

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW BALANCE ATHLETICS, INC.,
Petitioner,

v.

NIKE, INC.,
Patent Owner.

IPR2024-00778
Patent 8,266,749 B2

Before KEN B. BARRETT, JOSIAH C. COCKS, and
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

1. Introduction

A conference call was held on September 23, 2024, between counsel for the respective parties and Judges Barrett, Cocks, and Fitzpatrick. The purpose of the call was to discuss Petitioner’s request to file a preliminary reply to Patent Owner’s Preliminary Response.

2. Discussion

At the outset, we note that although Patent Owner filed its Preliminary Response on August 9, 2024 (Paper 7, “Prelim. Resp.”), it was not until September 18, 2024, more than five weeks later, that Petitioner contacted the Board to request authorization to file a preliminary reply to that Response. That is a considerable delay. In any event, during the call, Petitioner expressed that it was seeking to file a preliminary reply to address matters of claim construction that Petitioner contends it could not have anticipated Patent Owner would raise. In particular, Petitioner represented that it could not have anticipated Patent Owner’s proposed interpretations of “article of footwear,” “surrounding,” and “knitting.”

In the Petition, Petitioner offered proposed construction of five claim terms or phrases of involved patent 8,266,749 (“the ’749 patent”) that Petitioner contends the Board construed under a “broadest reasonable construction standard” that was previously applicable to a prior *inter partes* review proceeding involving the ’749 patent. *See* Pet. 12–13. Petitioner expressed that it did not seek to have any of those terms “re-construed in view of the now-applicable *Phillips* stands.” *Id.* at 12 (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005)). We note that none of those terms was the subject of the conference call. Petitioner also

conveyed that “the Board need not specifically construe any other claim terms.” *Id.* at 13.

In its Preliminary Response, Patent Owner expressed that all claim terms of the ’749 patent should be afforded their “ordinary and customary meaning.” Prelim. Resp. 10–12. Patent Owner made explicit that meaning for the term or phrase “article of footwear.” *Id.* at 11–12. During the call, Petitioner did not disagree with Patent Owner that all terms of the ’749 have their ordinary and customary meaning. As expressed on the conference call, however, Petitioner disagrees with the ordinary and customary meaning offered by Patent Owner in its Preliminary Response. To that end, Petitioner seeks to expand on its Petition as to why “stockings” should be regarded as an “article of footwear,” within the ordinary meaning of that term. We note that Petitioner had opportunity to address that issue as a part of the Petition, and indeed did so, taking the position, for instance, at page 43 of the Petition that “a knitted stocking . . . is an article of footwear” and offering support for that position (citing Ex. 1007, 1:19–25, and Ex. 1003 (Dr. Brookstein’s testimony) ¶¶ 102–106). Petitioner does not adequately convey why Patent Owner’s challenge to the Petition gives rise to a position or positions that Petitioner could not have anticipated.

With respect to “surrounding” and “knitting,” we also note that Petitioner had opportunity to address claim limitations in connection with steps involving those terms, specifically in the context of knitting a textile element and a surrounding textile structure, and proposed grounds of unpatentability based on Petitioner’s understanding of the claim requirements. *See, e.g.,* Pet. 20. That Petitioner may disagree with views offered by Patent Owner in challenging the propriety of Petitioner’s

proposed grounds of unpatentability does not establish, in this case, adequate cause to authorize additional briefing on matters of claim construction.

Accordingly, although we take note of Petitioner's disagreement with Patent Owner's views expressed in the Preliminary Response as to matters of claim construction, and that disagreement will be considered in assessing the Petition, the panel concludes that further briefing on the matter is not warranted under the circumstances. The panel will determine whether to institute an *inter partes* review based on the current record.

It is so ORDERED.

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