

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

Civil Action No. 1:23-cv-00313-RM-KAS

FOX FACTORY, INC.,

Plaintiff,

v.

SRAM, LLC,

Defendant.

**DEFENDANT SRAM, LLC'S
AMENDED PRELIMINARY INVALIDITY CONTENTIONS**

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

I. PRELIMINARY MATTERS

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

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

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

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

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

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

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

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

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

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

II. SRAM'S AMENDED PRELIMINARY INVALIDITY CONTENTIONS

Claims 1-8 of the '331 patent and claims 1-9, 11-15, and 19 of the '223 patent¹ are invalid in view of prior art under 35 U.S.C. §§ 102, 103, and 112 (pre-AIA).² The charts in the

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

² Fox has asserted on page 11 of its Second Amended Infringement Contentions that the Asserted Claims "of the '331 patent are entitled to a priority date at least as early as May 9, 2012, as stated on the face of the patent." Further, Fox has asserted on page 11 of its Infringement Contentions that the Asserted Claims "of the '223 patent are entitled to a priority date at least as early as May 9, 2008, as stated on the face of the patent." Fox bears the burden of proving any priority date, and to date, Fox has provided no evidence that it is entitled to the benefit of any priority application, or to any particular priority date. To the extent the Court allows Fox to assert earlier priority dates, SRAM reserves its right to respond, including by supplementing its contentions to include additional prior art and arguments. Based on these representations in Fox's infringement contentions, SRAM's Amended Preliminary Invalidity Contentions rely on the pre-America Invents Act ("AIA") versions of applicable statutes.

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

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

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

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

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

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

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

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

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

DATED: March 1, 2024

LEWIS RICE LLC

By: /s/Richard B. Walsh, Jr.
Richard B. Walsh, Jr.

Attorneys for Defendant SRAM, LLC

CERTIFICATE OF SERVICE

I hereby certify that on March 1, 2024, the foregoing document was served upon counsel of record via email transmission to the following:

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