

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

SAS GROUP, INC.,)	
)	
Plaintiff,)	Civil Action No.: 22-cv-1065
)	
v.)	COMPLAINT FOR
)	DECLARATORY JUDGMENT
SOLO BRANDS, LLC, (fka SOLO DTC BRANDS, LLC), (fka FRONTLINE ADVANCE, LLC), (dba SOLO STOVE),)	
)	
Defendant.)	JURY TRIAL DEMAND
)	

COMPLAINT

Plaintiff, SAS Group, LLC. ("SAS" or "Plaintiff"), by and through its counsel, for its Complaint against Defendant, Solo Brands, LLC, (fka Solo DTC Brands, LLC), (fka Frontline Advance, LLC), (dba Solo Stove) ("Solo" or "Defendant") alleges as follows:

NATURE OF THE ACTION

1. This action is an action for declaratory judgment of non-infringement, invalidity and unenforceability of U.S. Patent No. D923,163, entitled "Fire Pit" ("the D163 patent"), non-infringement of U.S. Patent No. D914,858, entitled "Bonfire Pit Stand" ("the D858 patent"), non-infringement of purported Solo trade dress and that any Solo trade dress is functional, not distinctive, and therefore not subject to protection. The D163 and D858 patents list Jeffery Jan as inventor. On information and belief, the D163 and D858 patents are both currently assigned to Solo DTC Brands, LLC. The D163 and D858 patents are attached as **Exhibits 1 and 2**, respectively.

2. Counsel on behalf of Solo has sent cease and desist letters to SAS and to at least three retailers who agreed to market and sell SAS' duraflame® Fire Pit product and associated fire pit stand alleging infringement of the D163 and D858 patents, and some unspecified trade dress associated with Solo's fire pit products. Based on Solo's infringement allegations, SAS seeks a declaratory judgment that its duraflame® Fire Pit and associated fire pit stand do not infringe the D163 and D858 patents, respectively. SAS also seeks a declaratory judgment that the D163 patent is invalid for failing to comply with the requirements of 35 U.S.C. § 100 *et seq.*, and is also unenforceable pursuant to 37 C.F.R. § 1.56. Additionally, SAS seeks a declaratory judgment that its duraflame® Fire Pit and associated fire pit stand do not infringe any purported trade dress associated with Solo's fire pit products. Finally, SAS seeks a declaratory judgment that any purported trade dress associated with Solo's fire pit products is functional in nature, not distinctive, and therefore not protectable.

3. As detailed below, this action arises out of a substantial, immediate and real controversy based on repeated threats and allegations Solo has made against SAS and various retailers that the marketing and sale of SAS' duraflame® Fire Pit and associated fire pit stand infringes Solo's D163 and D858 patents as well as some unspecified trade dress associated with Solo's fire pit products.

THE PARTIES

4. SAS Group, Inc. is a New York corporation with its principal place of business located at 220 White Plains Road, Tarrytown, New York 10591.

5. SAS is a marketing company that locates, creates, designs and markets innovative products, and currently has ten (10) employees. SAS' products encompass a broad range of general categories, including houseware and general merchandise, lawn and garden, automotive,

health and beauty aids, sports and fishing, crafts and toys. SAS' products are marketed and sold via television commercials, a product's individual website, through various retail outlets, including CVS, Bed Bath & Beyond, Target, Walmart, Home Depot and True Value Hardware, and/or listings on amazon.com.

6. On information and belief, Defendant Solo Brands, LLC, (fka Solo Brands DTC, LLC), (fka Frontline Advance, LLC), (dba Solo Stove) has corporate offices located at 1001 Mustang Drive, Grapevine, Texas 76051.

7. On information and belief, in 2011 Jeffery Jan was one of the founders of Solo.

8. On information and belief, Solo owns, controls, maintains and/or operates the interactive website, www.solobrand.com, and through this website regularly does and/or transacts business in this Judicial District and throughout New York State by marketing, distributing and selling Solo fire pit and camp stove products and accessories directly to residents of this Judicial District and New York State.

9. On information and belief, Solo also regularly does and/or transacts business in this Judicial District and throughout New York State by marketing, distributing and selling its fire pit and camp stove products and accessories through various agents and authorized Solo Dealers located in this Judicial District and throughout New York State. On information and belief, a listing of authorized Solo Dealers located in this Judicial District and New York State can be accessed at www.solostove.com/dealer-locator/.

JURISDICTION AND VENUE

10. Plaintiff asserts causes of action arising under the federal Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202, the Patent Act, 35 U.S.C. §§ 100 *et seq.*, and the Trademark Act, 15

U.S.C. §§ 1051 *et seq.* This Court has subject matter jurisdiction over the action pursuant to 28 U.S.C. §§ 1331, 1338(a).

11. This Court has personal jurisdiction over Solo because, on information and belief, Solo regularly solicits and transacts business, and supplies goods in this Judicial District and throughout New York State, by marketing, distributing and selling Solo fire pit and camp stove products and accessories to residents of this Judicial District and New York State through various agents and authorized Solo Dealers located in this Judicial District. This Court also has personal jurisdiction over Solo because, on information and belief, Solo owns, controls, maintains and/or operates an interactive website, www.solobrand.com, through which residents of this Judicial District and New York State can purchase Solo fire pit and camp stove products and accessories directly from Solo. Consequently, this Court has personal jurisdiction over Solo pursuant to NY CPLR §§ 301, 302.

12. Venue is proper in this Judicial District pursuant to 28 U.S.C. §§ 1391.

13. An actual case of controversy exists giving SAS standing under Article III of the United States Constitution to file this declaratory judgment action pursuant to 28 U.S.C. §§ 2201, 2202. Specifically, Solo, through its outside counsel, has sent letters to SAS threatening legal action if SAS continues to market, distribute and sell SAS' duraflame® Fire Pit and associated fire pit stand. Solo, through its outside counsel, has also sent cease and desist letters to at least three (3) retailers threatening each with legal action if they market and sell SAS' duraflame® Fire Pit and associated fire pit stand. A declaration by this Court will finalize the controversy and offer relief from uncertainty, and help avoid the accrual of potential damages and additional litigation.

FACTUAL BACKGROUND

14. Beginning in 2021, before the D163 patent application was publically accessible or the D163 patent issued, SAS began efforts to develop, manufacture and market a low smoke stainless steel fire pit product.

15. As part of its efforts to develop and market a low smoke stainless steel fire pit product, SAS secured a trademark license from Duraflame, Inc.

16. Based on SAS' efforts, the duraflame® Fire Pit was designed. In pertinent part, SAS' duraflame® Fire Pit comprises:

(a) a double walled stainless cylindrical fire pit;

(b) square air intake openings spaced equidistantly along the outside circumference near the bottom of the fire pit;

(c) smaller square exhaust openings spaced equidistantly near the top of the inner portion of the fire pit;

(d) a removable dome-shaped grate with square openings arranged in a linear pattern to support combustible biomass (*e.g.*, twigs, sticks, branches, logs), the openings allowing air flow beneath the grate to promote more efficient combustion;

(e) a handle affixed to the center of the dome-shaped grate to aid in the grate's removal;

(f) a removable ash catch-pan located beneath the grate;

(g) a flat surface located at the top of the fire pit which is disposed inwardly and slightly toward the fire pit's center to allow for secure positioning of a fire ring;

(h) a removable fire ring which overlaps the flat surface at the top side of the fire pit and which has a downward facing flange which fits over and around the outer cylindrical wall to secure the fire ring in position;

(i) a flat fire pit base configured with a cylindrical rim to position the rim on the stand associated with the duraflame® Fire Pit; and

(j) the “duraflame®” logo prominently embossed on outside of the stainless fire pit.

An exploded image of the duraflame® Fire Pit, with the internal exhaust openings slightly visible, is reproduced below:



17. The stand associated with the duraflame® Fire Pit has three straight arms with notches that grab the outer cylindrical wall of the fire pit base. The arms attach to a triangular center that elevates and further supports the fire pit, and provides additional insulation to prevent scorching of surface beneath the fire pit.

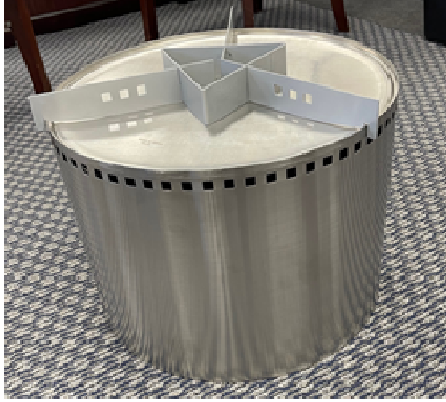
18. During combustion, air is drawn through the square air intake openings along the circumference near the bottom of the fire pit and directed into the fire pit beneath the grate holding the biomass fuel source promoting primary combustion. A portion of the air that is drawn into the square intake openings is directed between the doubled-walled fire pit, heated and

then discharged through the smaller internal square exhaust openings spaced equidistantly near the top of the fire pit. This heated air helps ignite fuel gases that were incompletely burned during primary combustion. This “secondary combustion” results in more efficient combustion, a hotter fire and reduced smoke formation.

19. The removable dome-shaped grate of the duraflame® Fire Pit is designed to permit air to be drawn directly below the biomass fuel source allowing for faster, hotter and more efficient combustion. The grate openings also allows any ash resulting from combustion to fall into the removable ash catch-pan located below. The handle permits the grate to be more easily removed allowing access to the catch-pan and removal of any ash that accumulates during combustion of the biomass fuel source.

20. The fire ring of the duraflame® Fire Pit is designed to be securely positioned at the top of the fire pit by overlapping the side the flat surface at the top of the fire pit. The fire ring comprises a downward facing cylindrical flange that fits over and around the outer cylindrical wall of the fire pit. The top portion of the fire ring extends inwardly and is angled to direct the heated air discharged from the internal exhaust openings into the center of the fire pit to increase secondary combustion and minimize the formation of smoke. The fire ring also acts as a windscreen.

21. The fire pit stand associated with the duraflame® Fire Pit comprises three straight arms with notches at the end of each arm that fit into the cylindrical rim of the fire pit base. The arms connect to a triangular center that further supports the fire pit and provides insulation to avoid scorching of surface beneath the fire pit. Photographs of the stand associated with the duraflame® Fire Pit and the stand positioned on the fire pit are reproduced below:



22. A number of retailers, including The Home Depot, Inc. (“Home Depot”), the True Value Company (“True Value”) and Target Corporation (“Target”) have agreed to market and sell SAS’ duraflame® Fire Pit and associated fire pit stand.

THE D163 PATENT

23. On information and belief, the D163 patent, entitled “Fire Pit,” was filed on February 2, 2017 and issued on June 22, 2021.

24. The D163 patent claims protection over the “ornamental design for a fire pit.”

25. The claims of the D163 patent are limited to the precise figures of the patent which are reproduced below:

FIG. 1

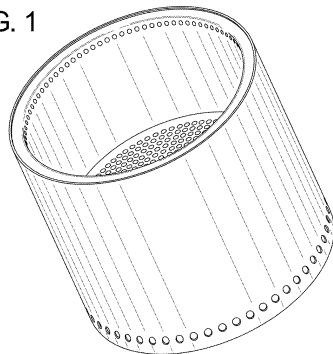


FIG. 2

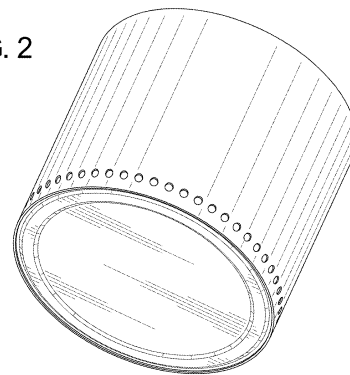


FIG. 3

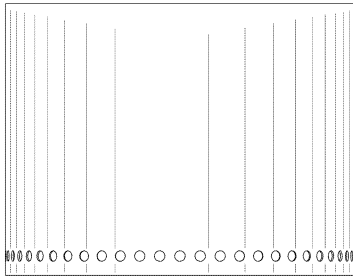


FIG. 4

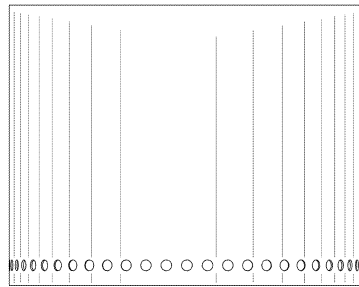


FIG. 5

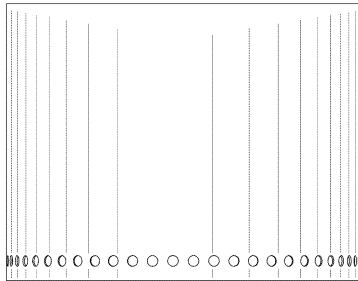


FIG. 6

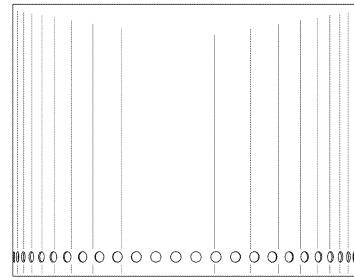


FIG. 7

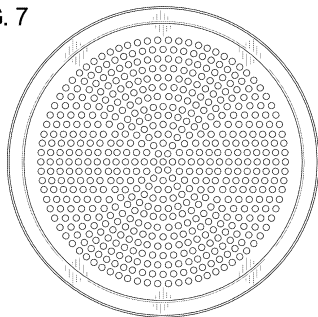
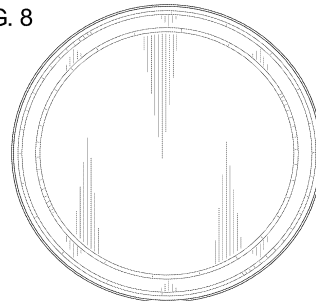


FIG. 8

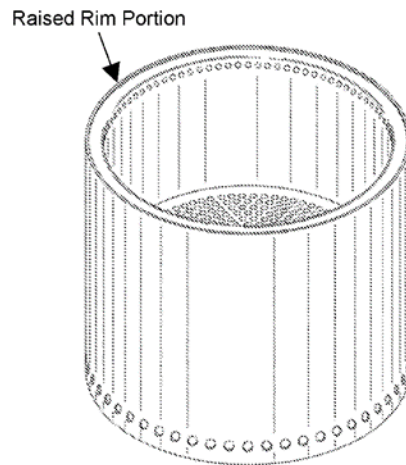


26. Design patent protection is limited to an “original and ornamental design for an article of manufacture.” 35 U.S.C. § 171(a). However, the D163 patent drawings do not include any ornamental designs distinct from the functional features of prior art fire pit and camp stove products (*e.g.*, double-walled cylindrical construction, air intake openings along the bottom, internal exhaust openings at the top, a grate upon which the biomass fuel source is placed which allows ash to drop below, and a recessed bottom).

27. To obtain allowance of the D163 patent and in an effort to distinguish the primary reference cited by the Patent Examiner, Solo repeatedly advanced arguments regarding, *inter alia* what is depicted in Figure 1 and 2.

28. For example, Solo maintained that, in contrast to the “completely flat” roof disclosed in the prior art, Figure 1 of the D163 patent depicts a “raised rim portion along the outer periphery.”

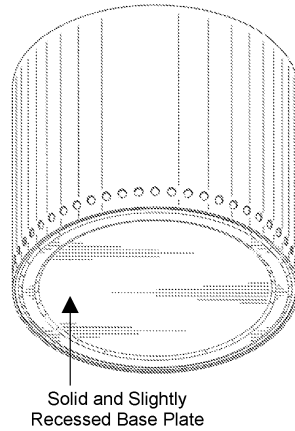
Exhibit 3, pp. 0053, 0084-0085. In advancing this argument, Solo annotated Figure 1 to particularly indicate where the “raised rim portion” is located.



Applicant's Figure 1 (Annotated)

Exhibit 3, pp. 0053, 0085.

29. Additionally, Solo maintained that, in contrast to the prior art, Figure 2 depicts “a solid and slightly recessed base plate.” **Exhibit 3, pp 0051-0052, 0083-0084.** In advancing this argument, Solo annotated Figure 2 to particularly indicate the position of the “solid and slightly recessed base plate.”



Applicant's Figure 2 (Annotated)

Exhibit 3, pp. 0052, 0083.

30. After applicant filed an Appeal Brief, the Patent Examiner acquiesced to arguments and representations made during prosecution, and stated in pertinent part:

[T]here are several differences that as not taught in the prior art.
Here is a list of the differences:

- The layout of the circular pattern on the bottom recessed surface is different.
- The configuration of the bottom of the fire pit is different.
- The top rim of the fire pit is different.

In view of the differences mentioned above the current design is patentable over the prior art.

Exhibit 3, p. 0108.

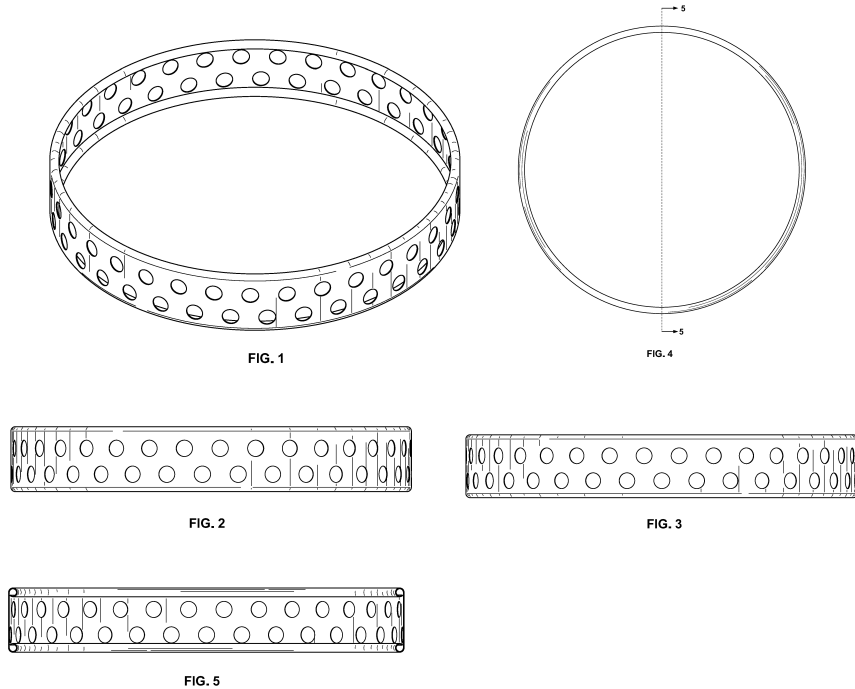
31. On information and belief, Solo DTC Brands, LLC has been assigned all right, title and interest in the D163 patent.

THE D858 PATENT

32. On information and belief, the D858 patent, entitled “Bonfire Pit Stand,” was filed on February 25, 2019 and issued on March 30, 2021.

33. The D858 patent claims protection over the “ornamental design for a bonfire pit stand.”

34. The claims of the D858 patent are limited to the precise figures drawn in the patent and are reproduced below:



35. On information and belief, Solo DTC Brands, LLC has been assigned all right, title and interest in the D858 patent.

SOLO’S THREATENING CEASE AND DESIST LETTERS

36. On July 30, 2021, counsel representing Solo sent a cease and desist letter to Duraflame, Inc., and stated in pertinent part:

[Solo] recently became aware that Duraflame is either currently offering or planning to offer products for sale in the United States, that mimic products manufactured and sold by Solo Stove, particularly a “smokeless” fire pit, stand and carrying case.

Based on the descriptions we have heard, we are concerned your proposed products infringe on our patents, including but not limited to U.S. Patent D923,163 and D914,858, as well as common law rights.

We right [sic] to alert you that **any manufacture, importation, use, sale or offer to sell any product covered by Solo Stove’s intellectual property will not be tolerated. We will pursue whatever legal means**

necessary to protect our intellectual property rights and prohibit unfair competition.

A copy of Solo's letter of July 30, 2021 is attached as **Exhibit 4**.

37. On August 20, 2021, Solo forwarded a copy of its letter to Duraflame dated July 30, 2021 to counsel for SAS.

38. On August 25, 2021, SAS' counsel responded to Solo's letter dated July 30, 2021, and stated in pertinent part:

SAS is a trademark licensee of Duraflame and intends to distribute fire pits (SAS' Fire Pit). SAS respects the intellectual property rights of others and has no intention of violating your company's rights.

After reviewing the [D163 and D858] patents, we can state that SAS' Fire Pit does not infringe either patent. You have not identified any common law rights and thus we cannot comment on that issue, other than to restate that SAS respects the intellectual property rights of others and has no intention of violating your company's rights.

A copy of SAS' letter of August 25, 2021 is attached as **Exhibit 5** (emphasis added).

39. On October 22, 2021, Solo's counsel sent a joint letter to counsel representing Duraflame and SAS, again raising unfounded allegations and making various unwarranted demands and threats. In pertinent part, Solo stated:

Duraflame and SAS, including True Value, have manufactured and sold, and continue to manufacture and sell fire pits that infringe the '163 and the '858 patents, including the Duraflame Smokeless Fire Pit. . . .

Needless to say **neither [SAS nor Duraflame] were authorized to manufacture or sell knock-off versions of Solo Stove's patented fire pits.**

[T]he Duraflame Smokeless Fire Pit is virtually identical to Solo Stove's patented fire pits, and therefore an ordinary observer will undoubtedly believe the products are sufficiently similar to find infringement.

We are also informed and believe that **Duraflame is selling a fire pit stand that is virtually identical to the stand depicted in Solo Stove's '858 patent.**

In addition to patent rights, **Solo Stove is also the owner of trade dress rights for its distinctive product designs that serve to easily identify the source of its products to consumers. By manufacturing and selling an identical product, Duraflame and SAS are also likely infringing upon Solo Stove’s trade dress rights.**

For these reasons and more, **Solo Stove demands that Duraflame and SAS, and any person or entity acting in concert with Duraflame and SAS, including any of its retailers and in particular True Value, immediately and forever . . . [c]ease and desist any and all further infringement of the ‘163 and ‘858 patents**, including any advertising, marketing, manufacture, sale, of the Duraflame Fire Pit.

A copy of Solo’s letter of October 22, 2021 is attached as **Exhibit 6** (emphasis added).

40. On October 25, 2021, Solo’s counsel sent a cease and desist letter to True Value and, in pertinent part, made similar unfounded allegations, demand and threats:

We recently sent a cease and desist letter to [Duraflame] and [SAS], which have manufactured and sold, and continue to manufacture and sell fire pits that infringe the ‘163 and the ‘858 patents, including the Duraflame Smokeless Fire Pit. . . .

It has come to our attention that **True Value is selling the Duraflame Smokeless Fir Pit online and in its stores and is therefore infringing upon the Solo Stove patents.**

For these reasons and more, **Solo Stove demands that True Value, and any person or entity acting in concert with True Value, immediately and forever . . . [c]ease and desist any and all further infringement of the ‘163 and ‘858 patents**, including any advertising, marketing, or sale, of the Duraflame Fire Pit. . . .

A copy of Solo’s letter of October 25, 2021 is attached as **Exhibit 7** (emphasis added).

41. On November 11, 2021, SAS’ counsel responded to Solo’s various infringement allegations, and stated in pertinent part:

Solo Stove’s suggestion that Duraflame, Inc. and True Value Company have sold “knock-off versions of Solo Stove’s patented fire pits” manufactured by SAS is simply incorrect.

For at least the reasons discussed below **Solo Stove’s allegations of infringement are meritless.** Please note SAS will not address the

questionable validity of Solo Stove’s ‘163 and ‘858 patents at the present time.

As an initial matter, **the simple comparison . . . of photographs taken from Solo Stove’s letter of October 22 is insufficient on its face to make out a claim of patent infringement.** Rather the comparisons must be made between the ‘163 patent claim and the Duraflame® branded fire pit actually sold by SAS.

The ‘858 patent claims an ornamental design for a circular fire pit stand. To the extent SAS intends to manufacture and sell a fire pit stand, any stand sold will not be circular. Such a fire pit stand would not infringe Solo Stove’s ‘858 patent. . . .

Solo Stove also claims its products are entitled to trade dress protection. SAS cannot respond to this claim since Solo Stove failed to *inter alia*, (i) provide a precise expression of the character and scope of the claimed trade dress; (ii) demonstrate that the claimed trade dress is non-functional; and (iii) demonstrate that the claimed trade dress has secondary meaning.

At bottom, **the allegations of Solo Stove that SAS is infringing the ‘163 and ‘858 patent and some unspecified trade dress rights are meritless. Any similarities between Solo Stove’s fire pit and SAS’ concept fire pits and any fire pit SAS ultimately sells are due to functional requirements of the fire pits.** These functional elements include, but are not limited to: (i) a cylindrical shape; (ii) a stainless steel construction; (iii) holes around the bottom for air flow; (iv) holes around the top of inside the fire pit for air flow; (v) holes in the grate for air flow . . . (vi) the structure of the fire pit bottom . . .; (vii) the top ring; and (viii) the support top ring. . . . These functional elements would be included in any fire pit ultimately sold by SAS. **Because these functional elements are not protected by the ‘163 or ‘858 patents or any purported Solo Stove trade dress, there is no basis for Solo Stove’s allegation of infringement.** If you disagree and have evidence to the contrary, please produce it so that SAS can better understand and hence respond to the basis of Solo Stove’s allegation.

A copy of SAS’ letter of November 11, 2021 is attached as **Exhibit 8** (emphasis added).

42. Instead of responding to SAS’ letter of November 11, 2021, Solo continued its pattern of harassing and threatening retailers whom have agreed to market and sell SAS’ duraflame® Fire Pit and associated fire pit stand. Specifically, on January 7, 2022, Solo’s counsel sent virtually identical cease and desist letters to Home Depot and Target, and stated in pertinent part “[t]here

is little doubt the Duraflame Smokeless Fire Pit infringes Solo Stove’s intellectual property rights. . . . Please know that Solo Stove intends to vigorously enforce its intellectual property rights. As part of those enforcement efforts, Solo Stove requests that [Home Depot and Target], and any person or entity acting in concert. . . . (1) immediately cease any and all further sales of the Duraflame Smokeless Fire Pit, including any advertising, marketing, or sale of the fire pits, and (2) provide an accounting of all sales of the Duraflame Fire Pit, and all of the fire pits that remain in your possession.” Copies of Solo’s letters to Home Depot and Target are attached as Exhibits 9 and 10, respectively (emphasis added).

43. On January 14 and January 18, 2022, SAS’ counsel responded to Solo’s cease and desist letters to Home Depot and True Value, respectively. SAS’ counsel again reiterated that the duraflame® Fire Pit and associated stand does not infringe the D163 and D858 patents. Copies of SAS’ letters of January 14 and January 18, 2022 are attached as Exhibits 11 and 12, respectively.

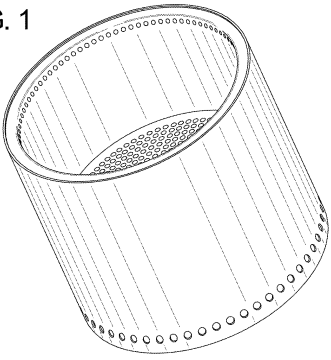


SAS’ duraflame® FIRE PIT DOES NOT INFRINGE THE D163 PATENT

44. On information and belief, devices (*e.g.*, fire pits and camp stoves) used for the combustion of biomass comprising, *inter alia*, double-walled cylindrical construction, openings at the bottom of the fire pit or stove, internal openings at the top of the fire pit or stove, a grate designed to allow ash to drop below and a recessed base plate have been common features of fire pit and camp stove products prior to the February 2, 2017 effective filing date of the D163 patent.

45. Any similarities between SAS’ duraflame® Fire Pit and the claimed design of the D163 patent are functional, rather than ornamental in nature, can not be protected by a design patent, and do not constitute design patent infringement.

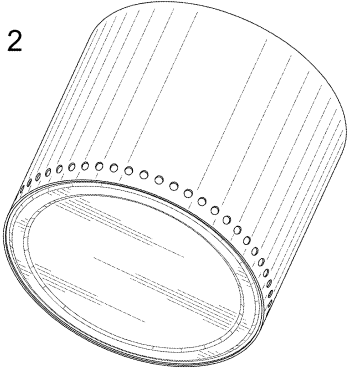

46. The ornamental appearance of the duraflame® Fire Pit is also plainly dissimilar from the claimed design of the D163 patent and, any design similarities stem from aspects of the D163 patent design that are functional and/or well-established in the prior art. Because of the numerous differences between the duraflame® Fire Pit and the claimed design, the D163 patent is not infringed.

47. Figure 1 of the D163 patent depicts a double-walled circular fire pit with round holes located along the perimeter close to the bottom of the fire pit, round internal holes located close to the top of the fire pit, a flat grate with round openings that allows ash to drop below, and a raised rim or lip portion along the outer periphery of the top of the fire pit. In contrast, the duraflame® Fire Pit has square intake openings at the bottom of the fire pit, smaller square holes internally disposed near the top of the fire pit, a dome-shaped, removable grate with square openings arranged in a linear pattern that allows ash to drop down into a removable ash catch-pan below, a grate handle, a flat surface disposed inwardly at a slight angle along the periphery of the top of the fire pit sized to assist in the positioning of a fire ring, and a fire ring that can be securely positioned on the flat surface of the top of the fire pit and which has a downward facing flange which fits over and around the cylindrical wall. Additionally, the duraflame® logo is prominently embossed on the fire pit. With the exception of the duraflame® logo, each of the foregoing elements depicted in Figure 1 of the D163 patent and present in the duraflame® Fire Pit are functional, not ornamental in nature, and/or well-established in the prior art.

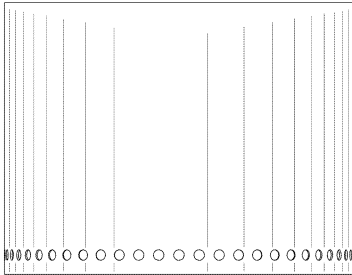

The D163 Patent	SAS' duraflame® Fire Pit
<p>FIG. 1</p> 	
	 <p>(With Fire Ring)</p>

48. Figure 2 of the D163 patent depicts a cylindrical fire pit with round holes located along the perimeter and towards the bottom of the fire pit, and a solid and slightly recessed base plate structured to accept a circular fire pit stand to elevate the fire pit and protect surface beneath the fire pit from scorching. In contrast, the duraflame® Fire Pit has square intake openings at the bottom of the fire pit, and a flat base plate with an extended circular rim sized to accept the notches located on the three arms of the associated fire pit stand. The duraflame® logo is also prominently embossed on the fire pit. With the exception of the duraflame® logo, each of the

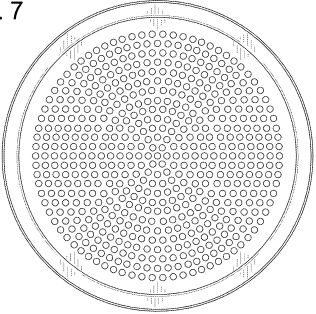

foregoing elements depicted in Figure 2 of the D163 patent are functional, not ornamental in nature, and/or well-established in the prior art.

The D163 Patent	SAS duraflame® Fire Pit
<p>FIG. 2</p> 	

49. Figures 3-6 of the D163 patent are identical and depict the front, back and sides of a cylindrical fire pit with round holes located along the perimeter close to the bottom of the fire pit. In contrast, SAS' duraflame® Fire Pit comprises rectangular intake openings at the bottom of the fire pit, and the duraflame® logo prominently embossed on the fire pit. With the exception of the duraflame® logo, all of the foregoing elements depicted in Figures 3-6 of the D163 patent and present in the duraflame® Fire Pit, are functional, not ornamental in nature, and/or well-established in the prior art.

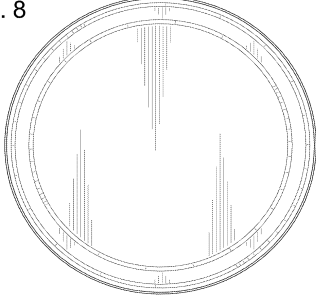

The D163 Patent	SAS' duraflame® Fire Pit
<p>FIG. 3</p> 	

50. Figure 7 of the D163 patent is the top view of the claimed fire pit and depicts a flat fixed grate with circular grate openings arranged in a radial pattern to support the biomass fuel source and allow ash to drop below, and a raised rim portion along the outer periphery of the top of the fire pit base. In contrast, the duraflame® Fire Pit has a dome-shaped removable grate with a handle and square grate openings arranged in a linear pattern to allow ash to drop down into a removable ash catch-pan below. Additionally, in contrast to the raised rim or lip portion along the outer periphery at the top of the fire pit of the D163 patent, the duraflame® Fire Pit has a flat surface disposed inwardly at a slight angle located at the top of the fire pit on which an overhanging fire ring is supported. All of the foregoing elements depicted in Figure 7 of the D163 patent and present in the duraflame® Fire Pit are functional, not ornamental in nature, and/or well-established in the prior art.

The D858 Patent	SAS' duraflame® Fire Pit
<p data-bbox="310 1083 375 1108">FIG. 7</p> 	

51. Figure 8 of the D163 patent is a bottom view of the D163 patent claimed fire pit and depicts a solid and slightly recessed base plate structured to accept a circular fire pit stand to elevate the fire pit and protect surface beneath the fire pit from scorching. In contrast, the duraflame® Fire Pit base has an extended circular rim sized to accept the notches located on the three arms of the associated fire pit stand. All of the foregoing elements depicted in Figure 8 of

the D163 patent and present in the duraflame® Fire Pit are functional, not ornamental in nature, and/or well-established in the prior art.

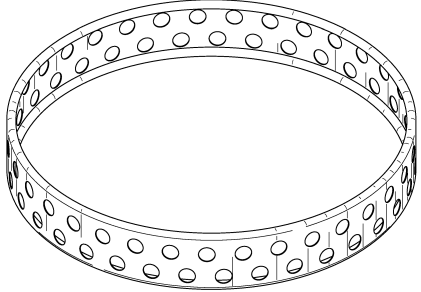
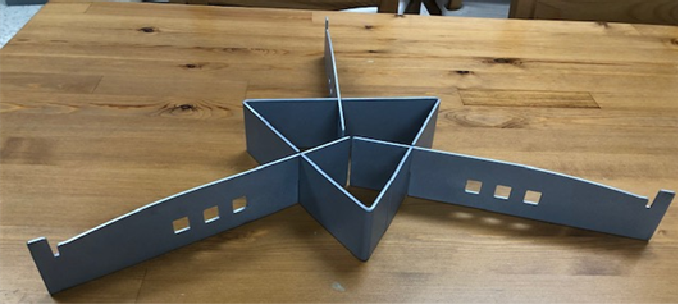
The D163 Patent	SAS’ duraflame® Fire Pit
<p data-bbox="315 422 380 443">FIG. 8</p> 	

52. Based on the preceding paragraphs, an ordinary observer, taking into account the prior art, would not believe that SAS’ duraflame® Fire Pit is the same design shown in the D163 patent.

SAS’ duraflame® FIRE PIT STAND DOES NOT INFRINGE THE D858 PATENT

53. The stand associated with the duraflame® Fire Pit clearly does not have the same overall visual appearance as the circular fire pit stand design claimed in the D858 patent.

54. As shown in the side-by-side comparison below, SAS’ duraflame® Fire Pit stand is so distinct from the circular fire pit stand claimed in the D858 patent that no ordinary observer could possibly be deceived into thinking that SAS’ “three armed” fire pit stand was the same as the circular stand design of the D858 patent.

The D858 Patent	SAS' duraflame® Fire Pit stand
 <p data-bbox="393 583 430 604">FIG. 1</p>	

PRIOR ART PRODUCTS

55. SAS repeats and incorporates by reference the allegations in the preceding paragraphs as if fully set forth herein.

56. On information and belief, an application for the D163 patent was filed on February 2, 2017. The D163 patent issued on January 22, 2021.

57. On information and belief, the features of the D163 patent are functional, not ornamental in nature, and/or were already known in the prior art prior to the February 2, 2017 effective filing date of the D163 patent.

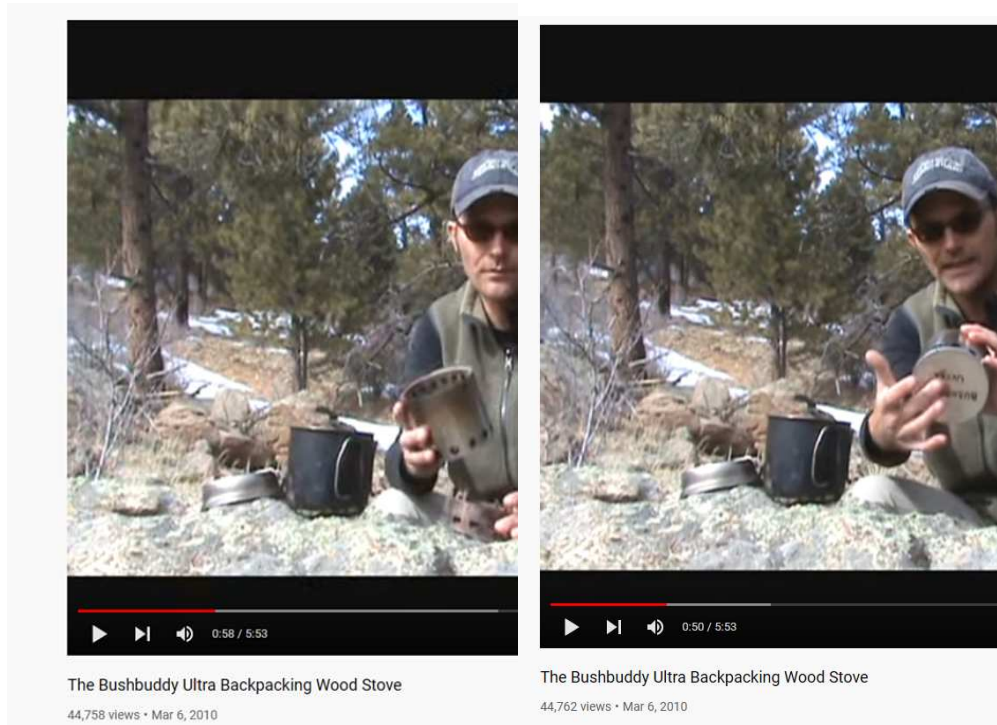
THE BUSHBUDDY PRIOR ART STOVE CAMP PRODUCT

58. On information and belief, the Bushbuddy camp stove is a prior art product having similar, if not identical, design characteristics and features, that were later claimed in the D163 patent.

59. On information and belief, the Bushbuddy Ultra camp stove product was in public use, on sale or otherwise known and available to the public as early as 2006, and comprised double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located near the top of the stove, a fixed grate, a raised rim portion

along the periphery of the top of the stove, and a solid and slightly recessed base plate. **Exhibit 13.**

60. On information and belief, Bushbuddy camp stoves incorporating all the design features and characteristics as the D163 patent were in public use, on sale or otherwise known and available to the public prior to the February 2, 2017 effective filing date of the D163 patent. For example, and without limitation, a video posted on March 6, 2010 (available at https://www.youtube.com/watch?v=cd_s4x7xVjU) shows the Bushbuddy Ultra camp stove product comprising double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located near the top of the stove, a fixed grate, a raised rim portion along the periphery of the top of the stove, and a solid and slightly recessed base plate.



61. A video posted on July 30, 2014 (available at <https://www.youtube.com/watch?v=noKrCm73iGc>) shows the Bushbuddy Trekka Ultra camp

stove product comprising double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located near the top of the stove, a fixed grate, a raised rim portion along the periphery of the top of the stove, and a solid and slightly recessed base plate.



62. On information and belief, additional videos further demonstrating that Bushbuddy camp stove products incorporating all the design features and characteristics of the D163 patent were in public use, on sale or otherwise known and available to public prior to the February 2, 2017 effective filing date of the D163 patent include, but are not limited, to the following:

- (a) A video posted on March 7, 2011, and available at <https://www.youtube.com/watch?v=OdsGIaXGKAM>;
- (b) A video posted on April 20, 2012 and available at <https://www.youtube.com/watch?v=bAlkNJPmY28>; and
- (c) A video posted on July 2, 2014 and available at <https://www.youtube.com/watch?v=LRvUEpWWmEs>.

63. The Bushbuddy videos referenced in the preceding paragraphs were posted and available to the public more than one (1) year before the February 2, 2017 effective filing date of the D163 patent.

THE BUSH COOKER PRIOR ART CAMP STOVE

64. On information and belief, the Bush Cooker camp stove product was in public use, on sale or otherwise known and available to the public as early as 2008, and comprised double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located near the top of the stove, a fixed grate, a raised rim portion along the periphery of the top of the stove, and a solid and slightly recessed base plate, as evidenced by a video posted on December 4, 2008

(<https://www.youtube.com/watch?v=qBWLlgJD2Ec>).



65. The Bush Cooker video referenced in the preceding paragraph was posted and available to the public more than one (1) year before the February 2, 2017 effective filing date of the D163 patent.

SOLO'S PRIOR ART CAMP STOVE PRODUCTS

66. On information and belief, Solo camp stove products having double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located at the top of the stove, a fixed, flat grate, a raised rim portion along the outer periphery located at the top of the stove, and a solid and slightly recessed base plate were offered for sale at least as early as January 17, 2012. **Exhibit 14.**

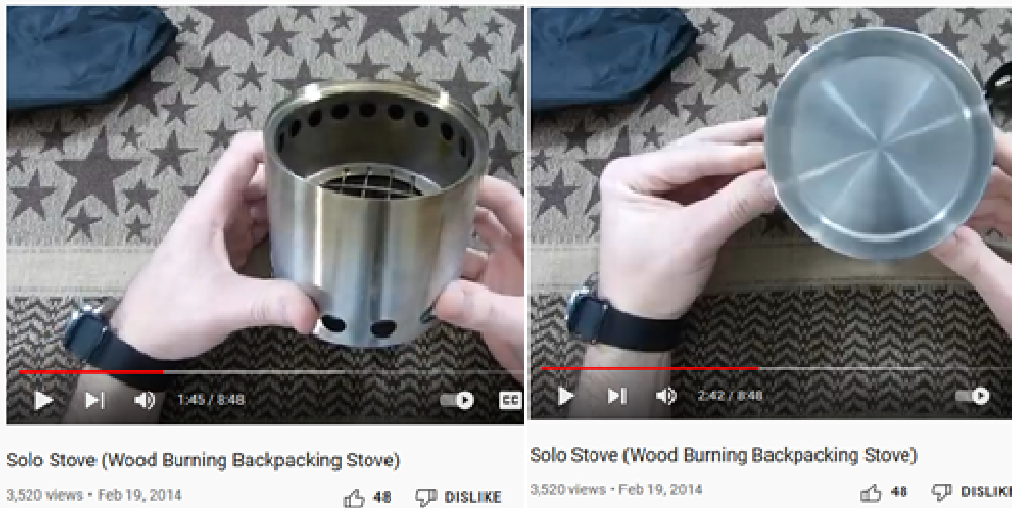
67. On information and belief, Solo camp stove products incorporating all the design characteristics and features of the D163 patent were in public use, on sale or otherwise known and available to the public prior to the February 2, 2017 effective filing date of the D163 patent. For example, and without limitation:

- (a) A video posted on July 5, 2013 (available at <https://www.youtube.com/watch?v=D4IS8x6dcgw>), shows Solo's original camp stove product with double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located at the top of the stove, a fixed, flat grate and a raised rim portion along the outer periphery located at the top of the stove, and a solid and slightly recessed base plate.



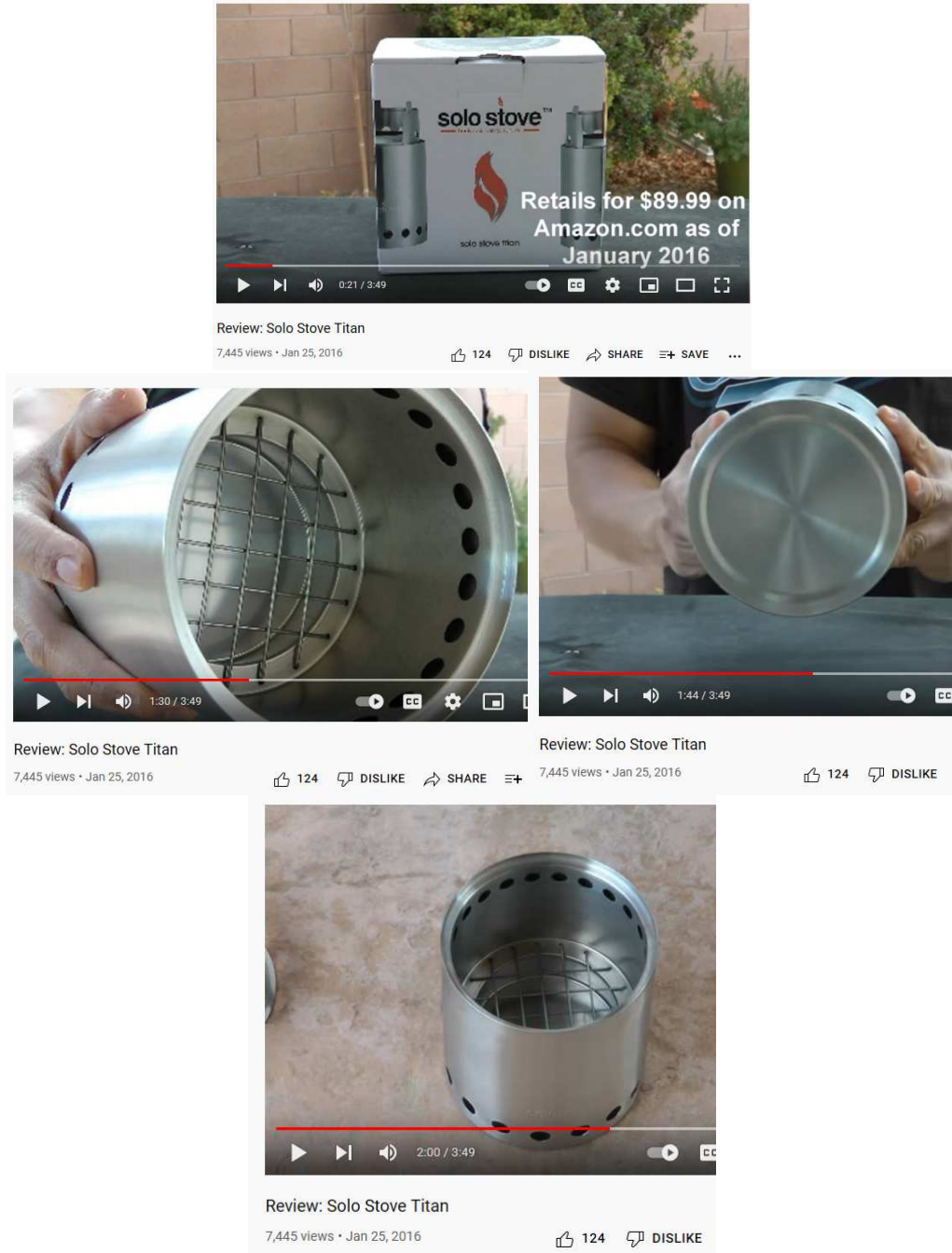
(b) A video posted on February 19, 2014

(<https://www.youtube.com/watch?v=8e1Uk0VpJbE>) depicts a Solo camp stove comprising double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located at the top of the stove, a fixed, flat grate, a raised rim portion along the outer periphery located at the top of the stove, and a solid and slightly recessed base plate.



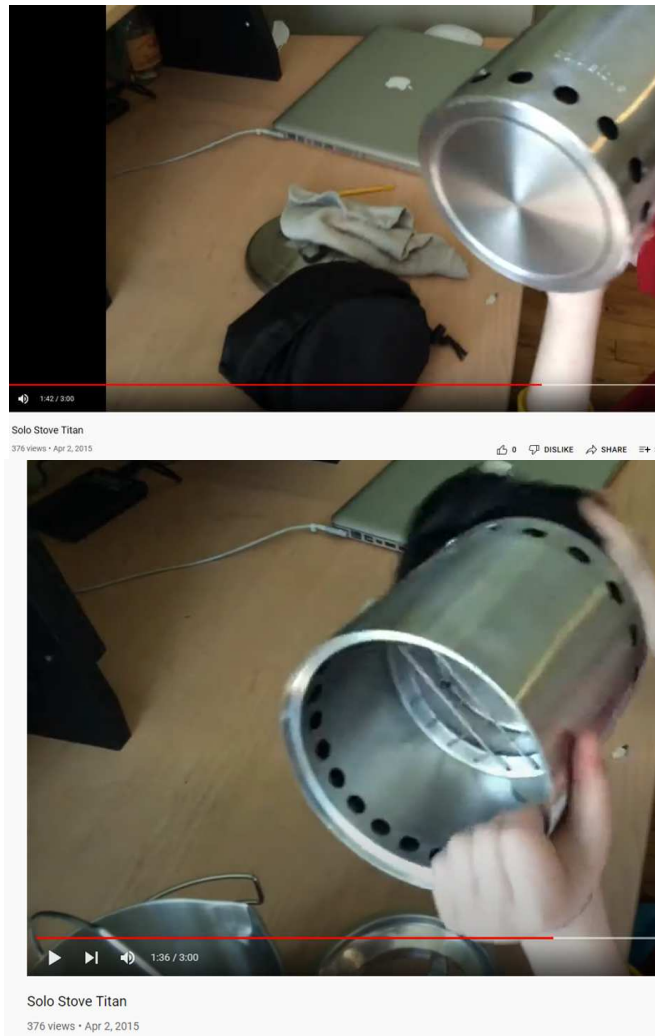
(c) A video posted on January 25, 2016 (available

https://www.youtube.com/watch?v=IAXNsN_GQqc) indicates Solo's Titan camp stove product was available to purchase in January 2016, and comprised double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located at the top of the stove, a fixed, flat grate, a raised rim portion along the outer periphery located at the top of the stove, and a solid and slightly recessed base plate.



- (d) A video posted on April 2, 2015 (available <https://www.youtube.com/watch?v=4sk2Lg1HJqA>) depicts Solo's Titan camp stove product comprising double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the stove, round internal holes located at the top of the stove, a fixed, flat grate, a raised rim portion along the

outer periphery located at the top of the stove, and a solid and slightly recessed base plate.



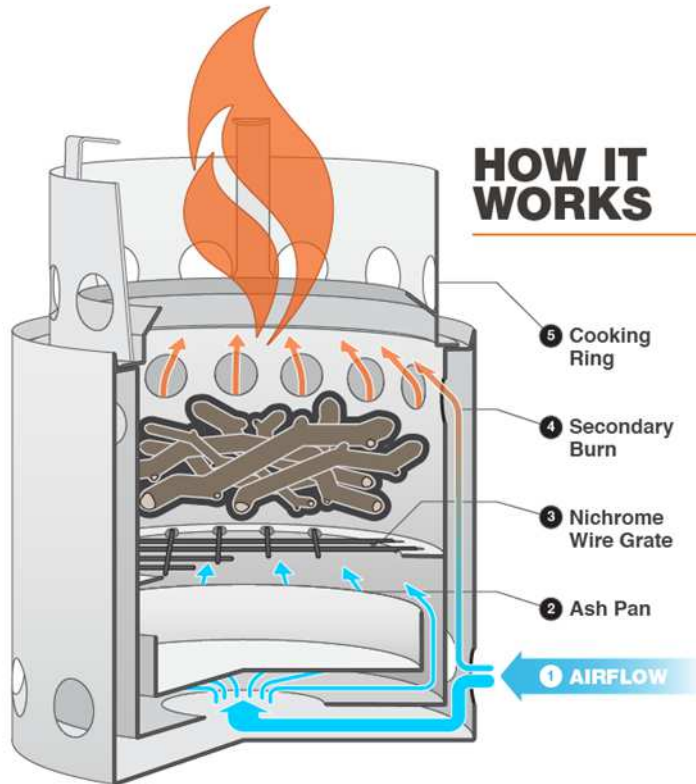
68. A video posted on May 24, 2013 (available <https://www.youtube.com/watch?v=tiM8IN0hgCM>) depicts the similarities between a prior art Bushbuddy camp stove product on the left and a prior art Solo camp stove product on the right. In fact, at 0:26 - 0:50 of the video, it is stated that the designs of the Bushbuddy and Solo camp stove products are “identical.”



69. On information and belief, Solo launched a Kickstarter campaign in 2014, <https://www.kickstarter.com/projects/340672218/solo-stove-campfire-backpack-camp-survive/description>, to solicit funds to produce a larger version of its original and Titan camp stove products. As part of this campaign, Solo represented that the original and Titan camp stove products were first marketed in 2011 and 2013, respectively, and that the “main difference” between the original, Titan and Campfire stove products “is size.” In support of its fundraising efforts, Solo also included a schematic of its camp stove products and a description of some of the functional features of the stove elements associated with Solo’s camp stove product design.

The Solo Stove Campfire Design

How It Works



1) Airflow - Rising hot air, and the absence of oxygen created by the combustion process, pulls air through the bottom vent holes. This air movement fuels the fire at its base while also providing a boost of preheated air through the vent holes at the top of the burn chamber.

2) Ash Pan - Catches loose ash and prevents the clogging of vital airflow. The ash pan also acts as a heat shield and minimizes scorching of the ground beneath it.

3) Nichrome Wire Grate - Allows oxygen to be fed directly to embers from below. This helps to burn wood faster and hotter while allowing spent ash to fall out of the process.

4) Secondary Burn - Vent holes near the top of the stove allow preheated oxygen to fuel the flame resulting in a more complete combustion and a hotter fire with less smoke.

5) Cooking Ring - Directs heat up and towards the center of your pot for maximized efficiency. The cooking ring also acts as a windscreen while still allowing oxygen to fuel the flame. The entire cooking ring can be packed into the stove body for compact storage.

70. On information and belief, Solo also released numerous promotional videos further demonstrating that Solo camp stove products, incorporating all the design features and characteristics of D163 patent, were in public use, on sale or otherwise known and available to the public prior to the February 2, 2017 effective filing date of the D163 patent. These Solo promotional video include, but are not limited to, the following:

- (a) A Solo promotional video posted on October 14, 2014 and available at <https://www.youtube.com/watch?v=9xsRdcnd38w>;
- (b) A Solo promotional video posted on December 20, 2014 and available at <https://www.youtube.com/watch?v=q6O0xu4WTIM>;
- (c) A Solo promotional video posted on April 1, 2015 and available at https://www.youtube.com/watch?v=W2Mjz1_BHWE; and
- (d) A Solo promotional video posted on October 5, 2015 and available at <https://www.youtube.com/watch?v=wBFgu0iZ0VM>.

71. On information and belief, other videos demonstrating that Solo camp stove products incorporated all of design features and characteristics of the D163 patent, and further evidencing that these stoves were in public use, on sale or otherwise known and available to public prior to the February 2, 2017 effective filing date of the D163 patent include, but are not limited to, the following:

- (a) A video posted on June 11, 2012 (and available at <https://www.youtube.com/watch?v=ZqOhi7NiNBQ>);
- (b) A video posted on October 9, 2012 and available at <https://www.youtube.com/watch?v=FbsMa3Llcm8>;
- (c) A video posted on May 27, 2013, available at

https://www.youtube.com/watch?v=q-_83MdYaFk;

(d) A video posted on December 31, 2014, and available at

<https://www.youtube.com/watch?v=x9S56JBOJO8>; and

(e) A video posted on October 15, 2015, and available at

<https://www.youtube.com/watch?v=wBFgu0iZ0VM>.

72. All of the videos of Solo's products referenced in the preceding paragraphs were posted and available to the public more than one (1) year before the February 2, 2017 effective filing date of the D163 patent.

73. U.S. Patent No. D858,729, issued on September 3, 2019, and claims priority to an application filed on February 24, 2014. U.S. Patent No. D858,729 discloses all of the design features and characteristics as the claimed design of the D163 patent.

74. U.S. Publication No. 2014/0238378, filed on February 24, 2014, discloses all of the design features and characteristics as the claimed design of the D163 patent.

75. U.S. Publication No. 2020/0224879, filed on March 25, 2020 and claiming priority to an application filed on February 26, 2013, discloses all of the design features and characteristics as the claimed design of the D163 patent.

76. U.S. Publication No. 2007/0137634, filed on December 16, 2005, discloses some of the design features and characteristics as the claimed design of the D163 patent.

77. The issued U.S. patent and published U.S. patent applications referenced in the preceding paragraphs were published more than one (1) year before the February 2, 2017 effective filing date of the D163 patent.

COUNT I

DECLARATION OF NON-INFRINGEMENT OF U.S. PATENT NO. D923,163

78. SAS repeats and incorporates by reference the allegations in the preceding paragraphs as if fully set forth herein.

79. On information and belief, Solo claims to own all rights, title and interest in the D163 patent.

80. In letters of July 30, 2021 (**Exhibit 4**), October 22, 2021 (**Exhibit 6**), October 25, 2021 (**Exhibit 7**), January 7, 2022 (**Exhibits 9 and 10**), Solo has repeatedly (a) threatened SAS and three retailers who have agreed to market and sell SAS' duraflame® Fire Pit, (b) alleged that the manufacture and sale of the duraflame® Fire Pit infringes the D163 patent, and (c) demanded, *inter alia*, that all advertising, marketing and sale of the duraflame® Fire Pit immediately cease.

81. As a result of the acts described in the foregoing paragraphs, a substantial controversy of sufficient immediacy and reality exists with respect to the non-infringement of the D163 patent to warrant the issuance of a declaratory judgment of non-infringement.

82. As detailed in the preceding paragraphs, SAS' duraflame® Fire Pit does not infringe the D163 patent, and SAS does not infringe, induce infringement of and/or contributorily infringe, and has not infringed, induced infringement of and/or contributorily infringed the D163 patent.

83. Any similarities between SAS' duraflame® Fire Pit and the claimed design of the D163 patent are functional, not ornamental in nature, and/or well-established in the prior art, and therefore do not constitute design patent infringement.

84. The ornamental appearance, features and characteristics of the duraflame® Fire Pit are also plainly dissimilar from the claimed design of the D163 patent. Because of the numerous

differences between the duraflame® Fire Pit and the claimed design, the D163 patent is not infringed.

85. An actual case or controversy exists between SAS and Solo based on Solo's repeated assertions that SAS' duraflame® Fire Pit infringes the D163 patent.

86. A judicial declaration is necessary and appropriate so that SAS may ascertain its rights regarding the D163 patent.

87. SAS requests that the Court enter a declaratory judgment that the manufacture, use, sale, offer to sell and/or importation of the duraflame® Fire Pit has not infringed and is not infringing the D163 patent.

COUNT II

DECLARATION OF NONINFRINGEMENT OF U.S. PATENT NO. D914,858

88. SAS repeats and incorporates by reference the allegation in the preceding paragraphs as if fully set forth herein.

89. On information and belief, Solo claims to own all rights, title and interest in the D858 patent.

90. In letters of July 30, 2021 (**Exhibit 4**), October 22, 2021 (**Exhibit 6**), October 25, 2021 (**Exhibit 7**), January 7, 2022 (**Exhibits 9 and 10**), Solo has repeatedly (a) threatened SAS and three retailers who have agreed to market and sell the fire pit stand associated with SAS' duraflame® Fire Pit, (b) alleged that the manufacture and sale of the fire pit stand infringes the D858 patent, and (c) demanded, *inter alia*, that all advertising, marketing and sale of the fire pit stand associated with SAS' duraflame® Fire Pit immediately cease.

91. As a result of the acts described in the foregoing paragraphs, a substantial controversy of sufficient immediacy and reality exists with respect to the non-infringement of the D858 patent to warrant the issuance of a declaratory judgment of non-infringement of the D858 patent.

92. As detailed in the preceding paragraphs, the fire pit stand associated with SAS' duraflame® Fire Pit does not infringe the D858 patent, and SAS does not infringe, induce infringement of and/or contributorily infringe, and has not infringed, induced infringement of and/or contributorily infringed the D858 patent.

93. The ornamental appearance of the stand associated with duraflame® Fire Pit is also plainly dissimilar from the claimed design of the D858 patent. Because of the differences between the stand associated with SAS' duraflame® Fire Pit and the claimed design, the D858 patent is not infringed.

94. An actual case or controversy exists between SAS and Solo based on Solo's repeated assertions that the stand associated with SAS' duraflame® Fire Pit infringes the D858 patent.

95. A judicial declaration is necessary and appropriate so that SAS may ascertain its rights regarding the D858 patent.

96. SAS requests that the Court enter a declaratory judgment that the manufacture, use, sale, offer to sell and/or importation of the stand associated with SAS' duraflame® Fire Pit has not infringed and is not infringing the D858 patent.

COUNT III

DECLARATION OF INVALIDITY OF U.S. PATENT NO. D923,163

97. SAS repeats and incorporates by reference the allegations in the preceding paragraphs as if fully set forth herein.

98. If as Solo alleges, the D163 patent is interpreted to cover SAS' duraflame® Fire Pit, then the D163 patent is not valid for failure to satisfy one or more provisions of the Patent Act including, but not limited to, 35 U.S.C. §§ 102, 103, 171.

99. As detailed in the preceding paragraphs, the design elements that Solo alleges are protectable, and which Solo seeks to enforce against SAS' duraflame® Fire Pit, are not ornamental, but are functional in nature, and/or well-established in the prior art, and therefore not subject to design patent protection. The D163 patent is invalid under 35 U.S.C. § 171.

100. As detailed in the preceding paragraphs, the design claimed in the D163 patent was known, in public use, sold or used by others in this country or patented or described in a printed publication in this country prior to the purported D163 invention date (*i.e.*, February 2, 2017).

101. As detailed in the preceding paragraphs, the design claimed in the D163 patent is not novel and not valid pursuant to 35 U.S.C. § 102(a) because camp stove products having the same design features and characteristics as the D163 patent were in public use, on sale or otherwise known and/or available to public prior to the February 2, 2017 effective filing date of the D163 patent including, but not limited to, Solo's Original, Titian and Campfire, the Bushbuddy Ultra and the Bush Cooker camp stove products.

102. As detailed in the preceding paragraphs, the design claimed in the D163 patent is not novel and not valid pursuant to 35 U.S.C. § 102(a) because the same design features and characteristics were described in one or more published patent applications and available to public prior to the February 2, 2017 effective filing date of the D163 patent including, but not limited to, U.S. Patent No. D858,729, U.S. Publication No. 2014/0238378, U.S. Publication No. 2020/0224879 and U.S. Publication No. 2007/0137634.

103. The design claimed in the D163 patent is not novel and, in any event, is invalid pursuant to 35 U.S.C. § 103 as merely an obvious variation of prior art camp stove product designs and published patent applications, and issued patents. As detailed in the preceding paragraphs, the design features and characteristics of Solo's Original, Titan and Campfire, the Bushbuddy and/or the Bush Cooker camp stove products are basically the same, if not identical, to the D163 patent design. The D163 patent would have been obvious to a designer of ordinary skill based on one or more of the Solo, Bushbuddy and/or Bush Cooker prior art camp stove products in view of U.S. Patent No. D858,729, U.S. 2014/0238378, U.S. Publication No. 2020/0224879 and/or U.S. Publication No. 2007/0137634.

104. An actual case or controversy exists between SAS and Solo based on Solo's repeated allegations that SAS' duraflame® Fire Pit infringes the D163 patent.

105. A judicial declaration is necessary and appropriate so that SAS may ascertain its rights regarding the D163 patent.

106. SAS requests that the Court enter a declaratory judgment that the D163 patent is not valid for failing to comply with 35 U.S.C. § 102, 103 and 171.

COUNT IV

UNENFORCEABILITY OF THE D163 PATENT

107. SAS repeats and incorporates by reference its allegations in each of the foregoing paragraphs as if fully set forth herein.

108. Intentional concealment of prior art that is material to the patentability of an invention claimed in a patent, an affirmative misrepresentation of a material fact, and/or the submission of false material information with intent to deceive the United States Patent and Trademark Office ("USPTO") constitutes inequitable conduct sufficient to render an issued patent unenforceable.

109. On information and belief, Jeffery Jan is one of the founders of Solo.

110. The D163 patent issued on June 22, 2021 and identifies Jeffrey Jan as inventor.

111. As named inventor of the D163 patent, Jeffery Jan owed a duty of candor to the USPTO during prosecution of the application that issued as the D163 patent.

112. On information and belief, before the filing of the application that issued as the D163 patent, and throughout the prosecution of the D163 patent, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent knew or should have known Solo was making, using, selling, offering to sell and/or otherwise disclosing to the public, camp stove products having basically the same, if not identical, design features and characteristics as the design claimed in the D163 patent.

113. On information and belief, during the entirety of the prosecution of the application that issued as the D163 patent, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent failed to disclose to the USPTO that Solo was making, using, selling, offering to sell and/or otherwise disclosing to the public camp stove products having of basically the same, if not identical, design features and characteristics as the design claimed in the D163 patent.

114. On information and belief, during the prosecution of the application that issued as the D163 patent, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent knew or should have known that these Solo prior art camp stove products were material to the patentability to the design claimed in the D163 patent.

115. On information and belief, during the prosecution of the application that issued as the D163 patent, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent repeatedly and intentionally concealed and withheld from the USPTO material information regarding Solo's prior art camp stove products having of basically the same, if not identical, design features and characteristics as the design claimed in the D163 patent.

116. On information and belief, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent failed to disclose Solo's prior art camp stove products to the USPTO with an intent to deceive because Jeffrey Jan and/or Solo's attorney wanted to conceal and withhold the fact that the design claimed in the D163 patent was unpatentable in view of Solo's own prior art camp stove products having the same, if not identical, design features and characteristics as those claimed in the D163 patent.

117. As detailed in the preceding paragraphs, in Solo's April 7, 2020 "Response to Office Action Mailed January 9, 2020," Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent, sought to distinguish the prior art cited by the Patent Examiner by arguing, *inter alia*, that the prior art failed to disclose "a solid and slightly recessed base plate" and a "raised rim portion along its outer periphery."

118. As detailed in the preceding paragraphs, in Solo's Appeal Brief dated December 1, 2020 responding to the Patent Examiner's Final Rejection dated July 2, 2020, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent again argued, *inter alia*, that the prior art failed to disclose "a solid and slightly recessed base plate" and a "raised rim portion along its outer periphery."

119. As detailed in the preceding paragraphs, prior to Solo's April 7, 2020 "Response to Office Action Mailed January 9, 2020" and Appeal Brief dated December 1, 2020, Solo made, used, sold and offered for sale various camp stove products embodying "a solid and slightly recessed base plate" and a "raised rim portion along [the stove's] outer periphery," as well as other design features and characteristics as claimed in the D163 patent.

120. On information and belief, prior to Solo's April 7, 2020 "Response to Office Action Mailed January 9, 2020" and Appeal Brief dated December 1, 2020, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent knew or should have known Solo made, used, sold and

offered for sale various camp stove products embodying “a solid and slightly recessed base plate” and a “raised rim portion along [the stove’s] outer periphery,” as well as other design features and characteristics as claimed in the D163 patent.

121. On information and belief, in Solo’s “Response to Office Action Mailed January 9, 2020,” and December 1, 2020 Appeal Brief, Jeffrey Jan and/or Solo’s attorney prosecuting the D163 patent intentionally failed to disclose and withheld the fact that various prior art Solo camp stove products having “a solid and slightly recessed base” and a “raised rim portion along [the stove’s] outer periphery,” and other similar, if not identical, design features and characteristics as claimed in the D163 patent were made, used, sold and/or offered for sale by Solo.

122. On information and belief, the existence of prior art Solo camp stove products having “a solid and slightly recessed base” and a “raised rim portion along [the stove’s] outer periphery,” as well as other similar, if not identical, design features and characteristics as those claimed in the D163 patent would have been material to the prosecution of the D163 patent.

123. On information and belief, if the USPTO had been aware of Solo’s prior art stove products having the same, if not identical, design features and characteristics as the D163 patent, the USPTO would not have allowed the D163 patent to issue.

124. On information and belief, these Solo prior art camp stoves were not cumulative of the prior art considered by the Patent Examiner, and were but-for material to the Patent Examiner’s decision relating to the patentability of the D163 patent.

125. On information and belief, as a result of the aforementioned intentional concealment and withholding of Solo’s prior art stove products detailed in the preceding paragraphs, the Patent Examiner concluded in pertinent part in the Notice of Allowance dated March 4, 2021:

[T]here were several differences that are not taught in the prior art.

Here is a list of the differences:

- The layout of the circular pattern on the bottom recessed surface is different;
- The configuration of the bottom of the fire pit is different;
- The top rim of the fire pit is different.

In view of the differences mentioned above the current design is patentable over the prior art.

126. On information and belief, Jeffrey Jan, one of the founders of Solo and named inventor of the D163 patent and/or Solo's attorney prosecuting the D163 patent knew or should have known of the various prior art camp stove products detailed in the preceding paragraphs were made, used, sold and offered for sale by Solo before the effective filing date of the D163 patent, and intentionally withheld, concealed and otherwise failed to disclose those prior art products to Patent Examiner during prosecution of the application that issued as the D163 patent.

127. On information and belief, as one of the founders of Solo and named inventor of Solo's D163 patent, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent knew or should have known that Solo camp stove products made, used, sold and offered for sale prior to the February 2, 2017 effective filing date of the D163 patent were material to the patentability of the D163 patent.

128. Neither Jeffery Jan nor Solo's attorney prosecuting the D163 patent disclosed or otherwise submitted any of Solo prior art camp stove products to the USPTO during prosecution of the application that issued as the D163 patent.

129. On information and belief, inventor of the D163 patent, Jeffrey Jan and/or Solo's attorney prosecuting the D163 patent committed inequitable conduct by withholding, concealing and otherwise failing to disclose Solo's prior art camp stove products to the Patent Examiner during prosecution of the application that issued as the D163 patent including, but not limited to, Solo's April 7, 2020 Response and Solo's December 1, 2020 Appeal Brief.

130. On information and belief the inventor of the D163, Jeffrey Jan, and/or Solo's attorney prosecuting the D163 patent had specific intent to deceive the USPTO by withholding Solo's prior art camp stove products from the Patent Examiner during prosecution of the application that issued as the D163 patent.

131. On information and belief, based on the intentional acts of Jeffery Jan and/or Solo's attorney prosecuting the D163 patent to deceive the USPTO, none of the Solo prior art camp stove products detailed in the preceding paragraphs were considered by the Patent Examiner during the prosecution of the application that matured into the D163 patent.

132. On information and belief and based on the preceding paragraphs, the D163 patent is unenforceable because one or more persons directly involved in the prosecution of the D163 patent made the deliberate decision to conceal and withhold one or more material pieces of prior art from the USPTO. The single most reasonable inference that can be drawn is that the deliberate concealment and withholding of these material pieces of prior art was done with the specific intent to deceive the USPTO.

133. On information and belief, the D163 patent is unenforceable due to inequitable conduct and fraud in the USPTO under 37 C.F.R. § 1.56 (a) because the named inventor, Jeffery Jan, and/or Solo's attorney prosecuting the D163 patent knowingly, intentionally and deliberately withheld prior art that was material to the patentability of the D163 patent. These deliberate omissions were but-for material to patentability, were made with the intent to deceive the USPTO, and were justifiably relied on by the Patent Examiner in ultimately allowing the D163 patent to issue.

134. An actual case or controversy exists between SAS and Solo based on Solo's repeated allegations that SAS' duraflame® Fire Pit infringes the D163 patent.

135. A judicial declaration is necessary and appropriate so that SAS may ascertain its rights regarding the D163 patent.

136. SAS requests that the Court enter a declaratory judgment that the D163 patent is unenforceable pursuant to 37 C.F.R. § 1.56.

COUNT V

DECLARATION OF NON-INFRINGEMENT OF TRADE DRESS

137. SAS repeats and incorporates by reference the allegations in the preceding paragraphs as if fully set forth herein.

138. In Solo's letter of October 22, 2021 to SAS and Duraflame (**Exhibit 6**), Solo alleged that it possessed trade dress rights in unspecified designs associated with its fire pit products, and that the manufacture and sale of SAS' duraflame® Fire Pit and associated stand likely infringes on those trade dress rights.

139. On information and belief, Solo does not have a federal trademark registration for its purported fire pit trade dress. Thus, Solo has the burden to: (a) identify unregistered trade dress with particularity; (b) demonstrate that its unregistered trade dress is distinctive, in that its is recognized by consumers as indicating the source of Solo's fire pit products; and (c) to demonstrate that its unregistered trade dress is non-functional. Solo cannot demonstrate any element required for trade dress protection.

140. Solo has failed to identify any purported fire pit trade dress with the requisite particularity. In its letter of October 22, 2021 to SAS, Solo simply asserts "Solo Stove is also the owner of trade dress rights for its distinctive designs that serve to easily identify the sources of its products to consumers." **Exhibit 6, p. 2**. Solo's superficial trade dress allegation fails to define its purported fire pit trade dress with the required specificity.

141. On information and belief, Solo's fire pit products have not developed secondary meaning and have not acquired distinctiveness such that in the minds of consumers, the primary significance of the design is to identify Solo as the source of the fire pit products, rather than the product itself. Thus, the claimed design of the D163 patent is not protectable trade dress under the Lanham Act.

142. Solo's claimed trade dress cannot be inherently distinctive. Solo has the burden to demonstrate that its purported trade dress has acquired distinctiveness through secondary meaning -- that in the minds of consumers, the primary significance of the trade dress is to identify the source of its fire pit products rather than the product itself. Given the third party marketing and sale of fire pit and camp stove products comprising double-walled cylindrical construction, round holes located along the perimeter close to the bottom of the product, round internal holes located near the top of the product, a fixed grate, a raised rim portion along the periphery of the top of the product, and a solid and slightly recessed base plate, among other features, Solo cannot establish secondary meaning in its alleged fire pit product trade dress.

143. Solo does not have any rights in the purported trade dress because the features of the Solo fire pit products are functional, not ornamental in nature, and/or well-established in the prior art.

144. Solo also cannot establish that its purported fire pit product trade dress is non-functional. Trade dress is considered functional if (a) it is essential to the use or purpose of the product or (b) it affects the cost of quality of the product. Solo's purported fire pit product trade dress is functional because it serves utilitarian purposes for fire pit and camp stove products, and affects the cost and quality of the product by using basic features that consumers are have grown accustomed to seeing in fire pit and camp stove products.

145. This Court should therefore declare that Solo lacks protected trade dress rights associated with the design of its fire pit products because its purported trade dress lacks specificity, and is functional, not distinctive or ornamental, in nature, and/or is well-established in the prior art.

146. Even if Solo's purported trade dress was protectable, SAS' duraflame® Fire Pit and associated fire pit stand do not infringe and have not infringed any purported Solo fire pit trade dress pursuant to 15 U.S.C. § 1116 because the sale of SAS' duraflame® Fire Pit and the associated fire pit stand is not likely to cause any consumer confusion, mistake or deception.

147. An actual case or controversy exists between SAS and Solo based on Solo's allegation that SAS' duraflame® product infringes some unspecified Solo fire pit product trade dress.

148. A judicial declaration is necessary and appropriate so that SAS may confirm its rights regarding any purported Solo trade dress rights.

149. SAS requests that the Court enter a declaratory judgment that Solo does not have trade dress rights in the design of its fire pit products and, even if it did, SAS' duraflame® Fire Pit and associated fire pit stand have not infringed and are not infringing any such trade dress rights.

COUNT VI

DECLARATION OF LACK OF DAMAGES TO SOLO

150. SAS repeats and incorporates by reference its allegations in each of the foregoing paragraphs as if fully set forth herein.

151. SAS seeks and is entitled to a declaratory judgment that Solo has no claim for damages from the alleged infringing activities because (a) the D163 and D858 patent are not infringed; (b) the D163 patent is invalid and unenforceable; (c) Solo has no protectable trade dress associated with its fire pit products; and (d) the marketing and sale of the duraflame® fire pit and associated fire pit stand does not infringe any purported Solo trade dress.

PLAINTIFF'S PRAYER FOR RELIEF

WHEREFORE, SAS respectfully requests that this Court enter judgment in its favor and grant the following relief:

- (a) A declaration that the manufacture, use, sale, offer to sell and/or importation of SAS' duraflame® Fire Pit has not infringed, induced infringement of, or contributorily infringed, and does not infringe, induce infringement of, and/or contributorily infringe the D163 patent;
- (b) A declaration that the manufacture, use, sale, offer to sell and/or importation of the fire pit stand associated with SAS' duraflame® Fire Pit has not infringed, induced infringement of, or contributorily infringed, and does not infringe, induce infringement of, and/or contributorily infringe the D858 patent;
- (c) A declaration that the D163 patent is invalid and void for failure to comply with one or more sections of Title 35 of the United States Code including, without limitation, 35 U.S.C. §§ 102, 103, and/or 171;
- (d) A declaration that the D163 patent is unenforceable due to inequitable conduct;
- (e) A declaration that Solo has no trade dress rights associated with the design of its fire pit products, and/or that SAS' duraflame® Fire Pit and associated fire pit stand have not infringed any such trade dress;
- (f) A declaration that Solo has no claim for damages from the alleged infringement of the D163 patent;
- (g) A declaration that Solo has no claim for damages from the alleged infringement of the D858 patent;

- (h) A declaration that Solo has no claim for damages from the alleged infringement of any purported trade dress rights associated with Solo's fire pit products;
- (i) A declaration that this case is "exceptional" within the meaning of 35 U.S.C. § 285;
- (j) An award to SAS of its costs, attorney fees, and expenses pursuant to 35 U.S.C. § 285 and as permitted by law; and
- (k) An award to SAS of any and all other just and reasonable relief to which it is entitled.

JURY DEMAND

SAS requests a trial by jury as to all issues triable by a jury.

Respectfully submitted,

Date: February 8, 2022
New York, New York

HOFFMANN & BARON, LLP

By: /s/ John T. Gallagher
John T. Gallagher
6900 Jericho Turnpike
Syosset, New York 11791
jgallagher@hbiplaw.com
(516) 822-3550

Daniel A. Scola, Jr. (*pro hac vice* forthcoming)
Michael I. Chakansky
4 Century Drive
Parsippany, New Jersey 07054
dscola@hbiplaw.com
chakansky@hbiplaw.com
(973) 331-1700

Attorneys for Plaintiff SAS Group, Inc.