

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNDER ARMOUR, INC.,
Petitioner,

v.

ATHALONZ, LLC,
Patent Owner.

Case IPR2024-00638
Patent No. 11,064,760

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	2
A.	Overview of the '760 Patent.....	2
B.	The Claims of the '760 Patent.....	5
C.	Overview of Petitioner's Prior Art	7
1.	Kim (EX1005).....	7
2.	Dufour (EX1006)	11
3.	Rubin (EX1007).....	15
4.	De Obaldia (EX1008)	17
III.	PRIORITY DATE OF THE '760 PATENT	18
IV.	LEVEL OF ORDINARY SKILL	18
V.	RELATED MATTERS	18
VI.	CLAIM CONSTRUCTION	19
A.	Petitioner's Claim Constructions	19
B.	Patent Owner's Construction of "Athletic Positioning"	20
VII.	THE BOARD SHOULD EXERCISE ITS DISCRETION NOT TO INSTITUTE UNDER <i>FINTIV</i> AND 35 U.S.C. § 314(a).	23
A.	Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.....	24
B.	Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.....	27
C.	Investment in the parallel proceeding by the court and the parties.	29

D.	Overlap between issues raised in the petition and in the parallel proceeding.	33
E.	Whether the petitioner and the defendant in the parallel proceeding are the same party.	34
F.	Other circumstances that impact the Board’s exercise of discretion, including the merits.	34
VIII.	PETITIONER HAS NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIMS.	35
A.	Ground 1: Kim Does Not Disclose or Render Obvious Independent Claim 1	35
B.	Ground 2: Dufour Does Not Disclose or Render Obvious Independent Claim 1	40
1.	Dufour Does Not Disclose the Claimed “Athletic Positioning” And A Heel Area With Substantially No Slope.	40
2.	Dufour Does Not Disclose “A Pair of Shoes” With a “Left Foot Shoe” and a “Right Foot Shoe”.	44
C.	Ground 3: Rubin Does Not Disclose or Render Obvious Independent Claim 1	46
1.	Rubin Does Not Disclose or Render Obvious Limitation 1.4 or 1.5	47
2.	Rubin Does Not Disclose “A Pair of Shoes” With a “Left Foot Shoe” and a “Right Foot Shoe”	50
D.	Grounds 4-6: De Obaldia Does Not Solve the Problems in Grounds 1-3 For the Independent Claims	53
IX.	CONCLUSION.	54

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Docket Control Order (Dkt. 35) in <i>Athalonz LLC v. Under Armour, Inc.</i> , No. 2:23-cv-00193-JRG (E.D. Tex.)
2002	United States District Court Judicial Case Profiles, as of December 2023
2003	Under Armour's Invalidity Contentions in <i>Athalonz LLC v. Under Armour, Inc.</i> , No. 2:23-cv-00193-JRG (E.D. Tex.)
2004	Exhibit D ('760 Patent Invalidity Chart Based on Kim) to Under Armour's Invalidity Contentions in <i>Athalonz LLC v. Under Armour, Inc.</i> , No. 2:23-cv-00193-JRG (E.D. Tex.)
2005	Exhibit E ('760 Patent Invalidity Chart Based on Rubin) to Under Armour's Invalidity Contentions in <i>Athalonz LLC v. Under Armour, Inc.</i> , No. 2:23-cv-00193-JRG (E.D. Tex.)
2006	Exhibit F ('760 Patent Invalidity Chart Based on Dufour) to Under Armour's Invalidity Contentions in <i>Athalonz LLC v. Under Armour, Inc.</i> , No. 2:23-cv-00193-JRG (E.D. Tex.)
2007	Exhibit S ('760 Patent Obviousness Chart) to Under Armour's Invalidity Contentions in <i>Athalonz LLC v. Under Armour, Inc.</i> , No. 2:23-cv-00193-JRG (E.D. Tex.)

Athalonz, LLC (“Athalonz” or “Patent Owner”) submits this Preliminary Response to the Petition of Under Armour, Inc. (“UA” or “Petitioner”) seeking *inter partes* review (“IPR”) of U.S. Patent No. 11,064,760 (“the ’760 patent”).

I. INTRODUCTION

Institution should be denied for two independent reasons. First, the Board should exercise its discretion under 35 U.S.C. § 314(a) and *Fintiv* to deny institution based on the parallel litigation between the same parties scheduled for trial more than six months before the Board’s Final Written Decision would issue. Petitioner delayed filing this Petition for months after it provided invalidity contentions in district court relying on every single piece of prior art it included in this Petition, in the same way, for the same arguments. Moreover, the district court litigation will almost certainly not be stayed pending these proceedings, since it involves a small, patent-practicing company seeking relief from its larger adversary infringing its patent rights. There is no reason for the Board to waste resources—both its own and the Patent Owner’s—in proceeding here on a mere subset of the validity issues that will be tried to a jury months before any Final Written Decision would issue.

Second, the Board should deny institution on the merits, as Petitioner’s asserted hodgepodge of prior art references fail to disclose the invention claimed in the ’760 patent. Petitioner relies solely on obviousness arguments, and for every ground, either ignores critical limitations or relies exclusively on conclusory expert

testimony to fill substantial gaps in the prior art. The fact is that the '760 Patent is novel and nonobviousness—no piece of prior art discloses the invention, and Petitioner's attempts to use hindsight to claim obviousness fail.

II. BACKGROUND

A. Overview of the '760 Patent

The '760 patent is directed toward novel athletic shoes. *See* EX1001. The patent recognizes that the prior art offered “a wide variety of shoes” on the market, each with different designs and styles depending on their use. *Id.*, 1:47-49. For example, athletic shoes generally had a “particular sole pattern, a sole design, an insole design, and upper shoe portion design.” *Id.*, 1:51-56. However, prior art athletic shoes were limited in their design for athletic performance. For example, the patent recognizes that prior art baseball cleats were typically designed only to “facilitate[] better traction in grass and/or dirt while playing baseball.” *Id.*, 1:64-65. As such, these prior art shoes consisted of either a “relatively flat platform for the foot within the baseball spikes,” or sometimes offered a “heel portion of the shoe” “higher than the toe portion of the shoe.” *Id.*, 1:65-2:3.

The '760 patent improved on the prior art by inventing shoes that place athletes in an “athletic position” through a novel “athletic positioning shape.” *Id.*, 9:25-27. As the patent explains, an “athletic position” involves having the athletes’ “knees slightly bent, weight more on the inside of the legs than the outside of the

legs, knees position aligned with ankles and hips, and/or other athletic positioning characteristics.” *Id.*, 9:25-30. The patent further explains that this athletic positioning can be used in “any type of shoe” “to promote a better athletic position for an athlete.” *Id.*, 9:46-56.

The particular implementation of the athletic position varies, but generally consists of a shoe with an upper section, an insole section, and a sole section with an athletic positioning shape, which is formed by a heel section, a mid-foot section, and a toe section. *Id.*, 9:12-17. The athletic positioning described by the ’760 patent has the heel section higher than the inside edge of a toe section at a first angle, the heel section higher than the outer edge of a toe section at a third angle, and the outside edge of a toe section higher than the inside edge of the toe section at a second angle. *Id.*, 10:59-11:3. Figure 8 is an isometric diagram of one embodiment of the athletic positioning shoe described in the ’760 patent:

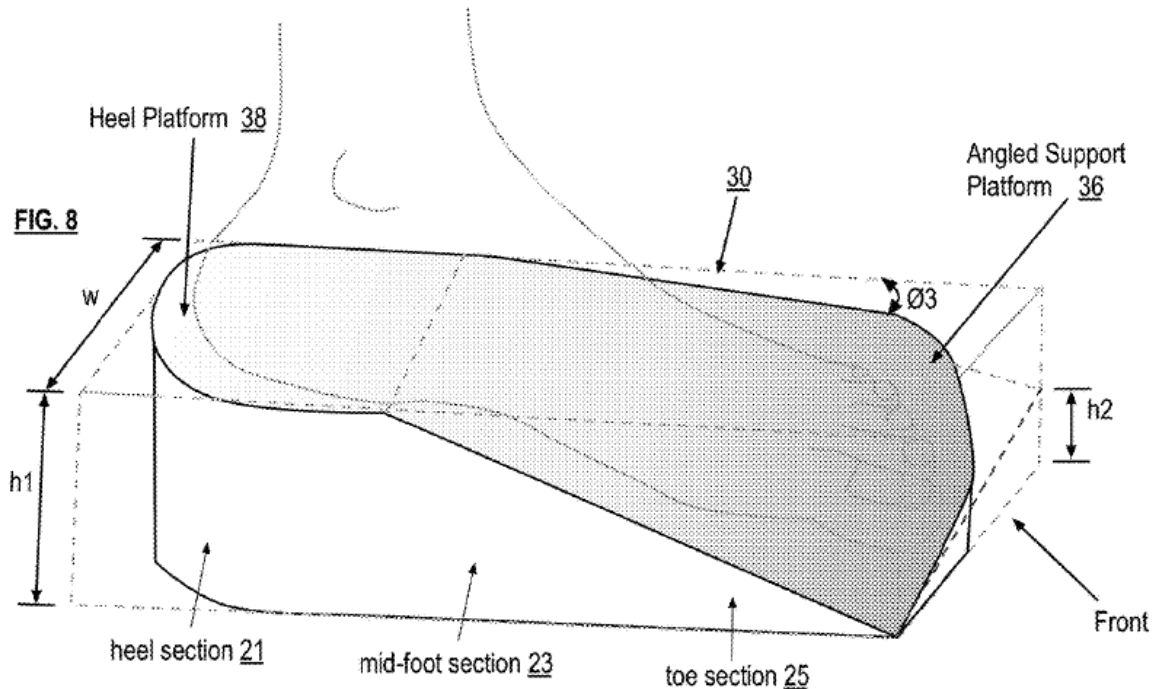


Figure 20 is one of many other illustrations of athletic positioning in a sole of a shoe:

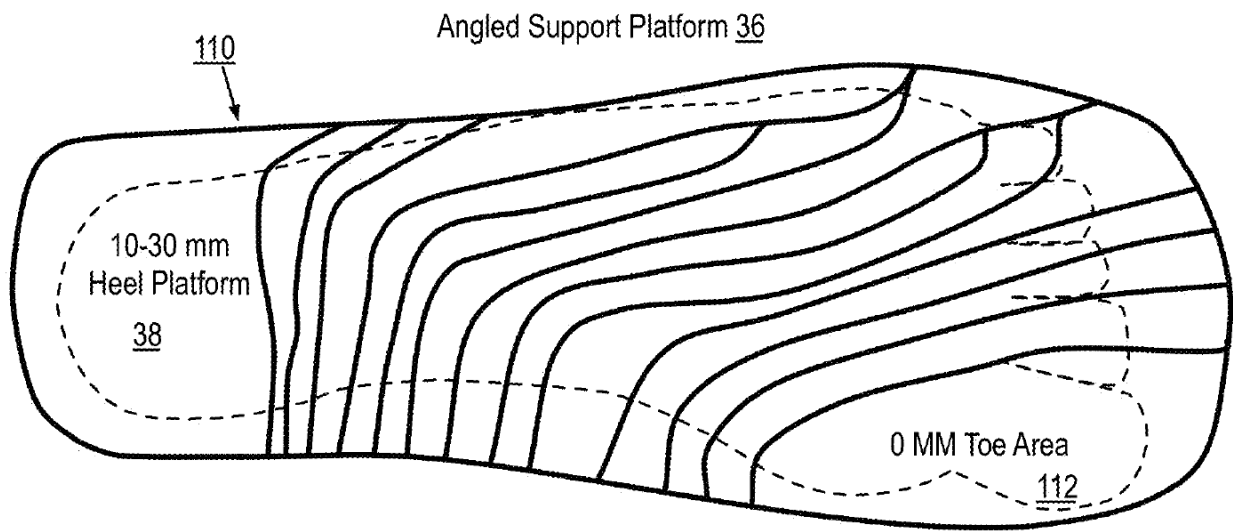


FIG. 20

Each of these embodiments shows a shoe with a heel platform at a height greater than the small toe area and the small toe area at a height greater than the big

toe area. As such, the heel section is higher than the inside edge of a toe section at a first angle (represented by elevations lines in Figure 20 above), the heel section is higher than the outer edge of a toe section at a third angle (also represented by elevation lines), and the outside edge of the toe section higher than the inside edge of the toe section at a second angle (also represented by elevation lines).

The angles of an athletic positioning insole and/or sole correspond to slopes. For instance, a first slope corresponds to the first angle of the inside edge from the heel section to the toe section, a second slope corresponds to the second angle of the outside edge of the toe section to the inside edge of the toe section, and a third slope corresponds to the third angle of the outside edge from the heel section to the toe section. *Id.*, 10:20-31. “While the surface on which the foot lies, the angles, and the perimeter lines are shown as straight lines and/or flat surfaces, they may be contoured lines and/or angles, contoured surfaces, contour slopes, concave and/or convex slopes and/or surfaces, and/or a combination thereof to provide a more comfortable and/or custom fit.” *Id.*, 10:47-52.

B. The Claims of the '760 Patent

Exemplary independent claim 1 of the '760 patent is shown below:

A pair of shoes comprises:

a left foot shoe including:

a left upper shoe portion; and

a left sole coupled to the left upper shoe portion, wherein a foot platform of the left sole provides an athletic positioning of a left big toe area of the left shoe at a lower position than a left heel area of the left shoe and at a lower position than an outer small toe area of the left shoe, wherein, from an inner edge to an outer edge of the left shoe, the left heel area has substantially no slope, and wherein, from the inner edge to the outer edge of the left shoe at a cross section at a ball of ball, a bottom of the left sole is substantially linear; and

a right foot shoe including:

a right upper shoe portion; and

a right sole coupled to the right upper shoe portion, wherein a foot platform of the right sole provides an athletic positioning of a right big toe area of the right shoe at a lower position than a right heel area of the right shoe and at a lower position than an outer small toe area of the right shoe and wherein, from an inner edge to an outer edge of the right shoe, the right heel area has substantially no slope, and wherein, from the inner edge to the outer edge of the right shoe at a cross section at a ball of ball, a bottom of the right sole is substantially linear.

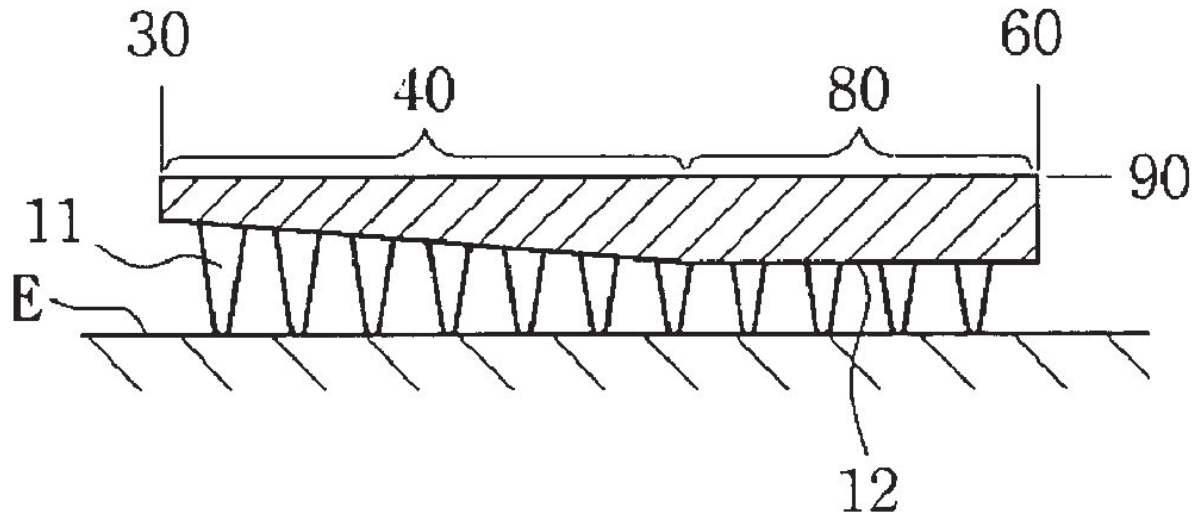
EX1001, claim 1. Petitioner also challenges dependent claims 2-11 which add additional limitations.

C. Overview of Petitioner's Prior Art

Petitioner relies on four prior art references for its obviousness arguments. None of those references disclose or render obvious the claims of the '760 patent.

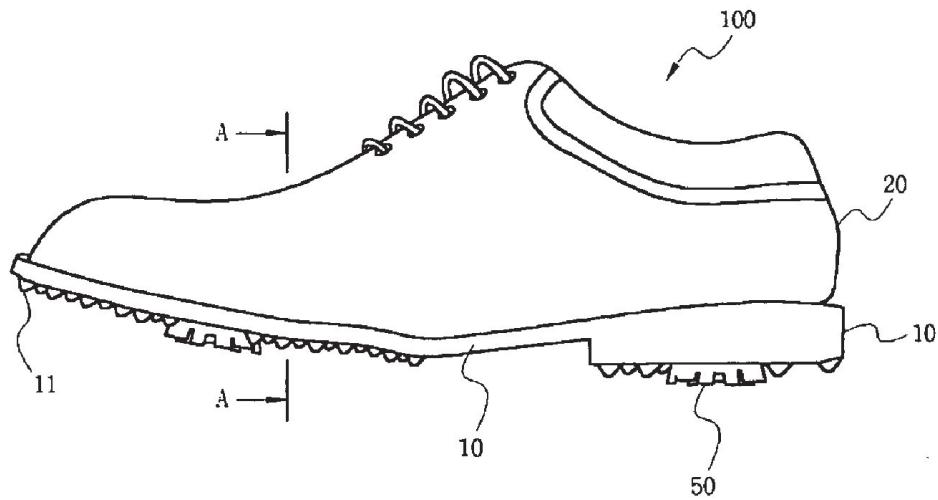
1. Kim (EX1005)

Kim is directed to a pair of golf shoes. EX1005. The shoes disclosed in Kim are designed to “assist a golfer in concentrating his/her proper weight balance on the inner edge of soles of feet during the address and swing motions” and to “allow a golfer to stably maintain the lower part of his/her body on the surface of a green during the address and swing motions.” *Id.*, [0012]-[0013]. To do so, the shoes in Kim have an “outsole provided with a plurality of spikes protruded from a lower surface of the outsole,” arranged so that “the lower surface of the outsole is inclined from an outer edge of the outsole to an inner edge of the outsole[.]” *Id.*, Abstract. Kim’s outsole is also designed “so that the spikes at the inner edge of the outsole have a height larger than that of the spikes at the outer edge of the outsole[.]” *Id.* As a result, the shoes disclosed in Kim are designed so that the “upper surface of the outsole is substantially parallel with a ground,” *id.*, thereby providing a flat surface for an athlete’s foot. Figure 3b illustrates a cross section of the outsole:



Kim also explains that its outsole and spike design is consistent throughout the entire shoe. Figure 1 of Kim shows both “[a] plurality of spikes 11 are protruded from the lower surface 12 of the outsole 10,” as well as “a plurality of cleat-shaped spikes 50 [that] are also protruded from the lower surface 12 of the outsole.” *Id.*, [0030]. According to Kim, “the variation in the height of the spikes 11 and 50 protruded from the lower surface 12 of the outsole 10 is inversely proportional to the variation in the thickness of the outsole 10.” *Id.*, [0033]. Thus, in Kim, “the height of the spikes 11 and 50 at the outer edge 60 of the outsole 10 with the larger thickness is smaller than the height of the spikes 11 and 50 at the inner edge 30 of the outsole 10 with the smaller thickness.” *Id.* This is shown in Figure 1:

FIG. 1



Kim is silent about the height of its heel relative to the rest of the outsole. The outsole design in Kim permits the entire foot, including the heel, to tilt inward when the spikes are pressed into soft ground, such as when “standing on a green.” *Id.*, [0024]. Kim illustrates this inward foot tilt in Figure 5b when a golfer is “standing on a green,” and contrasts this with Figure 5a, showing there is no inward tilt when a golfer is “standing on a hard ground.” *Id.*, [0023]-[0024].

FIG. 5a

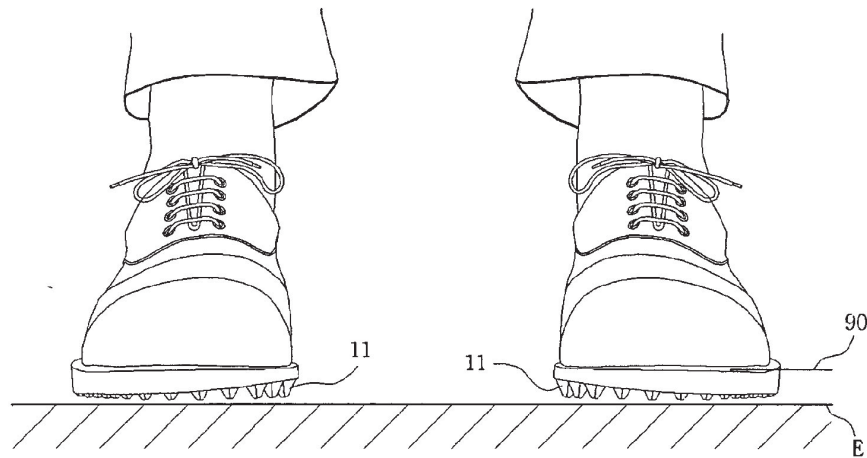
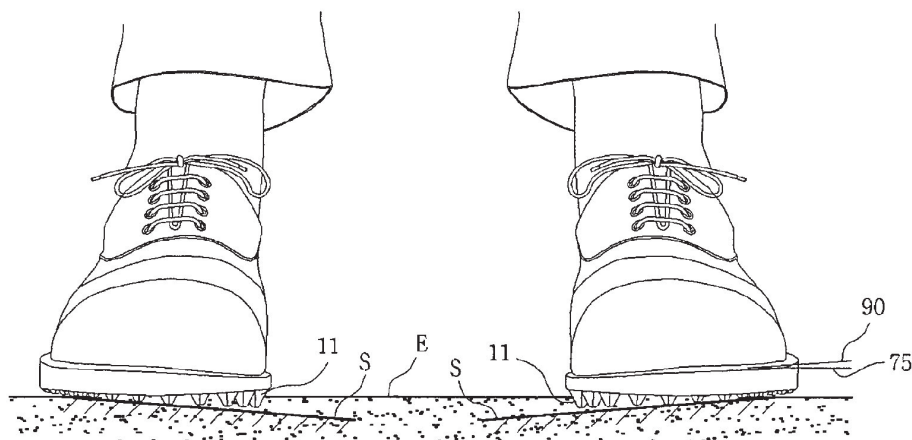


FIG. 5b



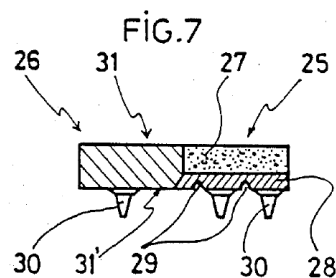
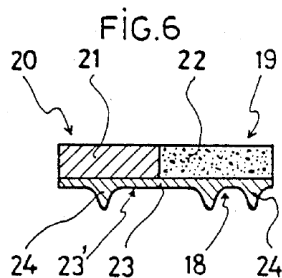
As explained by Kim, “the reference numeral 90 denotes a line representing the level of the golfer’s feet being parallel with the ground E, and the reference numeral 75 denotes a line being parallel with a line (S) representing the level of the bottoms of the spikes 11.” *Id.*, [0039]. Therefore, the golfer’s entire foot (including the heel) is either parallel with the ground when on hard surfaces (Fig. 5a, where 90 is parallel

to ground E) or the entire foot (including the heel) is angled inward when on soft surfaces (Fig. 5b, along the reference line S).

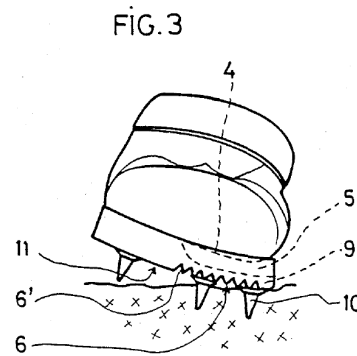
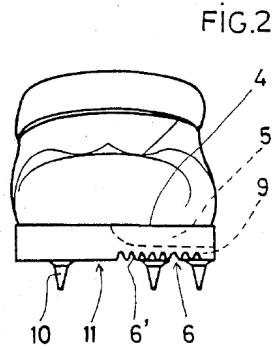
2. Dufour (EX1006)

Dufour is directed to a golf shoe. EX1006. In particular, Dufour describes a number of different embodiments of a golf shoe for the front foot in a golfer's swing. Generally, Dufour's golf shoe includes an active zone of a shock absorbing material on the outside edge of a golfer's front shoe to promote comfort when the foot rolls to the outer edge of the sole during a golf swing. *Id.*, 1:50-55. Dufour has four separate embodiments, with several variations of those embodiments made with reference to certain figures and descriptions: 1) Figures 1-10; 2) Figures 11 and 12; 3) Figures 13 and 15; and 4) Figure 14. *Id.*, 3:5-39.

The first embodiment of Dufour includes two separate implementations of the sole 2 at cross-section VI – VI from Figure 1. The cross section of Figures 6-9 traverses the length of the shoe (i.e., from the front part 7 to the back of the heel 8).

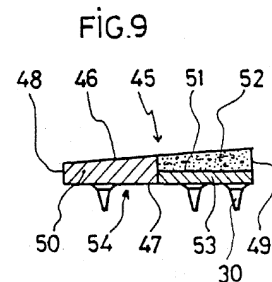
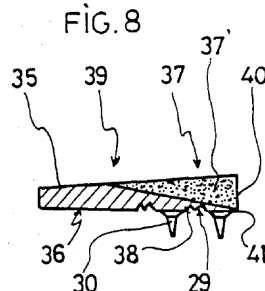
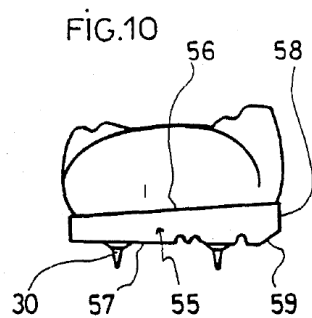


Figures 2 and 3 illustrate front views of the golf shoe. The sole of Figures 2 and 3 are of the same height from the outer edge to the inner edge as shown in Figures 6 and 7:



Thus, in these particular embodiments, the sole maintains a constant thickness throughout the shoe from heel to toe and from inner edge to outer edge.

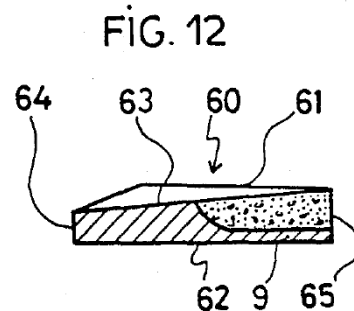
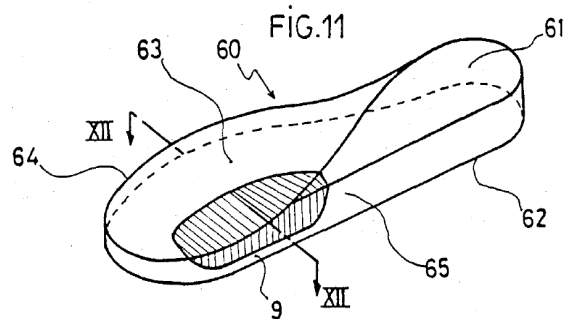
Figure 10 also illustrates a front view of the shoe. However, the sole of Figure 10 has the thickness of the sole increasing from inner edge to the outer edge, as shown in Figures 8 and 9 (cross section view equivalent to Figures 6 and 7).



Thus, in these particular embodiments, the sole maintains a constant thickness from heel to toe (like the previous embodiments), but has an increasing thickness from inner edge to outer edge.

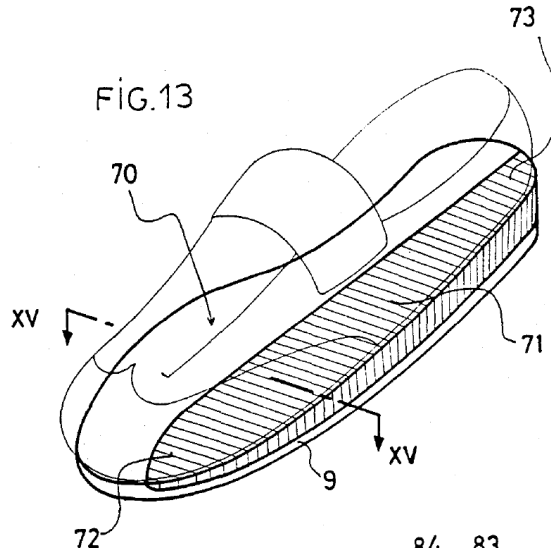
The second main embodiment of Dufour is illustrated in Figures 11 and 12. In this embodiment, the foot surface “at the level of the heel remains substantially parallel to the walking surface 62, while the support surface 63 in the front area of

the foot is inclined upwards from the inner edge 64 towards the outer edge 65.” *Id.*, 5:7-14.



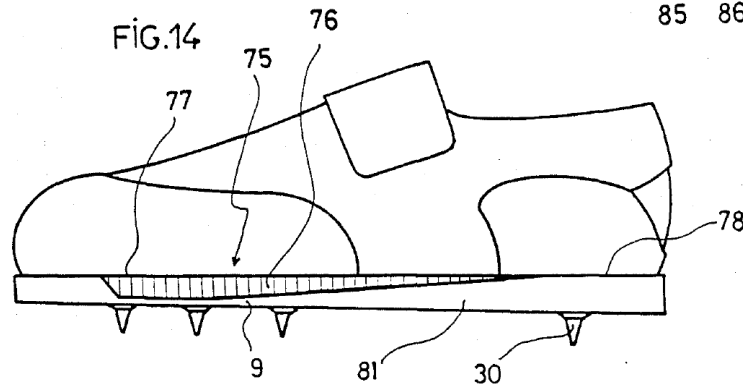
As shown in Figure 12 above, the second embodiment of Dufour maintains a flat plantar support zone 61 at the rear of the image at the same height as the outer edge 65, and has a declined support surface 63 at the inner edge 64. That is, the plantar support zone 61 remains at the same level at the outer toe, with the inner toe at a lower level.

The third embodiment of Dufour (Figure 13) has a shock absorbing element 71, which extends from the front part of the shoe to the heel and has a variable thickness “so that the front part 72 is thinner than the part at the heel 73. In this example, the thickness of the sole 70, seen in elevation in its longitudinal direction, also increases as it goes towards the heel zone 73.” *Id.*, 5:15-24.



As shown in Figure 13, the heel in this third embodiment is at a higher position than the toe, but the entire foot remains at the same angle relative to the ground—that is, there is no incline or slope from the inner edge to the outer edge of the shoe. Dufour also discloses in Figure 15 an alternate view along the cross section of line XV-XV in Figure 13 with “another structure which can deform transversely in the rolling direction of the foot.” *Id.*, 3:36-39.

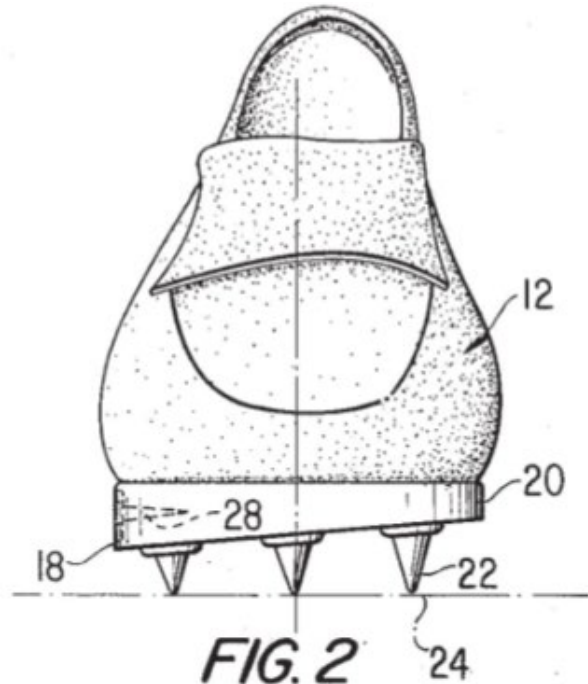
The fourth embodiment of Dufour (Figure 14) “teaches a relatively constant thickness in the direction of its length, while the shock absorbing element 76 has a thickness which decreases progressively from the front part 77 occupied by the 3rd, 4th, and 5th first phalanges of the foot up to the heel 78.” *Id.*, 5:25-31.



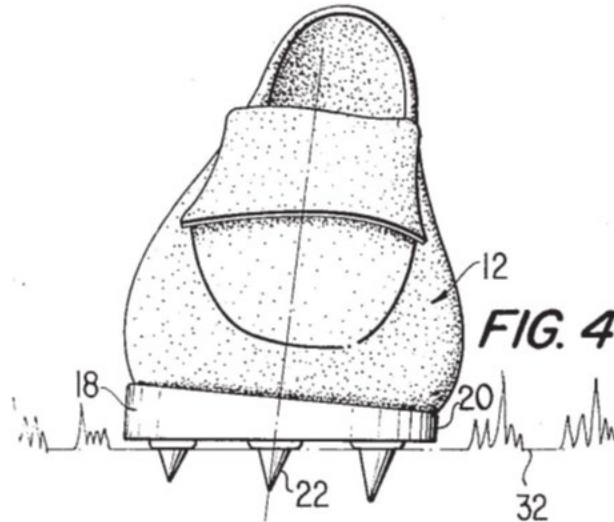
In this embodiment, the entire foot remains flat and parallel to the ground surface, from the heel to the toe and from the inner to the outer portion of the toe.

3. Rubin (EX1007)

Rubin is directed to a golf shoe. EX1007. Rubin discloses a golf shoe for the “rearmost foot positioned when the golfer takes his stance over the ball.” *Id.*, 3:2-5. Rubin’s shoe includes a “wedge-shaped sole 14” that has an “outer side 18” that “extends downwardly from the shoe upper 12 to a lower elevation than the inner side 20 of [the] sole.” *Id.*, 3:9-11, 3:59-61. The shoe 10 includes cleats 22, which are shorter near the outer side 18 than at the inner side 20. The difference in cleat length is equal to the difference in elevation between the outer side 10 and the inner side. *Id.*, 3:29-33. Rubin explains that these differences enable the wearer to keep the foot substantially level to the ground when walking, as shown in Figure 2. *Id.*, 3:34-37.

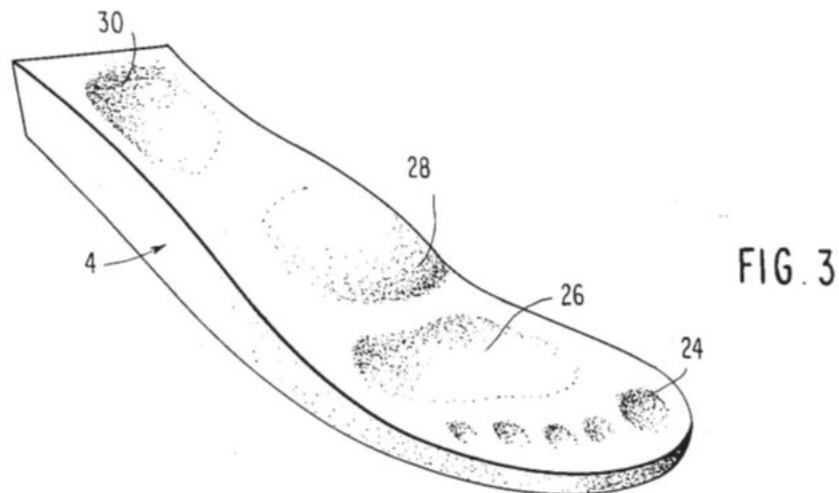


Rubin further discloses that when standing on a soft playing surface, “the golfer will imbed cleats 22 in a golf playing surface 32 when addressing a golf ball. The[] rearwardmost foot of the golfer will be tilted inwardly because of the wedge-shaped sole 14 of shoe 10. This will tend to provide a more satisfactory weight distribution when hitting the ball.” *Id.*, 3:56-62. This inward tilt of the entire foot is shown in Figure 4, which shows both the heel and toe of the rear foot tilted inward based on the vertical line over the shoe:



4. De Obaldia (EX1008)

De Obaldia is directed to “molded footwear,” which it describes preferably as a “jogging sandal.” EX1008, 1:1-9. De Obaldia discloses a sandal that includes a foot support member 4 as shown in Figure 3.



De Obaldia explains that its foot support member 4 includes at least one toe recess 24, a ball of foot recess 26, an arch support portion 28, and a heel recess 30. *Id.*, 2:65-68.

III. PRIORITY DATE OF THE '760 PATENT

Petitioner does not explicitly identify the priority date of the '760 patent. The '760 patent claims priority to U.S. Provisional Patent Application No. 61/450,485, filed on March 8, 2011. Patent Owner does not dispute, for purposes of this preliminary response, that all of Petitioner's prior art pre-dates the priority date of the '760 patent. Patent Owner reserves all rights to establish its preferred priority date if the Petition is instituted and in any other proceeding involving the '760 patent.

IV. LEVEL OF ORDINARY SKILL

Petitioner sets forth a level of ordinary skill. Pet., 15. Patent Owner reserves the right to dispute Petitioner's definition if an IPR is instituted. For present purposes, this preliminary response establishes that Petitioner's arguments fail even under its preferred definition of the level of ordinary skill.

V. RELATED MATTERS

Patent Owner is presently asserting the '760 patent in the following district court action: *Athalonz, LLC v. Under Armour, Inc.*, No. 2:23-cv-00193 (E.D. Tex.). Petitioner has also filed four other petitions for *inter partes* review on the four other patents asserted in the district court action: *Under Armour, Inc. v. Athalonz, LLC*, No. IPR2024-00636 (P.T.A.B. Mar. 4, 2024) (U.S. Pat. No. 10,674,786); *Under*

Armour, Inc. v. Athalonz, LLC, No. IPR2024-00637 (P.T.A.B. Mar. 4, 2024) (U.S. Pat. No. 11,013,291); *Under Armour, Inc. v. Athalonz, LLC*, No. IPR2024-00639 (P.T.A.B. Mar. 4, 2024) (U.S. Pat. No. 11,375,768); *Under Armour, Inc. v. Athalonz, LLC*, No. IPR2024-00640 (P.T.A.B. Mar. 4, 2024) (U.S. Pat. No. 11,510,456).

VI. CLAIM CONSTRUCTION

A. Petitioner's Claim Constructions

Petitioner claims that no terms require construction for purposes of this IPR but identifies constructions for two terms “for purposes of clarity only” based on its description of Patent Owner's infringement contentions. Pet., 12. Specifically, Petitioner states the following:

- ***“Heel Area That Has Substantially No Slope from the Inner Edge to the Outer Edge”***: Petitioner asserts that Patent Owner construes “inner” and “outer” edge of the heel area to mean “the edges of the portion of the shoe where the heel of the foot sits, not the inner and outer-most edges of the shoe.” Pet., 12. Petitioner also asserts that Patent Owner construes this limitation “to include a heel area that includes some degree of curvature and height change from its inner edge to its outer edge.” Pet., 12.
- ***“From the Inner Edge to the Outer Edge of the [Left/Right] Shoe at a Cross Section at a Ball of [Foot], a Bottom of the [Left/Right] Sole***

is Substantially Linear”: Petitioner asserts that Patent Owner construes this limitation “to encompass a sole that is curved, textured and/or includes protrusions on the bottom of the sole.” Pet., 13.

Petitioner has an obligation to provide a claim construction, if one is necessary. 37 CFR § 42.104(b)(3). Petitioner’s claim construction analysis is incomplete. It is insufficient to provide a construction “for purposes of clarity only”: Petitioner either definitively provides a construction or it does not. Nevertheless, unless otherwise stated below, Patent Owner adopts Petitioner’s claim construction proposals for purposes of this preliminary response and reserves the right to propose different constructions if the Petition is instituted.

B. Patent Owner’s Construction of “Athletic Positioning”

Patent Owner offers the following additional claim construction for the term “athletic positioning.” To the extent that the Board does not agree with the Patent Owner’s offered construction, Patent Owner submits that this Petition still fails for the reasons described below. Patent Owner reserves the right to revise its proposed constructions and assert additional constructions should the Petition be instituted.

Term	Meaning
“Athletic positioning” (claim 1)	“a heel section higher than the toe section and the outside edge of the toe section higher than the inside edge of the toe section”

Independent claim 1 (and its dependent claims) requires the shoe sole to provide an “athletic positioning” of the foot. “Athletic positioning” does not have a clear, immediate ordinary meaning, but its meaning is clear from the specification of the ’760 patent. Generally speaking, an “athletic position” in the context of the ’760 patent refers to placing an athlete in a position with, for example, their “knees slightly bent, weight more on the inside of the legs than the outside of the legs, knees position aligned with ankles and hips. . . .” EX1001, 9:25-30. The patent claims a specific arrangement of a shoe that allows for “athletic positioning,” which is illustrated, for example, in Figure 20:

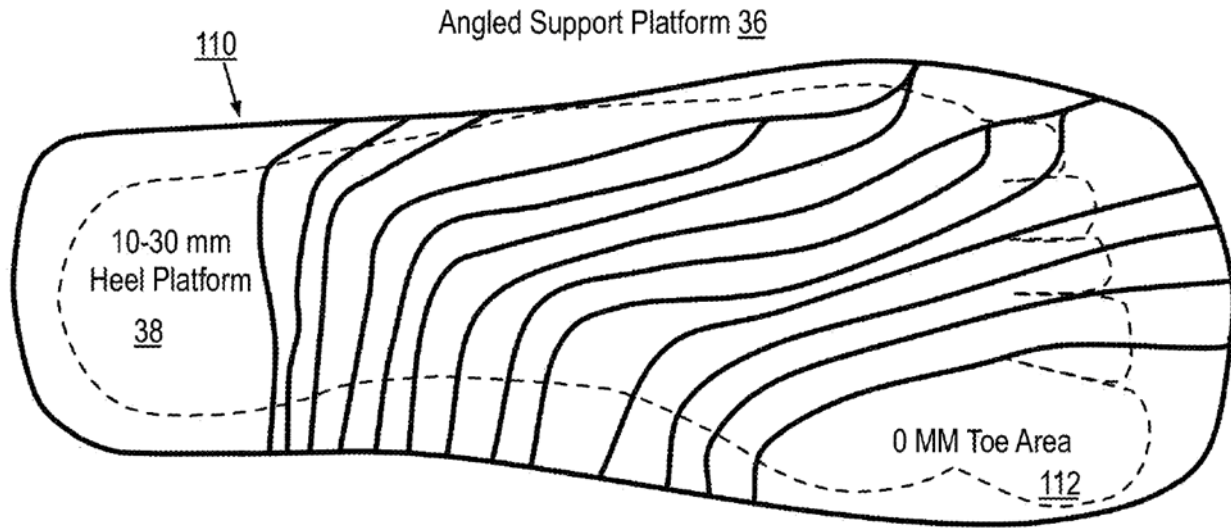


FIG. 20

As explained by the '760 patent with reference to the figures, “[t]he athletic positioning shape further includes a heel platform 38, an angled support platform 36, and a toe area 112. With respect to the toe area 112, the heel platform 38 may be 10 to 30 mm higher and may have a shape corresponding to the heel of a shoe. The angle support platform 36 includes a contoured shape that angles from the outer edge of the foot to the inner edge of the foot with a lesser slope along the outer edge of the shape than along the inner edge of the shape.” *Id.*, 13:60-14:4.

Other embodiments of the athletic positioning claimed in the '760 patent are illustrated throughout the figures and specification, including Figures 3-4, 5-7, 8-10, 11, 12, 14, 15, 19, 21, 22, 23, 44-47, 63-64, 87, 93-94, 119-121. Each of these embodiments consistently include a heel section higher than the toe section and the outside edge of the shoe higher than the inside edge of the shoe. *See also, e.g., id.*

9:12-24 (“the athletic positioning shape has the heel section 21 higher than the toe section by a particular angle (e.g., Ø1, which may range from a fraction of a degree to 10’s of degrees) and the outside edge of the shoe higher than the inside edge of the shoe by another angle (e.g., Ø2, which may range from a fraction of a degree to 10’s of degrees) at the ball of foot and/or toe section of the shoe.”).

“Properly viewed, the ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc). Here, in the context of the ’760 patent, “athletic positioning” means having “a heel section higher than the toe section and the outside edge of the toe section higher than the inside edge of the toe section.”

VII. THE BOARD SHOULD EXERCISE ITS DISCRETION NOT TO INSTITUTE UNDER *FINTIV* AND 35 U.S.C. § 314(a).

The Board should exercise its discretion under 35 U.S.C. §314(a) and *Fintiv* to deny institution “because institution of a trial at the PTAB would be an inefficient use of Board resources in light of the ‘advanced state’ of the parallel district court litigation....” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 2 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”).

Under *Fintiv*, to determine whether to deny institution, the Board considers the following list of non-exhaustive factors:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board's exercise of discretion, including the merits.

Id. at 6.

Here, there is ongoing parallel district court litigation between the same parties, and each *Fintiv* factor favors denial. Principally, there is no stay in the parallel litigation; trial is scheduled more than six months before the Board's Final Written Decision would issue; the district court case is well into discovery and there has been heavy investment by both the parties and the Court; Petitioner's invalidity contentions in district court rely on identical prior art and arguments included in the Petition; the Petitioner here and the Defendant in district court are the same party; and the merits of Petitioner's arguments are not compelling. Institution would be a waste of resources for both the Board and the parties and should be denied.

A. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.

Factor 1 favors denial when a district court stay is unlikely. *See 10x Genomics, Inc. v. President & Fellows of Harvard Coll.*, IPR2023-01299, Paper 15 at 16

(P.T.A.B. Mar. 7, 2024) (“*10x Genomics*”); *Samsung Elecs. Co., Ltd. v. California Inst. of Tech.*, IPR2023-00133, Paper 10 at 14 (P.T.A.B. May 4, 2023) (“*Samsung*”); *see also Fintiv*, Paper 11 at 6-8.

The district court has not granted a stay, no evidence exists that a stay may be granted if a proceeding is instituted, and, in fact, a stay—even if sought—is extremely unlikely. While the Board typically does not speculate as to whether a district court will grant a stay, *see Fintiv*, Paper 11 at 6-8, here the circumstances make clear that a stay will not be issued. The presiding judge—Judge Gilstrap of the Eastern District of Texas—rarely grants stays, and, to Patent Owner’s knowledge, has never granted a stay under facts similar to those here.

As Judge Gilstrap has stated, “[d]istrict courts typically consider three factors when determining whether to grant a stay pending inter partes review of a patent in suit: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.” *Force MOS Tech., Co. v. ASUSTek Comput., Inc.*, 2024 WL 1586266, at *1 (E.D. Tex. Apr. 10, 2024) (Gilstrap, J.) (quoting *NFC Tech. LLC v. HTC Am., Inc.*, 2015 WL 1069111, at *2 (E.D. Tex. Mar. 11, 2015)).

Here, none of the factors support a stay. First, a stay would unduly prejudice Athalonz, which is a direct competitor to UA in selling its patented products and is seeking damages for past infringement and an injunction or ongoing royalty to prevent further infringement. *See Voltstar Techs., Inc. v. Superior Commc'ns, Inc.*, 2013 WL 4511290, at *2 (E.D. Tex. Aug. 22, 2013) (finding that prejudice factor weighed heavily against a stay where parties competed directly in the marketplace). Second, the proceedings before the district court have reached an advanced stage—by the time of any institution decision, the parties will have completed most of discovery, all claim construction briefing, be days away from a *Markman* hearing, and be only a few months from trial. *See* EX2001 (district court Docket Control Order); *see also Force MOS Tech.*, 2024 WL 1586266, at *3 (the substantial completion of discovery and exchange of contentions indicate a relatively advanced stage); *Netlist, Inc. v. Samsung Elec. Co., Ltd.*, No. 2:22-cv-293, Dkt. 689 at 4 (E.D. Tex. Mar. 11, 2024) (Gilstrap, J.) (engaging in claim construction indicates an advanced stage of litigation). Finally, a stay will not meaningfully simplify the case before the court. Any possible simplification is speculative, and “is not a given.” *Netlist*, No. 2:22-cv-293, Dkt. 689 at 5. Further, UA has raised many other defenses, including invalidity under § 112 and standing. And of course, a FWD will not resolve any of the infringement allegations.

Because there is no stay and it is extremely unlikely there ever will be, this factor weighs against institution, or at least is neutral.

B. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.

“If the district court’s trial date is before the projected deadline for the final written decision, the Board has generally weighed this fact in favor of exercising discretion.” *10x Genomics*, Paper 15 at 16; *see Fintiv*, Paper 11 at 6. “[T]he parties may also present the most recent statistics on median time-to-trial for civil actions in the relevant district court.” *Boe Tech. Grp. Co., Ltd. v. Element Cap. Com. Co. Pte. Ltd.*, IPR2023-00808, Paper 9 at 22 (P.T.A.B. Nov. 15, 2023) (citing Memorandum Re: Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022) at 8-9, (“Interim *Fintiv* Guidance”)). “The PTAB will weigh this factor against exercising discretion to deny institution under *Fintiv* if the median time-to-trial is around the same time or after the projected statutory deadline for the PTAB’s final written decision.” Interim *Fintiv* Guidance at 9.

This factor weighs heavily against institution in this case. First, the district court’s trial date is set for March 3, 2025. EX2001. But the projected statutory deadline for a FWD is not until September 14, 2025—more than six months after trial in district court will have concluded. *See, e.g., Roku, Inc. v. Ioengine, LLC*, IPR2022-01553, Paper 11 at 10-11 (P.T.A.B. May 5, 2023) (finding that a district

court proceeding six months before a FWD “weighs heavily in favor of discretionary denial of institution”) (“*Roku*”); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7 at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months before a final decision would be due”); *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 8 (P.T.A.B. May 15, 2020) (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”).

Second, the median time to trial in the Eastern District of Texas shows an even greater discrepancy. The median time to trial is just 21.4 months. EX2002 at 35 (E.D.Tex. statistic for cases “from filing to trial (civil only)”). The district court litigation was filed in April 2023, meaning the court’s trial date is just under 23 months after filing. The fact that the median time to trial is before the scheduled date shows the trial date is realistic and likely to stick. *Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01093, Paper 11 at 12-13 (P.T.A.B. Jan. 8, 2024) (“*Mojo Mobility*”) (“The fact that the time-to-trial statistics cited by Petitioner predict an even earlier trial date than that set by Judge Gilstrap merely confirms that the

schedule set by the district court is credible and should be given weight.”). Therefore, according to both the court’s schedule and the median court statistics, trial will occur well before any FWD, and this factor heavily favors discretionary denial.

C. Investment in the parallel proceeding by the court and the parties.

In evaluating factor 3, the Board should “consider[] the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. Delay in filing a petition further weighs in favor of denial. *See 10x Genomics*, Paper 15 at 18-19; *Ericsson Inc. v. Collision Commc’ns, Inc.*, IPR2022-01233, Paper 12 at 14-15 (P.T.A.B. Jan. 19, 2023) (“*Ericsson*”).

Both the Court and the parties have invested substantial time and resources in the parallel litigation and will continue to do so before an institution decision. At the time of filing this POPR in June 2024, both UA and Athalonz have produced thousands of documents in discovery, exchanged dozens of letters and emails relating to discovery issues, responded to multiple sets of written discovery, and are undertaking significant work in the claim construction process. *See EX2001*. The parties fully briefed (and the Court denied) a motion to transfer venue. *See Athalonz LLC v. Under Armour, Inc.*, 2023 WL 8809293 (E.D. Tex. Dec. 20, 2023). Athalonz has also filed (and the Court decided) two motions to compel, served four third-party

subpoenas, and briefed three motions to quash in district courts across the country relating to subpoenas to UA’s sponsored athletes Stephen Curry, Jordan Spieth, and Bryce Harper.

By the time of potential institution in mid-September 2024, the parties will have done even more work—they will already have completed claim construction discovery and briefing, and the court’s claim construction hearing will be only days away on September 18, 2024. EX2001. The parties will have substantially completed document production and will be nearly done with fact discovery, including most depositions. *Id.* Finally, the parties will be well into drafting expert reports, including validity expert reports, which are due in mid-October 2024. *Samsung*, Paper 10 at 15-16 (“We consider [validity expert] work significant because it relates directly to the merits of the parties’ invalidity positions.”) (citing *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 10-11 (P.T.A.B. June 16, 2020) (informative) (“*Sand Revolution*”)). The investment in the district court weighs heavily against institution. *See Mojo Mobility*, Paper 11 at 13-14 (finding factor 3 weighed in favor of denial because “Fact discovery is well underway (the deadline to ‘substantially complete document production’ has passed, fact discovery is set to close a little more than two months after the issuance of this decision) and substantial preparation for a . . . Markman Hearing (including briefing) will be completed by [institution].”); *Roku*, Paper 11 at 11-12 (finding factor 3

weighted heavily in favor of denial due to the “completion of preliminary disclosures and claim construction, and the near-completion of discovery.”).

This delay was exacerbated by Petitioner’s lengthy (and unnecessary) delay, causing the Court and the parties to invest significant additional resources. Petitioner was on notice of Athalonz’s infringement theories from its detailed complaint served in April 2023. Athalonz’s infringement contentions were served on September 14, 2023, meaning Petitioner knew full well the entire scope of the case and which claims were at issue for over six months before filing this Petition. EX2001. More significantly, Petitioner’s invalidity contentions were served in November 2023, more than three months before its petitions were filed here. Those contentions raised *every single prior art reference included in the petitions in the same way*. See EX2003 at 11 (listing Kim, Rubin, and Dufour as references that anticipate the ’760 patent), 12 (explaining “[e]ach anticipatory prior art reference, either alone or in combination with other prior art, also renders the Asserted Claims obvious”); EX2004 (invalidity claim chart for Kim); EX2005 (invalidity claim chart for Rubin); EX2006 (invalidity claim chart for Dufour); EX2007 (obviousness chart including all of Petitioner’s obviousness arguments, including use of De Obaldia for dependent claims 4-5 and 9-10). That is, there are no new references, no new combinations, and no new arguments in the Petition that Petitioner did not already know about in November. There is no reason why Petitioner should have delayed for months in

filing this petition, when it entirely repeats its November contentions. Petitioner's choice to delay filing this petition ensured that the court's trial date would come months before the projected date for a FWD. This delay also weighs heavily against institution. *See 10x Genomics*, Paper 15 at 18-19 (finding that waiting to file a Petition "one year after [Petitioner] was served with the counterclaim for infringement" "and nine months after receiving the initial infringement contentions weighs in favor of exercising our discretion to deny institution"); *Ericsson*, Paper 12 at 14-15 (finding factor weighed in favor of denial when petition was filed almost one year from parallel proceeding and nine months after infringement contentions).

The timing of this proceeding, if instituted, would also cause significant hardship on Athalonz, since as it stands Athalonz will be undertaking some of the most burdensome tasks in district court at the same time as it would be required to serve a Patent Owner Response in this IPR. *See Roku*, Paper 11 at 11 ("[I]f we institute trial, the Patent Owner response 'would be due in the middle of pretrial submissions.'"). Indeed, three months after the September 14 deadline for institution in this case is December 14, 2024—just weeks after the dispositive motions briefing is complete and two days before the deadline for pretrial disclosures. EX2001. This timing would significantly disadvantage Athalonz, a small company represented by the same counsel in this IPR proceeding as in district court.

Moreover, Athalonz’s investment in the district court is particularly significant here, as it is a small operating company trying to compete with the much-larger UA by enforcing its patent rights. UA is a public company that saw nearly \$6 billion in revenue last year, whereas Athalonz is a three-employee company that sells only its patented products. Forcing Athalonz to litigate the same prior art here as in district court cuts directly against the goals of IPRs to be a cost-effective alternative to district court proceedings. Accordingly, factor 3 should weigh in favor of discretionary denial.

D. Overlap between issues raised in the petition and in the parallel proceeding.

This factor favors denial “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 12; *Ericsson Inc. v. Godo Kaisha IP Bridge 1*, IPR2022-00726, Paper 11 at 11 (P.T.A.B. Nov. 2, 2022) (“*Godo Kaisha*”) (same).

As explained above for factor 3, this Petition is identical to UA’s invalidity defense in district court. Every single piece of prior art and invalidity ground UA raised in this Petition is also asserted in the district court. *See* EXS2003-2007. This overlap weighs heavily against institution.

Moreover, Petitioner has not offered any stipulation that it will not raise prior art that it raised or reasonably could have raised in the Petition in district court. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB

Dec. 1, 2020) (precedential as to § II.A); *Sand Revolution II*, Paper 24 at 7. This is particularly troublesome here, where Petitioner faces no statutory estoppel in district court because of its choice to delay filing the Petition such that a FWD would not issue until well after trial. Petitioner's overlapping prior art and lack of stipulation weighs extremely heavily in favor of denying institution.

E. Whether the petitioner and the defendant in the parallel proceeding are the same party.

UA is both the Petitioner and the defendant in the parallel proceeding, which weighs against institution. *See Int'l Bus. Machines Corp. v. Digital Doors, Inc.*, No. IPR2023-00970, Paper 8 at 13 (P.T.A.B. Jan. 12, 2024); *10x Genomics*, Paper 15 at 20; *Godo Kaisha*, Paper 11 at 13.

F. Other circumstances that impact the Board's exercise of discretion, including the merits.

Other circumstances support the Board exercising its discretion not to institute here. As discussed above, Athalonz is a small operating company trying to compete in the market by enforcing its patent rights against an alleged willful infringer, UA. And UA is a multinational corporation with billions of dollars in revenue that can much more easily afford to litigate these claims in parallel proceedings than Athalonz. This skewed power dynamic weighs against institution.

Moreover, the merits weigh against institution. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4-5 (P.T.A.B. Feb. 27, 2023)

(precedential) (“In circumstances where ... the Board’s analysis of *Fintiv* factors 1–5 favors denial of institution, the Board shall then assess compelling merits.”). Petitioner’s invalidity arguments fall far short of a “[c]ompelling, meritorious challenge”—one “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Interim *Fintiv* Guidance, 4; *Roku*, Paper 11 at 14. As set forth in detail below, Petitioner’s invalidity arguments contain significant flaws, and rely on conclusory expert testimony to fill critical gaps in the prior art. At bottom, this is not a compelling case on the merits—it is the opposite, which favors denial of institution, particularly when combined with the other unique circumstances here.

VIII. PETITIONER HAS NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIMS.

A. Ground 1: Kim Does Not Disclose or Render Obvious Independent Claim 1

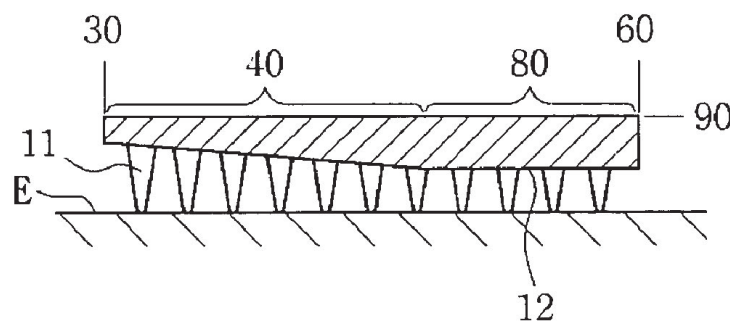
Every challenged claim of the ’760 patent requires having a left shoe sole that “provides an athletic positioning of a left big toe area of the left shoe at a lower position than a left heel area of the left shoe and at a lower position than an outer small toe area of the left shoe.” Kim does not disclose this limitation, regardless of the construction of “athletic positioning,” and Petitioner makes no obviousness argument at all. Indeed, Petitioner cites only to its expert declaration generally for this limitation, but the declaration contains no opinions on obviousness—it simply

parrots the claim language and quotes from various paragraphs of Kim with no other explanation. *See* EX1002, § IX.A.e. Thus, Ground 1 of the Petition fails.

Under Patent Owner’s construction, the term “athletic positioning” requires having “a heel section higher than the toe section and the outside edge of the toe section higher than the inside edge of the toe section.” *Supra*, § VI.B. Petitioner presents no evidence that Kim discloses such an arrangement or would render it obvious. Even adopting a broader construction of “athletic positioning” would not resolve the issues in Kim because Kim does not disclose a pair of shoes where both “a left big toe area of the left shoe at a lower position than a left heel area of the left shoe and at a lower position than an outer small toe area of the left shoe” and “from an inner edge to an outer edge of the shoe, the heel area has substantially no slope.”

In Kim, the sole remains at a parallel, flat position relative to the ground, as illustrated below in the cross-section shown in Figure 3b:

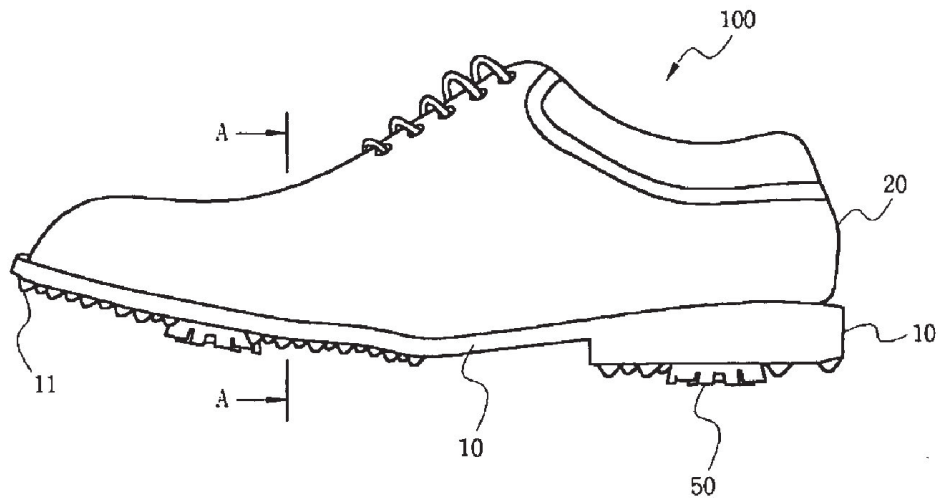
FIG. 3b



Thus, when the shoe is worn on flat, hard surfaces, the “upper surface of the outsole is substantially parallel with a ground,” EX1005, Abstract, both from the heel to the toe of the shoe and from the inner to the outer edge of the shoe. That is, in Kim, the left big toe area is not at a lower position than the outer small toe area of the shoe, and the left big toe area of the left shoe is not at a lower position than a left heel area of the left shoe. Petitioner therefore fails to show that Kim discloses the “athletic positioning” of the ’760 patent with or without Patent Owner’s construction.

Petitioner argues that Kim has a heel area that is elevated as compared to the front inner edge of the outsole, relying on Figures 2 and 3A. Pet., 20. However, these figures are insufficient to show a heel area higher than the toe area. As shown above, the cross-sectional views of Kim’s shoes show a completely flat foot platform relative to the ground, and Kim repeatedly explains that the “upper surface of the outsole is substantially parallel with a ground.” EX1005, Abstract. And Kim also explains that its cleats and outsole design are consistent throughout the entire shoe, from toe portion to heel portion. As disclosed by Kim and shown in Figure 1, “the height of the spikes 11 and 50 at the outer edge 60 of the outsole 10 with the larger thickness is smaller than the height of the spikes 11 and 50 at the inner edge 30 of the outsole 10 with the smaller thickness.” *Id.*, [0033]; Fig. 1:

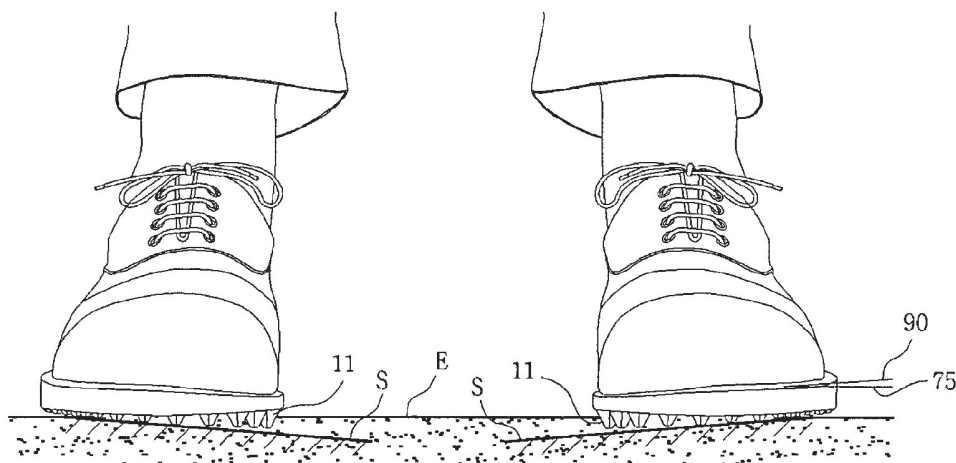
FIG. 1



Thus, Kim does not disclose a heel platform higher than a toe section. This is yet another reason why Kim fails to disclose or render obvious claim 1.

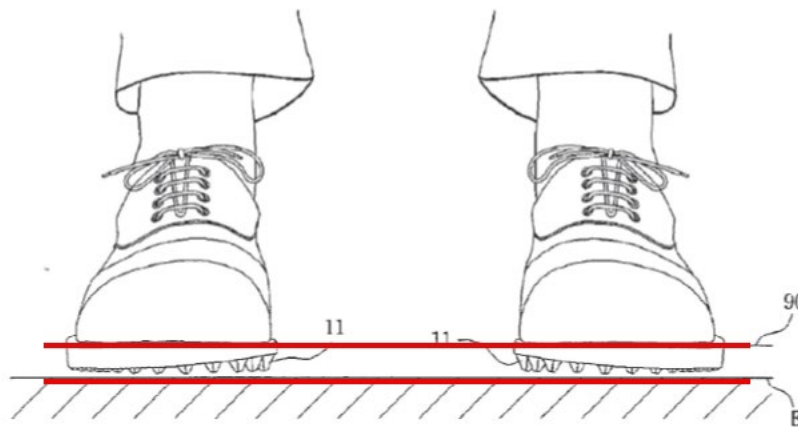
Petitioner also relies on the fact that Kim has cleats that are longer on the inner edge of the shoe than the outer edge of the shoe, such that when the shoes are worn on soft surface the entire foot (from toe to heel) tilts inward, as shown in Figure 5b:

FIG. 5b



But this requires a manual repositioning of the shoes with respect to Figure 5a of Kim, which shows Kim's shoes as manufactured and placed on a flat, level surface. In this figure, as with the description of the other embodiments of Kim, the foot remains flat with respect to the upper surface of the outsole, and as a result the big toe and small toe are level with each other and parallel to the ground surface and to the bottom of the shoe (the portion in contact with the ground E):

FIG. 5a



EX1005, Fig. 5a (annotated). Indeed, Kim explains that in this figure, “the reference numeral 90 denotes a line representing the level of the golfer’s feet being parallel with the ground E.” *Id.*, [0039].

Moreover, in Fig. 5b of Kim, the *entire foot* is rotated inward at an angle, including the heel. Thus, even if the Board finds the claim permits manual reorientation of the shoe when pressed into the ground, Kim still fails to disclose or render obvious claim 1, which also requires “from an inner edge to an outer edge of

the left shoe, the left heel area has substantially no slope.” In the Fig. 5b embodiment of Kim, the left heel area has an inward slope and the entire foot of Kim is at an angle. Therefore Kim fails to disclose or render obvious the claim.

Because Kim fails to disclose the limitations of claim 1, and because Petitioner makes no other obviousness arguments as to Kim, Ground 1 fails.

B. Ground 2: Dufour Does Not Disclose or Render Obvious Independent Claim 1

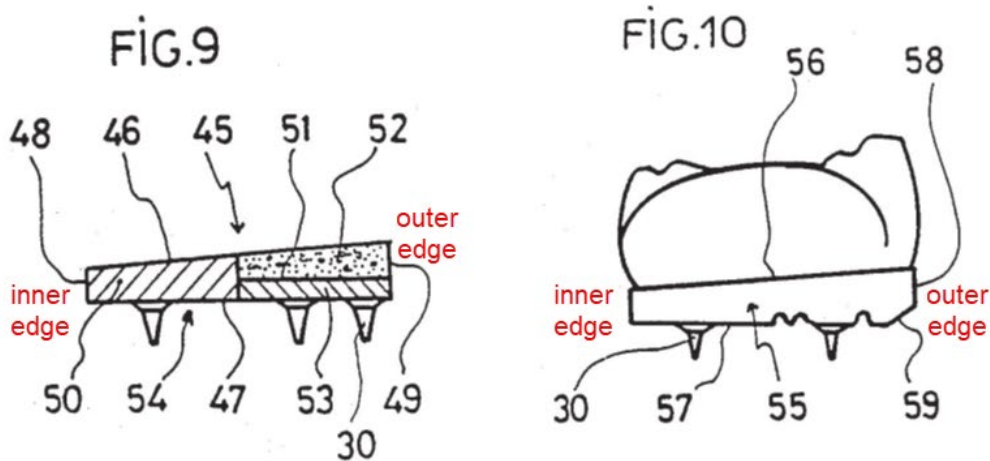
As discussed above, every challenged claim of the '760 patent requires having a left shoe sole that “provides an athletic positioning of a left big toe area of the left shoe at a lower position than a left heel area of the left shoe and at a lower position than an outer small toe area of the left shoe,” and has a heel area with substantially no slope. Dufour also does not disclose these limitations, and Petitioner again makes no obviousness argument, citing only to its expert declaration generally for limitation 1.4, which contains no opinions on obviousness. *See* EX1002, § IX.B.e. Thus, Ground 2 of the Petition fails.

1. Dufour Does Not Disclose the Claimed “Athletic Positioning” And A Heel Area With Substantially No Slope.

Dufour discloses a number of separate embodiments of a golf shoe with different foot positioning, but none of those embodiments show a shoe with the athletic positioning claimed in the '760 patent including a heel area with substantially no slope. Petitioner mixes and matches different figures from different

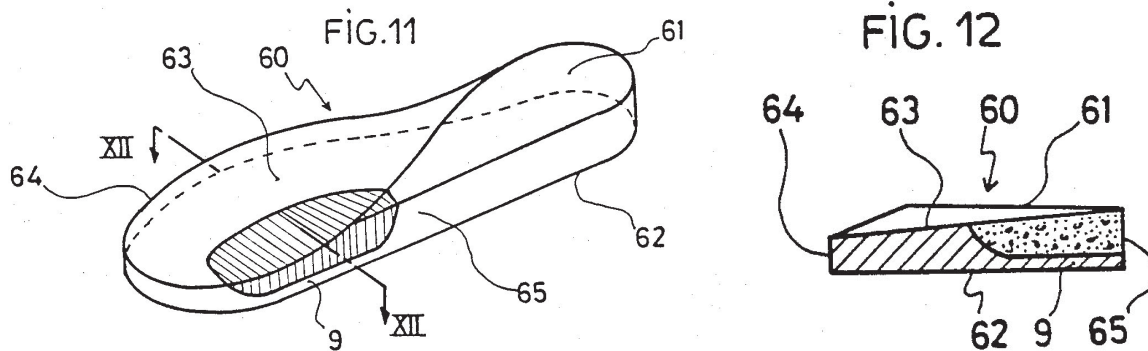
embodiments without admitting it is doing so and without providing any obviousness rationale for making any modifications. For limitations 1.4 and 1.5, Petitioner cites Figures 9, 10, 11, and 12, which as previously explained are directed to two different embodiments with different features.

First, Figures 9 and 10 of Dufour show a golf shoe where the entire sole is inclined consistently from the inner edge 48 upward to the outer edge 49:



That is, in this embodiment of Dufour, the heel at the inner edge of the shoe (left side of the figures) is at the same height as the big toe area, and the heel at the outer edge of the shoe (right side of the figures) is at the same height as the small toe area. In this embodiment, Dufour does not disclose a shoe where “from an inner edge to an outer edge of the left shoe, the left heel area has substantially no slope.” *See Pet.*, 32. Petitioner appears to rely on this embodiment for limitations 1pre through 1.3, but then abandons citations to Figures 9 and 10 for the rest of the limitations.

Second, Figures 11 and 12 of Dufour show a different embodiment of a golf shoe where the plantar support surface 61 is flat and the support surface 63 inclines from the inner edge to the outer edge, which is at the same height as the plantar support surface 61:



That is, in this separate embodiment of Dufour, the plantar support surface 61 (which includes more than just the heel section) at the outer edge of the shoe (the right side of Figs. 11 and 12) is at the same height as the small toe, and only the inner edge of the shoe in the big toe area is at a lower position.

This embodiment does not disclose the “athletic positioning” in limitation 1.4. Under Petitioner’s construction, this term requires “a heel section higher than the toe section and the outside edge of the toe section higher than the inside edge of the toe section.” In Figures 11 and 12 of Dufour, the heel section 60 is at the same level as the outside edge 65 of the shoe. This fails to provide the athletic positioning claimed in the ’760 patent because the heel is not elevated with respect to the rest of the foot.

Petitioner makes no obviousness argument that a POSITA would have modified Dufour to achieve this positioning.

None of the other embodiments of Dufour disclose the claimed “athletic positioning,” either. Figure 13 shows a consistently sloped foot platform where the heel is higher than the toe, “so that the front part 72 is thinner than the part at the heel 72.” EX1006, 5:15-24. And Figure 14 “teaches a relatively constant thickness in the direction of its length” such that the entire foot platform remains flat relative to the ground. *Id.*, 5:25-30.

Petitioner’s attempt to mix and match embodiments without providing any rationale or reasoning is improper. *See, e.g., Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 8 at 8-12 (P.T.A.B. Oct. 23, 2017) (“*Abiomed*”). For example, in *Abiomed*, Petitioner’s obviousness argument relied on a combination of various embodiments within a single prior art reference. The Board declined institution, finding that “Petitioner’s challenge treats the various features of [the prior art]’s different embodiments as if they are interchangeable with one another.” *Id.*, 10. The Board made clear that Petitioner’s failure to “explain sufficiently *why* one skilled in the art would have found it obvious to combine those teachings” was fatal, even where an expert declaration supported the obviousness argument. *Id.*, 10-11 (emphasis in original).

Here, Petitioner's Ground 2 suffers from the same flaws. Petitioner relies on two separate embodiments of Dufour (Figures 9-10 and Figures 11-12) and treats their features as if they are interchangeable. Neither Petitioner nor its expert even acknowledges that there are separate embodiments at issue and they provide no explanation at all of how or why a POSITA would have combined those embodiments and modified Dufour to meet the claims. Given that no single embodiment of Dufour discloses all the claim elements as arranged and Petitioner makes no legitimate obviousness arguments, Petitioner's Ground 2 fails.

2. Dufour Does Not Disclose “A Pair of Shoes” With a “Left Foot Shoe” and a “Right Foot Shoe”

Ground 2 also fails for an independent reason: Dufour is directed to a single shoe among a pair of shoes that has a unique positioning to aid in a golf swing, whereas the '760 patent expressly claims a pair of shoes, each of which have the claimed athletic positioning. Dufour explains in its abstract that the invention is designed “to allow the golfer's foot to roll on the outer edge of the sole” and provides a shock absorbing element and deformable structure to achieve this goal. EX1006, Abstract; *see also* Figs. 1, 3. Thus, Dufour is specifically designed to provide “a left shoe, thus a shoe for right-handed golfers,” *id.* 1:51-57, meaning it is directed only to the front, rolling foot in a golfer's swing. Dufour is not directed to a “pair of shoes” for that purpose.

Petitioner's attempt to extend Dufour's disclosure to a pair of shoes fails.

Petitioner relies on the fact that Dufour states that the characteristics “can be applied to a right shoe,” but ignores that this is in the context of a shoe “for left-handed golfers.” *Id.*, 3:43-48. That is, Dufour's invention is clearly about a new design for the front foot in a golf swing, and explains that the shoe can be adapted to work for the front foot in the stance of either a right-handed or left-handed player. Dufour does not suggest in any way that its design would be applied to both shoes for a single golfer.

Petitioner's only other obviousness argument is that “it would have been obvious to a POSITA to apply these features to both shoes to provide the associated benefits for both feet.” Pet., 33. Petitioner's claimed rationale for this modification is that it would provide “the transverse seating for the foot having an inclined support surface from the inner edge to the outer edge, as shown in Figs. 11-12, that provides for an improved golf stance.” *Id.* But Petitioner's argument is illogical and conflicts with Dufour's own disclosure—that the shoe is designed to allow the front foot of a golfer to roll over more effectively during a swing on the outside, front edge of the shoe. Petitioner also provides no explanation about why this alleged benefit would actually be beneficial to a golf swing, particularly where the rear foot of the golf swing would never roll over on its outside edge during a swing.

Moreover, Petitioner has no support for this alleged benefit other than a conclusory statement from its expert—the entire paragraph of the expert declaration is taken directly from the paragraph in the Petition with only a few non-substantive word changes. *Compare* Pet., 33 (paragraph beginning “To the extent Dufour suggests providing the described features to only one of the shoes . . .”), *with* EX1002, ¶ 81 (“To the extent Dufour suggests providing the described features to only one of the shoes . . .”). This type of conclusory expert testimony, copied from the Petition, fails to support an obviousness argument. *See, e.g., Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15-16 (P.T.A.B. Aug. 24, 2022) (rejecting expert testimony that “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support,” which is “particularly problematic in cases where, like here, expert testimony is offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art.”) (citing 37 C.F.R. § 42.65(a) and Federal Circuit case law).

C. Ground 3: Rubin Does Not Disclose or Render Obvious Independent Claim 1

As discussed above, every challenged claim of the '760 patent requires having a left shoe sole that “provides an athletic positioning of a left big toe area of the left shoe at a lower position than a left heel area of the left shoe and at a lower position than an outer small toe area of the left shoe.” Rubin does not disclose this limitation—like Kim, Rubin discloses a golf shoe with a foot platform parallel to the

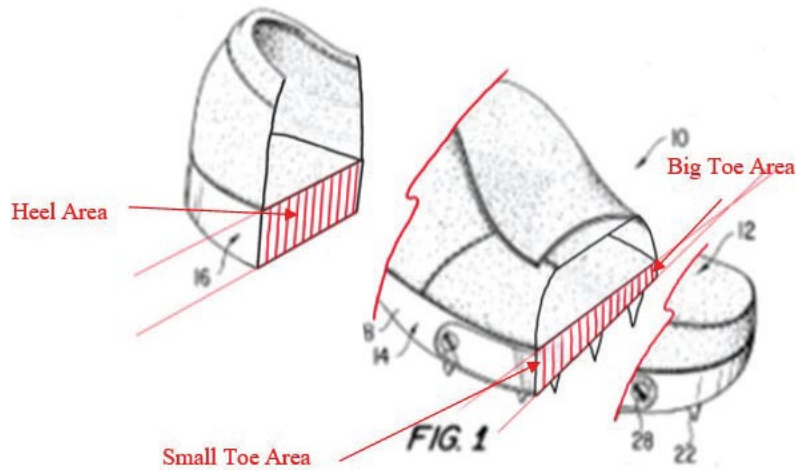
ground surface. Once again, Petitioner makes no obviousness argument, citing only to its expert declaration generally for limitation 1.4, which contains no opinions on obviousness. *See* EX1002, § IX.C.e. Thus, Ground 3 of the Petition fails.

1. Rubin Does Not Disclose or Render Obvious Limitation 1.4 or 1.5

Rubin discloses a golf shoe with variable thickness in the sole and variable length on the cleats, which are inversely proportional. As described by Rubin, “[t]he outer side 18 of sole 14 extends downwardly from the shoe upper 12 to a lower elevation than the inner side 20 of [the] sole.” EX1007, 3:9-11. But Rubin also explains that “[p]rojecting downwardly from the bottom of sole 14 are a plurality of cleats 22. . . . Cleats 22 adjacent the other side 18 of the sole 14 are smaller than the cleats adjacent the inner side 20 of the sole 14 by an amount approximately equal to the difference in elevation between the outer side 18 and inner side 20 of the sole 14 so that when the wearer walks on a non-playing surface, such as a concrete deck 24 as illustrated in FIG. 2, the foot of the wearer will be substantially level.” *Id.*, 3:24-37.

As Rubin itself explains, the foot platform of the shoe remains substantially level on a hard surface. Rubin does not disclose anywhere that it has a toe section lower than a heel section. Petitioner’s only basis for claiming Rubin discloses this is a single statement that “Rubin also teaches and/or suggests that the big toe area is at a lower position than the heel area” relying solely on its expert and Figures 1 and 3.

Pet., 42. But these figures do not show a heel area higher than a toe area. Instead, the annotations Petitioner's expert applied to Figure 1 ignore the cleats on the sole of Rubin and only consider the shoe sole:

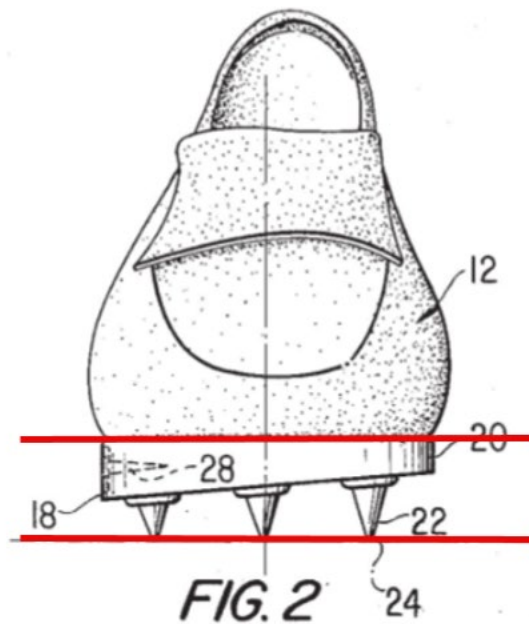


This figure clearly shows cleats on the inner edge of the shoe that are not included in Petitioner's expert's annotations. When the cleats are considered, Rubin explains clearly that the "foot of the wearer will be substantially level." EX1007, 3:24-37. Thus, Rubin fails to disclose or render obvious a toe section at a lower position than a heel section.¹

Moreover, Rubin also fails to disclose a shoe where both 1) the big toe area is at a lower position than an outer small toe area, and 2) the heel area has substantially no slope from an inner edge to an outer edge of the shoe. *See* Limitation 1.4 and 1.5. Petitioner relies on Fig. 4 of Rubin, which shows the cleats on the inner edge 20

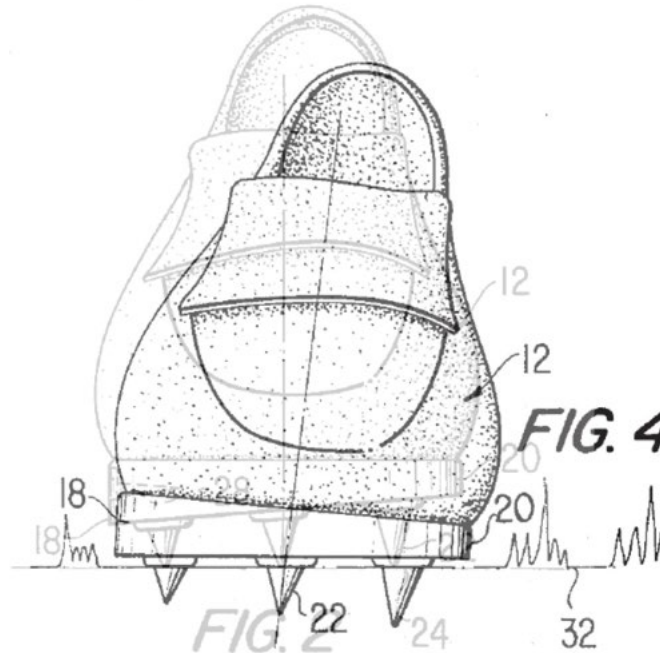
¹ This limitation is required regardless of the construction of "athletic positioning."

(right above) depressed into the ground so that the big toe position is lower than the small toe position. Pet., 41. Petitioner admits that this position only applies “when the shoe is worn,” which is not required by the claims. Instead, when the shoe is on flat ground, the cleats on the outer side of the shoe are proportionally smaller than on the inside of the shoe to account for the change in thickness of the sole, such that “the foot of the wearer will be substantially level.” EX1007, 3:24-37. This is shown in Figure 2 (annotated):



Even accepting Petitioner’s argument and considering the shoe’s position when worn and pushed into the ground, however, Rubin fails to disclose claim 1. Claim 1 also requires “from an inner edge to an outer edge of the left shoe, the left heel area has substantially no slope.” When Rubin’s shoe is pressed into the ground, the entire foot of the golfer will tilt inward, such that the inner edge of the heel is

lower than the outer edge. This can be seen by superimposing Figure 4 over Figure 2:



As these figures make clear, the entire foot of Rubin will be tilted in at an angle during a swing on a soft surface. Therefore, Rubin does not disclose or render obvious claim 1 and Ground 3 fails.

2. Rubin Does Not Disclose “A Pair of Shoes” With a “Left Foot Shoe” and a “Right Foot Shoe”

Like with Dufour, *see* §VIII.B.2, Petitioner’s Ground 3 based on Rubin also independently fails because Rubin is directed only to a single shoe and not a pair of shoes with both a right and left shoe, as required by the ’760 patent.

Rubin is directed to a “golf shoe,” EX1007, Title, and never once references or shows a pair of golf shoes.² Rubin explains that the purpose of its golf shoe is to “aid a golfer in assuming a proper stance on a golf playing surface so that when addressing the ball the golfer pivots about a more or less stationary vertical line rather than swaying during his swing.” *Id.*, Abstract. Rubin explains that when its golf shoe is used, the “rearwardmost foot of the golfer will be tilted inwardly because of the wedge-shaped sole 14 of [the] shoe 10,” which “will tend to provide a more satisfactory weight distribution when hitting the ball” and will result in a “more desirable pivot.” *Id.*, 3:56-64. Rubin also includes features such as a “metal plate” fixed to the sole “along the outer side thereof so as to be substantially flush therewith and to preclude undue bending and wear of the sole edge during the pivotal portion of a golfer’s swing.” *Id.*, 4:14-32. Thus, Rubin is clear that its design is aimed at improving only the rear shoe in a golfer’s swing. Because Rubin’s design is focused on improving only the rearward shoe in a golfer’s stance, its design is simply not applicable to a “pair” of golf shoes.

² Petitioner makes its obviousness argument in the preamble, but a “left foot shoe” and a “right foot shoe” are both required by independent claim 1. Thus, the preamble need not be limiting for this Ground to fail.

Petitioner’s attempt to extend Rubin’s disclosure to a pair of shoes fails. Petitioner first claims that Rubin “discloses golf shoes designed to aid a golfer in assuming a proper stance, and thereby develop a more consistent swing.” Pet., 38. None of the portions of Rubin cited by Petitioner or its expert, however, refer to a pair of shoes or a left and right shoe—they consistently refer to a single shoe. *See* EX1007, 1:5-22 (referencing a “golf shoe” three times); 1:63-68 (“The golf shoe of the present invention . . .”); EX1002, § IX.C.a (citing Abstract and 1:6-11). And other portions of Rubin make clear that its disclosure is limited to use in the rearwardmost foot of the golfer when taking a swing. EX1007, 3:56-64.

Petitioner’s only other obviousness argument is that “it would have been obvious to provide both left and right shoes with the disclosed features based on Rubin’s teachings and the knowledge of a POSITA.” Pet., 38-39. Petitioner’s claimed rationale for this modification is that it would improve a golfer’s stance and weight distribution further to provide the golfer’s weight to be placed on the inside of both feet. *Id.* But Petitioner does not rely on anything in Rubin for this argument—Rubin never discusses weight distribution of both of a golfer’s feet, and consistently refers only to a single rearward shoe, including features like a metal plate designed particularly to prevent bending in the rolling motion of a golfer’s rear foot. EX1007, Abstract.

Moreover, Petitioner has no support for this alleged benefit other conclusory testimony its expert—most of the entire paragraph of the expert declaration is taken directly from the paragraph in the Petition with only a few non-substantive word changes. *Compare* Pet., 38-39, with EX1002, ¶ 94. This type of conclusory expert testimony, copied from the Petition, fails to support an obviousness argument. *See, e.g., Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15-16 (P.T.A.B. Aug. 24, 2022) (rejecting expert testimony that “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support,” which is “particularly problematic in cases where, like here, expert testimony is offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art.”) (citing 37 C.F.R. § 42.65(a) and Federal Circuit case law). The only other addition in the expert declaration is a string of citations from Kim that purportedly describe additional benefits of providing both shoes with the claimed features. But Petitioner does not rely on Kim in combination with Rubin and does not even rely on this portion of the expert declaration in the Petition in any detail. Petitioner’s attempt to modify Rubin using teachings from Kim without actually doing an obviousness analysis or combination is improper.

D. Grounds 4-6: De Obaldia Does Not Solve the Problems in Grounds 1-3 For the Independent Claims

Petitioner relies on De Obaldia in Grounds 4, 5, and 6 solely for the “stabilizing cup” limitation in dependent claims 4-5 and 9-10. Petitioner does not

argue or show that De Obaldia would be combined with Kim, Dufour, or Rubin to resolve the issues each reference has for independent claim 1, as described above. Thus, Grounds 4, 5, and 6 all fail because none of Kim, Dufour, or Rubin, alone or as combined with De Obaldia, disclose or render obvious independent claim 1. Institution should therefore be denied.

IX. CONCLUSION

For the reasons stated above, the Board should deny institution of IPR.

Dated: June 14, 2024

Respectfully submitted,

/Michael Matulewicz-Crowley/
Michael Matulewicz-Crowley
Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that Patent Owner's Preliminary Response (the "POPR") consists of 10,877 words, excluding the table of contents, certificate of service, this certificate of compliance, or table of exhibits. The POPR complies with the type-volume limitation of 14,000 words as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare this paper (Microsoft Word).

Dated: June 14, 2024

/Michael Matulewicz-Crowley/
Michael Matulewicz-Crowley
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** was served on, via electronic mail, as agreed to by counsel, upon the following counsel for Petitioner:

Frank C. Cimino
fccimino@veneable.com
Megan S. Woodworth
MSwoodworth@veneable.com
Justin J. Oliver
JJoliver@veneable.com
VENEABLE LLP
600 Massachusetts Ave., N.W.
Washington, DC 20001

Robert E. Bugg
REBugg@veneable.com
VENEABLE LLP
151 West 42nd Street
49th Floor
New York, NY 10036

Dated: June 14, 2024

/Michael Matulewicz-Crowley/
Michael Matulewicz-Crowley
Counsel for Patent Owner