IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF GEORGIA
AUGUSTA DIVISION

SOLBELLO, INC.,	)	
Plaintiff,	)	
v.	)	Case No. 1:25-cv-00267-JRH-BKE
SHORESHADE, LLC,	)	
Defendant.	)	

SHORESHADE'S RESPONSE TO PRELIMINARY INJUNCTION MOTION

Solbello, Inc. ("Solbello") seeks the extraordinary remedy of a preliminary injunction based entirely on an allegation that ShoreShade LLC ("ShoreShade") has directly infringed Claim 44 of U.S. Pat. No. RE50606 (the "Reissue Patent"). But, even assuming solely for the sake of argument that Claim 44 covers ShoreShade's accused product, **no infringement has occurred**.

First, direct infringement occurs only if an infringer has performed an infringing act "during the term of the patent." 35 U.S.C. § 271(a). But the Reissue Patent did not grant until September 30, 2025, so any sales before that date could not be infringing. Solbello, however, does not distinguish between actions occurring before the issue date of Reissue Patent and those occurring after the issue date. In reality, ShoreShade has not distributed products after the issue date other than a small number of products distributed for free.

Second, because Claim 44 was not in the original patent surrendered in favor of the Reissue Patent, intervening rights provide an absolute defense against infringement for any products in inventory before the grant date of the Reissue Patent. 35 U.S.C. § 252. Intervening rights are always a substantial issue in cases involving conduct that began before a reissue patent is granted, but Solbello's motion

conspicuously ignores intervening rights. Given that all existing products in ShoreShade's inventory were made and purchased before the grant of the Reissue Patent, ShoreShade is entitled under 35 U.S.C. § 252 to use, offer to sell, and sell these products.

In addition, Claim 44, if properly construed according to claim construction principles established by the Federal Circuit, does not even cover the accused ShoreShade product. While Solbello omits any discussion about claim construction, claim construction is required to evaluate the likelihood of infringement to understand the scope of the claim. When the claims are appropriately construed in light of the specification and the prosecution history, the accused product is outside the scope of Claim 44. Indeed, if Claim 44 is read as broadly as Solbello appears to read it, the claim is invalid for lack of written description support and/or due to obviousness in light of the prior art.

Finally, the accused product is being phased out, which moots any need for the extraordinary relief that Solbello now seeks. ShoreShade evaluated its product to prepare for next season before the issue date of the Reissue Patent. As a result of that evaluation, ShoreShade had already decided that the previous generation design will be discontinued in favor of a next generation design starting next season. The next generation design will not have a pole that rotates relative to the beach sand, so the product will not self-adjust to the wind in this manner. As this self-adjusting feature seems to be the entire basis of Plaintiff's motion, the motion fails on this basis too.

A preliminary injunction may be defeated by raising a "substantial question" about infringement or validity. *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1364 (Fed. Cir. 1997). As explained below, ShoreShade meets this low threshold for numerous reasons.

I. BACKGROUND

Since the day that the Reissue Patent was granted on September 30, 2025, ShoreShade's website has presented the accused products as being "sold out." Simply put, customers could not and still cannot

order them. Schulze Decl. at ¶ 3. This is shown by the material on the website as of September 8, 2025, which is reproduced as Attachment 1 to the Schulze Declaration. Also, ShoreShade has not sold any of the accused products through Amazon or any other third-party since the issue date of the Reissue Patent. *Id.* ¶ 5. The images in the Complaint were images from before the issue date of the Reissue Patent. *Id.* ¶ 4. Also, all products currently in inventory were made and received by ShoreShade before the issue date of the Reissue Patent. *Id.* ¶ 7. Since the issue date of the Reissue Patent, ShoreShade has distributed fewer than twenty of the accused products for free to fulfill warranty obligations and for other reasons. *Id.* ¶ 6. However, these products were each purchased, made, and received by ShoreShade well before the issue date of the Reissue Patent. *Id.*

Solbello originally obtained U.S. Pat. No. 11,596,211 (the "Original Patent"). However, on September 12, 2023, Solbello filed a reissue patent application seeking to broaden the claims in the Original Patent. Compl. (Dkt. No. 1) at 20. The reissue patent application ultimately resulted in the Reissue Patent, which issued on September 30, 2025. On the issuance of the Reissue Patent, the surrender of the Original Patent took effect, making the Original Patent no longer assertable. 35 U.S.C. § 252. Claim 44, the sole claim being asserted in this case, was not in the Original Patent, but sprang into existence as a patent claim only with the issuance of the Reissue Patent on September 30, 2025.

Solbello focuses "only on its claim for direct infringement [of Claim 44] for the purposes of its" preliminary injunction motion, Mot. (Dkt. No. 5) at 10 n.3, so ShoreShade will similarly focus on that sole direct infringement claim here.

II. LEGAL STANDARD

First, even assuming that infringement may be shown, a patent does not entitle the patentee to automatically enjoin infringers. "A preliminary injunction is an extraordinary remedy never awarded as of right." *Winter v. Nat. Res. Def. Council, Inc.*, 555 U.S. 7, 24 (2008); *accord Takeda*

Pharms. U.S.A., Inc. v. Mylan Pharms. Inc., 967 F.3d 1339, 1345 (Fed. Cir. 2020). The burden is on Solbello to show it is likely to succeed on the merits, that it is likely to suffer irreparable harm caused by the alleged infringement absent preliminary relief, that the balance of equities tips in its favor, and that an injunction is in the public interest. *Luminara Worldwide v. Liown Elecs. Co.*, 814 F. 3d 1343, 1352 (Fed. Cir. 2016) (quoting *Winter*, 555 U.S. at 20); *accord Incyte Corp. v. Sun Pharm. Indus., Ltd.*, 135 F.4th 1381, 1383 (Fed. Cir. 2025).[1]

As to a likelihood of success on the merits, a patentee must show that: "(1) the patentee will likely prove that the accused infringer infringes the asserted patent; and, (2) the patentee's infringement claim will likely withstand the accused infringer's challenges to the validity and enforceability of the patent." *Sciele Pharma Inc. v. Lupin Ltd.*, 684 F.3d 1253, 1259 (Fed. Cir. 2012) (noting that this showing is made while considering the presumptions and burdens that will inhere at trial on the merits). If a defendant raises a "substantial question" concerning infringement or validity, the preliminary injunction should not issue. *Genentech*, 108 F.3d at 1364; *accord Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 130 F.4th 1372, 1384 (Fed. Cir. 2025).

The likelihood of success factor "depends fundamentally on the meaning of the asserted claim and its relationship to the accused product or process." *Chamberlain Grp., Inc. v. Lear Corp.*, 516 F.3d 1331, 1339–40 (Fed. Cir. 2008). "[A] correct claim construction is almost always a prerequisite for imposition of a preliminary injunction." *Id.*; *accord Pfizer, Inc. v. Teva Pharms., USA, Inc.*, 429 F.3d 1364, 1372 (Fed. Cir. 2005) ("Determining the likelihood of infringement requires two steps, first claim construction and second a comparison of the properly construed claims to the accused product."). Claim construction is a legal determination reviewed de novo. *Ball Aerosol & Specialty Container, Inc. v. Ltd.*

[1] Federal Circuit precedent applies to preliminary injunctions in patent cases. *Chrysler Motors Corp. v. Auto Body Panels of Ohio, Inc.*, 908 F.2d 951, 953 (Fed. Cir. 1990).

Brands, Inc., 555 F.3d 984, 989 (Fed. Cir. 2009) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1328 (Fed. Cir. 2005) (*en banc*)).

III. ARGUMENT

Due to the lack of infringement and invalidity of Claim 44, Solbello's motion fails to meet its burden of establishing a likelihood of success. Solbello also fails to show that any harm is attributable to an infringement of Claim 44, especially because no infringement has occurred and no infringement will occur. Moreover, the balance of the equities weigh against injunctive relief and an injunction is not in the public interest.

A. No Likelihood of Success.

Solbello fails to establish a likelihood of success because (1) absolute intervening rights apply to ShoreShade's existing products under 35 U.S.C. § 252; (2) other than the limited number of products distributed for free, ShoreShade has not otherwise distributed any products since the issue date of the Reissue Patent; (3) ShoreShade's previous generation design does not infringe Claim 44 of the Reissue Patent, if properly construed; (4) Claim 44 claim is invalid, especially if read as broadly as Solbello would have the Court read it; and (5) ShoreShade's next generation design does not infringe the Reissue Patent. Each issue is discussed below.

i. Absolute Intervening Rights Applies to ShoreShade's Existing Products

Even assuming the previous design of ShoreShade's products fall within the scope of Claim 44 (which ShoreShade strenuously denies), Solbello's filings ***ignore*** the fact that ShoreShade is entitled to ***absolute intervening rights*** for its existing products under to 35 U.S.C. § 252. Although a patentee is entitled to seek a reissue patent if an original patent is believed to be defective, the trade-off is that an accused infringer may be entitled to absolute or equitable intervening rights. As for "absolute intervening rights," 35 U.S.C. § 252 provides:

> A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.

The legislative history of section 252 underscores the meaning of the words in the first sentence: "[t]he specific things made before the date of reissue, which infringe the new reissue claims, are absolutely free of the reissued patent and may be used or sold after the date of reissue without regard to the patent." *BIC Leisure Prods., Inc. v. Windsurfing Int'l, Inc*., 1 F.3d 1214, 1221 (Fed. Cir. 1993) (citing P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 46 (1954)). Consequently, ShoreShade is entitled to sell off the existing inventory in its possession made before the issue date of the Reissue Patent. "Intervening rights typically arise as a consequence a patentee may have to bear for correcting a defect in its patent after the patent issues." 2 Annotated Patent Digest (Matthews) § 11:12.

Solbello substantively changed the scope of its claims during prosecution, attempting to broaden the claims to cover ShoreShade's products. Solbello concedes this point, stating that, "[o]n September 12, 2023, Solbello applied to have the '211 Patent reissued ***with claims that more properly covered the full extent of its innovative shade***." Compl. (Dkt. No. 1) at ¶ 20 (emphasis added). There are no claims in the Reissue Patent that were in the original patent, so absolute intervening rights will always apply to any product existing on the issue date. For products made, purchased, offered for sale, or imported into the United States before the grant of the Reissued Patent, ShoreShade is entitled by statute to "continue the use of, to offer to sell, or to sell to others" those products. 35 U.S.C. § 252. All products currently in ShoreShade's inventory were made and received by ShoreShade before the issue date of the Reissue Patent. Schulze Decl. at ¶ 7. Consequently, ShoreShade is entitled to sell off the existing inventory in its

possession, and any products distributed by ShoreShade after the issue date are protected from allegations of infringement. Thus, there have been no acts of direct infringement due to absolute intervening rights.

ii. No Sales Since the Date the Reissue Patent was Granted

Direct infringement is only present where an infringer "without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention ***during the term of the patent therefor***. . . ." 35 U.S.C. § 271(a) (emphasis added). Any sales arising before the grant of the Reissue Patent fall outside of the term of the Reissue Patent, preventing these sales from constituting direct infringement.[2] *See Welker Bearing Co. v. PHD, Inc.*, 550 F.3d 1090, 1095 (Fed. Cir. 2008) (stating that there is no infringement until an infringing act occurs in the U.S. during the term of the patent).

Solbello fails to acknowledge this critical issue and fails to distinguish between acts that occurred before the issue date and those that occurred after the issue date. ShoreShade has made no sales or offers to sell the accused products since the date that the Reissue Patent was granted. Since the issue date of the Reissue Patent, ShoreShade's website has always indicated that its accused products were sold out, preventing any customers from ordering these products. Schulze Decl. at ¶ 3.[3] Additionally, the accused products have not been sold on Amazon since the issue date. *Id.* ¶ 5. None of the accused products have been made in the United States or imported into the United States since the issue date either. *Id.* ¶ 7.

While fewer than twenty of the accused products were distributed for free for warranty fulfillment and for other reasons, Schulze Decl. at ¶ 6, absolute intervening rights insulate ShoreShade

[2] As will be discussed in ShoreShade's motion to dismiss, Solbello asks for a preliminary injunction before it has even pled a proper claim for patent infringement. Solbello's infringement allegations are conclusory and do not provide sufficient factual allegations to show that direct infringement occurred after the issue date of the Reissue Patent.

[3] ShoreShade does have limited remaining inventory, but this is being maintained to provide a sufficient quantity of product for spare parts and to address warranty issues. Schulze Decl. at ¶ 7.

from infringement as these products were made, purchased, and then received by ShoreShade before the issue date of the Reissue Patent. Consequently, the distribution of these few products cannot be acts of infringement.

Thus, there has been no infringement at the time the Complaint was filed. Without more than the mere apprehension of potential future infringement, a preliminary injunction is unjustified. *Roper Corp. v. Litton Sys., Inc.*, 757 F.2d 1266, 1273 (Fed. Cir. 1985) (affirming denial of preliminary injunction where there was nothing in the record establishing infringement or an immediate threat of renewed infringement); *see also Lang v. Pac. Marine & Supply Co.*, 895 F.2d 761, 765 (Fed. Cir. 1990) (affirming dismissal of claim for an injunction against threatened patent infringement where the alleged infringing ship was still nine months away from completion at the time the complaint was filed).

iii. Previous Generation Design Falls Outside the Scope of Claim 44

In addition to the issues regarding a lack of sales since the issue date and absolute intervening rights, the previous generation design does not infringe because it falls outside the scope of Claim 44. Solbello only discusses Claim 44 of the Reissue Patent in its complaint and in its motion for preliminary injunction.[4] Claim 44 provides as follows (emphasis added):

> 44. A sun shade assembly comprising:
>
> a mast configured to extend upwardly from a supporting surface, and having a top end and a bottom end;
>
> ***at least one rib located proximate the top end of said mast, and configured to rotate relative to the supporting surface;***
>
> a sail having a proximal edge secured to said rib and an unrestrained free edge adapted to unfurl in response to blowing of the wind, and wherein an entire surface area of said sail is unrestrained from the proximal edge to the free edge; and
>
> when unfurled, said sail and rib are adapted to rotate together to a direction of the blowing wind.

[4] None of the other patent claims in the Reissue Patent are infringed either, but these have not been addressed here since there was no discussion of these claims by Solbello. To the extent Solbello attempts to rely on other patent claims to show infringement in subsequent briefing, it has not met its burden to show it is likely to succeed on the merits for these patent claims.

"Determining the likelihood of infringement requires two steps, first claim construction and second a comparison of the properly construed claims to the accused product." *Pfizer, Inc. v. Teva Pharms., USA, Inc*., 429 F.3d 1364, 1372 (Fed. Cir. 2005). "[A] correct claim construction is almost always a prerequisite for imposition of a preliminary injunction." *Id*. Despite this, Solbello does not even mention the concept of claim construction in its briefing. When Claim 44 is properly construed, ShoreShade's products do not infringe the claim.

The starting point in construing such claims is their ordinary and customary meaning, which "is the meaning that the term would have to a person of ordinary skill." *Phillips*, 415 F.3d at 1313. However, *Phillips* clarified that "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id*. For this reason, the specification is often 'the single best guide to the meaning of a disputed term.'" *Id*. at 1315 (quoting *Markman v. Westview Instruments, Inc*., 52 F.3d 967, 979–81 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996)) (internal quotation marks omitted). Where the specification "repeatedly, consistently, and exclusively" shows a component as having a particular feature, the claim term will be defined by implication to include this feature. *In re Abbott Diabetes Care Inc*., 696 F.3d 1142, 1149–50 (Fed. Cir. 2012). Courts also look to the prosecution history with the patent office to understand the meaning of a claim term. *Phillips*, 415 F.3d at 1314.

Claim 44 requires "at least one rib . . . ***configured to rotate*** relative to the supporting surface." This does not mean that the rib can be fixed to the mast and rotate as the mast itself rotates relative to the "supporting surface" (which seems to be how Solbello is applying the term). Instead, "configured to rotate" means that something about the ribs themselves makes them specifically designed to rotate relative to the supporting surface—a rib that is fixedly attached to the mast so it rotates with the mast is not "configured to" rotate but is merely along for the ride. *Cf. Ball Aerosol & Specialty*

Container, Inc. v. Ltd. Brands, Inc., 555 F.3d 984, 994 (Fed. Cir. 2009) (reversing district court's grant of summary judgment of infringement in favor of patentee where district court granted summary judgment because the accused product was "reasonably capable of being configured in such a way that its holder is supported by the cover," with Federal Circuit stating that the mere fact that the accused product "was reasonably capable of being put into the claimed configuration is insufficient for a finding of infringement" where the claim language itself specified that infringement occurs only if the accused product was ***configured*** with a cover used as a base underneath a candle holder).

Solbello uses the term "capable of" in several instances in the Reissue Patent. Reissue Patent at col. 8, line 62; *id.* at col. 9, line 32; *id.* at col. 12, line 61. This shows that Solbello knew how to use this "capable of" term when it wanted to, and, by using a different "configured to" term in claim 44, Solbello intended to have a different meaning apply.

A construction that the ribs themselves are specifically designed to enable them to rotate is consistent with the discussion throughout the specification, which repeatedly describes the ribs as being rotatable about the non-movable mast. *See infra* at Section III(A)(iv). Given the repeated, consistent, and exclusive discussion where the mast is not capable of moving and where the ribs are configured to rotate relative to the mast, the claim term has been defined by implication.

Additionally, adopting a broader construction would render Claim 44 invalid for a lack of written description as discussed below. *See infra* at Section III(A)(iv). Given the clear issues that are present with the validity of the Claim 44, this claim term should be construed in a way that preserves its validity. *See Ruckus Wireless, Inc. v. Innovative Wireless Sols., LLC*, 824 F.3d 999, 1004 (Fed. Cir. 2016) (construing claims to have a narrower construction to preserve validity where a broader construction would render the claims invalid for a lack of written description).

The patent examiner's own statements also indicate that he interpreted the claim much more narrowly than Solbello apparently does now, with the patent examiner's interpretation falling in line with the construction ShoreShade proposes here. In the examiner's statement of reasons for allowance, the examiner discussed application Claim 47, which became Claim 44 in the Reissue Patent after the claims were renumbered for issuance. The examiner stated the closest prior art was U.S. Pat. Publ. No. 2008/0196754 to Saiz ("Saiz"), and the examiner distinguished the claim from Saiz by stating that "Saiz does teach rotation, ***but this rotation is effected by the mast, and not relative to the mast.***" Ex. B at 9 (using ECF provided page number). Thus, in the examiner's eyes, something about the ribs of the Reissue Patent allowed them to rotate "relative to the mast," and this was the critical point of distinction between Saiz and the present claim. Now that Solbello has obtained a patent, it is trying to interpret the claims more broadly, using a different interpretation for infringement relative to the interpretation used for validity. This is improper. *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) ("[T]he claims must be interpreted and given the same meaning for purposes of both validity and infringement analyses.").[5] Based on the above, "at least one rib . . . configured to rotate relative to the supporting surface" should be construed to mean "at least one rib . . . specifically designed to rotate relative to the mast."

"[D]irect infringement can be found when 'each and every limitation set forth in a claim' is found in an accused product." *Mitek Sys., Inc. v. United Servs. Auto. Ass'n*, 139 F.4th 1340, 1348 (Fed. Cir. 2025). Each limitation must be present either literally or under the doctrine of equivalents. *Microsoft Corp. v. GeoTag, Inc.*, 817 F.3d 1305, 1313 (Fed. Cir. 2016). "The law is clear . . . that 'infringement is determined on the basis of the claims, not on the basis of a comparison with the patentee's commercial

[5] To the extent Solbello's broad interpretation of the claim is accepted, this would also render the claims invalid as being obvious pursuant to 35 U.S.C. § 103 at least over Saiz and U.S. Pat. No. 10,190,330 to Barnes.

embodiment of the claimed invention.'" *Myco Indus., Inc. v. BlephEx, LLC*, 955 F.3d 1, 15 (Fed. Cir. 2020) (citations omitted).[6]

The doctrine of equivalents may be applied when a claim limitation is not literally present. *NexStep, Inc. v. Comcast Cable Commc'ns, LLC*, 119 F.4th 1355, 1370 (Fed. Cir. 2024), *cert. denied*, 145 S. Ct. 2794 (2025). A doctrine of equivalents theory cannot be asserted if it will encompass or "ensnare" the prior art. *G. David Jang, M.D. v. Bos. Sci. Corp.*, 872 F.3d 1275, 1285 (Fed. Cir. 2017) (citing *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1322 (Fed. Cir. 2009)). To the extent Solbello's broad interpretation of the claim is accepted, this would also render the claims invalid as being obvious pursuant to 35 U.S.C. § 103 at least over Saiz and U.S. Pat. No. 10,190,330 to Barnes.

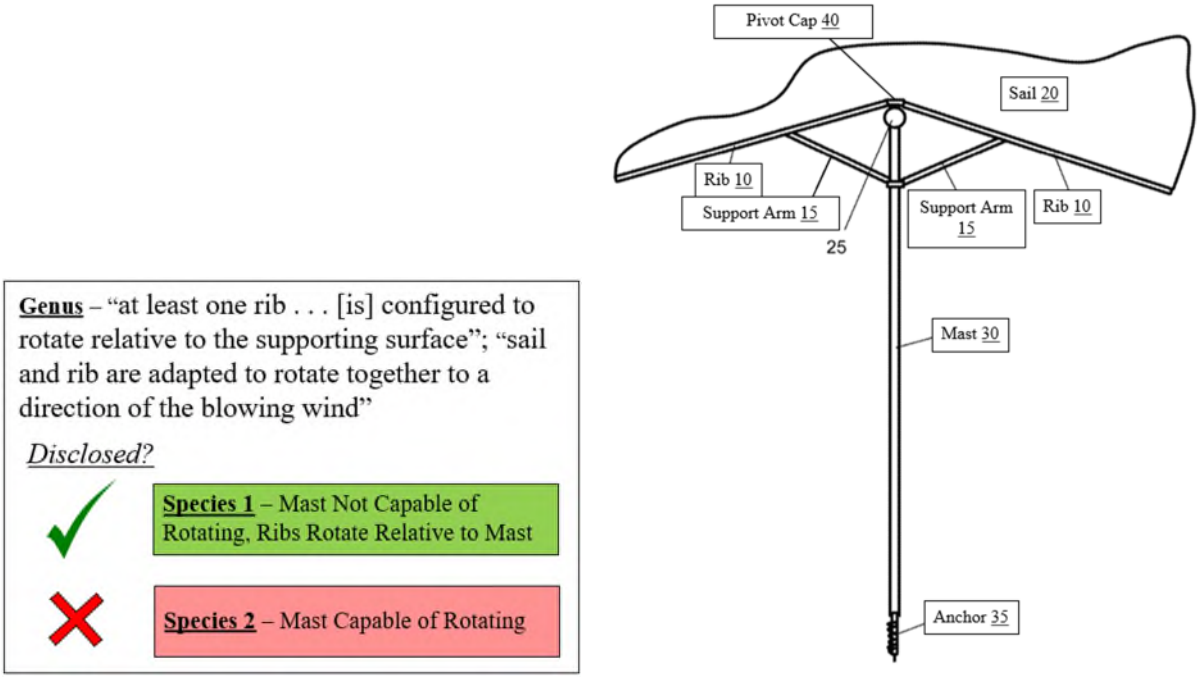
Regardless, the doctrine of equivalents is disfavored as the basis for a preliminary injunction, because it is a "highly factual inquiry [that] rarely comes clear on a premature record." *Pressure Specialist, Inc. v. Next Gen Mfg. Inc.*, 469 F. Supp. 3d 863, 871–72 (N.D. Ill. 2020) (quoting *Jeneric/Pentron, Inc. v. Dillon Co., Inc.*, 205 F.3d 1377, 1382 (Fed. Cir. 2000)); *see also Mylan Institutional LLC v. Aurobindo Pharma Ltd.*, 857 F.3d 858, 866 (Fed. Cir. 2017) (observing that it is unusual for a court to grant a preliminary injunction based on infringement under the doctrine of equivalents). Thus, it would be inappropriate to rely on the doctrine of equivalents to find a likelihood of infringement.

[6] Despite this, pages 5–7 of its preliminary injunction motion are dedicated to a comparison of Solbello's products and ShoreShade's products, but none of this is relevant to the question of infringement. The presence of unclaimed features in the accused products that are also present in the patentee's products is irrelevant to the question of patent infringement.

iv. Claim 44 is Invalid for a Lack of Written Description Support.

Especially if Claim 44 of the Reissue Patent is read as broadly as Solbello wants, it is invalid at least because of a lack of written description support. To satisfy the written description requirement of 35 U.S.C. § 112(a), the disclosure of the application must "reasonably convey[ ] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Brita LP v. Int'l Trade Comm'n*, No. 2024-1098, 2025 WL 2922550, at *3 (Fed. Cir. Oct. 15, 2025) (quoting *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*)). Assessing such "possession as shown in the disclosure" requires "an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." *Id.* (quoting *Ariad*, 598 F.3d at 1351). "[T]he specification must describe an invention understandable to [a person of ordinary skill in the art] and show that the inventor actually invented the invention claimed." *Id.* (quoting *Ariad*, 598 F.3d at 1351).

For a broad, functional claim to meet the written description requirement, the patentee must demonstrate he "has invented species sufficient to support a claim to the functionally-defined genus." *Brita LP*, 2025 WL 2922550, at *7 (quoting *Ariad*, 598 F.3d at 1349). This is where Claim 44 fails:



Claim 44 is a new claim by which Solbello attempted to obtain broader coverage than it got in the Original Patent. An annotated version of FIG. 1 of the Reissue Patent is shown above with various claim terms shown to aid the court in interpreting the claims. Claim 44 requires that "at least one rib . . . [is] configured to rotate relative to the supporting surface" and that "when unfurled, said sail and rib are adapted to rotate together to a direction of the blowing wind." If Solbello is allowed to move forward with a broad construction of these limitations, then these limitations amount to a functionally defined genus that does not describe the particular species. Solbello has removed the limitations about the pivot cap from Claim 44, attempting to cover situations where the mast itself is capable of rotating relative to the supporting surface in attempt to broaden the claims to cover ShoreShade's old design. There is, however, no support in the specification of the Reissue Patent to cover a species within the larger genus where the mast is allowed to rotate. Every time the mast is discussed, the specification of the Reissue Patent notes that other components such as the ribs and the support arms are allowed to rotate about the mast. The Reissue Patent **never states** that the mast is capable of rotating. Reissue Patent at col. 3, ll. 7–10 ("The method further includes adjusting the tension adjuster to achieve a desired amount

of rotation of the pivot cap, ribs, support arms, slider, and sail relative to the ***non-movable mast***."); *id*. at col. 7, ll. 34–38 ("Particularly, ***the mast remains in a stationary position***, while the slider (and attached support arms and ribs) rotate in response to the wind blowing"); *id*. at col. 9, ll. 1–2 ("***[T]he mast does not rotate in response*** to wind conditions due to its attachment to the anchor."); *id*. at col. 12, ll. 39 ("Specifically, when the wind shifts direction, the sail will self-adjust (e.g. the pivot cap, ribs, sail, support arm, and slider rotate about the ***non-movable mast*** in response to the wind blowing and changing direction))." Instead, the specification only describes a species where the mast does not rotate, and the pivot cap, the ribs, and support arms are always described as being able to rotate relative to the mast to allow the ribs to rotate to the direction of the blowing wind. Thus, the Reissue Patent never describes a mast that is capable of rotating, Schulze Decl. at ¶ 10, making it clear that Solbello did not possess the claimed subject matter in Claim 44 as of the filing date.

By bringing this case, Solbello has created a Catch-22 situation for itself. It can press forward and seek a claim construction of Claim 44 that attempts to cover ShoreShade's product, which includes a "mast" that rotates. However, doing so would require a claim construction that would eventually invalidate Claim 44 under 35 U.S.C. § 112 for a lack of written description.[7] A more appropriate and narrower construction, however, would not cover the ShoreShade product. No matter the path Solbello ultimately chooses, it has fallen far short of showing a likelihood of success on the merits.

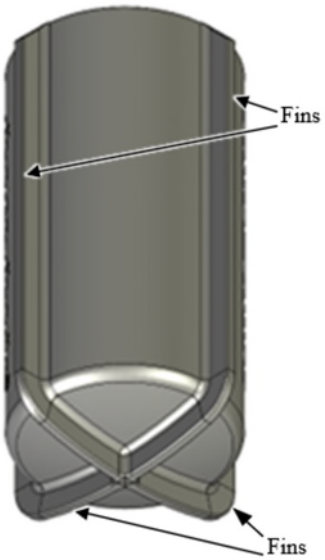
v. Next Generation Design Falls Outside the Scope of Claim 44.

As stated above, the current version of the ShoreShade product is being discontinued. After the summer selling season, ShoreShade evaluated its product and decided to launch a next generation design starting next season. Schulze Decl. at ¶ 8. The next generation design will not rotate to self-adjust

[7] If construed as broadly as Solbello proposes, Claim 44 would also be invalid based on the prior art.

to the direction of the blowing wind, which seems to be the entire basis of Plaintiff's motion. Consequently, the next generation design does not infringe Claim 44, either literally or under the doctrine of equivalents.

ShoreShade's next generation design will include the following lower end cap at the base of the pole, which includes fins that are specifically configured to prevent rotation of the pole to the direction of the blowing wind:



Lower End Cap

Layout for ShoreShade's Products

The lower end cap includes fins, and these fins will engage the surrounding sand when the lower end cap is positioned in the sand. Schulze Decl. at ¶ 8. The engagement of the fins with the sand will prevent rotation of the lower end cap. *Id*. The next generation design will be sold to customers with the lower end cap attached to the pole using a strong adhesive that effectively prevents removal of the lower end cap once attached. *Id.* The adhesive is so strong that, for a customer to remove the lower end cap, the customer would be required to saw off the bottom part of the pole. *Id.* Additionally, the top beams are attached to the pole to prevent rotation of the top beams relative to the pole. *Id.* Even with the addition of the lower end cap to the next generation design, the top beams and arms will still be attached to the pole in a similar manner so they will not freely rotate relative to the pole, thus preventing

rotation of these components relative to the blowing wind. *Id*. As a result, the next generation design will not possess a "rib . . . configured to rotate relative to the supporting surface," and the limitation "said sail and rib are adapted to rotate together to a direction of the blowing wind" will also not be satisfied, preventing any literal infringement.

The next generation design would not infringe under the doctrine of equivalents either. The doctrine does not apply "where 'the accused device contain[s] the antithesis of the claimed structure,' such that the claim limitation would be vitiated." *Steuben Foods, Inc. v. Shibuya Hoppmann Corp*., 127 F.4th 348, 362 (Fed. Cir. 2025) (quoting *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1356 (Fed. Cir. 2012)). Solbello concedes that the ability of the rib to automatically rotate with the blowing wind is critical. For example, Solbello quotes the claim language of Claim 44 and then states that, "[i]n other words, claim 44 covers a specific type of sunshade with a loose, billowing sail that automatically swivels to match the wind's direction." Mot. (Dkt. No. 5) at 5. Solbello also states that "its innovative structure makes it more stable on windy days, because it automatically adjusts to the wind," Compl. (Dkt. No. 1) at ¶ 10, and that its "unique and innovative design makes it more stable on windy days because it automatically swivels to face the wind," Mot. at 4. In the discussion of the doctrine of equivalents, Solbello states that the doctrine applies since ShoreShade's product "is, after all, a vertical sunshade with horizontal ribs that unfolds to release a billowing sail and which rotates to align with the wind," Mot. at 17, which again highlights how Solbello itself perceives the rotatability of the ribs to be important.

The use of the lower end cap in the next generation of ShoreShade's product prevents rotation of the top beams (which Solbello contends corresponds to the rib) of the ShoreShade product relative to the beach surface. This is "the antithesis of the claimed structure," *Steuben Foods*, 127 F.4th at 362, and the application of the doctrine of equivalents here would vitiate the final

limitation of Claim 44, making application of that doctrine inappropriate here. As evidenced by Solbello's own statements, the differences between the claimed invention and the accused device or process are not insubstantial, and the products do not provide substantially the same function in substantially the same way to obtain the same result.

Thus, the next generation design will not infringe, either literally or under the doctrine of equivalents, further showing that no likelihood of success is present.

B. No Irreparable Harm.

While Solbello seeks the extraordinary relief of a preliminary injunction, it has not shown that it is likely to suffer irreparable harm ***caused by the alleged infringement*** absent preliminary relief. To satisfy the irreparable harm element, the patentee must show that a "causal nexus relates the alleged harm to the alleged infringement." *Apple Inc. v. Samsung Elecs. Co.*, 695 F.3d 1370, 1374 (Fed. Cir. 2012). "[T]he causal nexus requirement is simply a way of distinguishing between irreparable harm caused by patent infringement and irreparable harm caused by otherwise lawful competition—e.g., "sales [that] would be lost even if the offending feature were absent from the accused product." *Apple Inc. v. Samsung Elecs. Co.*, 735 F.3d 1352, 1361 (Fed. Cir. 2013) (quoting *Apple Inc. v. Samsung Electronics Co.*, 678 F.3d 1314, 1324 (Fed. Cir. 2012)).

Solbello cannot complain about harms arising to it that stem from lawful competition rather than from infringement of Claim 44 of the Reissue Patent. First off, Solbello has not shown that any infringement has occurred or that any infringement will occur. Consequently, there is no irreparable harm attributable to an act of patent infringement. Even assuming that ShoreShade has infringed Claim 44 of the Reissue Patent (which ShoreShade strenuously denies), Solbello has not sufficiently explained how any alleged harms are actually attributable to the inclusion of the allegedly infringing features as opposed to other factors.

To the extent Solbello attempts to argue that the harms arising before the Reissue Patent was issued provide insight into the harms that will arise after the Reissue Patent was issued, it still has not shown that any infringement has occurred or will occur and fails to show a causal nexus as required. As such, Solbello does not meet the causal nexus requirement, and the lack of irreparable harm weighs strongly against entering a preliminary injunction.[8]

Additionally, in the initial email to the court requesting an expedited hearing, counsel for Solbello acknowledged that "we are not in beach season," Ex. C, which further supports that there is no irreparable harm here and no basis for expedited relief. Although counsel for Solbello stated that "the next month or so is when orders are placed for the manufacture of beach shade products," *id.*, submitting an order for products is not an act of infringement, and it establishes no irreparable harm.

C. Balance of Equities Weigh Against Injunctive Relief.

A proper balance of potential hardships must also consider the patentee's showing on likelihood of success and irreparable harm. *Illinois Tool Works, Inc. v. Grip-Pak, Inc.*, 906 F.2d 679, 683 (Fed. Cir. 1990). "Because the [C]ourt must balance the hardships, at least in part in light of its estimate of what is likely to happen at trial, it must consider the movant's showing of likelihood of success." *Id*. The issues presented here show that Solbello is not likely to succeed, making the equities weigh even greater against injunctive relief.

D. An Injunction is Not in the Public Interest.

The public interest is best served by denying a preliminary injunction where a likelihood of success on the merits has not been shown. *See, e.g., Abbott Lab'ys v. Andrx Pharms., Inc.*, 452

[8] Solbello also cites to *Noorani Trading Inc. v. Bijani*, 2017 WL 8292437, at *9 (N.D. Ga. May 4, 2017) and *Express Franchise Servs., L.P. v. Impact Outsourcing Sols., Inc.*, 244 F. Supp. 3d 1368, 1375 (N.D. Ga. 2017) in attempt to say that it has no way of controlling the quality of the ShoreShade's products, but both cases are trade dress cases from another court that do not apply here.

F.3d 1331, 1348 (Fed. Cir. 2006) ("As Abbott did not establish a likelihood of success on the merits, we conclude that the public interest is best served by denying the preliminary injunction.").

Furthermore, courts recognize a company's legitimate right to compete, especially at early stages of the litigation. *Avocent Huntsville*, 2018 WL 1411100, at *17 (citing cases). Given the weak showing that Solbello has made on the likelihood of success, the public interest is served by allowing other products to compete in the marketplace. *Illinois Tool Works*, 906 F.2d at 684.[9]

IV. BOND

Solbello only mentions the bond requirement in passing in footnote 4 of its motion, stating that the court should impose a minimal bond. To the extent the Court is inclined to enter a preliminary injunction, ShoreShade requests additional briefing regarding the amount of any bond.

V. CONCLUSION

None of the elements for a preliminary injunction have been established here, particularly given the applicability of absolute intervening rights and ShoreShade's lack of sales since the issue date of the Reissue Patent. The preliminary injunction motion should be denied.

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[9] While Solbello cites to *Davidoff & CIE, S.A. v. PLD Int'l Corp.*, 263 F.3d 1297, 1302 (11th Cir. 2001) and *Ryder Sys., Inc. v. Storage & Moving Servs., Inc.*, No. 0:13-cv-61466, 2013 WL 3873231, at *1 (S.D. Fla. July 25, 2013) in attempt to show that the public interest is served by preventing consumer confusion, these cases relate to trademark infringement and other causes of action under the Lanham Act, making them inapplicable here. Regardless, Solbello cannot show that any confusion is actually tied to any act of patent infringement by ShoreShade.

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Counsel for Defendant ShoreShade LLC

** Pro Hac Vice Application Not Yet Accepted*

ShoreShade LLC Ex. 1020

CERTIFICATE OF SERVICE

I certify that I have completed service of the foregoing document by filing this document with the Court's electronic-filing system.

This the 19th day of November 2025.

/s/ Lucas A. Westby
Lucas A. Westby

ShoreShade LLC Ex. 1020

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF GEORGIA
AUGUSTA DIVISION

SOLBELLO, INC., Plaintiff, v. SHORESHADE, LLC, Defendant.	)	Case No. 1:25-cv-00267-JRH-BKE

DECLARATION OF CAMERON M. SCHULZE

I, Cameron M. Schulze, hereby declare as follows:

1. I am a member of ShoreShade LLC ("ShoreShade").

2. Solbello, Inc. ("Solbello") alleges that ShoreShade's sail products (the "Accused Products") infringe U.S. Pat. No. RE50606 (the "Reissue Patent").

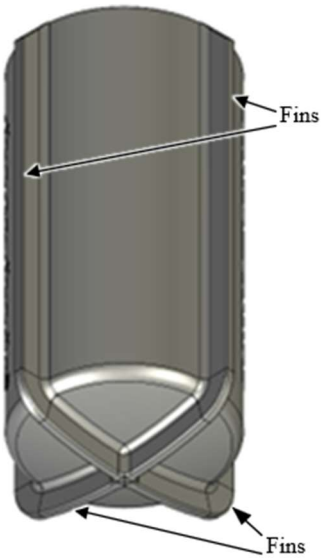
3. A true and correct copy of ShoreShade's website as of September 8, 2025 is reproduced as Attachment 1 to this declaration. This shows that, as of September 8, 2025, the website presented the Accused Products as being sold out. In addition, the functionality allowing customers prior to September 8, 2025 to make a purchase was disabled. As a result, no customer has been able to purchase the accused products since September 8, 2025. The website has continued to present the products as being sold out since at least September 8, 2025, and customers still cannot order the Accused Products.

4. The images presented in the complaint and in the preliminary injunction motion were images of Accused Products from before September 30, 2025.

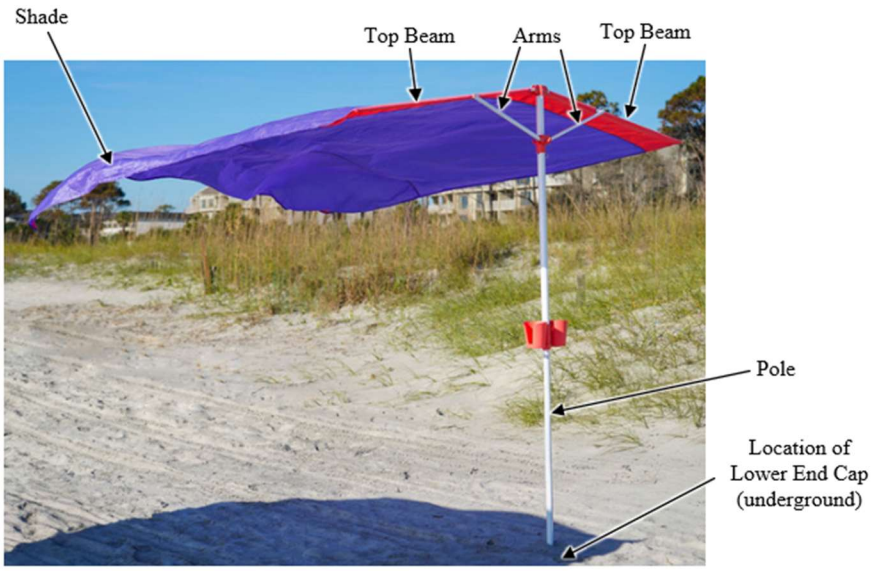
5. While ShoreShade has also sold its products on Amazon in the past, ShoreShade has not sold or offered any products for sale on Amazon since before September 30, 2025. ShoreShade has not sold or offered any products for sale through any other third-party since before September 30, 2025.

6. Since the Issue Date of the Reissue Patent, ShoreShade has distributed less than twenty (20) of the accused products to fulfill warranty obligations and for other reasons. These products were each provided for free, and each of the products that were distributed after the issue date of the Reissue Patent were purchased, made, and received by ShoreShade well before September 30, 2025.

7. All of the Accused Products currently in ShoreShade's inventory were made and received by ShoreShade before September 30, 2025. ShoreShade does have limited remaining inventory of the Accused Products, but this is being maintained to provide a sufficient quantity of product for spare parts and to address warranty issues. None of the Accused Products have been made in the United States or imported into the United States since the issue date of the Reissue Patent.



Lower End Cap



Layout for ShoreShade's Products

8. After the summer selling season, ShoreShade performed an evaluation of its product. As a result of this evaluation, ShoreShade decided, prior to the issue date of the Reissue Patent, to launch a next generation design starting next season. The next generation design will be sold to customers with the lower end cap shown above. An annotated version of a drawing is shown above to illustrate how the next generation product will function. The lower end cap includes fins, and these fins will engage the surrounding sand when the lower end cap is positioned in the sand. The engagement of the fins with the sand will prevent rotation of the lower end cap. The lower end cap will be attached to the pole using a strong adhesive that fixes the lower end cap and the pole together and that effectively prevents removal of the lower end cap once attached. The adhesive is so strong that, for a customer to remove the lower end cap, the customer would be required to saw off the bottom portion of the pole. Additionally, the top beams are attached to the pole to prevent rotation of the top beams relative to the pole. The top beams and arms will be attached to the pole in a similar manner so that they may not freely rotate relative to the pole, thereby preventing rotation of these components relative to the blowing wind.

9. I have reviewed the specification, Claim 44, and drawings of the Reissue Patent. The Reissue Patent discusses the ribs rotating relative to a non-movable mast in several locations. For example, the Reissue Patent states:

a. "The method further includes adjusting the tension adjuster to achieve a desired amount of rotation of the pivot cap, ribs, support arms, slider, and sail relative to the non-movable mast." Reissue Patent at column 3, lines 7–10.

b. "Particularly, the mast remains in a stationary position, while the slider (and attached support arms and ribs) rotate in response to the wind blowing." Reissue Patent at column 7, lines 34–38.

c. "[T]he mast does not rotate in response to wind conditions due to its attachment to the anchor." Reissue Patent at column 9, lines 1–2.

d. "Specifically, when the wind shifts direction, the sail will self-adjust (e.g. the pivot cap, ribs, sail, support arm, and slider rotate about the non-movable mast in response to the wind blowing and changing direction)." Reissue Patent at column 12, lines 39–42.

10. Based on my review of the Reissue Patent, the Reissue Patent never describes a mast that is capable of rotating and never describes an example where rotation of the ribs is accomplished without the ribs rotating relative to the mast. Instead, the specification always states that the mast does not rotate. The pivot cap, the ribs, and support arms are always described as being able to rotate relative to the mast to allow the ribs to rotate to the direction of the blowing wind (subject to how tight the tension adjuster is).

I declare under penalty of perjury that the foregoing is true and correct.

Executed on November 19, 2025

Cameron M. Schulze

ATTACHMENT 1

PageVault

Document title:	ShoreShade Sails - The World's Most Feature-Packed Sunshade
Capture URL:	https://web.archive.org/web/20250908153611/https://shoreshadesails.com/
Page loaded at (UTC):	Wed, 12 Nov 2025 20:38:38 GMT
Capture timestamp (UTC):	Wed, 12 Nov 2025 20:38:39 GMT
Capture tool:	3.15.8
Collection server IP:	54.162.60.39
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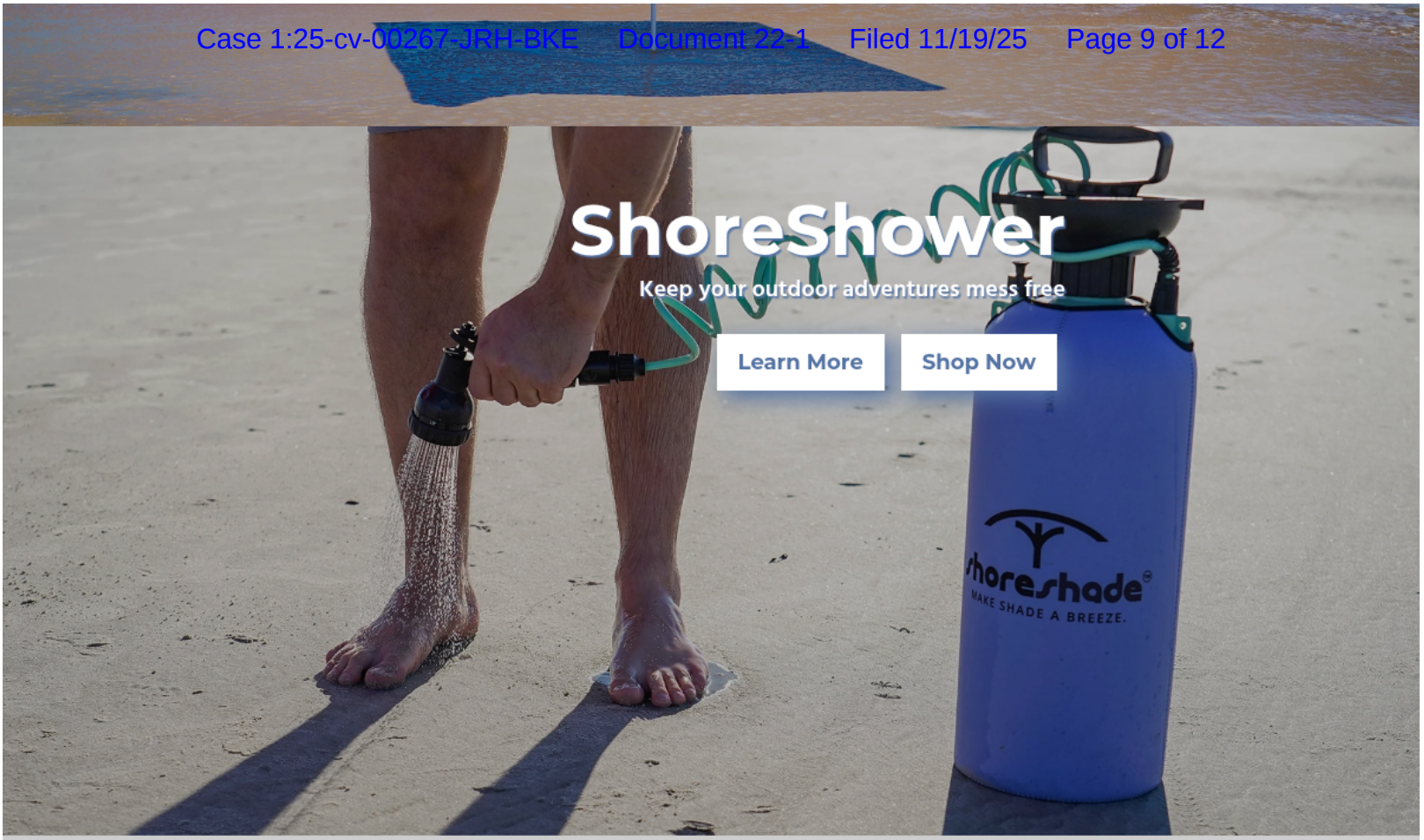

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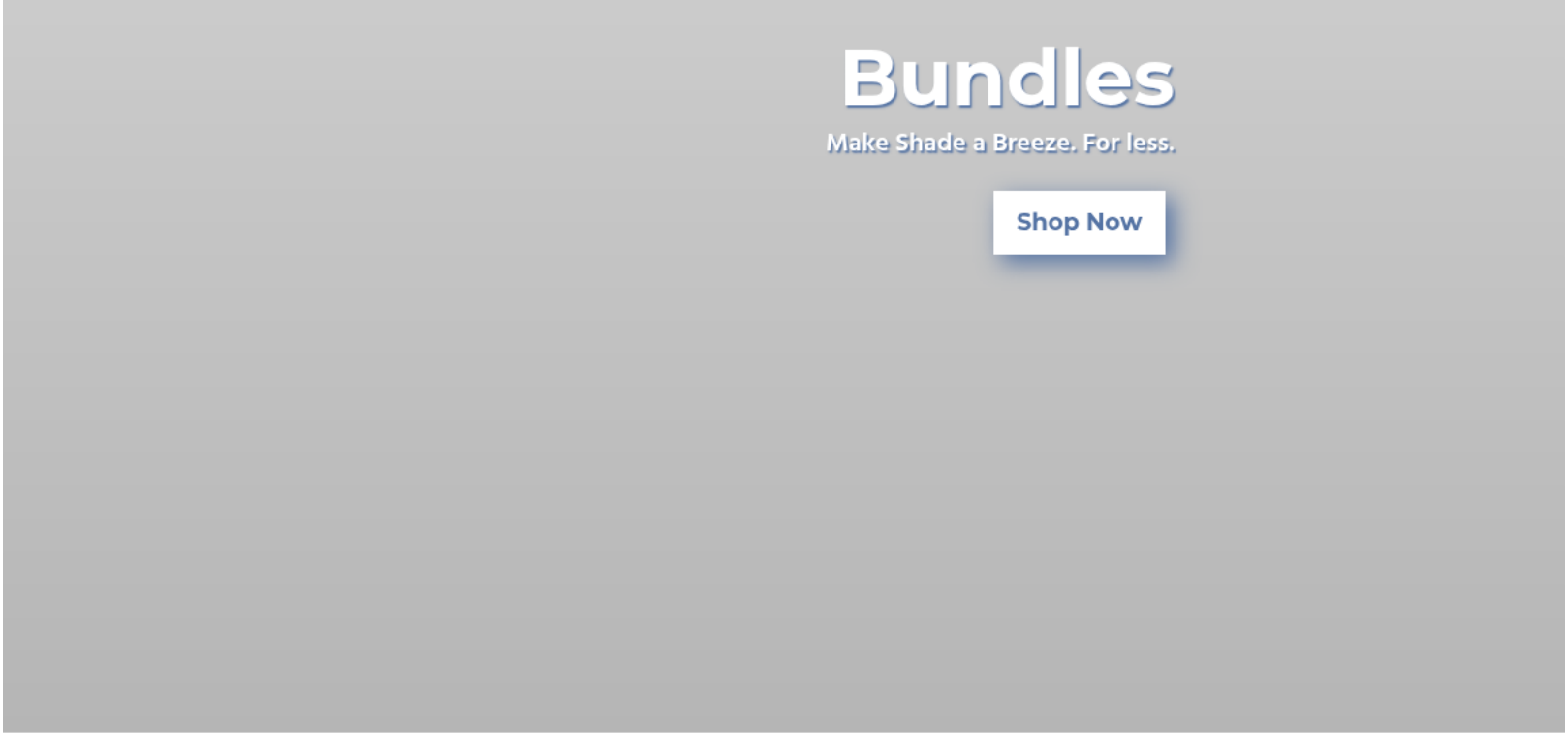

Reviews

★★★★★

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Lesley B

The ShoreShade Difference

At ShoreShade, we provide high-quality, innovative products that are meticulously designed in order to make your beach & outdoor adventures as easy & relaxing as possible. With unmatched features, old-school customer service, and products that are built-to-last, you'll see why thousands are happy members of our ShoreShade Family.

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EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

36829 7590 08/21/2025

SCHWARTZ LAW FIRM, P.C.
6100 FAIRVIEW ROAD
SUITE 1135
CHARLOTTE, NC 28210

EXAMINER	
TILL, TERRENCE R	
ART UNIT	PAPER NUMBER
3993	

DATE MAILED: 08/21/2025

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
18/367,224	09/12/2023	Paul T. James	1500/2US-RE	9298

TITLE OF INVENTION: SELF-ADJUSTING SUN SHADE ASSEMBLY

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	MICRO	$258	$0.00	$0.00	$258	11/21/2025

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 40% the amount of undiscounted fees, and micro entity fees are 20% the amount of undiscounted fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Maintenance fees are due in utility patents issuing on applications filed on or after Dec. 12, 1980. It is patentee's responsibility to ensure timely payment of maintenance fees when due. More information is available at www.uspto.gov/PatentMaintenanceFees.

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Complete and send this form, together with applicable fee(s), by mail or fax, or via the USPTO patent electronic filing system.

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Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

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I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via the USPTO patent electronic filing system or by facsimile to (571) 273-2885, on the date below.

(Typed or printed name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
18/367,224	09/12/2023	Paul T. James	1500/2US-RE	9298

TITLE OF INVENTION: SELF-ADJUSTING SUN SHADE ASSEMBLY

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	MICRO	$258	$0.00	$0.00	$258	11/21/2025

EXAMINER	ART UNIT	CLASS-SUBCLASS
TILL, TERRENCE R	3993	135-098000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

❑ Change of correspondence address (or Change of Correspondence Address form PTO/AIA/122 or PTO/SB/122) attached.

❑ "Fee Address" indication (or "Fee Address" Indication form PTO/AIA/47 or PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list
(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,
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1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ❑ Individual ❑ Corporation or other private group entity ❑ Government

4a. Fees submitted: ❑ Issue Fee ❑ Publication Fee (if required)

4b. Method of Payment: *(Please first reapply any previously paid fee shown above)*

❑ Electronic Payment via the USPTO patent electronic filing system ❑ Enclosed check ❑ Non-electronic payment by credit card (Attach form PTO-2038)

❑ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. _____

5. **Change in Entity Status** (from status indicated above)

❑ Applicant certifying micro entity status. See 37 CFR 1.29

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

❑ Applicant asserting small entity status. See 37 CFR 1.27

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

❑ Applicant changing to regular undiscounted fee status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

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Authorized Signature _____ Date _____

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TILL, TERRENCE R	
ART UNIT	**PAPER NUMBER**
3993	

DATE MAILED: 08/21/2025

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)

A reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. 251. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

ShoreShade LLC Ex. 1020

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013).
https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf

Routine uses of the information in this record may include disclosure to:

1) law enforcement, in the event that the system of records indicates a violation or potential violation of law;
2) a federal, state, local, or international agency, in response to its request;
3) a contractor of the USPTO having need for the information in order to perform a contract;
4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record;
5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record;
6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations;
7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals;
8) another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c));
9) the Office of Personnel Management (OPM) for personnel research purposes; and
10) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

Notice of Allowability	Application No. 18/367,224	Applicant(s) James, Paul T.	
	Examiner TERRENCE R TILL	Art Unit 3993	AIA (First Inventor to File) Status Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☑ This communication is responsive to the supplemental amendment filed 8/13/2025.
   ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

3. ☑ The allowed claim(s) is/are 21,23-41,43,45-48,50-55 and 57 . As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see **http://www.uspto.gov/patents/init_events/pph/index.jsp** or send an inquiry to **PPHfeedback@uspto.gov.**

4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____ .

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____ .

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☑ Notice of References Cited (PTO-892)
2. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____.
3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material _____.
4. ☑ Interview Summary (PTO-413), Paper No./Mail Date. 08152025.
5. ☐ Examiner's Amendment/Comment
6. ☑ Examiner's Statement of Reasons for Allowance
7. ☐ Other _____.

/TERRENCE R TILL/
Reexamination Specialist, Art Unit 3993

ShoreShade LLC Ex. 1020

Notice of Pre-AIA or AIA Status

1. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Reasons for Allowance

2. The following is an examiner's statement of reasons for allowance:

3. With respect to claim 21, the prior art does not teach nor render obvious the claimed combination, particularly a channel sized and shaped to house each rib such that the ribs extend across the edge; at least one support arm with a first end and a second end, wherein the first end of the support arm is attached to a rib and the second end of the support arm is attached to a slider configured to move up and down the mast; and wherein the pivot cap, ribs, slider, and support arms are configured to rotate about the mast in response to blowing of the wind.

4. With respect to claim 35, the prior art does not teach nor render obvious the claimed combination, particularly a sail with a front edge comprising a channel sized and shaped to house each rib such that the ribs extend across the edge; at least one support arm with a first end and a second end, wherein the first end of the support arm is attached to a rib and the second end of the support arm is attached to a slider configured to move up and down the mast; and wherein the sun shade assembly self-adjusts in response to the blowing of the wind.

5. With respect to claim 41, the prior art does not teach nor render obvious the claimed combination, particularly a sail having a proximal edge secured to each of said pivoted ribs, and an unrestrained free edge opposite the proximate edge; whereby said sail is unfolded by lifting said pivot ribs outwardly from said mast from the folded condition into the unfolded condition such that the unrestrained free edge of said sail

unfurls in response to blowing of the wind, and wherein said sail and ribs rotate together to a direction of the blowing wind; and a tension adjuster adapted for adjusting pivot tension of said cap, thereby controlling rotation of said sail and ribs in response to blowing of the wind.

6. With respect to claim 47, the prior art does not teach nor render obvious the claimed combination, particularly a sail having a proximal edge secured to said rib and an unrestrained free edge adapted to unfurl in response to blowing of the wind, and wherein an entire surface area of said sail is unrestrained from the proximal edge to the free edge; and when unfurled, said sail and rib are adapted to rotate together to a direction of the blowing wind.

7. With respect to claim 53, the prior art does not teach nor render obvious the claimed combination, particularly a sail having a proximal edge defining a channel sized and shaped to receive each of said pivoted ribs, and an unrestrained free edge adapted to unfurl in response to blowing of the wind; a slider configured to move up and down said mast, and operatively actuating said pivoted ribs such: that raising said slider on said mast causes said pivoted ribs to open outwardly from a folded condition into an unfolded condition thereby unfolding said sail, such that when unfolded said sail unfurls in response to blowing of the wind and rotates together with said pivoted ribs to a direction of the blowing wind.

8. With respect to claim 54, the prior art does not teach nor render obvious the claimed combination, particularly a sail having a proximal edge secured to each of the pivoted ribs and an unrestrained free edge opposite the proximate edge; that in the unfolded condition the unrestrained free edge of the sail unfurls in response to blowing

of the wind; and when the sail is unfurled, enabling the sail and pivoted ribs to rotate together relative to the mast to a direction of the blowing wind.

9. The closest prior art, to Saiz, does not teach nor render obvious, with any other combination of prior art, the above claimed combinations. Saiz does teach rotation, but this rotation is effected by the mast, and not relative to the mast. See para. [0008]. There would be no reason to modify Saiz to have the sail and pivot ribs (from claim 54) of figure 1 of Saiz to rotate *relative to the mast*, especially since there is no teaching in the prior art of such an arrangement while meeting all the other limitations as well.

10. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

11. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 11,596,211 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

12. Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely appraise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

13. These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

14. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. The US patent to Rizzoti and PCT Publication to Toth (not prior art) show the current state of the art in pivoting shade assemblies.

Telephone Numbers for reexamination inquiries:

Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Future Correspondence

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TERRENCE R TILL whose telephone number is (571)272-1280. The examiner can normally be reached on Monday through Thursday and every other Friday 6:45-4:15 EST.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-9900.

19. Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: https://patentcenter.uspto.gov.

20. Visit https://www.uspto.gov/patents/apply/patent-center for more information about Patent Center and https://www.uspto.gov/patents/docx for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer

Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

All correspondence relating to this reissue proceeding should be directed as follows:

By Patent Center:
https://patentcenter.uspto.gov

By **U.S. Postal Service Mail** to:

Mail Stop Ex Parte Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand to: Customer Service Window
Knox Building
501 Dulany St.
Alexandria, VA 22314

/TERRENCE R TILL/
Reexamination Specialist, Art Unit 3993

Conferees:	/WILLIAM E DONDERO/ and William E. Dondero Reexam Specialist AU 3993	/Patricia L Engle/ Patricia Engle Supervisory Reexam Specialist AU 3993

EXHIBIT C

Jonathan Todd

From: Christopher A. Cosper <CCosper@hullbarrett.com>
Sent: Friday, November 7, 2025 3:23 PM
To: Lisa_Widener@gas.uscourts.gov; Craig Killen
Cc: docket@wardandsmith.com; Joseph A. Schouten; Payton Collier Bullard; Gavin B. Parsons; Mark S. Wigley; Monica A. Talley
Subject: RE: Case 1:25-cv-00267-JRH-BKE Solbello, Inc. v. Shoreshade, LLC

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Use caution responding or clicking links/attachments.
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The password for the zip files is Augusta, if it requires one. Thanks

Chris

From: Christopher A. Cosper
Sent: Friday, November 7, 2025 3:22 PM
To: Lisa_Widener@gas.uscourts.gov; 'craig.killen@nelsonmullins.com' <craig.killen@nelsonmullins.com>
Cc: 'docket@wardandsmith.com' <docket@wardandsmith.com>; Joseph A. Schouten <jas@wardandsmith.com>; Payton Collier Bullard <pcbullard@wardandsmith.com>; Gavin B. Parsons <gbparsons@wardandsmith.com>; Mark S. Wigley <mswigley@wardandsmith.com>; Monica A. Talley <mtalley@hullbarrett.com>
Subject: Case 1:25-cv-00267-JRH-BKE Solbello, Inc. v. Shoreshade, LLC

Hi Lisa:

I hope you are doing well. I am attaching a verified complaint and motion for preliminary injunction filed today in the referenced case. This is an interesting patent case about two nearly identical beach shade products. We are requesting that the Court schedule a preliminary injunction hearing in the next 2-3 weeks. While we are not in beach season, the next month or so is when orders are placed for the manufacture of beach shade products, and so it would be a tremendous assistance to the parties to resolve the preliminary injunction issue before substantial orders are made to overseas manufacturers.

By copy of this email, I am notifying counsel for the Defendant of this request. We are also sending these documents by mail and FedEx today to Defendant's counsel and registered agent, and we are engaging a process server to serve the local registered agent. If the Court requires any additional information from us, please let me know. Thanks

Chris

Christopher A. Cosper, Shareholder
Hull Barrett, PC • 801 Broad Street, 7th Floor • Augusta, Georgia 30901
T: 706-722-4481 • F: 706-722-9779 • CCosper@hullbarrett.com • www.HullBarrett.com

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