

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNDER ARMOUR, INC.

Petitioner

v.

ATHALONZ, LLC

Patent Owner

Case IPR2024-00640
U.S. Patent 11,510,456

PATENT OWNER'S PRELIMINARY RESPONSE

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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 J ('456 Patent Invalidity Chart Based on Won) 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 K ('456 Patent Invalidity Chart Based on Umezawa) 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 L ('456 Patent Invalidity Chart Based on Norton) 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 U ('768 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.)
2008	U.S. Patent 11,375,768 to <i>Adair et al.</i> (" <i>Adair</i> ")

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. 11,510,456 (“the ’456 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 here. Petitioner delayed filing the Petition here for months after it provided invalidity contentions in district court relying on every piece of prior art it included in the Petition, in the same way. 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 ’456 patent. Petitioner relies solely on obviousness arguments, and every ground either ignores critical limitations by relying, *sub silentio*, on erroneous claim

constructions that read out the limitations or bases its arguments exclusively on conclusory expert testimony to fill substantial gaps in the prior art. The fact is that the '456 Patent is novel and nonobvious—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 '456 Patent

The '456 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.*, 1:48-50. For example, athletic shoes generally had a “particular sole pattern, a sole design, an insole design, and upper shoe portion design.” *Id.*, 1:54-57. 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.*, 1:65-66. 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.*, 1:66-2:4.

The '456 patent improved on the prior art by generally claiming, *inter alia*, a shoe in which the heel section is constructed of a first material and has a substantially

uniform height from an inner edge to an outer edge, and the forefoot is constructed of a second material that has a gradient compression factor.

Figure 8 is an isometric diagram of one embodiment of the shoe described in the '456 patent, which shows the heel platform with a substantially uniform height from an inner edge to an outer edge:

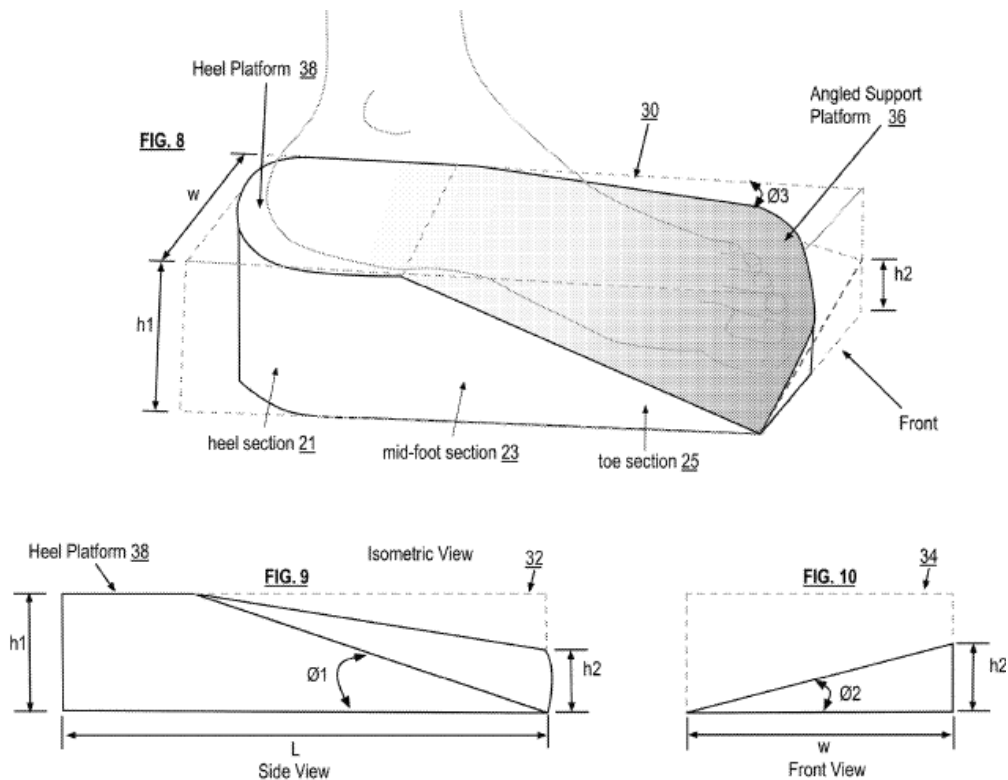


Figure 20 is one of many other illustrations, which illustrates a heel platform 38 with a substantially uniform height from an inner edge to an outer edge, as well as a forefoot platform (i.e., the angled support platform 36).

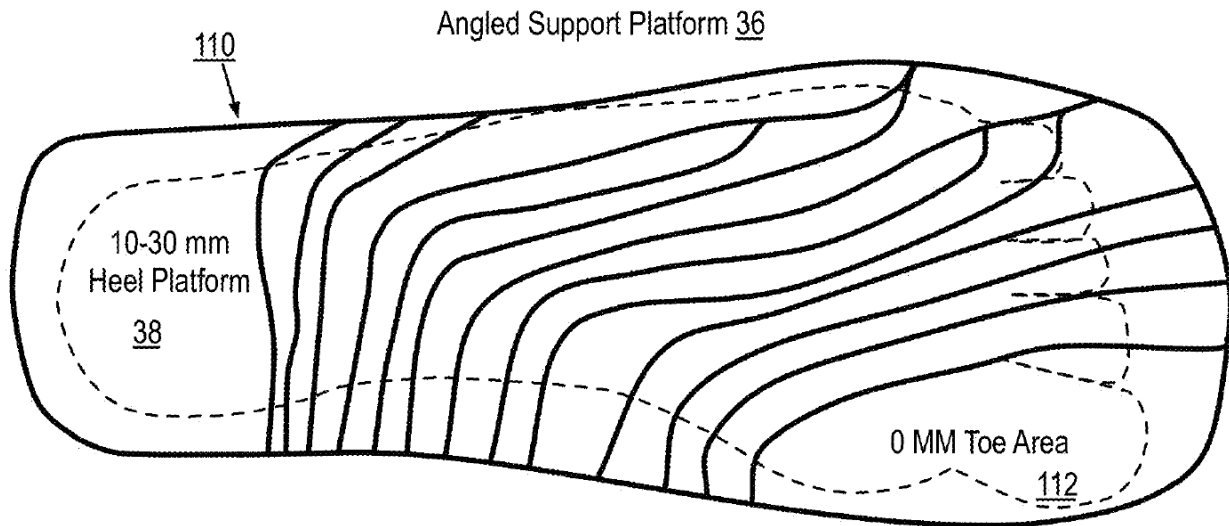


FIG. 20

Figure 93 is a diagram of one embodiment of the shoe described in the '456 patent with a second material that has a gradient compression factor, as described in the '456 patent:

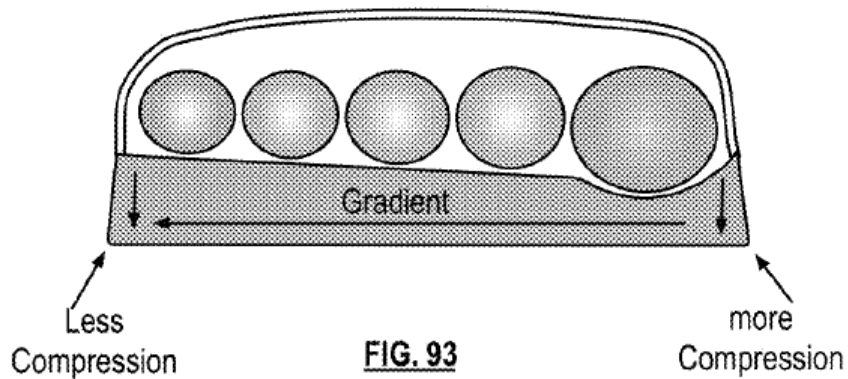


FIG. 93

Figure 42 shows an embodiment of the athletic positioning shoe with the heel and the forefoot constructed of different material compositions (i.e., there is a greater

proportion of “Compressible Material #2” in the heel platform than in the forefoot platform).

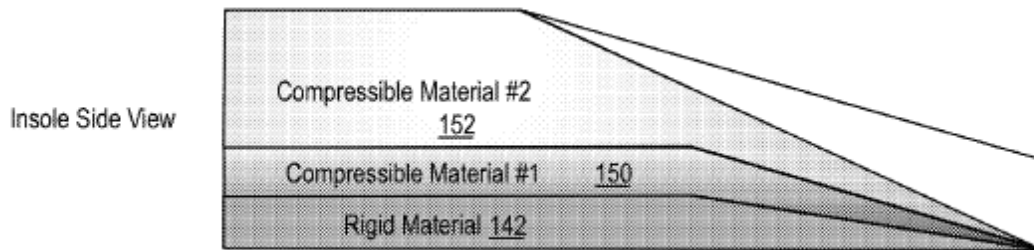


FIG. 42

Figures 112 and 113 illustrate a front view of another embodiment of the shoe described in the '456 patent with the forefoot platform constructed of a material composition of an easily compressible material 140 and a rigid material 142.

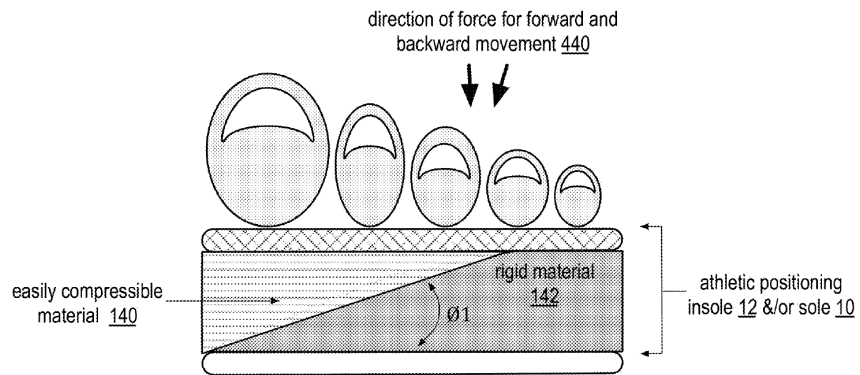
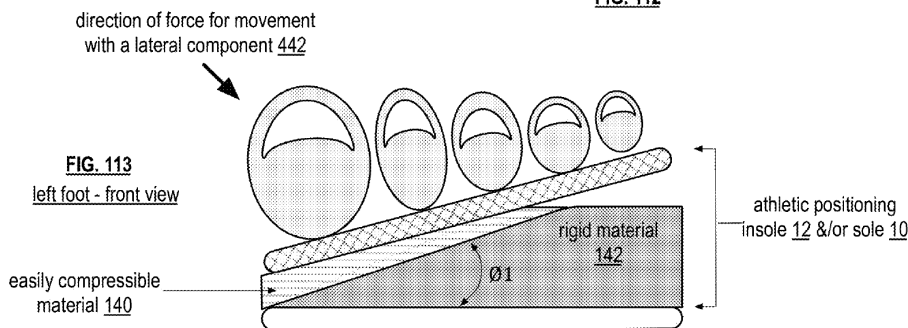


FIG. 112



B. The Claims of the '456 Patent

Exemplary independent claim 1 of the '456 patent is shown below:

1. An athletic shoe comprises:
 - an upper section; and
 - a sole section coupled to the upper section, wherein the sole section includes:
 - a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section, wherein the heel platform is constructed of a first material; and
 - a forefoot platform juxtaposed to the heel platform, wherein the forefoot platform is constructed of a second material having a gradient compression factor, wherein, when the athletic shoe is worn by an athlete and weight of the athlete is applied to the athlete shoe, the second material compresses to a first level near an outer edge of the sole section and the second material compresses to a second level near an inner edge of the sole section, wherein the second level of compression is greater than the first level of compression.

EX1001, claim 1.

Exemplary independent claim 10 of the '456 patent is shown below:

10. An athletic shoe comprises:

an upper section; and

a sole section coupled to the upper section, wherein the sole section includes:

a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section, wherein the heel platform is constructed of a first material; and

a forefoot platform juxtaposed to the heel platform, wherein the forefoot platform is constructed to have a first level of compression proximal to the outer edge of the shoe and a second level of compression proximal to an inner edge of the shoe, wherein the second level of compression is greater than the first level of compression.

EX1001, claim 10.

Petitioner also challenges dependent claims 2-5, 7, 9, 11-15, 17, which add additional limitations.

C. Overview of Petitioner's Prior Art

1. Overview of Umezawa (EX1006)

U.S. Patent Application No. 11/505,338 to Umezawa ("Umezawa") claims a "shoe" that, in particular, has a "low elastic part 20" (shown in yellow below), a

“high elastic part 22” (shown in red below), and another “high elastic part 22 which is located to the inside of the low elastic part 20 [that] is hereinafter referred to as ‘inner high elastic part 26’” (still shown in red below). EX1006, ¶0037. Notably, the level of compression near the inner edge of the sole is the same as that near the outer edge of the sole, because they are both the same “high elastic part 22” (in red). *Id.* It is only in the middle of the sole that Umezawa discloses a “low elastic part” (in yellow). This is markedly unlike the ’456 patent, which requires that “level of compression” “near an inner edge of the sole section” is greater than the “level of compression” “near an outer edge of the sole section.”

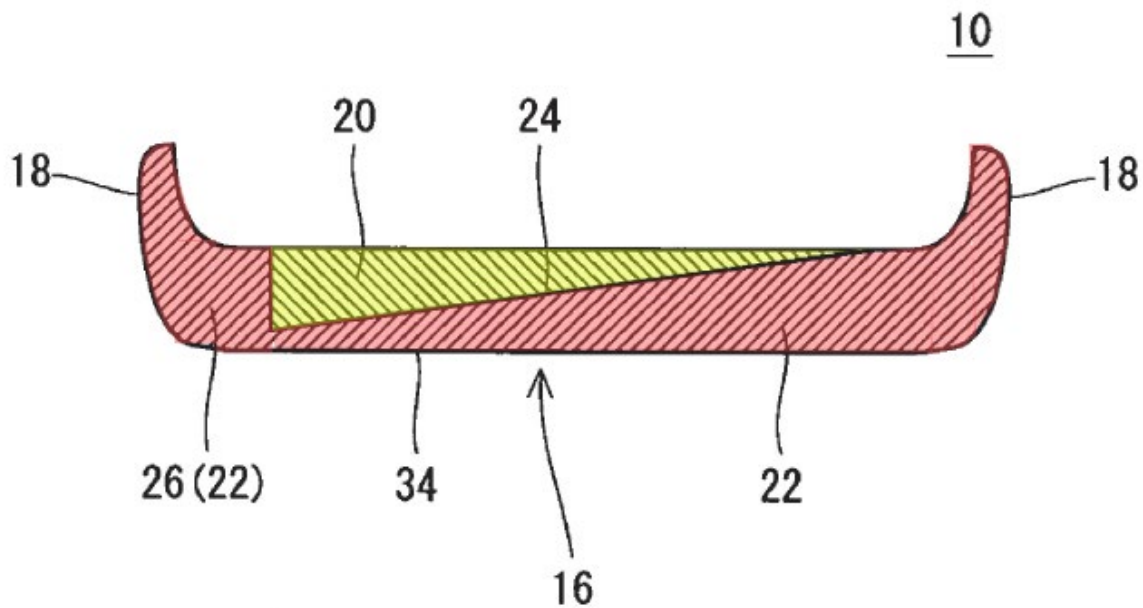


Fig. 3

EX1006, Fig. 3 (annotated).

2. Overview of Norton (EX1007)

U.S. Patent No. 7,464,428 to Norton (“Norton”) discloses a “sole element” (for example in Figures 4A and 4B)—not a “heel platform” (of which the “sole element” is a part). EX1007, Title; Abstract; 7:36-38. Norton explains that the sole element is used with other parts of the sole: “[T]he sole element in accordance with the invention is typically formed as a midsole, *where an outsole and an insole for improving comfort are additionally provided.*” *Id.*, 5:60-63 (emphasis added). Thus, the “sole element” is not the entirety of the “heel platform,” but just a part, and does not disclose that the entire “heel platform” has a first uniform height from an inner edge to an outer edge.

Moreover, the point of Norton is that “[o]ne aspect of one embodiment of the present invention is to not use two different materials with different densities to create the density variation over the sole element and to connect these materials subsequently, but *to use a single material* being supplied as a preform and having a thickness distribution that is transformed by pressure forming into the desired density distribution.” EX1007, 3:9-15 (emphasis added). Petitioner acknowledges that “Norton teaches a single-material sole.” Pet., 28. Thus, unlike the ’456 patent, Norton does not disclose or suggest a heel platform and a forefoot platform—much less that the heel platform and the forefoot platform are constructed of different materials (a first and second material).

3. Overview of Won (EX1005)

U.S. Patent No. 6,158,151 to Won (“Won”) discloses “golf shoes.” EX1005, Title; Abstract. Won is largely concerned with the height relationship between heel and toe of golf shoes, such that “the toe portion (34) is higher than the heel portion (30).” *Id.*, 4:40-44.

Petitioner does not point to these portions of Won, but instead to a short disclosure that concerns the “surface of [the] sole” (and, notably, not the sole material itself). *Id.*, 4:46-58 (“The inside surface is soft surfaced and outside surface is hard surfaced, both of which are made from elastic materials.”). This is shown in Figure 5 below, which shows various surfaces of shoes.

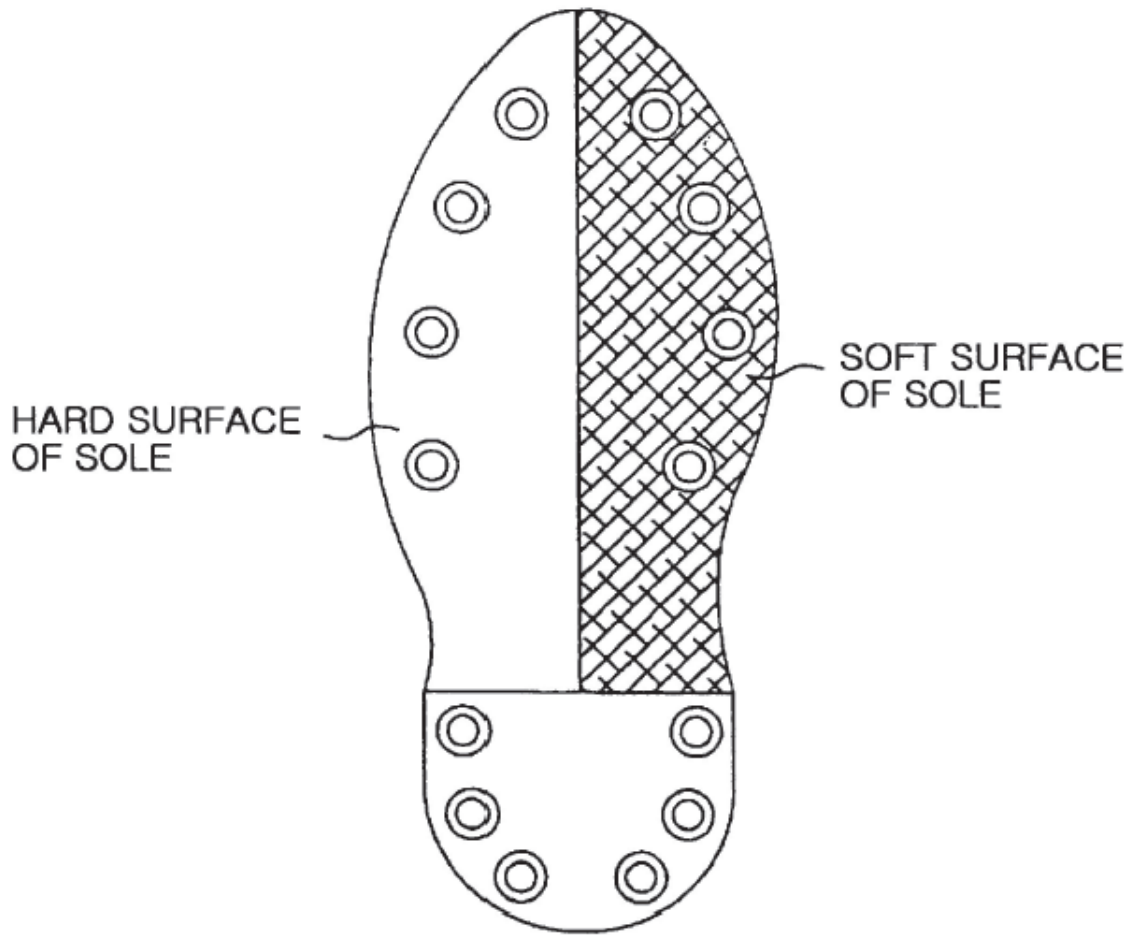


FIG. 5

EX1005, Fig. 5.

Notably, even these surfaces do not disclose a material with a “gradient compression factor,” as Petitioner acknowledges, but two areas with different compressions (and no gradient). *Id.*, *see, e.g.*, Pet., 27-28. Moreover, Won is also concerned mainly with the forefoot platform and its relationship to the heel platform, but not the heel platform itself, and thus does not disclose the heel platform’s

material or that it has a substantially uniform height from an inner edge to an outer edge.

4. Overview of Talarico '911 (EX1008)

U.S. Patent No. 4,642,911 to Talarico ("Talarico II") discloses "Dual-Compression Forefoot Compensated Footwear." EX1008, Title; Abstract. Talarico '911 is also directed only to the forefoot portions of the footwear, and thus does not disclose the elements of the '456 patent concerning the heel.

III. PRIORITY DATE OF THE '456 PATENT

Petitioner does not explicitly identify the priority date of the '456 patent. The '456 patent claims priority to, *inter alia*, 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 '456 patent. Patent Owner reserves all rights to establish its preferred priority date if the Petition is instituted and in any other proceeding involving the '456 patent.

IV. LEVEL OF ORDINARY SKILL

Petitioner sets forth a level of ordinary skill. Pet., 17-18. 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 '456 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. IPR2024-00639 (P.T.A.B. Mar. 4, 2024) (U.S. Pat. No. 11,375,768); *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. IPR2024-00638 (P.T.A.B. Mar. 4, 2024) (U.S. Pat. No. 11,064,760).

VI. CLAIM CONSTRUCTION

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., 13-16.

Specifically, Petitioner states the following:

- **“Gradient Compression Factor”**: Petitioner asserts that “a POSITA would understand that a forefoot platform constructed of a second material having a ‘gradient compression factor’ would become

‘increasingly less compressible’ from the inner edge to the outer edge of the forefoot platform.” Pet., 14-15.

- ***“Heel Platform Having a First Height That is Substantially Uniform from an Inner Edge of the Sole Section to an Outer Edge of the Sole Section”***: Petitioner asserts that Patent Owner construes¹ this limitation “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, and to construe this limitation to include a heel platform that includes some degree of curvature and height change from its inner edge to its outer edge.” Pet., 15-16.

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. 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.

¹ Petitioner alleges that it applies this construction due to Patent Owner’s infringement contentions in the District Court proceeding. Pet., 15-16. By applying this construction, Patent Owner is not agreeing with Petitioner’s characterization of its infringement contentions, but that dispute is not relevant to this proceeding.

A. Patent Owner's Additional Claim Constructions²

Patent Owner offers the following additional claim constructions for (1) the terms “first material” and “second material” and (2) the terms “near an outer edge of the sole section” / “proximal to the outer edge of the shoe” and “near an inner edge of the sole section” / “proximal to an inner edge of the shoe.” To the extent that the Board does not agree with the Patent Owner’s offered constructions, 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
“a first material” and “a second material” (claim 1)	The “first material” and the “second material” must be different materials (e.g., be composed of different materials or different combinations of materials)

² Patent Owner reserves the right to make additional claim construction arguments if trial is instituted. To the extent this Preliminary Response does not address claim interpretations advanced in the Petition (whether made explicitly or implicitly), Patent Owner does not concede that such interpretations are correct or proper under the governing standard.

“near an outer edge of the sole section” / “proximal to the outer edge of the shoe” and “near an inner edge of the sole section” / “proximal to an inner edge of the shoe” (claims 1, 10)	Near/proximal to the outer edge and inner edge (respectively) of the portion of the shoe where the foot sits
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1. “First Material” and “Second Material”

The “first material” and “second material” are set forth as separate limitations and so should be required to be met by different materials. “[T]he use of the terms ‘first’ and ‘second’ is a common patent-law convention to distinguish between repeated instances of an element or limitation.” *Free Motion Fitness, Inc. v. Cybex Int’l, Inc.*, 423 F.3d 1343, 1348 (Fed. Cir. 2005); *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1373 (Fed. Cir. 2005) (“The terms ‘first, second, and third’ are terms to distinguish different elements of the claim”). The Federal Circuit has repeatedly confirmed that the terms “first” and “second” are used to distinguish between **different** elements. *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371 (Fed. Cir. 2003) (citing *Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1304 (Fed. Cir. 2003) (“first” and “second”

sidewall surfaces are different surfaces)); *Springs Window Fashions LP v. Novo Indus.*, L.P., 323 F.3d 989, 992 (Fed. Cir. 2003) (“first” and “second” opposed ends are different ends). That is precisely how the terms are used in the ’456 patent: to distinguish between materials that are in some way different (for example, they are totally different materials, or they consist of materials combined in different ways). *See* Section II.A.

Petitioner seemingly acknowledges that the plain meaning of a “first material” and a “second material” requires that “the heel platform” and “forefoot platform” are constructed of different materials. Pet., 27, n.1 (“claim 1[]³ recites that the heel platform is constructed of a ‘first material’ and the forefoot platform of a ‘second material’”). Despite this, Petitioner proposes a different construction: that the claims are satisfied even where “the heel platform” and “the forefoot platform” are “constructed of the same material(s).”⁴ *Id.* Petitioner’s only argument in support of its construction is that “Athalonz contends that they can be the same material” because it “accus[es] shoes with the heel platform and forefoot platform constructed

³ Petitioner erroneously states “claim 10.”

⁴ Petitioner only includes this argument in a footnote, and does not list it as one of its explicit claim construction positions, Pet., 16-20, 25, n.1, despite unambiguously applying Petitioner’s construction in which the first and second material can be the same. *Id.*, 27, n.1 (“Under Armour applies Athalonz’s apparent construction.”). This is in direct contravention of the Board’s Trial Practice Guide. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012), § 15A:13.30.

of the same material(s) as infringing claim 1.” *Id.* (citing EX1012, 30-44).
Petitioner’s argument is baseless.

As an initial matter, Patent Owner has never “contend[ed] that [the first and second materials] can be the same material” and its infringement contentions do ***not*** “accus[e] shoes with the heel platform and forefoot platform constructed of the same material(s) as infringing claim 1.” Patent Owner’s infringement contentions clearly show the heel platform and the forefoot platform have different material compositions. *Compare* EX1012, 30 *with id.*, 43 (showing a different ratio of orange and white material).

Even more importantly, Patent Owner’s infringement contentions are irrelevant because they are not evidence of the proper claim construction of first and second material. “[T]he words of a claim ‘are generally given their ordinary and customary meaning’ . . . that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005). The Federal Circuit has repeatedly applied this principle in analogous situations to hold that irrelevant extrinsic evidence should be ignored. For example, it is black letter law that “claims may not be construed with reference to the accused device.” *Ferguson Beauregard/Logic Controls, Div. of Dover Res., Inc. v. Mega Sys., LLC*, 350 F.3d 1327, 1340 (Fed. Cir. 2003); *NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1074 (Fed. Cir. 2002). Similarly, “[t]he

testimony of an inventor ‘cannot be relied on to change the meaning of the claims.’” *Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1346 (Fed. Cir. 2008) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983 (Fed.Cir.1995)). And extrinsic evidence that postdates the invention date and “do[es] not reflect the meanings that would have been attributed to the words in dispute by [POSITAs]” at the time of invention should also “not [be] considered.” *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 326 F.3d 1215, 1221 (Fed. Cir. 2003).

Petitioner’s (erroneous) interpretation of Patent Owner’s infringement contentions in a separate proceeding are irrelevant to how a POSITA would understand these claim terms. Petitioner cannot use the Patent Owner’s statements regarding how Petitioner’s accused devices infringe, which post-date the invention, to change the meaning of “first” and “second material.” If Petitioner’s products do not infringe under the correct construction of “first” and “second material,” then Patent Owner’s district court infringement allegations will fail. But that is no reason to construe the claims incorrectly here to accommodate those allegations.

The Board’s decision in *Ford Motor Co. v. Massachusetts Inst. of Tech.* is on point. No. IPR2020-00011, 2020 WL 1493934 (P.T.A.B. Mar. 26, 2020). There, the Petitioner “adopt[ed] . . . what it characterizes as Patent Owner’s construction in the related district court litigation” without providing any “intrinsic evidence in support of the correctness of its proposed construction.” *Id.*, *6. The Petitioner derived its

construction from Patent Owner’s infringement contentions, arguing that “the claim construction to be applied in this *inter partes* review is broad enough to encompass the accused engines of the related litigation.” *Id.*

The Board rightly rejected Petitioner’s argument, noting that “[w]e look to the Petitioner—the party that, at this stage, bears the burden of demonstrating a reasonable likelihood of prevailing—to assist us in our claim construction analysis by showing us why its proposed construction should be applied in the second step.” *Id.* In particular, the Board held that that by merely “adopt[ing]” what it thinks Patent Owner’s construction is, Petitioner “skip[ped]” “a proper claim construction analysis.” Ultimately, the Board stated that “[i]n order for Petitioner to prevail at this stage, we would have to draft a claim construction analysis without any help from Petitioner, the party asking us to rule favorably on its challenges using that construction.” *Id.*, *7. In light of that, the Board “determine[d] that Petitioner has not explained adequately why its adopted construction is proper and, thus, has not demonstrated a reasonable likelihood of prevailing on its assertion.” *Id.* Just so here. Petitioner has made no effort to explain why its adopted construction is proper, and thus the Board should reject it in favor of the plain of ordinary meaning of the terms: The “first material” and the “second material” must be different materials (e.g., be composed of different materials or different combinations of materials).

2. “Near An Outer Edge Of The Sole Section” and “Near An Inner Edge Of The Sole Section”

“A word or phrase used consistently throughout a claim should be interpreted consistently.” *Phonometrics, Inc. v. N. Telecom Inc.*, 133 F.3d 1459, 1465 (Fed. Cir. 1998). In its Petition, Petitioner asserts that, *in the context of the heel platform*, the terms “inner edge of the sole section” and “outer edge of the sole section” means “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., 15-16. The ’456 patent also uses the terms “inner edge of the sole section” and “outer edge of the sole section” in the context of the forefoot platform. *See, e.g.*, ’456 patent, claim 1 (“the second material compresses to a first level near an outer edge of the sole section and the second material compresses to a second level near an inner edge of the sole section”); *see also id.*, claim 10. There is no reason to apply inconsistent or different constructions of the same terms. Thus, applying Petitioner’s construction to the claim language at issue here, the terms “**near an / proximal to the outer edge of the sole section**” and “**near an / proximal to the inner edge of the sole section**” should be construed as “**near an / proximal to the outer edge and inner edge (respectively) of the portion of the shoe where the foot sits.**”

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, generally in the same way*. See EX2003 at 8 (listing Talarico '911 as a reference that anticipates or renders obvious the asserted patents, including the '456 patent), 11 (listing Won, Norton, and Umezawa as references that anticipate the '456 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 Won); EX2005 (invalidity claim chart for Umezawa); EX2006 (invalidity claim chart for Norton). And for Talarico '911, Petitioner asserted it in combination with Norton, (EX2006, 1-2, 3, 4, 7-9, 17-20), and in general against element 1[d] of the related '768 patent, which is substantively identical in relevant part to elements 1[d] and 10[d] of the '456 patent. EX2007, 6-9; EX1001, claims 1, 10. Talarico '911 is not a new reference that Petitioner was unaware of—it was cited on the face of the '456 patent and considered extensively during prosecution of the '768 patent. EX1001; EX1011, 15. Regardless of whether Petitioner chose to include Talarico '911 in its November invalidity contentions, it clearly was aware of it.

Thus, 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 simply 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 DEMONSTRATED A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM

A. The Petition Fails to Demonstrate That Claims 10, 11, 15, 17 Are Obvious Based on Won (Ground 1).

1. “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section”

Claims 1 and 10 require “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section.” For purposes of the Petition, Petitioner construes “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section” to require that the “a heel platform” is substantially uniform “from an inner edge of the sole section to an outer edge of the

sole section” “where the heel of the foot sits, not the inner and outer-most edges of the shoe.” Pet., 15-16. As discussed above, Patent Owner does not dispute this construction for purposes of these preliminary arguments.

Petitioner *first* argues that “Won discloses golf shoe designs that include a heel platform with a substantially uniform height.” Pet., 22-23. Petitioner first points to “Figures 2, 6, and 7” as purportedly “show[ing] a uniform height heel section.” *Id.*, 23. That is not correct. Figures 2, 6, and 7 only show the heel platform from the side, which does not show that the heel platform has a uniform height along the width (from the inner edge to the outer edge). And similarly, Figure 5 shows the heel platform from below. Without a figure showing the back of the shoe (or an equivalent disclosure), Won does not disclose that the heel platform is of a uniform height from the outside edge to the inside edge.

Petitioner next argues that Won discloses a heel platform with a uniform height from the inner edge to the outer edge because “Won describes that ‘it is preferred that said heel portion is ... substantially 0 degrees’ from rear to front.” Pet., 23. Petitioner’s argument mischaracterizes Won, fails as a matter of logic, and is wholly unsupported. Won *does not* disclose that the “‘heel portion is ... substantially 0 degrees’ *from rear to front*,” as Petitioner claims. Pet., 23 (citing EX1005, 2:51-53). Won states “It is preferred that said heel portion is tilted -5-5° and more preferable, substantially 0°.” EX1005, 2:51-53. That means that it is preferable that

the heel is not tilted *vis-à-vis* the toe—it says nothing about the height of the heel along its width. Won in general concerns the slope between the heel and toe portions. EX1005, 2:27-30 (“That is to say, because the value of the downward slope from the heel portion (22) to the toe portion is linear, the golf shoes do not provide stability and convenience while addressing or walking.”), 2:54-57. And elsewhere Won is clear that its disclosed angles refer to the angle between the heel and the toe. *Id.*, 2:54-57 (“When a golfer wears the golf shoes according to the present invention having the angle between the heel portion and horizontal line of $-7-7^{\circ}$, and an angle between the toe portion and horizontal line of $1-5^{\circ}$. . .”). Thus, Won’s disclosed “0 degrees” angle refers to the angle between the heel and the toe—not the height of the heel.

Petitioner asserts that “the heel platform must be level from the inner edge to the outer edge to obtain the desired zero-degree tilt across the entire width of the heel.” Pet., 23. But as a matter of logic, the heel in Won easily could have a non-uniform height (for example, if the sides of the heel have an inconsistent height), while still not being tilted one way or another. Moreover, Petitioner’s only support for its argument is a citation to Mr. Delgatty’s declaration, but the cited passage merely repeats the Petition verbatim. *Compare* EX1002, ¶65 with Pet., 23. That expert testimony thus provides no support for Petitioner’s argument, and can thus be

disregarded. *Xerox Corp. v. Bytemark, Inc.*, No. IPR2022-00624, 2022 WL 3648989, at *6 (P.T.A.B. Aug. 24, 2022).

Petitioner next argues that “Won teaches that the bottom surfaces of the heel platform and the toe platform of the prior art shoes are almost in parallel, further confirming that these are substantially flat surfaces.” Pet., 24 (citing EX1005, 1:42-50; EX1002, ¶119). But whether “the ***bottom surfaces*** of the heel platform” are flat does nothing to show that the width of the heel platform has a substantially uniform ***height***. The shoe could have a flat bottom, but varying height. In sum, Won does not disclose or render obvious “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section.”

Second, in apparent recognition of this gap in Won, the Petition argues that this element would be obvious to a POSITA based on its understanding of “a ‘conventional’ golf shoe, which a POSITA would understand includes a heel platform that is substantially uniform in height from its inner edge to its outer edge.” Pet., 24. In particular, the Petition argues that “a POSITA would have recognized that the conventional heel . . . could be used in this embodiment without altering the forefoot, or the rest of the shoe’s, design.” *Id.*

Petitioner’s argument is striking. Won (the only reference in this Ground) does not disclose or suggest a “heel platform” that has a first height that is substantially uniform from an inner edge of the sole section to an outer edge of the

sole section. Indeed, much of the art Petitioner raises in its Petition does not disclose such a heel. *See* Sections VIII.B.1, VIII.C.1, VIII.E.1. Yet Petitioner alleges that “a POSITA would have recognized that the conventional heel . . . could be used in this embodiment without altering the forefoot, or the rest of the shoe’s, design” simply based on its conclusory assertion that a “conventional” shoe would include it. That makes no sense and is unsupported by the evidence.

The Federal Circuit has cautioned against using such “common sense” arguments to “supply a missing claim limitation” and that “the deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’ to one of ordinary skill in the art.” *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016); *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). Additionally, “[t]he Supreme Court has warned against a ‘temptation to read into the prior art the teachings of the invention in issue,’ and instructed ‘courts to guard against slipping into the use of hindsight.’” *Apple, Inc. v. Mullen Indus. LLC*, No. IPR2023-00087, 2023 WL 5103997, at *8 (P.T.A.B. May 3, 2023). “[T]he inventor’s own path itself never leads to a conclusion of obviousness; that is hindsight. What matters is the path that the person of ordinary skill in the art would have followed, as evidenced by the pertinent prior art.” *Millennium Pharms., Inc. v. Sandoz Inc.*, 862 F.3d 1356, 1367 (Fed. Cir. 2017). Here, there is no concrete evidence that a POSITA would assume that *every*

“conventional” or “typical” shoe would have a heel platform with a first height that is substantially uniform from an inner edge of the sole section to an outer edge of the sole section. Petitioner’s argument otherwise is no more than impermissible hindsight.

Petitioner’s only support for its argument is from its expert, Mr. Delgatty, who opines that “conventional” shoes have a heel platform with substantially uniform height around from an inner edge to an outer edge. Pet., 39-40 (citing EX1002, ¶¶55-61, 66). However, Mr. Delgatty’s broad opinions are “conclusory and unsupported,” without any “additional supporting evidence” or “technical reasoning,” and are thus “entitled to little weight. *Xerox Corp.*, No. IPR2022-00624, at *6.

Although Mr. Delgatty purports to cite “evidence” for his opinions, that purported evidence does not support his opinions. Mr. Delgatty points to a number of shoes and that he alleges show that “shoes in general, including athletic shoes and golf shoes, have several traits and features that are ‘conventional’ or ‘standard,’” including “a heel platform that is substantially uniform in height from its inner edge to its outer edge.” EX1002, ¶55. But, as an initial matter, even if Mr. Delgatty’s evidence showed shoes with “a heel platform that is substantially uniform in height from its inner edge to its outer edge,” the fact that *some* shoes have such a heel platform is not sufficient evidence that *every* “conventional” or “typical” shoe does—which is Petitioner’s assertion.

Moreover, Mr. Delgatty's evidence does not show any shoes with "a heel platform that is substantially uniform in height from its inner edge to its outer edge." Most of Mr. Delgatty's evidence is simply pictures of the outside of shoes. EX1002, ¶¶55-57, 59. Pictures of the *outside* of shoes do not show anything relevant under Petitioner's applied construction, since that construction require the heel height from an inner edge to an outer edge be uniform "where the heel of the foot sits, not the inner and outer-most edges of the shoe." Pet., 15. Mr. Delgatty's images do not show the relevant portion of the heel platform (the inside) because it is covered by the top portion of the shoe. These images thus do not provide any evidence that conventional shoes have a heel platform with a substantially uniform height from the inner edge to the outer edge (as Petitioner construes it), much less that it is "conventional" or "standard" for all shoes.

Mr. Delgatty's two other pieces of purported "evidence" are design patents that show various shoe designs. EX1002, ¶¶58, 60. But neither patent discloses that the heel platforms have a substantially uniform height from the inner edge to the outer edge, nor does Mr. Delgatty explain how the figures show heel platforms with a substantially uniform height from the inner edge to the outer edge. *Id.* In any event, even if these two design patents did show individual examples of shoes with a substantially uniform height from the inner edge to the outer edge (which they do not), that does not prove that a POSITA would understand all "conventional" shoes

to have the same trait. That is particularly true in light of the number of shoes at issue in this proceeding that do *not* have that trait. *See* Sections VIII.B.1, VIII.C.1, VIII.E.1.

Petitioner also cites one additional portion of Mr. Delgatty’s declaration, but that paragraph merely repeats the Petition’s allegation that “a POSITA would understand [that a “conventional” gold shoe] includes a heel platform that is substantially uniform in height from its inner edge to its outer edge based on Patent Owner’s apparent interpretation of this limitation” verbatim, without support, EX1002, ¶66, and can thus be disregarded. *Xerox Corp.*, No. IPR2022-00624, at *6; *Advance Med. Designs, Inc. v. Corbin Clinical Res., LLC*, No. PATENT 11,547,436, 2024 WL 249517, at *12 (P.T.A.B. Jan. 23, 2024) (“Dr. Yun’s testimony is essentially a verbatim repetition of Petitioner’s argument Thus, we accord little weight to Dr. Yun’s testimony on this topic.”).

There is thus insufficient evidence to support Petitioner and Mr. Delgatty’s broad assertion that “a heel platform having a first height that is substantially uniform from an inner edge of the sole section to an outer edge of the sole section,” is obvious because it is a component of all “conventional” shoes. Yet, Mr. Delgatty and Petitioner simply declare that a heel platform with a substantially uniform height from an inner edge to an outer edge would be obvious because any “conventional” shoe would include it, without any evidence that that is true. This unsupported

assertion is particularly problematic because it is “offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art.” *Xerox Corp.*, No. IPR2022-00624, at *6; *Arendi S.A.R.L. v. Apply, Inc.*, 832 F.3d 1355, 1361–62 (Fed. Cir. 2016) (holding that reliance on common sense in an obviousness analysis is “typically invoked to provide a known motivation to combine, not to supply a missing claim limitation”) (emphasis omitted).

In sum, Won does not render obvious this element. Petitioner has thus failed to demonstrate a reasonable likelihood that Won renders obvious any asserted claim and that it will succeed on Ground 1.

B. The Petition Fails to Demonstrate That Claims 1-5, 7, 12-14 Are Obvious Over Won in View of Norton (Ground 2).

1. “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section”

The Petitioner does not allege that Norton discloses or suggests the element “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section.” Pet., 31. As explained above, Won does not disclose or teach this element. Section VIII.A.1. Petitioner has thus failed to demonstrate a reasonable likelihood that Won in view of Norton renders obvious any claim and that it will succeed on Ground 2.

2. “the forefoot platform is constructed of a second material having a gradient compression factor”

The Petition does not show that Won in view of Norton render obvious a forefoot platform “*constructed of a second material having a gradient compression factor*,” as required by claim 1. Petitioner acknowledges that Won does not disclose a forefoot platform having a gradient compression factor because it “does not explicitly disclose a forefoot platform that becomes ‘increasingly less compressible’ from its inner edge to its outer edge.” Pet., 27-28, 36-37. Instead, Petitioner argues that it would be obvious “in view of Norton, which expressly discloses this limitation and how it improves upon the dual-material design of Won.” *Id.*, 32. But the Petition does not allege, much less provide any evidence, that a POSITA would find it obvious to add Norton’s single material having a varying density distribution to Won’s shoe *as a second material*, different from the material in the heel platform. *Id.*, 27-31, 31-34. Ground 2 fails for having not addressed how this element is disclosed or rendered obvious. *See* 35 U.S.C. § 312(a)(3) (“[T]he petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.”); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with

particularity’ the ‘evidence that supports the grounds for the challenge to each claim’”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016).

Petitioner argues that “Won’s multi-material sole or midsole could easily be replaced with a single material sole element as disclosed in Norton.” Pet., 30. Petitioner’s argument demonstrates why this Ground fails. Even accepting it as true, replacing the entire “sole” in Won would not result in the forefoot platform being constructed of a “*second* material.” Neither Won nor Norton discuss the heel material in any capacity, so there would be no suggestion to use a different material in the heel and in the forefoot.

Additionally, Won’s “soft surface” and “hard surface” in Won are just that—surfaces (the thin layer on the outside of the shoe to which spikes are attached). Won discloses that “the golf shoes can be formed such that the inside surface and outside surface . . . are different from each other” EX1005, 4:46-58. Thus, Petitioner’s identified “surfaces” are not part of the sole, but the outside surface to which the spikes are attached. *Id.* The Petition points to these “surfaces” and alleges that “Won’s multi-material sole or midsole could easily be replaced with a single material sole element as disclosed in Norton.” Pet., 30. That makes no sense, as the “sole element” in Norton cannot be used to replace a *surface* (the outside portion of the shoe to which the spike are attached).

Moreover, a POSITA would *not* add Norton’s “material having a gradient compression factor” to Won’s shoe *as a second material* in light of Norton’s clear purpose “to not use two different materials,” “but to use a single material.” EX1007, 3:9-15; Pet., 28 (“Norton teaches a single-material sole.”). Norton thus teaches away from using two different materials, one for the heel platform and one for the forefoot platform. *See Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360 (Fed. Cir. 2017) (“Prior art teaches away when ‘a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.’” (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994))).

In sum, Won in view of Norton does not render obvious this element. Petitioner has thus failed to demonstrate it will succeed on Ground 2.

C. The Petition Fails to Demonstrate That Claims 1-5, 7, 9, 12-14 Are Obvious Based on Won over Talarico ’911 (Ground 3).

1. “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section”

Petitioner argues that “Limitations [1.0] – [1.3] of claim 1 are similar to limitations [10.0] – [10.3] and are disclosed by Won.” Pet., 30. As explained above, Won does not disclose or render obvious this element. *See* Section VIII.A.1. The Petition does not allege that Talarico ’911 discloses or suggests this element.

In sum, Won in view of Talarico '911 does not render obvious this element. Petitioner has thus failed to demonstrate a reasonable likelihood that Won in view of Talarico '911 renders obvious any asserted claim and that it will succeed on Ground 3.

2. “a forefoot platform juxtaposed to the heel platform, wherein the forefoot platform is constructed of a second material having a gradient compression factor”

The Petition does not show that Won in view of Talarico '911 render obvious a forefoot platform “*constructed of a second material having a gradient compression factor*,” as required by claim 1. Petitioner acknowledges that Won does not disclose a forefoot platform having a gradient compression factor because it “does not explicitly disclose a forefoot platform that becomes ‘increasingly less compressible’ from its inner edge to its outer edge.” Pet., 27-28, 36-37. Instead, Petitioner argues that this element is “obvious in View of Talarico '911, which expressly discloses it.” *Id.*, 40. But the Petition does not allege, much less provide any evidence, that a POSITA would find it obvious to add Talarico '911’s single material having a varying density distribution to Won’s shoe *as a second material*, different from the material in the heel platform. *Id.*, 36-42. Ground 3 fails for having not addressed how this element is disclosed or rendered obvious. *See* 35 U.S.C. § 312(a)(3); *Intelligent Bio-Sys., Inc.*, 821 F.3d at 1369.

Moreover, as Petitioner admits, Talarico '911 is “directed only to the forefoot portions of the footwear,” not to the heel portion of the footwear. Pet., 66 (citing EX1008, 6:56-62). Similarly, Won is only concerned with the forefoot material, and does not disclose anything regarding the heel material. Therefore, there is no suggestion in either Won or Talarico '911 to use a different material in the heel and in the forefoot. Won in view of Talarico '911 does not suggest a “*second material* having a gradient compression factor.”

In sum, Won in view of Talarico '911 does not render obvious this element. Petitioner has thus failed to demonstrate that it will succeed on Ground 3.

D. The Petition Fails to Demonstrate That Claims 1-5, 7, 9-15, 17 Are Obvious Over Won in View of Umezawa (Ground 4).

1. the level of compression near (or proximate to) an inner edge is greater than the level of compression near (or proximate to) an outer edge

Claim 1 requires that “the second material compresses to a first level near an outer edge of the sole section and the second material compresses to a second level near an inner edge of the sole section, wherein the second level of compression is greater than the first level of compression.” Claim 10 requires that “the forefoot platform is constructed to have a first level of compression proximal to the outer edge of the shoe and a second level of compression proximal to an inner edge of the shoe, wherein the second level of compression is greater than the first level of compression.” In other words, for both claims 1 and 10, the level of compression

near (or proximate to) an inner edge must be greater than the level of compression near (or proximate to) an outer edge. Petitioner fails to demonstrate a reasonable likelihood that Umezawa discloses or renders obvious this claim element.

Petitioner points to Figs. 3 and 6, which show “a low elastic part 20 and a high elastic part 22,” where “the low elastic part 20 is more easily deformed than the high elastic part 22.” Pet., 49-51 (quoting EX1006, ¶¶0036, 0038, 0043). Petitioner then quotes Umezawa’s disclosure that “[s]ince the thickness of the low elastic part 20 is larger in the inside, the inside compression deformation is larger.” *Id.*, 51 (quoting EX1006, ¶0038).

Petitioner’s argument ignores a crucial fact: “near an inner edge of the sole section” in Umezawa is *not* the “low elastic part 20” (shown in yellow below) but is instead the “inner high elastic part 26.” EX1006, ¶¶0038, 0039, Abstract. Petitioner appears to map the “inner edge of the sole section” to the location where the “low elastic” material is thick (shown generally with a blue line in Figures 3 and 6 below). But Umezawa explicitly discloses that there is a portion of the sole that is *more* inner and is high elastic: “The high elastic part 22 is also *located to the inside of the low elastic part 20*. A high elastic part 22 which is located *to the inside of the low elastic part 20* is hereinafter referred to as ‘inner high elastic part 26’.” *Id.*, ¶0037 (emphasis added), Abstract (“An inner high elastic part 26 is located to the inside of a low elastic part 20.”); *see also id.*, ¶0061 (“The high elastic part 56 is located to the

outside of the inclined surface 58. An inner high elastic part 60 is located to the inside of the low elastic part 54.”), 0063, 0065, 0068, 0072, 0077, 0078 (“The high elastic part includes an inner high elastic part.”), 0083. This high elastic part 22 (including the “inner high elastic part 26”) is shown in red below.

Umezawa also discloses that the “inner high elastic part 26” has the same level of compression as the “high elastic part 22” as the “outer edge of the sole section.” Indeed, Figures 2-5 refer to the “inner high elastic part 26” as “26 (22)” —further indicating that the “inner high elastic part 26” is the same thing as the “high elastic part 22.” *Id.*, Figs. 2-5; *id.*, ¶0037 (“The high elastic part 22 is also located to the inside of the low elastic part 20.”), Figs. 8-15 (similarly showing that the outer edge and inner edge are made of the same material, with the same compressibility, *e.g.*, “60 (56)” and “56”). Thus, Umezawa discloses that the level of compression “near an inner edge of the sole section” is ***the same*** as the level of compression “near an outer edge of the sole section”—as they are both made of “high elastic part 22.”

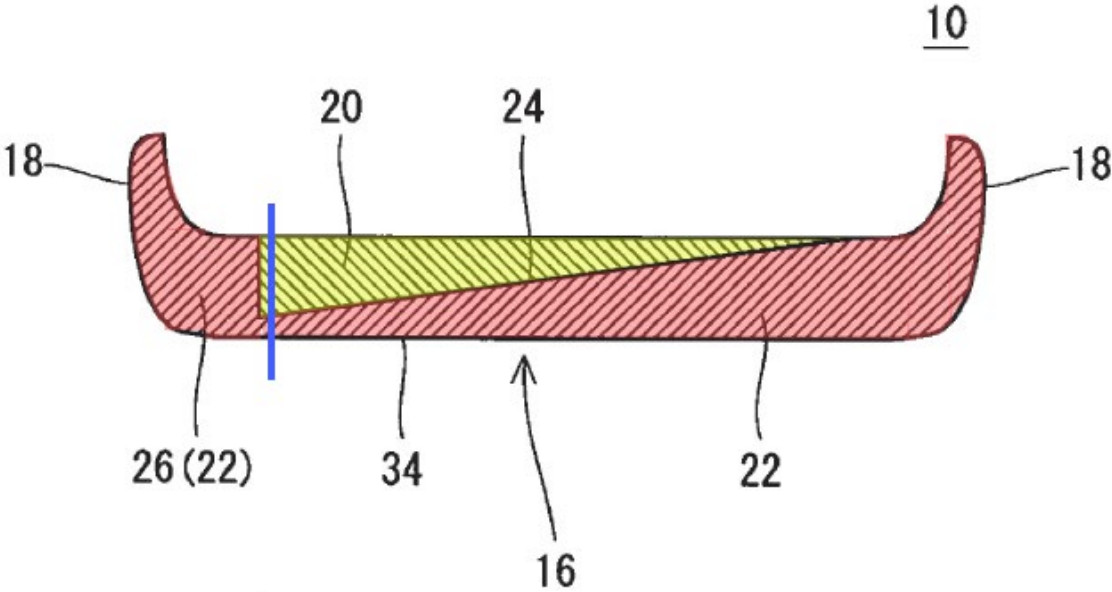


Fig. 3

EX1006, Fig. 3 (annotation added).

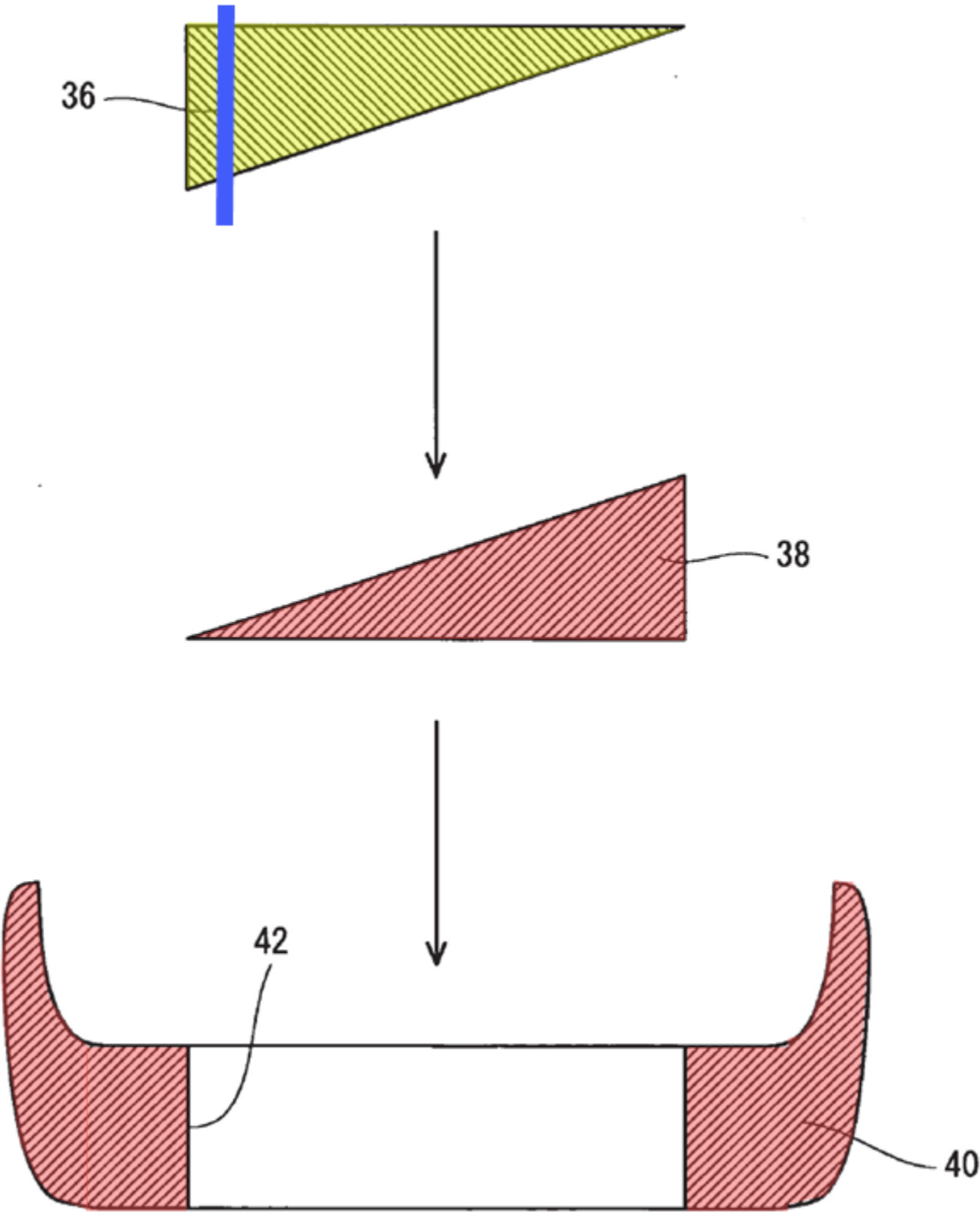


Fig. 6

EX1006, Fig. 6 (annotation added).

Figure 2 similarly shows that, in Umezawa, the portion “near an inner edge of the sole section” (element “26 (22)”) and “near an outer edge of the sole section” (element “22”) are both made of “high elastic part 22” and thus have the same level of compression.

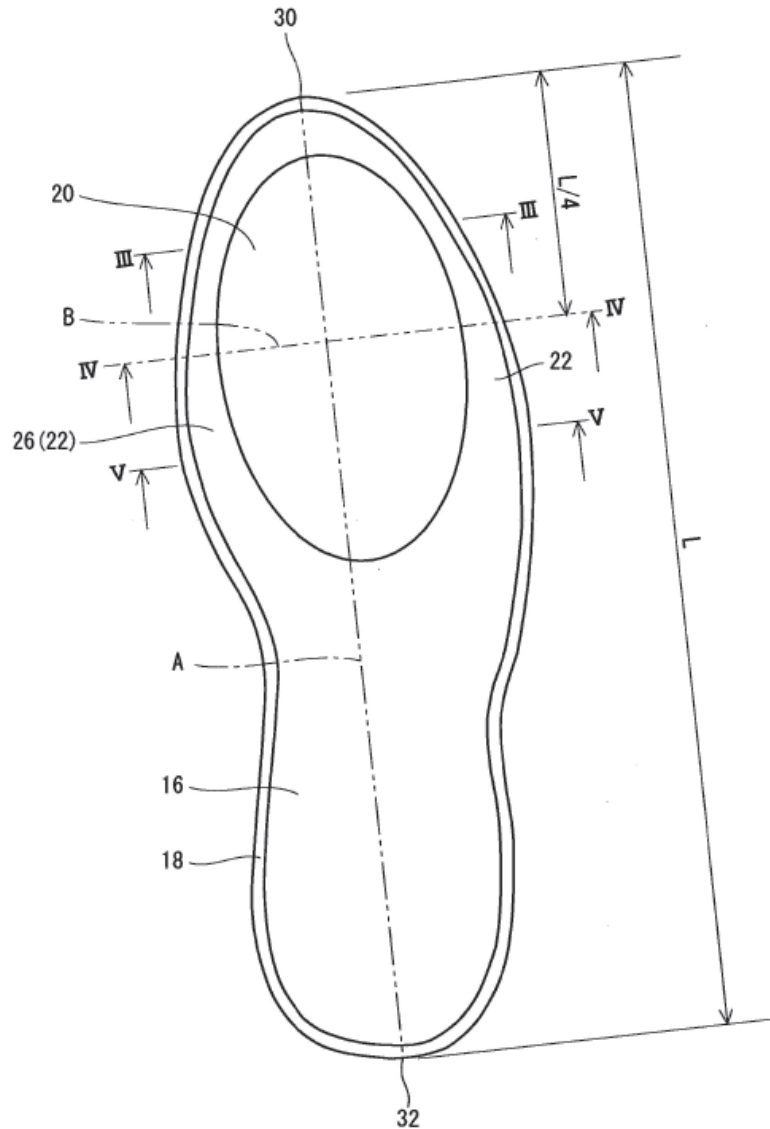


Fig. 2

EX1006, Fig. 2.

The specification repeatedly confirms that, in Umezawa, the levels of compression are the same “near an inner edge of the sole section” and “near an outer edge of the sole section.” For example, Umezawa explains that the “width of a flat top surface of the inner high elastic part 26” is preferably at least 3mm (and most preferably 10mm) but less than 25mm, so that “sufficient force is transferred from the foot to the ground.” *Id.*, ¶0049. Thus, Umezawa discloses that between 3mm to 25mm of sole near to the “inner edge of the sole section” is “high elastic,” with the same compressibility as the “high elastic” material at the “outer edge of the sole section.” *Id.*; *see also id.* ¶¶0037, 0050.

For another example, Umezawa states that “[e]ven if the body weight of a golf player is applied to the bottom part 6, the inner high elastic part 26 is not deformed so much” and that “[a] large amount of force is transferred from the foot to the ground through this inner high elastic part 26.” EX1006, ¶0039 (“This inner high elastic part 26 contributes to generation of great head speed.”), ¶0062 (“The inner high elastic part 60 does not absorb much of the force transferred from a foot to the ground.”), 0064, 0066, 0069, 0072, 0075, 0077. These disclosures demonstrate that the “the inner high elastic part 26” sits at the inmost portion of the sole and that Umezawa made that decision on purpose, in order to “transfer[]” force “from the foot to the ground.” *Id.*

Finally, Umezawa discloses two different manufacturing processes (shown in Figures 6 and 7) and, in both, the same material (with the same compressibility) is used near the “inner and outer edge of the sole section.” *Id.*, ¶¶0056-0058. In Figure 6 (shown above), the portion near the inner edge is made of the third component 40.⁵ The portion near the outer edge is also made of the third component 40, and then attached to the second component 38. Both “the second component 38 and the third component 40 form the high elastic part 22.” *Id.*, ¶¶0057, 0056 (“The elastic modulus of the first component 36 is smaller than that of the second component 38 and the third component 40.”). Similarly, Figure 7 shows that the portions near the inner and outer edges are both made of “the second component 46,” which “the high elastic component 22.” EX1006, ¶¶0058-0059.

⁵ Although this portion appears to be designated “42,” Umezawa discloses that the “42” designation is pointing to the “hole” formed by blanking (the blank space in Figure 6). EX10006, ¶¶0056, 0057.

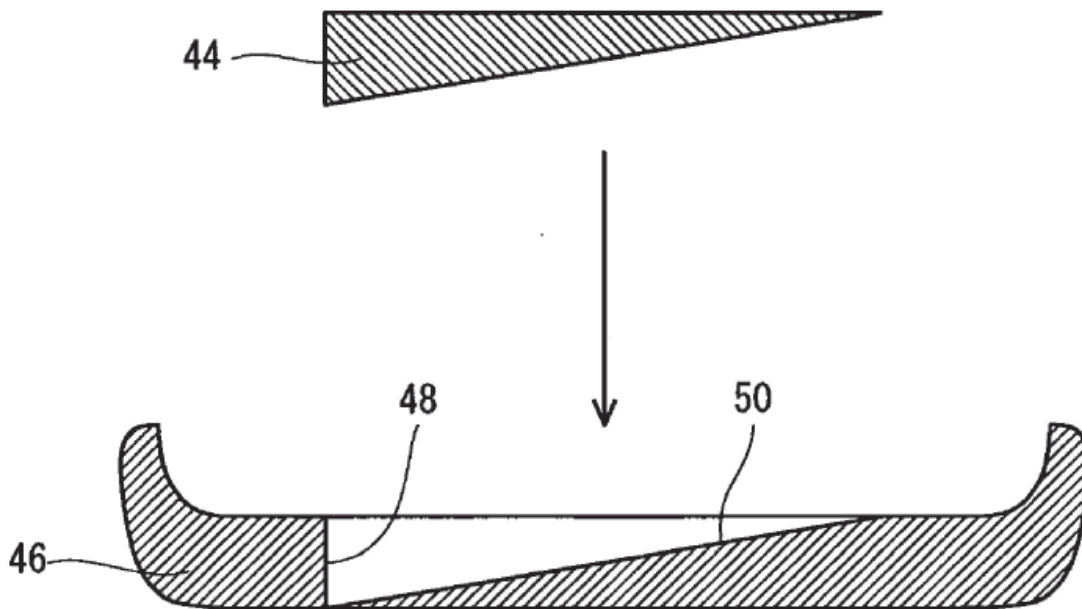


Fig. 7

EX1006, Fig. 7.

In sum, Umezawa does not disclose this element. And Petitioner does not argue that this element would otherwise be obvious over Umezawa. Pet., 49-51. Petitioner has thus failed to demonstrate a reasonable likelihood that Umezawa renders obvious any claim and that it will succeed on Ground 4.

E. The Petition Fails to Demonstrate That Claims 1-5, 7, 9-15, 17 Are Obvious Over Norton (Ground 5).

- 1. “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section”**

Claims 1 and 10 require “a heel platform having a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the

sole section.” Petitioner construes this as requiring that the “a heel platform” is “substantially uniform in height from its inner edge to its outer edge” “where the heel of the foot sits, not the inner and outer-most edges of the shoe.” Pet., 15-16. Petitioner has not shown that this element is obvious over Norton.

Petitioner *first* argues that Norton itself discloses this element. It does not. The Petition’s only argument that Norton itself discloses this element is Norton’s disclosure of Figures 4A and 4B (shown below). Pet., 56-57. But Figures 4A and 4B show only a “sole element,” not an entire “heel platform” (of which the “sole element is a part). EX1007, 7:36-38. Norton explains that “the sole element in accordance with the invention is typically formed as a midsole, *where an outsole and an insole for improving comfort are additionally provided.*” *Id.*, 5:60-63 (emphasis added). A heel platform includes a midsole as well as an outsole and insole. *Id.* Thus, the “sole element” shown in Figures 4A and 4B is not the entirety of the “heel platform,” but just a part, and cannot disclose that the entire “heel platform” has “a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section.” *See also id.* 5:63-67 (“[I]t is not necessary that the sole element extends in a longitudinal direction (i.e. from the heel to the forefoot part) over the complete sole. It is also possible that a sole element in accordance with the invention is only used in the heel and/or in parts of the forefoot.”).

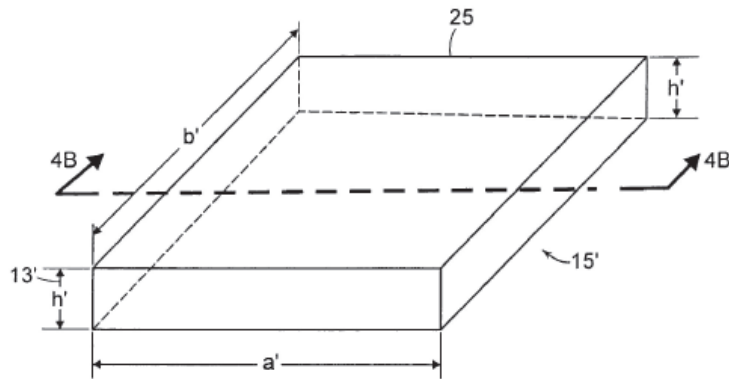


FIG. 4A

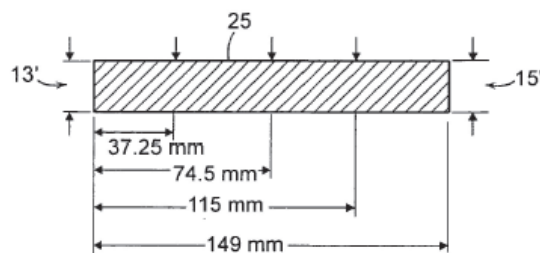


FIG. 4B

Second, in apparent recognition of this gap in Norton, the Petition argues that this element would be obvious to a POSITA based on the POSITA's understanding of "a typical athletic shoe." Pet., 57-58. Petitioner's argument rehashes its argument regarding a "typical" shoe in Ground 3, and fails, as discussed above. *See* Section VIII.A.1. Petitioner's argument is particularly baseless for this ground, as Norton does not even disclose a heel platform at all (but instead discloses just a single sole element that can go into a heel). *See supra*.

Third, Petitioner argues that another reference, Giese, is incorporated by reference into Norton and “discloses several shoe embodiments wherein the heel platform is substantially uniform in height from its inner edge to its outer edge.” Pet., 58. But once again, the Petitioner does not show how the “heel platform” has “a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section. None of the identified figures explicitly show that the heels have a first height that is substantial uniform from an inner edge of the sole section to an outer edge of the sole section. EX1010, Figs. 5, 39, 51. If anything, the figures show possible deviations from a uniform height, and Petitioner does not even attempt to show why these are not “substantial.” EX1010, Figs. 5, 39, 51; Pet., 58. Petitioner cites to its expert declaration, but the cited portion parrots the Petition verbatim, without more, and can thus be disregarded. *Xerox Corp.*, No. IPR2022-00624, at *6.

Geise’s specification provides further evidence that Geise does not disclose this element. Geise’s specification states that, for the embodiment shown in Figure 5, “[t]he heel portion (FIG. 5) has a cup shape provided in the lower layer and less drastic cup shape of the softer layer in composite.” EX1010, 7:16-18. Thus, a POSITA would understand that the embodiment in Figure 5 has a drastic and a “less drastic” cup shape in the heel, not that the heel has a substantially uniform height from its inner edge to its outer edge. Figure 39 shows the same embodiment but with

“stability inserts 11 and 12,” for example a “u-shaped insert which is placed around the perimeter of the heel.” *Id.*, 8:57-68. And Figure 51 merely shows an embodiment in which “the contour of the **lower layer** may be provided by a single step 14 change in height about the perimeter,” EX1010, 9:18-23 (emphasis added)—which has nothing to do with the height from the shoe’s inner edge to its outer edge. In short, Geise does not disclose that any of the identified embodiments disclose a “heel platform” that is “substantially uniform around” from its inner edge to its outer edge.

Petitioner also points to Geise’s statement that “historically, shoe bottoms [] consisted primarily of flat surfaces on both their top and bottom.” Pet., 58 (quoting EX1010, 1:10-27). But this statement only concerns “shoe bottoms,” not the entirety of the heel platform, and thus does nothing to show that Geise discloses a heel with a substantially uniform heel height from its inner edge to its outer edge.

In sum, Norton does not render obvious this element. Petitioner has thus failed to demonstrate a reasonable likelihood that Norton renders obvious any asserted claim and that it will succeed on Ground 5.

2. “the forefoot platform is constructed of a second material having a gradient compression factor”

The Petition does not show that Norton renders obvious a forefoot platform “constructed of a **second material** having a gradient compression factor,” as required by claim 1. The Petition generically alleges that “Norton teaches and/or suggests a

forefoot platform juxtaposed to the heel platform, wherein the forefoot platform is constructed of a second material having a gradient compression factor,” but does not reference the “second material” requirement again, much less show how Norton discloses it or renders it obvious. Pet., 59. The Petition thus does not show how Norton renders obvious a forefoot platform “constructed of a *second material* having a gradient compression factor.” Ground 5 fails for having not addressed how this element is disclosed or rendered obvious. *See* 35 U.S.C. § 312(a)(3); *Intelligent Bio-Sys., Inc.*, 821 F.3d at 1369.

Moreover, Norton only discloses a “sole element”—not an entire shoe. EX1007, 7:36-38, 5:60-67; *see supra*. Norton does not say anything about the materials of a forefoot platform and a heel platform, which is unsurprising given that it is only concerned with a single portion of the sole, and not the entire sole, and accordingly does not disclose a forefoot platform and a heel platform at all. Thus, Norton does not disclose that the forefoot platform is made of a different material than the heel platform.

Additionally, Norton is clear that its disclosed “sole element” is made with a *single material* throughout, and it thus teaches away from the forefoot platform being made of a second material as compared to the heel platform. Norton explicitly states that “[o]ne aspect of one embodiment of the present invention is to not use *two different materials* with different densities to create the density variation over

the sole element and to connect these materials subsequently, but *to use a single material* being supplied as a preform and having a thickness distribution that is transformed by pressure forming into the desired density distribution.” EX1007, 3:9-15 (emphasis added). Elsewhere, the Petition acknowledges that “Norton teaches a single-material sole.” Pet., 28. Thus, Norton does not render obvious a forefoot platform “constructed of a *second material* having a gradient compression factor.”

In sum, Norton does not render obvious this element. Petitioner has thus failed to demonstrate a reasonable likelihood that it will succeed on Ground 5.

F. The Petition Fails to Demonstrate That Claims 1-5, 7, 9-15, 17 Are Obvious Based on Talarico ’911 (Ground 6).

1. the level of compression near (or proximate to) an inner edge is greater than the level of compression near (or proximate to) an outer edge

Petitioner argues that Talarico ’911 discloses this element. Pet., 72, 66-69. But Petitioner does not grapple with the fact that the Patent Office already explicitly considered Talarico ’911, and still allowed the ’456 patent. EX1001, References Cited (listing Talarico ’911); *see BlephEx, LLC v. Myco Indus., Inc.*, 24 F.4th 1391, 1402 (Fed. Cir. 2022) (“[W]hen prior art ‘is listed on the face’ of a patent, ‘the examiner is presumed to have considered it.’” (quoting *Stone Basket Innovations, LLC v. Cook Med. LLC*, 892 F.3d 1175, 1179 (Fed. Cir. 2018))).

Moreover, the Patent Office explicitly considered whether Talarico ’911 disclosed this element during the examination of related patent, U.S. Patent No.

11,375,768 (the “’768 patent”) and determined that it did not. “When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency.” *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984), *abrogated on other grounds by Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011); *Cadence Pharms. Inc. v. Exela PharmSci Inc.*, 780 F.3d 1364, 1375 (Fed. Cir. 2015). Therefore, “a party challenging validity shoulders an enhanced burden if the invalidity argument relies on the same prior art considered during examination by the U.S. Patent and Trademark Office (‘PTO’).” *Tokai Corp. v. Easton Enterprises, Inc.*, 632 F.3d 1358, 1367 (Fed. Cir. 2011); *Andersen Corp. v. Pella Corp.*, 300 F. App’x 893, 899 (Fed. Cir. 2008).

In the Notice of Allowance for the ’768 patent, the examiner first noted that Talarico ’376 (a patent related to Talarico ’911) “does not show or teach the forefoot platform sole section/midsole ***having an outer edge having a greater first thickness proximate the heel platform and a smaller second thickness at a toe portion in that the outer edge.***” Ex. 1011, 15 (emphasis added). The examiner went on to say that Talarico ’911 is also “***silent as to any change in thickness.***” *Id.* (emphasis added). In other words, the examiner determined that Talarico ’911 does not disclose the “thickness” requirement of the patent: that it has a level of compression near (or

proximate to) an inner edge that is greater than the level of compression near (or proximate to) an outer edge. This determination applies with equal force the '456 patent, which shares the same claim language. *Compare* EX2008 (the '768 patent), claim 1 (“the second material compresses to a first level near an outer edge of the sole section and the second material compresses to a second level near an inner edge of the sole section, wherein the second level of compression is greater than the first level of compression”) *with* EX1001 at claim 1 (same), claim 10 (substantially the same). Moreover, the '768 was appealed, and the Notice of Allowance issued only after the appeal—demonstrating that the Patent Office seriously and closely considered this issue. EX1011, 24-31. Thus, the Patent Office has already considered the very argument that Petitioner now raises, and rejected it. Despite that, the Petition does not address the Patent Officer’s determination, much less even attempt to meet Petitioner’s “enhanced,” “added burden” to show that the Patent Officer’s determination was wrong.

Moreover, the evidence cited in the Petition ***does not*** show that Talarico '911 discloses a level of compression near (or proximate to) an inner edge that is greater than the level of compression near (or proximate to) an outer edge. The Petition alleges that “Talarico '911 teaches that the varied density across the forefoot platform would cause the sole elements to compress more near their inner edge than

near their outer edge when the weight of an athlete is applied to the shoe.”⁶ Pet., 69. In support of its assertion, Petitioner first quotes Talarico ’911’s statement that “the sole effectively slo[p]es at an angle upwardly from the lateral aspect to the medial aspect when weight-bearing forces are exerted on the forefoot.” *Id.* (quoting EX1008, Abstract). But this discloses the *exact opposite* of the claim language. Claims 1 and 10 require that the level of compression near (or proximate to) an inner edge is greater than the level of compression near (or proximate to) an outer edge. In contrast, the quoted text from Talarico ’911 states that the sole “slopes at an angle upwardly from the lateral aspect [i.e., the outside of the shoe] to the medial aspect [i.e., the inside of the shoe].” EX1008, Abstract. In other words, the quoted text from Talarico ’911 discloses that the level of compression at the outer edge is greater than at the inner edge, and thus the outer edge is lower than the inner edge, and so the sole “slopes at an angle upwardly.

The Petition next cites a passage of Talarico ’911 without discussion or quotation. Pet., 69 (citing EX1008, 19:50-63). That portion again discloses an “effective upward slope of the sole at the lateral aspect of the footwear”—the opposite of the claim element. EX1008, 19:50-63. And Petitioner does not disclose how this passage otherwise purportedly discloses this element.

⁶ While the Petition discusses different densities in Talarico ’911, this is its only statement regarding the levels of compression in Talarico ’911. Pet., 67-69.

Finally, the Petition cites Mr. Delgatty's declaration. Pet., 69 (citing EX1002, ¶139). But the cited portion again just repeats the Petition verbatim, *compare* Pet., 69 *with* EX1002, ¶139, and is thus entitled to no weight. *See Xerox Corp.*, No. IPR2022-00624, at *6.

In sum, Talarico '911 does not render obvious this element. Petitioner has thus failed to demonstrate a reasonable likelihood that Talarico '911 renders obvious any asserted claim and that it will succeed on Ground 6.

2. “a forefoot platform juxtaposed to the heel platform, wherein the forefoot platform is constructed of a second material having a gradient compression factor”

Petitioner argues that this element is “Talarico '911 discloses a midsole with a forefoot platform made up of a ‘second material’ comprised of different compressibilities across the width of a shoe.” Pet., 67. But the Petition does not explain, much less provide any evidence, for how or why Talarico '911 discloses a “second material.” *Id.*, 64-69. Ground 6 fails for having not addressed how this element is disclosed or rendered obvious. *See* 35 U.S.C. § 312(a)(3); *Intelligent Bio-Sys., Inc.*, 821 F.3d at 1369.

Moreover, as Petitioner admits, Talarico '911 is “directed only to the forefoot portions of the footwear,” not to the heel portion of the footwear. Pet., 65 (citing EX1008, 6:56-62); EX1008, 6:56-62 (“[I]t is the sole intention of this specification and the present invention to provide footwear compensating the forefoot portion of

the footwear only.”). Talarico ’911 is not concerned with the material of the heel platform, including whether it is different than the material in the forefoot platform. *See, e.g.*, EX1008, 10:19-22 (“[T]he present invention is uniquely concerned with different densities of materials employed to affect a functional change ***in the forefoot portion of footwear.***” (emphasis added)). And the Petition does not argue in any way that it would be obvious for the forefoot platform and the heel platform to be different materials. Therefore, Talarico ’911 does not disclose or suggest “a forefoot platform juxtaposed to the heel platform, wherein the forefoot platform is constructed of a ***second material*** having a gradient compression factor.”

In sum, Talarico ’911 does not render obvious this element. Petitioner has thus failed to demonstrate a reasonable likelihood that Talarico ’911 renders obvious any asserted claim and that it will succeed on Ground 6.

IX. CONCLUSION

For the reasons stated above, institution of the IPR should be denied.

Dated: June 14, 2024

By: /Michael Matulewicz-Crowley/
Michael Matulewicz-Crowley
PTO Reg. No. 72,220
Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that Patent Owner's Preliminary Response (the "POPR") consists of 13,807 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:

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