IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

| | | |
|---|---|---|
| HILTI AKTIENGESELLSCHAFT,<br><br>Plaintiff,<br><br>v.<br><br>SPECIFIED TECHNOLOGIES INC.,<br><br>Defendant. | ) | C.A. No.<br><br>**TRIAL BY JURY DEMANDED** |

**COMPLAINT FOR PATENT INFRINGEMENT**

1. Plaintiff, Hilti Aktiengesellschaft ("Plaintiff" or "Hilti") files this Complaint for patent infringement and demand for jury trial against Defendant Specified Technologies Inc. ("Defendant" or "STI"), and alleges as follows:

**NATURE OF THE ACTION**

2. This is a civil action for patent infringement arising under the patent laws of the United States, 35 U.S.C. § 1, *et seq*., including 35 U.S.C. § 271, which gives rise to the remedies specified under 35 U.S.C. §§ 281 and 283-285.

**THE PARTIES**

3. Plaintiff Hilti is a corporation organized under the laws of Liechtenstein, with its principal place of business at Feldkircherstrasse 100, P.O. Box 333, 9494 Schaan, Principality of Liechtenstein.

4. Hilti's products and services are distributed in the United States by its subsidiary, Hilti, Inc. Hilti, Inc. employs approximately 3,500 individuals and is based in Plano, Texas where it has research and development facilities and corporate offices.

5. Upon information and belief, Defendant STI is a corporation organized under the laws of the State of Delaware, with its principal place of business at 210 Evans Way, Somerville, New Jersey 08876.

## JURISDICTION AND VENUE

6. This Court's jurisdiction over this action is proper under relevant statutes, including 35 U.S.C. § 271, *et seq.*, 28 U.S.C. § 1331 (federal question jurisdiction), and 28 U.S.C. § 1338 (jurisdiction over patent actions). The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a).

7. This Court has general personal jurisdiction over Defendant at least because Defendant is incorporated in Delaware and, upon information and belief, Defendant has committed acts of patent infringement in Delaware and Defendant regularly conducts business, solicits business, and/or derives substantial revenue from products provided within Delaware, including products that infringe Hilti's patented technology.

8. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1400(b) at least because Defendant is incorporated in Delaware.

## THE PATENTS-IN-SUIT

9. Founded in 1941 and based in Schaan, Principality of Liechtenstein, Hilti has, through its 80+-year history been a world leader and innovator across a variety of technical industries. Over the years, Hilti has expended significant resources on research, development, and innovation, and on capturing the fruits of those efforts in patent applications filed around the world. For example, Hilti's fire protection related patents born from this history of innovation

include U.S. Patent Nos. 10,138,629, 10,519,653, and 11,339,566 (collectively, the "Patents-in-Suit").

10. U.S. Patent No. 10,138,629 ("the '629 Patent"), titled "Facade Assembly, Building Structure, and Method for Mounting the Facade Assembly," was duly and legally issued by the United States Patent and Trademark Office on November 27, 2018. Hilti is the owner of the '629 Patent, with all substantial rights, including the exclusive right to enforce, sue, and recover damages for past and future infringements. A copy of the '629 Patent is attached as Exhibit 1.

11. U.S. Patent No. 10,519,653 ("the '653 Patent"), titled "Facade Assembly, Building Structure, and Method for Mounting the Facade Assembly," was duly and legally issued by the United States Patent and Trademark Office on December 31, 2019. Hilti is the owner of the '653 Patent, with all substantial rights, including the exclusive right to enforce, sue, and recover damages for past and future infringements. A copy of the '653 Patent is attached as Exhibit 2.

12. U.S. Patent No. 11,339,566 ("the '566 Patent"), titled "Dynamic, Fire-Resistance-Rated Thermally Insulating and Sealing System for Use with Curtain Wall Structures," was duly and legally issued by the United States Patent and Trademark Office on May 24, 2022. Hilti is the owner of the '566 Patent, with all substantial rights, including the exclusive right to enforce, sue, and recover damages for past and future infringements. A copy of the '566 Patent is attached as Exhibit 3.

## COUNT ONE

## INFRINGEMENT OF U.S. PATENT NO. 10,138,629

13. Hilti incorporates by reference the allegations in paragraphs 1-12 as if fully set forth herein.

14. On information and belief, Defendant has infringed claims of the '629 Patent, including at least claim 1, in violation of 35 U.S.C. § 271(b) by actively inducing its customers to make and/or use infringing assemblies.

15. Claim 1 of the '629 Patent recites:

> 1. A facade assembly for a building, comprising:
>
> at least one facade element, configured to be fastened to a wall or an inter-story ceiling of the building,
>
> at least one fire-protection element, configured to be mounted between the facade element and the wall or the inter-story ceiling, and
>
> a protective layer which covers the fire. protection element at least partly,
>
> wherein the fire-protection element comprises an insulating layer and at least one self-supporting angle profile with two flanges disposed at an angle relative to one another,
>
> wherein one of the flanges of the angle profile is fastened to the facade element and the other flange of the angle profile bears on the insulating layer, and
>
> wherein the protective layer comprises an elastic material.

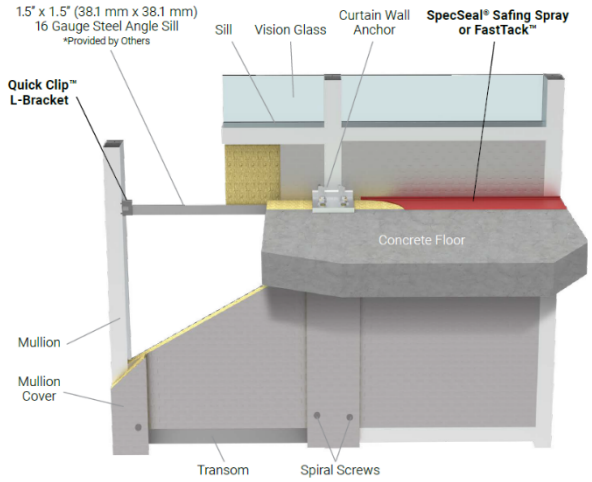
16. On information and belief, Defendant has indirectly infringed at least claim 1 of the '629 Patent by inducing infringement by others, such as Defendant's customers and end users, including customers and end users involved in the construction of buildings, in this District and elsewhere in the United States. For example, on information and belief, Defendant's customers and end users, including customers and end users involved in the construction of buildings, directly infringe through their making and using of the inventions claimed in the '629

Patent. Defendant induces this direct infringement through its affirmative acts of manufacturing, selling, distributing, and/or otherwise making available its SpecSeal® Safing Spray (the "Safing Spray"), and providing instructions for use, documentation, online technical support and videos, marketing, and other information to customers and end users suggesting they use the products in an infringing manner. As a result of Defendant's inducement, Defendant's customers and end users make and use the facade assembly for a building as intended by Defendant to directly infringe the '629 Patent. Defendant has performed and continues to perform these affirmative acts with knowledge or willful blindness of the '629 Patent and with the intent, or willful blindness, that the induced acts directly infringe the '629 Patent.

17. On information and belief, Defendant has been aware of and has had notice and actual knowledge of the '629 Patent and its infringement of the '629 Patent since at least as early as September 2022, and by no later than the filing of this Complaint. For example, Defendant was notified in a letter dated September 23, 2022 that Defendant is inducing its customers to infringe the '629 Patent at least by instructing its customers to make and/or use curtain walls that include the claimed features of the '629 Patent. *See* Exhibit 8 (September 23, 2022 notice letter and enclosed exhibits). A non-exhaustive analysis of Defendant's infringement was included in an attached claim chart directed to the '629 Patent. That letter serves as actual notice for the respective product(s) and for all substantially similar products.

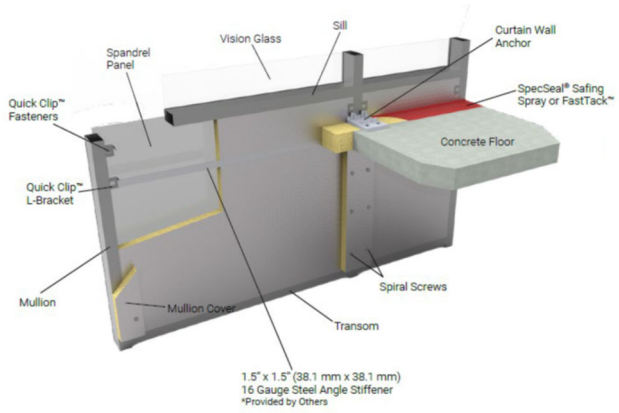
18. According to Defendant, the "SpecSeal® Safing Spray is a high solids, latex-based elastomeric coating specifically formulated for slab edge safing applications." *See* Exhibit 4 (Product Data Sheet for the SpecSeal® Safing Spray). Further, the "SpecSeal® Safing Spray is designed for use in curtain wall safing applications for perimeter fire barrier systems." ("Perimeter Fire Barrier System"). *Id.*

19. On information and belief, STI instructs customers to use a Perimeter Fire Barrier System as part of a facade assembly for a building. This Perimeter Fire Barrier System includes the Safing Spray. *See*, *e.g.*, Exhibit 5 (Quick Clip™ L-Bracket Perimeter Fire Barrier System Product Brochure) at 1, depicting a completed field installation of the Perimeter Fire Barrier System on a facade assembly:



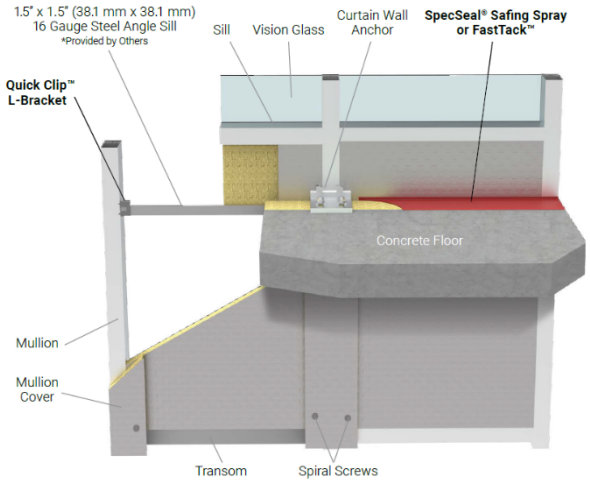

*Id*.

20. On information and belief, the Perimeter Fire Barrier System includes at least one facade element configured to be fastened to a wall or an inter-story ceiling of the building. *See*, *e.g.*, Exhibit 6 (SpecSeal® Quick Clip™ L-Bracket Perimeter Fire Containment System Product Data Sheet) at 1, depicting mullions, transoms, and vision glass (collectively, the "Facade") shown fastened to a floor/ceiling with a curtain wall anchor:

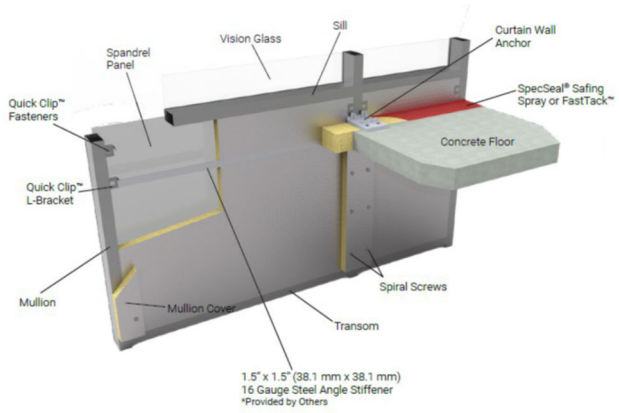



*Id*.

21. On information and belief, the Perimeter Fire Barrier System includes at least one fire-protection element configured to be mounted between the facade element and the wall or the inter-story ceiling. *See*, *e.g.*, Exhibit 5 at 1, depicting safing insulation between the Facade and the concrete floor:

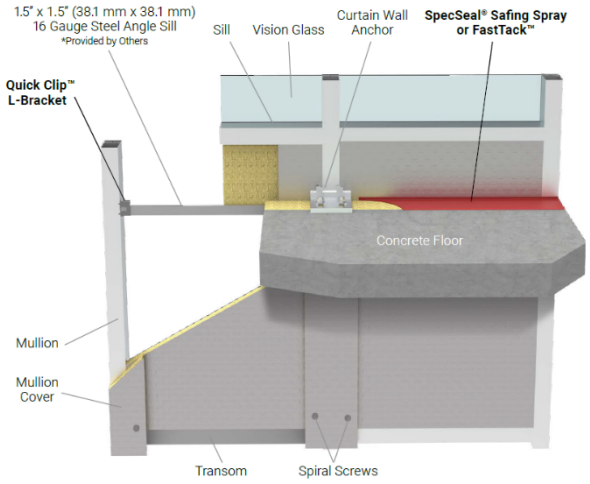



*Id*. *See also* Exhibit 6 at 1:

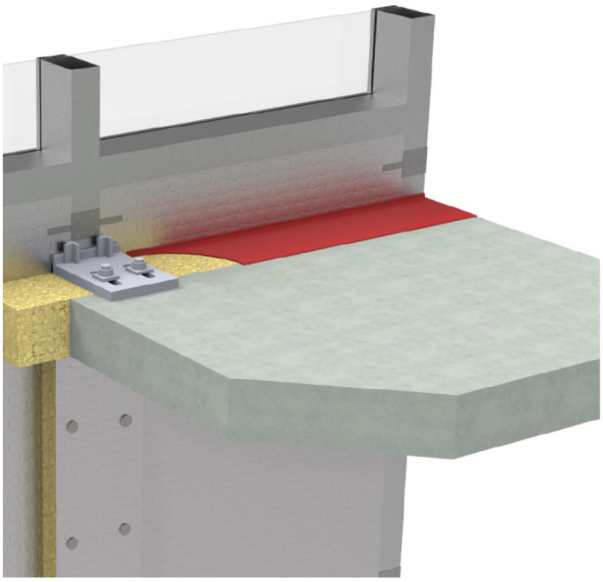



*Id*.

22. On information and belief, the Perimeter Fire Barrier System includes a protective layer which covers the fire protection element at least partly. *See*, *e.g.*, Exhibit 5 at 1, depicting a protective layer (SpecSeal® Safing Spray (*i.e.*, Safing Spray) or Fast Tack® in red) which covers the fire protection element at least partly:

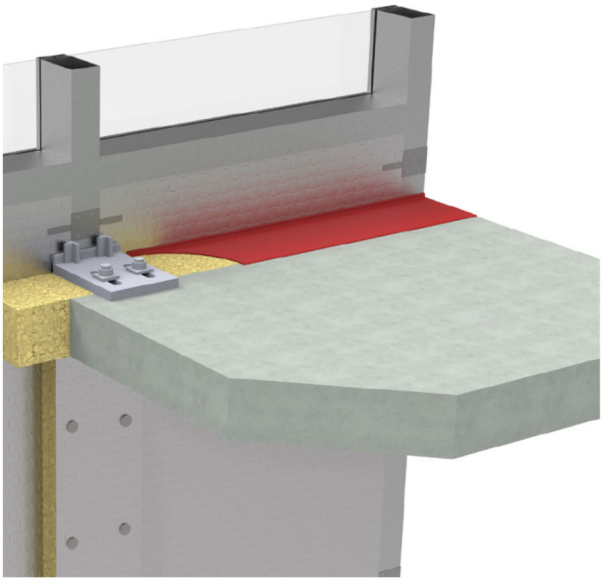



*Id*. *See also* Exhibit 4 (Product Data Sheet for the SpecSeal® Safing Spray ) at 1:



*Id*.

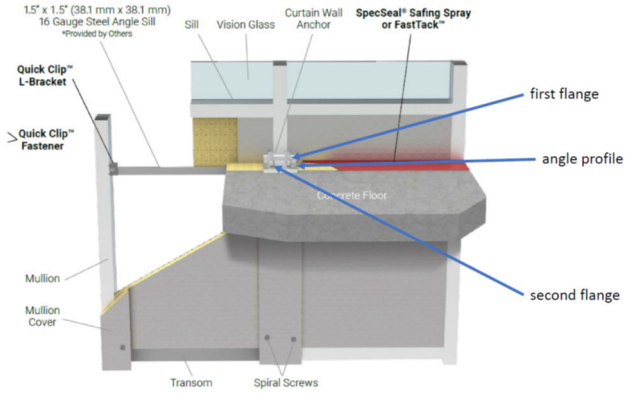
23. On information and belief, the fire-protection element in the Perimeter Fire Barrier System comprises an insulating layer. *See*, *e.g.*, Exhibit 4 at 1:



*Id*.

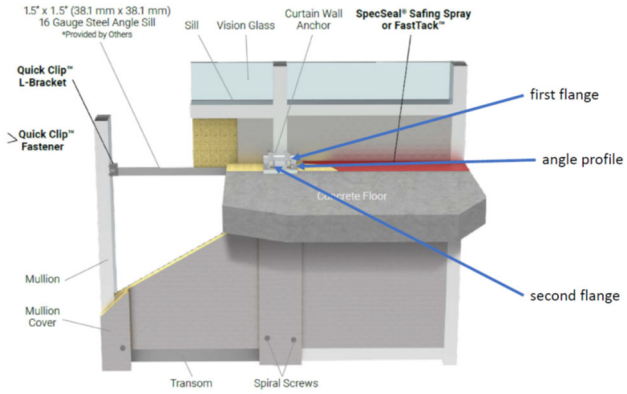
24. On information and belief, the fire-protection element in the Perimeter Fire Barrier System comprises at least one self-supporting angle profile with two flanges disposed at

an angle relative to one another. *See*, *e.g.*, Exhibit 5 at 1, depicting an angle profile (*i.e.*, curtain wall anchor) having a first flange and a second flange:



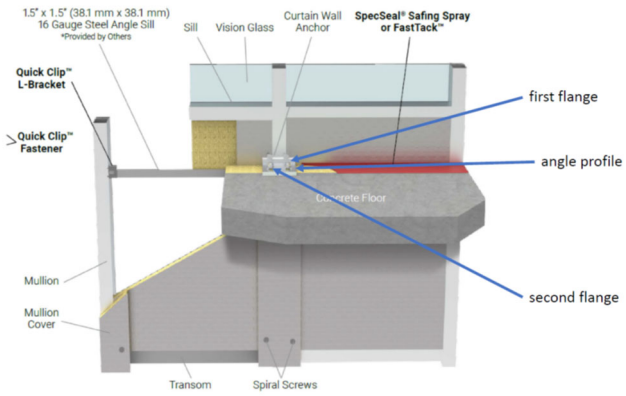

*Id*. (Annotated).

25. On information and belief, at least one of the flanges of the angle profile in the Perimeter Fire Barrier System is fastened to the facade element. *See*, *e.g.*, Exhibit 5 at 1, depicting the first flange of the angle profile (*i.e.*, curtain wall anchor) fastened to the Facade:




*Id*. (Annotated).

26. On information and belief, the other flange of the angle profile in the Perimeter Fire Barrier System bears on the insulating layer. *See, e.g.,* Exhibit 5 at 1, depicting the second flange of the angle profile (*i.e.*, curtain wall anchor) bearing on the insulating layer (*i.e.*, the safing insulation):




*Id*. (Annotated).

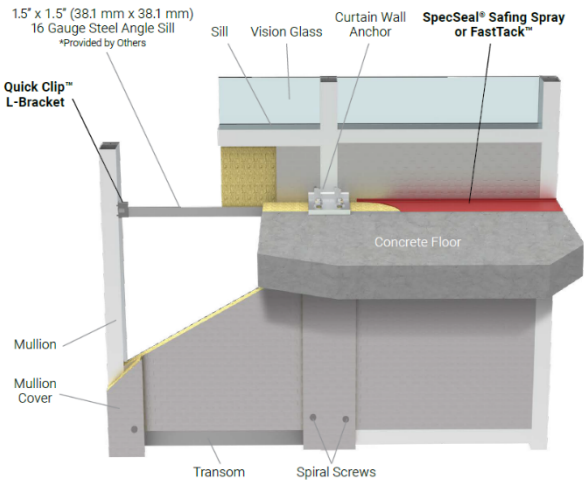
27. On information and belief, the protective layer in the Perimeter Fire Barrier System comprises an elastic material. *See*, *e.g.*, Exhibit 4 at 1: "SpecSeal® Safing Spray is a high solids, latex-based elastomeric coating specifically formulated for slab edge safing applications."

28. On information and belief, Defendant has also indirectly infringed at least claim 1 of the '629 Patent by inducing infringement by others, such as Defendant's customers and end users, including customers and end users involved in the construction of buildings, in this District and elsewhere in the United States. For example, on information and belief, Defendant's customers and end users, including customers and end users involved in the construction of buildings, directly infringe through their making and using of the inventions claimed in the '629 Patent. Defendant induces this direct infringement through its affirmative acts of manufacturing, selling, distributing, and/or otherwise making available its SpecSeal® Fast Tack® Firestop Spray (the "Firestop Spray"), and providing instructions for use, documentation, online technical support and videos, marketing, and other information to customers and end users suggesting they use the products in an infringing manner. As a result of Defendant's inducement, Defendant's customers and end users make and use the facade assembly for a building as intended by

Defendant to directly infringe the '629 Patent. Defendant has performed and continues to perform these affirmative acts with knowledge or willful blindness of the '629 Patent and with the intent, or willful blindness, that the induced acts directly infringe the '629 Patent.

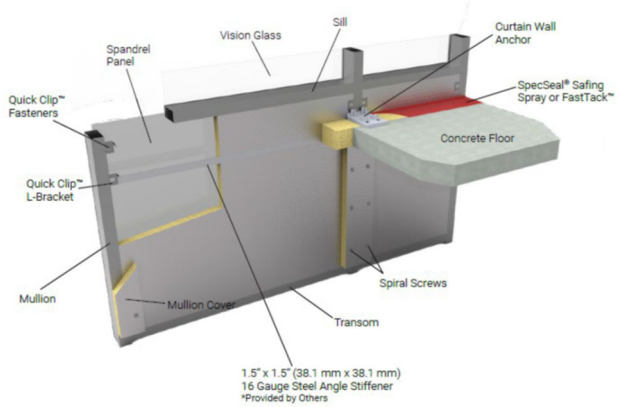
29. According to Defendant, the "SpecSeal® Fast Tack® Firestop Spray is an elastomeric single component advanced hybrid polymer spray coating designed to provide passive smoke and fire protection in construction joints." *See* Exhibit 7 (Product Data Sheet for the SpecSeal® Fast Tack® Firestop Spray). Further, the "SpecSeal® Fast Tack® Firestop Spray is designed primarily for the protection of construction joints and excels in curtain wall safing gap conditions, slab edge/curtain wall conditions, floor to floor joints, floor to wall joints, and vertical joints (columns or shear walls). *Id.*

30. On information and belief, STI instructs customers to use a Perimeter Fire Barrier System as part of a facade assembly for a building. This Perimeter Fire Barrier System includes the Firestop Spray. *See*, *e.g.*, Exhibit 5 (Quick Clip™ L- Bracket Perimeter Fire Barrier System Product Brochure) at 1, depicting a completed field installation of the Perimeter Fire Barrier System on a facade assembly:




*Id*.

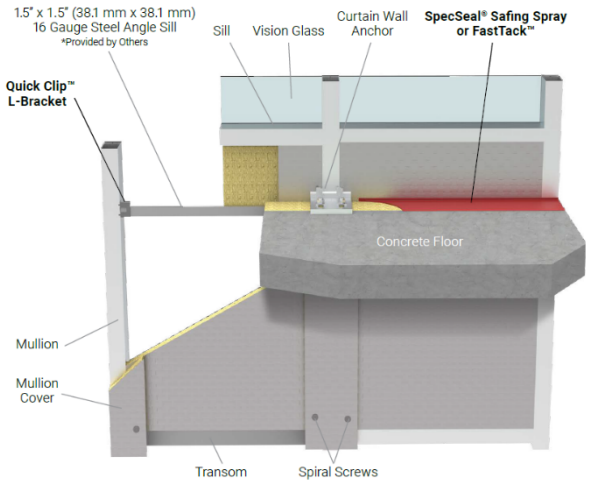
31. On information and belief, the Perimeter Fire Barrier System includes at least one facade element configured to be fastened to a wall or an inter-story ceiling of the building. *See*, *e.g.*, Exhibit 6 (SpecSeal® Quick Clip™ L-Bracket Perimeter Fire Containment System Product Data Sheet) at 1, depicting mullions, transoms, and vision glass (collectively, the "Facade") shown fastened to a floor/ceiling with a curtain wall anchor:



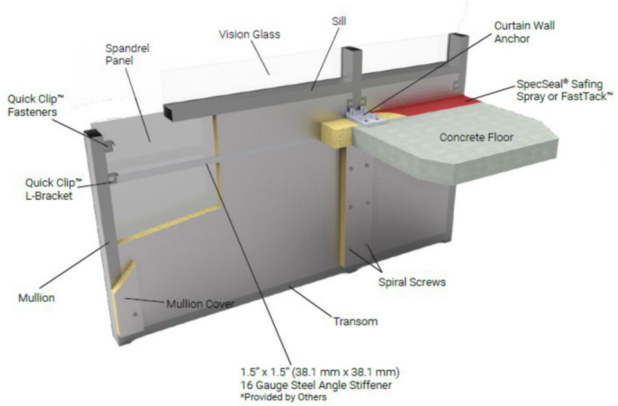

*Id*.

32. On information and belief, the Perimeter Fire Barrier System includes at least one fire-protection element configured to be mounted between the facade element and the wall or the

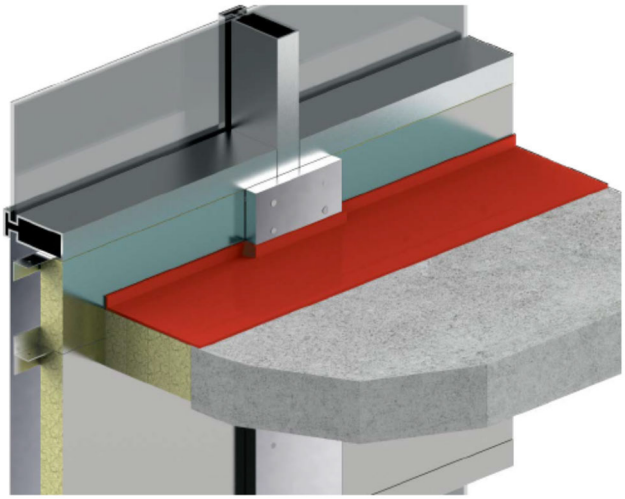
inter-story ceiling. *See*, *e.g.*, Exhibit 5 at 1, depicting safing insulation between the Facade and the concrete floor:




*Id*. *See also* Exhibit 6 at 1:

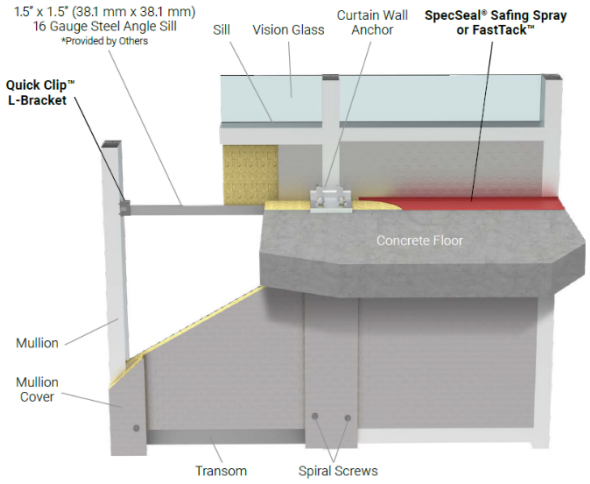



*Id*. *See also* Exhibit 7 (SpecSeal® Fast Tack® Firestop Spray Product Data Sheet) at 1:

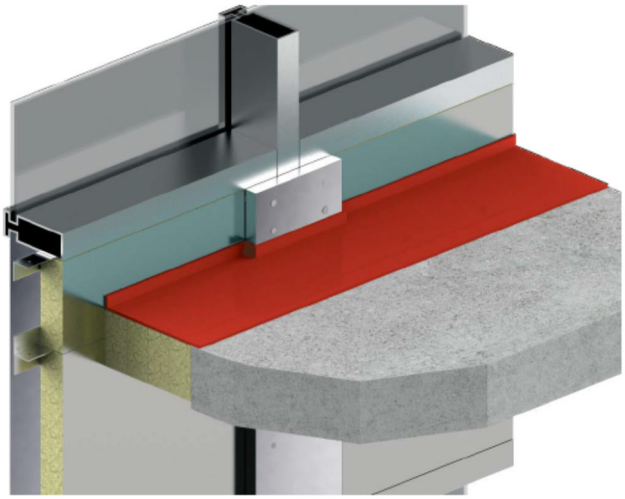


*Id*.

33. On information and belief, the Perimeter Fire Barrier System includes a protective layer which covers the fire protection element at least partly. *See*, *e.g.*, Exhibit 5 at 1, depicting a protective layer (SpecSeal® Safing Spray or Fast Tack® (*i.e.*, Firestop Spray) in red) which covers the fire protection element at least partly:

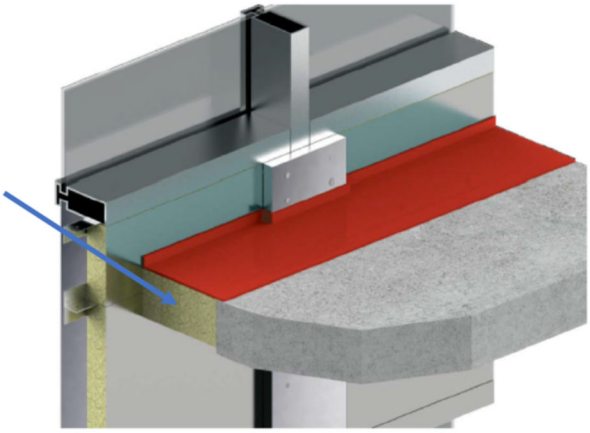



*Id*. *See also* Exhibit 7 (SpecSeal® Fast Tack® Product Data Sheet) at 1:



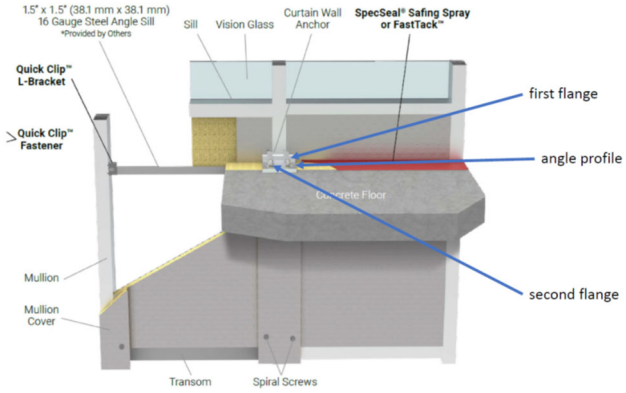
*Id*.

34. On information and belief, the fire-protection element in the Perimeter Fire Barrier System comprises an insulating layer. *See*, *e.g.*, Exhibit 7 at 1:



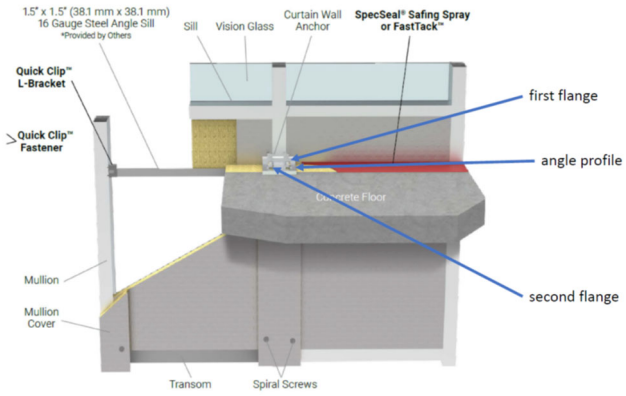
*Id*. (Annotated).

35. On information and belief, the fire-protection element in the Perimeter Fire Barrier System comprises at least one self-supporting angle profile with two flanges disposed at an angle relative to one another. *See*, *e.g.*, Exhibit 5 at 1, depicting an angle profile (*i.e.*, curtain wall anchor) having a first flange and a second flange:



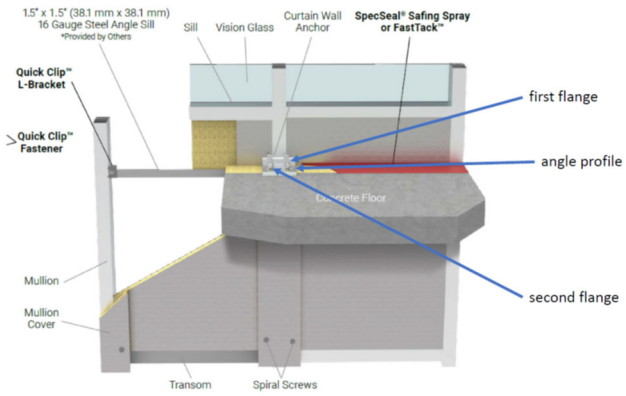

*Id*. (Annotated).

36. On information and belief, at least one of the flanges of the angle profile in the Perimeter Fire Barrier System is fastened to the facade element. *See*, *e.g.*, Exhibit 5 at 1, depicting the first flange of the angle profile (*i.e.*, curtain wall anchor) fastened to the Facade:




*Id*. (Annotated).

37. On information and belief, the other flange of the angle profile in the Perimeter Fire Barrier System bears on the insulating layer. *See, e.g.,* Exhibit 5 at 1, depicting the second flange of the angle profile (*i.e.*, curtain wall anchor) bearing on the insulating layer (*i.e.*, the safing insulation):




*Id*. (Annotated).

38. On information and belief, the protective layer in the Perimeter Fire Barrier System comprises an elastic material. *See*, *e.g.*, Exhibit 7 at 1: "SpecSeal® Fast Tack® Firestop Spray is an elastomeric single component advanced hybrid polymer spray coating…"

39. The full extent of Defendant's infringement is not presently known to Hilti. Hilti makes this preliminary identification of infringing products and infringed claims in Count One without the benefit of discovery or claim construction in this action, and expressly reserves the right to augment, supplement, and revise its identifications based on additional information obtained through discovery or otherwise.

40. Hilti has suffered damages, including specifically lost profits, as a result of Defendant's infringement of the '629 Patent in an amount to be determined at trial.

41. Defendant's infringement of the '629 Patent is causing irreparable harm for which Hilti has no adequate remedy at law unless Defendant is enjoined by this Court. Under 35 U.S.C. § 283, Hilti is entitled to a permanent injunction against further infringement of the '629 Patent.

## COUNT TWO

## INFRINGEMENT OF U.S. PATENT NO. 10,519,653

42. Hilti incorporates by reference the allegations in paragraphs 1-12 as if fully set forth herein.

43. On information and belief, Defendant has infringed claims of the '653 Patent, including at least claim 1, in violation of 35 U.S.C. § 271(b) by actively inducing its customers to make and/or use infringing assemblies.

44. Claim 1 of the '653 Patent recites:

> 1. A facade assembly for a building, comprising:
>
> at least one facade element, configured to be fastened to a wall or an inter-story ceiling of the building, and
>
> at least one fire-protection element, configured to be mounted between the facade element and the wall or the inter-story ceiling,
>
> wherein the fire-protection element comprises an insulating layer and at least one self-supporting angle profile with two flanges disposed at an angle relative to one another,
>
> wherein a first flange of the flanges of the angle profile extends in a first direction and is fastened to the facade element and a second flange of the flanges of the angle profile extends in a second direction corresponding to a direction in which the insulating layer extends, the second flange having a first surface and a second surface opposing the first surface, the first surface and the second surface of the second flange unfastened to the insulating layer, and wherein the first flange and the second flange are made of at least one metal.

45. On information and belief, Defendant has indirectly infringed at least claim 1 of the '653 Patent by inducing infringement by others, such as Defendant's customers and end users, including customers and end users involved in the construction of buildings, in this District and elsewhere in the United States. For example, on information and belief, Defendant's customers and end users, including customers and end users involved in the construction of

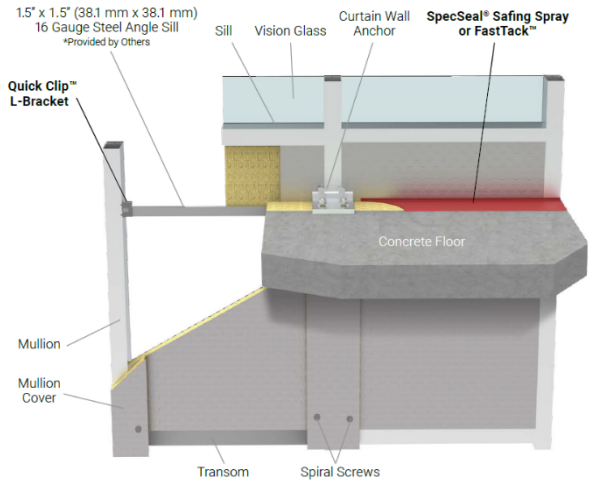
buildings, directly infringe through their making and using of the inventions claimed in the '653 Patent. Defendant induces this direct infringement through its affirmative acts of manufacturing, selling, distributing, and/or otherwise making available its Quick Clip™ L- Bracket Perimeter Fire Barrier System, and providing instructions for use, documentation, online technical support and videos, marketing, and other information to customers and end users suggesting they use the products in an infringing manner. As a result of Defendant's inducement, Defendant's customers and end users make and use the facade assembly for a building as intended by Defendant to directly infringe the '653 Patent. Defendant has performed and continues to perform these affirmative acts with knowledge or willful blindness of the '653 Patent and with the intent, or willful blindness, that the induced acts directly infringe the '653 Patent.

46. On information and belief, Defendant has been aware of and has had notice and actual knowledge of the '653 Patent and its infringement of the '653 Patent since at least as early as September 2022, and by no later than the filing of this Complaint. For example, Defendant was notified in a letter dated September 23, 2022 that Defendant is inducing its customers to infringe the '653 Patent at least by instructing its customers to make and/or use curtain walls that include the claimed features of the '653 Patent. *See* Exhibit 8 (September 23, 2022 notice letter and enclosed exhibits). A non-exhaustive analysis of Defendant's infringement was included in an attached claim chart directed to the '653 Patent. That letter serves as actual notice for the respective product(s) and for all substantially similar products.

47. According to Defendant, the "SpecSeal® Quick Clip™ L-Bracket Perimeter Fire Containment System is designed to accelerate the installation of curtain wall insulation for perimeter fire containment systems. Each L-Bracket is fastened into the mullion with steel screws to support the curtain wall insulation. Self-locking fasteners secure the insulation panels

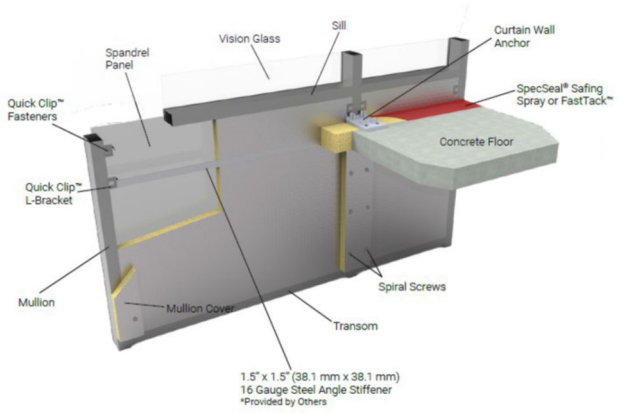
in place. The L-Bracket has a receiving slot to lock an 'L-shaped' stiffener channel in place without the need for mechanical attachment by screws." *See* Exhibit 6 (Product Data Sheet for the SpecSeal® Quick Clip™ L-Bracket Perimeter Fire Containment System).

48. On information and belief, STI instructs customers to use a Quick Clip™ L-Bracket Perimeter Fire Barrier System (the "L-Bracket Perimeter Fire Barrier System") as part of a facade assembly for a building. This L-Bracket Perimeter Fire Barrier System includes STI's Quick Clip™ L-Brackets and Quick Clip™ Fasteners. *See*, *e.g.*, Exhibit 5 at 1, depicting a completed field installation of the Perimeter Fire Barrier System on a facade assembly:




*Id*.

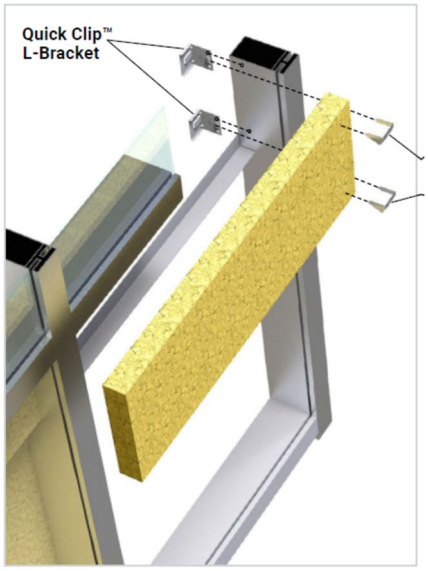
49. On information and belief, the L-Bracket Perimeter Fire Barrier System includes at least one facade element configured to be fastened to a wall or an inter-story ceiling of the building. *See*, *e.g.*, Exhibit 6 at 1 depicting mullions, transoms, and vision glass (collectively, the "Facade") shown fastened to a floor/ceiling with a curtain wall anchor:



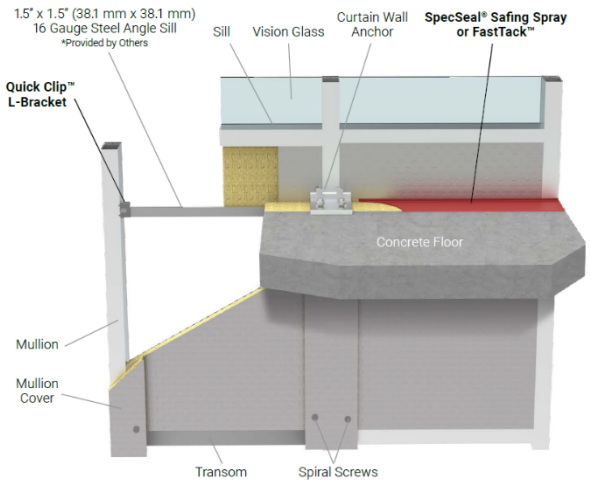

*Id*.

50. On information and belief, the L-Bracket Perimeter Fire Barrier System includes at least one fire-protection element configured to be mounted between the facade element and the wall or the inter-story ceiling. *See*, *e.g.*, the Exhibit 5 at 1 depicting curtain wall insulation mounted between the facade element (on one side of the insulation) and the concrete floor (on the other side of the insulation):

**Quick Clip™**
**Perimeter Fire Barrier System**
**Exploded View**
(shown from exterior)



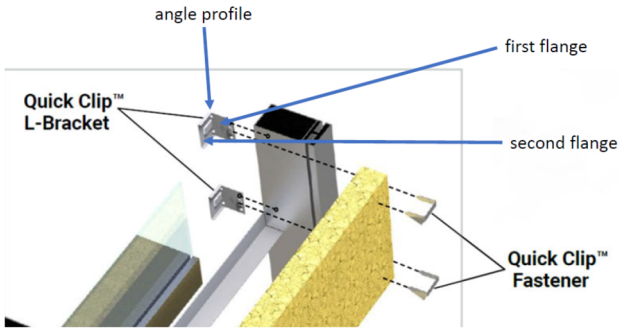

*Id*. *See also id.*:




*Id.*

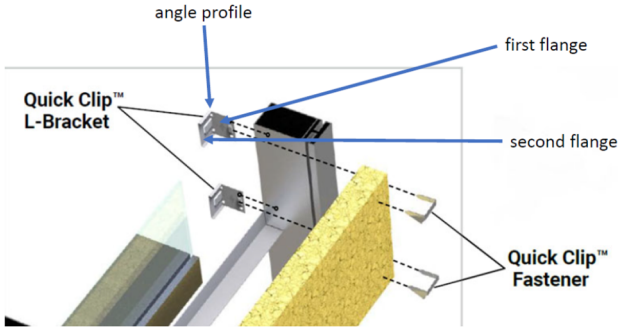
51. On information and belief, the fire-protection element in the L-Bracket Perimeter Fire Barrier System comprises an insulating layer. *See*, *e.g.*, Exhibit 5 at 1 depicting the insulating layer (yellow curtain wall insulation) and stating, "SpecSeal® Quick Clip™ L-Bracket Perimeter Fire Barrier System is the fastest way to install curtain wall insulation for perimeter fire barrier systems. Simply fasten the L-shaped brackets to the mullion, cut and fit the curtain wall insulation, and then secure the insulation in place with self-locking fasteners." *See also* Exhibit 6 at 1 depicting the insulating layer (yellow curtain wall insulation) and stating, "The SpecSeal® Quick Clip™ L-Bracket Perimeter Fire Containment System is designed to accelerate the installation of curtain wall insulation for perimeter fire containment systems. Each L-Bracket is fastened into the mullion with steel screws to support the curtain wall insulation. Self-locking fasteners secure the insulation panels in place."

52. On information and belief, the fire-protection element in the L-Bracket Perimeter Fire Barrier System includes at least one self-supporting angle profile with two flanges disposed at an angle relative to one another. For example, Exhibit 5 at 1 depicts an L-bracket that has two flanges disposed at an angle relative to one another:



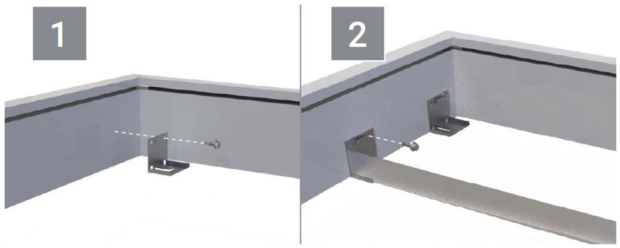

*Id.* (Annotated).

53. On information and belief, a first flange of the flanges of the angle profile in the L-Bracket Perimeter Fire Barrier System extends in a first direction and is fastened to the facade element. For example, Exhibit 5 at 1 depicts a first flange that extends in a first direction and is fastened to the Facade (see screw holes in first flange and in mullion):

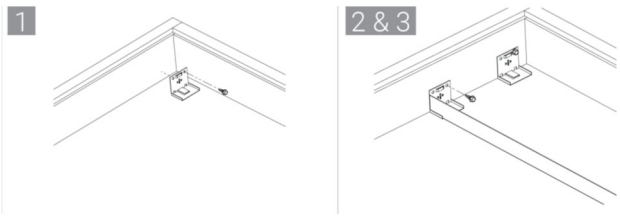



*Id.* (Annotated).

54. For example, Exhibit 5 at 2 shows "[t]he easiest factory installed system available today" and depicts, at steps 1 and 2 the first flange being fastened to the Facade:

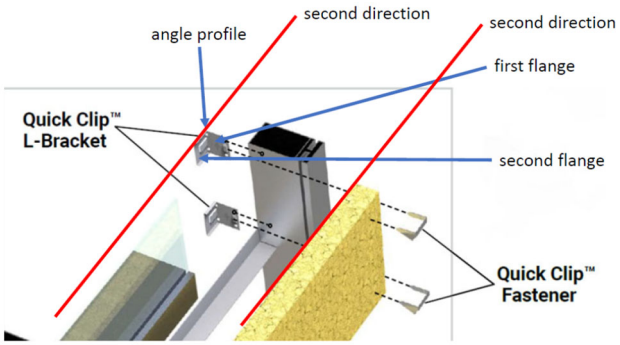


*Id*. *See also* Exhibit 9 (Installation Instructions - SpecSeal® Quick Clip™ L-Bracket Perimeter Fire Barrier System Factory Installation at 1 depicting the first flange being fastened to the Facade:



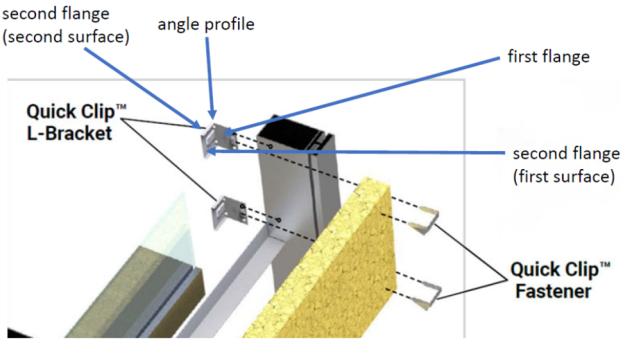

*Id*.

55. On information and belief, a second flange of the flanges of the angle profile in the L-Bracket Perimeter Fire Barrier System extends in a second direction in which the insulating layer extends. For example, as shown in Exhibit 5 at 1, the second flange extends in a second direction corresponding to a direction in which the insulating layer extends:



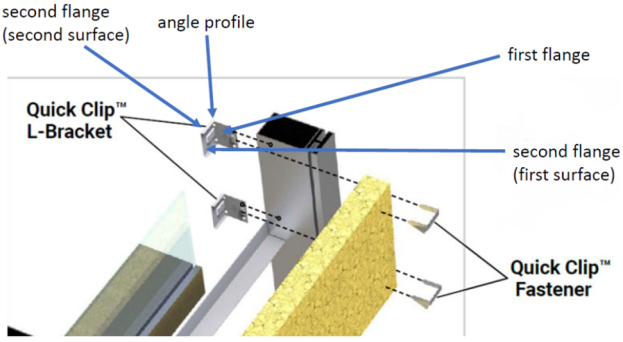

*Id*. (Annotated).

56. On information and belief, the second flange of the flanges of the angle profile in the L-Bracket Perimeter Fire Barrier System has a first surface and a second surface opposing the first surface. For example, Exhibit 5 depicts the second flange as having a first surface and a second surface opposing the first surface:




*Id.* (Annotated).

57. On information and belief, the first surface and the second surface of the second flange in the L-Bracket Perimeter Fire Barrier System are unfastened to the insulating layer. For example, Exhibit 5 at 1 depicts the Quick Clip™ Fasteners being inserted through the insulating layer and into the first flange, while the first surface and second surface of the second flange are unfastened to the insulating layer:




*Id*. (Annotated).

58. On information and belief, the first flange and the second flange of the angle bracket in the L-Bracket Perimeter Fire Barrier System are made of at least one metal. For example, Exhibit 6 at 2 identifies the "Material" of the brackets as "Galvanized steel":

| Catalog Number | UPC Number | Product Name | Product Image | Mullion Width | Insulation Thickness | Weight (Each) | Case Qty. | Material |
|---|---|---|---|---|---|---|---|---|
| SC20B | 730573100271 | Quick Clip™ L-Bracket | | | 2" (50.8 mm) | 0.09 lbs (0.04 kg) | 100 | |
| SC30B | 730573100288 | Quick Clip™ L-Bracket | | All | 3" (76.2 mm) | 0.11 lbs (0.05 kg) | 100 | Galvanized steel |
| SC40B | 730573100295 | Quick Clip™ L-Bracket | | | 4" (101.6 mm) | 0.13 lbs (0.06 kg) | 100 | |

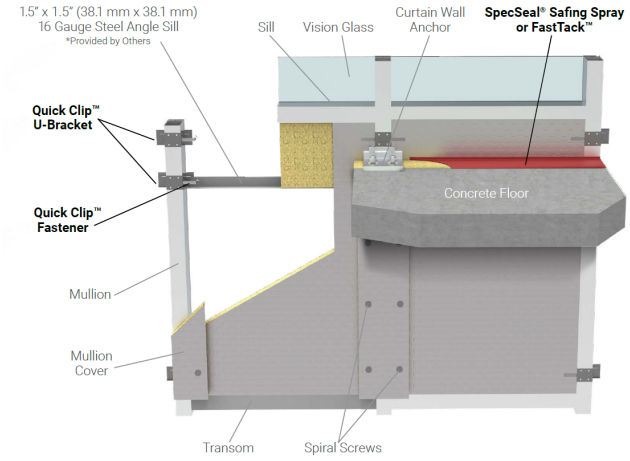
*Id*.

59. On information and belief, Defendant has also indirectly infringed at least claim 1 of the ’653 Patent by inducing infringement by others, such as Defendant’s customers and end users, including customers and end users involved in the construction of buildings, in this District and elsewhere in the United States. For example, on information and belief, Defendant’s customers and end users, including customers and end users involved in the construction of buildings, directly infringe through their making and using of the inventions claimed in the ’653 Patent. Defendant induces this direct infringement through its affirmative acts of manufacturing, selling, distributing, and/or otherwise making available its SpecSeal® Quick Clip™ Perimeter Fire Containment System (the “U/Z Bracket Perimeter Fire Barrier System”), and providing instructions for use, documentation, online technical support and videos, marketing, and other information to customers and end users suggesting they use the products in an infringing manner. As a result of Defendant’s inducement, Defendant’s customers and end users make and use the facade assembly for a building as intended by Defendant to directly infringe the ’653 Patent. Defendant has performed and continues to perform these affirmative acts with knowledge or willful blindness of the ’653 Patent and with the intent, or willful blindness, that the induced acts directly infringe the ’653 Patent.

60. According to Defendant, “[t]he SpecSeal® Quick Clip™ Perimeter Fire Containment System is designed to accelerate the installation of curtain wall insulation for perimeter fire containment systems. The system’s unique U-Brackets clip onto the mullions without direct attachment by screws to support the curtain wall insulation. Self-locking fasteners secure the insulation panels in place. Each U-Bracket has a receiving slot to lock an ‘L-shaped’ stiffener channel in place without the need for mechanical attachment by screws. Traditional

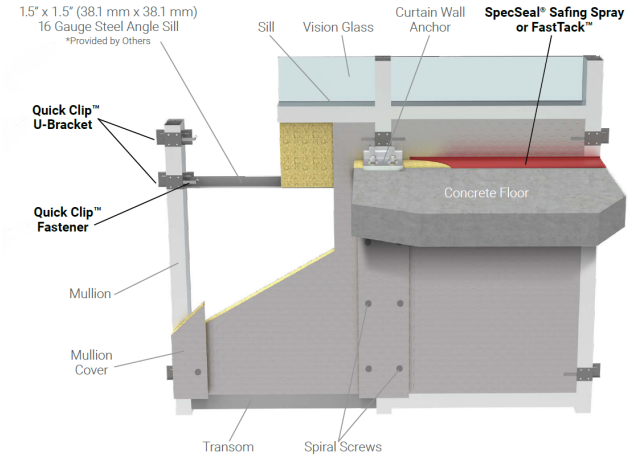
methods for curtain wall insulation support often require light gauge metal to be cut and fabricated onsite and fastened into mullions with screws. The Quick Clip™ U-Brackets lock into place on the mullion with a strike from a mallet. The Quick Clip™ Z-Brackets attach to the mullion using screws for corner or non-standard applications." *See* Exhibit 10 at 1.

61. On information and belief, STI instructs customers to use a U/Z Bracket Perimeter Fire Barrier System as part of a facade assembly for a building. This U/Z Bracket Perimeter Fire Barrier System includes STI's Quick Clip™ U-Brackets, Z-Brackets and Quick Clip™ Fasteners. *See*, *e.g.*, Exhibit 11 (Quick Clip™ Perimeter Fire Barrier System Product Brochure (the "Bracket Brochure") at 1, depicting a completed field installation of the Perimeter Fire Barrier System on a facade assembly:



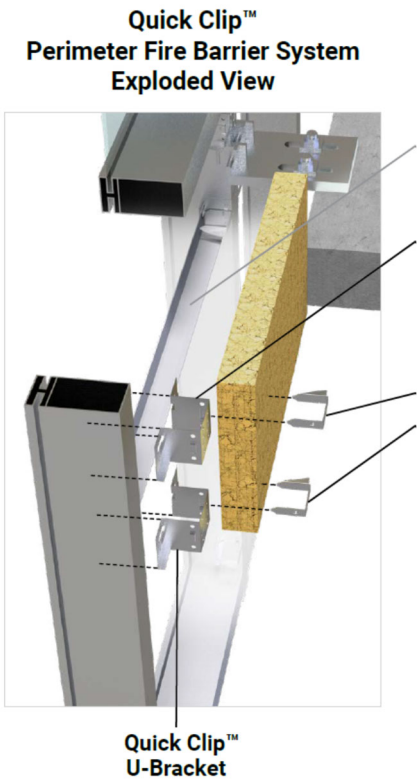

*Id*.

62. On information and belief, the U/Z Bracket Perimeter Fire Barrier System includes at least one facade element configured to be fastened to a wall or an inter-story ceiling of the building. *See*, *e.g.*, Exhibit 11 at 1 depicting mullions, transoms, and vision glass (collectively, the "Facade") shown fastened to a floor/ceiling with a curtain wall anchor:

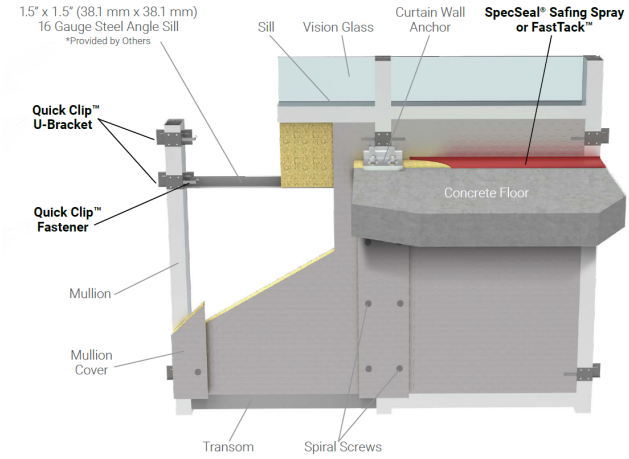



*Id*.

63. On information and belief, the U/Z Bracket Perimeter Fire Barrier System includes at least one fire-protection element configured to be mounted between the facade element and the wall or the inter-story ceiling. *See*, *e.g.*, Exhibit 11 at 1 depicting curtain wall insulation mounted between the facade element (on one side of the insulation) and the concrete floor (on the other side of the insulation):




*Id*. *See also id.*:

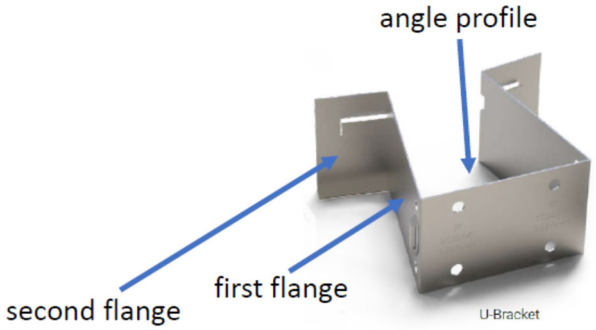



*Id.*

64. On information and belief, the fire-protection element in the U/Z Bracket Perimeter Fire Barrier System comprises an insulating layer. *See*, *e.g.*, Exhibit 11 at 1 depicting the insulating layer (yellow curtain wall insulation) and stating, "SpecSeal® Quick Clip™

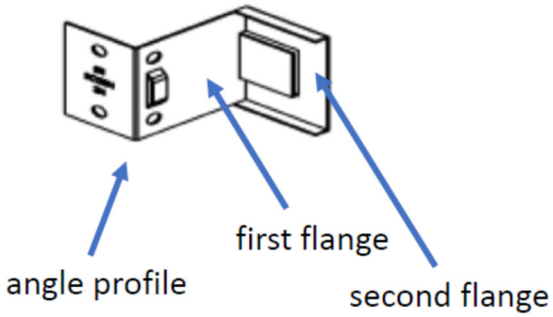
Perimeter Fire Barrier System is designed to accelerate the installation of curtain wall insulation for perimeter fire barrier systems. The system's unique U-brackets clip onto the mullions without direct attachment by screws to support the curtain wall insulation. Self-locking fasteners secure the insulation panels in place."

65. On information and belief, the fire-protection element in the U/Z Bracket Perimeter Fire Barrier System includes at least one self-supporting angle profile with two flanges disposed at an angle relative to one another. For example, Exhibit 11 at 1 depicts a U-bracket that has two flanges disposed at an angle relative to one another:



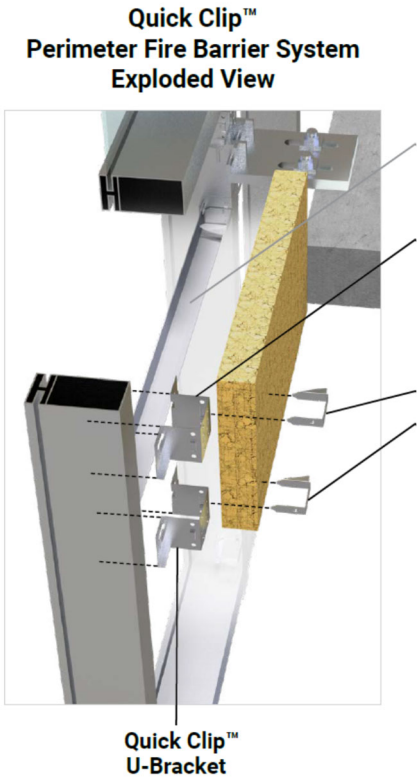

*Id.* (Annotated).

66. Similarly, Exhibit 11 at 2 depicts a Z-bracket that has two flanges disposed at an angle relative to one another:

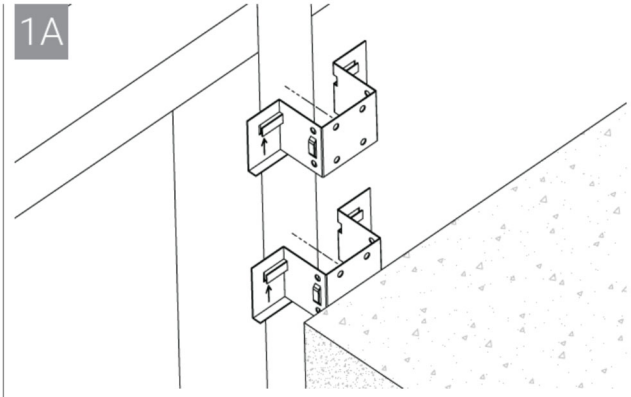



*Id.* (Annotated).

67. On information and belief, a first flange of the flanges of the angle profile in the U/Z Bracket Perimeter Fire Barrier System extends in a first direction and is fastened to the facade element. For example, Exhibit 11 at 1 depicts a first flange of the U-bracket that extends in a first direction and is fastened to the Facade (see screw holes in first flange and in mullion and/or friction mount):

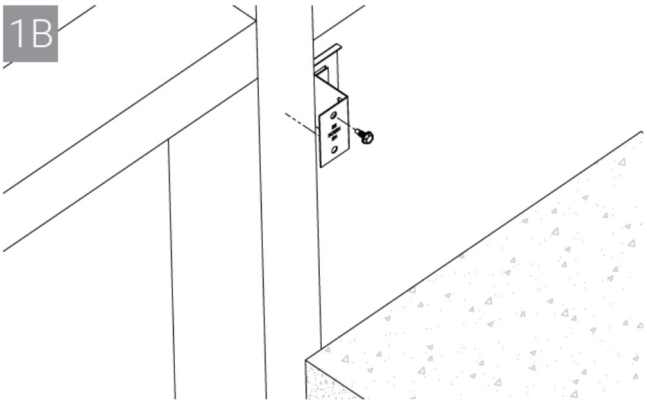



*Id*. *See also* Exhibit 12 (Installation Instructions - SpecSeal® Quick Clip™ Perimeter Fire Barrier System (Field Installation) at 1 depicting the first flange of the U-bracket being fastened to the facade:




Clip U-Bracket onto mullions (vertical framing) nominally 2" (51 mm) from bottom of sill, flush with the bottom of the floor and 2" (51 mm) from the top of the transoms (horizontal framing) below the floor. U-Brackets lock into place with a strike of a mallet.

*Id*. *See also id.* depicting the first flange of the Z-bracket being fastened to the Facade:




Attach Z-Bracket to mullion (vertical framing) using minimum of one No. 10 by min 1/2" long self-drilling, self-tapping steel screw or as specified in the applicable UL System. Z-Bracket to be located nominally 2" (51 mm) from bottom of sill and 2" (51 mm) from of the top of the transoms (horizontal framing) below the floor.

*Id.*

68. On information and belief, a second flange of the flanges of the angle profile in the U/Z Bracket Perimeter Fire Barrier System extends in a second direction in which the insulating layer extends.

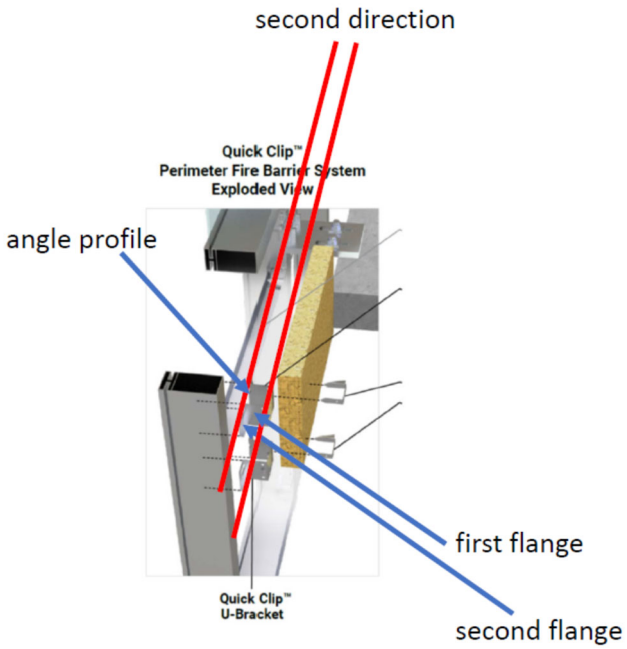
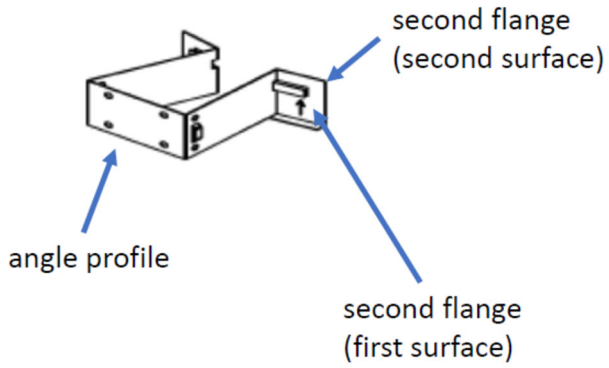



Exhibit 11 (annotated).

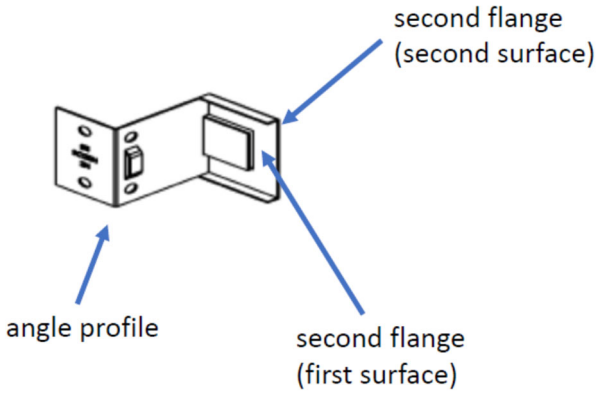
69. On information and belief, the Z-bracket would have the same orientation in an installed state and, thus, also has a second flange that extends in a second direction corresponding to a direction in which the insulating layer extends.

70. On information and belief, the second flange of the flanges of the angle profile in the U/Z Bracket Perimeter Fire Barrier System has a first surface and a second surface opposing the first surface. For example, Exhibit 11 at 2 depicts the second flange of the U-bracket as having a first surface and a second surface opposing the first surface:



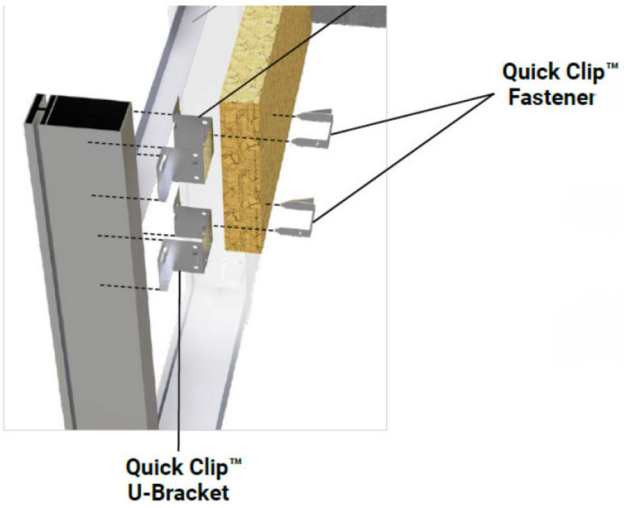
*Id*. (Annotated).

71. Similarly, Exhibit 11 at 2 depicts the second flange of the Z-bracket as having a first surface and a second surface opposing the first surface:




*Id*. (Annotated).

72. On information and belief, the first surface and the second surface of the second flange in the U/Z Bracket Perimeter Fire Barrier System are unfastened to the insulating layer. For example, Exhibit 11 at 1 depicts the Quick Clip™ Fasteners being inserted through the insulating layer and into the first flange, while the first surface and second surface of the second flange are unfastened to the insulating layer:



*Id.*

73. On information and belief, the Z-bracket would have the same orientation in an installed state and, thus, would also have a first surface and second surface of the second flange unfastened to the insulating layer.

74. On information and belief, the first flange and the second flange of the angle bracket in the U/Z Bracket Perimeter Fire Barrier System are made of at least one metal. For example, the Bracket Brochure Sheet at 2 identifies the "Material" of the U-bracket as "Heat treated galvanized steel" and the Z-bracket as "Galvanized steel":

| Catalog Number | UPC Number | Description | Product Image | Mullion Width | | Insulation | Weight (Each) | Case Qty. | Material |
|---|---|---|---|---|---|---|---|---|---|
| | | | | Min. | Max. | | | | |
| SC25020 | 730573100011 | Quick Clip™ U-Bracket* |  | 2.375" (60.3 mm) | 2.525" (65.1 mm) | 2" (50.8 mm) | 0.31 lbs (0.14 kg) | 100 | Heat treated galvanized steel |
| SC25030 | 730573100028 | Quick Clip™ U-Bracket* |  | | | 3" (76.2 mm) | 0.28 lbs (0.13 kg) | 100 | |
| SC25040 | 730573100035 | Quick Clip™ U-Bracket* |  | | | 4" (101.6 mm) | 0.32 lbs (0.15 kg) | 100 | |
| SC30020 | 730573100042 | Quick Clip™ U-Bracket |  | 2.875" (73 mm) | 3.2" (81.2 mm) | 2" (50.8 mm) | 0.25 lbs (0.11 kg) | 100 | Heat treated galvanized steel |
| SC30030 | 730573100059 | Quick Clip™ U-Bracket |  | | | 3" (76.2 mm) | 0.30 lbs (0.14 kg) | 100 | |
| SC30040 | 730573100066 | Quick Clip™ U-Bracket |  | | | 4" (101.6 mm) | 0.35 lbs (0.16 kg) | 100 | |
| SC32520 | 730573100073 | Quick Clip™ U-Bracket |  | 3.125" (79.4 mm) | 3.45" (87.6 mm) | 2" (50.8 mm) | 0.25 lbs (0.11 kg) | 100 | Heat treated galvanized steel |
| SC32530 | 730573100028 | Quick Clip™ U-Bracket |  | | | 3" (76.2 mm) | 0.30 lbs (0.14 kg) | 100 | |
| SC32540 | 730573100097 | Quick Clip™ U-Bracket |  | | | 4" (101.6 mm) | 0.34 lbs (0.15 kg) | 100 | |
| SC20H | 730573100103 | Quick Clip™ Z-Bracket |  | All | All | 2" (50.8 mm) | 0.13 lbs (0.06 kg) | 100 | Galvanized steel |
| SC30H | 730573100110 | Quick Clip™ Z-Bracket |  | | | 3" (76.2 mm) | 0.15 lbs (0.07 kg) | 100 | |
| SC40H | 730573100127 | Quick Clip™ Z-Bracket |  | | | 4" (101.6 mm) | 0.14 lbs (0.06 kg) | 100 | |

*Id.*

75. The full extent of Defendant's infringement is not presently known to Hilti. Hilti makes this preliminary identification of infringing products and infringed claims in Count Two without the benefit of discovery or claim construction in this action, and expressly reserves the right to augment, supplement, and revise its identifications based on additional information obtained through discovery or otherwise.

76. Hilti has suffered damages, including specifically lost profits, as a result of Defendant's infringement of the '653 Patent in an amount to be determined at trial.

77. Defendant's infringement of the '653 Patent is causing irreparable harm for which Hilti has no adequate remedy at law unless Defendant is enjoined by this Court. Under 35 U.S.C. § 283, Hilti is entitled to a permanent injunction against further infringement of the '653 Patent.

## COUNT THREE

## INFRINGEMENT OF U.S. PATENT NO. 11,339,566

78. Hilti incorporates by reference the allegations in paragraphs 1-12 as if fully set forth herein.

79. On information and belief, Defendant has infringed claims of the '566 Patent, including at least claim 1, in violation of 35 U.S.C. § 271(b) by actively inducing its customers to make and/or use infringing systems.

Claim 1 of the '566 Patent recites:

> 1. A dynamic, thermally insulating and sealing system for effectively thermally insulating and sealing of a safing slot within a building construction, having a curtain wall construction defined by an interior wall surface including at least one vertical framing member and at least one horizontal framing member and at least one floor spatially disposed from the interior wall surface of the curtain wall construction, thereby defining the safing slot extending between the interior wall surface of the curtain wall construction and an outer edge of the floor, the system comprising:
>
> a first element comprised of a plate having opposing edges and an inner and an outer surface, wherein the plate is recessed from an inner side of the at least one vertical framing member and extends below the vertical framing member in an installed state;
>
> at least one supplemental element configured to attach the first element to at least one side of the horizontal and/or vertical framing member of the curtain wall construction in the installed state,
>
> a second element comprised of a thermally resistant material for insulating, wherein the second element includes:

an outer primary end surface adjacent to the inner surface of the first element;

an inner primary end surface positionable spatially disposed from the outer edge of the floor in the installed state for sealing thereadjacent; and

a lower primary surface and an upper primary surface extending between the opposing edges of the first element, and

a third element comprised of a thermally resistant material for insulating and positioned in the safing slot in the installed state, wherein the third element includes:

an inner primary end surface adjacent to the outer edge of the floor in the installed state for sealing thereadjacent;

an outer primary end surface adjacent to the inner primary end surface of the second element and spatially disposed from the inner surface of the first element; and

a lower primary surface and an upper primary surface extending between the opposing edges of the first element, and wherein the plate has a moment of inertia that is sufficient enough to keep a second element and a third element in place.

80. On information and belief, Defendant has indirectly infringed at least claim 1 of the ’566 Patent by inducing infringement by others, such as Defendant’s customers and end users, including customers and end users involved in the construction of buildings, in this District and elsewhere in the United States. For example, on information and belief, Defendant’s customers and end users, including customers and end users involved in the construction of buildings, directly infringe through their making and using of the inventions claimed in the ’566 Patent. Defendant induces this direct infringement through its affirmative acts of distributing materials relating to a system marketed as STI’s “Zero” Spandrel System (Intertek System number: STI/BPF120-03) (the “‘Zero’ Spandrel System”), and providing instructions for use, documentation, online technical support and videos, marketing, and other information to customers and end users suggesting they assemble this “Zero” Spandrel System in an infringing

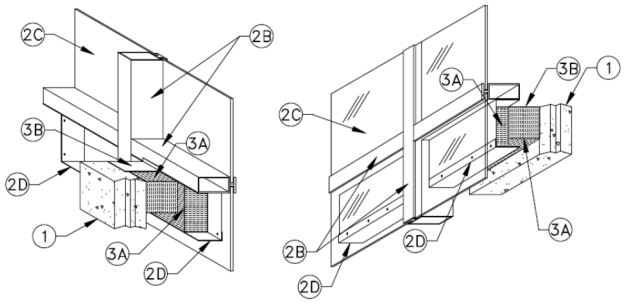
manner. As a result of Defendant's inducement, Defendant's customers and end users make and use the dynamic, thermally insulating and sealing system as intended by Defendant to directly infringe the '566 Patent. Defendant has performed and continues to perform these affirmative acts with knowledge or willful blindness of the '566 Patent and with the intent, or willful blindness, that the induced acts directly infringe the '566 Patent.

81. On information and belief, Defendant has been aware of and has had notice and actual knowledge of the '566 Patent and its infringement of the '566 Patent since at least as early as September 2022, and by no later than the filing of this Complaint. For example, Defendant was notified in a letter dated September 23, 2022 that Defendant is inducing its customers to infringe the '566 Patent at least by instructing its customers to make and/or use spandrel system walls that include the claimed features of the '566 Patent. *See* Exhibit 8 (September 23, 2022 notice letter and enclosed exhibits). A non-exhaustive analysis of Defendant's infringement was included in an attached claim chart directed to the '566 Patent. That letter serves as actual notice for the respective product(s) and for all substantially similar products.

82. On information and belief, the "Zero" Spandrel System is a dynamic, thermally insulating and sealing system for effectively thermally insulating and sealing of a safing slot within a building construction, having a curtain wall construction. *See*, *e.g.*, Exhibit 13 (the Burn Newsletter, Summer 2020, "STI's 'Zero' Spandrel System") at 1 ("…voids created at the intersection of the exterior curtain wall assemblies and such floor assemblies shall be sealed with an approved system to prevent the interior spread of fire.").

83. On information and belief, the curtain wall construction in the "Zero" Spandrel System is defined by an interior wall surface including at least one vertical and at least one

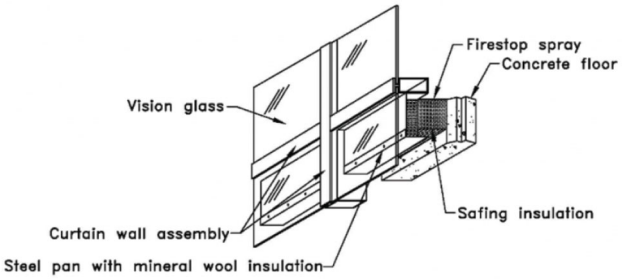
horizontal framing member. *See* Exhibit 14 (Specified Technologies, Inc. Design No. STI/BPF 120-03 Perimeter Fire Barrier System – Curtain Wall) at 1:




*Id.*

84. The interior wall surface is defined by the inside of 2B and 2C, with vertical and horizontal members 2B.

85. On information and belief, the curtain wall construction in the "Zero" Spandrel System is defined by at least one floor spatially disposed from the interior wall surface of the curtain wall construction. *See*, *e.g.*, Exhibit 15 (The Burn Newsletter, Winter 2021, "IBC Slab Edge Perimeter Fire Containment Requirements: A-Voiding a Misunderstanding") at 6:

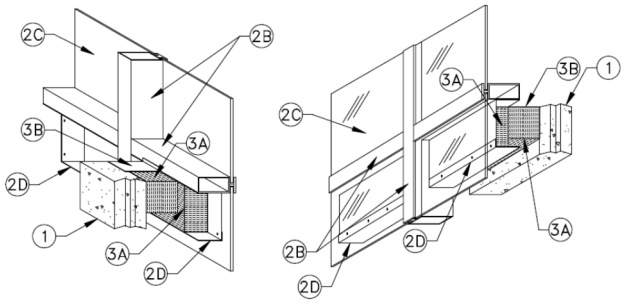



*Id.*

86. The concrete floor assembly 1 is shown spatially disposed from the interior wall surface of the curtain wall construction.

87. On information and belief, the at least one floor spatially disposed from the interior wall surface of the curtain wall construction in the curtain wall construction in the

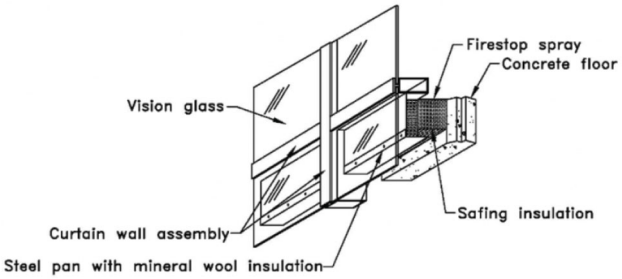
"Zero" Spandrel System defines the safing slot extending between the interior wall surface of the curtain wall construction and an outer edge of the floor. *See* Exhibit 14 at 1:



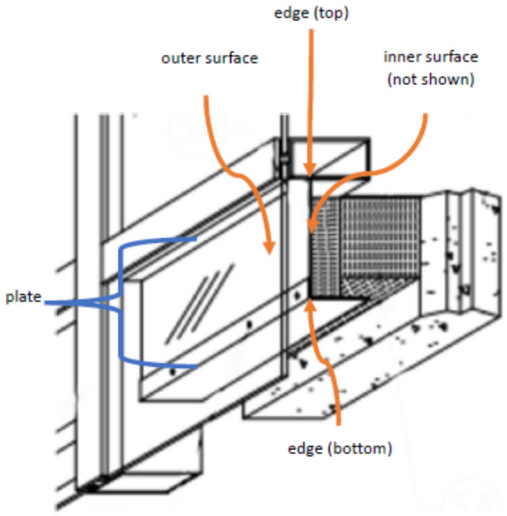

*Id.*

88. The safing slot is between the concrete floor assembly 1 and the interior wall surface of the curtain wall construction 2B, 2C.

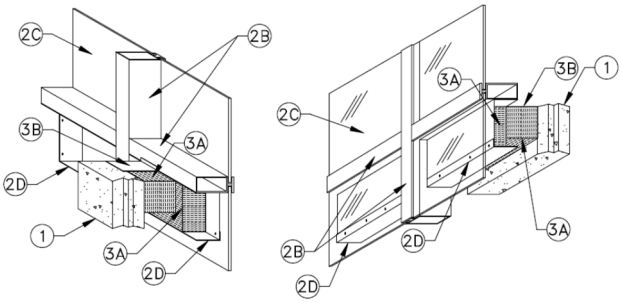
89. Similarly, see Exhibit 15 at 6:




90. On information and belief, the "Zero" Spandrel System comprises a first element comprised of a plate having opposing edges and an inner and an outer surface, wherein the plate is recessed from an inner side of the at least one vertical framing member and extends below the vertical framing member in an installed state. *See* Exhibit 13 (annotated) at 1:




*Id.* (Annotated). *See also* Exhibit 14 at 1 depicting the plate recessed from an inner side of the at least one vertical framing member and extending below the vertical framing member in an installed state:

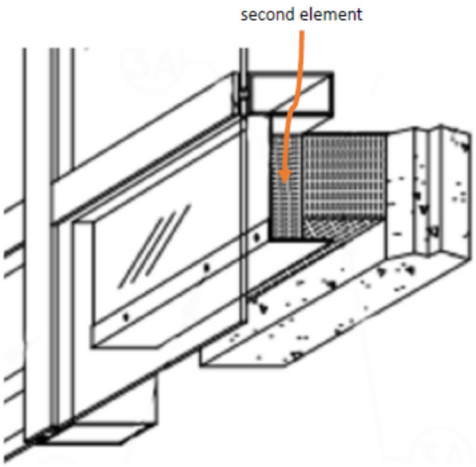



*Id.*

91. On information and belief, the "Zero" Spandrel System comprises at least one supplemental element configured to attach the first element to at least one side of the horizontal and/or vertical framing member of the curtain wall construction in the installed state. For example, Exhibit 14 at 2 states, "A bead of SpecSeal® Sil300 Silicone Firestop Sealant is applied to the underside of the transom, 1-1/2 in. inboard of the joint opening and the box pan sections are secured to the underside of the transoms in the aluminum framing (Item 2B). The

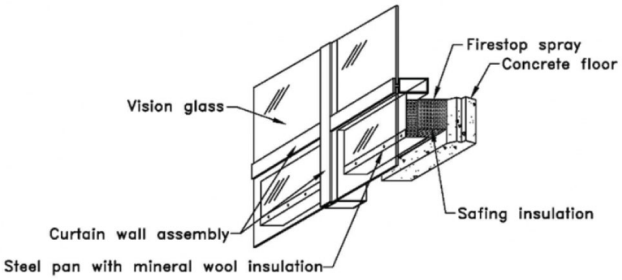
box pans are secured with . . . sheet metal screws spaced max. 12 in. oc and 1 in. inboard of the joint opening."

92. On information and belief, the "Zero" Spandrel System comprises a second element comprised of a thermally resistant material for insulating. For example, Exhibit 13 (annotated) at 1 depicts the second element:



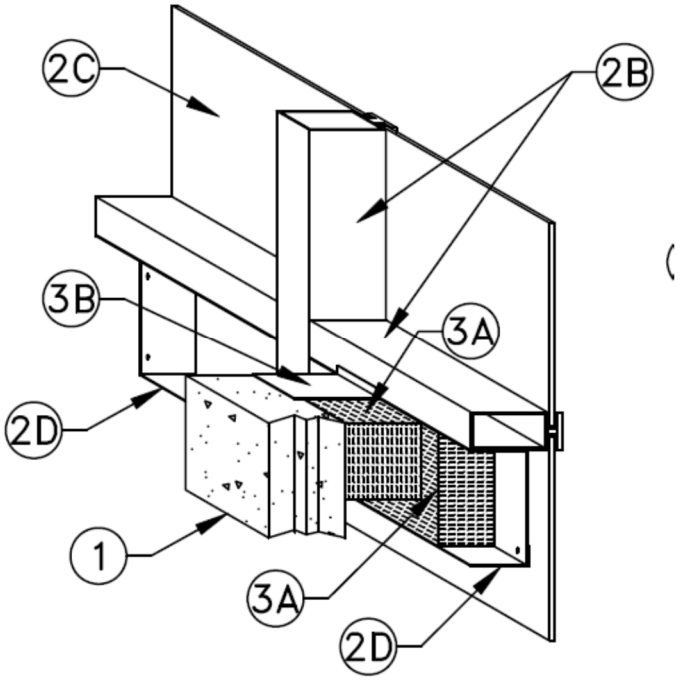

*Id.* (Annotated).

93. Further, Exhibit 15 at 6 depicts a "Steel pan with mineral wool insulation":



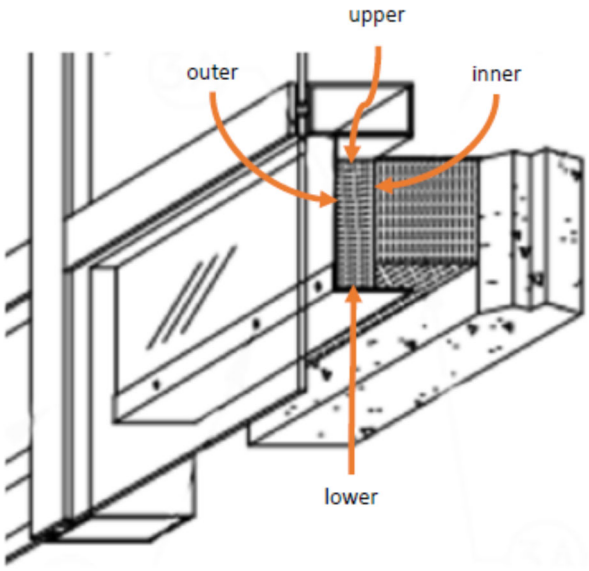

*Id.*

94. Similarly, Exhibit 14 at 2 states, "PACKING MATERIAL - Fill the box pan sections to a depth of 2-7/8 in. with 4 pcf density, mineral wool batt insulation installed with the fibers running parallel to the floor. Compress the packing material 25% vertically in the box pans." *See also id.* at 1 (insulation 3A):



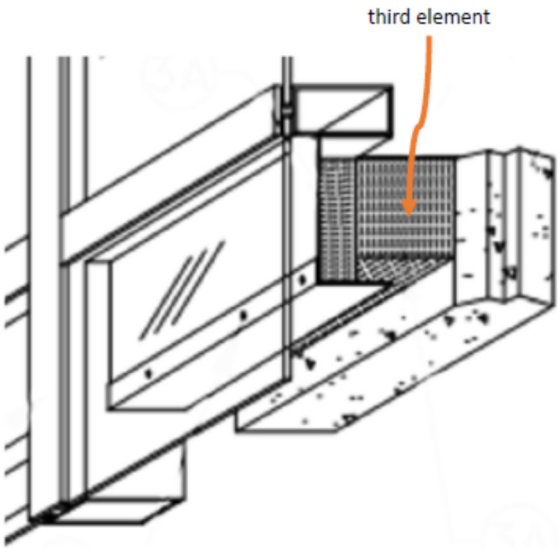

*Id.*

95. On information and belief, the second element in the "Zero" Spandrel System comprises an outer primary end surface adjacent to the inner surface of the first element; an inner primary end surface positionable spatially disposed from the outer edge of the floor in the installed state for sealing thereadjacent; and a lower primary surface and an upper primary surface extending between the opposing edges of the first element. For example, Exhibit 13 (annotated) at 1 depicts the second element:



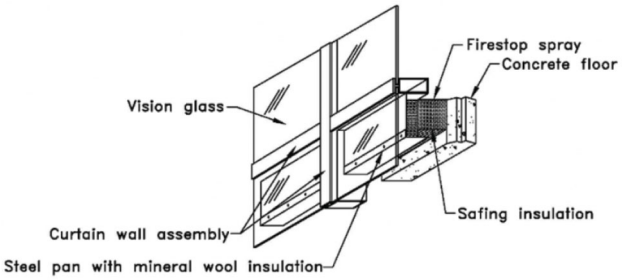

*Id.* (Annotated). *See also* Exhibit 14 at 2 which states, "PACKING MATERIAL - Fill the box pan sections to a depth of 2-7/8 in. with 4 pcf density, mineral wool batt insulation installed with the fibers running parallel to the floor. Compress the packing material 25% vertically in the box pans."

96. On information and belief, the "Zero" Spandrel System comprises a third element comprised of a thermally resistant material for insulating and positioned in the safing slot in the installed state. For example, Exhibit 13 (annotated) at 1 depicts the third element:



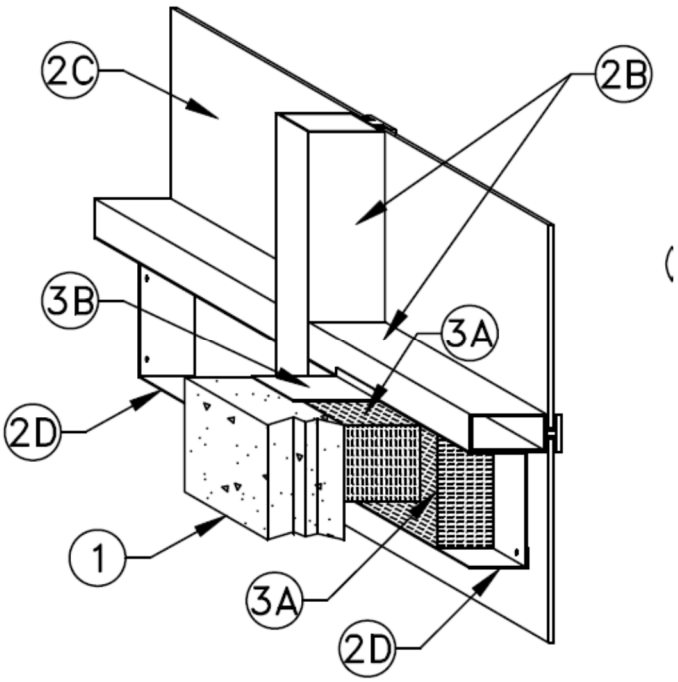

*Id.* (Annotated)

97. Further, Exhibit 15 at 6 depicts the third element ("Safing insulation"):



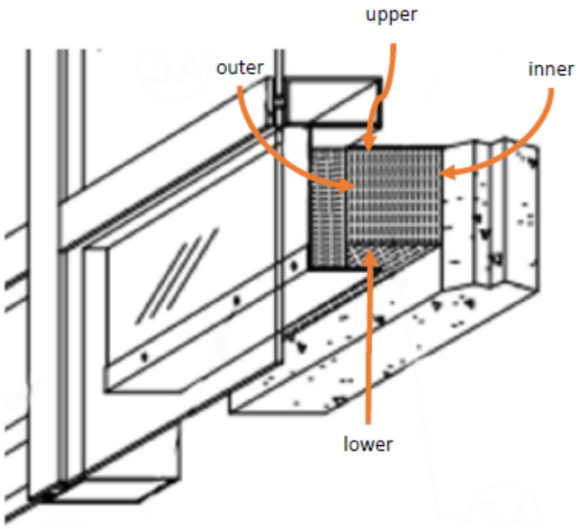

*Id.*

98. Similarly, Exhibit 14 at 2 states, "PACKING MATERIAL - . . . Install min. 4 in. thick, 4 pcf density, mineral wool batt insulation in the joint opening, installed with the fibers running parallel to the slab edge and curtain wall. Compress the packing material 25% in the nominal joint width. Compress the batt insulation into the perimeter joint flush with the top surface of the concrete floor slab (Item 1) and its mid-depth is compressed against the interior surface of the insulation-filled box pan (Item 2D). Splices (butt joints) in the lengths of mineral wool batt insulation are to be tightly compressed together." *See also id.* at 1 (insulation 3A):



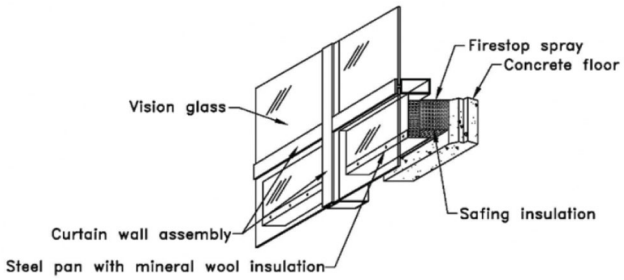

*Id.*

99. On information and belief, the third element in the "Zero" Spandrel System comprises an inner primary end surface adjacent to the outer edge of the floor in the installed state for sealing thereadjacent; an outer primary end surface adjacent to the inner primary end surface of the second element and spatially disposed from the inner surface of the first element; and a lower primary surface and an upper primary surface extending between the opposing edges of the first element. For example, Exhibit 13 (annotated) at 1 depicts the third element:




*Id.* (Annotated).

100. On information and belief, the plate in the "Zero" Spandrel System has a moment of inertia that is sufficient enough to keep a second element and a third element in place. For example, Exhibit 15 at 6 depicts a "Steel pan with mineral wool insulation" and the "Safing insulation" being held in place as a result of the plate's moment of inertia:




*Id.*

101. Similarly, Exhibit 14 at 2 states, "Install min. 4 in. thick, 4 pcf density, mineral wool batt insulation in the joint opening, installed with the fibers running parallel to the slab edge and curtain wall. Compress the packing material 25% in the nominal joint width. Compress the batt insulation into the perimeter joint flush with the top surface of the concrete floor slab (Item 1) and its mid-depth is compressed against the interior surface of the insulation-filled box

pan (Item 2D). Splices (butt joints) in the lengths of mineral wool batt insulation are to be tightly compressed together." The plate's moment of inertia holds the compressed insulation in place.

102. The full extent of Defendant's infringement is not presently known to Hilti. Hilti makes this preliminary identification of infringing products and infringed claims in Count Four without the benefit of discovery or claim construction in this action, and expressly reserves the right to augment, supplement, and revise its identifications based on additional information obtained through discovery or otherwise.

103. Hilti has suffered damages, including specifically lost profits, as a result of Defendant's infringement of the '566 Patent in an amount to be determined at trial.

104. Defendant's infringement of the '566 Patent is causing irreparable harm for which Hilti has no adequate remedy at law unless Defendant is enjoined by this Court. Under 35 U.S.C. § 283, Hilti is entitled to a permanent injunction against further infringement of the '566 Patent.

**PRAYER FOR RELIEF**

WHEREFORE, Hilti prays for the following judgments and relief:

(a) A judgment that Defendant has infringed and is infringing the Patents-in-Suit;

(b) A permanent injunction against Defendant and its affiliates, subsidiaries, assigns, employees, agents or anyone acting in privity or concert from infringing the Patents-in-Suit, including by inducing others to use and perform methods that infringe any claim of the Patents-in-Suit, until the expiration of the Patents-in-Suit;

(c) An award of damages adequate to compensate Hilti for Defendant's patent infringement, and an accounting to adequately compensate Hilti for the infringement, including, but not limited to, lost profits and/or a reasonable royalty;

(d) An award of pre-judgment and post-judgment interest at the maximum rate allowed by law;

(e) An order finding that this is an exceptional case and awarding Hilti its costs, expenses, disbursements, and reasonable attorneys' fees related to Defendant's patent infringement under 35 U.S.C. § 285 and all other applicable statutes, rules and common law; and

(f) Such other further relief, in law or equity, as this Court deems just and proper.

**JURY TRIAL**

In accordance with Rule 38 of the Federal Rules of Civil Procedure, Hilti hereby demands a jury trial on all issues triable before a jury.

Dated: October 21, 2022

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