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Z-SHADE CO. LTD.

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IN THE UNITED STATES DISTRICT COURT

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FOR THE CENTRAL DISTRICT OF CALIFORNIA

12

SOUTHERN DIVISION

13

CARAVAN CANOPY INT'L, INC.,

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Plaintiff,

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v.

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Z-SHADE CO. LTD., et. al.

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Defendants.

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19

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AND RELATED COUNTERCLAIMS

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Civil Action No.
2:19-cv-06224-PSG-ADSx

**Z-SHADE CO. LTD.'S FINAL
INVALIDITY CONTENTIONS
AND ACCOMPANYING
DOCUMENT PRODUCTION**

Hon. Philip S. Gutierrez

1 Defendant Z-Shade Co. Ltd. (“Defendant” or “Z-Shade”) hereby discloses
2 its final invalidity contentions and accompanying document production pursuant
3 to the Court’s January 27, 2020 Scheduling Order and Standing Patent Rule 4.2
4 with respect to the asserted claims identified by Plaintiff Caravan Canopy Int’l,
5 Inc. (“Plaintiff” or “Caravan”).

6 Caravan has served Z-Shade with its disclosure of asserted claims and
7 infringement contentions that allege infringement of Claims 1-3 (“the Asserted
8 Claims”) of U.S. Patent No. 5,944,040 (“the Asserted Patent”).

9 Z-Shade has prepared its invalidity contentions to the best of its present
10 ability. However, discovery and fact investigation is continuing, and Z-Shade
11 has not completed its own investigation and discovery. In addition, these
12 invalidity contentions are based, in part, on Caravan’s interpretation of the
13 Asserted Claims in its infringement contentions. Accordingly, Z-Shade’s
14 contentions take into account alternative and potentially inconsistent positions as
15 to claim construction and scope advanced by Caravan. Further, by including prior
16 art that would invalidate the Asserted Claims based on Caravan’s apparent claim
17 construction or any other particular claim construction, Z-Shade is not adopting
18 Caravan’s apparent claim construction or admitting to the accuracy of any
19 particular claim construction apparent in Caravan’s infringement contentions.
20 Z-Shade reserves all rights to amend or supplement these invalidity contentions,
21 including if Caravan attempts to modify, supplement, alter, and/or amend its
22 infringement contentions.

23 With respect to disclosures relating to invalidity, Z-Shade’s prior art
24 search, discovery, investigation, and analysis in connection with this lawsuit are
25 continuing and these disclosures are based on information obtained to date.
26 While Z-Shade has been diligent in its efforts to locate prior art to the Asserted
27 Patent, Z-Shade notes that further discovery may reveal additional prior art not
28 located thus far. Accordingly, Z-Shade may identify additional prior art or

1 contentions that will add meaning to and/or increase the relevance of already
2 known prior art or contentions, or possibly lead to additions or changes to these
3 invalidity contentions. To the extent that Z-Shade obtains additional information
4 relevant to these contentions, but without obligating itself to do so, Z-Shade
5 expressly reserves the right to amend, modify, or supplement these contentions.

6 To be clear, Z-Shade expressly reserves the right to modify, amend or
7 supplement these contentions in view of, without limitation: (i) information
8 provided by Caravan concerning its infringement allegations, theories,
9 contentions, or facts supporting them; (ii) information provided by Caravan
10 concerning the priority, conception, and reduction to practice dates for any of the
11 Asserted Claims; (iii) any additional information provided by Caravan; (iv)
12 additional prior art obtained through discovery, including without limitation
13 discovery from Caravan or from third parties; and/or (v) any other basis in law or
14 in fact.

15 In addition to these invalidity contentions and prior art identified herein,
16 Z-Shade hereby incorporates by reference in their entirety and expressly reserves
17 the right to rely upon any invalidity contentions, including any prior art cited
18 therein, and any prior art identified in any exhibit list served in any prior or
19 ongoing actions or proceedings, including any proceeding in front of the United
20 States Patent and Trademark Office (“USPTO”), involving the Asserted Patent.
21 Z-Shade expressly incorporates by reference Walmart Inc.’s Preliminary
22 Invalidity Contentions (ZSHAD0000326-0000478), served on March 16, 2020,
23 in connection with Civil Action No. 2:19-cv-06978-PSG-ADS, also pending in
24 the Central District of California, as well as any final or amended invalidity
25 contentions served by parties in the various actions consolidated with case.
26 Z-Shade also expressly incorporates by reference any prior art and prior art
27 combinations identified or cited in the *inter partes* review proceeding initiated by
28 Walmart Inc. IPB2020-01026 regarding the Asserted Patent. In addition, the

1 identification of exemplary disclosures in the prior art that teach or render
2 obvious a particular claim element should in no way be construed as an admission
3 that the claim element satisfies the requirements of 35 U.S.C. § 112. In those
4 instances where Z-Shade contends that the Asserted Claims are invalid under 35
5 USC § 112, Z-Shade has applied the prior art in view of Caravan's infringement
6 contentions. However, Z-Shade's invalidity contentions do not represent
7 Z-Shade's agreement as to the meaning, definiteness, written description support
8 for, or enablement of any claim contained therein.

9 Based on discovery to date, Z-Shade contends that the Asserted Claims of
10 the Asserted Patent are entitled to a priority date of no earlier than May 23, 1997.

11 **I. PRIOR ART**

12 Z-Shade identifies the following items of prior art that anticipate each
13 asserted claim or render it obvious. Further, Z-Shade identifies and incorporates
14 herein by reference: (1) all prior art references identified during prosecution of
15 the Asserted Patent including the references cited on the face of the Asserted
16 Patent; (2) the admitted prior art references in the Asserted Patent's specification;
17 (3) references cited during prosecution of the Asserted Patent; (4) references cited
18 in any proceeding before the USPTO regarding the Asserted Patent; and (5)
19 references cited in any invalidity contentions submitted in any current or prior
20 action or proceeding involving the Asserted Patent.

21 **A. Patents and Patent Publications**

22 U.S. Patent No. 1,449,894 ("Dial"), which issued on March 27, 1923.

23 U.S. Patent No. 1,502,898 ("Berg"), which issued on July 29, 1924.

24 U.S. Patent No. 4,779,635 ("Lynch"), which issued on October 25, 1988.

25 U.S. Patent No. 5,511,572 ("Carter"), which issued on April 30, 1996.

26 U.S. Patent No. 5,638,853 ("Tsai"), which issued on June 17, 1997.

27 U.S. Patent No. 5,701,923 ("Losi"), which issued on December 30, 1997.

1 German Patent No. DE29703246U1 (“Tsai 2”), which published on April
2 24, 1997.

3 Japanese Unexamined Utility Model Application Publication No.
4 H1-61370 (“Yang”), which published on April 19, 1989.

5 The prior art references may disclose or otherwise include the elements of
6 the Asserted Claims of the Asserted Patent, either explicitly, inherently, or via an
7 obvious modification or combination of the prior art references, and may also be
8 relied upon to show the state of the art during the relevant timeframes.

9 Additionally, to the extent they qualify as prior art, Z-Shade reserves the
10 right to rely upon: (1) foreign counterparts (patents and/or published patent
11 applications) of the U.S. patents and/or publications identified in these
12 contentions; (2) U.S. counterparts (patents and/or published patent applications)
13 of foreign patents and/or foreign patent publications identified in these
14 contentions; (3) prior art activities discussed in, or related to, patents and/or
15 publications identified in these contentions; (4) activities or other work
16 performed by the named inventor(s), author(s), or assignee(s) of the patents
17 and/or publications identified in these contentions; and (5) U.S. and foreign
18 patents and published patent applications corresponding to products and
19 publications identified in these contentions.

20 **B. Sales or Offers for Sale**

21 Upon information and belief, there may have been one or more sales or
22 offers for sale, of a product embodying the alleged inventions, more than one year
23 before the priority date of the Asserted Patent. For example, upon information
24 and belief, a company called Variflex, Inc. sold or offered for sale instant
25 canopies embodying the alleged inventions more than one year before the priority
26 date of the Asserted Patent. *See, e.g.*, ZSHAD0000143-0000146.

27 In addition, Z-Shade identifies the sale and public use of an E-AN canopy
28 product as prior art under 35 U.S.C. § 102(b) because it was on sale and publicly

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