

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,

Petitioner

v.

SHERRYWEAR LLC,

Patent Owner.

Case No. IPR2024-01122

U.S. Patent No. 9,289,016

PETITIONER'S REPLY TO PATENT OWNER'S § 325(d) ARGUMENTS

TABLE OF CONTENTS

Table of Authorities iii

Exhibit List iv

I. Discretionary Denial Is Not Appropriate Because Petitioner’s
Grounds Do Not Involve the Same or Substantially the Same Art
(*Advanced Bionics*, Part I) 1

II. Even If the Petitioner’s References Are Cumulative, the Examiner
Materially Erred (*Advanced Bionics*, Part II) 6

III. Conclusion 7

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Fubotv Media Inc. v. Dish Techs. L.L.C.</i> , No. IPR2024-00917, 2024 WL 4858758 (P.T.A.B. Nov. 21, 2024).....	7
<i>Fusion Orthopedics, LLC v. Extremity Medical, LLC</i> , IPR2023-00894, Paper 15 (Nov. 17, 2023)	1
<i>K/S HIMPP v. BRAGI GmbH</i> , IPR2023-01205, Paper 8 (Mar. 19, 2024)	1, 7
<i>Microsoft Corp. v. Parallel Networks Licensing, LLC</i> , IPR2015-00486, Paper 10 (P.T.A.B. July 15, 2015)	4
<i>Quasar Sci. LLC v. Colt Int'l Clothing, Inc.</i> , No. IPR2023-00611, 2023 WL 6811976 (P.T.A.B. Oct. 10, 2023).....	6
<i>Regents of the Univ. of California v. Eli Lilly & Co.</i> , 119 F.3d 1559 (Fed. Cir. 1997)	2
<i>Veeam Software Corp. v. Hybir Inc.</i> , IPR2020-01037, 2020 WL 7121603 (P.T.A.B. Dec. 4, 2020)	3
Statutes	
35 U.S.C. § 301(a)(2).....	5

EXHIBIT LIST

Exhibit No.	Description¹
NIKE-1001	Declaration of Joyce Baran
NIKE-1002	Resume of Joyce Baran
NIKE-1003	Certified U.S. Patent No. 9,295,288 (filed Nov. 18, 2013)
NIKE-1004	Certified Prosecution File History for U.S. Patent No. 9,295,288
NIKE-1005	RESERVED
NIKE-1006	RESERVED
NIKE-1007	RESERVED
NIKE-1008	RESERVED
NIKE-1009	Certified U.S. Patent No. 9,289,016 (filed Feb. 5, 2015)
NIKE-1010	Certified Prosecution File History for U.S. Patent No. 9,289,016
NIKE-1011	RESERVED
NIKE-1012	RESERVED
NIKE-1013	RESERVED
NIKE-1014	RESERVED
NIKE-1015	RESERVED
NIKE-1016	RESERVED
NIKE-1017	RESERVED

¹ Descriptions are for convenience only and are not admissions or evidence.

Exhibit No.	Description¹
NIKE-1018	RESERVED
NIKE-1019	U.S. Patent No. 3,518,998 (filed Feb. 8, 1968) (“Barg”)
NIKE-1020	U.S. Patent No. 2,920,628 (filed Oct. 7, 1958) (“York”)
NIKE-1021	U.S. Patent Application Publication No. 2014/0051331 (filed Aug. 20, 2012) (“Handras”)
NIKE-1022	U.S. Patent No. 7,753,759 (filed Sept. 29, 2008) (“Pintor”)
NIKE-1023	U.S. Patent Publication No. 2005/0037687(A1) (filed Aug. 12, 2003) (“Newman”)
NIKE-1024	U.S. Design Patent No. D597,279 (filed Oct. 26, 2008) (“Spillman”)
NIKE-1025	U.S. Design Patent No. D529,259 (filed Jan. 13, 2006) (“Faagau”)
NIKE-1026	EP211124(A1) (filed July 22, 1985) (“Vidai”) (Original)
NIKE-1027	EP211124(A1) (filed July 22, 1985) (“Vidai”) (Official Translation)
NIKE-1028	RESERVED
NIKE-1029	RESERVED
NIKE-1030	U.S. Patent Application Publication No. 2011/0223832 (filed Mar. 4, 2011) (“Rose”)
NIKE-1031	RESERVED
NIKE-1032	RESERVED
NIKE-1033	RESERVED

Exhibit No.	Description ¹
NIKE-1034	<i>Early Brassiere</i> , Google Arts & Culture, https://artsandculture.google.com/asset/early-brassiere/-gGoCcJIsFqA1g?hl=en .
NIKE-1035	Rebecca Unsworth, <i>Hands Deep in History: Pockets in Men and Women's Dress in Western Europe, c. 1480-1630</i> , THE COSTUME SOCIETY (Edinburgh Univ. Press 2017), https://www.euppublishing.com/doi/epub/10.3366/cost.2017.0022 .
NIKE-1036	Derek Gentile, <i>A comfortable convenience: County woman creates, patents the 'pocketbra'</i> , THE BERKSHIRE EAGLE (May 12, 2014), https://www.berkshireeagle.com/business/a-comfortable-convenience-county-woman-creates-patents-the-pocketbra/article_039dd3a3-29d7-58a7-aa5a-fd5dc171479f.html .
NIKE-1037	Kit-lun Yick et al., <i>Study of thermal–mechanical properties of polyurethane foam and the three-dimensional shape of molded bra cups</i> , 210 Journal of Materials Processing Technology at 116–21 (Aug. 2009)
NIKE-1038	U.S. Patent No. 6,997,775 B2 (Feb. 14, 2006) (“Jagarc”))
NIKE-1039	RESERVED
NIKE-1040	MA Litigation, SherryWear’s Infringement Contentions, ’016 Swoosh Bra Infringement Claim Chart
NIKE-1041	MA Litigation, SherryWear’s Infringement Contentions, ’016 Swoosh Pocket Bra Infringement Claim Chart
NIKE-1042	RESERVED
NIKE-1043	RESERVED
NIKE-1044	RESERVED
NIKE-1045	RESERVED

Exhibit No.	Description ¹
NIKE-1046	MA Litigation Docket No. 31 (Scheduling Order)
NIKE-1047	LegalMetric District Report Massachusetts District Court in Patent Cases January 2019 to January 2024
NIKE-1048	LegalMetric Individual Judge Report on Judge Leo Sorokin in Patent Cases June 2014 to April 2023
NIKE-1049	Appendix A to SherryWear’s Answers and Objections to Nike’s First Set of Interrogatories (Response to Interrogatory No. 5) (Mar. 29, 2024).
NIKE-1050	U.S. Patent No. 8,597,072 (filed Apr. 26, 2011)
NIKE-1051	File History for U.S. Patent No. 8,597,072
NIKE-1052	RESERVED
NIKE-1053	<i>SherryWear v. Nike</i> , No. 1:23-cv-11599, Dkt. 69 (Order on Motion to Stay) (D. Mass. Sept. 3, 2024)
NIKE-1054	RESERVED
NIKE-1055	RESERVED
NIKE-1056	RESERVED

Petitioners file this Reply addressing arguments concerning § 325(d) pursuant to email authorization as of December 17, 2024.

I. DISCRETIONARY DENIAL IS NOT APPROPRIATE BECAUSE PETITIONER’S GROUNDS DO NOT INVOLVE THE SAME OR SUBSTANTIALLY THE SAME ART (*Advanced Bionics*, Part I)

Patent Owner admits, as it must, that Vidai and Handras—the two primary references relied on by Petitioner—were not before the Examiner during prosecution of the ’016 patent. Paper 8 (Patent Owner’s Preliminary Response) at 12 (“POPR”). *Advanced Bionics* Part I is not satisfied for this reason alone, and discretionary denial is inappropriate. *E.g.*, *Fusion Orthopedics, LLC v. Extremity Medical, LLC*, IPR2023-00894, Paper 15 at 34–35 (Nov. 17, 2023) (instituting review, finding § 325(d) not sufficiently implicated because the primary reference for four of the seven grounds was not previously presented to the Office). Indeed, the Petition explains how Vidai and Handras alone each independently disclose and/or render claim 1 obvious, relying on Pintor only in the alternative, or as a secondary reference for certain dependent claims. *See* Petition, §§ IX.A, IX.B. “Because neither of those references was before the office, Patent Owner has not satisfied the first prong of the *Advanced Bionics* test,” and discretionary denial is not warranted. *K/S HIMPP v. BRAGI GmbH*, IPR2023-01205, Paper 8 at 19–20 (Mar. 19, 2024).

PO nevertheless argues that Part I of the *Advanced Bionics* framework is met because Vidai and Handras are allegedly cumulative of and not materially different

from Sherwood (SW-2064) and are cumulative of Gentry (SW-2065).² A reference is only considered “cumulative” if it “teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO.” *Regents of the Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1575 (Fed. Cir. 1997). Vidai and Handras are materially different from Sherwood, and are not cumulative of Sherwood or Gentry. PO’s arguments to the contrary are inconsistent with arguments it made during prosecution, misconstrue Petitioner’s arguments, and overly simplify the disclosures of Vidai and Handras.

² PO also contends that “Petitioner here relies on Vidai and Handras for the same structure and purpose the Examiner explicitly considered in Pintor: a pocket designed to removably store items.” POPR at 14. Not so. The Examiner applied Pintor only as a secondary reference for the purpose of demonstrating polyurethane, holding non-padding items, and the disclosure of underwire in ’016’s dependent claims. *E.g.*, NIKE-1010 at 115. By contrast, Petitioner relies on Vidai and Handras as primary references to establish each limitation of independent claim 1 of the ’016 patent, including the disclosure of a side pocket which “extends onto the adjacent cup,” which PO admits Pintor does not disclose. Petition, §§ IX.A, IX.B.

First, PO contends that Petitioner relies on Vidai and Handras exclusively to show disclosure of a side pocket, which is already disclosed by Sherwood, and thus there is no material, or “probative,” difference between the references. POPR at 14. But PO took the *opposite* position regarding Sherwood during prosecution: during prosecution of the ’016 patent’s parent, the ’288 patent, PO argued that Sherwood “does not teach a side pocket” because Sherwood instead “teaches a mastectomy bra” designed to hold padding that compensates for removed tissue on the side of a wearer’s torso, the pockets of which are “closed permanently” with stitching once fitted to the wearer. NIKE-1004 at 176. Similarly, during prosecution of the ’016, PO refused to concede that Sherwood taught a side pocket in response to the Examiner’s rejection. NIKE-1010 at 143. PO should not be permitted to take a contrary position now. *Veeam Software Corp. v. Hybir Inc.*, IPR2020-01037, 2020 WL 7121603, at *5 (P.T.A.B. Dec. 4, 2020) (declining to exercise discretion under § 325(d) where patent owner’s arguments were contrary to arguments made during prosecution).

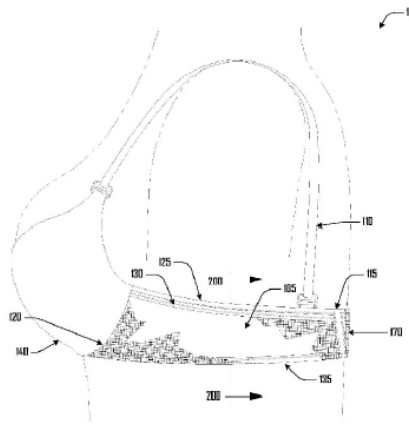
Second, the disclosures of Vidai and Handras are more salient than Sherwood. As explained in the Petition, PO distinguished its alleged invention from mastectomy bras in connection with reference Newman. Petition at 52. By PO’s own admission, Sherwood too teaches a mastectomy bra with pockets for the permanent insert of padded prostheses. *See, e.g.*, NIKE-1010 at 143; NIKE-1004 at 176. Conversely, the

pockets disclosed in Vidai and Handras are expressly directed to the removable storage of non-padding items. Moreover, Petitioner relies on Vidai and Handras as primary references to demonstrate disclosure of *every* limitation of claim 1, including a side pocket which “extends onto the adjacent cup.” *E.g.*, Petition at 2, 22–24. And to show obviousness in the alternative, Petitioner does not rely only on Vidai’s disclosure of a side pocket as PO suggests, but on the knowledge of a POSA as explained in the unrebutted testimony of expert Joyce Baran, whose testimony was also never previously before the Patent Office. *See* Petition at 22–24.

Third, PO is wrong that Vidai and Handras are cumulative of Gentry. As an initial matter, Gentry was listed in an Information Disclosure Statement but was not discussed or cited in any rejections. NIKE-1010 at 4. Thus, it is unclear to what extent the Examiner reviewed and relied upon Gentry. *Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00486, Paper 10 at 14–15 (P.T.A.B. July 15, 2015) (instituting review despite reference having been listed on IDSs initialed by the Examiner). In any event, Gentry discusses the benefits of reducing manufacturing costs by *not* extending the pockets onto the cups (SW-2065 at 4:60–5:3), making Vidai and Handras—which do not express such preferences—more pertinent disclosures.

Fourth, PO asserts a broader reading of its claims in the MA Litigation, which was not before the Examiner. Specifically, the Applicant obtained allowance by

amending the independent claims to add a “side pocket” that “extends onto the adjacent cup, such that each pocket spans both a part of the chest strap and a part of the adjacent cup,” arguing that “neither Newman nor Pintor [nor Sherwood or Gentry] teach that a side pocket spanning part of the strap and part of the cup as required by claim 1.” NIKE-1010 at 133–144. But as explained in the Petition, PO in the MA Litigation now reads this same limitation on products with pockets that extend no farther onto the adjacent cup than Gentry:

Gentry	MA Litigation Accused Product
	

SW-2065 at Fig. 1; Petition at 22–24; 35 U.S.C. § 301(a)(2) (“any person” may rely upon “statements of [PO] filed in a proceeding before a Federal court or the Office in which [PO] took a position on the scope of any claim of a particular patent.”). The Petition’s grounds therefore do not present the same or similar arguments as those considered during prosecution, as the Examiner never had the opportunity to

consider arguments regarding whether any prior art, let alone Vidai and Handras, disclosed this limitation under PO's new, broader reading of the claims.

II. EVEN IF THE PETITIONER'S REFERENCES ARE CUMULATIVE, THE EXAMINER MATERIALLY ERRED (*Advanced Bionics*, Part II)

PO broadly argues no material error because the Examiner "had already considered a reference that taught a pocket on the chest strap" (POPR at 17). This argument fails for at least the following reasons.

First, Vidai and Handras disclose more than merely "a pocket on the chest strap"; they disclose and/or render obvious every limitation of claim 1, including a side pocket that "extends onto the adjacent cup"—the limitation PO argues distinguished its alleged invention from Sherwood and Gentry. Petition at 2, 22–24; POPR at 13; *Quasar Sci. LLC v. Colt Int'l Clothing, Inc.*, No. IPR2023-00611, 2023 WL 6811976, at *6 (P.T.A.B. Oct. 10, 2023) ("a petitioner's showing that the challenged claims are unpatentable over the asserted prior art may itself be evidence of material error by the Office during prosecution.").

Second, as discussed above, PO is reading its claims more broadly in the MA Litigation than it did during prosecution to secure allowance. Had this broader reading been before the Examiner, it would have been material error to allow the claims over Gentry, whose pockets "extend over" the cups to no less an extent than the products accused in the MA Litigation, and Vidai, whose side pockets extend

even farther. *K/S HIMPP*, Paper 8 at 20 (“[i]f the record of the Office’s previous consideration of the art is not well-developed or silent, then a petitioner may show the Office erred by overlooking something persuasive.”) (citing *Advanced Bionics*, Paper 6 at 10); *Fubotv Media Inc. v. Dish Techs. L.L.C.*, No. IPR2024-00917, 2024 WL 4858758, at *13 (P.T.A.B. Nov. 21, 2024) (Examiner materially erred by overlooking limitations taught by reference disclosed in IDS).

Third, Petitioner offers new evidence (*Becton* factor (f)) that was not available to the Examiner, such as the testimony of Ms. Baran (NIKE-1001). Ms. Baran provides important additional context for what a POSA would have known—such as pocket shapes, placement, and how to achieve a desired aesthetic and function—and how a POSA would have understood the disclosures of Vidai, Handras, and Pintor, including how to modify such disclosures to achieve a desired design. Since the Examiner lacked this evidence, the Examiner did not appreciate that a POSA would have easily known how to modify the prior art’s teachings with a high expectation of success, rendering the Challenged Claims obvious. *E.g.*, NIKE-1001, ¶¶ 648–51, 692–696.

III. CONCLUSION

For the foregoing reasons, denial under § 325(d) is inappropriate, and *inter partes* review of the ’016 patent should be instituted.

Date: December 27, 2024

/s/ W. Todd Baker

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CERTIFICATE OF SERVICE

In compliance with 37 C.F.R. §§ 42.105, 42.6(e), the undersigned hereby certifies that a copy of the foregoing “PETITIONER’S REPLY TO PATENT OWNER’S § 325(d) ARGUMENTS” was sent electronically on December 27, 2024, directed to counsel of the Patent Owner at mdrayton@caldwelllaw.com, jameson@caldwelllaw.com, and tanner@caldwelllaw.com.

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