

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

HILTI AKTIENGESELLSCHAFT,

Plaintiff, Counterclaim Defendant

v.

SPECIFIED TECHNOLOGIES INC.,

Defendant, Counterclaimant.

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

**DEFENDANT AND COUNTERCLAIMANT SPECIFIED
TECHNOLOGIES INC.'S OBJECTIONS AND RESPONSES TO
PLAINTIFF AND COUNTERCLAIM DEFENDANT HILTI
AKTIENGESELLSCHAFT'S SECOND SET OF INTERROGATORIES**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and this Court's Local Rules, Defendant and Counterclaimant Specified Technologies, Inc. ("STI" or "Defendant") hereby responds to Plaintiff and Counterclaim Defendant Hilti Aktiengesellschaft's ("Hilti" or "Plaintiff") Second Set of Interrogatories (Nos. 7-12) (the "Interrogatories"), as follows:

INTRODUCTION

As discovery is still in its early stages, STI reserves the right to supplement or amend these objections and answers under Fed. R. Civ. P. 26(e). The following responses reflect STI's good faith effort to provide responsive information now known to STI, and are based upon information and documentation that is currently available and specifically known to STI following a reasonable and ongoing investigation, and are given without prejudice to STI's right to produce or rely on subsequently discovered, uncovered, or learned information and documentation.

STI anticipates that further discovery, independent investigation, and analysis may lead to the discovery of additional documents, supply additional facts, and add meaning to known facts, as well as establish entirely new factual conclusions and legal contentions, all of which may lead to additions to, changes to, or variations from the information set forth herein. The following responses reflect STI's good faith effort to provide responsive information now known to STI, but STI reserves the right both to supplement and amend any of the responses set forth below and to utilize at trial any further information revealed by further discovery, independent investigation, and analysis.

GENERAL OBJECTIONS

1. STI objects to each interrogatory, and the instructions and definitions that accompany it, to the extent that it requests information protected by the attorney-client privilege, work-product immunity, and/or other applicable privilege or immunity. The inadvertent production by STI of any document, information, or thing protected from disclosure by the attorney-client privilege, work-product immunity, and/or other applicable privilege or immunity is unintentional and shall not be construed as a waiver of any applicable objection or privilege.

2. STI objects to these Interrogatories to the extent they seek information that is not relevant to the claims or defenses of any party.

3. STI objects to these Interrogatories to the extent they are disproportionate to the needs of the case considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, STI's limited resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.

4. STI objects to Hilti's Interrogatories to the extent that they are vague, ambiguous, and do not identify with particularity the information sought.

5. STI objects to Hilti's Interrogatories to the extent that they are overbroad or unduly burdensome in that the burden or expense of the proposed discovery outweighs its likely benefit.

6. STI objects to Hilti's Interrogatories to the extent that they are unreasonably cumulative and duplicative.

7. STI objects to Hilti's Interrogatories to the extent that they are unreasonably unlimited in time.

8. STI objects to each interrogatory to the extent it requests STI to identify "all" information, documents, and/or things relating to a particular subject, on the ground that such interrogatories are overly broad and unduly burdensome.

9. STI objects to each interrogatory to the extent it seeks information available through public sources, known to Hilti, or may be obtained from less burdensome sources.

10. STI objects to Hilti's Interrogatories, definitions, and instructions to the extent that they attempt to impose duties upon STI greater than those required by the Federal Rules of Civil Procedure, the Local Rules of the District of Delaware, any agreements or stipulations between the parties, or any other applicable rule or law.

11. STI objects to Hilti's Interrogatories to the extent that they require any information or documents beyond what is available to STI at present from a reasonable search of its own files or reasonable inquiry of STI's employees or officers. STI reserves the right to supplement its answers to Hilti's Interrogatories as well as the information and documents

produced or identified in response to these interrogatories as discovery progresses and in accordance with the Federal Rules of Civil Procedure.

12. STI objects to the extent that the Interrogatories prematurely seek expert discovery.

13. STI objects to each interrogatory, and the instructions and definitions accompanying it, to the extent it calls for any legal conclusions.

14. STI objects to the identification or disclosure of information in the possession, custody, or control of STI that STI is obligated to a third party to maintain in confidence.

15. STI objects to the Interrogatories to the extent they seek the disclosure or identification of documents or things that are not within STI's possession, custody, or control.

16. STI objects to Hilti's Interrogatories to the extent that they prematurely seek STI's contentions, including information and contentions of STI prior to Hilti providing the basis for its claims which it has the burden of proving. STI reserves the right to amend and supplement its answers to the Interrogatories as more information is discovered or otherwise becomes available to STI.

17. STI objects to each interrogatory as compound to the extent it contains multiple subparts or attempts to improperly combine multiple subparts into one request.

18. STI objects to Hilti's definition of "STI," "Defendant," "You," and "Your" as overly inclusive, overbroad, and unduly burdensome in that it includes any person or entity who is currently or was previously affiliated with STI, or who has ever done business with STI, and seeks information that is not relevant to any claim or defense in this action.

19. STI's answers to Hilti's Interrogatories are all made subject to and without waiver of the foregoing General Objections. To the extent that STI cites a particular General Objection in a particular response, STI does so because it believes that the General Objection is particularly

relevant to the interrogatory but not to the exclusion of any other General Objections.

20. In answering the Interrogatories, STI does not concede that any of the information sought or provided is relevant, material, or admissible in evidence.

21. STI's answers to these Interrogatories in no way constitute acquiescence or agreement to any definition proposed by Hilti.

22. To the extent STI responds to any Interrogatories by stating that responsive documents will be produced and identified, such statement does not constitute a representation that such documents or things exist but only that a reasonable search for such documents has been or will be made and that any relevant, responsive, non-privileged documents that STI locates will be produced and identified.

23. The specific responses set forth below are for the purposes of discovery only, and STI neither waives nor intends to waive, but rather expressly reserves, any and all objections to the relevance, competence, materiality, privilege, admissibility, or use at any hearing or at trial of any information, documents, or things produced, identified, or referred to herein, or to the introduction of any evidence at any hearing or at trial relating to the subjects covered by such responses.

SPECIFIC OBJECTIONS AND ANSWERS TO INTERROGATORIES

Interrogatory No. 7: Identify the location of, all individuals involved in, and the circumstances surrounding the alleged installation of devices shown in STI-1248-003736, STI-1248-003738, and STI-1248-003767.

RESPONSE: STI incorporates by reference the foregoing General Objections as if fully stated herein. STI further objects to this Interrogatory as compound to the extent it contains multiple subparts or attempts to improperly combine multiple subparts into one request.

Subject to and without waiver of the foregoing objections, STI responds as follows:

The European EZ Path 44+ devices shown in STI-1248-003736, STI-1248-003738, and STI-1248-003767 were installed prior to December 9, 2013 in a building in Europe, although these photographs were taken on December 19, 2013. Tony Abou Rjeily was involved in the project that resulted in the installation of the European EZ Path 44+ devices. STI generally sells its products to its distributors (such as, e.g., Legrand), and those distributors in turn sell the products to the ultimate buyer. In general, neither STI nor its distributors are told by the ultimate customer where the STI products will be installed. Because STI does not track—and indeed has no way of tracking—where its products are ultimately installed unless they are provided that information by mere fortuity or happenstance, information regarding the locations of other buildings where these European EZ Path 44+ devices were installed prior to December 9, 2013 is not within STI’s possession, custody, or control. As discovery progresses, STI may serve additional discovery, including third party discovery, to obtain information regarding where these European EZ Path 44+ devices were installed. In accordance with Fed. R. Civ. P. 26(e), STI will supplement this response in a timely manner in due course.

Interrogatory No. 8: To the extent You allege that an asserted claim of the STI Patents-in-Suit, including, without limitation, claims 6-12 of U.S. Patent No. 9,157,232 and claims 1-6 and 9 of U.S. Patent No. 10,143,868, is not invalid, describe in full, for each such claim, element by element, the legal and factual basis for Your allegation that the claim is not invalid specifically in response to Hilti’s First Amended Answer, Defenses, and Counterclaims, dated January 27, 2023 (D.I. 25), and its Invalidity Contentions, served on June 30, 2023, including a description of all Documents and witnesses you intend to rely on regarding the validity of the asserted claims.

RESPONSE: STI incorporates by reference the foregoing General Objections as if fully stated herein. STI further objects to this Interrogatory as calling for claim construction prior to the deadlines for the claim construction process included in the Scheduling Order, in particular to the extent this Interrogatory calls for information regarding STI’s positions on 35 U.S.C. § 112 and indefiniteness issues and further in light of the fact that STI requested similar information

from Hilti well in advance of Hilti's request to STI, but Hilti has yet to provide a substantive response on the issue. Thus, providing this information prematurely would give Hilti an unfair advantage and reward Hilti for failing to provide its own discovery on this topic. STI further objects to this Interrogatory as premature. It will be Hilti's burden to demonstrate obviousness by clear and convincing evidence that each asserted claim is invalid as obvious. STI has no burden to prove validity in this Court. STI further objects to this Interrogatory as compound to the extent it contains multiple subparts or attempts to improperly combine multiple subparts into one request. STI further objects to this Interrogatory to the extent it requests or implicates information protected from disclosure by the attorney-client privilege and/or work product doctrine.

Subject to and without waiver of the foregoing objections, STI responds as follows:

Pursuant to the Scheduling Order, Hilti served its Invalidity Contentions on June 30, 2023 (D.I. 35). STI's response to this interrogatory is in response to those Invalidity Contentions. Below STI sets forth, on a claim by claim and element by element basis, STI's contentions as to why none of its Asserted Claims of its Asserted Patents are invalid. STI expressly reserves the right to oppose any amendment Hilti may attempt to make to its Invalidity Contentions in the future. STI also expressly reserves the right to supplement its response to this interrogatory. STI further notes that Hilti has alleged in its interrogatory responses that the STI products covered by STI's patents, and/or products similar to them, are commercially successful. STI may rely on this and other secondary considerations of nonobviousness and refers to its response to Interrogatory 11 as well. STI further notes that Hilti has thus far failed to provide any substantive response to a similar interrogatory served on Hilti by STI much earlier in the discovery phase of this litigation.

U.S. Patent No. 10,143,868 to Lopes et al. (“the ‘868 Patent”)

i) Exhibit 1: Hilti’s Invalidity Contentions for 3M Fire Barrier Pass-Through Devices (“the 3M Device”)

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the following elements of claim 1 of the ‘868 patent:

- [1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;
- [1.1.2] the front panel defining a front opening therethrough;
- [1.1.3] the rear panel defining a rear opening therethrough; and
- [1.1.4] the housing including first and second housing members which are completely detachable from one another and movable relative to one another between.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the subject matter of claim 2 of the ‘868 patent, i.e., one or more mounting tabs extend outwardly from the housing.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the subject matter of claim 5 of the ‘868 patent, i.e., the first and second housing members are completely detachable from one another via the hinge.

Hilti states on page 16 of Exhibit 1 that the 3M Device does not teach the subject matter of claim 6 of the ‘868 patent, i.e., a latching assembly positioned along the wall surface to lock the housing in the assembled condition.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the following elements of claim 9 of the ‘868 patent: [9.1.2] a front panel extending from the wall surface and defining a front opening therethrough; and [9.3] wherein a sealing member extends across at least a portion of the front opening.

ii) Exhibit 2: Hilti’s Invalidity Contentions for 3M Fire Barrier Pass-Through Devices with Product Numbers PT2RD, PT4RD and PT4SD (the “3M Device”)

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the following elements of claim 1 of the ‘868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;
[1.1.2] the front panel defining a front opening therethrough;
[1.1.3] the rear panel defining a rear opening therethrough; and
[1.1.4] the housing including first and second housing members which are completely detachable from one another and movable relative to one another between.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the subject matter of claim 2 of the '868 patent, i.e., one or more mounting tabs extend outwardly from the housing.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the subject matter of claim 5 of the '868 patent, i.e., the first and second housing members are completely detachable from one another via the hinge.

Hilti states on page 21 of Exhibit 2 that the 3M Device does not disclose the subject matter of claim 6 of the '868 patent, i.e., a latching assembly positioned along the wall surface to lock the housing in the assembled condition.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the 3M Device does not disclose the following elements of claim 9 of the '868 patent: [9.1.2] a front panel extending from the wall surface and defining a front opening therethrough; and [9.3] wherein a sealing member extends across at least a portion of the front opening.

iii) Exhibit 3: Hilti's Invalidity Contentions for STI EZ-Path Series Pathway, Catalog No. EZDP33FWS ("the Pathway")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the Pathway does not disclose the following elements of claim 1 of the '868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;
[1.1.2] the front panel defining a front opening therethrough; and
[1.1.3] the rear panel defining a rear opening therethrough.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the Pathway does not disclose the subject matter of claim 2 of the '868 patent, i.e., one or more mounting tabs extend outwardly from the housing.

With regard to claim 4 of the '868 Patent, Hilti alleges that the Pathway teaches a hinge that is defined along the wall surface between the first and second housing members. In support of its position, Hilti references its statements made in relation to [1.1.4] at Movable Relative to One Another and [1.1.4.2]. However, nowhere in these statements does Hilti specifically identify which feature of the Pathway is considered as corresponding to a hinge.

With regard to claim 5 of the '868 Patent, Hilti alleges that the Pathway teaches the first and second housing members are completely detachable from one another via the hinge. In support of its position, Hilti references its statements made in relation to [1.1.4] at Completely Detachable from One Another, [1.1.4] at Movable Relative to One Another, and [1.1.4.2]. However, nowhere in these statements does Hilti specifically identify which feature of the Pathway is considered as corresponding to the hinge.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the Pathway does not disclose the subject matter of claim 6 of the '868 patent, i.e., a latching assembly is positioned along the wall surface to lock the housing in the assembled condition.

iv) Exhibit 4: Hilti's Invalidity Contentions for STI EZ-Path Series 33 Pathway Extension, Catalog No. EZD33E ("the Extension Module")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the Extension Module does not disclose the following elements of claim 1 of the '868 patent:

- [1.1.1]** a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;
- [1.1.2]** the front panel defining a front opening therethrough; and
- [1.1.3]** the rear panel defining a rear opening therethrough.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the Extension Module does not disclose the subject matter of claim 2 of the '868 patent, i.e., one or more mounting tabs extend outwardly from the housing.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the Extension Module does not disclose the subject matter of claim 6 of the '868 patent, i.e., a latching assembly is positioned along the wall surface to lock the housing in the assembled condition.

v) Exhibit 5: Hilti’s Invalidity Contentions for UK Patent Application No. GB 2111624 to Patterson (“Patterson”)

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that Patterson does not disclose the following elements of claim 1 of the ‘868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough;

[1.1.3] the rear panel defining a rear opening therethrough; and

[1.1.4] the housing including first and second housing members which are completely detachable from one another and movable relative to one another between.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that Patterson does not disclose the subject matter of claim 2 of the ‘868 patent, i.e., one or more mounting tabs extend outwardly from the housing.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that Patterson does not disclose the subject matter of claim 5 of the ‘868 patent, i.e., wherein the first and second housing members are completely detachable from one another via the hinge.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that Patterson does not disclose the subject matter of claim 6 of the ‘868 patent, i.e., a latching assembly is positioned along the wall surface to lock the housing in the assembled condition.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that Patterson does not disclose the following elements of claim 9 of the ‘868 patent: [9.1.2] a front panel extending from the wall surface and defining a front opening therethrough; and [9.3] wherein a sealing member extends across at least a portion of the front opening.

vi) Exhibit 6: Hilti’s Invalidity Contentions for Hilti CP 642 (“the CP 642”)

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the CP 642 does not disclose the following elements of claim 1 of the ‘868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough;

[1.1.3] the rear panel defining a rear opening therethrough; and

[1.1.4] the housing including first and second housing members which are completely detachable from one another and movable relative to one another between.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the CP 642 does not disclose the subject matter of claim 5 of the '868 patent, i.e., wherein the first and second housing members are completely detachable from one another via the hinge.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the CP 642 does not disclose element [9.1.2] of claim 9 of the '868 patent, i.e., a front panel extending from the wall surface and defining a front opening therethrough.

Hilti states on page 22 of Exhibit 6 that the CP 642 does not disclose element [9.3] of claim 9 of the '868 patent, i.e., a sealing member [that] extends across at least a portion of the front opening.

vii) Exhibit 7: Hilti's Invalidity Contentions for Nullifire System-B150 ("the B150")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the BN150 does not disclose the following elements of claim 1 of the '868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough; and

[1.1.3] the rear panel defining a rear opening therethrough.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the B150 does not disclose element [9.1.2] of claim 9 of the '868 patent, i.e., a front panel extending from the wall surface and defining a front opening therethrough.

Hilti states on page 15 of Exhibit 7 that the B150 does not disclose element [9.3] of claim 9 of the '868 patent, i.e., a sealing member [that] extends across at least a portion of the front opening.

viii) Exhibit 8: Hilti's Invalidity Contentions for STI Ready Stop Grommet, including the EZ-Path Firestop Grommet models RFG1 and RFG2 (collectively "the RFG")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the RFG does not disclose the following elements of claim 1 of the '868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough; and

[1.1.3] the rear panel defining a rear opening therethrough.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the RFG does not disclose the element [9.1.2] of claim 9 of the '868 patent, i.e., a front panel extending from the wall surface and defining a front opening therethrough.

Hilti states on page 43 of Exhibit 8 that the RFG does not disclose the following element [9.3] of claim 9, i.e., wherein a sealing member extends across at least a portion of the front opening.

ix) Exhibit 9: Hilti's Invalidity Contentions for U.S. Patent No. 8,397,452 B2 to Stahl Sr. ("Stahl Sr.")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Stahl Sr. does not disclose the following elements of claim 1 of the '868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough; and

[1.1.3] the rear panel defining a rear opening therethrough.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Stahl Sr. does not disclose element [9.1.2] of claim 9 of the '868 patent, i.e., a front panel [that] extends from the wall surface and defining a front opening therethrough.

On page 36 of Exhibit 9, Hilti states that Stahl Sr. does not disclose element [9.3] of claim 9 of the '868 patent, i.e., a sealing member [that] extends across at least a portion of the front opening.

x) Exhibit 10: Hilti's Invalidity Contentions for U.S. Patent No. 8,739,482 B2 to Feil, III et al. ("Feil")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Feil does not disclose the following elements of claim 1 of the '868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough; and

[1.1.3] the rear panel defining a rear opening therethrough.

Hilti states on page 28 of Exhibit 10 that Feil does not teach the subject matter of claim 6 of the '868 patent, i.e., a latching assembly positioned along the wall surface to lock the housing in the assembled condition.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Feil does not disclose element [9.1.2] of claim 9 of the '868 patent, i.e., a front panel extending from the wall surface and defining a front opening therethrough.

xi) Exhibit 11: Hilti's Invalidity Contentions for U.S. Patent Publication No. 2015/0251028 to Klein et al. ("Klein")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Klein does not disclose the following elements of claim 1 of the '868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough;

[1.1.3] the rear panel defining a rear opening therethrough; and

[1.1.4] the housing including first and second housing members which are completely detachable from one another and movable relative to one another between.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Klein does not disclose the subject matter of claim 5 of the '868 patent, i.e., wherein the first and second housing members are completely detachable from one another via the hinge.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Klein does not disclose element [9.1.2] of claim 9 of the '868 patent, i.e., a front panel extending from the wall surface and defining a front opening therethrough.

Hilti states on page 25 of Exhibit 11 that Klein does not disclose element [9.3] of claim 9 of the '868 patent, i.e., sealing member [that] extends across at least a portion of the front opening.

xii) Exhibit 12: Hilti's Invalidity Contentions for International Patent Publication No. WO2013/160776 to Ramorino et al. ("Ramorino")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Ramorino does not disclose the following elements of claim 1 of the '868 patent:

- [1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;
- [1.1.2] the front panel defining a front opening therethrough;
- [1.1.3] the rear panel defining a rear opening therethrough; and
- [1.1.4] the housing including first and second housing members which are completely detachable from one another and movable relative to one another between.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Ramorino does not disclose the subject matter of claim 5 of the '868 patent, i.e., wherein the first and second housing members are completely detachable from one another via the hinge.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Ramorino does not disclose the following elements of claim 9 of the '868 patent: [9.1.2] a front panel extending from the wall surface and defining a front opening therethrough; and [9.3] wherein a sealing member extends across at least a portion of the front opening.

xiii) Exhibit 13: Hilti's Invalidity Contentions for the Wruth RK I ("the RK I")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the RK I does not disclose the following elements of claim 1 of the '868 patent:

- [1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;
- [1.1.2] the front panel defining a front opening therethrough; and
- [1.1.3] the rear panel defining a rear opening therethrough.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that the RK I does not disclose element [9.1.2] of claim 9 of the '868 patent, i.e., a front panel extending from the wall surface and defining a front opening therethrough.

Hilti states on page 25 of Exhibit 13 that the RK I does not disclose element [9.3] of claim 9 of the '868 patent, i.e., a sealing member [that] extends across at least a portion of the front opening.

xiv) Exhibit 14: Hilti’s Invalidity Contentions for ZHQ50A Xinlonghai (“the ZHQ50A”)

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the ZHQ50A does not disclose the following elements of claim 1 of the ‘868 patent:

[1.1.1] a housing having a wall surface extending between opposed front and rear panels with an inner chamber defined therein;

[1.1.2] the front panel defining a front opening therethrough;

[1.1.3] the rear panel defining a rear opening therethrough; and

[1.1.4] the housing including first and second housing members which are completely detachable from one another and movable relative to one another between.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that the ZHQ50A does not disclose element [9.1.2] of claim 9 of the ‘868 patent, i.e., a front panel extending from the wall surface and defining a front opening therethrough.

Hilti states on page 19 of Exhibit 14 that the ZHQ50A does not disclose element [9.3] of claim 9 of the ‘868 patent, i.e., a sealing member [that] extends across at least a portion of the front opening.

U.S. Patent No. 9,157,232 to Stahl, Jr. (“the ‘232 Patent”)

xv) Exhibit 15: Hilti’s Invalidity Contentions for U.S. Patent No. 7,950,198 B2 to Pilz et al. (“Pilz”)

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that Pilz does not disclose the preamble of 6 of the ‘232 Patent, i.e., an adjustable head-of-wall insulating construction.

Contrary to Hilti’s assertions in its Invalidity Contentions, STI asserts that Pilz does not disclose element [6.5] of claim 6 of the ‘232 Patent, i.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. It should be noted that this element was the subject matter of original claim 8 of the ‘001 Corresponding Application. In the Office Action, the Examiner indicated that claim 8 included allowable subject matter.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Pilz does not disclose the subject matter of claim 7 of the '232 Patent. It should be noted that claim 7 of the '232 Patent corresponds to original claim 9 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that original claim 9 included allowable subject matter.

xvi) Exhibit 16: Hilti's Invalidity Contentions for U.S. Patent No. 8,595,999 B1 to Pilz et al. ("Pilz 999")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Pilz 999 does not disclose element [6.5] of claim 6 of the '232 Patent, i.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. It should be noted that this element was the subject matter of original claim 8 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that claim 8 included allowable subject matter.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Pilz 999 does not disclose the subject matter of claim 7 of the '232 Patent. It should be noted that claim 7 of the '232 Patent corresponds to original claim 9 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that original claim 9 included allowable subject matter.

xvii) Exhibit 17: Hilti's Invalidity Contentions for U.S. Patent Publication No. 2009/0049781 A1 to Pilz et al. ("Pilz 781")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Pilz 781 does not disclose element [6.5] of claim 6 of the '232 Patent, i.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. It should be noted that this element was the subject matter of original claim 8 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that claim 8 included allowable subject matter.

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Pilz 781 does not disclose the subject matter of claim 7 of the '232 Patent. It should be noted that claim 7 of the '232 Patent corresponds to original claim 9 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that original claim 9 included allowable subject matter.

xviii) Exhibit 18: Hilti's Invalidity Contentions for U.S. Patent No. 6,783,345 to Morgan et al. ("Morgan")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Morgan does not disclose element [6.5] of claim 6 of the '232 Patent, i.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. It should be noted that this element was the subject matter of original claim 8 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that claim 8 included allowable subject matter.

xix) Exhibit 19: Hilti's Invalidity Contentions for U.S. Patent Publication No. 2011/0011019 to Stahl, Jr. et al. ("Stahl 019")

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that Stahl 019 does not disclose element [6.5] of claim 6 of the '232 Patent, i.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. It should be noted that this element was the subject matter of original claim 8 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that claim 8 included allowable subject matter.

xx) Exhibit 20: Hilti's Invalidity Contentions for CEMCO Fas Track

Contrary to Hilti's assertions in its Invalidity Contentions, STI asserts that STI asserts that CEMCO Fas Track does not disclose element [6.5] of claim 6 of the '232 Patent, i.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. It should be noted that this element was the subject matter of original claim 8 of the '001 Corresponding Application. In the Office Action, the Examiner indicated that claim 8 included allowable subject matter.

STI further states that its investigation is ongoing and that it will supplement these Validity Contentions as is necessary in due course. STI further expressly reserves its rights to supplement or amend this interrogatory response in the event Hilti supplements or amends its Invalidity Contentions and/or following the Court's claim construction ruling.

Interrogatory No. 9: For each Defense and Counterclaim asserted by Hilti in its First Amended Answer, Defenses, and Counterclaims, dated January 27, 2023 (D.I. 25), explain in detail Your factual and legal basis, if any, for disagreeing with each such Defense and Counterclaim, and identify all documents supporting Your positions regarding same.

RESPONSE: STI incorporates by reference the foregoing General Objections as if fully stated herein. STI further objects to this Interrogatory as premature. STI further objects to this Interrogatory to the extent it requests or implicates information protected from disclosure by the attorney-client privilege and/or work-product doctrine. Discovery has just begun, and Hilti has yet to provide discovery to substantiate its defenses and counterclaims.

Subject to and without waiver of the foregoing objections, STI responds as follows:

STI will respond to each defense and counterclaim as appropriate through this case and will produce all information on which it will rely to do so during the discovery period provided for in this case.

- First Defense: Non-Infringement. STI disagrees with this defense because Hilti infringes the asserted claims of the STI Patents-in-Suit for the reasons set forth in STI's Infringement Contentions served on March 17, 2023 and supplemented on March 22, 2023.
- Second Defense: Invalidity. STI disagrees with this defense because Hilti will not be able to carry its burden to demonstrate that the asserted claims from the STI Patents-in-Suit

are invalid by clear and convincing evidence and the reasons set forth in response to Interrogatory No. 8.

- Third Defense: Equitable Bars. STI disagrees with this defense at least because Hilti has not identified any such applicable principles of equity, including waiver, acquiescence and/or unclean hands.
- Fourth Defense: Limitations on Recovery. The limitations on recovery that Hilti asserts as a defense are not bases for invalidity. Further, 35 U.S.C. § 286 and 35 U.S.C. § 287 are not affirmative defenses but are limitations on recovery. STI disagrees that it is barred by 35 U.S.C. § 288 from recovering costs associated with this action because none of the asserted claims of the STI Patents-in-Suit have been found invalid.
- Fifth Defense: Patent Misuse & Unclean Hands. STI disagrees with this defense at least because Hilti will not be able to meet its burden in establishing patent misuse or unclean hands and Hilti has provided no information thus far on these defenses for STI to assess.
- Counterclaim 1: Declaratory Judgment of Non-Infringement of STI's U.S. Patent No. 10,143,868. STI disagrees with this counterclaim because Hilti infringes the asserted claims of U.S. Patent No. 10,143,868 for the reasons set forth in STI's Infringement Contentions served on March 17, 2023 and supplemented on March 22, 2023.
- Counterclaim 2: Declaratory Judgment of Non-Infringement of STI's U.S. Patent No. 9,157,232 Patent. STI disagrees with this counterclaim because Hilti infringes the asserted claims of U.S. Patent No. 9,157,232 for the reasons set forth in STI's Infringement Contentions served on March 17, 2023 and supplemented on March 22, 2023.

- Counterclaim 3: Declaratory Judgment of Invalidity of STI's U.S. Patent No. 10,143,868.
STI disagrees with this counterclaim because Hilti will not be able to carry its burden to demonstrate that the asserted claims of U.S. Patent No. 10,143,868 are invalid by clear and convincing evidence and the reasons set forth in response to Interrogatory No. 8.
- Counterclaim 4: Declaratory Judgment of Invalidity of STI's U.S. Patent No. 9,157,232.
STI disagrees with this counterclaim because Hilti will not be able to carry its burden to demonstrate that the asserted claims of U.S. Patent No. 9,157,232 are invalid by clear and convincing evidence and the reasons set forth in response to Interrogatory No. 8.

Interrogatory No. 10: For each category of damages claimed by STI:

- (a) state the amount of the alleged damages;
- (b) describe in detail how You calculate those alleged damages;
- (c) state each and every fact on which You will rely to support the alleged damages; and
- (d) describe in detail the legal theory on which You rely to support the alleged damages for each claim or request for remedies in this Action.

RESPONSE: STI incorporates by reference the foregoing General Objections as if fully stated herein. STI further objects to this Interrogatory to the extent it prematurely seeks expert discovery regarding “(a) [] the amount of alleged damages.” STI will provide its damages claim through expert testimony consistent with the schedule entered by the Court. STI further objects to Hilti’s request for “(c) [] each and every fact . . . to support the alleged damages” as premature as discovery is in its early stages. STI will produce or make available all information on which it will affirmatively rely for proving damages in due course prior to the close of fact discovery.

Subject to and without waiver of the foregoing objections, STI responds as follows:

Lost Profits

U.S. Patent No. 10,143,868

With respect to its lost profits under U.S. Patent No. 10,143,868 (the “’868 Patent”), STI intends to rely on lost profits for its lost sales of EZDR200, EZDR400, EZPR150, and EZPR300, which STI would have made “but for” Hilti’s infringement of the ’868 Patent.

With respect to the first Panduit factor, STI intends to show that there was clearly demand for the patented products. For example, STI’s sales of the EZDR200, EZDR400, EZPR150, and EZPR300 demonstrate that demand existed for the patented products.

With respect to the second Panduit factor, STI intends to show that there were, and are, no acceptable and available (at least to Hilti) non-infringing alternatives to the EZDR200, EZDR400, EZPR150, and EZPR300 on the market. As such, the second Panduit factor is met. To the extent non-infringing alternatives did exist, STI would rely on its market share to meet the second Panduit factor. The relevant market included STI and Hilti. To the extent the market included other companies, STI included those companies in the relevant market as well. The market would be defined as with reference to the EZDR200, EZDR400, EZPR150, and EZPR300.

With respect to the third Panduit factor, STI intends to show that it had and has the ability to manufacture as many EZDR200, EZDR400, EZPR150, and EZPR300 as the market could demand. To be sure, STI intends to show it had and has the ability to manufacture and sell Hilti’s entire volume of U.S. sales of CFS-MSL Modular Fire Sleeve and CFS-MSL P Modular Sleeve Frame products.

With respect to the amount of profit STI would have made in making the infringing sales, STI will produce information sufficient to show such profits during the normal course of discovery. STI intends to include convoyed sales within its calculation of profits.

U.S. Patent No. 9,157,232

With respect to its lost profits under U.S. Patent No. 9,157,232 (the “’232 Patent”), STI intends to rely on lost profits for its lost sales of TTG350F and TTG600F, which STI would have made “but for” Hilti’s infringement of the ’232 Patent.

With respect to the first Panduit factor, STI intends to show there was clearly demand for the patented products. For example, STI’s sales of the TTG350F and TTG600F demonstrate that demand existed for the patented products.

With respect to the second Panduit factor, STI intends to show that there were, and are, no acceptable and available (at least to Hilti) non-infringing alternatives to the TTG350F and TTG600F on the market. As such, the second Panduit factor is met. To the extent non-infringing alternatives did exist, STI would rely on its market share to meet the second Panduit factor. The relevant market included STI and Hilti. To the extent the market included other companies, STI included those companies in the relevant market as well. The market would be defined as with reference to the TTG350F and TTG600F.

With respect to the third Panduit factor, STI intends to show that it had and has the ability to manufacture as many TTG350F and TTG600F as the market could demand. To be sure, STI intends to show it had and has the ability to manufacture and sell Hilti’s entire volume of U.S. sales of Firestop Top Track Seal CFS-TTS 212, Firestop Top Track Seal CFS-TTS OS, Firestop Top Track Seal CFS-TTS R OS, Firestop Top Track Seal CFS-TTS 358, Firestop Top Track Seal CFS-TTS 600, Firestop Top Track Seal CFS-TTS MD OS, Firestop Top Track Seal CFS-

TTS MD 600, Smoke & Acoustic Track Seal CS-TTS SA 358, Smoke & Acoustic Track Seal CS-TTS SA OS, Smoke & Acoustic Track Seal CS-TTS SA 600 (collectively “Accused TTS Products”).

With respect to the amount of profit STI would have made in making the infringing sales, STI will produce information sufficient to show such profits during the normal course of discovery. STI intends to include convoyed sales within its calculation of profits.

Reasonably Royalty

U.S. Patent No. 10,143,868

With respect to the '868 Patent, the hypothetical negotiation would have been no later than July 2022, which was when the '868 Patent had issued and Hilti had begun selling the accused CFS-MSL Modular Fire Sleeve and the CFS-MSL Modular Sleeve Frame products. Without a license to the '868 Patent, Hilti could not have begun and continued to sell key products for Hilti. The parties to the hypothetical negotiation would have been Hilti and STI. In addition, STI intends to show that there were no available and acceptable non-infringing alternatives to which Hilti could have turned to avoid infringement. This fact would put upward pressure on the royalty rate to which the parties would have agreed as a result of the hypothetical negotiation.

As to the Georgia Pacific factors:

Factor 1: There was no established royalty that would have guided the parties through the hypothetical negotiation process.

Factor 2: There were no comparable licenses that would have guided the parties through the hypothetical negotiation process.

Factor 3: The license that would have resulted from the hypothetical negotiation would have been a non-exclusive license.

Factor 4: STI has amassed an extensive and valuable patent portfolio that protects its long history of innovation and its leading role in the market for firestop products. STI has not licensed any of those patents and would not be inclined to do so. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 5: STI and Hilti are direct competitors—and indeed are the two main players—in the firestop market within the United States. As such, STI would be licensing a direct competitor and would view nearly every sale Hilti could have made as a sale STI could have made absent the grant of a license to Hilti. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 6: When Hilti sells the Accused Products to customers, it may sell additional products. Absent a license, Hilti would not make the sales of other products that are associated with the Accused Products. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 7: The duration of the license would extend through the expiration of the '868 Patent.

Factor 8: STI's EZDR200, EZDR400, EZPR150, and EZPR300 products have been very profitable and successful products for STI. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 9: The '868 Patent represented a significant advancement over the prior art. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 10: Numerous customers have obtained benefits from STI's EZDR200, EZDR400, EZPR150, and EZPR300. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 11: Hilti's sales of the accused CFS-MSL Modular Fire Sleeve and the CFS-MSL Modular Sleeve Frame products demonstrate that Hilti has made wide use of STI's patented invention. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 12: STI is aware of no customary portion of profits or selling price that is customary in this field.

Factor 13: STI's position is that the patented features drive the entire demand for the accused CFS-MSL Modular Fire Sleeve and the CFS-MSL Modular Sleeve Frame products. To the extent any other feature contributes to the demand of the accused CFS-MSL Modular Fire Sleeve and the CFS-MSL Modular Sleeve Frame products, such a contribution is minimal. In other words, STI would intend to argue that the entire market value rule would apply. To the extent Hilti disputes this, STI would conduct an apportionment analysis.

Factors 14 and 15: STI intends to rely on expert testimony with respect to these two factors.

U.S. Patent No. 9,157,232

With respect to the accused (1) Firestop Top Track Seal CFS-TTS 212, (2) Firestop Top Track Seal CFS-TTS OS, (3) Firestop Top Track Seal CFS-TTS R OS, (4) Firestop Top Track Seal CFS-TTS 358, (5) Firestop Top Track Seal CFS-TTS 600, (6) Smoke & Acoustic Track Seal CS-TTS SA 358, (7) Smoke & Acoustic Track Seal CS-TTS SA OS, and (8) Smoke & Acoustic Track Seal CS-TTS SA 600, the hypothetical negotiation regarding the '232 Patent

would have been no later than June 2016, which was when the '232 Patent had issued and Hilti had begun selling those accused products. With respect to the accused (1) Firestop Top Track Seal CFS-TTS MD OS and (2) Firestop Top Track Seal CFS-TTS MD 600, the hypothetical negotiation regarding the '232 Patent would have been no later than November 2019, which was when the '232 Patent had issued and Hilti had begun selling those accused products. Without a license to the '232 Patent, Hilti could not have begun and continued to sell key products for Hilti. The parties to the hypothetical negotiation would have been Hilti and STI. In addition, STI intends to show that there were no available and acceptable non-infringing alternatives to which Hilti could have turned to avoid infringement. This fact would put upward pressure on the royalty rate to which the parties would have agreed as a result of the hypothetical negotiation.

As to the Georgia Pacific factors:

Factor 1: There was no established royalty that would have guided the parties through the hypothetical negotiation process.

Factor 2: There were no comparable licenses that would have guided the parties through the hypothetical negotiation process.

Factor 3: The license that would have resulted from the hypothetical negotiation would have been a non-exclusive license.

Factor 4: STI has amassed an extensive and valuable patent portfolio that protects its long history of innovation and its leading role in the market for firestop products. STI has not licensed any of those patents and would not be inclined to do so. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 5: STI and Hilti are direct competitors—and indeed are the two main players—in the firestop market within the United States. As such, STI would be licensing a direct competitor

and would view nearly every sale Hilti could have made as a sale STI could have made absent the grant of a license to Hilti. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 6: When Hilti sells the Accused TTS Products to customers, it may sell additional products. Absent a license, Hilti would not make the sales of other products that are associated with the Accused Products. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 7: The duration of the license would extend through the expiration of the '232 Patent.

Factor 8: STI's TTG350F and TTG600F products have been very profitable and successful products for STI. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 9: The '232 Patent represented a significant advancement over the prior art. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 10: Numerous customers have obtained benefits from STI's TTG350F and TTG600F. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 11: Hilti's sales of the Accused TTS Products demonstrate that Hilti has made wide use of STI's patented invention. This would put upward pressure on the royalty rate STI would have sought during the hypothetical negotiation.

Factor 12: STI is aware of no customary portion of profits or selling price that is customary in this field.

Factor 13: STI's position is that the patented features drive the entire demand for the Accused TTS Products. To the extent any other feature contributes to the demand of the Accused TTS Products, such a contribution is minimal. In other words, STI would intend to argue that the entire market value rule would apply. To the extent Hilti disputes this, STI would conduct an apportionment analysis.

Factors 14 and 15: STI intends to rely on expert testimony with respect to these two factors.

Interrogatory No. 11: For each asserted claim of each of the STI Patents-in-Suit, identify any and all secondary considerations of nonobviousness that You contend support the patentability of that claim, explain in detail how each such secondary consideration supports the patentability of that claim, identify each person knowledgeable about each such secondary consideration, and identify all Documents relating to the same.

RESPONSE: STI incorporates by reference the foregoing General Objections as if fully stated herein. STI objects to this Interrogatory as calling for claim construction prior to the deadlines for the claim construction process included in the Scheduling Order. STI further objects to this Interrogatory as premature, as it will be Hilti's burden to demonstrate obviousness by clear and convincing evidence that each asserted claim is invalid as obvious. STI has no burden to prove validity in this Court and is not required to identify objective indicia of non-obviousness until STI has made a showing suggestive of obviousness. STI further objects to this Interrogatory to the extent it prematurely seeks expert discovery regarding secondary considerations of nonobviousness.

Subject to and without waiver of the foregoing objections, STI incorporates its related response to Interrogatory No. 8 and further responds as follows:

U.S. Patent No. 10,143,868

Commercial Success

With regard to U.S. Patent No. 10,143,868, STI's EZDR200, EZDR400, EZPR150, and EZPR300 have been commercially successful in terms of sales and market share.

James Stahl is knowledgeable about the foregoing.

Long-Felt But Unsolved Need

Prior to the earliest effective filing date of U.S. Patent No. 10,143,868, there had been a long-felt but unsolved need for a firestopping device that could restore code compliance to overfilled cable sleeves that could install easily around cable sleeves.

The named inventors are knowledgeable about the foregoing.

Copying by Others

Hilti copied the invention claimed in U.S. Patent No. 10,143,868 with its CFS-MSL Modular Fire Sleeve and CFS-MSL P Modular Sleeve Frame products.

James Stahl and Hilti personnel are the individuals knowledgeable about the foregoing.

U.S. Patent No. 9,157,232

Commercial Success

With regard to U.S. Patent No. 9,157,232, STI's TTG350F and TTG600F have been commercially successful in terms of sales and market share.

James Stahl is knowledgeable about the foregoing.

Long-Felt But Unsolved Need

Prior to the earliest effective filing date of U.S. Patent No. 9,157,232, there had been a long-felt but unsolved need for a firestopping device for construction joints that could easily be cut to size to minimize waste and could be installed more quickly than existing sealants or sprays.

The named inventor is knowledgeable about the foregoing.

Interrogatory No. 12: Identify any and all prior art, including physical products, drawings, patents, printed publications, or text pertaining to the subject matter of any of the STI Patents-in-Suit of which STI, the named inventors and/or their counsel, and/or anyone else associated with the filing, prosecution, or any subsequent post-grant challenges to any of the STI Patents-in-Suit, was aware during prosecution before the United States Patent and Trademark Office (“USPTO”) and/or during any subsequent proceeding before the USPTO (including but not limited to *inter partes* review proceedings) of any of the STI Patents-in-Suit.

RESPONSE: STI incorporates by reference the foregoing General Objections as if fully stated herein. STI further objects to this Interrogatory to the extent it requests or implicates information protected from disclosure by the attorney-client privilege and/or work-product doctrine. STI further objects to this Interrogatory as vague and confusing in reference to post-grant challenges to any of the STI Patents-in-Suit because no such challenges have been made. STI further objects to this Interrogatory as seeking information that is not relevant to any claim or defense asserted in this case.

Subject to and without waiver of the foregoing objections, STI responds as follows:

All material, non-cumulative prior art of which STI was aware during prosecution of the STI Patents-in-Suit was of record at the United States Patent and Trademark Office as set forth in the file histories for the STI Patents-in-Suit.

Dated: August 18, 2023

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*Attorneys for Defendant and
Counterclaimant Specified Technologies
Inc.*

CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of August, 2023, a copy of the foregoing *Defendant and Counterclaimant Specified Technologies, Inc.'s Objections and Responses to Plaintiff and Counterclaim Defendant Hilti Aktiengesellschaft's Second Set of Interrogatories (Nos. 7-12)* was served via e-mail on the following:

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