “black nylon filament.” See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); and Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012). Nylon filament is a flexible

material that bends into the channel when cables or pipes are inserted into the housing. See Stahl Decl. (Ex. 1), ¶¶ 22, 25, 28.

77. For example, the below photograph from the November 6, 2012 PowerPoint presentation titled “EZD44T Quality Control Procedure” shows that the nylon filaments of the brush are flexible and would clearly bend into the chamber when cables or pipes are inserted into the opening of the housing.



See Exhibit 3 (EZD44T Quality Control Procedure); Stahl Decl. (Ex. 1), ¶ 34.

78. Therefore, to the extent the accused EZ Path product is “suitable for passing a pipe or cable through an opening in a building and the curtain at least partially bends in a through direction of the passage channel when a pipe or cable is in the device,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily are also “suitable for passing a pipe or cable through an opening in a building and the curtain[s] at least partially bend[] in a through direction of the passage channel when a pipe or

cable is in the device.”

79. Based on the below image, Hilti alleges that “the EZ Path Pathway includes a curtain that comprises at least one selected from the group consisting of an inorganic fiber and an organic fiber, as shown in the below image”:



See Complaint ¶ 29.

80. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’088 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

81. The 2012 engineering drawing of the European EZ Path 44+ device and the 2013 engineering drawings of the Marine 300 and 400 devices state that brushes of those prior art products are made of “black nylon filament.” See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); and Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12,

2012). Therefore, the brushes of the prior art European EZ Path 44+, Marine 300, and Marine 400 devices comprise “at least one selected from the group consisting of an inorganic fiber and an organic fiber.”

82. Additional engineering drawings of the prior art Marine 300, Marine 400, and European EZ Path 44+ product show details of the individual components of those products. Attached hereto as Exhibit 43 is a compilation of true and correct copies of engineering drawings dated prior to December 9, 2013 that show details of various individual components of the Marine 300, Marine 400, and European EZ Path 44+ products that were actually sold, described in printed publications, were in public use, and were otherwise available to the public prior to December 9, 2013.

B) The '088 Patent is invalid for additional reasons under 35 U.S.C. §§ 102, 103, and/or 112.

83. In addition to the reasons set forth in Section A above, the asserted claim(s) of the '088 Patent are invalid under 35 U.S.C. §§ 102, 103 and/or 112.

84. For example, the asserted claim(s) of the '088 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. No. 4,538,389 (Heinen)
- U.S. Pat. No. 5,456,050 (Ward)
- U.S. Pat. No. 6,172,052 (Takahashi)
- U.S. Pat. No. 6,426,463 (Munzenberger)

- U.S. Pat. No. 6,632,999 (Sempliner)
- U.S. Pat. No. 6,732,481 (Stahl), owned by STI
- U.S. Pat. No. 6,928,777 (Cordts)
- U.S. Pat. No. 7,373,761 (Stahl), owned by STI
- U.S. Pat. No. 8,051,614 (Peck)
- U.S. Pat. No. 8,188,382 (Monden)
- U.S. Pat. No. 8,266,854 (Reddicliffe)
- U.S. Pat. No. 8,833,478 (Zernach)
- U.S. Pat. No. 8,887,458 (Lopes), owned by STI
- U.S. Pat. No. 9,046,194 (Gandolfo), owned by STI
- U.S. Pat. No. 7,523,590 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2006/0037264 (Paetow)
- U.S. Pat. App. Pub. No. 2013/0277918 (Fitzgerald)
- U.S. Pat. App. Pub. No. 2013/0307225 (Boyd)
- WO2004/015319 (Porter)
- WO2013/160776 (Ramorino)
- EP0869303 (Seebode)
- DE10043430 (Munzenberger)
- The EZ-Path System – The Zero-Maintenance Solution for
Firestopping Cables, Specified Technologies, Inc. (Rev. 03/2008)

- 2003 STI brochure (Exhibit 41)
- May 2013 STI Marine Firestop brochure (Exhibit 5)

85. A person of ordinary skill in the art (“POSITA”) would have been motivated to combine one or more of these prior art references to achieve the asserted claim(s) of the ’088 Patent, before the earliest possible priority date of the ’088 Patent, for at least the following reasons: (1) it was well known and understood in the art that a sleeve comprising a passageway with intumescent material located therein could be, and was, used as a firestopping apparatus; (2) it was well known and understood in the art that the intumescent material should permit a pipe or cable to pass through the sleeve; (3) it was well known and understood in the art that a brush or curtain could be, and was, used to close off the ends of the sleeve while permitting a pipe or cable to pass through the sleeve; (4) it was well known and understood in the art that permitting cables to be inserted or removed without removal or reinstallation of the firestopping apparatus was advantageous; and (5) it was well known and understood in the art that bristles and flexible intumescent material permitted insertion and removal of cables while maintaining a sealing effect when the cables were in the device. The combination of one or more of these prior art references would have yielded entirely predictable results.

86. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 2: Declaration of Invalidity of U.S. Patent No. 10,663,090

87. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

88. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '090 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '090 Patent is valid, and specifically alleges that STI infringes claim 1 of the '090 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Series 44+ Fire Rated Pathway (the "EZ Path Pathway"). STI contends that each asserted claim of the '090 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

89. The '090 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

A) The '090 Patent is invalid under 35 U.S.C. § 102 – on sale bar, printed publication, public use.

90. At least claim 1 of the '090 Patent is invalid under 35 U.S.C. § 102 because STI's Marine 300, Marine 400, and European EZ Path 44+ products were on sale, actually sold, described in printed publications, in public use, and/or were otherwise available to the public before December 9, 2013, the earliest priority date

of the '090 Patent.

91. As explained above in paragraphs 11-17, the Marine 300, Marine 400, and European EZ Path 44+ products are prior art to the '090 Patent because they were sold before December 9, 2013, the earliest priority date of the '090 Patent. See Exhibit 6 (6/28/13 invoice) and Exhibit 4 (11/30/12 invoice); see also Stahl Decl. (Ex. 1), ¶¶ 12, 16.

92. As discussed further below, the Marine 300, Marine 400, and European EZ Path 44+ products that STI sold in 2012 and 2013 have nearly identical components as the accused EZ Path product which Hilti alleges are covered by claim 1 of the '090 Patent. See Stahl Decl. (Ex. 1), ¶¶ 14, 18. Any minor differences between the components of STI's prior art products and the accused EZ Path product are insignificant and have no bearing on the question of whether STI's prior art products anticipate claim 1 of the '090 Patent or on whether they invalidate any other asserted claim.

93. Claim 1 of the '090 Patent recites:

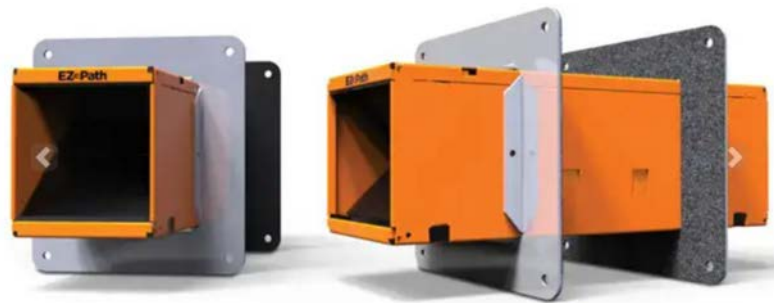
1. A device, comprising:

a sleeve-like housing comprising a passage channel that is open at opposite ends and has an approximately rectangular cross section,

at least two brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and that mesh to close the passage channel; and

a flexible material that is mounted in the passage channel and comprises an intumescent material, wherein the flexible material at least partially curves in an axial direction of the passage channel and wherein the device is suitable for passing a pipe or cable through an opening in a building.

94. Based on the below image, Hilti alleges that “the EZ Path Pathway is a device” that “includes a sleeve-like housing comprising a passage channel that is open at opposite ends and has an approximately rectangular cross section, namely the orange galvanized steel pathway shown in the below image”:



See Complaint ¶¶ 37-38.

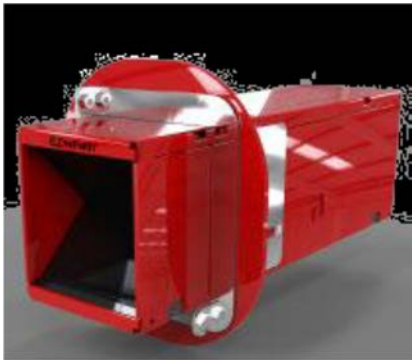
95. Given Hilti’s allegation that the accused EZ Path product practices these limitations of claim 1 of the ’090 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice these limitations.

96. For example, the STI Marine Firestop brochure, dated May 2013, includes photographs of the Marine 300 and Marine 400 products that are virtually identical to the photograph of the accused EZ Path product that Hilti included in

paragraphs 37-38 of its Complaint:



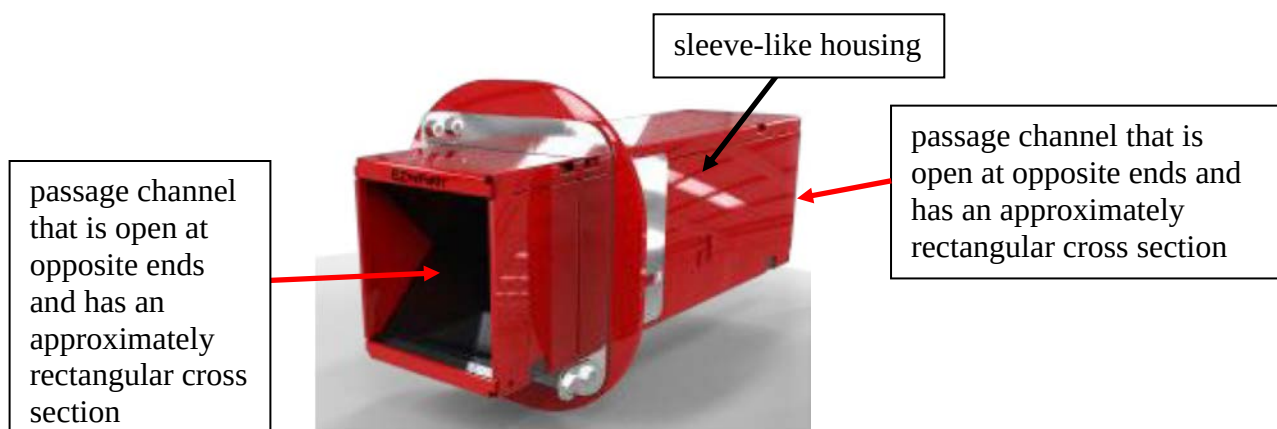
Compare Complaint ¶ 37 and May 2013 STI Marine Firestop brochure:

Complaint ¶ 37 (accused EZ Path)	Prior art Marine 300/400 product shown in May 2013 STI Marine Firestop brochure
	

See Exhibit 5 (May 2013 STI Marine Firestop brochure).

97. The May 2013 STI Firestop Brochure was publicly available in or around May 2013. Printed copies of the May 2013 STI Firestop Brochure were circulated to more than 1,000 of STI's customers and potential customers before December 2013. Stahl Decl. (Ex. 1), ¶ 17.

98. The below photo from the May 2013 STI Marine Firestop brochure (with added annotations) identifies the features of the Marine 300 and Marine 400 products that correspond to these elements of claim 1 of the '090 Patent according to Hilti's apparent understanding of the claim:



See Exhibit 5 (May 2013 Marine Firestop brochure).

99. In addition, a PowerPoint presentation dated November 6, 2012, titled “EZD44T Quality Control Procedure,” includes photographs of the European EZ Path 44+ product that are virtually identical to the photograph of the accused EZ Path product that Hilti included in paragraphs 37-38 of its Complaint:

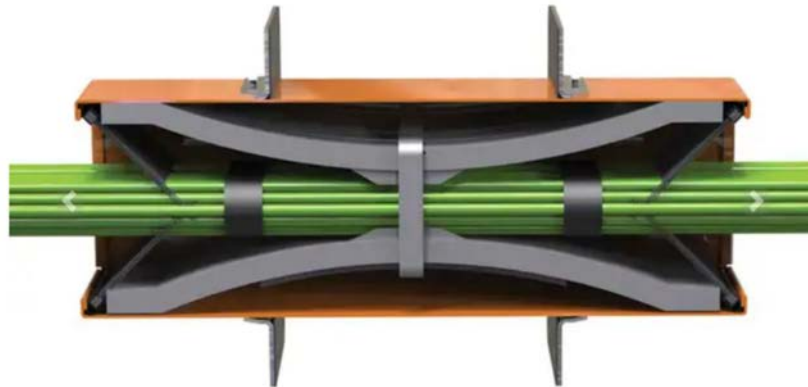
Complaint ¶ 37 (accused EZ Path)	Prior art European EZ Path 44+ product shown in 11/6/12 PowerPoint
	

See Exhibit 3 (EZD44T Quality Control Procedure); Stahl Decl. (Ex. 1), ¶ 13.

100. Therefore, to the extent the accused EZ Path product is a “device” that “includes a sleeve-like housing comprising a passage channel that is open at opposite ends and has an approximately rectangular cross section,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily are also devices that “include[] a sleeve-like housing comprising a passage channel that is open at opposite ends and ha[ve] an approximately rectangular cross section.”

101. Based on the below image, Hilti alleges that “the EZ Path Pathway includes at least two brushes mounted on two parallel, opposite flat walls of the

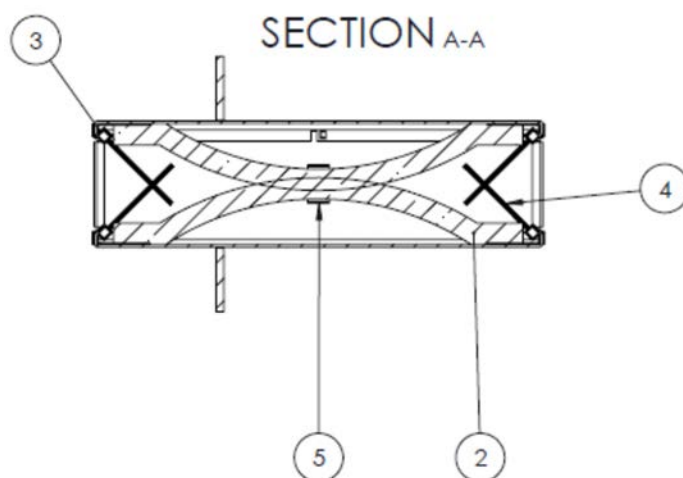
passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel, namely the two brushes on the left and/or right side of the housing shown in the below image”:



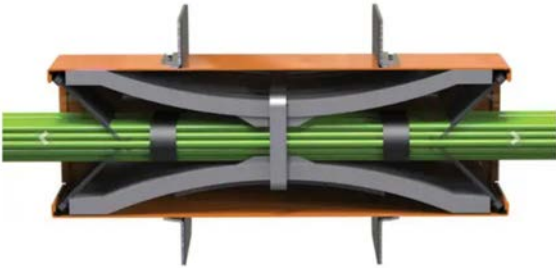
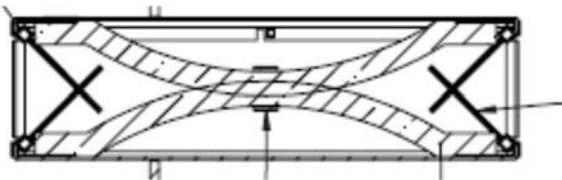
See Complaint ¶ 39.

102. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’090 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

103. The below image is an excerpt from an engineering drawing of the Marine 300 product dated August 13, 2013. The engineering drawing accurately depicts the Marine 300 product that was sold prior to December 9, 2013. Stahl Decl. (Ex. 1), ¶ 20. The cross section of the Marine 300 product shown in this August 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 39 of Hilti’s Complaint.



Compare Complaint ¶ 39 and 8/13/13 engineering drawing:

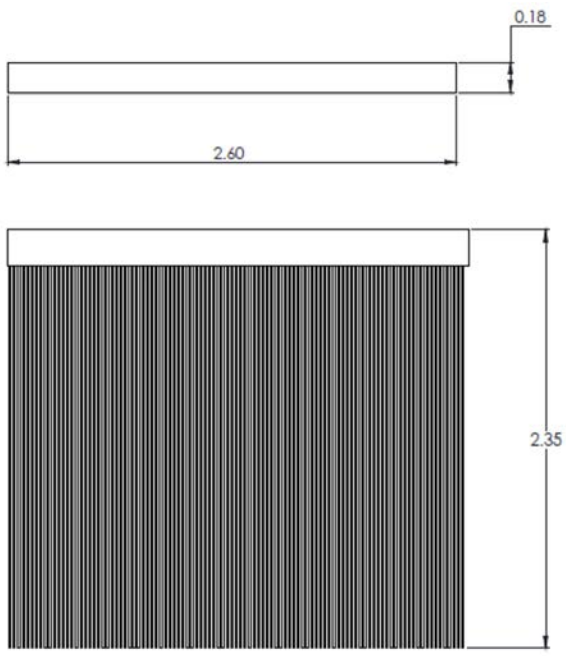
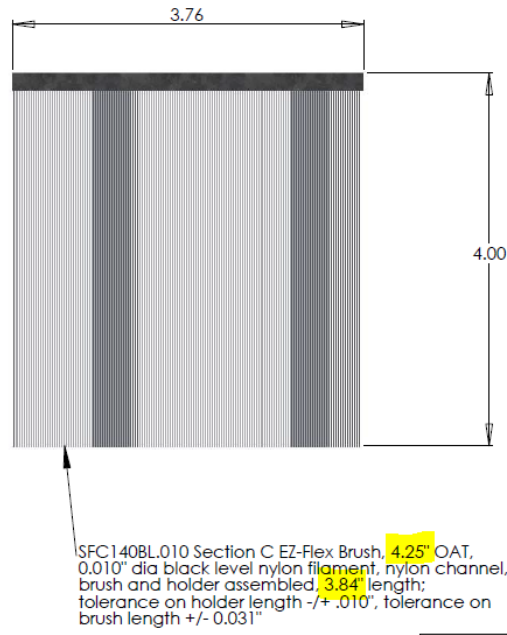
Complaint ¶ 39 (accused EZ Path)	Prior art Marine 300 product shown in 8/13/13 engineering drawing
	

See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013).

104. Item number 4 in the August 13, 2013 engineering drawing corresponds to part number MP1711, “EZ Flex Section C Brush - 2.35" OAT, 2.60" length, 0.010" diam black nylon filament, nylon channel.” Apart from very minor differences in size, these brushes on the Marine 300 product are otherwise identical

to the accused EZ Path product's alleged "two brushes on the left and/or right side of the housing," which Hilti alleges constitute the claimed "brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel." See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); Stahl Decl. (Ex. 1), ¶ 21.

105. The part number of the brush on the accused EZ Path is MP1354, as shown on Exhibit 44. The engineering drawings of the brushes show the minor differences in dimensions between the Marine 300 brushes (part number MP1711 – Exhibit 43, p. 2) and the accused EZ Path brushes (part number MP1354 – Exhibit 43, p. 1), as illustrated and highlighted below:

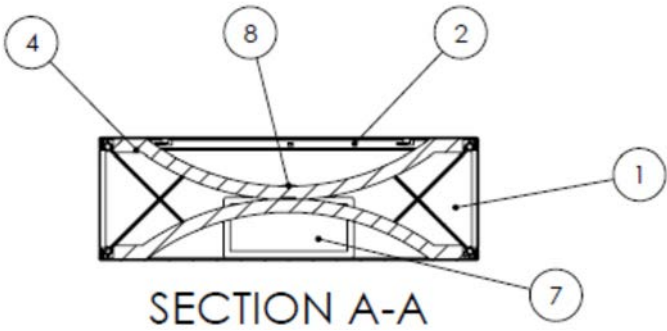
Marine 300 brushes, Part No. MP1711 (Exhibit 43, p. 2)	Accused EZ Path brushes, Part No. MP1354 (Exhibit 43, p. 1)
	 SFC140BL010 Section C EZ-Flex Brush, 4.25" OAT, 0.010" dia black level nylon filament, nylon channel, brush and holder assembled, 3.84" length; tolerance on holder length $\pm .010$", tolerance on brush length ± 0.031" PROPRIETARY AND CONFIDENTIAL

See Exhibit 43; Exhibit 44; Stahl Decl. (Ex. 1), ¶ 21.

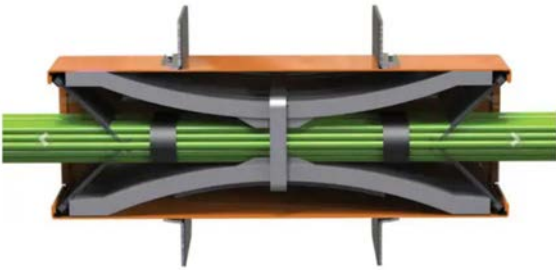
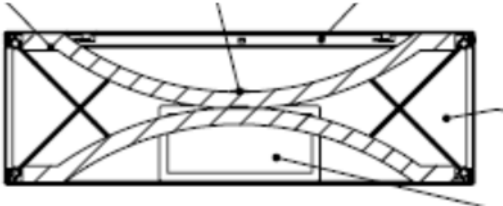
106. The Marine 300 and accused EZ Path products have brushes of slightly different sizes because the products differ slightly in size; the accused EZ Path is a larger device than the Marine 300. The brushes are scaled to fit the size of the particular product. Apart from being slightly different in size, the brushes on the Marine 300 and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 21.

107. The below image is an excerpt from an engineering drawing of the Marine 400 product dated March 1, 2013. The engineering drawing accurately

depicts the Marine 400 product that was sold prior to December 9, 2013. Stahl Decl. (Ex. 1), ¶ 24. The cross section of the Marine 400 product shown in this March 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 39 of Hilti’s Complaint.

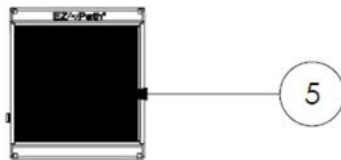


Compare Complaint ¶ 39 and 3/1/13 engineering drawing:

Complaint ¶ 39 (accused EZ Path)	Prior art Marine 400 product shown in 3/1/13 engineering drawing
	

See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013).

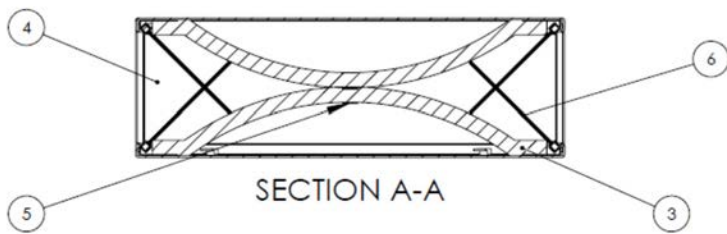
108. The image below is another excerpt from the March 2013 engineering drawing of the Marine 400 product.



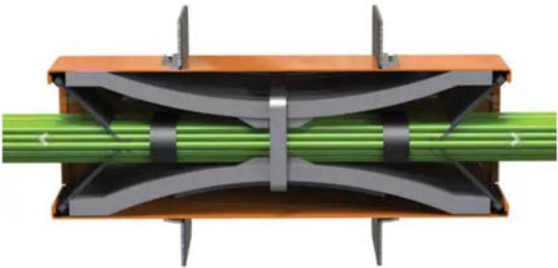
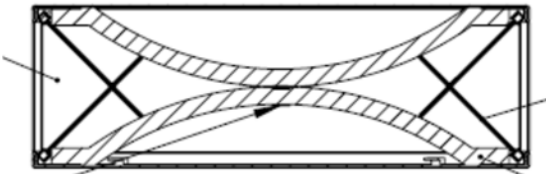
Item number 5 on the drawing corresponds to part number MP1354, “EZ Flex Section C Brush - 4.25" OAT, 3.84" length, 0.010" diam black nylon filament, nylon channel.” These brushes on the Marine 400 product have the same part number as, and are identical to, the accused EZ Path product’s alleged “two brushes on the left and/or right side of the housing,” which Hilti alleges constitute the claimed “brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel.” As shown on the engineering drawing of the accused EZ Path (Exhibit 44), the brush also has part number MP1354. See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); Exhibit 44; Stahl Decl. (Ex. 1), ¶ 25.

109. The below image is an excerpt from an engineering drawing of the European EZ Path 44+ product dated September 12, 2012. The engineering drawing accurately depicts the European EZ Path 44+ product that was sold prior to December 9, 2013. Stahl Decl. (Ex. 1), ¶ 27. The cross section of the European

EZ Path 44+ product shown in this September 2012 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 39 of Hilti's Complaint.



See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012); Compare Complaint ¶ 39 and 9/12/12 engineering drawing:

Complaint ¶ 39 (accused EZ Path)	Prior art European EZ Path 44+ product shown in 9/12/12 engineering drawing
	

110. Item number 6 in the September 12, 2012 engineering drawing corresponds to part number MP1354, “EZ Flex Section C Brush - 4.25" OAT, 3.84" length, 0.010" diam black nylon filament, nylon channel.” See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12,

2012). These brushes on the European EZ Path 44+ product have the same part number as, and are identical to, the accused EZ Path product's alleged "two brushes on the left and/or right side of the housing," which Hilti alleges constitute the claimed "brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel." As shown on the engineering drawing of the accused EZ Path (Exhibit 44), the brush also has part number MP1354. See Exhibit 9; Exhibit 44; Stahl Decl. (Ex. 1), ¶ 28.

111. Further, based on Hilti's allegations pertaining to the accused EZ Path product, the brushes of STI's prior art products "comprise bristles that extend inwards and mesh to close the passage channel." Each of these products included brushes made of "black nylon filament." See Exhibit 7; Exhibit 8; and Exhibit 9. Nylon filament is a flexible material that bends inward into the channel when cables or pipes are inserted into the housing. See Stahl Decl. (Ex. 1), ¶¶ 22, 25, 28.

112. In addition, the photograph below is from a 2013 PowerPoint presentation pertaining to the European EZ Path 44+ product. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed "brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel" in paragraph 39 of its Complaint.



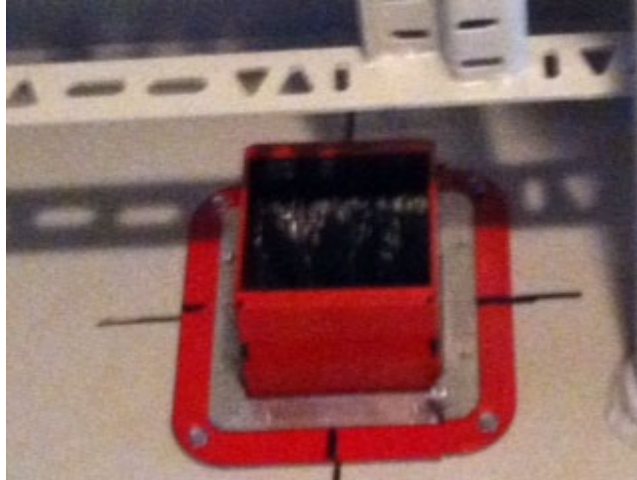
See Exhibit 10 (EZ PATH 44T 2013 PowerPoint); Stahl Decl. (Ex. 1), ¶ 30.

113. As another example, the photograph below is from a PowerPoint presentation dated November 6, 2012, titled “EZD44T Quality Control Procedure,” pertaining to the European EZ Path 44+ product. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel” in paragraph 39 of its Complaint.



See Exhibit 3 (11/6/12 PowerPoint “EZD44T Quality Control Procedure”); Stahl Decl. (Ex. 1), ¶ 33.

114. In addition, the below photograph, which is attached to an email dated August 9, 2013, shows a Marine 300 product installed on a vessel built at Bollinger Shipyard. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel” in paragraph 39 of its Complaint.

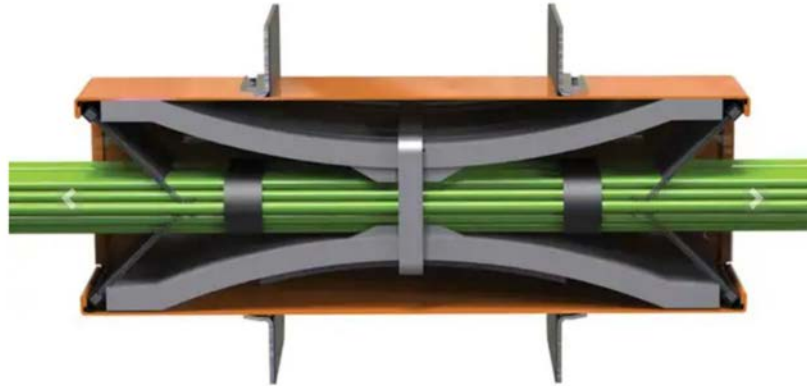


See Exhibit 12 (August 9, 2013 email attaching photographs of Marine 300 product installed on vessel built at Bollinger Shipyard); Stahl Decl. (Ex. 1), ¶ 35.

115. Therefore, to the extent the accused EZ Path product includes “at least two brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also include “at least two brushes mounted on two parallel, opposite flat walls of the passage channel, and wherein the brushes comprise bristles that extend inwards and mesh to close the passage channel.”

116. Based on the below image, Hilti alleges that “the EZ Path Pathway includes a flexible material that is mounted in the passage channel and comprises an intumescent material, wherein the flexible material at least partially curves in an axial direction of the passage channel and wherein the device is suitable for passing

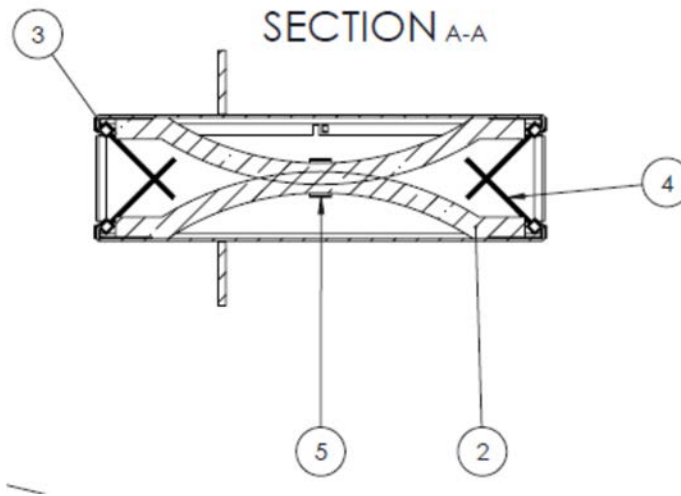
a pipe or cable through an opening in a building, namely the gray intumescent pads shown in the below image”:



See Complaint ¶ 40.

117. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’090 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

118. The below image is an excerpt from an engineering drawing of the Marine 300 product dated August 13, 2013. The cross section of the Marine 300 product shown in this August 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 40 of Hilti’s Complaint.

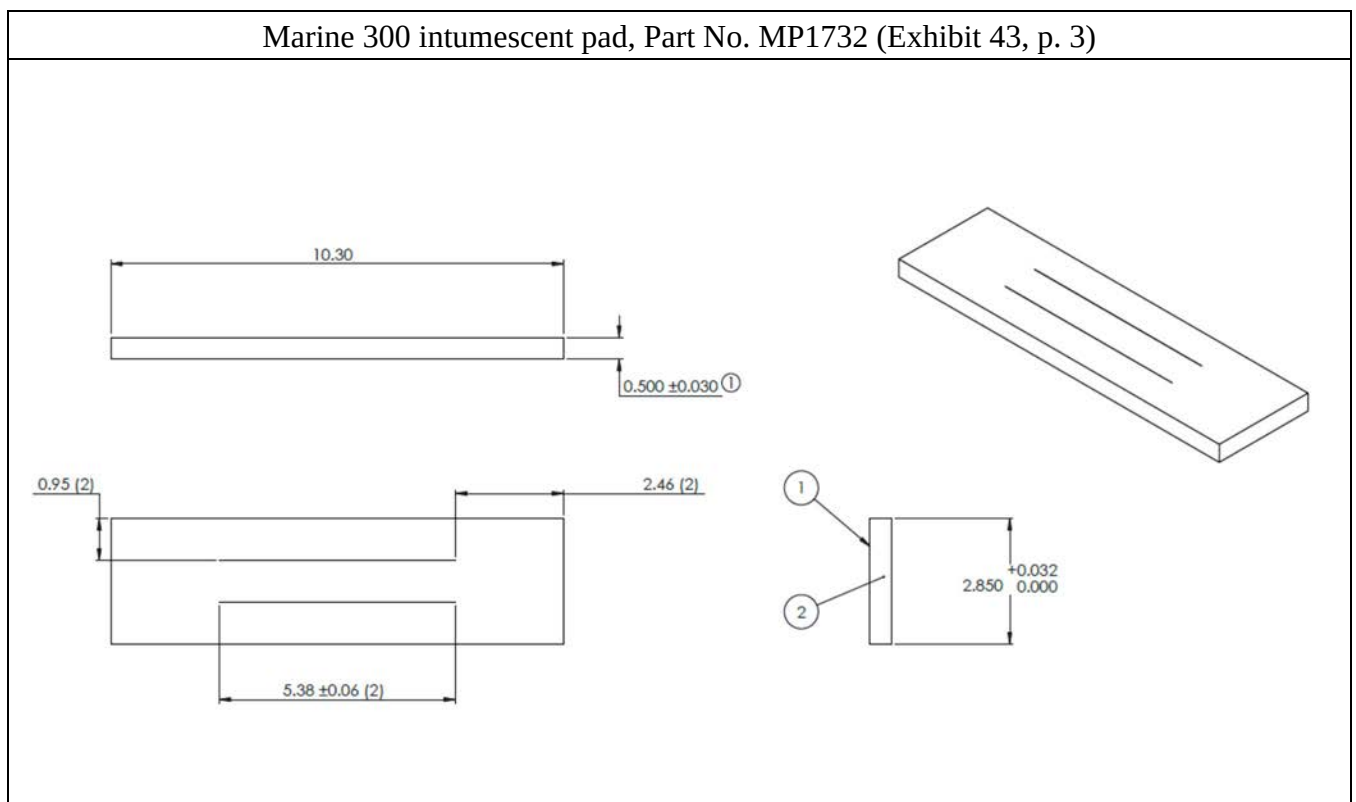


See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); see also ¶ 103 above.

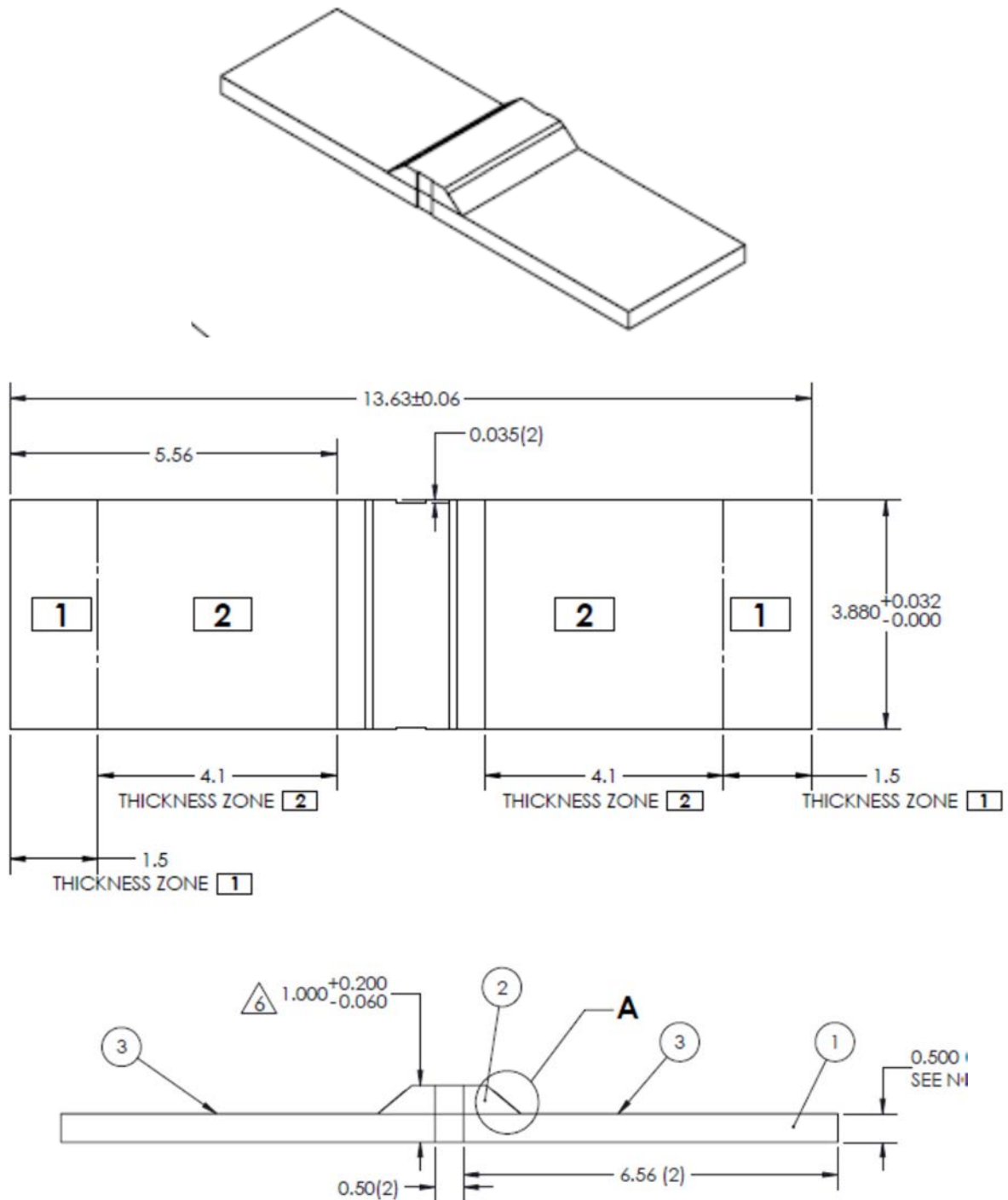
119. Item number 2 in the August 13, 2013 engineering drawing corresponds to part number MP1732, “EZ Path 300 Marine Intumescent Foam Pad.” See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013). Apart from some minor variations—for example, in size and tolerances—these intumescent foam pads on the Marine 300 product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “flexible material that is mounted in the passage channel and comprises an intumescent material, wherein the flexible material at least partially curves in an axial direction of the passage channel.” Stahl Decl. (Ex. 1), ¶ 23. The August 13, 2013 engineering drawing depicts the curvature of the intumescent pads,

similar to the curvature of the intumescent pads depicted in the CAD rendering of the accused EZ Path product shown in paragraph 40 of the Complaint.

120. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the Marine 300 intumescent pads (part number MP1732 – Exhibit 43, p. 3) and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)

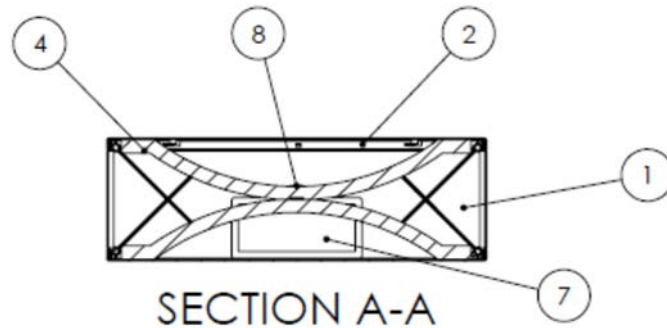


See Exhibit 43, Exhibit 44, and Exhibit 45; see also Stahl Decl. (Ex. 1), ¶ 23.

121. The Marine 300 and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size; the accused EZ Path is a larger device than the Marine 300. The pads are scaled to fit the size of the particular product. In addition, slight differences in the pads—for instance, the two parallel score lines on the MP1732 intumescent pad and the slight notch or indentation on the side of the MPASSY767 intumescent pad—are attributable to the evolution of the manufacturing process for these pads. For example, notches were added to the pads to make the assembly process easier. In addition, a small component, identified as Item No. 2 in the engineering drawing of the intumescent pad of the accused EZ Path (Exhibit 45), was added as an additional remedial sealing component to help reduce air leakage. Apart from being slightly different in size, having minor cosmetic differences, and having slight differences in their tolerances, the intumescent pads on the Marine 300 and accused EZ Path are otherwise identical. Stahl Decl. (Ex. 1), ¶ 23.

122. The below image is an excerpt from an engineering drawing of the Marine 400 product dated March 1, 2013. The cross section of the Marine 400 product shown in this March 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 40 of Hilti's

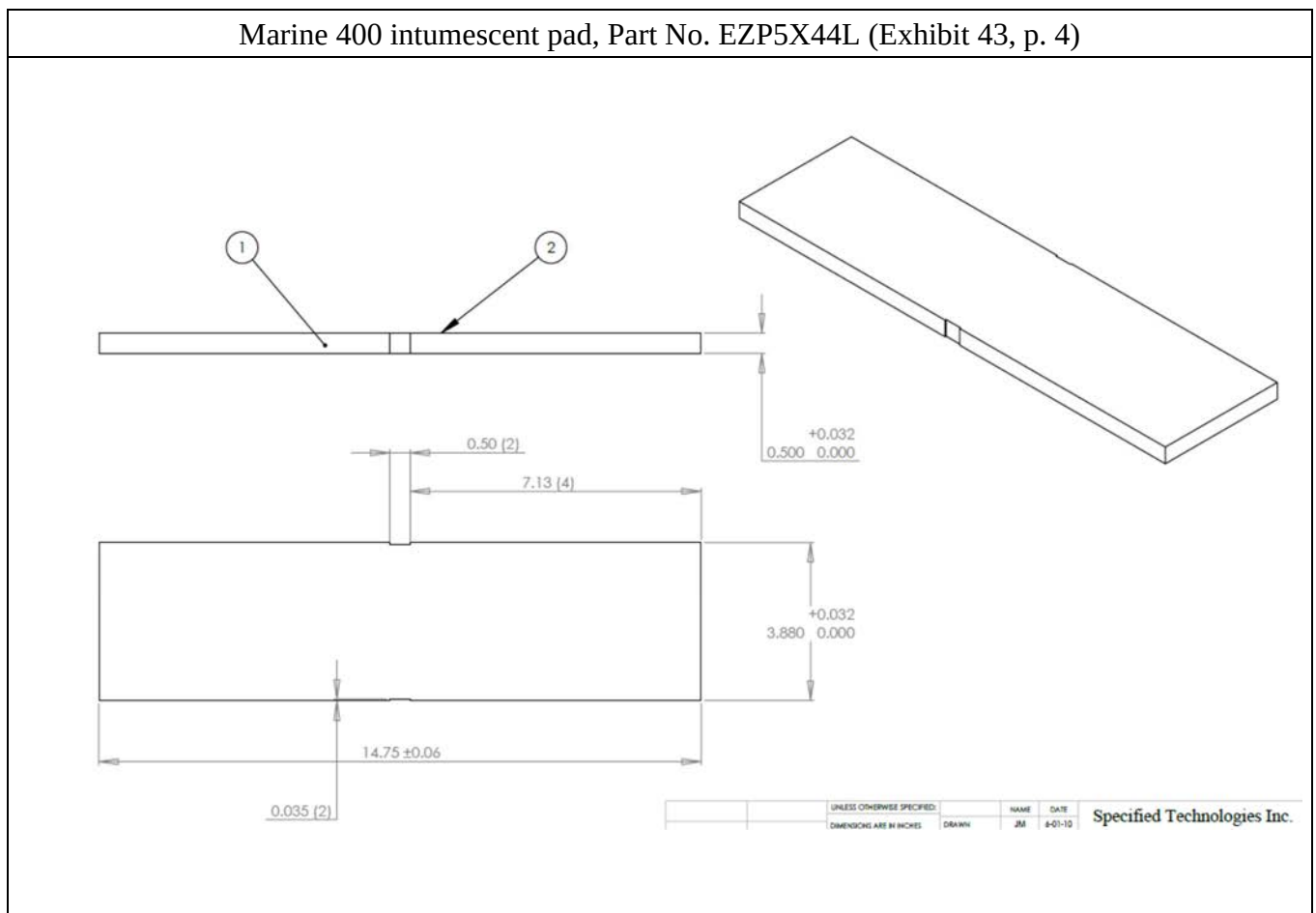
Complaint.



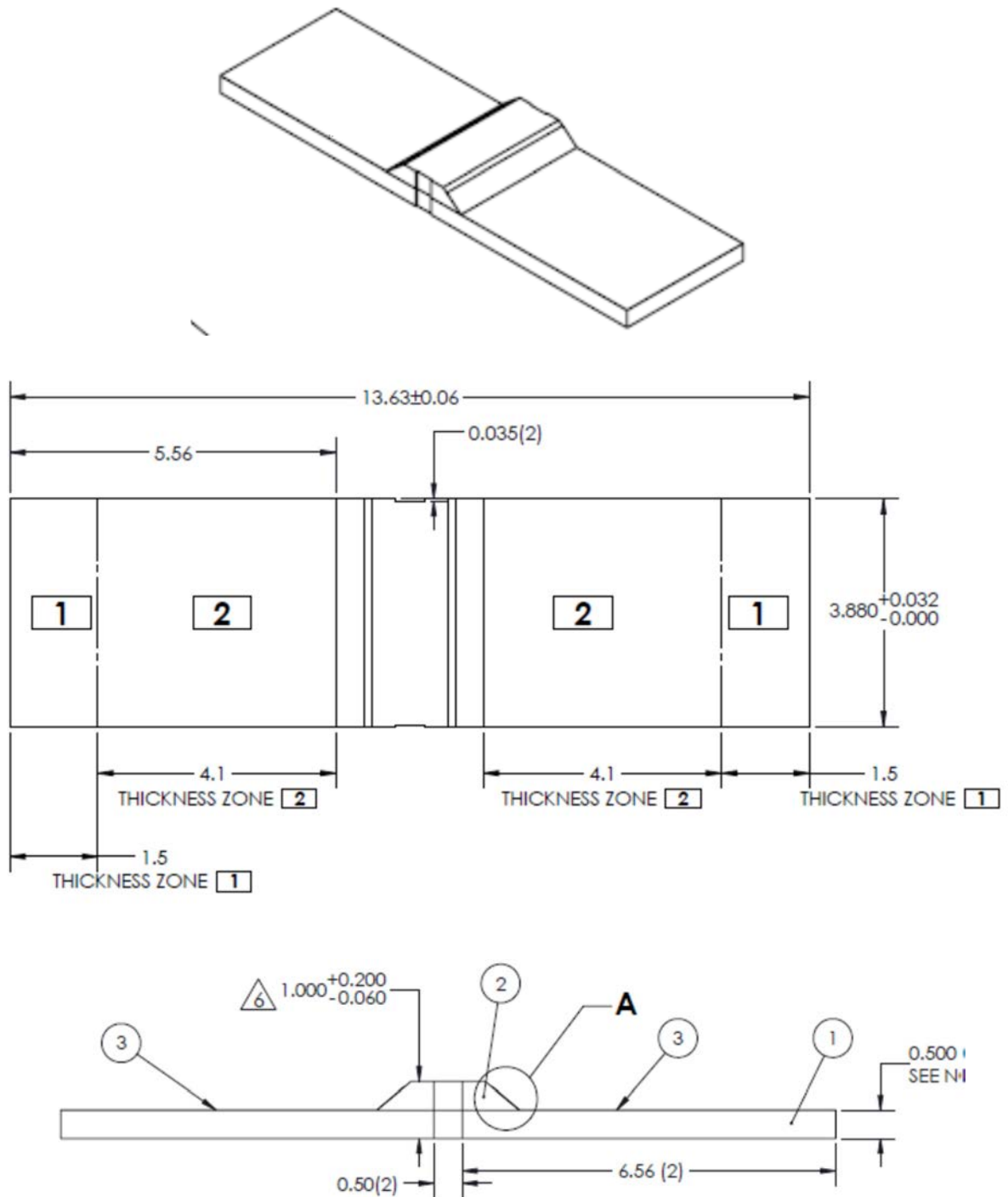
See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); see also ¶ 107 above.

123. Item number 4 on the March 1, 2013 engineering drawing corresponds to part number EZP5X44L, “EZ Path 400 Marine Fire Rated Pathway Intumescent Foam Pad.” See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013). Apart from some minor variations—for example, in size and tolerances—these intumescent foam pads on the Marine 400 product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “flexible material that is mounted in the passage channel and comprises an intumescent material, wherein the flexible material at least partially curves in an axial direction of the passage channel.” Stahl Decl. (Ex. 1), ¶ 26. The March 1, 2013 engineering drawing depicts the curvature of the intumescent pads, similar to the curvature of the intumescent pads depicted in the CAD rendering of the accused EZ Path product shown in paragraph 40 of the Complaint.

124. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the Marine 400 intumescent pads (part number EZP5X44L – Exhibit 43, p. 4) and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)

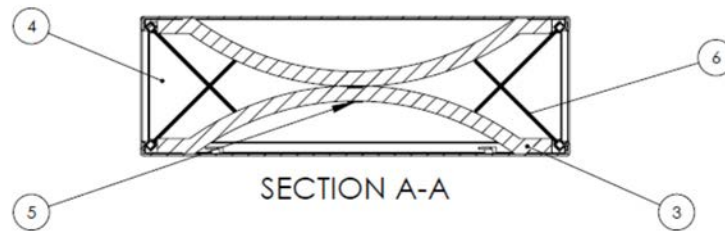


See Exhibit 43, Exhibit 44, Exhibit 45; Stahl Decl. (Ex. 1), ¶ 26.

125. The Marine 400 and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size. The pads are scaled to fit the size of the particular product. The pads also differ slightly in that the intumescent pad of the accused EZ Path has an additional small component, identified as Item No. 2 on Exhibit 45, that was added as an additional remedial sealing component to help reduce air leakage. Apart from being slightly different in size, having a minor cosmetic difference, and having slight differences in their tolerances, the intumescent pads on the Marine 400 and accused EZ Path are otherwise identical. Stahl Decl. (Ex. 1), ¶ 26.

126. In addition, the May 2013 STI Marine Firestop brochure indicates that STI's Marine Fire Rated Pathways, including the Marine 300 and Marine 400 products, are "comprised of compressible foam pads installed to form an arch." See Exhibit 5 (May 2013 STI Marine Firestop brochure, at 4).

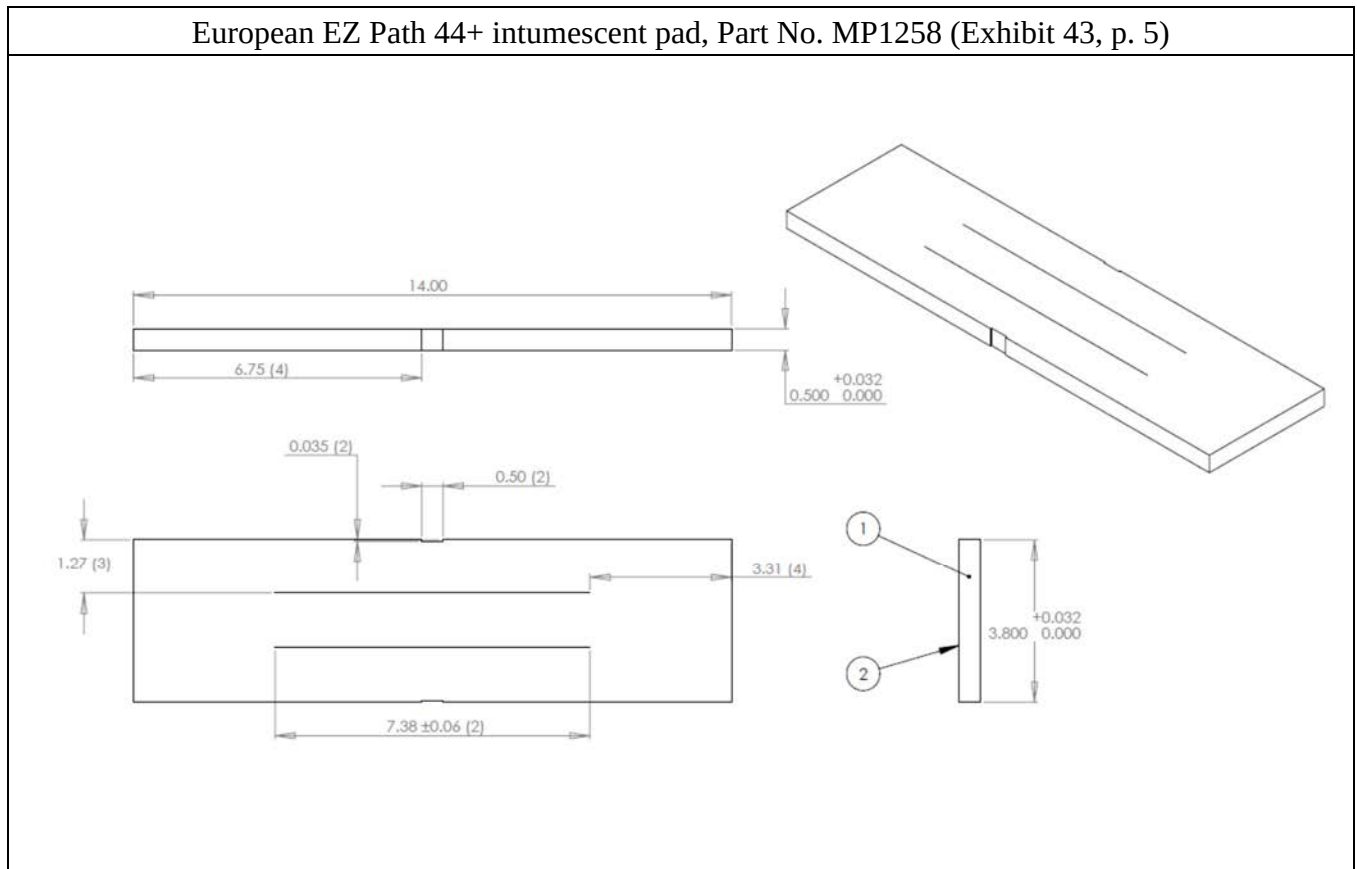
127. The below image is an excerpt from an engineering drawing of the European EZ Path 44+ product dated September 12, 2012. The cross section of the European EZ Path 44+ product shown in this September 2012 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 40 of Hilti's Complaint.



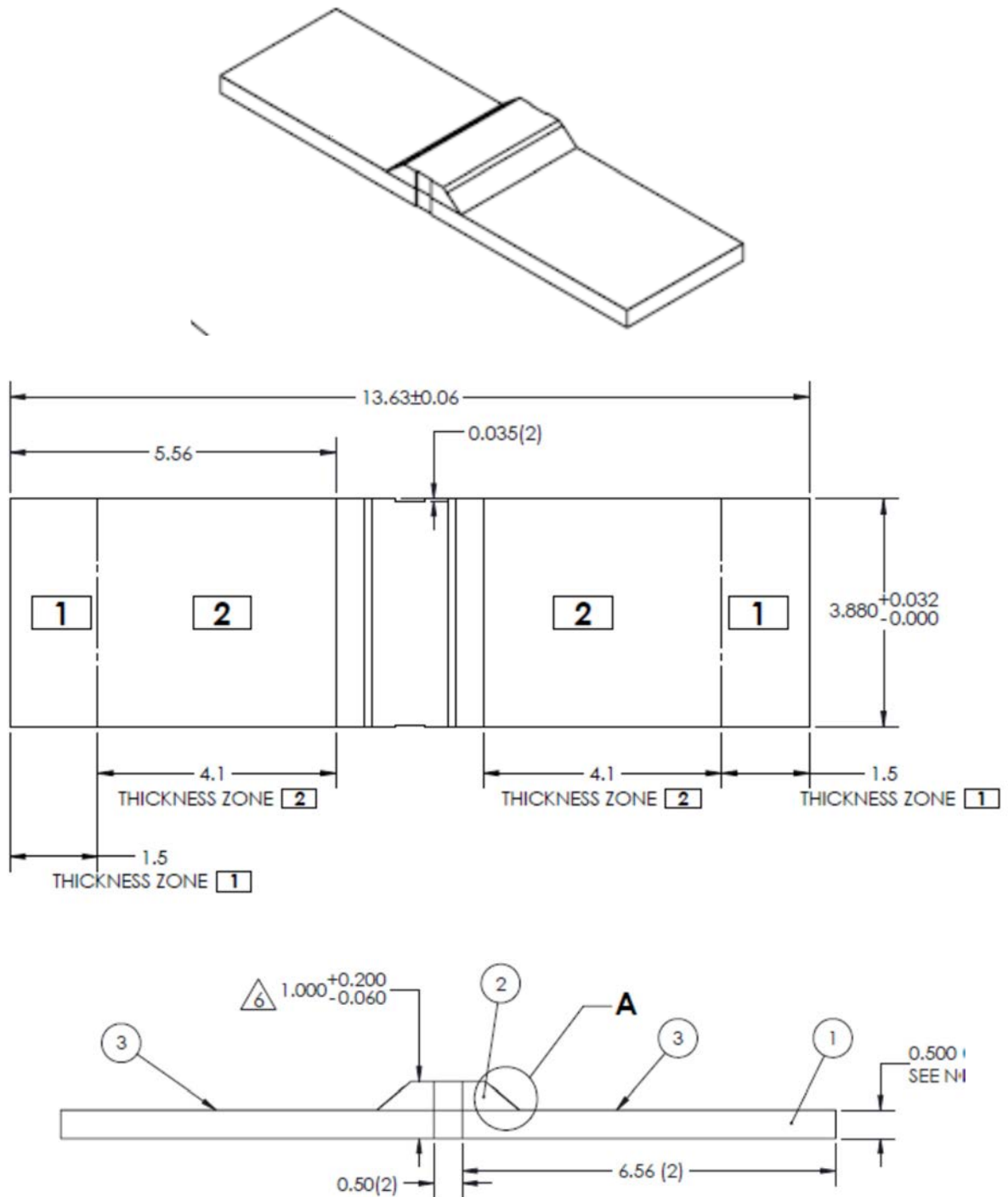
See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012); *see also* ¶ 109 above.

128. Item number 3 in the September 12, 2012 engineering drawing corresponds to part number MP1258, “Series 44+ Europe EZ Path Intumescent Foam Pad.” See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012). Apart from some minor variations—for example, in size and tolerances, these intumescent foam pads on the European EZ Path 44+ product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “flexible material that is mounted in the passage channel and comprises an intumescent material, wherein the flexible material at least partially curves in an axial direction of the passage channel.” See Stahl Decl. (Ex. 1), ¶ 29. The September 12, 2012 engineering drawing depicts the curvature of the intumescent pads, similar to the curvature of the intumescent pads depicted in the CAD rendering of the accused EZ Path product shown in paragraph 40 of the Complaint.

129. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the European EZ Path 44+ intumescent pads (part number MP1258 – Exhibit 43, p. 5) and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



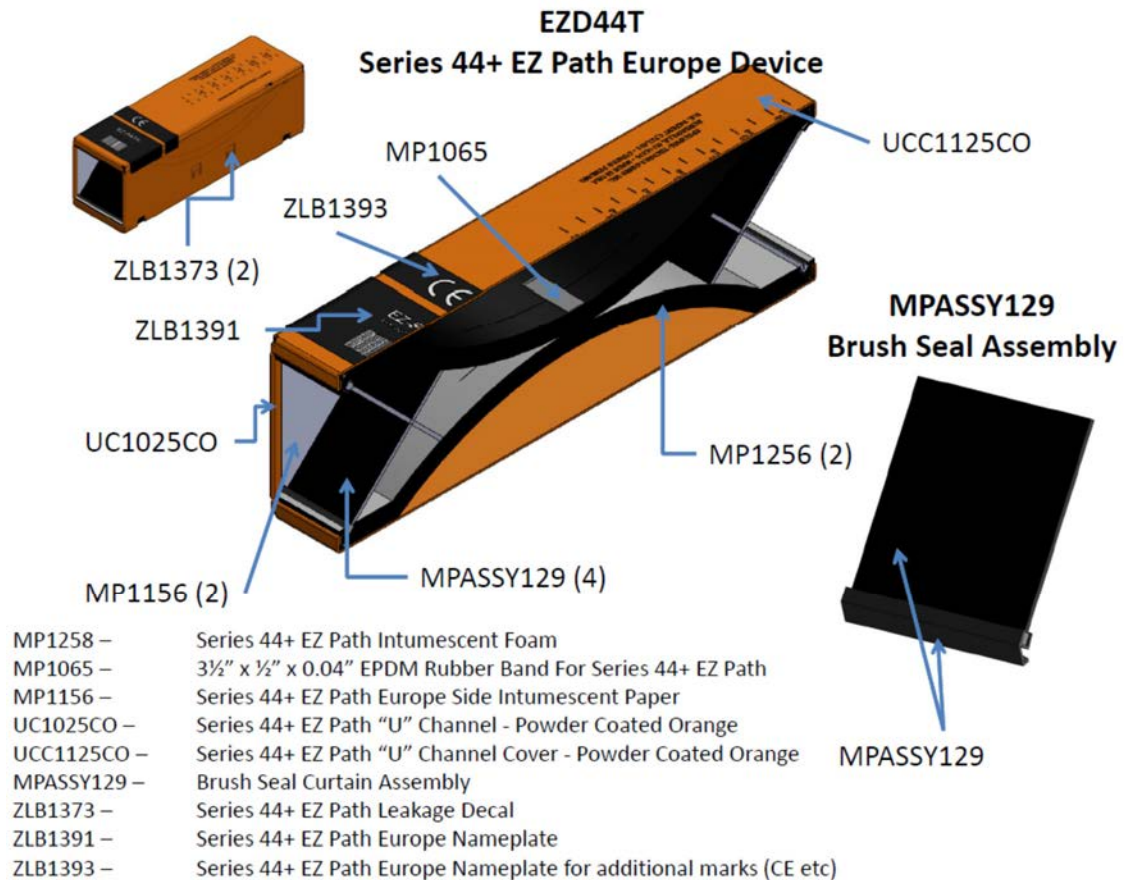
Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)



See Exhibit 43, Exhibit 44, Exhibit 45; Stahl Decl. (Ex. 1), ¶ 29.

130. The European EZ Path 44+ and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size. The pads are scaled to fit the size of the particular product. The pads also differ slightly in that the European EZ Path 44+ intumescent pads have two parallel score lines (which the intumescent pads of the accused EZ Path do not have), and the accused EZ Path intumescent pads have a small component (identified as Item No. 2 on Exhibit 45) that was added as an additional remedial sealing component to help reduce air leakage (which the European EZ Path 44+ intumescent pads do not have). Apart from being slightly different in size, having minor cosmetic differences, and having slight differences in their tolerances, the intumescent pads on the European EZ Path 44+ and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 29.

131. In addition, a PowerPoint slide depicting a CAD representation of the European EZ Path 44+ product clearly shows the foam intumescent pads, identified as part no. MP1258:



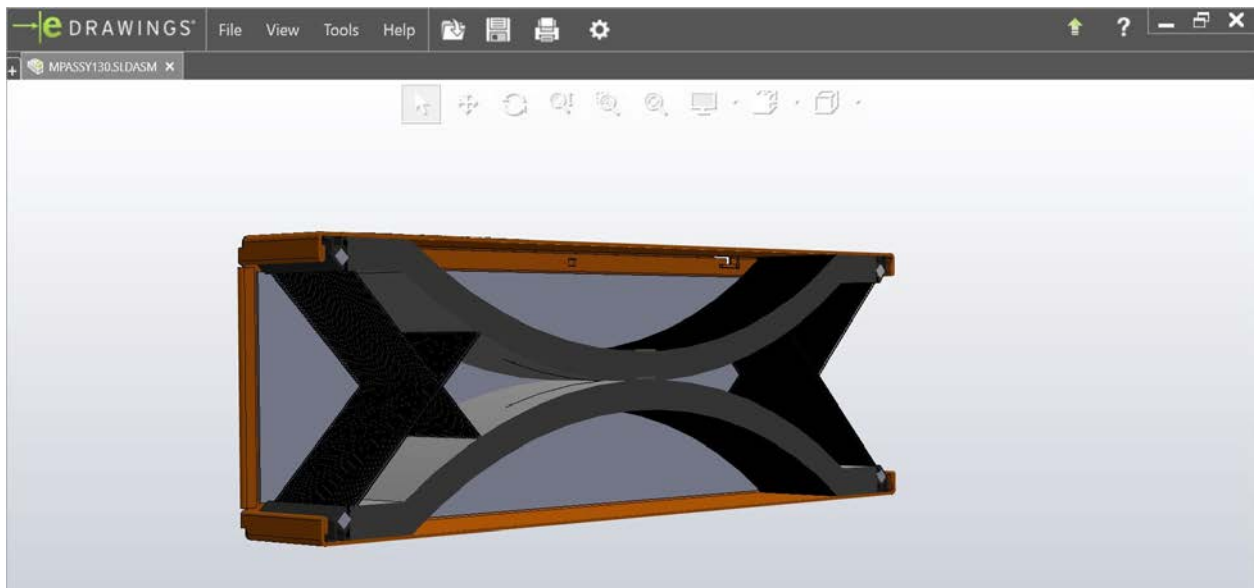
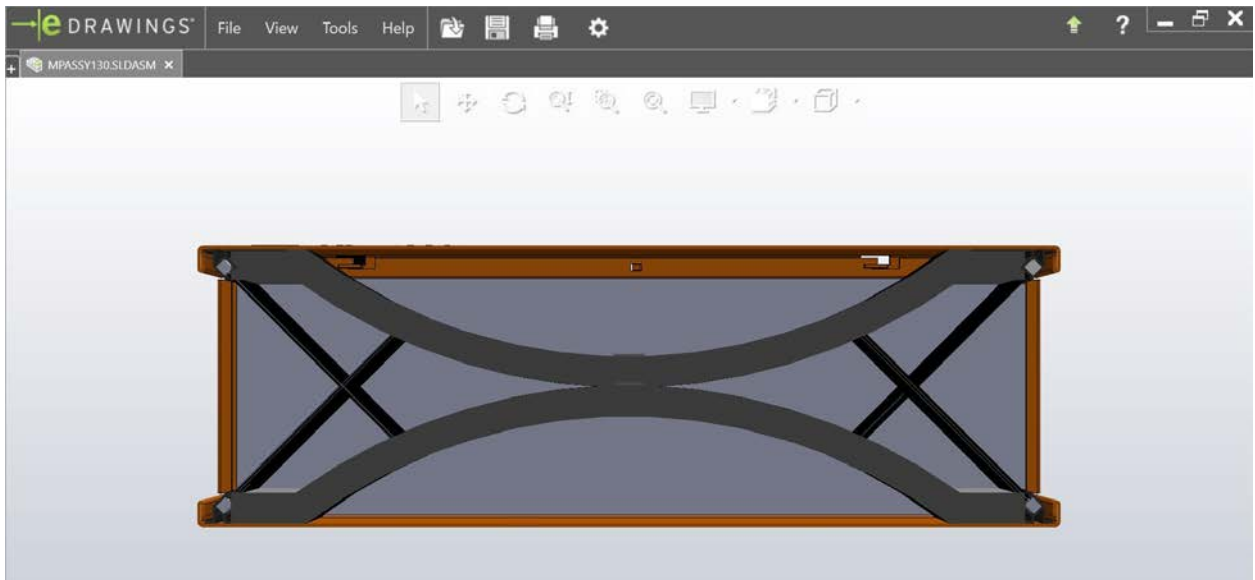
See Exhibit 13 (EZD44T.pptx); Stahl Decl. (Ex. 1), ¶ 37.

132. The metadata on this PowerPoint slide indicates the following: "Content created 2/27/12 9:08 AM" and "Date last saved 9/11/12 2:16 PM." See Exhibit 14 (metadata for EZD44T.pptx). See Stahl Decl. (Ex. 1), ¶ 38. Therefore, the document was created before the earliest priority date of the '090 Patent.

133. Additionally, 3D SolidWorks files that were created by STI before the earliest priority date of the '090 Patent show the various components of the prior art products that were on sale, sold, described in printed publications, in public use, and/or were otherwise available to the public before the earliest priority date of the

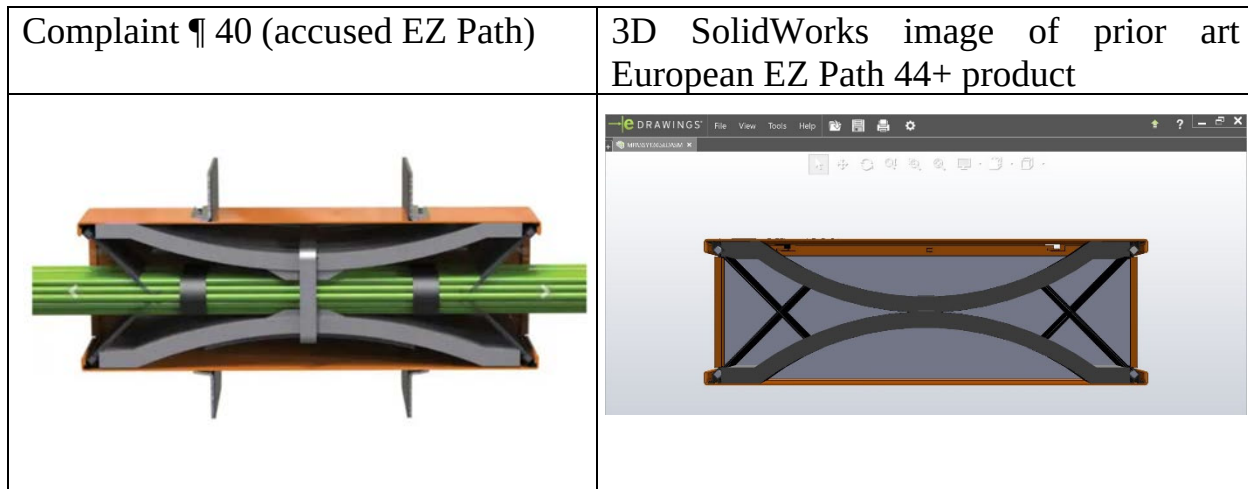
'090 Patent.

134. For example, the below excerpt of a 3D SolidWorks file shows two cross-sectional views of the prior art European EZ Path 44+ product:



See Exhibit 15 (3D SolidWorks image of European EZ Path 44+ product). These 3D images are virtually identical to the cross-sectional image of the accused EZ Path

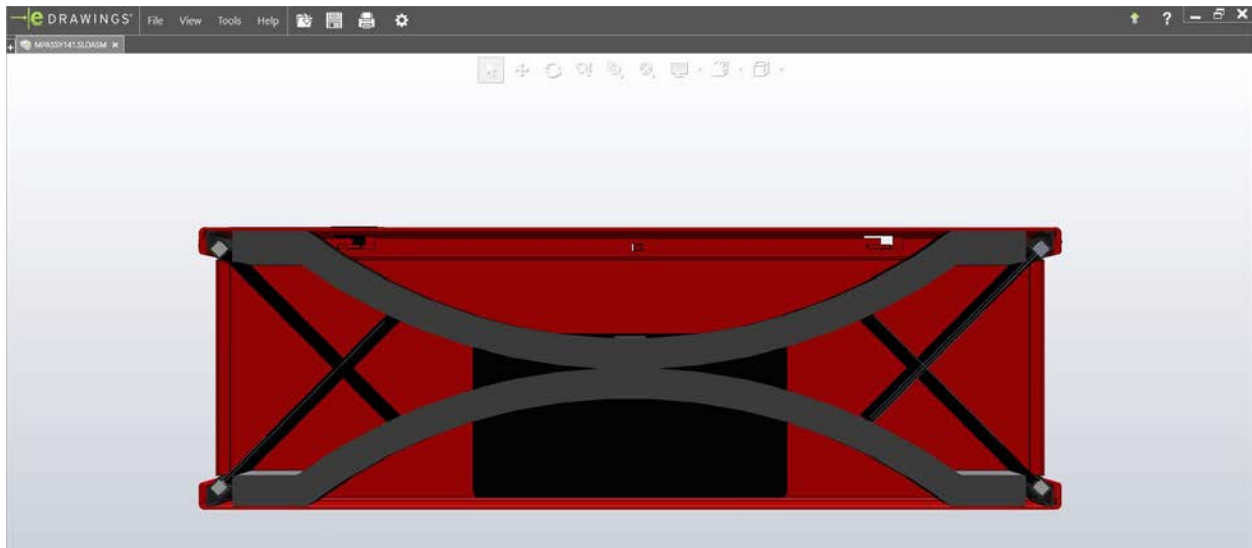
44+ product shown in paragraph 40 of the Complaint. *Compare* Complaint ¶ 40 and 3D SolidWorks image of European EZ Path 44+ product (Ex. 15):



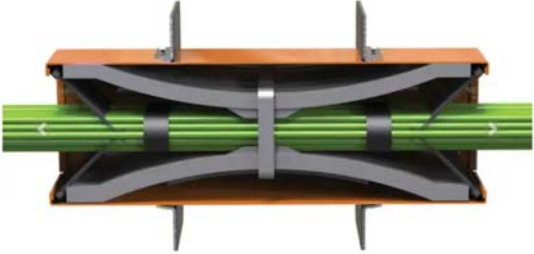
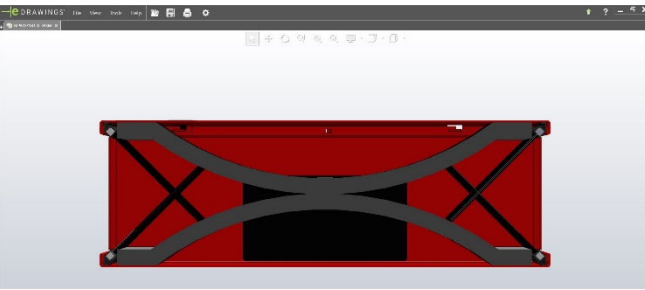
135. Exhibit 15 is a compilation of screenshots taken from a SolidWorks Assembly file of the European EZ Path 44+ viewed using the eDrawings program. The metadata for this 3D SolidWorks image indicates that it was created on July 16, 2012—more than one year before the earliest priority date of the '090 Patent. See Exhibit 15 at p. 15. The source data for the interactive 3D model shown is the SolidWorks Assembly file for the European EZ Path 44+ that was created on July 16, 2012. Exhibit 15 is a true and accurate representation of the European EZ Path 44+ as it appeared in 2012, with the exception of a minor change in 2021 to the brush seal holder used in the product, as discussed above. Lopes Decl. (Ex. 16), ¶¶ 4, 6-9.

136. In addition, the below excerpt of a 3D SolidWorks file shows two

cross-sectional views of the prior art Marine 400 product:



See Exhibit 18 (3D SolidWorks image of Marine 400 product). These 3D images are virtually identical to the cross-sectional image of the accused EZ Path 44+ product shown in paragraph 40 of the Complaint. Compare Complaint ¶ 40 and 3D SolidWorks image of Marine 400 product (Ex. 18):

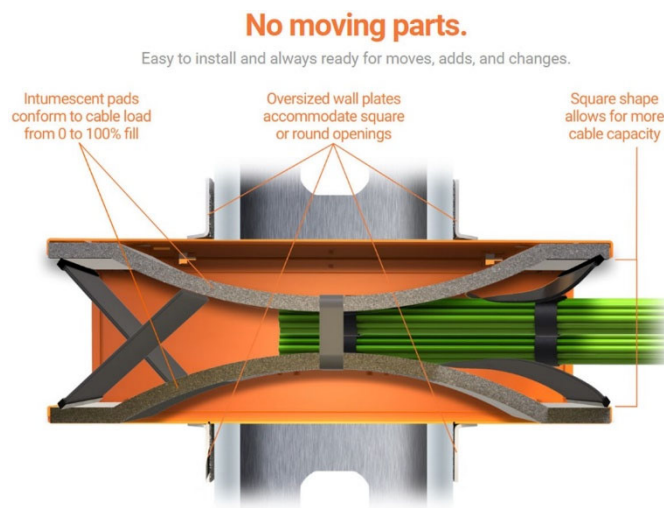
Complaint ¶ 40 (accused EZ Path)	3D SolidWorks image of prior art Marine 400 product
	

137. Exhibit 18 is a screenshot taken from a SolidWorks Assembly file of the Marine 400 viewed using the eDrawings program. The metadata for this 3D SolidWorks image indicates that it was created on September 24, 2012. *See* Exhibit 18 at p. 3. This SolidWorks Assembly file of the Marine 400 has not been changed since September 24, 2012. The source data for the interactive 3D model shown is the SolidWorks Assembly file for the Marine 400 that was created on September 24, 2012. Exhibit 18 is a true and accurate representation of the Marine 400 as it appeared by June 28, 2013. *See* Lopes Decl. (Ex. 16), ¶¶ 10-12.

138. Therefore, to the extent the accused EZ Path product includes a “flexible material that is mounted in the passage channel and comprises an intumescent material, wherein the flexible material at least partially curves in an axial direction of the passage channel,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products

necessarily also include a “flexible material that is mounted in the passage channel and comprises an intumescent material, wherein the flexible material at least partially curves in an axial direction of the passage channel.”

139. Based on the below image, Hilti alleges that “the EZ Path Pathway is suitable for passing a pipe or cable through an opening in a building, as shown in the below image”:



See Complaint ¶ 41.

140. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’090 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

141. First, based on Hilti’s allegation that the accused EZ Path practices this limitation, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also are “suitable for passing a pipe or cable through an

opening in a building.” For example, the May 2013 STI Marine Firestop brochure, which pertains to the Marine 300 and Marine 400 products, states that “cables pass through the device.” See Exhibit 5 (May 2013 STI Marine Firestop brochure, at 4).

142. In addition, the below photograph, which is attached to an email dated August 9, 2013, shows a Marine 300 product installed on a vessel built at Bollinger Shipyard. The photograph shows cables passing through an opening in a building—in this case, a wall in a ship—via the housing of the Marine 300 product.



See Exhibit 12 (August 9, 2013 email attaching photographs of Marine 300 product installed on vessel built at Bollinger Shipyard); Stahl Decl. (Ex. 1), ¶ 36.

143. In addition, the below photograph from a 2013 PowerPoint pertaining to the European EZ Path 44+ product shows cables passing through an opening in a wall via the housing of the product.



See Exhibit 10 (EZ PATH 44T 2013 PowerPoint); Stahl Decl. (Ex. 1), ¶ 31.

144. Therefore, to the extent the accused EZ Path product is “suitable for passing a pipe or cable through an opening in a building,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily are also “suitable for passing a pipe or cable through an opening in a building.”

B) The '090 Patent is invalid for additional reasons under 35 U.S.C. §§ 102, 103, and/or 112.

145. In addition to the reasons set forth in Section A above, the asserted claim(s) of the '090 Patent are invalid under 35 U.S.C. §§ 102, 103 and/or 112.

146. For example, the asserted claim(s) of the '090 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. No. 4,538,389 (Heinen)
- U.S. Pat. No. 5,456,050 (Ward)

- U.S. Pat. No. 6,172,052 (Takahashi)
- U.S. Pat. No. 6,426,463 (Munzenberger)
- U.S. Pat. No. 6,632,999 (Sempliner)
- U.S. Pat. No. 6,732,481 (Stahl), owned by STI
- U.S. Pat. No. 6,928,777 (Cordts)
- U.S. Pat. No. 7,373,761 (Stahl), owned by STI
- U.S. Pat. No. 8,051,614 (Peck)
- U.S. Pat. No. 8,188,382 (Monden)
- U.S. Pat. No. 8,266,854 (Reddicliffe)
- U.S. Pat. No. 8,833,478 (Zernach)
- U.S. Pat. No. 8,887,458 (Lopes), owned by STI
- U.S. Pat. No. 9,046,194 (Gandolfo), owned by STI
- U.S. Pat. No. 7,523,590 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2006/0037264 (Paetow)
- U.S. Pat. App. Pub. No. 2013/0277918 (Fitzgerald)
- U.S. Pat. App. Pub. No. 2013/0307225 (Boyd)
- WO2004/015319 (Porter)
- WO2013/160776 (Ramorino)
- EP0869303 (Seebode)
- DE10043430 (Munzenberger)

- The EZ-Path System – The Zero-Maintenance Solution for Firestopping Cables, Specified Technologies, Inc. (Rev. 03/2008)
- 2003 STI brochure (Exhibit 41)
- May 2013 STI Marine Firestop brochure (Exhibit 5)

147. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible filing date of the '090 Patent, to achieve the asserted claim(s) of the '090 Patent for at least the following reasons: (1) it was well known and understood in the art that a sleeve comprising a passageway with intumescent material located therein could be, and was, used as a firestopping apparatus; (2) it was well known and understood in the art that the intumescent material should permit a pipe or cable to pass through the sleeve; (3) it was well known and understood in the art that a brush or curtain could be, and was, used to close off the ends of the sleeve while permitting a pipe or cable to pass through the sleeve; (4) it was well known and understood in the art that permitting cables to be inserted or removed without removal or reinstallation of the firestopping apparatus was advantageous; and (5) it was well known and understood in the art that bristles and flexible intumescent material permitted insertion and removal of cables while maintaining a sealing effect when the cables were in the device. The combination of one or more of these prior art references would have yielded entirely predictable results.

148. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 3: Declaration of Invalidity of U.S. Patent No. 11,242,946

149. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

150. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '946 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '946 Patent is valid, and specifically alleges that STI infringes claim 1 of the '946 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Series 44+ Fire Rated Pathway (the "EZ Path Pathway"). STI contends that each asserted claim of the '946 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

151. The '946 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

A) The '946 Patent is invalid under 35 U.S.C. § 102 – on sale bar, printed publication, public use.

152. At least claim 1 of the '946 Patent is invalid under 35 U.S.C. § 102 because STI's Marine 300, Marine 400, and European EZ Path 44+ products were

on sale, actually sold, described in printed publications, in public use, and/or were otherwise available to the public before December 9, 2013, the earliest priority date of the '946 Patent.

153. As explained above in paragraphs 11-17, the Marine 300, Marine 400, and European EZ Path 44+ products are prior art to the '946 Patent because they were sold before December 9, 2013, the earliest potential priority date of the '946 Patent. See Exhibit 6 (6/28/13 invoice) and Exhibit 4 (11/30/12 invoice); see also Stahl Decl. (Ex. 1), ¶¶ 12, 16.

154. As discussed further below, the Marine 300, Marine 400, and European EZ Path 44+ products that STI sold in 2012 and 2013 have nearly identical components as the accused EZ Path product that Hilti alleges are covered by claim 1 of the '946 Patent. See Stahl Decl. (Ex. 1), ¶¶ 14, 18. Any minor differences between the components of STI's prior art products and the accused EZ Path product are insignificant and have no bearing on the question of whether STI's prior art products anticipate claim 1 of the '946 Patent or on whether they invalidate any other asserted claim.

155. Claim 1 of the '946 Patent recites:

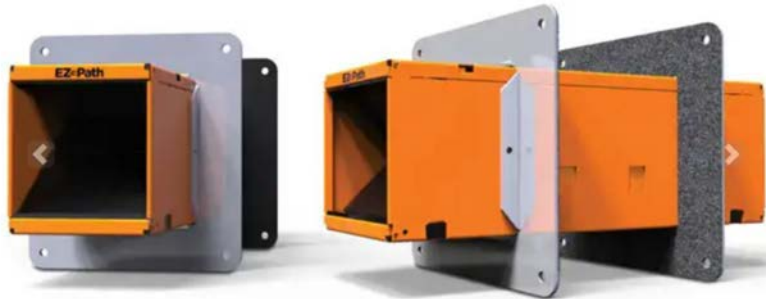
1. A device, comprising:

a housing comprising a channel with open ends;

a curtain extending into the channel at a first location; and

a fire-retardant material extending into the channel at a second location, wherein the curtain moves within the channel in an installed state, the curtain moving to accommodate passage of an object through the channel, and wherein the fire-retardant material curves in an axial direction within the channel and at least partially surrounds the object in the channel in the installed state, the housing coupled to an opening in a barrier.

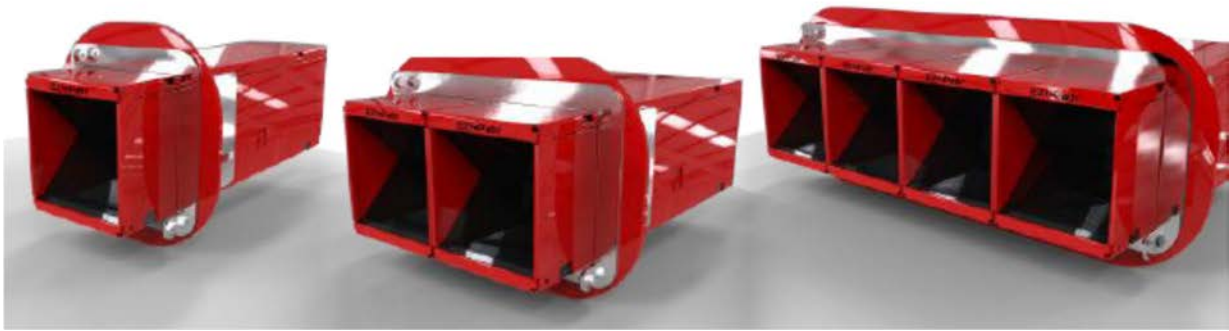
156. Based on the below image, Hilti alleges that “the EZ Path Pathway is a device” that “includes a housing comprising a channel with open ends, namely the orange galvanized steel pathway shown in the below image”:



See Complaint ¶¶ 49-50.

157. Given Hilti’s allegation that the accused EZ Path product practices these limitations of claim 1 of the ’946 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice these limitations.

158. For example, the STI Marine Firestop brochure, dated May 2013, includes photographs of the Marine 300 and Marine 400 products that are virtually identical to the photograph of the accused EZ Path product that Hilti included in paragraphs 49-50 of its Complaint:



Compare Complaint ¶ 49 and May 2013 STI Marine Firestop brochure:

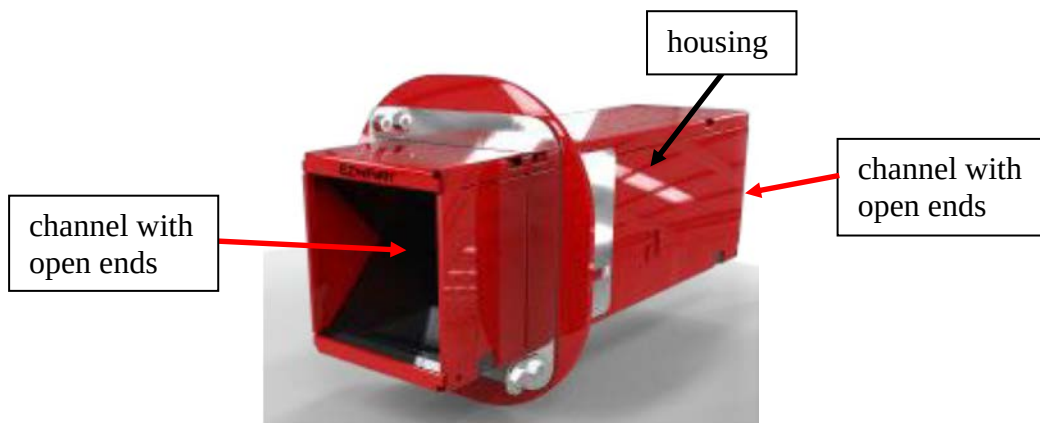
Complaint ¶ 49 (accused EZ Path)	Prior art Marine 300/400 product shown in May 2013 STI Marine Firestop brochure
	

See Exhibit 5 (May 2013 STI Marine Firestop brochure); Stahl Decl. (Ex. 1), ¶ 17.

159. The May 2013 STI Firestop Brochure was publicly available in or around May 2013. Printed copies of the May 2013 STI Firestop Brochure were

circulated to more than 1,000 of STI's customers and potential customers before December 2013. Stahl Decl. (Ex. 1), ¶ 17.

160. The below photo from the May 2013 STI Marine Firestop brochure (with added annotations) identifies the features of the Marine 300 and Marine 400 products that correspond to these elements of claim 1 of the '946 Patent according to Hilti's apparent understanding of the claim:



See Exhibit 5 (May 2013 Marine Firestop brochure).

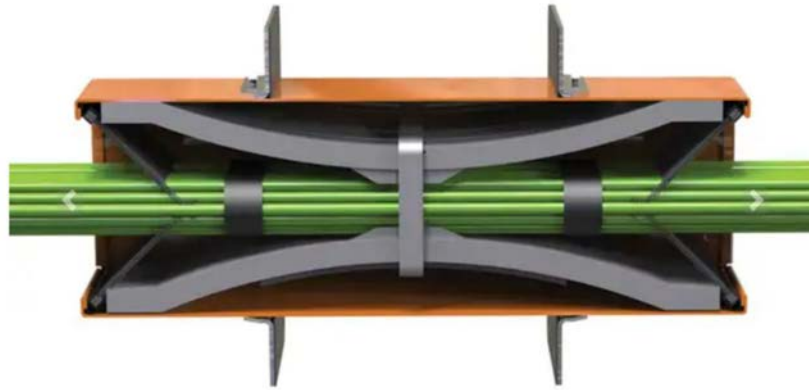
161. In addition, a PowerPoint presentation dated November 6, 2012, titled "EZD44T Quality Control Procedure," includes photographs of the European EZ Path 44+ product that are virtually identical to the photograph of the accused EZ Path product that Hilti included in paragraphs 49-50 of its Complaint:

Complaint ¶ 49 (accused EZ Path)	Prior art European EZ Path 44+ product shown in 11/6/12 PowerPoint
	

See Exhibit 3 (EZD44T Quality Control Procedure); Stahl Decl. (Ex. 1), ¶ 13.

162. Therefore, to the extent the accused EZ Path product is a “device” that includes a “housing comprising a channel with open ends,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily are also devices that include a “housing comprising a channel with open ends.”

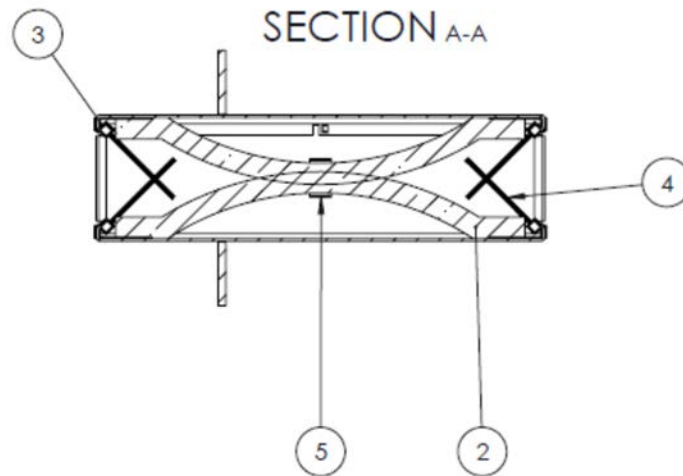
163. Based on the below image, Hilti alleges that “the EZ Path Pathway includes a curtain extending into the channel at a first location, namely the two brushes on the left and/or right side of the housing shown in the below image”:



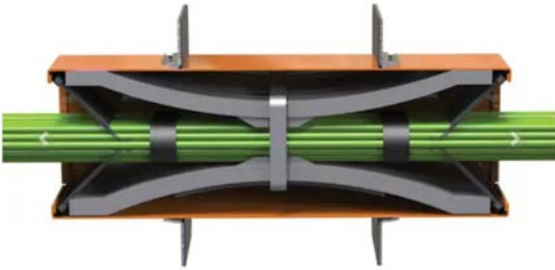
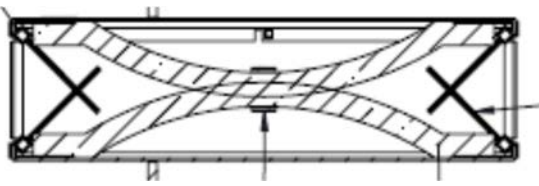
See Complaint ¶ 51.

164. Given Hilti's allegation that the accused EZ Path product practices this limitation of claim 1 of the '946 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

165. The below image is an excerpt from an engineering drawing of the Marine 300 product dated August 13, 2013. The engineering drawing accurately depicts the Marine 300 product that was sold prior to December 9, 2013. Stahl Decl. (Ex. 1), ¶ 20. The cross section of the Marine 300 product shown in this August 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 51 of Hilti's Complaint.



Compare Complaint ¶ 51 and 8/13/13 engineering drawing:

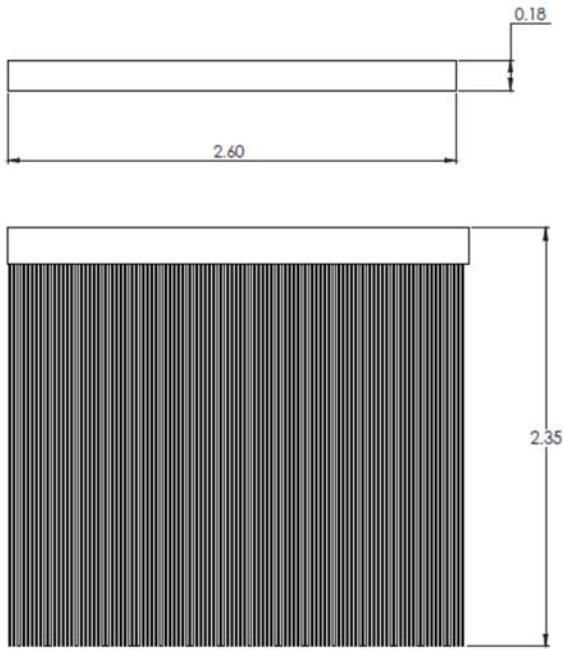
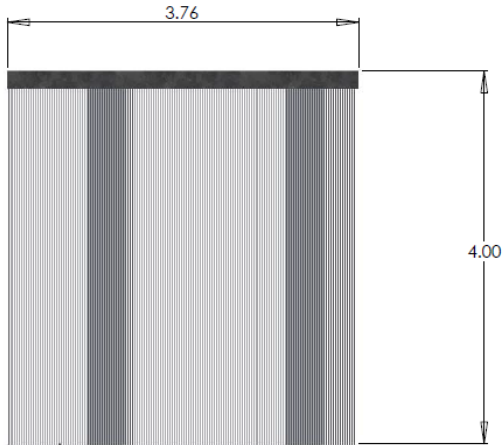
Complaint ¶ 51 (accused EZ Path)	Prior art Marine 300 product shown in 8/13/13 engineering drawing
	

See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013).

166. Item number 4 in the August 13, 2013 engineering drawing corresponds to part number MP1711, “EZ Flex Section C Brush - 2.35" OAT, 2.60" length, 0.010" diam black nylon filament, nylon channel.” See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013). Apart from very minor differences in size, these brushes on the Marine 300 product are otherwise

identical to the accused EZ Path product's alleged "two brushes on the left and/or right side of the housing," which Hilti alleges constitute the claimed "curtain extending into the channel at a first location." See Stahl Decl. (Ex. 1), ¶ 21.

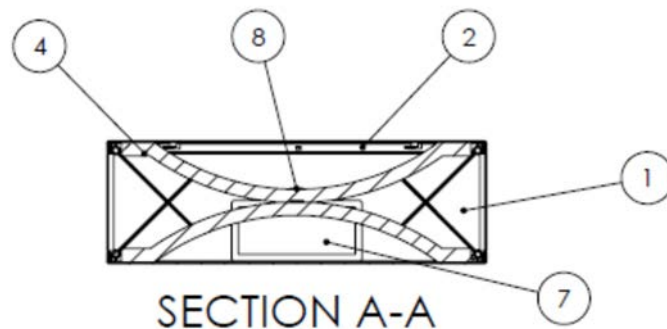
167. The part number of the brush on the accused EZ Path is MP1354, as shown on Exhibit 44. The engineering drawings of the brushes show the minor differences in dimensions between the Marine 300 brushes (part number MP1711 – Exhibit 43, p. 2) and the accused EZ Path brushes (part number MP1354 – Exhibit 43, p. 1), as illustrated and highlighted below:

Marine 300 brushes, Part No. MP1711 (Exhibit 43, p. 2)	Accused EZ Path brushes, Part No. MP1354 (Exhibit 43, p. 1)
	 SFC140BL010 Section C EZ-Flex Brush, 4.25" OAT, 0.010" dia black level nylon filament, nylon channel, brush and holder assembled, 3.84" length; tolerance on holder length +/- .010", tolerance on brush length +/- 0.031" PROPRIETARY AND CONFIDENTIAL

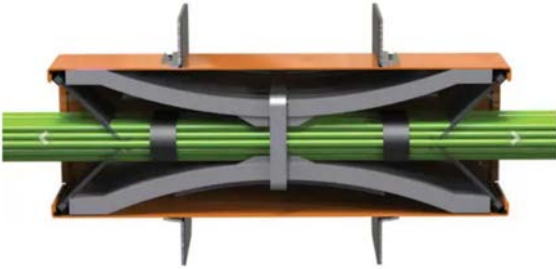
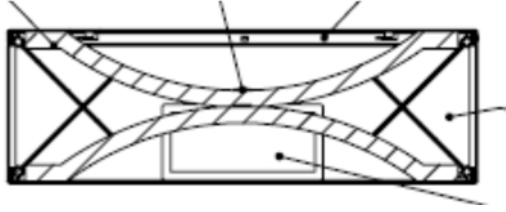
See Exhibit 43; Exhibit 44; Stahl Decl. (Ex. 1), ¶ 21.

168. The Marine 300 and accused EZ Path products have brushes of slightly different sizes because the products differ slightly in size; the accused EZ Path is a larger device than the Marine 300. The brushes are scaled to fit the size of the particular product. Apart from being slightly different in size, the brushes on the Marine 300 and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 21.

169. The below image is an excerpt from an engineering drawing of the Marine 400 product dated March 1, 2013. The engineering drawing accurately depicts the Marine 400 product that was sold prior to December 9, 2013. Stahl Decl. (Ex. 1), ¶ 24. The cross section of the Marine 400 product shown in this March 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 51 of Hilti's Complaint.

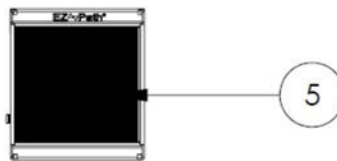


Compare Complaint ¶ 51 and 3/1/13 engineering drawing:

Complaint ¶ 51 (accused EZ Path)	Prior art Marine 400 product shown in 3/1/13 engineering drawing
	

See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013).

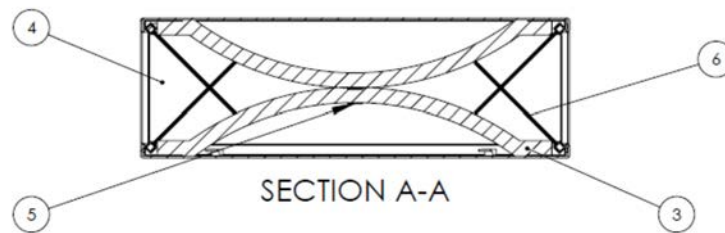
170. The image below is another excerpt from the March 2013 engineering drawing of the Marine 400 product.



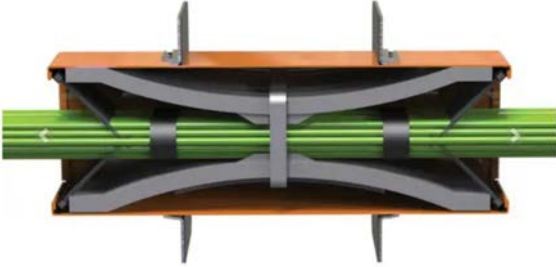
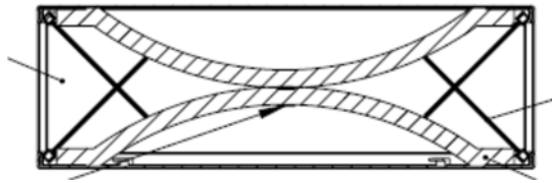
Item number 5 on the drawing corresponds to part number MP1354, “EZ Flex Section C Brush - 4.25" OAT, 3.84" length, 0.010" diam black nylon filament, nylon channel.” These brushes on the Marine 400 product have the same part number as, and are identical to, the accused EZ Path product’s alleged “two brushes on the left and/or right side of the housing,” which Hilti alleges constitute the claimed “curtain extending into the channel at a first location.” As shown on the engineering drawing of the accused EZ Path (Exhibit 44), the brush also has part number MP1354. See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); Exhibit 44;

Stahl Decl. (Ex. 1), ¶ 25.

171. The below image is an excerpt from an engineering drawing of the European EZ Path 44+ product dated September 12, 2012. The engineering drawing accurately depicts the European EZ Path 44+ product that was sold prior to December 9, 2013. Stahl Decl. (Ex. 1), ¶ 27. The cross section of the European EZ Path 44+ product shown in this September 2012 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 51 of Hilti's Complaint.



Compare Complaint ¶ 51 and 9/12/12 engineering drawing:

Complaint ¶ 51 (accused EZ Path)	Prior art European EZ Path 44+ product shown in 9/12/12 engineering drawing
	

See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012).

172. Item number 6 in the September 12, 2012 engineering drawing corresponds to part number MP1354, “EZ Flex Section C Brush - 4.25" OAT, 3.84" length, 0.010" diam black nylon filament, nylon channel.” See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012). These brushes on the European EZ Path 44+ product have the same part number as, and are identical to, the accused EZ Path product’s alleged “two brushes on the left and/or right side of the housing,” which Hilti alleges constitute the claimed “curtain extending into the channel at a first location.” As shown on the engineering drawing of the accused EZ Path (Exhibit 44), the brush also has part number MP1354. See Exhibit 9; Exhibit 44; Stahl Decl. (Ex. 1), ¶ 28.

173. In addition, the photograph below is from a 2013 PowerPoint presentation pertaining to the European EZ Path 44+ product. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “curtain extending into the channel at a first location” in paragraph 51 of its Complaint.



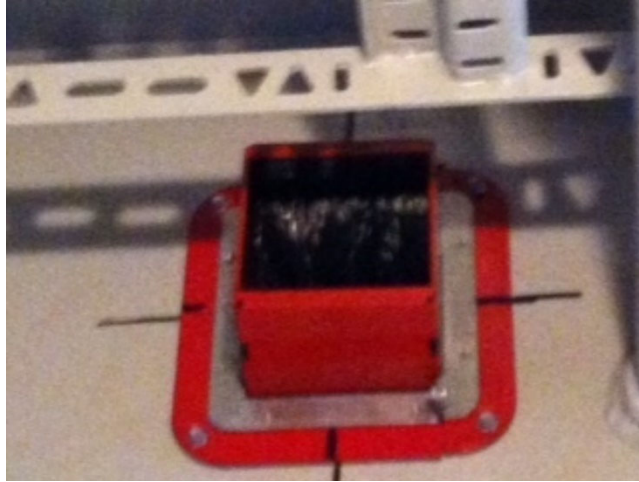
See Exhibit 10 (EZ PATH 44T 2013 PowerPoint); Stahl Decl. (Ex. 1), ¶ 30.

174. As another example, the photograph below is from a PowerPoint presentation dated November 6, 2012, titled “EZD44T Quality Control Procedure,” pertaining to the European EZ Path 44+ product. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “curtain extending into the channel at a first location” in paragraph 51 of its Complaint.



See Exhibit 3 (11/6/12 PowerPoint “EZD44T Quality Control Procedure”); Stahl Decl. (Ex. 1), ¶ 33.

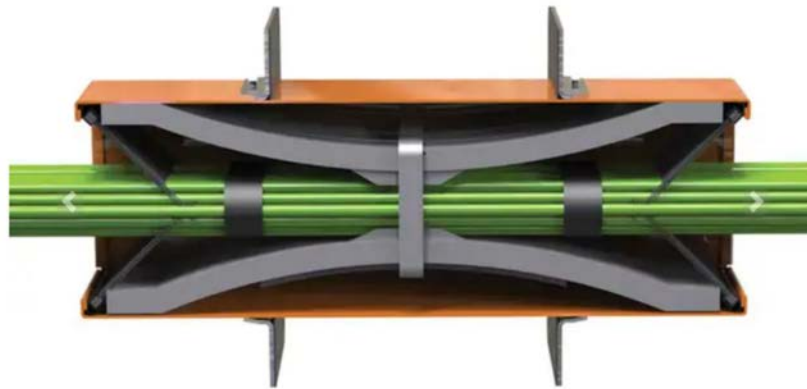
175. In addition, the below photograph, which is attached to an email dated August 9, 2013, shows a Marine 300 product installed on a vessel built at Bollinger Shipyard. It clearly shows the brushes on the side of the housing which Hilti identifies as the claimed “curtain extending into the channel at a first location” in paragraph 51 of its Complaint.



See Exhibit 12 (August 9, 2013 email attaching photographs of Marine 300 product installed on vessel built at Bollinger Shipyard); Stahl Decl. (Ex. 1), ¶ 35.

176. Therefore, to the extent the accused EZ Path product includes a “curtain extending into the channel at a first location,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also include a “curtain extending into the channel at a first location.”

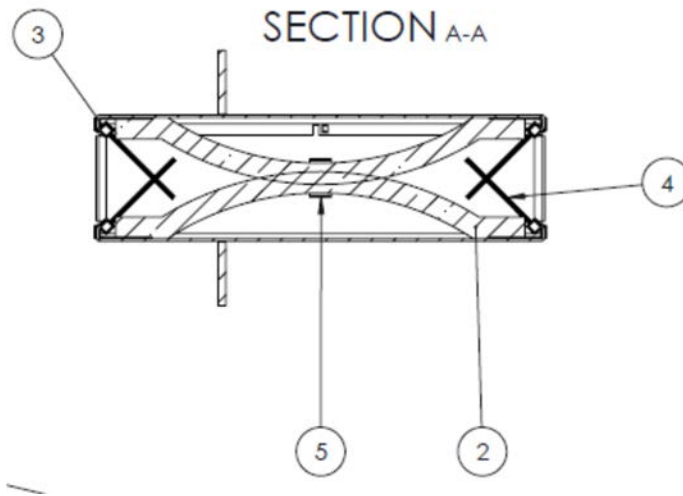
177. Based on the below image, Hilti alleges that “the EZ Path Pathway includes a fire-retardant material extending into the channel at a second location, namely the gray intumescent pads shown in the below image”:



See Complaint ¶ 52.

178. Given Hilti's allegation that the accused EZ Path product practices this limitation of claim 1 of the '946 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

179. The below image is an excerpt from an engineering drawing of the Marine 300 product dated August 13, 2013. The cross section of the Marine 300 product shown in this August 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 52 of Hilti's Complaint.

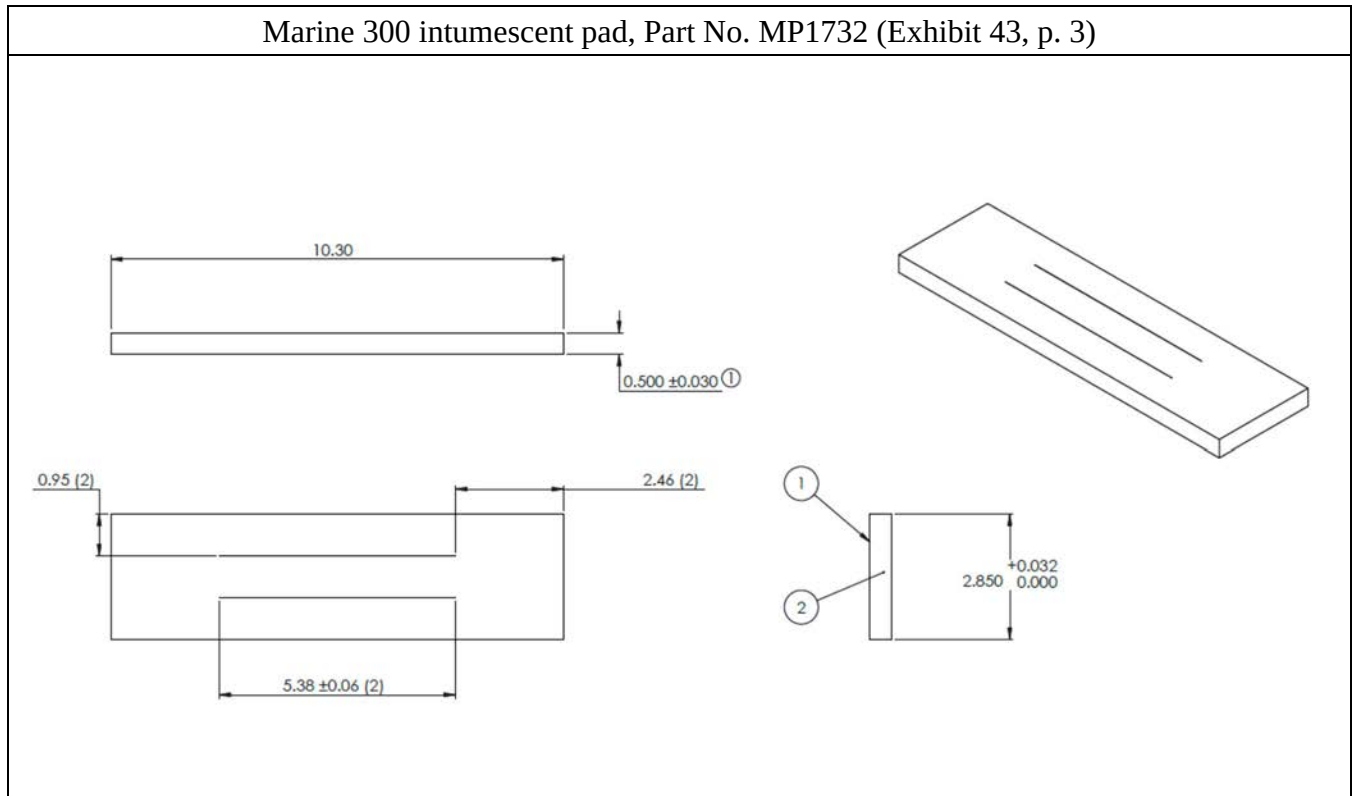


See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); see also ¶ 165 above.

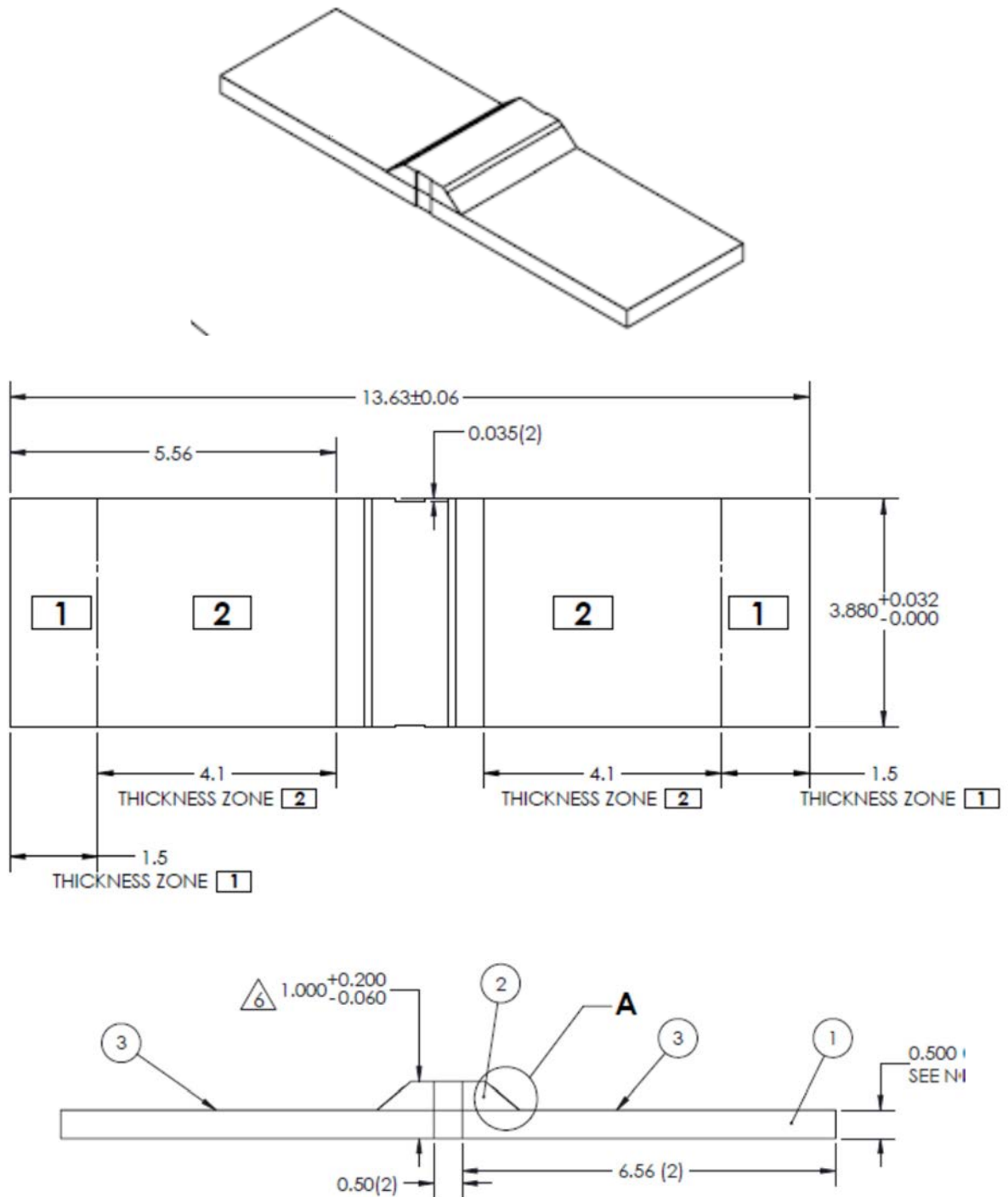
180. Item number 2 in the August 13, 2013 engineering drawing corresponds to part number MP1732, “EZ Path 300 Marine Intumescent Foam Pad.” See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013). Apart from some minor variations—for example, in size and tolerances—these intumescent foam pads on the Marine 300 product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “fire-retardant material extending into the channel at a second location.” See Stahl Decl. (Ex. 1), ¶ 23.

181. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the

Marine 300 intumescent pads (part number MP1732 – Exhibit 43, p. 3) and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



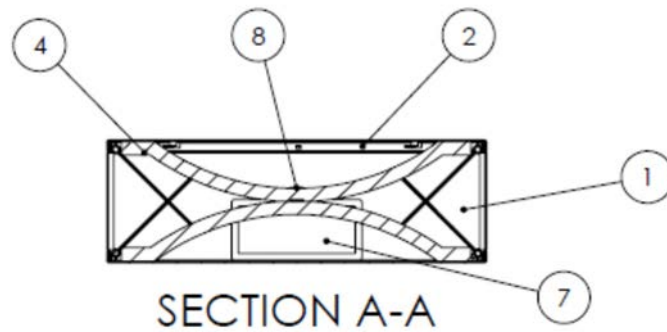
Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)



See Exhibit 43, Exhibit 44, and Exhibit 45; see also Stahl Decl. (Ex. 1), ¶ 23.

182. The Marine 300 and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size; the accused EZ Path is a larger device than the Marine 300. The pads are scaled to fit the size of the particular product. In addition, slight differences in the pads—for instance, the two parallel score lines on the MP1732 intumescent pad and the slight notch or indentation on the side of the MPASSY767 intumescent pad—are attributable to the evolution of the manufacturing process for these pads. For example, notches were added to the pads to make the assembly process easier. In addition, a small component, identified as Item No. 2 in the engineering drawing of the intumescent pad of the accused EZ Path (Exhibit 45), was added as an additional remedial sealing component to help reduce air leakage. Apart from being slightly different in size, having minor cosmetic differences, and having slight differences in their tolerances, the intumescent pads on the Marine 300 and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 23.

183. The below image is an excerpt from an engineering drawing of the Marine 400 product dated March 1, 2013. The cross section of the Marine 400 product shown in this March 2013 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 52 of Hilti's Complaint.

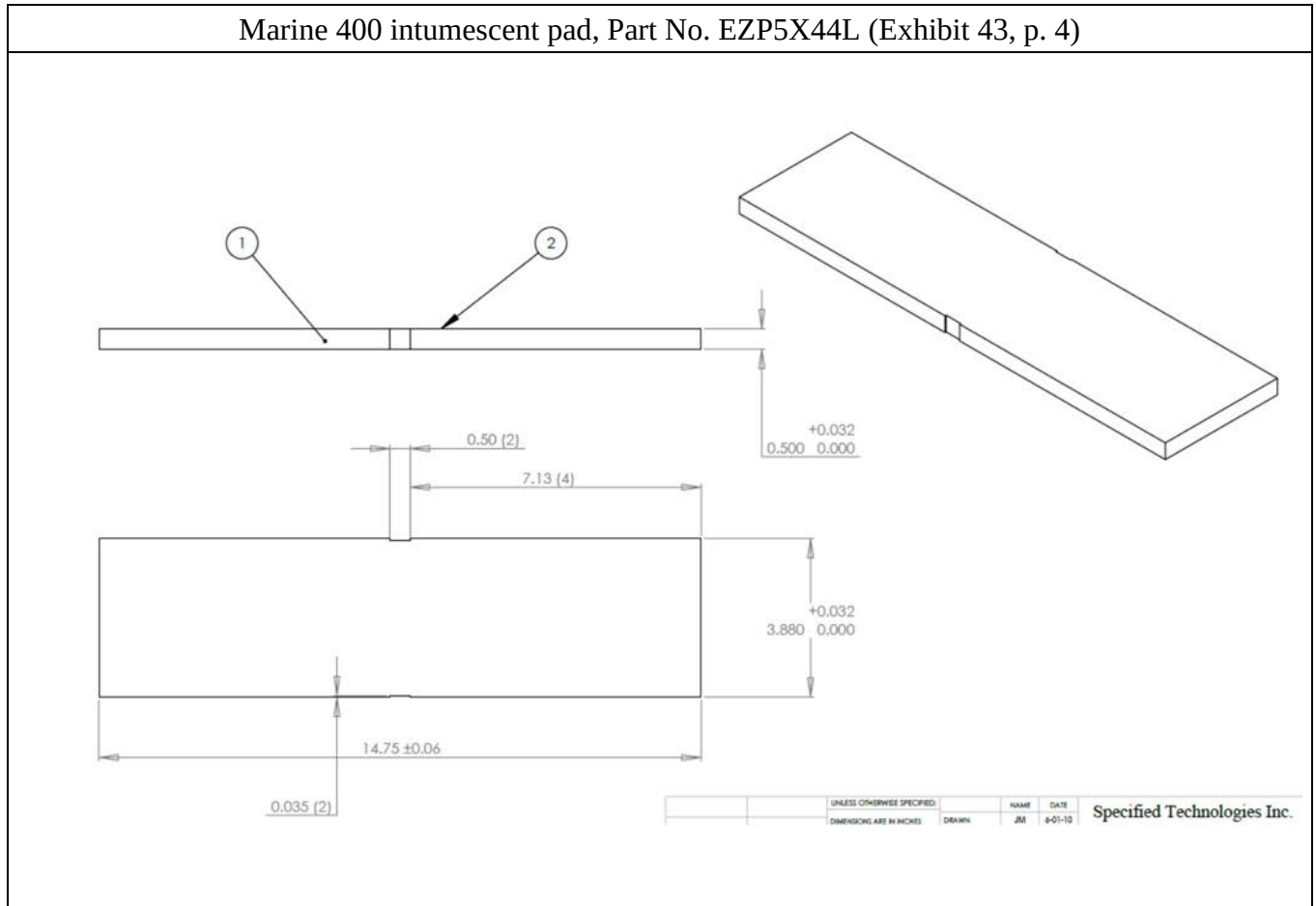


See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); see also ¶ 169 above.

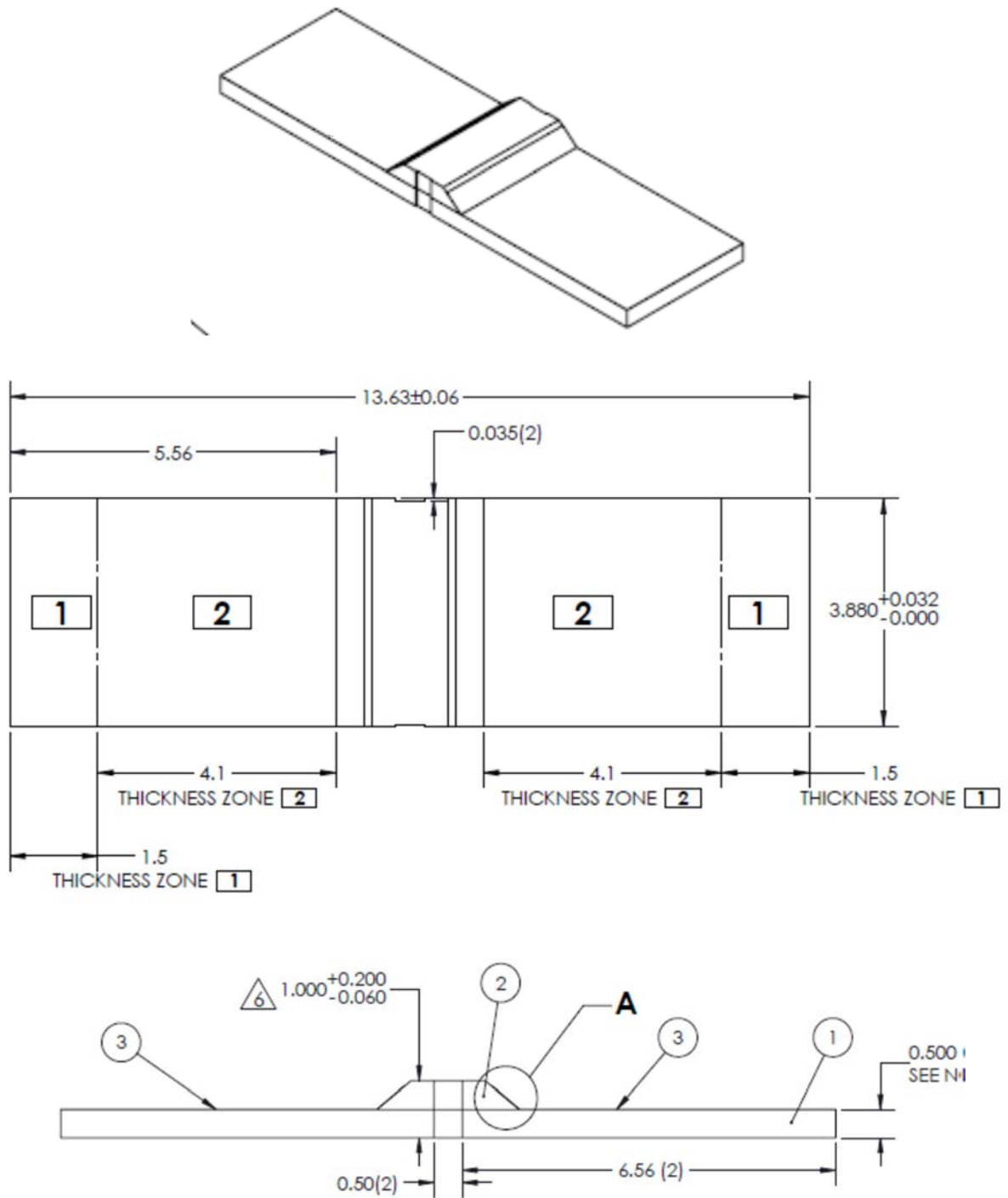
184. Item number 4 on the March 1, 2013 engineering drawing corresponds to part number EZP5X44L, “EZ Path 400 Marine Fire Rated Pathway Intumescent Foam Pad.” See Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013). Apart from some minor variations—for example, in size and tolerances—these intumescent foam pads on the Marine 400 product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “fire-retardant material extending into the channel at a second location.” See Stahl Decl. (Ex. 1), ¶ 26.

185. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the Marine 400 intumescent pads (part number EZP5X44L – Exhibit 43, p. 4) and the

accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)

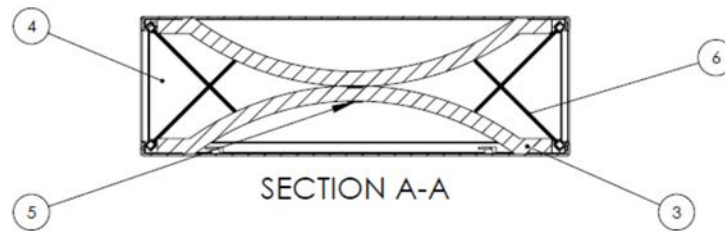


See Exhibit 43, Exhibit 44, Exhibit 45; Stahl Decl. (Ex. 1), ¶ 26.

186. The Marine 400 and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size. The pads are scaled to fit the size of the particular product. The pads also differ slightly in that the intumescent pad of the accused EZ Path has an additional small component, identified as Item No. 2 on Exhibit 45, that was added as an additional remedial sealing component to help reduce air leakage. Apart from being slightly different in size, having a minor cosmetic difference, and having slight differences in their tolerances, the intumescent pads on the Marine 400 and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 26.

187. In addition, the May 2013 STI Marine Firestop brochure indicates that STI's Marine Fire Rated Pathways, including the Marine 300 and Marine 400 products, are "comprised of compressible foam pads installed to form an arch." See Exhibit 5 (May 2013 STI Marine Firestop brochure, at 4).

188. The below image is an excerpt from an engineering drawing of the European EZ Path 44+ product dated September 12, 2012. The cross section of the European EZ Path 44+ product shown in this September 2012 engineering drawing is nearly identical to the cross section of the accused EZ Path product shown in paragraph 52 of Hilti's Complaint.

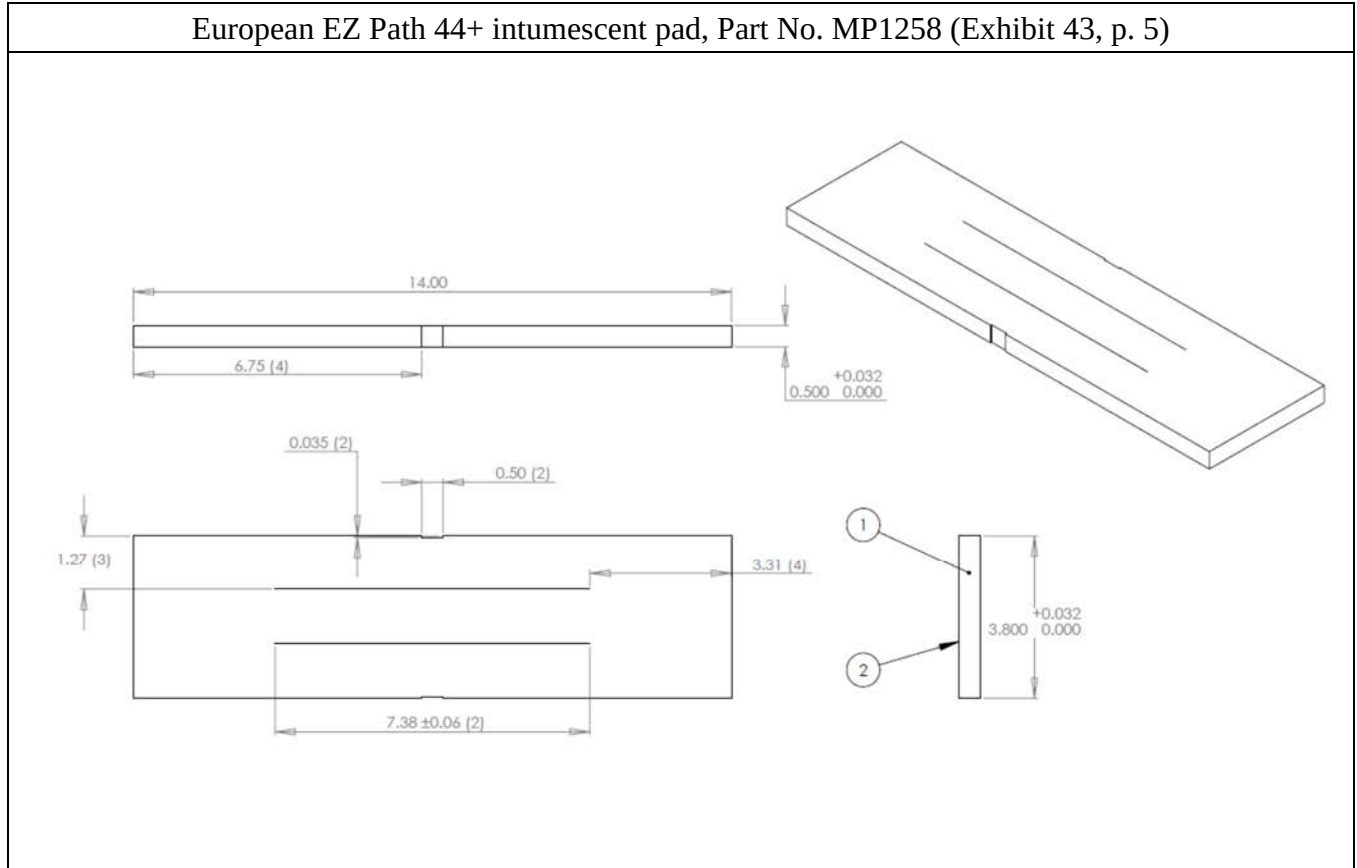


See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012); *see also* ¶ 171 above.

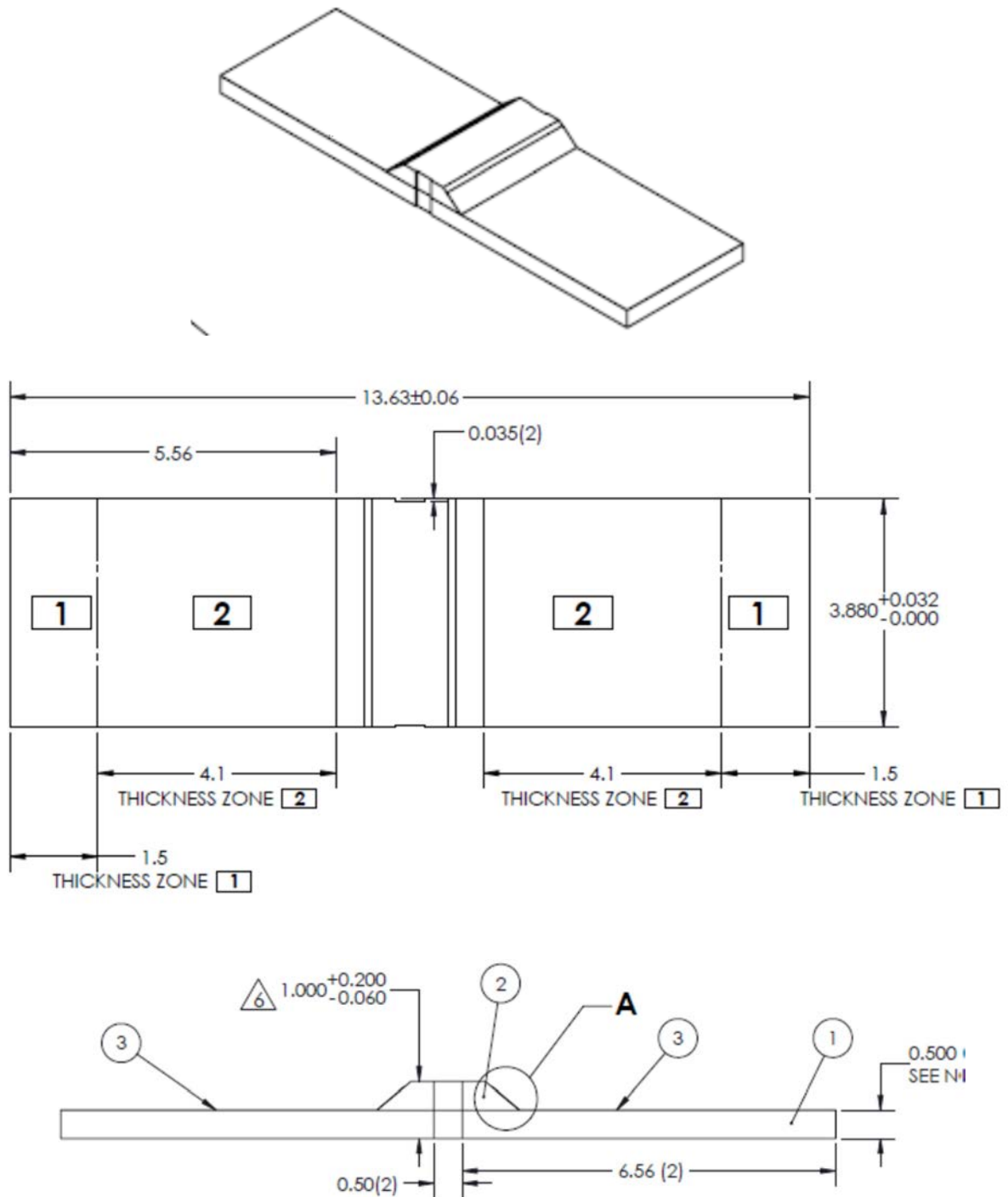
189. Item number 3 in the September 12, 2012 engineering drawing corresponds to part number MP1258, “Series 44+ Europe EZ Path Intumescent Foam Pad.” See Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012). Apart from some minor variations—for example, in size and tolerances—these intumescent foam pads on the European EZ Path 44+ product are otherwise identical to the accused EZ Path product’s alleged “gray intumescent pads” which Hilti alleges constitute the claimed “fire-retardant material extending into the channel at a second location.” See Stahl Decl. (Ex. 1), ¶ 29.

190. The part number of the intumescent pads of the accused EZ Path is MPASSY767, as shown on Exhibit 44. The engineering drawings of the intumescent pads show the minor variations in size and tolerances between the European EZ Path 44+ intumescent pads (part number MP1258 – Exhibit 43, p. 5)

and the accused EZ Path intumescent pads (part number MPASSY767 – Exhibit 45), as illustrated below:



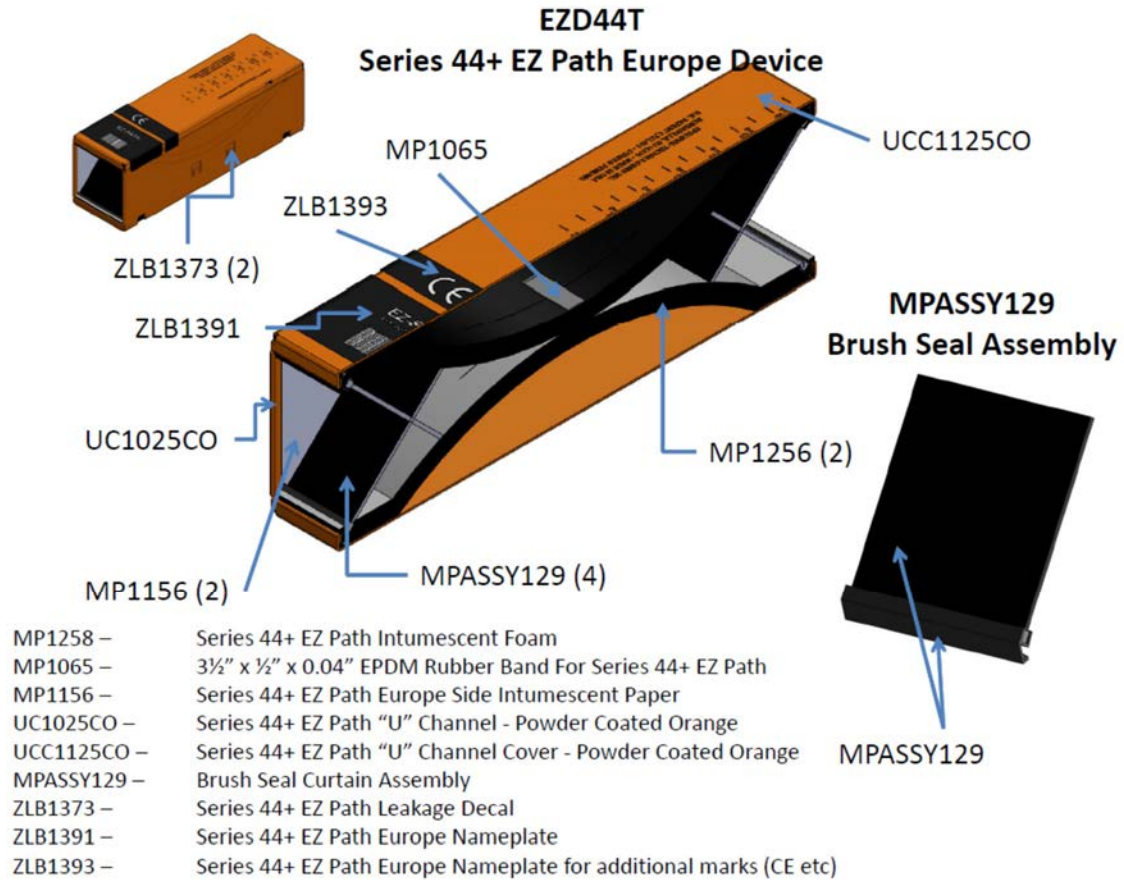
Accused EZ Path intumescent pad, Part No. MPASSY767 (Exhibit 45)



See Exhibit 43, Exhibit 44, Exhibit 45; Stahl Decl. (Ex. 1), ¶ 29.

191. The European EZ Path 44+ and accused EZ Path products have intumescent pads of slightly different sizes because the products differ slightly in size. The pads are scaled to fit the size of the particular product. The pads also differ slightly in that the European EZ Path 44+ intumescent pads have two parallel score lines (which the intumescent pads of the accused EZ Path do not have), and the accused EZ Path intumescent pads have a small component (identified as Item No. 2 on Exhibit 45) that was added as an additional remedial sealing component to help reduce air leakage (which the European EZ Path 44+ intumescent pads do not have). Apart from being slightly different in size, having minor cosmetic differences, and having slight differences in their tolerances, the intumescent pads on the European EZ Path 44+ and accused EZ Path are otherwise identical. See Stahl Decl. (Ex. 1), ¶ 29.

192. In addition, a PowerPoint slide depicting a CAD representation of the European EZ Path 44+ product clearly shows the foam intumescent pads, identified as part no. MP1258:



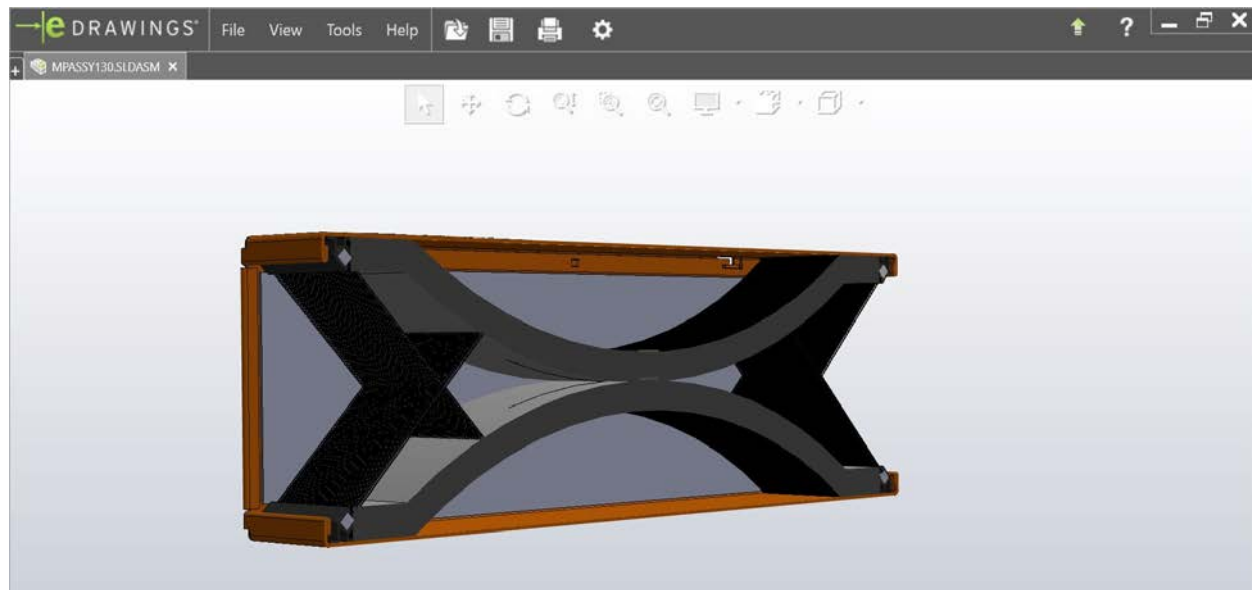
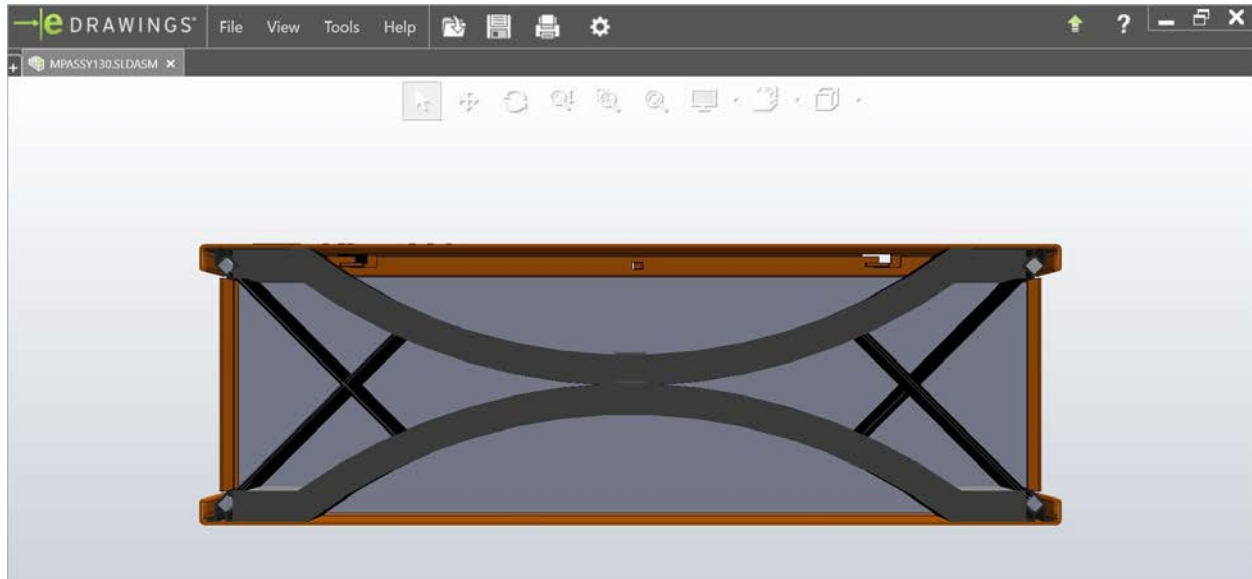
See Exhibit 13 (EZD44T.pptx); See Stahl Decl. (Ex. 1), ¶ 37.

193. The metadata on this PowerPoint slide indicates the following: "Content created 2/27/12 9:08 AM" and "Date last saved 9/11/12 2:16 PM." See Exhibit 14 (metadata for EZD44T.pptx). See Stahl Decl. (Ex. 1), ¶ 38. Therefore, the document was created before the earliest priority date of the '946 Patent.

194. Additionally, 3D SolidWorks files that were created by STI before the earliest priority date of the '946 Patent show the various components of the prior art products that were on sale, sold, described in printed publications, in public use, and/or were otherwise available to the public before the earliest priority date of the

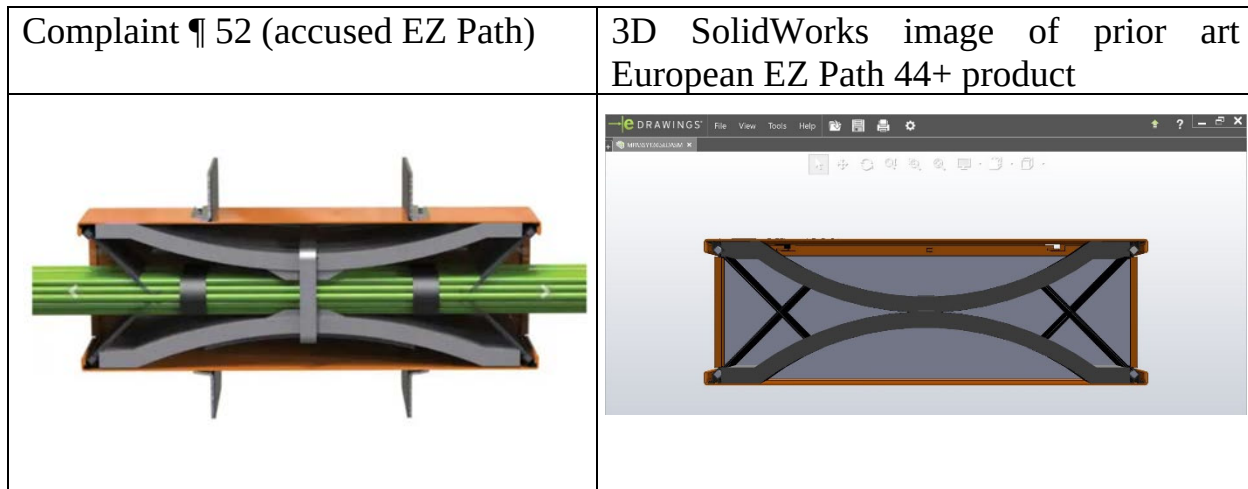
'946 Patent.

195. For example, the below excerpt of a 3D SolidWorks file shows two cross-sectional views of the prior art European EZ Path 44+ product.



See Exhibit 15 (3D SolidWorks image of European EZ Path 44+ product). These 3D images are virtually identical to the cross-sectional image of the accused EZ Path

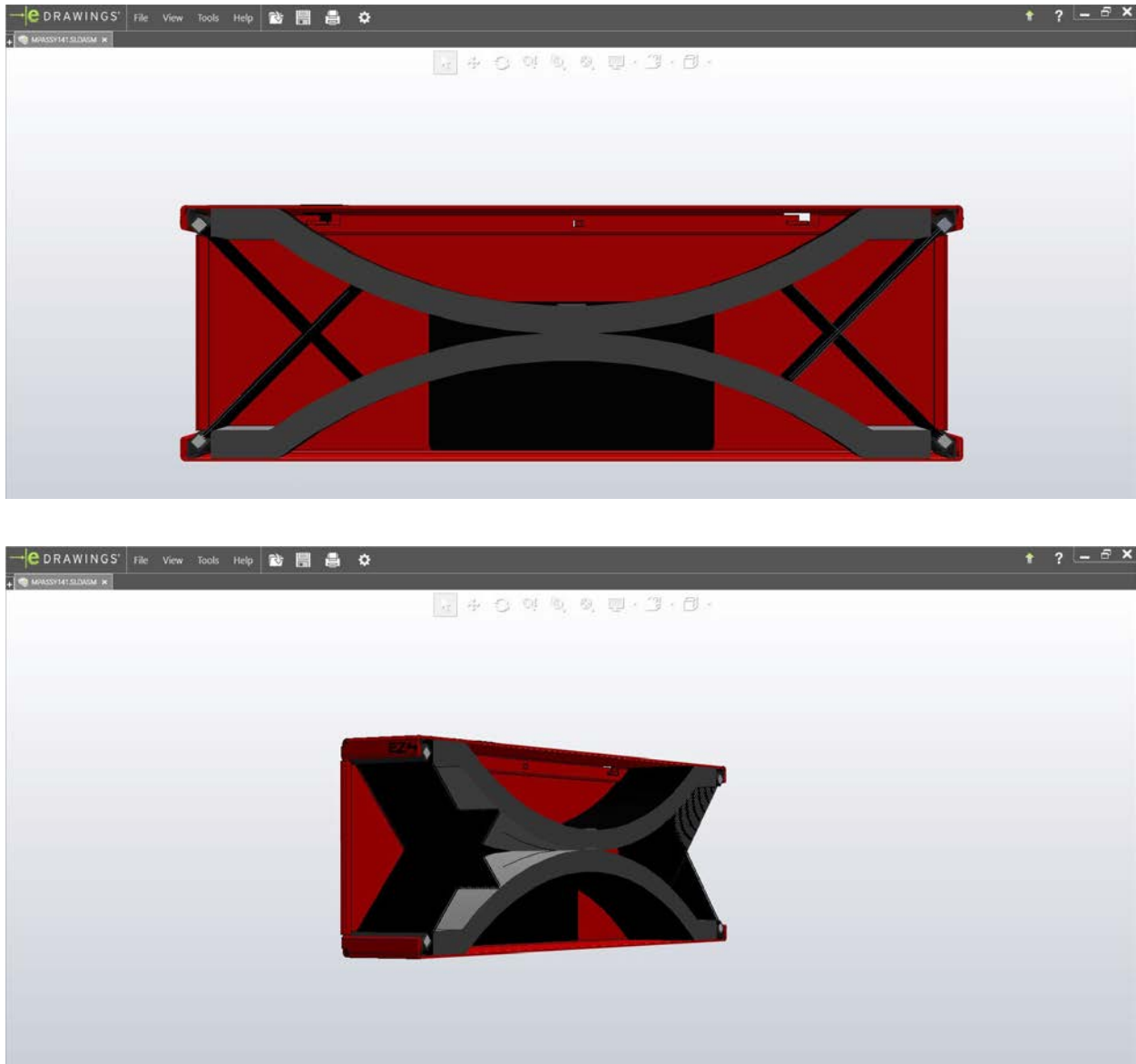
44+ product shown in paragraph 52 of the Complaint. *Compare* Complaint ¶ 52 and 3D SolidWorks image of European EZ Path 44+ product (Ex. 15):



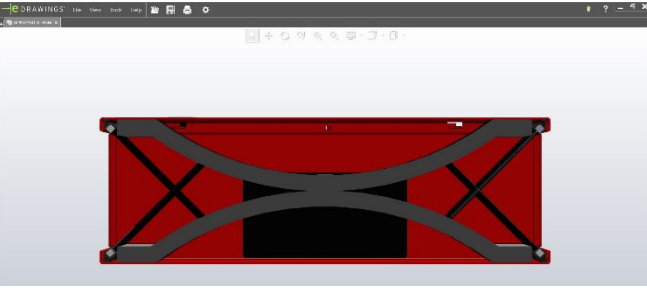
196. Exhibit 15 is a compilation of screenshots taken from a SolidWorks Assembly file of the European EZ Path 44+ viewed using the eDrawings program. The metadata for this 3D SolidWorks image indicates that it was created on July 16, 2012—more than one year before the earliest priority date of the '946 Patent. See Exhibit 15 at p. 15. The source data for the interactive 3D model shown is the SolidWorks Assembly file for the European EZ Path 44+ that was created on July 16, 2012. Exhibit 15 is a true and accurate representation of the European EZ Path 44+ as it appeared in 2012, with the exception of a minor change in 2021 to the brush seal holder used in the product, as discussed above. See Lopes Decl. (Ex. 16), ¶¶ 4, 6-9.

197. In addition, the below excerpt of a 3D SolidWorks file shows two

cross-sectional views of the prior art Marine 400 product.



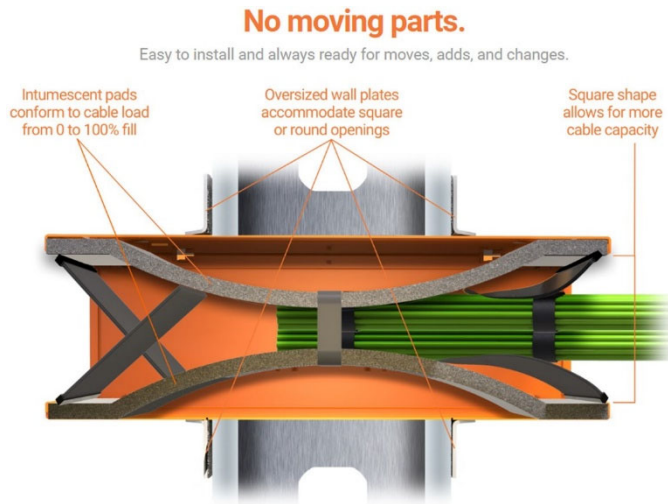
See Exhibit 18 (3D SolidWorks image of Marine 400 product). These 3D images are virtually identical to the cross-sectional image of the accused EZ Path 44+ product shown in paragraph 52 of the Complaint. *Compare* Complaint ¶ 52 and 3D SolidWorks image of Marine 400 product (Ex. 18):

Complaint ¶ 52 (accused EZ Path)	3D SolidWorks image of prior art Marine 400 product
	

198. Exhibit 18 is a screenshot taken from a SolidWorks Assembly file of the Marine 400 viewed using the eDrawings program. The metadata for this 3D SolidWorks image indicates that it was created on September 24, 2012. See Exhibit 18 at p. 3. This SolidWorks Assembly file of the Marine 400 has not been changed since September 24, 2012. The source data for the interactive 3D model shown is the SolidWorks Assembly file for the Marine 400 that was created on September 24, 2012. Exhibit 18 is a true and accurate representation of the Marine 400 as it appeared by June 28, 2013. See Lopes Decl. (Ex. 16), ¶¶ 10-12.

199. Therefore, to the extent the accused EZ Path product includes “a fire-retardant material extending into the channel at a second location,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also include “a fire-retardant material extending into the channel at a second location.”

200. Based on the below image, Hilti alleges that “the curtain in the EZ Path Pathway moves within the channel in an installed state, the curtain moving to accommodate passage of an object through the channel, as shown at the right side of the below image”:



See Complaint ¶ 53.

201. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’946 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

202. For example, in the prior art Marine 300, Marine 400, and European EZ Path 44+ products, the “curtain moves within the channel in an installed state . . . to accommodate passage of an object through the channel.” Each of these products included brushes made of “black nylon filament.” See Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); Exhibit 8

(Engineering drawing of Marine 400 dated March 1, 2013); and Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012). Nylon filament is a flexible material that bends into the channel when cables or pipes are inserted into the housing. Stahl Decl. (Ex. 1), ¶¶ 22, 25, 28. The brushes move within the channel to accommodate the passage of an object—such as a bundle of cables—through the channel. *Id.*

203. For example, the below photograph from the November 6, 2012 PowerPoint presentation titled “EZD44T Quality Control Procedure” shows that the nylon filaments of the brush are flexible and would clearly move within the channel when cables or pipes are inserted into the channel, in order to accommodate the passage of the cables or pipes through the channel.

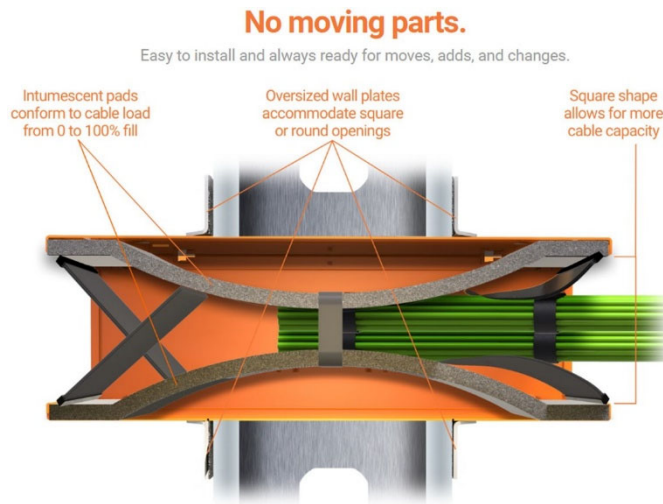


See Exhibit 3 (EZD44T Quality Control Procedure); Stahl Decl. (Ex. 1), ¶ 34.

204. Therefore, to the extent the accused EZ Path product has “curtain[s] [that] move[] within the channel in an installed state . . . to accommodate passage

of an object through the channel,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also have “curtain[s] [that] move[] within the channel in an installed state . . . to accommodate passage of an object through the channel.”

205. Based on the below image, Hilti alleges that “the fire-retardant material in the EZ Path Pathway curves in an axial direction within the channel and at least partially surrounds the object in the channel in the installed state, as shown in the below image”:



See Complaint ¶ 54.

206. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’946 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

207. First, with respect to the limitation “the fire-retardant material curves

in an axial direction within the channel,” the engineering drawings of the prior art Marine 300, Marine 400, and European EZ Path 44+ products depict the curvature of the intumescent pads, similar to the curvature of the intumescent pads depicted in the CAD rendering of the accused EZ Path product shown in paragraph 54 of the Complaint. Compare Complaint ¶ 54 and Exhibit 7 (Engineering drawing of Marine 300 dated August 13, 2013); Exhibit 8 (Engineering drawing of Marine 400 dated March 1, 2013); and Exhibit 9 (Engineering drawing of European EZ Path 44+ product dated September 12, 2012).

208. In addition, the May 2013 STI Marine Firestop brochure indicates that STI’s Marine Fire Rated Pathways, including the Marine 300 and Marine 400 products, are “comprised of compressible foam pads installed to form an arch.” See Exhibit 5 (May 2013 STI Marine Firestop brochure, at 4).

209. Second, with respect to the limitation “the fire-retardant material . . . at least partially surrounds the object in the channel in the installed state,” the May 2013 STI Marine Firestop brochure, which pertains to the Marine 300 and Marine 400 products, states that “cables pass through the device.” See Exhibit 5 (May 2013 STI Marine Firestop brochure, at 4). When cables (or any other object) pass through the channel in the Marine 300 and Marine 400 devices, the intumescent pads at least partially surround the object in the channel. See Stahl Decl. (Ex. 1), ¶ 36.

210. In addition, the below photograph, which is attached to an email dated

August 9, 2013, shows a Marine 300 product installed on a vessel built at Bollinger Shipyard. The photograph shows cables passing through the channel in the housing of the Marine 300 product.



See Exhibit 12 (August 9, 2013 email attaching photographs of Marine 300 product installed on vessel built at Bollinger Shipyard); Stahl Decl. (Ex. 1), ¶ 36. When these cables are passed through the channel in the Marine 300 device, the intumescent pads within the channel at least partially surround the cables. See Stahl Decl. (Ex. 1), ¶ 36.

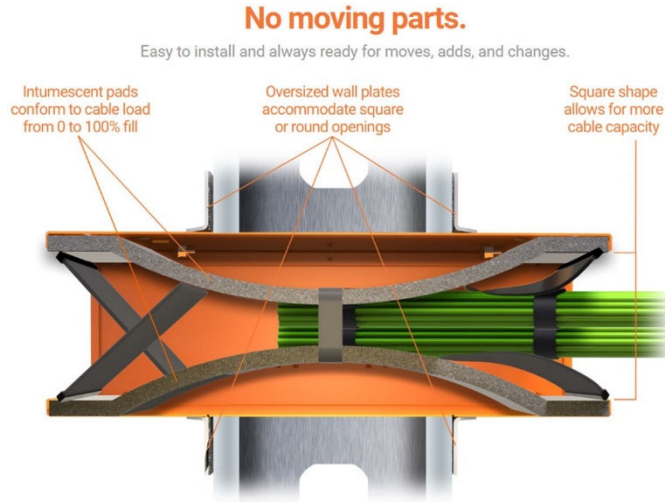
211. In addition, the below photograph from a 2013 PowerPoint pertaining to the European EZ Path 44+ product shows cables passing through the channel in the housing of the product.



See Exhibit 10 (EZ PATH 44T 2013 PowerPoint); Stahl Decl. (Ex. 1), ¶ 31. When these cables are passed through the channel in the European EZ Path 44+ product, the intumescent pads within the channel at least partially surround the cables. See Stahl Decl. (Ex. 1), ¶ 31.

212. Therefore, to the extent the accused EZ Path product has “fire-retardant material [that] curves in an axial direction within the channel and at least partially surrounds the object in the channel in the installed state,” as alleged by Hilti in the original Complaint, the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also have “fire-retardant material [that] curves in an axial direction within the channel and at least partially surrounds the object in the channel in the installed state.”

213. Based on the below image, Hilti alleges that “the housing in the EZ Path Pathway is coupled to an opening in a barrier, as shown in the below image”:



See Complaint ¶ 55.

214. Given Hilti’s allegation that the accused EZ Path product practices this limitation of claim 1 of the ’946 Patent, Hilti is necessarily admitting that the prior art Marine 300, Marine 400, and European EZ Path 44+ products also practice this limitation.

215. For example, the below photograph, which is attached to an email dated August 9, 2013, shows a Marine 300 product installed on a vessel built at Bollinger Shipyard. The photograph shows the housing of the Marine 300 product “coupled to an opening in a barrier”—i.e., an interior wall of the ship.



See Exhibit 12 (August 9, 2013 email attaching photographs of Marine 300 product installed on vessel built at Bollinger Shipyard); Stahl Decl. (Ex. 1), ¶ 36.

216. In addition, the below photograph from a 2013 PowerPoint pertaining to the European EZ Path 44+ product shows the housing of the product “coupled to an opening in a barrier”—i.e., a wall.



See Exhibit 10 (EZ PATH 44T 2013 PowerPoint); Stahl Decl. (Ex. 1), ¶ 31.

217. Therefore, to the extent the accused EZ Path product has a “housing coupled to an opening in a barrier,” as alleged by Hilti in the original Complaint,

the prior art Marine 300, Marine 400, and European EZ Path 44+ products necessarily also have a “housing coupled to an opening in a barrier.”

B) The '946 Patent is invalid for additional reasons under 35 U.S.C. §§ 102, 103, and/or 112.

218. In addition to the reasons set forth in Section A above, the asserted claim(s) of the '946 Patent are invalid under 35 U.S.C. §§ 102, 103 and/or 112.

219. For example, the asserted claim(s) of the '946 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. No. 4,538,389 (Heinen)
- U.S. Pat. No. 5,456,050 (Ward)
- U.S. Pat. No. 6,172,052 (Takahashi)
- U.S. Pat. No. 6,426,463 (Munzenberger)
- U.S. Pat. No. 6,632,999 (Sempliner)
- U.S. Pat. No. 6,732,481 (Stahl), owned by STI
- U.S. Pat. No. 6,928,777 (Cordts)
- U.S. Pat. No. 7,373,761 (Stahl), owned by STI
- U.S. Pat. No. 8,051,614 (Peck)
- U.S. Pat. No. 8,188,382 (Monden)
- U.S. Pat. No. 8,266,854 (Reddicliffe)

- U.S. Pat. No. 8,833,478 (Zernach)
- U.S. Pat. No. 8,887,458 (Lopes), owned by STI
- U.S. Pat. No. 9,046,194 (Gandolfo), owned by STI
- U.S. Pat. No. 7,523,590 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2006/0037264 (Paetow)
- U.S. Pat. App. Pub. No. 2013/0277918 (Fitzgerald)
- U.S. Pat. App. Pub. No. 2013/0307225 (Boyd)
- WO2004/015319 (Porter)
- WO2013/160776 (Ramorino)
- EP0869303 (Seebode)
- DE10043430 (Munzenberger)
- The EZ-Path System – The Zero-Maintenance Solution for Firestopping Cables, Specified Technologies, Inc. (Rev. 03/2008)
- 2003 STI brochure (Exhibit 41)
- May 2013 STI Marine Firestop brochure (Exhibit 5)

220. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible filing date of the '946 Patent, to achieve the asserted claim(s) of the '946 Patent for at least the following reasons: (1) it was well known and understood in the art that a sleeve comprising a passageway with fire-retardant material and/or intumescent

material located therein could be, and was, used as a firestopping apparatus; (2) it was well known and understood in the art that the fire-retardant material and/or intumescent material should permit a pipe or cable to pass through the sleeve; (3) it was well known and understood in the art that a brush or curtain could be, and was, used to close off the ends of the sleeve while permitting a pipe or cable to pass through the sleeve; (4) it was well known and understood in the art that permitting cables to be inserted or removed without removal or reinstallation of the firestopping apparatus was advantageous; (5) it was well known and understood in the art that bristles and flexible intumescent and/or fire-retardant material permitted insertion and removal of cables while maintaining a sealing effect when the cables were in the device; and (6) it was well known and understood in the art that fire-retardant materials and intumescent materials were among several types of materials used for fire protection of buildings. The combination of one or more of these prior art references would have yielded entirely predictable results.

221. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 4: Declaration of Invalidity of U.S. Patent No. 10,267,036

222. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

223. This counterclaim is for declaratory relief pursuant to 28 U.S.C.

§§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '036 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '036 Patent is valid, and specifically alleges that STI infringes claim 1 of the '036 Patent by making, using, selling, offering to sell, and/or importing the SpeedFlex® Track Top Gasket (TTG), Part Number TTG350F. STI contends that each asserted claim of the '036 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

224. The '036 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

225. For example, the asserted claim(s) of the '036 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. No. 3,143,208 (Sizemore)
- U.S. Pat. No. 4,460,804 (Svejkovsky)
- U.S. Pat. No. 5,390,458 (Menchetti)
- U.S. Pat. No. 5,765,318 (Michelson)
- U.S. Pat. No. 6,125,608 (Charlson)
- U.S. Pat. No. 6,935,080 (Allwein)

- U.S. Pat. No. 7,867,591 (Sieber)
- U.S. Pat. No. 8,590,231 (Pilz)
- U.S. Pat. No. 8,671,632 (Pilz II)
- U.S. Pat. No. 9,157,232 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2013/0205694 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2015/0135622 (Muenzenberger)
- WO2014/071362 (Sackler)
- DE202013103170 (Hogg)
- CertainTeed Marco Spark-Perf Drywall Joint Tape – Product Data and Submittal (4/2012 Rev.)
- Walls & Ceilings, Intumescent Tape is on the Rise, available at <https://www.wconline.com/articles/88252-intumescent-tape-is-on-the-rise-no-punintended>
- Sell Sheet for STI's SpeedFlex® TTG product (Exhibit 19)

226. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible priority date of the '036 Patent, to achieve the asserted claim(s) of the '036 Patent, for at least the following reasons: (1) it was well known and understood in the art that a first component and a second component forming a joint could be, and was, sealed with joint sealing tape; (2) it was well known and understood in the art that

at least two sealing elements could be, and were known to be, positioned on a connection element at a distance from and next to one another so as to seal two spaced joints at once; (3) it was well known and understood in the art that intumescent material could be, and was, used as a sealing element; (4) it would have been an obvious modification of the prior art, if not explicit or inherent in that art, to perforate the joint sealing tape to improve ease of separation of the joint sealing tape, which allows a single product to be used in multiple applications, and without requiring a cutting device and to reduce risk of error in cutting; and (5) it was well known and understood in the art that tapes in a variety of applications, including connecting drywall and for housing construction, could be, and were, perforated to improve ease of separation of the tape and to make a variety of dimensions readily available. The combination of one or more of these references would have yielded entirely predictable results.

227. As another example of how the '036 Patent is invalid for obviousness under 35 U.S.C. § 103, the '036 Patent merely claims a joint sealing tape with a perforation running down the midline of the tape. The addition of perforation to existing prior art joint sealing tape would have been obvious to a person of ordinary skill in the art.

228. In fact, before STI started selling the accused product SpeedFlex® Track Top Gasket (TTG), Part Number TTG350F, STI previously sold a version of

that product that was not perforated down the middle. Attached hereto as Exhibit 19 is a true and correct copy of a Sell Sheet for STI's SpeedFlex® TTG product attached to an email dated March 27, 2013—nearly two years prior to the earliest priority date of the '036 Patent, February 13, 2015. Accordingly, STI's 2013 TTG product is prior art to the '036 Patent.

229. Before the earliest priority date of the '036 Patent, STI was advising its customers that the “SpeedFlex® Track Top Gasket (TTG) may be cut in half, lengthwise, and installed over the outer face of both edges of the ceiling runner prior to attachment to underside of the concrete floor.” See Exhibit 20, a true and correct copy of an STI memorandum dated June 17, 2014. See also Exhibit 21, a true and correct copy of an STI instructional sheet for the SpeedFlex® Track Top Gasket dated July 30, 2014 (“Gasket may be cut to facilitate installation.”).

230. Adding perforation down the length of the TTG tape would have been an obvious modification that a POSITA would have readily implemented before the earliest possible priority date of the '036 Patent. A POSITA would have been motivated to add well-known perforations to the prior art SpeedFlex® TTG tape to facilitate separating the tape into two parts, as well as to facilitate installing the tape in certain areas that are too narrow to accommodate the entire width of an intact strip of TTG tape. STI was already advising its customers in 2014 to cut the tape down the middle lengthwise; adding perforations would have been the obvious next

step, entirely predictable to do, and providing predictable and successful results.

231. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 5: Declaration of Invalidity of U.S. Patent No. 10,774,528

232. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

233. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '528 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '528 Patent is valid, and specifically alleges that STI infringes claim 1 of the '528 Patent by making, using, selling, offering to sell, and/or importing the SpeedFlex® Track Top Gasket (TTG), Part Number TTG350F. STI contends that each asserted claim of the '528 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

234. The '528 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

235. For example, the asserted claim(s) of the '528 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in

combination:

- U.S. Pat. No. 3,143,208 (Sizemore)
- U.S. Pat. No. 4,460,804 (Svejkovsky)
- U.S. Pat. No. 5,390,458 (Menchetti)
- U.S. Pat. No. 5,765,318 (Michelson)
- U.S. Pat. No. 6,125,608 (Charlson)
- U.S. Pat. No. 6,935,080 (Allwein)
- U.S. Pat. No. 7,867,591 (Sieber)
- U.S. Pat. No. 8,590,231 (Pilz)
- U.S. Pat. No. 8,671,632 (Pilz II)
- U.S. Pat. No. 9,157,232 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2013/0205694 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2015/0135622 (Muenzenberger)
- WO2014/071362 (Sackler)
- DE202013103170 (Hogg)
- CertainTeed Marco Spark-Perf Drywall Joint Tape – Product Data and Submittal (4/2012 Rev.)
- Walls & Ceilings, Intumescent Tape is on the Rise, available at <https://www.wconline.com/articles/88252-intumescent-tape-is-on-the-rise-no-punintended>

- Sell Sheet for STI's SpeedFlex® TTG product (Exhibit 19)

236. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible priority date of the '528 Patent, to achieve the asserted claim(s) of the '528 Patent for at least the following reasons: (1) it was well known and understood in the art that a first sealing section and second sealing section comprising an intumescent material could be, and were, coupled for use in sealing a joint; (2) it was well known and understood in the art that at least two sealing elements could be, and were, coupled to a connection element; (3) it would have been an obvious modification of the prior art, if not explicit or inherent in that art, to perforate the joint sealing tape to permit the sealing separations to be separated and installed together, which allows a single product to be used in multiple applications, and without requiring a cutting device and to reduce risk of error in cutting; and (4) it was well known and understood in the art that tapes in a variety of applications, including connecting drywall and for housing construction, could be and were perforated to improve ease of separation of the tape and make a variety of dimensions readily available. The combination of one or more of these references would have yielded entirely predictable results.

237. As another example of how the '528 Patent is invalid for obviousness under 35 U.S.C. § 103, the '528 Patent merely claims a joint sealing tape with a

perforation running down the midline of the tape. The addition of perforation to existing prior art joint sealing tape would have been obvious to a POSITA.

238. In fact, before STI started selling the accused product SpeedFlex® Track Top Gasket (TTG), Part Number TTG350F, STI previously sold a version of that product that was not perforated down the middle. See Exhibit 19 (Sell Sheet for STI's SpeedFlex® TTG product attached to an email dated March 27, 2013). This Sell Sheet describing and depicting the previous unperforated version of STI's TTG tape existed nearly two years before the earliest priority date of the '528 Patent, February 13, 2015. Accordingly, STI's 2013 TTG product is prior art to the '528 Patent.

239. Before the earliest priority date of the '528 Patent, STI was advising its customers that the "SpeedFlex® Track Top Gasket (TTG) may be cut in half, lengthwise, and installed over the outer face of both edges of the ceiling runner prior to attachment to underside of the concrete floor." See Exhibit 20 (STI memorandum dated June 17, 2014); see also Exhibit 21 (STI instructional sheet for the SpeedFlex® Track Top Gasket dated July 30, 2014 ("Gasket may be cut to facilitate installation.")).

240. Adding perforation down the length of the TTG tape would have been an obvious modification that a POSITA would have readily implemented before the earliest possible priority date of the '528 Patent. A POSITA would have been

motivated to add well-known perforations to the prior art SpeedFlex® TTG tape to facilitate separating the tape into two parts, as well as to facilitate installing the tape in certain areas that are too narrow to accommodate the entire width of an intact strip of TTG tape. STI was already advising its customers in 2014 to cut the tape down the middle lengthwise; adding perforations would have been the obvious next step, entirely predictable to do, and providing predictable and successful results.

241. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 6: Declaration of Invalidity of U.S. Patent No. 10,641,417

242. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

243. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '417 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '417 Patent is valid, and specifically alleges that STI infringes claim 1 of the '417 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Retrofit Device (including model numbers EZDR200 and EZDR400). STI contends that each asserted claim of the '417 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the

United States Constitution.

244. The '417 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

245. At least claim 1 of the '417 Patent is invalid under 35 U.S.C. § 102 because STI's prior art Marine 300, Marine 400, and European EZ Path 44+ products were on sale, actually sold, described in printed publications, in public use, and/or were otherwise available to the public before April 27, 2015, the earliest priority date of the '417 Patent. See Exhibit 4 (11/30/12 invoice) and Exhibit 6 (6/28/13 invoice). Because the Marine 300, Marine 400, and European EZ Path 44+ products were sold before April 27, 2015, they are prior art to the '417 Patent.

246. The claims of the '417 Patent are so broad that they cover the prior art Marine 300, Marine 400, and European EZ Path 44+ devices, which, on the surface, look different from the accused EZ Path® Retrofit Device and the figures in the '417 Patent.

247. Attached as Exhibit 22 is a claim chart that shows, on an element-by-element basis, that claim 1 of the '417 Patent reads on the prior art European EZ Path 44+ device.

248. Because the prior art European EZ Path 44+ device, as well as the Marine 300 and 400 devices, embody claim 1 of the '417 Patent, that claim is invalid under 35 U.S.C. § 102.

249. In addition, the asserted claim(s) of the '417 Patent are invalid under 35 U.S.C. §§ 102 and/or 103 because they are anticipated and/or obvious in light of other prior art references.

250. For example, the asserted claim(s) of the '417 patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. Pub. App. US 2014/0020915 A1 (Lopes), owned by STI
- U.S. Pat. No. 5,058,341 (Harbeke)
- U.S. Pat. No. 5,347,767 (Roth)
- U.S. Pat. No. 5,351,448 (Gohlke)
- U.S. Pat. No. 5,452,551 (Charland)
- U.S. Pat. No. 6,176,052 (Takahashi)
- U.S. Pat. No. 7,797,893 (Stahl), owned by STI
- U.S. Pat. No. 9,162,093 (Foerg)
- DE216225 (Nichtnennung)
- DE9411293 (Pafamax)
- DE0988873 (Boot)
- JP2000240854 (Kaneda)
- JP2014148998 (Muroya)
- JP2015057560 (Muroya II)

- Guideline on Through-Penetration on Firestopping (2d ed.) (Sheet Metal & Air Conditioning Contractors' National Assoc.)

251. For example, attached as Exhibit 39 is a claim chart demonstrating that claim 1 of the '417 Patent is anticipated by U.S. Pat. Pub. App. US 2014/0020915 A1 (Lopes) (attached as Exhibit 40).

252. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible priority date of the '417 Patent, to achieve the asserted claim(s) of the '417 Patent for at least the following reasons: (1) it was well known in the prior art and understood that the use of intumescent material in a frame is advantageous to direct the expansion of intumescent material toward the building feature and not away from the location where sealing is desired; (2) it was well known in the prior art and understood that the opening in the frame should permit a building feature to pass through so that the apparatus can create a seal between the building feature and the opening around a building; (3) it would have been an obvious modification of the prior art, if not explicit or inherent in that art, to use a first and second area of intumescent material, such that the first area and second area overlap one another and overlap the opening of the frame to ensure that there is sufficient intumescent material to form a seal; (4) it would have been an obvious modification of the prior art, if not explicit or inherent in that art, to use a first and second area of intumescent

material that extend beyond the edge of the frame to allow various sizes and larger building features to pass through while maintaining the ability to form a seal; (5) it was well known in the prior art and understood that the use of two different intumescent materials, including with different temperature resistances or stability, would allow greater stability of the intumescent material and prevent it from falling out of the frame; and (6) a person of ordinary skill designing a fire protection sleeve would find the design of other pipe collars and fire stopping devices to be useful references. The combination of one or more of these references would have yielded entirely predictable results.

253. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 7: Declaration of Invalidity of U.S. Patent No. 11,137,091

254. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

255. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '091 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '091 Patent is valid, and specifically alleges that STI infringes claim 1 of the '091 Patent by making, using, selling, offering to sell, and/or

importing the EZ Path® Retrofit Device (including model numbers EZDR200 and EZDR400). STI contends that each asserted claim of the '091 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

256. The '091 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

257. At least claim 1 of the '091 Patent is invalid under 35 U.S.C. § 102 because STI's prior art Marine 300, Marine 400, and European EZ Path 44+ products were on sale, actually sold, described in printed publications, in public use, and/or were otherwise available to the public before April 27, 2015, the earliest priority date of the '091 Patent. See Exhibit 4 (11/30/12 invoice) and Exhibit 6 (6/28/13 invoice). Because the Marine 300, Marine 400, and European EZ Path 44+ products were sold before April 27, 2015, they are prior art to the '091 Patent.

258. The claims of the '091 Patent are so broad that they cover the prior art Marine 300, Marine 400, and European EZ Path 44+ device, which, on the surface, look different from the accused EZ Path® Retrofit Device and the figures in the '091 Patent.

259. Attached as Exhibit 23 is a claim chart that shows, on an element-by-element basis, that claim 1 of the '091 Patent reads on the prior art European EZ Path 44+ device.

260. Because the prior art European EZ Path 44+ device, as well as the Marine 300 and Marine 400 devices, embodies claim 1 of the '091 Patent, that claim is invalid under 35 U.S.C. § 102.

261. In addition, the asserted claim(s) of the '091 Patent are invalid under 35 U.S.C. §§ 102 and/or 103 because they are anticipated and/or obvious in light of other prior art references.

262. For example, the asserted claim(s) of the '091 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. Pub. App. US 2014/0020915 A1 (Lopes), owned by STI
- U.S. Pat. No. 5,058,341 (Harbeke)
- U.S. Pat. No. 5,347,767 (Roth)
- U.S. Pat. No. 5,351,448 (Gohlke)
- U.S. Pat. No. 5,452,551 (Charland)
- U.S. Pat. No. 6,176,052 (Takahashi)
- U.S. Pat. No. 7,797,893 (Stahl), owned by STI
- U.S. Pat. No. 9,162,093 (Foerg)
- DE216225 (Nichtnennung)
- DE9411293 (Pafamax)
- DE0988873 (Boot)

- JP2000240854 (Kaneda)
- JP2014148998 (Muroya)
- JP2015057560 (Muroya II)
- Guideline on Through-Penetration on Firestopping (2d ed.) (Sheet Metal & Air Conditioning Contractors' National Assoc.)
- 2003 STI brochure (Exhibit 41)
- May 2013 STI Marine Firestop brochure (Exhibit 5)

263. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible priority date of the '091 Patent, to achieve the asserted claim(s) of the '091 Patent for at least the following reasons: (1) it was well known in the prior art and understood that the use of intumescent material in a frame is advantageous to direct the expansion of intumescent material toward the building feature and not away from the location where sealing is desired; (2) it was well known in the prior art and understood that the opening in the frame should permit a building feature to pass through so that the apparatus can create a seal between the building feature and the opening around a building; (3) it would have been an obvious modification of the prior art, if not explicit or inherent in that art, to use a first and second area of intumescent material, such that the first area and second area overlap one another and overlap the opening of the frame to ensure that there is sufficient intumescent

material to form a seal; (4) it would have been an obvious modification of the prior art, if not explicit or inherent in that art, to use a first and second area of intumescent material that extend beyond the edge of the frame to allow various sizes and larger building features to pass through while maintaining the ability to form a seal; (5) it was well known in the prior art and understood that the use of two different intumescent materials, including with different temperature resistances or stability, would allow greater stability of the intumescent material and prevent it from falling out of the frame; and (6) a person of ordinary skill designing a fire protection sleeve would find the design of other pipe collars and fire stopping devices to be useful references. The combination of one or more of these references would have yielded entirely predictable results.

264. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 8: Declaration of Invalidity of U.S. Patent No. 10,596,399

265. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

266. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '399 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each

asserted claim of the '399 Patent is valid, and specifically alleges that STI infringes claim 1 of the '399 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Retrofit Device (including model numbers EZDR200 and EZDR400) and the EZ Path® Cable Tray Retrofit Device (including model numbers EZCTR612, EZCTR614, EZCTR616, EZCTR618). STI contends that each asserted claim of the '399 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

267. The '399 Patent is invalid for failure to meet the requirements of the Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

268. At least claim 1 of the '399 Patent is invalid under 35 U.S.C. § 102 because STI's prior art Marine 300, Marine 400, and European EZ Path 44+ products were on sale, actually sold, described in printed publications, in public use, and/or were otherwise available to the public before April 27, 2015, the earliest priority date of the '399 Patent. See Exhibit 4 (11/30/12 invoice) and Exhibit 6 (6/28/13 invoice). Because the Marine 300, Marine 400, and European EZ Path 44+ products were sold before April 27, 2015, they are prior art to the '399 Patent.

269. The claims of the '399 Patent are so broad that they cover the prior art Marine 300, Marine 400, and European EZ Path 44+ device, which, on the surface, look different from the accused EZ Path® Retrofit Device, EZ Path® Cable Tray Retrofit Device, and the figures in the '399 Patent.

270. Attached as Exhibit 24 is a claim chart that shows, on an element-by-element basis, that claim 1 of the '399 Patent reads on the prior art European EZ Path 44+ device.

271. Because the prior art European EZ Path 44+ device, as well as the Marine 300 and Marine 400 devices, embodies claim 1 of the '399 Patent, that claim is invalid under 35 U.S.C. § 102.

272. In addition, the asserted claim(s) of the '399 Patent are invalid under 35 U.S.C. §§ 102 and/or 103 because they are anticipated and/or obvious in light of other prior art references.

273. For example, the asserted claim(s) of the '399 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. No. 6,725,615 (Porter)
- U.S. Pat. No. 7,478,503 (Milani)
- U.S. Pat. No. 7,560,644 (Ford)
- U.S. Pat. No. 8,672,275 (van Walraven)
- U.S. Pat. No. 8,910,949 (Akesson)
- U.S. Pat. App. Pub. No. 2005/0133242 (Kreutz)
- U.S. Pat. App. Pub. No. 2007/0151183 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2012/0304979 (Munzenberger)

- U.S. Pat. App. Pub. No. 2013/0097948 (Burgess)
- U.S. Pat. App. Pub. No. 20140077043 (Foerg)
- WO2002/037011 (Wichmann)
- DE202006019593 (Roxtec)
- GB2216220 (Patterson)
- GB2233725 (Hamilton)
- GB2457152 (Parkkila)
- AU-B-30326/95 (Wexler)
- ES2312276 (Monroy Gemio)
- STI Firestopping – Products for Life Safety and Code Compliance
(1/23/2014)
- 2003 STI brochure (Exhibit 41)
- May 2013 STI Marine Firestop brochure (Exhibit 5)

274. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible priority date of the '399 Patent, to achieve the asserted claim(s) of the '399 Patent for at least the following reasons: (1) it was well known and understood in the art that a firestop apparatus can comprise a frame with an interior space comprising intumescent material; (2) it was well known and understood in the art that modular frames in which frame parts can be detached and reattached is advantageous for

flexibility in adjusting the opening size; and (3) it was well known and understood in the art that intumescent material could form an opening through which a pipe or cable could pass. The combination of one or more of these references would have yielded entirely predictable results.

275. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 9: Declaration of Invalidity of U.S. Patent No. 10,610,711

276. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

277. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration under the patent laws of the United States that the asserted claims of the '711 Patent are invalid. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti contends that each asserted claim of the '711 Patent is valid, and specifically alleges that STI infringes claim 1 of the '711 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Cable Tray Retrofit Device (including model numbers EZCTR612, EZCTR614, EZCTR616, EZCTR618). STI contends that each asserted claim of the '711 Patent is invalid. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

278. The '711 Patent is invalid for failure to meet the requirements of the

Patent Act, including but not limited to 35 U.S.C. §§ 102, 103, and/or 112.

279. At least claim 1 of the '711 Patent is invalid under 35 U.S.C. § 102 because STI's prior art Marine 300, Marine 400, and European EZ Path 44+ products were on sale, actually sold, described in printed publications, in public use, and/or were otherwise available to the public before April 27, 2015, the earliest priority date of the '711 Patent. See Exhibit 4 (11/30/12 invoice) and Exhibit 6 (6/28/13 invoice). Because the Marine 300, Marine 400, and European EZ Path 44+ products were sold before April 27, 2015, they are prior art to the '711 Patent.

280. The claims of the '711 Patent are so broad that they cover the prior art Marine 300, Marine 400, and European EZ Path 44+ devices, which, on the surface, look different from the accused EZ Path® Retrofit Device and the figures in the '711 Patent.

281. Attached as Exhibit 25 is a claim chart that shows, on an element-by-element basis, that claim 1 of the '711 Patent reads on the prior art European EZ Path 44+ device.

282. Because the prior art European EZ Path 44+ device, as well as the Marine 300 and Marine 400, embodies claim 1 of the '711 Patent, that claim is invalid under 35 U.S.C. § 102.

283. In addition, the asserted claim(s) of the '711 Patent are invalid under 35 U.S.C. §§ 102 and/or 103 because they are anticipated and/or obvious in light

of other prior art references.

284. For example, the asserted claim(s) of the '711 Patent are anticipated and/or rendered obvious by at least the following prior art references, alone or in combination:

- U.S. Pat. No. 6,725,615 (Porter)
- U.S. Pat. No. 7,478,503 (Milani)
- U.S. Pat. No. 7,560,644 (Ford)
- U.S. Pat. No. 8,672,275 (van Walraven)
- U.S. Pat. No. 8,910,949 (Akesson)
- U.S. Pat. App. Pub. No. 2005/0133242 (Kreutz)
- U.S. Pat. App. Pub. No. 2007/0151183 (Stahl), owned by STI
- U.S. Pat. App. Pub. No. 2012/0304979 (Munzenberger)
- U.S. Pat. App. Pub. No. 2013/0097948 (Burgess)
- U.S. Pat. App. Pub. No. 20140077043 (Foerg)
- WO2002/037011 (Wichmann)
- DE202006019593 (Roxtec)
- GB2216220 (Patterson)
- GB2233725 (Hamilton)
- GB2457152 (Parkkila)
- AU-B-30326/95 (Wexler)

- ES2312276 (Monroy Gemio)
- STI Firestopping – Products for Life Safety and Code Compliance (1/23/2014)
- 2003 STI brochure (Exhibit 41)
- May 2013 STI Marine Firestop brochure (Exhibit 5)

285. A person of ordinary skill in the art would have been motivated to combine one or more of these prior art references, before the earliest possible priority date of the '711 Patent, to achieve the asserted claim(s) of the '711 Patent, for at least the following reasons: (1) it was well known and understood in the art that a firestop apparatus can comprise a frame with an interior space comprising intumescent material; (2) it was well known and understood in the art that modular frames in which frame parts can be detached and reattached is advantageous for flexibility in adjusting the opening size; and (3) it was well known and understood in the art that intumescent material could form an opening through which a pipe or cable could pass. The combination of one or more of these references would have yielded entirely predictable results.

286. STI reserves the right to raise additional grounds of invalidity and identify additional prior art references as its investigation progresses.

Count 10: Non-Infringement of U.S. Patent No. 10,295,088

287. STI incorporates by reference and realleges the preceding paragraphs

of these Counterclaims as though fully set forth herein.

288. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '088 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '088 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Series 44+ Fire Rated Pathway (the "EZ Path Pathway"). STI contends that it does not infringe the '088 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

289. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '088 Patent, either literally or under the doctrine of equivalents.

290. The accused EZ Path Pathway does not infringe claim 1 of the '088 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: "a flexible material mounted in the passage channel at a location spaced from the curtain."

291. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '088 Patent, either literally or under the doctrine of equivalents.

Count 11: Non-Infringement of U.S. Patent No. 10,663,090

292. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

293. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '090 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '090 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Series 44+ Fire Rated Pathway (the "EZ Path Pathway"). STI contends that it does not infringe the '090 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

294. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '090 Patent, either literally or under the doctrine of equivalents.

295. The accused EZ Path Pathway does not infringe claim 1 of the '090 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: "flexible material."

296. The accused EZ Path Pathway does not infringe claim 2 of the '090 Patent (or any claims that depend from claim 2), either literally or under the doctrine

of equivalents, because it does not include at least the following claim limitations:
“flexible strips that are mounted in the passage channel.”

297. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '090 Patent, either literally or under the doctrine of equivalents.

Count 12: Non-Infringement of U.S. Patent No. 11,242,946

298. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

299. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '946 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '946 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Series 44+ Fire Rated Pathway (the “EZ Path Pathway”). STI contends that it does not infringe the '946 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

300. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '946 Patent, either literally or under the doctrine of equivalents.

301. The accused EZ Path Pathway does not infringe claim 1 of the '946

Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “a fire-retardant material.”

302. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '946 Patent, either literally or under the doctrine of equivalents.

Count 13: Non-Infringement of U.S. Patent No. 10,267,036

303. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

304. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '036 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '036 Patent by making, using, selling, offering to sell, and/or importing the SpeedFlex® Track Top Gasket (TTG), Part Number TTG350F. STI contends that it does not infringe the '036 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

305. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '036 Patent, either literally or under the doctrine of equivalents.

306. The accused SpeedFlex TTG does not infringe claim 1 of the '036 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “connection element”; “sealing elements.”

307. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '036 Patent, either literally or under the doctrine of equivalents.

Count 14: Non-Infringement of U.S. Patent No. 10,774,528

308. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

309. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '528 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '528 Patent by making, using, selling, offering to sell, and/or importing the SpeedFlex® Track Top Gasket (TTG), Part Number TTG350F. STI contends that it does not infringe the '528 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

310. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '528 Patent, either literally or under the doctrine

of equivalents.

311. The accused SpeedFlex TTG does not infringe claim 1 of the '528 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “connection section”; “a first sealing section and a second sealing section.”

312. The accused SpeedFlex TTG does not infringe claim 12 of the '528 Patent (or any claims that depend from claim 12), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “connection section.”

313. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '528 Patent, either literally or under the doctrine of equivalents.

Count 15: Non-Infringement of U.S. Patent No. 10,641,417

314. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

315. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '417 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '417 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Retrofit Device

(including model numbers EZDR200 and EZDR400). STI contends that it does not infringe the '417 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

316. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '417 Patent, either literally or under the doctrine of equivalents.

317. The accused Retrofit Device does not infringe claim 1 of the '417 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “first area of intumescent material”; “second area of intumescent material”; “wherein the second area of intumescent material is between the frame and the first intumescent material.”

318. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '417 Patent, either literally or under the doctrine of equivalents.

Count 16: Non-Infringement of U.S. Patent No. 11,137,091

319. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

320. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims

of the '091 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '091 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Retrofit Device (including model numbers EZDR200 and EZDR400). STI contends that it does not infringe the '091 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

321. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '091 Patent, either literally or under the doctrine of equivalents.

322. The accused Retrofit Device does not infringe claim 1 of the '091 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “first layer comprising a first material”; “second layer comprising a second material”; “offset in the second direction so as to be in different planes.”

323. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '091 Patent, either literally or under the doctrine of equivalents.

Count 17: Non-Infringement of U.S. Patent No. 10,596,399

324. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

325. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '399 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '399 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Retrofit Device (including model numbers EZDR200 and EZDR400) and the EZ Path® Cable Tray Retrofit Device (including model numbers EZCTR612, EZCTR614, EZCTR616, EZCTR618). STI contends that it does not infringe the '399 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

326. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '399 Patent, either literally or under the doctrine of equivalents.

327. The accused Retrofit Device does not infringe claim 1 of the '399 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “a modular frame.”

328. The accused Cable Tray Retrofit Device does not infringe claim 1 of the '399 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim

limitations: “a modular frame.”

329. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '399 Patent, either literally or under the doctrine of equivalents.

Count 18: Non-Infringement of U.S. Patent No. 10,610,711

330. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

331. This counterclaim is for declaratory relief pursuant to 28 U.S.C. §§ 2201-2202, and seeks a declaration that STI does not infringe the asserted claims of the '711 Patent. This Counterclaim relates directly to claims asserted by Hilti in the Complaint. Hilti alleges that STI infringes claim 1 of the '711 Patent by making, using, selling, offering to sell, and/or importing the EZ Path® Cable Tray Retrofit Device (including model numbers EZCTR612, EZCTR614, EZCTR616, EZCTR618). STI contends that it does not infringe the '711 Patent. Therefore, an actual controversy exists between the parties under Article III of the United States Constitution.

332. STI has not directly or indirectly infringed, and does not directly or indirectly infringe, any claim of the '711 Patent, either literally or under the doctrine of equivalents.

333. The accused Cable Tray Retrofit Device does not infringe claim 1 of

the '711 Patent (or any claims that depend from claim 1), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: “frame parts that are joined end-to-end to form a modular construction.”

334. The accused Cable Tray Retrofit Device does not infringe claim 16 of the '711 Patent (or any claims that depend from claim 16), either literally or under the doctrine of equivalents, because it does not include at least the following claim limitations: frame parts “that interchangeably attach to and detach from one another in order to allow a size of the frame to increase and decrease”; “the plurality of parts removably joined end-to-end in a modular construction.”

335. STI is entitled to a declaratory judgment that it does not directly or indirectly infringe any claims of the '711 Patent, either literally or under the doctrine of equivalents.

Count 19: Infringement of STI's U.S. Patent No. 10,143,868

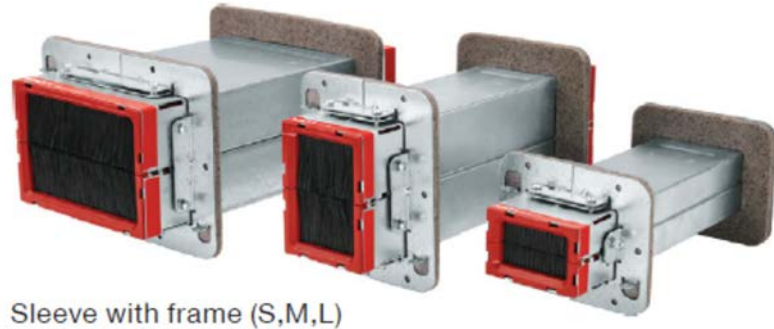
336. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

337. STI is the owner by assignment of U.S. Patent No. 10,143,868 (the “'868 Patent”), titled “Cable Firestopping Apparatus.” A true and correct copy of the '868 Patent is attached hereto as Exhibit 26.

338. The '868 Patent was duly and legally issued by the USPTO on December 4, 2018.

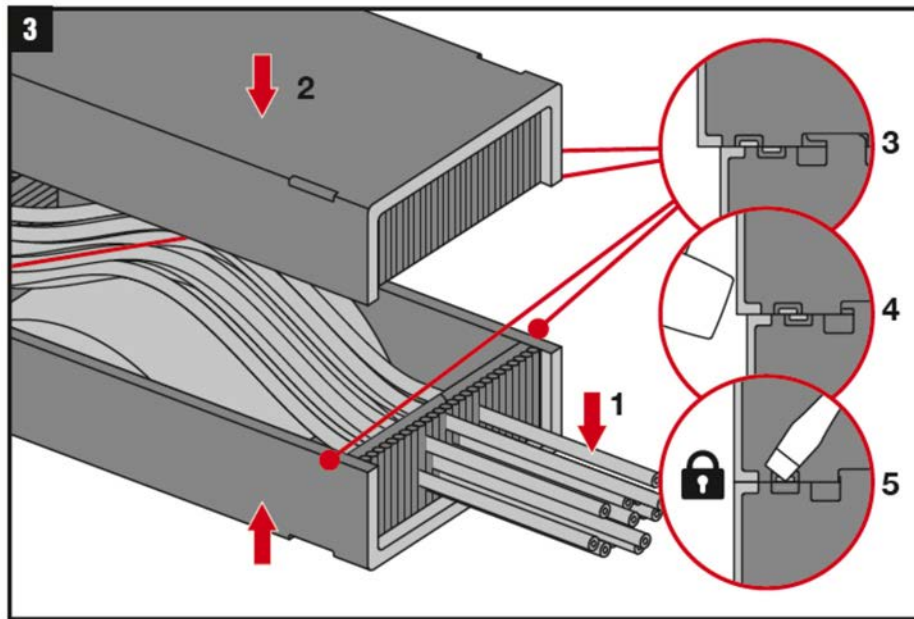
339. Hilti has directly infringed the '868 Patent by making, using, offering to sell, selling, and/or importing into the United States, without authority, several different models of cable firestopping apparatus products that fall within the scope of at least claims 1 and 9 of the '868 Patent.

340. For example, Hilti's CFS-MSL Modular Fire Sleeve products, which are available in at least three different sizes (small (3" x 2"), medium (3" x 4") and large (6" x 4")) (the "Accused Hilti MFS") practice each and every element of at least claims 1 and 9 of the '868 Patent. Below is a photograph of the Accused Hilti MFS as it appears in Hilti's Product Information Sheet for the Modular Fire Sleeve:



See Exhibit 27 (Product Information Sheet for Hilti CFS-MSL Modular Fire Sleeve).

341. The Operating Instructions for the Accused Hilti CFS product depict different configurations of the product. For example, the below excerpt from the Operating Instructions shows that the Accused Hilti CFS product can be separated into two parts.



See Exhibit 28 (Operating Instructions for Hilti CFS-MSL Modular Fire Sleeve).

342. Specifically, the Accused Hilti MSF is a firestopping apparatus that includes: (1) a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein, the front panel defining a front opening therethrough and the rear panel defining a rear opening therethrough; (2) the housing including first and second housing members which are completely detachable from one another and; (3) moveable relative to one another between an assembled condition wherein the first and second housing members are interconnected and the wall surface is substantially continuous about the internal chamber and an open condition wherein at least a portion of the first and second housing members are spaced from one another such that at least a portion of the wall surface is non-contiguous to define an opening into the internal chamber; and

(4) intumescent material positioned within the internal chamber. Therefore, the Accused Hilti MSF falls within the scope of claim 1 of the '868 Patent.

343. In addition, the Accused Hilti MSF product is a firestopping apparatus that includes: (1) a housing having a wall surface with an inner chamber defined therein, a front panel extending from the wall surface and defining a front opening therethrough; (2) the housing including first and second housing members which are moveable relative to one another; (3) between an assembled condition wherein the first and second housing members are interconnected and the wall surface is substantially continuous about the internal chamber, and an open condition wherein at least a portion of the first and second housing members are spaced from one another such that at least a portion of the wall surface is non-contiguous to define an opening into the internal chamber; and (4) intumescent material positioned within the internal chamber; (5) wherein a sealing member extends across at least a portion of the front opening. Therefore, the Accused Hilti MSF products fall within the scope of claim 9 of the '868 Patent.

344. Attached hereto as Exhibit 29 is a detailed claim chart that demonstrates on an element-by-element basis how the Accused Hilti MSF products embody claims 1 and 9 of the '868 Patent.

345. The full extent of Hilti's infringement is not yet precisely known to STI. STI makes this preliminary identification of infringing products and infringed

claims without the benefit of discovery or claim construction in this action, and expressly reserves the right to augment, supplement, and revise its identifications based on additional information obtained through discovery or otherwise.

346. STI has suffered damages, including specifically lost profits, as a result of Hilti's infringement of the '868 Patent in an amount to be determined at trial.

347. As a direct result of Hilti's infringement of the '868 Patent, STI has been, is being, and will continue to be, seriously damaged and irreparably harmed unless Hilti is enjoined by this Court from the actions complained of herein, and thus STI is without an adequate remedy at law. STI is entitled to a permanent injunction against further infringement of the '868 Patent.

Count 20: Infringement of STI's U.S. Patent No. 9,157,232

348. STI incorporates by reference and realleges the preceding paragraphs of these Counterclaims as though fully set forth herein.

349. STI is the owner by assignment of U.S. Patent No. 9,157,232 (the "'232 Patent"), titled "Adjustable Head-of-Wall Insulation Construction for Use with Wider Wall Configurations." A true and correct copy of the '232 Patent is attached hereto as Exhibit 30.

350. The '232 Patent was duly and legally issued by the USPTO on October 13, 2015.

351. Hilti has directly infringed the '232 Patent by making, using, offering

to sell, selling, and/or importing into the United States, without authority, several different models of joint sealing tape, including but not limited to the CFS-TTS Firestop Top Track Seal, CS-TTS SA Smoke and Acoustic Track Seal, and CFS-TTS MD Firestop Top Track Seal (collectively, the “Accused Hilti TTS”) that fall within the scope of at least claim 6 of the ’232 Patent.

352. For example, the Accused Hilti TTS practices each and every element of at least claim 6 of the ’232 Patent. Below is a photograph of the Accused Hilti TTS as it appears in Hilti’s Product Information Sheet for the Top Track Seal:



See Exhibit 31 (Product Information Sheet for Accused Hilti TTS).

353. The Instructions for Use and Brochure for the Accused Hilti TTS instruct users on how to install it:



Exhibit 32 (Instructions for Use: Accused Hilti TTS).

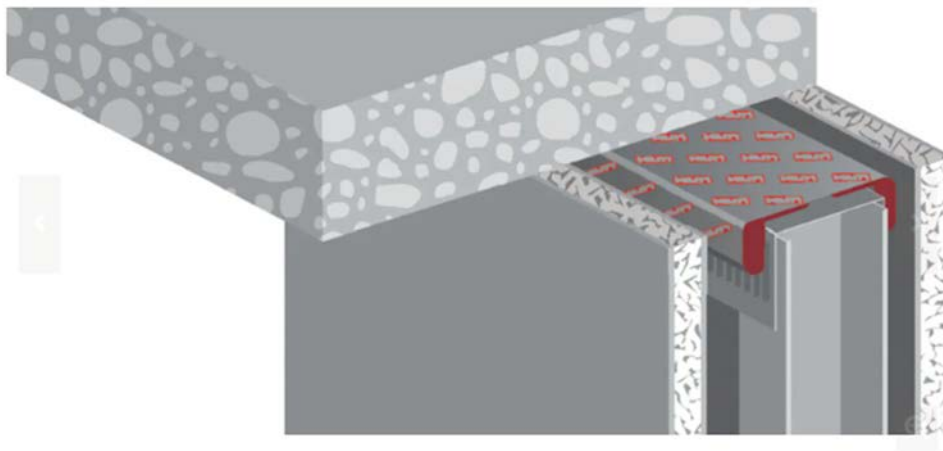


Exhibit 33 (Brochure: Accused Hilti TTS).

354. Specifically, the Accused Hilti TTS is an adjustable head-of-wall insulating construction that includes:

A. a first L-shaped gasket section including: (1) a first gasket upper

panel of insulating material positioned immediately above the main track section of the ceiling track and extending generally horizontally thereover; and (2) a first gasket side panel of insulating material attached with respect to said first gasket upper panel and extending generally downwardly therefrom across the first track side section for insulating thereover, said first gasket side panel extending downwardly from said first gasket upper panel to define the generally L-shaped configuration of the first L-shaped gasket section, said first gasket upper panel and said first gasket side panel together defining a track receiving recess facing downwardly therebelow;

B. a second L-shaped gasket section including: (1) a second gasket upper panel of insulating material positioned immediately above the main track section of the ceiling track and extending generally horizontally thereover at a position spatially disposed from said first gasket upper panel; and (2) a second gasket side panel of insulating material attached with respect to said second gasket upper panel and extending generally downwardly therefrom across the second track side section for insulating thereover, said second gasket side panel extending downwardly from said second gasket upper panel to define the generally L-shaped configuration of the second L-shaped gasket section, said second gasket upper panel and said second gasket side panel and said first gasket upper panel and said first gasket side panel

together defining a track receiving recess facing downward therebelow for receiving a ceiling track positionable therewithin for facilitating insulating therearound;

C. a first panel adhesive means mounted on said first gasket upper panel at a position between said first gasket upper panel of said first L-shaped gasket section and the main track section of the ceiling track to facilitate engagement therebetween;

D. a second panel adhesive means mounted on said second gasket upper panel at a position between said second gasket upper panel of said second L-shaped gasket section and the main track section of the ceiling track to facilitate engagement therebetween; and

E. at least one connecting strap positioned above the main track section of the ceiling track and attached to said first L-shaped gasket section and to said second L-shaped gasket section to limit spatial separation therebetween.

Therefore, the Accused Hilti TTS products fall within the scope of claim 6 of the '232 Patent.

355. Attached hereto as Exhibit 42 is a detailed claim chart that demonstrates on an element-by-element basis how the Accused Hilti TTS products embody claim 6 of the '232 Patent.

356. The full extent of Hilti's infringement is not yet precisely known to

STI. STI makes this preliminary identification of infringing products and infringed claims without the benefit of discovery or claim construction in this action, and expressly reserves the right to augment, supplement, and revise its identifications based on additional information obtained through discovery or otherwise.

357. STI has suffered damages, including specifically lost profits, as a result of Hilti's infringement of the '232 Patent in an amount to be determined at trial.

358. As a direct result of Hilti's infringement of the '232 Patent, STI has been, is being, and will continue to be, seriously damaged and irreparably harmed unless Hilti is enjoined by this Court from the actions complained of herein, and thus STI is without an adequate remedy at law. STI is entitled to a permanent injunction against further infringement of the '232 Patent.

PRAYER FOR RELIEF

WHEREFORE, STI respectfully prays the Court grant the following relief:

- (1) That judgment be entered in favor of STI;
- (2) That this Court enter an Order declaring that the '088 Patent, '090 Patent, '946 Patent, '036 Patent, '528 Patent, '417 Patent, '091 Patent, '399 Patent, and '711 Patents are invalid;
- (3) That this Court enter an Order declaring that STI does not infringe the '088 Patent, '090 Patent, '946 Patent, '036 Patent, '528 Patent, '417 Patent, '091 Patent, '399 Patent, or '711 Patent;

(4) That this Court enter an Order declaring that Hilti infringes the '868 Patent and '232 Patent;

(5) That this Court permanently enjoin Hilti, its officers, agents, employees, representatives, successors and assigns, and any others acting in concert with it, from infringing the '868 Patent and '232 Patent;

(6) That this Court award STI adequate damages resulting from Hilti's infringement of the '868 Patent and '232 Patent;

(7) That this Court declare this to be an exceptional case under 35 U.S.C. § 285;

(8) That this Court award STI its costs in this action, together with reasonable attorneys' fees and pre-judgment and post-judgment interest; and

(9) That this Court grant STI such other and further relief as it deems just and proper.

JURY DEMAND

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, STI hereby respectfully requests a trial by jury of all issues so triable.

Dated: November 21, 2022

FOX ROTHSCHILD LLP

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Counterclaimant Specified Technologies
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