

1 Paul R. Steadman (*Pro Hac Vice*)
2 paul.steadman@us.dlapiper.com
3 Matthew D. Satchwell (*Pro Hac Vice*)
4 matthew.satchwell@us.dlapiper.com
5 **DLA PIPER LLP (US)**
6 444 West Lake Street, Suite 900
7 Chicago, Illinois 60606-0089
8 T: (312) 368-2135 | F: (312) 251-2850
9 T: (312) 368-2111 | F: (312) 236-7519

10 Martin M. Ellison (SBN 292060)
11 martin.ellison@us.dlapiper.com
12 **DLA PIPER LLP (US)**
13 2000 Avenue of the Stars, Suite 400, N. Tower
14 Los Angeles, CA 90067-4735
15 T: (310) 595-3000 | F: (310) 595-3300

16 Attorneys for Defendants
17 Alpinestars USA Inc. and Alpinestars S.p.A.

18 **UNITED STATES DISTRICT COURT**
19 **CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION**

20 DAINESE S.p.A.,

21 Plaintiff,

22 v.

23 ALPINESTARS USA Inc. and
24 ALPINESTARS S.p.A.,

25 Defendants.

Case No. 2:24-cv-07066-PA-KS
Hon. Percy Anderson

**DEFENDANTS ALPINESTARS USA
INC. AND ALPINESTARS S.P.A.'S
INVALIDITY CONTENTIONS
COVER PLEADING**

Jury Trial Demanded

1 Defendants Alpinestars USA and Alpinestars S.p.A. (collectively
2 “Alpinestars”) hereby provide their Invalidity Contentions pursuant to the Court’s
3 March 12, 2025, Civil Minutes (Dkt. 39). AlpineStars is also concurrently producing
4 any supplemental prior art references incorporated in their Invalidity Contentions.
5 AlpineStars reserves the right to supplement these Invalidity Contentions, including,
6 but not limited to, by producing additional prior art it discovers or receives in response
7 to any third-party subpoenas it may serve in this litigation and by supplementing the
8 charts attached hereto. AlpineStars further reserves the right to supplement these
9 Invalidity Contentions following claim construction.

10 **I. INTRODUCTION**

11 Defendants’ Invalidity Contentions address the asserted claims identified by
12 Plaintiff Dainese S.p.A. (“Dainese”) in its Infringement Contentions dated April 21,
13 2025, which are claims 1-5, 8-13, 15-18, and 20-22 (hereinafter “Asserted Claims”) of
14 U.S. Patent No. 12,012,065 (“’065 Patent”). Should Plaintiff substantively amend its
15 Infringement theories in any subsequent Infringement Contentions, or should the Court
16 allow Plaintiff to later assert Infringement of additional claims not currently identified
17 in Plaintiff’s Infringement Contentions, or to supplement its Infringement contentions
18 with additional Infringement theories with respect to the Asserted Claims, Defendants
19 hereby reserve the right to supplement their Invalidity Contentions to assert invalidity
20 of those additional claims and/or to assert invalidity based on the additional
21 Infringement theories. Defendants also reserve the right to supplement their Invalidity
22 Contentions in response to information learned in fact or expert discovery, including
23 identification of additional prior art. Defendants’ Invalidity Contentions are based in
24 whole or in part on their present understanding of the Asserted Claims and Plaintiff’s
25 Infringement Contentions, including any priority date for the ’065 Patent in its
26 Infringement Contentions.

27 Defendants’ Invalidity Contentions are at at least to the same level of specificity
28 of Plaintiff’s Infringement Contentions. Defendants’ Invalidity Contentions may also

1 take into account Plaintiff's apparent applied claim constructions, to the extent
2 Plaintiff's applied constructions can be gleaned from its Infringement Contentions.
3 Such apparent constructions may be inconsistent with the constructions that
4 Defendants ultimately will proffer in this case. By including prior art that would
5 anticipate or render obvious the Asserted Claims of the '065 Patent based on Plaintiff's
6 disclosed and apparent as-applied claim constructions, or based on any other particular
7 claim construction, Defendants are not adopting Plaintiff's claim constructions, nor
8 are Defendants admitting to the accuracy of any particular claim construction. The
9 Court has established separate deadlines for the parties' proposed claim constructions,
10 and Defendants will disclose their proposed constructions according to those
11 deadlines. Solely for purpose of these Invalidity Contentions, Defendants may, if
12 necessary, apply alternative, and even inconsistent, claim construction positions.
13 Defendants reserve all rights to amend these Invalidity Contentions after the Court
14 issues its claim construction ruling, or if the Court permits Plaintiff to amend its
15 Infringement Contentions.

16 Defendants do not concede that Plaintiff's Infringement Contentions meet the
17 specificity required under the Patent Rules, and Defendants provide these Invalidity
18 Contentions without waiving any right to receive from Plaintiff full and complete,
19 specific Infringement contentions. Moreover, nothing in these disclosures admits in
20 any way that any accused product, or any of Defendants' other products, infringes any
21 of the Asserted Claims.

22 **II. PERSON HAVING ORDINARY SKILL IN THE ART**

23 A person having ordinary skill in the art ("POSITA") at the time of the alleged
24 invention of the '065 Patent would have had a Bachelors' degree in mechanical
25 engineering or a comparable field of study, plus approximately three years of
26 professional experience with airbag devices or other similar relevant industry
27 experience. Additional graduate education could substitute for professional
28 experience, and significant experience in the field could substitute for formal

1 education.

2 **III. RELATED INVALIDITY CONTENTIONS AND DISCLOSURES**

3 Defendants reserve the right to rely on contentions, charts, prior art references,
4 and other statements relating to any ground of invalidity identified by any potential or
5 actual licensees for the asserted patent and by any party in any other past, present, or
6 future litigation involving the asserted patent.

7 Defendants also incorporate by reference all grounds of invalidity identified in
8 any present or future reexamination, *inter partes* review, or other post-issuance review
9 by the Patent and Trademark Office of the asserted patent, which Defendants
10 incorporate herein by reference. Defendants further incorporate by reference the
11 production of documents associated with any grounds for invalidity for the asserted
12 patent. Defendants further incorporate any grounds of invalidity known to Plaintiff or
13 any affiliated party, whether or not disclosed. Defendants also request that all such
14 contentions from every case involving the asserted patent be produced to Defendants
15 as soon as possible after they are served on, or become known to, Plaintiff.

16 Defendants' discovery and investigation in connection with this lawsuit is
17 ongoing. Thus, these Invalidity Contentions are based on information obtained to date.
18 Among other things, fact discovery has not yet been completed, and no depositions
19 have been taken. Accordingly, Defendants' Invalidity Contentions are subject to
20 modification, amendment, or supplementation in accordance with the Scheduling
21 Order, the Local Rules of the Central District of California, and/or the Federal Rules
22 of Civil Procedure as this action progresses and additional information is obtained.

23 **IV. PRIOR ART PATENTS AND PUBLISHED PATENT**
24 **APPLICATIONS**

25 The following prior art patents and published patent applications invalidate the
26 Asserted Claims and/or provide background regarding the state of the art at the time
27 of the alleged invention:
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Patent No.	Description	Filed Date	Issue/Publication Date
U.S. Patent No. 3,823,711	Inflatable Profile with High Pneumatic Rigidity	6/28/1972	7/16/1974
U.S. Patent No. 4,242,769	Anti-Exposure Inflatable Structure	12/14/1978	1/6/1981
U.S. Patent No. 4,397,046	Protecting Device Especially for Motor-Cyclist	6/29/1981	8/9/1983
U.S. Patent No. 4,453,271	Protective Garment	9/29/1982	6/12/1984
U.S. Patent No. 4,722,099	Protective Motorcycle Garments for Maximum Cooling	12/1/1986	2/2/1988
U.S. Patent No. 5,505,485	Plastic Film Airbag	5/23/1994	4/9/1996
U.S. Patent No. 5,975,564	Flat-Sewn Partitioned Airbag Cushion	3/24/1998	11/2/1999
U.S. Patent No. 6,295,654	Protective Sports Garment	3/15/2000	10/2/2001
U.S. Patent No. 7,370,370	Pneumatic Devices for Personal Protection and Relevant Article of Clothing Including Such Device	8/5/2004	5/13/2008
U.S. Patent No. 8,365,316	Airbag Jacket	4/27/2007	2/5/2013
U.S. Patent No. 8,398,574	Athletic Garment with Inflatable Cup Protector Assembly	12/4/2009	3/19/2013
U.S. Patent No. 8,966,668	Web and Bladder Suspension Protection System	12/11/2013	3/3/2015
U.S. Patent No. 9,027,170	Personal Protection Device and Garment Incorporating Said Device	12/4/2009	5/12/2015
U.S. Patent No.	Impact Reduction	3/5/2014	9/27/2016

1	Patent No.	Description	Filed Date	Issue/Publication Date
2	9,451,795	System		
3	U.S. Patent No. 10,667,567	Wrist Protector	8/27/2018	6/2/2020
4	U.S. Patent Application Publication No. 2003/0019553	Run-Flat System for Pneumatic Tires Utilizing Air-Filled Elastic Balls	7/26/2002	1/30/2003
5	U.S. Patent Application Publication No. 2004/0183283	Air Bag Inflation Device	12/18/2003	9/23/2004
6	U.S. Patent Application Publication No. 2006/0253950	Protective Garment	12/19/2003	11/16/2006
7	U.S. Patent Application Publication No. 2007/0186328	Protection for Cycling Pants	1/30/2007	8/16/2007
8	U.S. Patent Application Publication No. 2012/0066820	Protective Headwear and Bodywear	9/20/2011	3/22/2012
9	U.S. Patent Application Publication No. 2012/0292894	Air Bag Device for Rear-End Collision	7/20/2012	11/22/2012
10	U.S. Patent Application Publication No. 2015/0238124	Method and apparatus for body impact protection	5/11/2015	8/27/2015
11	U.S. Patent Application Publication No. 2016/0073708	Wearable Inflating System and Apparatus for Automatically Arresting Falls Through Gaps in Structures, and Method of Use	11/13/2015	3/17/2016
12	U.S. Application	Personal Protective	6/11/2014	3/24/2016

1	Patent No.	Description	Filed Date	Issue/Publication Date
2	Publication No.	Device		
3	2016/0081403			
4	U.S. Patent Application	Inflatable Airbag for Protecting a Person, and Airbag Module, Vehicle Parts and Vehicle Occupant Restraint System Having Such as Airbag	4/30/2015	6/22/2017
5	Publication No.			
6	2017/0174170			
7				
8	U.S. Patent Application	Safe Air Head, Face, and Body Gear	10/25/2017	3/1/2018
9	Publication No.			
10	2018/0055103			
11	U.S. Patent Application	Inflatable Perfusion Balloon with Outer Mesh and Related Methods	4/6/2016	4/12/2018
12	Publication No.			
13	2018/0099126			
14	U.S. Patent Application	Inflatable Survival Vest	8/30/2018	9/3/2020
15	Publication No.			
16	2020/0277033			
17	U.S. Patent Application	Inflatable Safety Helmet	5/22/2017	10/8/2020
18	Publication No.			
19	2020/0315277			
20	U.S. Patent Application	Garment Comprising an Inflatable Protection Device	12/4/2019	10/28/2021
21	Publication No.			
22	2021/0329986			
23	U.S. Patent Application	Wearable Airbag Device	12/4/2019	11/25/2021
24	Publication No.			
25	2021/0360993			
26	U.S. Patent Application	Inflatable Device for the Protection of Objects or Persons	2/25/2020	8/11/2022
27	Publication No.			
28	2022/0248794			
	Chinese Patent No.	Inflatable Warm-Retaining Clothes	11/16/2010	5/23/2012
	CN102462007A			

1	Patent No.	Description	Filed Date	Issue/Publication Date
2	Chinese Patent No. CN104354665A	Airbag structure for vehicle	10/16/2014	2/18/2015
3	Chinese Patent No. CN108968180A	Air bag structure for fall-protection waist belt	9/25/2018	12/11/2018
4	Chinese Patent No. CN110037367A	Protection airbag	5/13/2019	7/23/2019
5	Chinese Patent No. CN110123064	An ultra-light, portable, low-cost, pressurized inflatable product	5/28/2019	8/16/2019
6	Chinese Patent No. CN111671174	Light and thin spring clothes with windproof function and manufacturing method thereof	7/22/2020	9/18/2020
7	Chinese Patent No. CN109203614	Multilayer protective material and safety protective suit manufactured therewith	10/22/2018	1/15/2019
8	Chinese Patent No. CN201437401	Floating life-saving work clothing	8/5/2009	4/14/2010
9	Chinese Patent No. CN201664106U	Partition cloth air mattress	3/29/2010	12/8/2010
10	Chinese Patent No. CN202980202U	Body protective device and garment with the same	10/18/2012	6/12/2013
11	Chinese Patent No. CN203063891U	Protective device comprising inflatable component	10/18/2012	7/17/2013
12	Chinese Patent No. CN203662955U	Postoperative nursing device	1/5/2014	6/25/2014
13	Chinese Patent No. CN205695842U	A geolocation-based airbag suit for alarming	4/6/2016	11/23/2016
14	Chinese Patent No. CN208740142U	Gasbag driving vest	9/10/2018	4/16/2019

1	Patent No.	Description	Filed Date	Issue/Publication Date
2	Chinese Patent No. CN2551115Y	Cloth mattress or cushion with stuffed inflatable hoses	6/13/2002	5/21/2003
3	Switzerland Patent No. CH697172	Airbag for a piece of clothing comprises a body integrated into the piece of clothing and folds flat when not in use on the side of the body to be protected	6/4/2004	6/25/2008
4	Czechia Patent No. CZ2018401A3	Cyclodres with air chest and spine protector	8/7/2018	2/19/2020
5	European Patent No. EP2329732	Size fitting device and wearable article including said device	12/2/2010	6/8/2011
6	European Patent No. EP 2621297	Airbag suitable for head protection	9/29/2011	8/9/2017
7	European Patent No. EP2745720	Protection device	12/18/2012	6/25/2014
8	European Patent No. EP 2879536 B1	Envelope for a laminar structure providing adaptive thermal insulation	7/31/2012	6/8/2016
9	European Patent No. EP3167730A1	Wearable Protection Device	11/10/2016	5/17/2017
10	European Patent No. EP 3498117A1	Garment for a user's protection comprising an inflatable member	12/17/2018	9/8/2021
11	European Patent No. EP 3835140A1	Protection device and method for manufacturing such protection device	12/9/2020	6/16/2021
12	European Patent No. EP 3890537A1	Garment comprising an inflatable protection device	12/4/2019	10/13/2021
13	European Patent No. EP4051041A1	Wearable Protective Device	10/27/2020	9/7/2022

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Patent No.	Description	Filed Date	Issue/Publication Date
European Patent No. EP 4072364B1	Protective device and method for making said protective device	12/9/2020	1/3/2024
European Patent No. EP4171302A1	Wearable Protection Device	6/23/2021	5/3/2023
France Patent No. FR1013137A	Improvement in inflatable objects	2/22/1950	7/23/1952
France Patent No. FR1555878A	Improvements to inflatable clothing	12/15/1967	1/31/1969
France Patent No. FR2305962	Rigid end cap for pneumatic beam and its application to the production of an articulated pneumatic beam	4/3/1975	4/21/1978
France Patent No. FR2507064	Inflatable garment or lining for thermal insulation – of coated impermeable fabric linked by internal ties	6/4/1981	12/10/1982
France Patent No. FR2706207	Inflatable Structure for Use as a Decoration, as a Support for a Screen or as a support for a decorative element	6/8/1993	5/10/1996
German Patent No. DE2626765	Protective suit for motor cycle racer – with leather outer layer and layer of PTFE	6/15/1976	12/22/1977
Germany Patent No. DE19754541	Head protector with ring-shaped airbag system	12/9/1997	6/10/1999
Italy Patent No. IT201800010820	Wearable airbag device	12/5/2018	6/5/2020
Italy Patent No. IT201900023958	Protective device and method for realizing this protective device	12/13/2019	6/13/2021
Japanese Patent No. JP3194894U	Atmospheric-pressure inflatable shock	6/16/2014	12/18/2014

1	Patent No.	Description	Filed Date	Issue/Publication Date
2		absorber		
3	Japanese Patent No. JP4949361	Jacket with airbag	11/27/2008	6/6/2012
4	Japanese Patent No. JP7164356	Airbag pants	8/27/2018	11/1/2022
5	Japanese Patent Application No. JP2006510418	Inflatable crash protective clothing for exposed vehicle drivers	12/19/2002	3/30/2006
6	Japanese Patent No. 2008100023	Air mat	10/20/2006	5/1/2008
7	Japanese Patent Application No. JP2008163533	Protective Vest	12/28/2006	7/17/2008
8	Japanese Patent Application No. JP2011052329	Protector	8/31/2009	3/17/2011
9	Japanese Patent Application No. JP2019163574	Airbag Pants	8/27/2018	9/26/2019
10	Japanese Patent Application No. JP2019206789A	Air bag	5/25/2018	12/5/2019
11	Korea Patent No. KR20070018628A	A pressing belt of air injection type	8/10/2005	2/14/2007
12	Korea Patent No. KR101326990B1	Air bag cushion for protecting pedestrian	11/3/2011	11/13/2013
13	Korea Patent No. KR200367805Y1	Solid air-back for insertion into the inner surface of jackets	8/13/2004	11/17/2004
14	Taiwan Patent No. TWM485621U	Inflatable ventral band	5/1/2014	9/11/2014
15	Taiwan Patent No. TWM556547U	Complex adjustable pillow	10/6/2017	3/11/2018
16	United Kingdom Patent No. GB 2167710	Inflated Structures	1/5/1984	6/4/1986
17	United Kingdom Patent No. GB	An inflatable garment	1/12/2004	7/13/2005

Patent No.	Description	Filed Date	Issue/Publication Date
2409799			
International Patent No. WO1998/051170	Protective Device for Motorcyclists	11/20/1997	11/19/1998
International Patent No. WO2008/044222	Inflatable Device for Personal Protection and Garment Comprising the Same	10/12/2006	4/17/2008
International Patent No. WO2010/076299	Inflatable multilayer textile structure for realizing protective body garments	12/28/2009	7/8/2010
International Patent No. WO2011/148350	Protective Garment with an Airbag	5/27/2011	12/1/2011
International Patent No. WO2013131954	Airbag assembly for a motor vehicle and method for producing an airbag assembly	3/6/2013	9/12/2013
International Patent No. WO2014/125368	Personal protective equipment for protecting a user	2/17/2014	8/21/2014
International Patent No. WO2015181734	Garment with an inflatable protective device	5/27/2015	12/3/2015
International Patent No. WO2020/115258	Garment comprising an inflatable protection device	12/5/2019	6/11/2020
International Patent No. WO2021/260002	Wearable Protection Device	6/23/2021	12/30/2021

V. NON-PATENT PUBLICATIONS

The following non-patent literature invalidates the Asserted Claims and/or provide background regarding the state of the art at the time of the alleged invention:

Title	Author	Date
Technology Today, The Personal Airbag, Technology Today	Alan Pierce	February 2002
Airportek, Structure of the Airportek Air Cushion,	N/A	2006

Title	Author	Date
Airprotek Technology		
Helite Airbag Technology Expert, Helite Free-Air Vented Airbag Jacket, Helite Moto	N/A	2016
Pneumatic Textile System, University of Michigan, Taubman, College of Architecture and Urban Planning	Adam Wang, Sean Ahlquist	2016
Airbag Revolution, In & Motion	N/A	2017
New Atlas, Dainese testing inflatable protective jacket in the workplace	Paul Ridden	2017
The Inflatable Man, Airbags Changed Automobile Safety. Airbag Jackets Are About to Do the Same for Motorcycles	David Curcurito	September 2017
IDETC2019-97782: Assessment of Shoulder and Check Protection of Wearable Motorcycle Airbags	Davide Girardi, Edoardo Marconi, Matteo Massaro	2019
Airbags in airplanes? Seat belt safety device gaining traction, https://www.nbcnews.com/id/wbna39270568	David Kolpack	9/20/2010
https://www.freejumpssystem.com.au/history-of-riding-airbags/	N/A	2/2022
https://www.dueruote.it/news/equipaggiamento/2012/10/10/la-giacca-con-airbag-di-clover.html	N/A	10/10/2012
https://www.cyclenews.com/2018/11/article/dainese-introduces-third-generation-d-air-range/	N/A	11/2018
https://motocrossactionmag.com/motocross-airbag-system-is-the-future-of-protection/	N/A	9/18/2017
Tech-Air Street User's Guide	Alpinestars	2016

VI. PRODUCT PRIOR ART

The following prior art products invalidate the Asserted Claims and/or provide background regarding the state of the art at the time of the alleged invention:

Description	Date
Bering Gilet C-Protect Air Vest	April 13, 2017
Spidi DPS 03 Jacket	2016
Tech-Air Street	2017
Viper For Tech-Air Jacket	2016
Hit-air MX-3 Model	2017

VII. CLAIM CHARTS

Claim charts discussing example disclosures of the patents and publications above that are relevant to certain claims of the '065 Patent are provided in Exhibits AH.

Defendants reserve all rights to supplement or modify these invalidity contentions and to rely on these references to prove invalidity of the Asserted Claims in a manner consistent with the Federal Rules of Civil Procedure and the Rules of this Court. The patents and patent publications listed in Section IV above are representative and incorporate related patent applications, patent publications, and issued patents by reference. In addition, Defendants' incorporates by reference each and every prior art reference of record in the prosecution of the '065 patent and related applications, as well as the prior art discussed in the specification of the '065 patent.

It is impossible to chart every possible invalidating combination of the prior art references listed above. The following combinations are provided by example, and Defendants reserve the right to substitute similar references for one another, or to use any of the references listed above to illustrate the background art or the knowledge of a person of skill in the art at the time of the invention.

Charted anticipation references and combinations include:

Exhibit	Description
A	EP 2879536 B1 ("EP'536") in view of CN108968180 ("CN'180")

Exhibit	Description
B	EP'536 in view of CN'180 and U.S. Patent No. 3,823,711 ("Hatton")
C	EP 2621297 B1 ("EP'297") in view of CN205695842 ("CN'842")
D	CN110123064 ("CN'064")
E	Bering Gilet C-Protect Air Vest ("Bering")
F	Spidi DPS 03 Jacket ("Spidi")
G	US 2021/0329986 ("US'986")
H	Tech-Air Street ("Tech-Air Street")

VIII. CLAIM CONSTRUCTION

As set forth in the Court's March 12, 2025, Civil Minutes (Dkt. 39), the parties have not yet identified claim terms for construction or identified preliminary or proposed constructions. No expert reports on claim construction issues have been served and no *Markman* hearing has taken place. These invalidity contentions are heavily based on Plaintiff's apparent interpretations of the claims for purposes of infringement. Defendants expressly reserve the right to modify, amend, supplement, or otherwise alter its invalidity contentions pursuant to any claim construction argument made in this case, including but not limited to, arguments made by the parties, any expert opinions offered in this matter, or any order of the Court.

IX. SECTION 112

Defendants contend that the following claims (and any claims dependent thereon) are invalid for failure to satisfy the enablement requirement, written description requirement, and/or "particularly pointing out and distinctly claim[]" requirement of 35 U.S.C. § 112 (AIA). On information and belief, at least the

1 following limitations of the '065 Patent fail to satisfy the enablement requirement,
2 written description requirement, and/or “particularly pointing out and distinctly
3 claim[]” requirement:

- 4 • “wherein in the inflated condition, said portions of said casing body are
5 inflated against said first mesh portion, said second mesh portion, and
6 said tie elements so as to form a planar structure” (Claim 1)
- 7 • “wherein in the inflated condition said casing body is configured to line
8 from the inside, at least partially in contact, said mesh structure and that
9 said mesh structure is an external structure of said protective device.”
10 (Claim 2)
- 11 • “wherein said protective garment has a covering layer, wherein said
12 covering layer is of breathable material or includes transpiration
13 openings, and wherein said covering layer covers said first region and
14 said second region of said one or more inner housings” (Claim 12)
- 15 • “wherein in the inflated condition said casing body is configured to line
16 from the inside, at least partially in contact, said mesh structure or that
17 said mesh structure is an external structure of said protective device”
18 (Claim 13)
- 19 • “wherein in the inflated condition, the portions of the casing body are
20 inflated against the first mesh portion, the second mesh portion, and the
21 tie elements so as to form a planar structure” (Claim 18)
- 22 • “wherein the casing body is inflated until the tie elements and the mesh
23 structure are tensioned or until the casing body is at least partially
24 adhered to the first mesh portion and the second mesh portion” (Claim
25 22)

26 **a. Means Plus Function Under 35 U.S.C. § 112(f)(AIA)**

27 A claim that uses the term “means” is presumed to be a means-plus function
28 claim. *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 1368 (Fed. Cir.

1 2005); *Creo Products, Inc. v. Presstek, Inc.*, 305 F.3d 1337, 1344 (Fed. Cir.
2 2002); *Generation II Orthotics Inc. v. Medical Technology Inc.*, 263 F.3d 1356,
3 1363 (Fed. Cir. 2001); *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250,
4 1257 (Fed. Cir. 1999). The claim is indefinite if the specification fails to disclose
5 adequate structure that corresponds to the claimed function.

6 Discovery is ongoing and Plaintiff has not yet identified its claim
7 constructions. As such, Defendants reserve the right to assert that any claim term is
8 a means-plus-function term and that the term is invalid because its structure is not
9 disclosed in the '065 Patent; or to respond to any such contention by Plaintiff.

10 **X. SECTION 101**

11 Discovery is ongoing and Plaintiff has not yet identified its claim
12 constructions. As such, Defendants reserve the right to assert that any claim is
13 directed to ineligible subject matter under Section 101.

14 **XI. MOTIVATION TO COMBINE**

15 The Court's March 12, 2025, Civil Minutes (Dkt. 39) requires the
16 identification of Invalidity Contentions, including whether each item of prior art
17 anticipates each asserted claim or renders it obvious. In addition, according to the
18 Civil Minutes (Dkt. 39), if a combination of items of prior art makes a claim
19 obvious, each such combination and the motivation to combine such items must be
20 identified. As such, Exhibits A-H identify any specific combination and the
21 motivation to combine the references in the combination where applicable. General
22 motivation to combine any and all references in these contentions are provided
23 below.

24 In *KSR International Co. v. Teleflex Inc.*, the United States Supreme Court
25 clarified the standard for what types of inventions are patentable. 127 S. Ct. 1727
26 (2007). In particular, the Supreme Court emphasized that inventions arising from
27 ordinary innovation, ordinary skill, or common sense should not be patentable. *Id.* at
28 1732, 1738, 1742-1743, 1746. In that regard, a patent claim may be obvious if the

1 combination of elements was obvious to try or there existed at the time of the
2 invention a known problem for which there was an obvious solution encompassed
3 by the patent's claims. In addition, when a work is available in one field of
4 endeavor, design incentives and other market forces can prompt variations of it,
5 either in the same field or a different one. If a person of ordinary skill can
6 implement a predictable variation, Section 103 likely bars its patentability.

7 Defendants contend that no showing of a specific motivation to combine prior
8 art is required to combine the references disclosed above and in the attached charts,
9 as each combination of art would have no unexpected results, and at most would
10 simply represent a known alternative to one of skill in the art. *See KSR*, 127 S. Ct. at
11 1739-40 (rejecting the Federal Circuit's "rigid" application of the teaching,
12 suggestion, or motivation to combine test, instead espousing an "expansive and
13 flexible" approach). Indeed, the Supreme Court held that a person of ordinary skill
14 in the art is "a person of ordinary creativity, not an automaton" and "in many cases a
15 person of ordinary skill in the art will be able to fit the teachings of multiple patents
16 together like pieces of a puzzle." *Id.* at 1742.

17 Nevertheless, in addition to the information contained in the section
18 immediately above and elsewhere in these contentions, Defendants hereby identify
19 motivation and reason to combine the cited art. One or more combinations of the
20 prior art references identified above would have been obvious because these
21 references would have been combined using: known methods to yield predictable
22 results; known techniques in the same way; a simple substitution of one known,
23 equivalent element for another to obtain predictable results; and/or a teaching,
24 suggestion, or motivation in the prior art generally. In addition, it would have been
25 obvious to try combining the prior art references identified above because there
26 were only a finite number of predictable solutions and/or because known work in
27 one field of endeavor prompted variations based on predictable design incentives
28 and/or market forces either in the same field or a different one. In addition, the

1 combination of the prior art references identified above would have been obvious
2 because the combination represents the known potential options with a reasonable
3 expectation of success. Nearly all of the references herein are directed to comfort
4 and safety – an additional Motivation to combine such references is to increase the
5 comfort and/or safety of the device as worn by the wearer. Additional evidence that
6 there would have been a motivation to combine the prior art references identified
7 above includes the interrelated teachings of multiple prior art references; the effects
8 of demands known to the design community or present in the marketplace; the
9 existence of a known problem for which there was an obvious solution encompassed
10 by the Asserted Claims; the existence of a known need or problem in the field of the
11 endeavor at the time of the invention(s); and the background knowledge that would
12 have been possessed by a person having ordinary skill in the art. Thus, the
13 motivation to combine the teachings of the prior art references disclosed herein is
14 found in the references themselves and: (1) the nature of the problem being solved,
15 (2) the express, implied and inherent teachings of the prior art, (3) the knowledge of
16 persons of ordinary skill in the art, and (4) the predictable results obtained in
17 combining the different elements of the prior art.

18 Any reference or combination of references that anticipates or makes obvious
19 an independent claim also makes obvious any dependent claim, which is dependent
20 on that independent claim, because every element of each dependent claim was
21 known by a person of ordinary skill at the time of the alleged invention, and it
22 would have been obvious to combine those known elements with the independent
23 claims at least as a matter of common sense and routine innovation.

24 Moreover, a person of ordinary skill would have been motivated to combine
25 the prior art discussed herein and cited in connection with the '065 patent based on
26 the nature of the problem to be solved, the teachings of the prior art, and the
27 knowledge of persons of ordinary skill in the art. The prior art is all from the same
28 field of endeavor. The identified prior art addresses the same or similar technical

1 issues and suggest the same or similar solutions to those issues. To the extent that
2 Plaintiff challenges a combination of prior art with respect to a particular element,
3 Defendants reserve the right to supplement these contentions to further specify the
4 motivation to combine such prior art. Defendants may rely on cited or uncited
5 portions of the prior art, other documents, and expert testimony to establish that at
6 the time of the claimed invention a person of ordinary skill in the art would have
7 been motivated to modify or combine the prior art so as to arrive at the claimed
8 invention.

9 For the reasons discussed herein, a person having ordinary skill in the art
10 would have been motivated to combine various aspects of the prior art to arrive at
11 the invention that the Asserted Claims purport to cover. By way of example only,
12 the accompanying claim charts and the following discussion present combinations
13 that demonstrate the obviousness of the claimed invention. These prior art
14 combinations are not exhaustive; rather, they are illustrative examples of the prior
15 art combinations that would have rendered the claimed subject matter obvious.
16 These exemplary combinations are in addition to the above discussion regarding
17 Defendants' contentions that the claims are anticipated and/or obvious over the
18 above-cited individual references standing alone. Accordingly, the exemplary
19 combinations described herein should not be interpreted as indicating that any of the
20 individual references included in the exemplary combinations are not on their own
21 invalidating prior art under 35 U.S.C. §§ 102 and/or 103 (AIA) and do not exclude
22 other unspecified combinations that would also demonstrate the obviousness of the
23 claimed subject matter.

24 Much of the art identified above and in the attached Exhibits reflects common
25 knowledge and the state of the art prior to the filing date of the '065 patent and/or at
26 the time each alleged invention was made. In many instances where a particular
27 contention calls for, or requires, combining references, any one of a number of
28 references can be combined. The inclusion of certain exemplary combinations

1 herein does not exclude other combinations based on the claim charts attached
2 hereto, as there are many possible combinations of the references listed herein.

3 **XII. CONTINUING SEARCH**

4 Defendants' search for prior art references, prior art systems, additional document,
5 and/or corroborating evidence concerning prior art patents, publications, and
6 systems is ongoing. Accordingly, Defendants reserve the right to continue to
7 supplement its contentions as Defendants obtains additional prior art references,
8 systems, document, and/or corroborating evidence concerning invalidity during the
9 course of the case. For example, Defendants reserve the right to supplement these
10 contentions to reflect information obtained through discovery regarding the first
11 dates on which prior art systems were publicly available, publicly known, sold,
12 and/or offered for sale, including the identification of additional prior art systems
13 not currently known to Defendants.

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By: /s/ Martin M. Ellison

17 Paul R. Steadman (*Pro Hac Vice*)

paul.steadman@dlapiper.com

18 T: (312) 368-2135 | F: (312) 251-2850

19 Matthew D. Satchwell (*Pro Hac Vice*)

matthew.satchwell@us.dlapiper.com

20 T: (312) 368-2111 | F: (312) 236-7519

21 **DLA PIPER LLP (US)**

444 West Lake Street, Suite 900

22 Chicago, Illinois 60606-0089

23
24 Martin M. Ellison (SBN 292060)

martin.ellison@dlapiper.com

25 **DLA PIPER LLP (US)**

26 2000 Avenue of the Stars, Suite 400, N.
Tower

27 Los Angeles, CA 90067-4735

28 T: (310) 595-3000 | F: (310) 595-3300

Peter D. VandeVort (SBN 359810)
peter.vandevort@us.dlapiper.com
DLA PIPER LLP (US)
555 Mission St. Suite 2400
San Francisco, CA 94105
T: (415) 836-2500 | F: (415) 836-2501

*Attorneys for Defendants Alpinestars
USA Inc. and Alpinestars S.p.A.*