

31663274 v1

4. Defendant is a limited liability company organized under the laws of the State of Kansas with its principal place of business located at 9604 West 121st Terrace, Overland Park, Kansas 66213.

5. On information and belief, Defendant is comprised of two members, Chrisanthia Brown ("Brown") and Billie Jean Smith ("Smith"), alleged co-investors of the patents at issue in this action.

JURISDICTION AND VENUE

6. This action arises under the Declaratory Judgment Action, 28 U.S.C. §§ 2201 and 2202, and the patent laws of the United States, 35 U.S.C. §§ 1 et seq.

7. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

8. This Court has personal jurisdiction over Defendant because Defendant has sent multiple cease and desist letters to Plaintiff in this forum, has attempted to negotiate a license with Plaintiff, and, on information and belief, has directed its business, licensing, and enforcement activities at this judicial district. Further, products licensed by Defendant are offered for sale and sold in this judicial district (including by Plaintiff).

9. Venue is proper in this district under 28 U.S.C. § 1391(b) because Defendant is subject to personal jurisdiction in this judicial district, has directed its business, licensing and enforcement activities at this judicial district, and because a substantial part of the events giving rise to the claim occurred in this judicial district.

FACTUAL BACKGROUND

10. United States Patent Number 6,598,234 ("the '234 Patent"), entitled "Face Guard," names Brown and Smith as co-inventors and states an issue date of July 29, 2003. Defendant

purports to be the assignee of the '234 patent. A true and correct copy of the '234 Patent is attached hereto as Exhibit "A."

11. United States Patent Number 6,499,139 ("the '139 Patent"), entitled "Face Guard," also names Brown and Smith as co-inventors and states an issue date of December 31, 2002. Defendant purports to be the assignee of the '139 patent. A true and correct copy of the '139 Patent is attached hereto as Exhibit "B."

12. Plaintiff is informed and believes that 13-31 has no active business operations and, instead, exists for solely for the purpose of owning and licensing the Patents-in-Suit.

13. Plaintiff is informed and believes that 13-31 has licensed the Patents-in-Suit to at least one particular business entity engaged in the manufacture and distribution of sporting equipment. That entity, which shall be referred to herein as "13-31's Licensee," is licensed to do business in the State of Alabama and, in fact, does business with Plaintiff. Plaintiff is informed and believes that 13-31's Licensee offers for sale or sells products, including products purporting to embody the Patents-in-Suit, in this judicial district.

14. Plaintiff sells athletic apparel, shoes, and sporting goods and equipment directly to the public through a network of brick-and-mortar retail stores and an e-commerce website. In its stores and online, Plaintiff sells "fielder's masks" manufactured by entities other than 13-31's Licensee. However, Plaintiff also offers for sale, sells, and/or has sold fielder's masks manufactured by 13-31's Licensee. Plaintiff has offered for sale and/or sold fielder's masks (including licensed and non-licensed masks) throughout the State of Alabama, including in this judicial district.

15. Images of products offered for sale or sold by Plaintiff are displayed below.



16. The above images reflect fielder's masks manufactured by third parties and offered for sale and/or sold by Plaintiff. The top left fielder's mask in the preceding paragraph shall be referred to as the "Accused Red Face Mask." The top right image in the preceding paragraph shall be referred to as the "Accused White Face Mask." The bottom image in the preceding paragraph shall be referred to as the "Accused Black Face Mask." The foregoing products will be referred to collectively as "the Accused Products."

17. On March 22, 2018, one of Plaintiff's in-house attorneys, Tamula Yelling ("Yelling"), received an email from an attorney for Defendant. Defendant's attorney stated that Defendant had recently filed a lawsuit against one of Plaintiff's competitors and that he would like to discuss the lawsuit at Yelling's earliest convenience. Defendant's attorney attached a copy of a complaint filed on March 7, 2018 against Dick's Sporting Goods, Inc. *See* March 22, 2018

Email from Austin Hansley to Tamula Yelling (Exhibit "C"). Yelling responded that she needed an opportunity to speak to Plaintiff's general counsel before she could have any further discussions. *See* March 28, 2018 Email from Tamula Yelling to Austin Hansley (Exhibit "D").

18. On the same day, Yelling received a phone call from another one of Defendant's attorneys. That attorney stated Defendant intended to file suit against Plaintiff for patent infringement due to Defendant's belief that certain fielder's masks offered for sale or sold by Plaintiff (such as those pictured above) infringed upon the Patents-in-Suit. However, the attorney indicated to Yelling that Defendant wanted to explore whether a pre-suit settlement was possible prior to filing the suit.

19. Defendant has, in fact, filed three infringement lawsuits relating to the Patents-in-Suit, styled as follows: *13-31 Sport, LLC v. Academy Ltd. d/b/a Academy Sports and Outdoors*, 4:18-cv-00159-ALM-KPJ, In the United States District Court for the Eastern District of Texas, Sherman Division; *13-31 Sport, LLC v. Dick's Sporting Goods, Inc.*, 4:18-cv-00157-ALM-KPJ, In the United States District Court for the Eastern District of Texas, Sherman Division; *13-31 Sport, LLC v. Walmart, Inc.*, 4:18-cv-00159-ALM-KPJ, In the United States District Court for the Eastern District of Texas, Sherman Division.

20. The defendants in the foregoing cases are citizens of Texas (Academy, Ltd.), Delaware/Arkansas (Walmart, Inc.), and Delaware/Pennsylvania (Dick's Sporting Goods, Inc.). Thus, Plaintiff is informed and believes that Defendant polices and enforces the Patents-in-Suit nationwide, including in the State of Alabama.

21. Subsequently, on April 6th, Defendant's attorney sent another email to Yelling, stating:

We hope to hear from you by next Wednesday. If for some reason we haven't, then we will assume that you have looked at the material and made the determination that there is no reason to have a discussion.

See Ex. D.

22. On April 10, 2018, Yelling had a telephone conversation with Defendant's attorney wherein Defendant's attorney offered to enter into a license agreement with Plaintiff at a rate that purported to compensate Defendant for alleged past infringements and future sales of non-licensed face masks.

23. Subsequently, Yelling had another conversation with Defendant's attorney wherein he proposed settlement options. One option involved payment of set amount and a license agreement for sales of all non-licensed masks until the Patents-in-Suit expire. The second involved a lump sum payment.

24. During the conversation, Yelling asked for a week to respond to Defendant's demand and Defendant's attorney stated he did not know if Defendant could wait that long because Defendant's lawsuit against Plaintiff was ready to be filed.

25. On April 27th, Yelling asked Defendant's counsel if a call could be scheduled to discuss Defendant's allegations with Plaintiff's general counsel. The call was scheduled for May 10th. *See* Email Exchanges between Tamula Yelling to Brian Took (Exhibit "E").

26. In the meantime, on April 30th and May 3rd, Defendant's attorney sent Yelling proposed "settlement agreements," one of which included a licensing component with a proposed royalty rate. The "settlement agreements" include a recital that the Accused Products "infringe at least one of [the '139 patent and the '234 patent]."

27. Defendant's attorney and Plaintiff's in-house counsel had a follow up conversation on May 10, 2018, during which Plaintiff's counsel agreed to gather some sales information relating to the Accused Products. The parties' counsel spoke again on Tuesday, May 23rd, and

Plaintiff's counsel shared some of the sales information it had gathered. Defendant's counsel expressed doubt about the quantity of sales reported by Plaintiff during the call, but followed up with another settlement demand after the phone conference. When communicating the latest settlement demand, Defendant's counsel informed Plaintiff's in-house counsel that, if Plaintiff did not accept the offer by Friday, May 25th, Defendant would file a lawsuit against Plaintiff for patent infringement.

28. Based on the foregoing, a justiciable controversy exists between Plaintiff and Defendant because Defendant alleges that Plaintiff is infringing or has infringed the Patents-In-Suit and Plaintiff denies any infringement whatsoever. Plaintiff believes that it is at threat of an imminent patent infringement lawsuit based on Defendant's counsel's statements and the existence of the other three lawsuits against retailers.

29. Absent a declaration of non-infringement Defendant will continue to wrongfully allege that Plaintiff infringes the Patents-In-Suit, and thereby cause Plaintiff irreparable injury and damage.

COUNT I
(Declaratory Judgment of Non-Infringement of the '139 Patent)

30. The allegations of paragraphs 1-28 are repeated and re-alleged as if set forth fully herein.

31. As alleged in the preceding paragraphs, there exists a controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment of non-infringement.

32. A judicial declaration is necessary and appropriate so that Plaintiff may ascertain its rights regarding the '139 Patent.

33. Plaintiff does not infringe, and has not committed any acts which would give rise to liability for infringement of, any properly construed, valid and enforceable claims of the '139 Patent. More specifically, Plaintiff does not infringe any claim of the '139 patent.

The Accused Red Face Mask

34. The Accused Red Face Mask (shown below) does not infringe any claim of the '139 Patent because it does not contain each and every element recited in any claim of the '139 Patent.



35. For example, with respect to independent claim 1 of the '139 Patent, the Accused Red Face Mask does not include "a plurality of risers interconnecting the crossbars . . . said risers being free of padding." The Accused Red Face Mask also does not include "a chin bar extending below the chin of the player when the guard is donned," or "a stretchable positioning strap and first and second adjustable securing straps." In addition, the Accused Red Face Mask is designed to protect against a softball, and does not include "an open framework configured to prevent a baseball from contacting the player's face when the guard is donned."

36. With respect to independent claim 7 of the '139 Patent, the Accused Red Face Mask does not include "an additional adjustable securing strap," which is in addition to the "securing strap" previously recited in claim 7 of the '139 Patent. The Accused Red Face Mask also does not include "a chin bar extending below the chin of the player when the guard is

donned," or a "chin pad being integrally formed with said chin guard." In addition, the Accused Red Face Mask is designed to protect against a softball, and does not include "an open framework configured to prevent a baseball from contacting the player's face when the guard is donned."

37. With respect to independent claim 10 of the '139 Patent, the Accused Red Face Mask does not include "a second securing strap being adjustable . . . [and] configured to secure the guard on the player's face when the guard is donned so that movement of the guard relative to the player's face in a second direction is substantially prevented wherein the first and second directions are generally perpendicular to one another." In addition, the Accused Red Face Mask is designed to protect against a softball, and does not include "an open framework configured to prevent a baseball from contacting the player's face when the guard is donned."

38. Because the Accused Red Face Mask does not include each and every element of any of the independent claims of the '139 Patent, the Accused Red Face Mask does not infringe any claims of the '139 Patent.

The Accused White Face Mask

39. The Accused White Face Mask (shown below) does not infringe any claim of the '139 Patent because it does not contain each and every element recited in any claim of the '139 Patent.



40. For example, with respect to independent claim 1 of the '139 Patent, the Accused White Face Mask does not include "plurality of straps including . . . first and second adjustable securing straps." The Accused White Face Mask also does not include "a chin bar extending below the chin of the player when the guard is donned."

41. With respect to independent claim 7 of the '139 Patent, the Accused White Face Mask does not include "an additional adjustable securing strap," which is in addition to the "securing strap" previously recited in claim 7 of the '139 Patent. The Accused White Face Mask also does not include "a chin bar extending below the chin of the player when the guard is donned," or a "chin pad being integrally formed with said chin guard."

42. With respect to independent claim 10 of the '139 Patent, the Accused White Face Mask does not include "a second securing strap being adjustable . . . [and] configured to secure the guard on the player's face when the guard is donned so that movement of the guard relative to the player's face in a second direction is substantially prevented wherein the first and second directions are generally perpendicular to one another."

43. Because the Accused White Face Mask does not include each and every element of any of the independent claims of the '139 Patent, the Accused White Face Mask does not infringe any claims of the '139 Patent.

The Accused Black Face Mask

44. The Accused Black Face Mask (shown below) does not infringe any claim of the '139 Patent because it does not contain each and every element of recited in any claim of the '139 Patent.



45. For example, with respect to independent claim 1 of the '139 Patent, the Accused Black Face Mask does not include "plurality of straps including . . . first and second adjustable securing straps." The Accused Black Face Mask also does not include "a chin bar extending below the chin of the player when the guard is donned."

46. With respect to independent claim 7 of the '139 Patent, the Accused Black Face Mask does not include "an additional adjustable securing strap," which is in addition to the "securing strap" previously recited in claim 7 of the '139 Patent. The Accused White Face Mask also does not include "a chin bar extending below the chin of the player when the guard is donned," or a "chin pad being integrally formed with said chin guard."

47. With respect to independent claim 10 of the '139 Patent, the Accused Black Face Mask does not include "a second securing strap being adjustable . . . [and] configured to secure the guard on the player's face when the guard is donned so that movement of the guard relative to the player's face in a second direction is substantially prevented wherein the first and second directions are generally perpendicular to one another."

48. Because the Accused Black Face Mask does not include each and every element of any of the independent claims of the '139 Patent, the Accused Black Face Mask does not infringe any claims of the '139 Patent.

49. Because the Accused Products do not contain at least the claimed features identified above, Plaintiff is entitled to a declaratory judgment that Plaintiff has not infringed and does not infringe, either directly or indirectly, any valid and enforceable claim of the '139 Patent.

COUNT II
(Declaratory Judgment of Non-Infringement of the '234 Patent)

50. The allegations of paragraphs 1-48 are repeated and re-alleged as if set forth fully herein.

51. As alleged in the preceding paragraphs, there exists a controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment of non-infringement.

52. A judicial declaration is necessary and appropriate so that Plaintiff may ascertain its rights regarding the '234 Patent.

53. Plaintiff does not infringe, and has not committed any acts which would give rise to liability for infringement of, any properly construed, valid and enforceable claims of the '234 Patent. More specifically, Plaintiff does not infringe any claim of the '234 patent.

The Accused Red Face Mask

54. In particular, the Accused Red Face Mask (shown above) does not infringe any claim of the '234 Patent because it does not contain each and every element of recited in any claim of the '234 Patent.

55. For example, with respect to independent claim 1 of the '234 Patent, the Accused Red Face Mask does not include "a plurality of risers interconnecting the crossbars . . . said risers being free of padding." The Accused Red Face Mask also does not include "a securing strap being coupled relative to the chin pad." In addition, the Accused Red Face Mask is designed to protect against a softball, and does not include "an open framework configured to prevent a baseball from contacting the player's face when the guard is donned."

56. With respect to independent claim 11 of the '234 Patent, the Accused Red Face Mask does not include "an additional securing strap being coupled to the chin guard" or "a chin bar extending below the chin of the player when the guard is donned." The Accused Red Face Mask also does not include a "chin pad being integrally formed with said chin guard." In addition, the Accused Red Face Mask is designed to protect against a softball, and does not include "an open framework configured to prevent a baseball from contacting the player's face when the guard is donned."

57. With respect to independent claim 13 of the '234 Patent, Plaintiff does not perform any of the claimed method steps of "positioning an open framework on the player's face . . .", "spacing the framework from the player's face . . .", or "securing the framework to the player's face . . ." using the Accused Red Face Mask. In addition, neither Plaintiff nor its customers perform the step "coupling at least one chin strap relative to the padding adjacent the second point of contact" using the Accused Red Face Mask because the Accused Red Face Mask does not include the recited "chin strap." In addition, the Accused Red Face Mask is designed to protect against a softball, and therefore Plaintiff does not perform the step of "securing the framework to the player's face so that impact forces of a baseball engaging the framework are substantially limited to the first and second points of contact."

58. Because the Accused Red Face Mask does not include each and every element of independent claims 1 or 11, and neither Plaintiff nor its customers perform all of the recited steps of independent claim 13, Plaintiff does not infringe any claims of the '234 Patent.

The Accused White Face Mask

59. The Accused White Face Mask (shown above) does not infringe any claim of the '234 Patent because it does not contain each and every element of recited in any claim of the '234 Patent.

60. For example, with respect to independent claim 1 of the '234 Patent, the Accused White Face Mask does not include "a securing strap being coupled relative to the chin pad."

61. With respect to independent claim 11 of the '234 Patent, the Accused White Face Mask does not include "an additional securing strap being coupled to the chin guard" or "a chin bar extending below the chin of the player when the guard is donned." The Accused White Face Mask also does not include a "chin pad being integrally formed with said chin guard."

62. With respect to independent claim 13 of the '234 Patent, Plaintiff does not perform any of the claimed method steps of "positioning an open framework on the player's face . . .", "spacing the framework from the player's face . . .", or "securing the framework to the player's face . . ." using the Accused White Face Mask. In addition, neither Plaintiff nor its customers perform the step "coupling at least one chin strap relative to the padding adjacent the second point of contact" using the Accused White Face Mask because the Accused White Face Mask does not include the recited "chin strap."

63. Because the Accused White Face Mask does not include each and every element of independent claims 1 or 11, and neither Plaintiff nor its customers perform all of the recited steps of independent claim 13, Plaintiff does not infringe any claims of the '234 Patent.

The Accused Black Face Mask

64. The Accused Black Face Mask (shown above) does not infringe any claim of the '234 Patent because it does not contain each and every element of recited in any claim of the '234 Patent.

65. For example, with respect to independent claim 1 of the '234 Patent, the Accused Black Face Mask does not include "a securing strap being coupled relative to the chin pad."

66. With respect to independent claim 11 of the '234 Patent, the Accused Black Face Mask does not include "an additional securing strap being coupled to the chin guard" or "a chin

bar extending below the chin of the player when the guard is donned." The Accused Black Face Mask also does not include a "chin pad being integrally formed with said chin guard."

67. With respect to independent claim 13 of the '234 Patent, Plaintiff does not perform any of the claimed method steps of "positioning an open framework on the player's face . . .", "spacing the framework from the player's face . . .", or "securing the framework to the player's face . . ." using the Accused Black Face Mask. In addition, neither Plaintiff nor its customers perform the step "coupling at least one chin strap relative to the padding adjacent the second point of contact" using the Accused Black Face Mask because the Accused Black Face Mask does not include the recited "chin strap."

68. Because the Accused Black Face Mask does not include each and every element of independent claims 1 or 11, and neither Plaintiff nor its customers perform all of the recited steps of independent claim 13, Plaintiff does not infringe any claims of the '234 Patent.

69. Because the Accused Products do not contain at least the claimed features identified above, Plaintiff is entitled to a declaratory judgment that Plaintiff has not infringed and does not infringe, either directly or indirectly, any valid and enforceable claim of the '234 Patent.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that the Court enter judgment:

a) Adjudging that Plaintiff has not infringed and is not infringing, either directly or indirectly, any valid and enforceable claim of any of the Patents-In-Suit, in violation of 35 U.S.C. § 271;

b) Restraining and enjoining Defendant and each of its officers, directors, agents, counsel, servants, employees and all of persons in active concert or participation with any of them, from alleging, representing or otherwise stating that Plaintiff infringes any claims of any of the Patents-In-Suit or from instituting or initiating any action or proceeding alleging infringement of any claims of any of the Patents-In-Suit against Plaintiff or any customers, manufacturers, users, importers, or sellers of Plaintiff's products;

- c) Declaring Plaintiff as the prevailing party and this case as exceptional, and awarding Plaintiff its reasonable attorneys' fees, pursuant to 35 U.S.C. § 285;
- d) That Defendant be ordered to pay all fees, expenses and costs associated with this action; and,
- e) Awarding such other, further, and different relief to which Plaintiff may be entitled.

**PLAINTIFF DEMANDS TRIAL BY STRUCK
JURY ON ALL CLAIMS SO TRIABLE.**

Respectfully Submitted,

s/ Ellen T. Mathews

Ellen T. Mathews

Burr & Forman, LLP
420 20th Street N
Suite 3400
Birmingham, Alabama 35203
Tel: (205) 458-5410
Fax: (205) 714-6897
emathews@burr.com