

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,

Petitioner,

v.

SHERRYWEAR LLC,

Patent Owner.

Case IPR2024-01122

Patent 9,289,016

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW
UNDER 35 U.S.C. §§ 311-19 AND 37 C.F.R. § 41.100, ET SEQ.**

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Exhibit List

Exhibit No.	Exhibit Description
SW-2001	Affidavit of Sharon Goff
SW-2002	Article: A Comfortable Convenience—Berkshire Eagle
SW-2003	Article: Should YOU Invest in a Brainy Bra—Daily Mail
SW-2004	Urban Savage License
SW-2006	Rabbit License
SW-2007	Senita License
SW-2008	‘036 Senita Sculpt Bra Chart
SW-2009	‘036 Tracksmith Allston Chart
SW-2010	‘036 Crasher Crop Chart
SW-2011	‘510 Senita Flight Bra Chart
SW-2012	‘510 Senita Hustle Bra Chart
SW-2013	‘510 Senita Perfect Pocket Bra Chart
SW-2014	‘510 Senita Sarah Sports Bra Chart
SW-2015	‘510 Urban Savage Stash Bra Chart
SW-2016	‘510 Rabbit Bunny Hop Chart
SW-2017	‘510 Rabbit Crop Hop Support and Pocket Chart
SW-2018	‘510 Rabbit Crop Hop Support and Pocket Tech Chart
SW-2019	‘510 Rabbit Strappy Pocket Bra Chart
SW-2020	‘510 Rabbit UtiliBRA-vo chart
SW-2021	‘550 Senita Sculpt Bra Chart
SW-2022	‘550 Tracksmith Allston Chart
SW-2023	‘550 Tracksmith Allston APA Chart
SW-2024	‘550 Rabbit Crusher Crop Chart
SW-2025	‘800 Senita Flight Bra Chart
SW-2026	‘800 Senita Hustle Bra Chart
SW-2027	‘800 Senita Perfect Pocket Bra Chart
SW-2028	‘800 Senita Sarah Sports Bra Chart
SW-2029	‘800 Urban Savage Stash Bra Chart
SW-2030	‘800 Rabbit Bunny Hop Support and Pocket Chart
SW-2031	‘800 Rabbit Crop Hop Support and Pocket Chart
SW-2032	‘800 Rabbit Crop Hop Support and Pocket Tech Chart.
SW-2033	‘800 Rabbit Strappy Pocket Bra Chart
SW-2034	‘800 Rabbit UtiliBRA-vo Chart
SW-2035	2015 NIKE IDEA Submission

SW-2036	NIKE Correspondence
SW-2037	NIKE Correspondence
SW-2038	Ms. Goff and Mr. Saraceni Correspondence
SW-2039	NIKE Patent Application 15/597,364
SW-2040	2017 NIKE IDEA Submission
SW-2041	Correspondence from NIKE
SW-2042	NIKE Patent Application 15/718,171
SW-2043	‘016 Swoosh Pocket Bra Chart
SW-2044	‘510 Swoosh Pocket Bra Chart
SW-2045	‘550 Swoosh Pocket Bra Chart
SW-2046	‘878 Swoosh Pocket Bra Chart
SW-2047	‘800 Swoosh Pocket Bra Chart
SW-2048	‘016 Swoosh Bra Chart
SW-2049	‘510 Swoosh Bra Chart
SW-2050	‘551 Swoosh Bra Chart
SW-2051	‘878 Swoosh Bra Chart
SW-2052	‘800 Swoosh Bra Chart
SW-2053	‘036 Swoosh on the Run Chart
SW-2054	‘288 Swoosh on the Run Chart
SW-2055	‘510 Swoosh on the Run Chart
SW-2056	‘550 Swoosh on the Run Chart
SW-2057	‘800 Swoosh on the Run Chart
SW-2058	Swoosh Pocket Bra (product images)
SW-2059	Swoosh Pocket Bra (product images)
SW-2060	Swoosh Bra (product images)
SW-2061	Swoosh Bra (product images)
SW-2062	Swoosh on the Run (product images)
SW-2063	Swoosh on the Run (product images)
SW-2064	US 4,699,144 to Sherwood
SW-2065	US 8,771,036 to Gentry, et al.

I. INTRODUCTION

The Petition fails to show a reasonable likelihood that Petitioner will succeed in invalidating at least one challenged claim of U.S. Patent No. 9,289,016 (“‘016 patent”). The Petition asserts three grounds for invalidity based on obviousness. Petitioner cannot show a reasonable likelihood that it will succeed on *any* of these grounds because the same or substantially similar art was considered during prosecution, the Petitioner has failed to demonstrate that the Examiner made any material error in allowing the patent, and none of the prior art offered in the petition renders the ‘016 patent obvious.

II. FACTUAL AND PROCEDURAL BACKGROUND

A. Invention, patenting and reception of the pocket bra

Sharon Goff invented the Pocket Bra to resolve a long-standing and unfulfilled need in women’s apparel: women’s clothes frequently lack pockets, and Ms. Goff, like many other women, resorted to storing objects in her bra. This was unfashionable, uncomfortable and sometimes resulted in objects getting lost. *See* Goff Affidavit, Exhibit SW-2001 at ¶ 2. In response, Ms. Goff invented several variations of bras with pockets, which are collectively referred to herein as variants of the Pocket Bra. *Id.* at ¶ 3.

When Ms. Goff began selling variants of the Pocket Bra, she discovered that many women had a similar experience to her and welcomed the new invention as a

way to store items and keep their hands free. *Id.* at ¶ 6. At least one woman who spoke to Ms. Goff also reported unexpected benefits, such as the ability to store insulin pumps on their person using the Pocket Bra. *Id.* at ¶ 7. Women showed further interest in the product by requesting it in a greater size range. *Id.*

The Pocket Bra also enjoyed significant positive press. In addition to various interviews with Ms. Goff herself, an expert in lingerie and women's undergarments hailed an early variant of the Pocket Bra as the Pocket Bra as "genius." Exhibit SW-2003. The expert, Chantelle, also echoed the observation of other women, and of Ms. Goff herself, that women frequently stowed items in their bras already, and the pocket bra represented a better solution than the ad hoc methods those women resorted to. [*Id.*].

Ms. Goff also pursued patent protection for the Pocket Bra and variants thereof, obtaining several patents in the process. These patents include the patents challenged in this and related IPR proceedings, specifically U.S. Patent No. 9,295,288 ("the '288 patent"); U.S. Patent No. 9,808,036 ("the '036 patent"); U.S. Patent No. 10,219,550 ("the '550 patent"); U.S. Patent No. 9,289,016 ("the '016 patent"); U.S. Patent No. 9,723,878 ("the '878 patent"); U.S. Patent No. 10,244,800 ("the '800 patent"); U.S. Patent No. 10,219,551 ("the '551 patent"); and U.S. Patent No. 10,869,510 ("the '510 patent") (collectively "the Disputed Patents).

B. Licensing of the Pocket Bra Patents to Third Parties.

Patents for the Pocket Bra have already been licensed to several other companies who started producing similar products after Ms. Goff filed her patent applications and began marketing her inventions. These licenses include a license to Urban Savage, LLC, [REDACTED] a license to Rabbit, LLC, and a license to Senita, LLC. SW-2001 at ¶ 9. The licensed products continue to enjoy commercial success, as evidenced by the continued availability of licensed products from each of the companies subject to the above-described licenses. *Id.* at ¶ 10. Each of the four licenses described above is provided herewith in Exhibits 2004-2007. Claim charts illustrating the applicability of Pocket Bra patent claims to products covered by the licenses are provided herewith as Exhibits 2008-2034.

SherryWear also has executed a license to Smooth Landing Inc., the provisions of which remain confidential. SW-2001 at ¶ 10.

C. Interactions with NIKE

On June 18, 2015, Ms. Goff submitted SherryWear's then-issued and pending patents, and photographs of a couple of SherryWear Pocket Bras, to NIKE via "NIKE Idea Submission," an online idea submission platform operated by NIKE. *Id.* at ¶ 11. A copy of the June 18, 2015, NIKE Idea submission is provided herewith as Exhibit 2035. Nike did not respond to the submission. SW-2001 at ¶

12. As illustrated below, the submission contained examples of the SherryWear sports bra products:



In January 2017, Ms. Goff contacted several high-ranking employees at NIKE via LinkedIn messenger including Evan Reynolds, then-Head of Marketplace Strategic Investments; Rick Boyd, then-Patent Footwear specialist; Nathan Plowman, then-Senior Director at NIKE; and Hillary Krane, then-General Counsel for NIKE. *Id.* at ¶¶ 13-14. Copies of the correspondence are provided herewith as Exhibit 2036 and Exhibit 2037. Hillary Krane forwarded Ms. Goff's messages to Paul Saraceni, then the VIP of Global IP Transactions & Licensing at NIKE, on

February 7, 2017. *See* Exhibit SW-2037.

On February 7, 2017, Mr. Saraceni asked Ms. Goff to send a “non-confidential list of IP assets that [SherryWear] had begun to market for sale.” SW-2001 at ¶ 15. In response, Ms. Goff sent Mr. Saraceni a list of SherryWear’s then-issued and pending patents. *Id.* at ¶ 16. The patents then pending included the ‘878 patent, the ‘016 patent, the ‘036 patent, and the ‘288 patent, as a result of which NIKE was given access to all disclosure elements of the challenged patents.

Between February and March of 2017, Mr. Saraceni and Ms. Goff communicated again by email regarding the licensing or purchasing of SherryWear’s intellectual property. *Id.* at ¶ 17. A copy of the February and March 2017 correspondence is provided herewith as exhibit 2038. On March 24, 2017, Ms. Goff received an email from Mr. Saraceni stating, “[w]e will respectfully pass on the opportunity.” SW-2001 at ¶ 18.

On May 17, 2017, only fifty-five days, or less than 8 weeks, after Mr. Saraceni emailed Ms. Goff that NIKE would “pass on the opportunity,” NIKE filed U.S. patent application 15/597,364, entitled “Bra With Storage Pockets.” A copy of the U.S. patent application 15/597,364 is provided herewith as Exhibit 2039.

On September 22, 2017, Ms. Goff submitted SherryWear’s Pocket Bra idea and patents to NIKE via NIKE Idea Submission again. SW-2001 at ¶ 19. A copy of the September 22, 2017, submission is provided herewith as Exhibit 2040. On

October 20, 2017, Barrett Inman of NIKE's legal department responded to Ms. Goff's second NIKE Idea Submission stating, "[t]here is no interest in pursuing your submission." SW-2001 at ¶ 20. A copy of Mr. Inman's October 20, 2017 response is attached hereto as Exhibit 2041.

On September 28, 2017, six days after Ms. Goff submitted SherryWear's second NIKE Idea Submission, NIKE filed U.S. patent application 15/718,171, entitled "Bra With Storage Pockets." A copy of U.S. patent application 15/718,171 is attached hereto as Exhibit 2042. Both patent application 15/597,364 and 15/718,171 have since issued as patents.

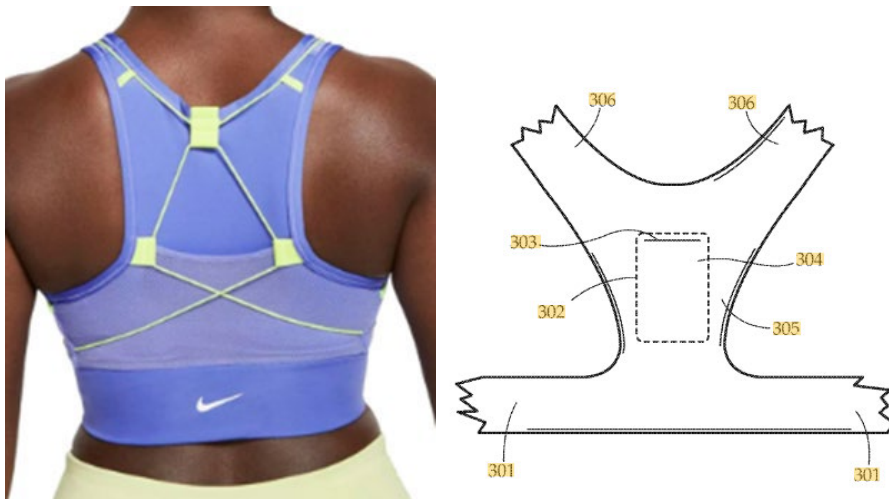
SherryWear filed a complaint in the United States District Court for the District of Massachusetts for patent infringement based on the manufacture, use, sale, offer for sale, and/or import by NIKE of and with regard to several bras with pockets, initiating Case 1:23-cv-11599-LTS, SHERRYWEAR, LLC v. NIKE, INC. (the "Coping Case"). This case advanced to the Markman ruling, after which NIKE filed a total of eight IPR requests against the Disputed Patents and moved to stay the Coping Case. The stay was granted.

D. Evidence of Copying by NIKE

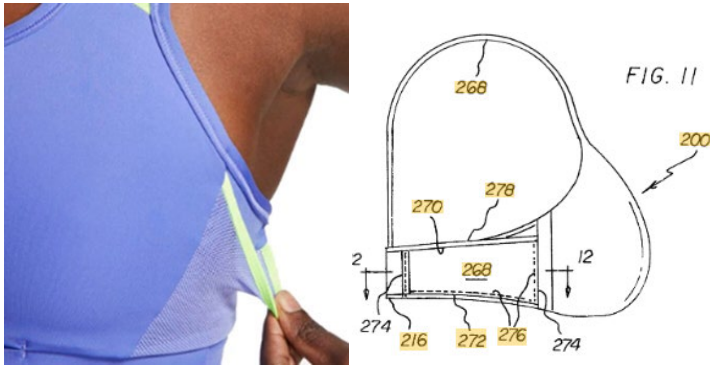
There is significant evidence that NIKE copied the patented inventions of Ms. Goff. As noted above, NIKE drafted and filed a patent application relating to a

bra with pockets shortly after receiving product samples, patents, and patent applications from Ms. Goff. NIKE also began producing and selling bras with pockets after this point.

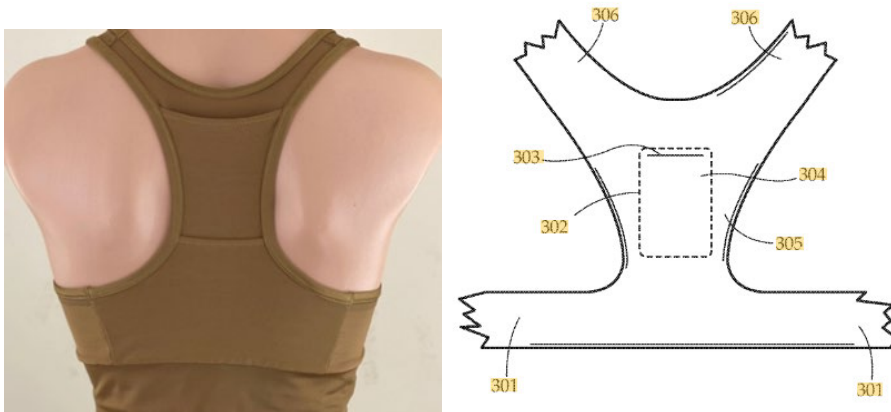
Several of Nike's products have notable similarities to the disclosures of the SherryWear patents. For instance, NIKE makes, uses, offers for sale, sells, and imports a sports bra with pockets titled the "Swoosh Pocket Bra." As shown in the following comparison, the Swoosh Pocket Bra has a back pocket, similarly to the back pocket portrayed in FIG. 13 of the '800 and '510 patents:



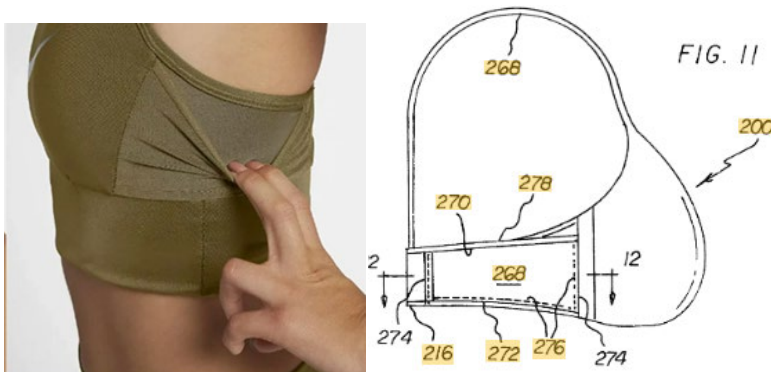
Similarly, the Swoosh Pocket Bra has a side pocket that closely resembles the side pocket portrayed in FIG. 11 of the '016, '551, and '878 patents:



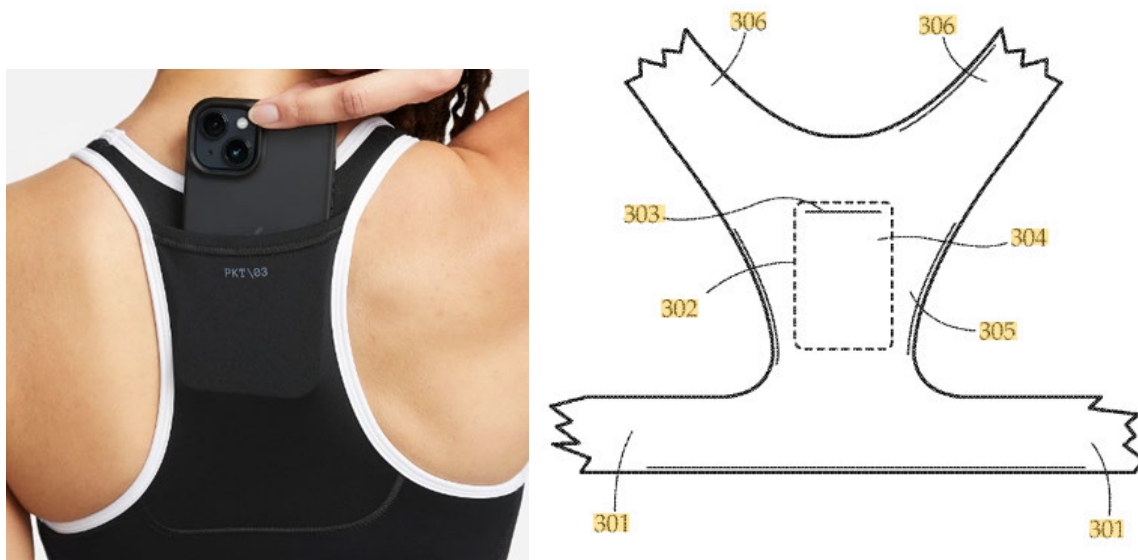
NIKE also makes, uses, offers for sale, sells, and imports a sports bra with pockets titled the “Swoosh Bra.” The Swoosh Bra has a rear pocket that resembles the rear pocket depicted in FIG. 13 of the ‘800 and ‘510 patents:



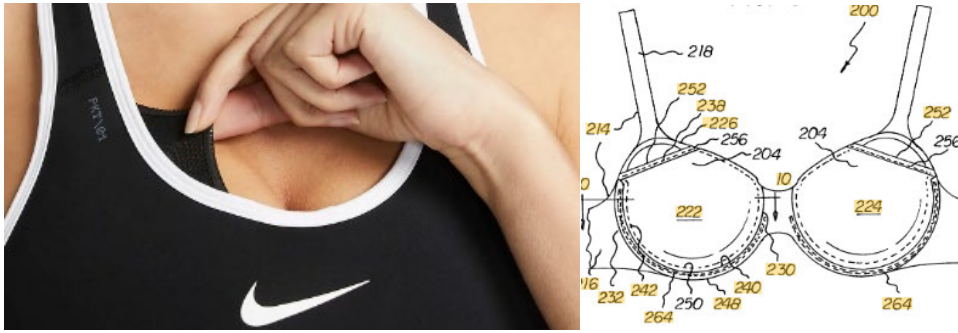
The Swoosh Bra also has a side pocket similar to that depicted in FIG. 11 of the ‘016, ‘551, and ‘878 patents:



NIKE also makes, uses, offers for sale, sells, and imports a sports bra with pockets titled, “Swoosh on the Run.” The Swoosh on the Run has one back pocket and two front pockets. The Swoosh on the Run has some similar features to those depicted in Ms. Goff’s patents. For instance, the back pocket of the Swoosh on the Run is similarly designed and positioned to the back pocket as portrayed in FIG. 13 of the ‘800 and ‘510 patents:



The Swoosh on the Run also has a pocket on the front cup area of the bra similarly to that portrayed in FIG. 9 of the ‘288, ‘036, and ‘550 patents:



There are also significant points of similarity between the above-mentioned NIKE products and the products that Ms. Goff presented to NIKE prior to NIKE's patent filings, as described above. For instance, both the Swoosh Bra and the Swoosh Pocket Bra have back pockets below the shoulder blade region on the respective bras, similarly to one of the sports bras presented by Ms. Goff to NIKE:



Similarly, each of the Swoosh Bra and the Swoosh Pocket Bra has a side pocket similarly positioned to the side pocket in another sports bra example Ms. Goff sent to NIKE:



There are also notable similarities between the products Ms. Goff provided to NIKE and the disclosures of the NIKE patents. For instance, FIG. 6 of patent application 15/597,364 shows a pocket below the shoulder blades on a depicted bra, similarly situated to the back pocket on one of the bras submitted by Ms. Goff:

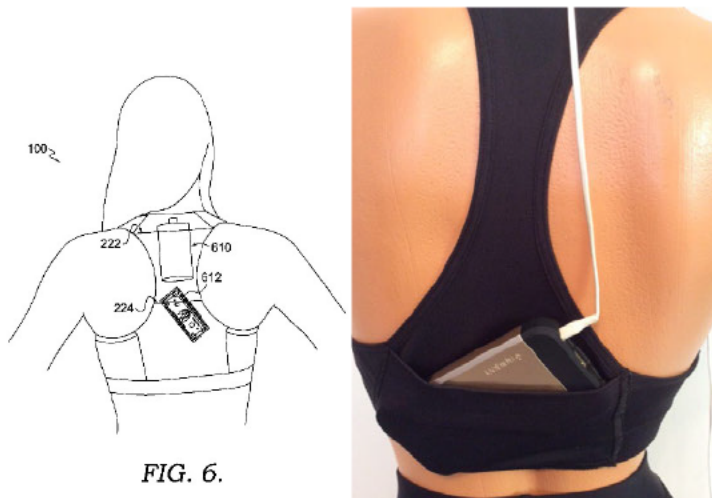


FIG. 5 of the same application depicts a side pocket similar to the side pocket of one of the bras Ms. Goff submitted to NIKE:

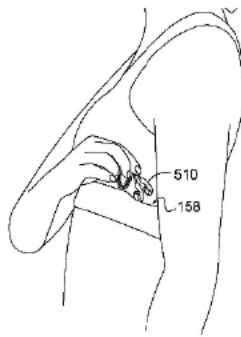
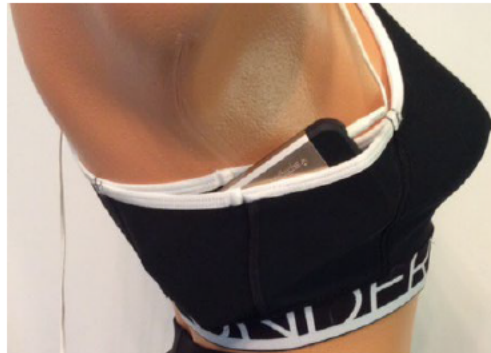


FIG. 5.



In the Copending Case, SherryWear has presented factual allegations indicating that NIKE intentionally copied her designs to produce its product lines and as the basis for its patent applications. NIKE had not yet produced any documentation concerning the initiation of the design process for the above-described products before the Copending Case was stayed. Counsel for SherryWear has also not had the opportunity to depose either Paul Saraceni or the person listed as the inventor on the Nike patents, Nicole Rendon; both depositions had been scheduled before the Copending Case was stayed, but are now on hold pending the outcome of this matter.

In filing the Copending Case, Sherrywear provided claim charts indicating how the claims of the Disputed Patents read on and/or correspond to features of the above-described products. These claim charts are provided herewith as Exhibits SW-2043 through SW-2057. The images provided above of NIKE products are provided herewith as Exhibits SW-2058 through SW-2063.

**III. THE BOARD SHOULD DENY INSTITUTION UNDER § 325(d)
BECAUSE THE PETITION-ASSERTED ART IS SUBSTANTIALLY
THE SAME AS ART CONSIDERED BY THE OFFICE AND
OVERCOME DURING PROSECUTION**

The Board should deny institution because the Petition relies exclusively on art over which the Office allowed the challenged claims during prosecution, or art that adds nothing material to over the art the Office considered. The Board has discretion over whether to institute an *inter partes* review proceeding. *See, e.g., Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding”). In particular, the Board may “reject [a] petition or request, because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Whether the Board rejects a petition as redundant to grounds considered in prosecution follows a two-part framework:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has

demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). In *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, the Board supplied six specific considerations when analyzing the framework laid out in *Advanced Bionics*:

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which the Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential).

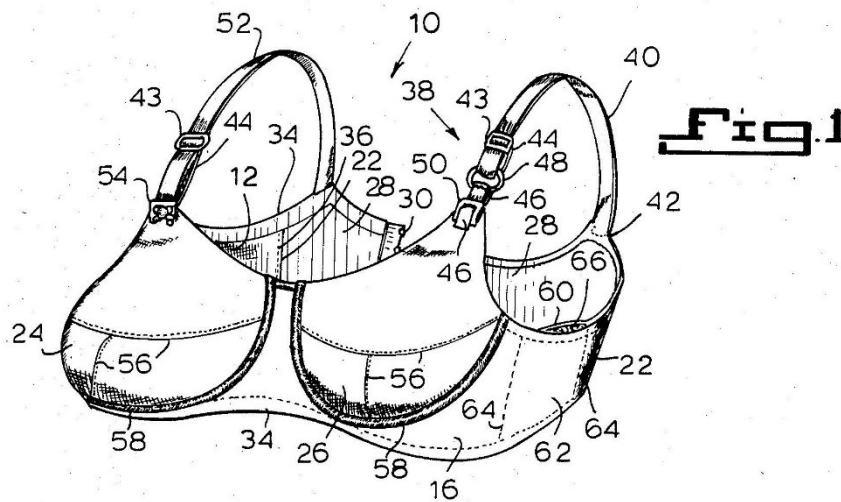
Both the *Advanced Bionics* framework and the *Becton, Dickinson* factors support denial of the Petition. Petitioner raises prior art that was either considered during examination or is cumulative over prior art considered by the Examiner. The Petitioner has not demonstrated that the Examiner committed any material error in allowing the ‘016 patent.

A. The Asserted Art does not Materially Differ from the Art Disclosed During Prosecution.

Material difference is a question of probative difference; where newly introduced art has no “probative differences” over the art considered by the Office, it is substantially the same art. *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 22. (PTAB Dec. 15, 2017) (precedential).

A patent teaching side pockets was considered by the Examiner in the prosecution of the ‘016 patent, and used to reject a claim of a side pocket. The Petitioner observes that Vidal and Handras were not considered during the prosecution of the ‘016 patent. The Petitioner also asserts that, the Newman reference used in the nonfinal rejection of the ‘016 patent appears only to relate to a pocket for storing padding on a bra cup, and is silent on the subject of side pockets. This is true, but totally irrelevant to the reasoning according to which the ‘016 patent was allowed. In the claims as originally filed, the independent claim

did not refer to side pockets, but dependent claim 6 did. The Examiner used a reference, Sherwood (US 4699144) in combination with Newman to reject claim 6. See Exhibit NIKE-1010 at page 116. A copy of Sherwood is provided herewith as exhibit SW-2064. A drawing of Sherwood is included here, showing a side pocket, denoted with reference numeral 66, for insertion of prosthetic materials:



This reference was subsequently distinguished by the Applicant as identifying a “pocket that extends over, under, or onto the cup,” as reflected in a subsequent Examiner interview summary. *Id.* at 130. Applicant subsequently amended claim 1 further to cover a pocket that extends “onto the adjacent cup.” *Id.* at 134. None of the references offered in the Grounds of this Petition probatively distinguish Sherwood. As noted below, the Petitioner argues that the primary reference in Ground 1, Vidal, teaches a pocket that extends “onto the adjacent

cup.” As noted below, this is false: Vidal includes no such teaching. Neither does the primary reference in Ground 2. The Petitioner’s principal argument is that this feature would nonetheless be obvious to a POSA because of their general knowledge pocket shapes and placements. But in that argument, the only teaching, suggestion, or motivation the Petitioner is using from Vidal or Handras is the existence of a side pocket, which is already taught by Sherwood. Therefore, Petitioner is relying on a newly asserted reference “in the same manner as the Examiner relied on” another reference during prosecution; so the the former was not materially different from the latter. *See Advanced Bionics*, Case IPR2019-00975, Paper 6 at 8 (where) Accordingly, neither Vidal nor Handras has a probative purpose beyond the art the Office considered, and thus represent substantially the same art that was already considered during the original prosecution of the ‘016 patent. *See Becton* at 22. The Petitioner also argues that Pintor was considered in the examination of the ‘016 patent, but only as a secondary reference to Newman. This is true, but also largely irrelevant. The Examiner relied on a different reference with respect to side pockets, a matter on which Pintor is entirely silent.

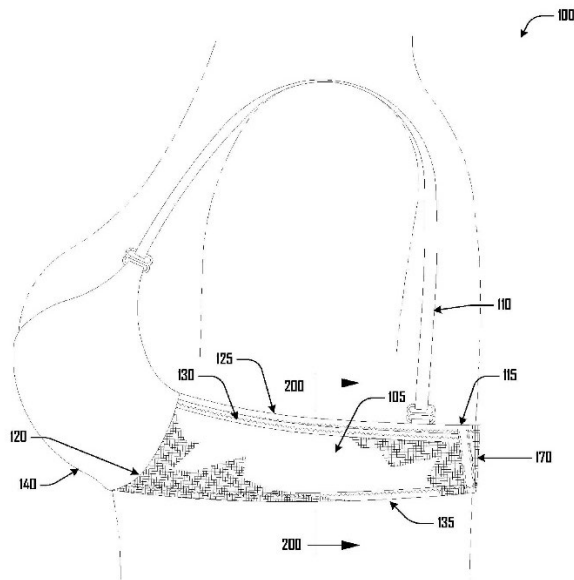
The Petitioner refers to the institution decision in *Oticon* for the proposition that art may not be the same or substantially the same where some asserted patents were considered in examination, while others were not. *See Oticon Medical AB v.*

Cochlear Limited (§ II.B and II.C), Case IPR2019-00975, Paper 15 (Oct. 16, 2019) (Precedential). However, in *Oticon* the Petitioner was able to identify a distinct feature that was present in the newly asserted art and absent from the art the Examiner had not considered, representing “different structures that serve different purposes.” *Id.* at 15. In contrast, the Petitioner here relies on Vidal and Handras for the same structure and purpose the Examiner explicitly considered in Pintor: a pocket designed to removably store items. Thus in contrast to the art presented in *Oticon*, Vidal and Handras are not materially different from the art the Examiner already viewed. *See Advanced Bionics*, Case IPR2019-00975, Paper 6 at 8.

**B. The Petitioner’s Prior Art is Cumulative over the Prior Art
Considered by the Office**

In addition to Pintor, the Examiner considered several other patents and patent applications relating generally to bras with pockets, both as provided in an IDS and as a result of the Examiner’s own searching. As noted above, the Examiner had already considered Sherwood for all elements relied on by the Petitioner to distinguish the asserted patents; the above-described references further render the asserted patents redundant. Nonetheless, it is useful to note that an additional patent was included in the IDS, also depicting a side pocket, albeit not one that extends “onto the adjacent cup.” That reference was Gentry, et al. (US

figure from Gentry, et al. is shown here for reference:



rendering them cumulative to the art already considered.

Manner Material to the Patentability of the Challenged Claims

“erred in a manner material to the patentability of the challenged claims.”

Advanced Bionics at 10. This analysis considers *Becton, Dickinson* factors (c), (e), and, (f): “(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection”; “(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art”; and “(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.” *Becton, Dickinson*, Paper 8 at 17-18. The Petition does not demonstrate that the Office erred in allowing the challenged claims.

Here, the Petitioner argues that the Examiner failed to consider various attributes of Pintor, without explaining how any consideration of Pintor would have aided in identifying a side pocket as obvious. Such an explanation would be needed in this case, as Pintor is silent on the subject of side pockets as noted above. In particular, Petitioner contends that the Examiner would have ruled differently had the Examiner considered Pintor as a “bra with a pocket for storage of personal items, including a cell phone.” However, nothing in claim 1 as allowed relies on “storage of personal items”; if claim 1 was non-obvious, the additional limitations of the dependent claims would of course be irrelevant to the question of obviousness, and analysis thereof could hardly have involved an error which affected the Examiner’s decision.

Petitioner further asserts that Pintor discloses “a bra with left and right cups, shoulder straps, and a chest strap,” and “additionally discloses the bra cups comprised of polyurethane and the pockets made of elastic material.” None of these points are material to the allowance of claim 1, which did not depend on the Examiner failing to find a bra harness, or cups, nor on any material from which the bra in question was constructed.

The Petitioner further claims there was error because that the Examiner “failed to consider how a POSA would have understood Pintor’s disclosures of stitching, polyurethane, elastic material, and use of the pocket for holding of non-padding items, and what a POSA would have been motivated to do with them, especially in combination with Vidal or Handras, which expressly disclose pockets on the chest strap, unlike Newman.” As already noted, the Examiner had already considered a reference that taught a pocket on the chest strap. Beyond that point, the Petitioner’s allegation of error amounts to no more than an invitation for the Board to substitute its judgement for that of the Examiner, and fails to give a reason why the Board should exercise its discretion to do so.

The Petition does not raise any grounds for invalidity not already considered by the Examiner, and Petitioner presents neither argument nor evidence to show that the Office erred in its consideration of the asserted art during prosecution. Further consideration of the Petition merely consumes the Board’s resources to

duplicate the work already done during prosecution. The Board should accordingly deny institution under 35 U.S.C. § 325(d) .

**IV. THE PETITION FAILS TO SHOW A REASONABLE LIKELIHOOD
OF SUCCESS OF EACH OF ITS GROUNDS FOR INVALIDITY**

Even if the Board reaches the merits of Petitioner’s asserted grounds for invalidity, each fails because the prior art fails to disclose, teach, or suggest important claim elements of the ‘016 patent, particularly in light of the evidence of copying by NIKE and other objective indicia.

The question of obviousness is determined according to the *Graham* factors. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). These include (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations of non-obviousness. *Id.* The Petition fails to show a reasonable likelihood of success on the merits because of the differences between the claims and the asserted art in light of significant objective indicia indicating non-obviousness.

**A. Ground 1 Fails to Demonstrate Obviousness over Vidal and
Pintor in Light of the Objective Indicia.**

1. Petitioner Does Not Demonstrate that Vidal in view of Pintor
Teaches, Suggests, or Motivates Each Element of the
Challenged Claims

The Petitioner asserts that Vidal¹ alone renders each element of claim 1 of the ‘016 patent obvious. However, there are elements of claim 1 as claimed that Vidal does not teach, suggest, or motivate. Furthermore, the objective indicia of non-obviousness weigh strongly against the conclusion that a person skilled in the art would consider claim 1.

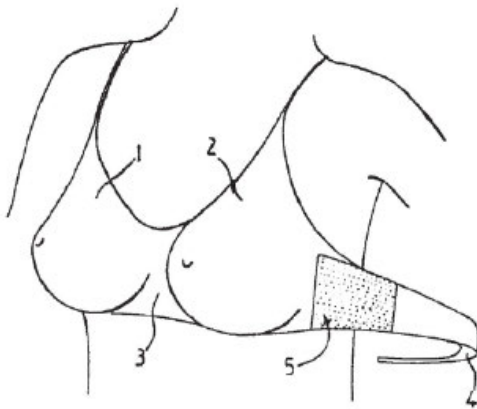
The Petitioner contends that Vidal teaches that “each side pocket extends onto the adjacent cup, such that each pocket spans both a part of the chest strap and the adjacent cup,” because, in the Petitioner’s view, one figure in Vidal appears to demonstrate this limitation, and because the Petitioner sees the Patent Owner’s infringement contentions in the Copending Case as illustrating a similar degree of overlap between the side pocket and the cup. Thus, in the Petitioner’s opinion the

¹ In an apparent translation artifact, the inventor’s name in this document is sometimes rendered “Vidai”; in Espacenet the inventor is listed as “Vidal,” and so that is the name that will be used in this document.

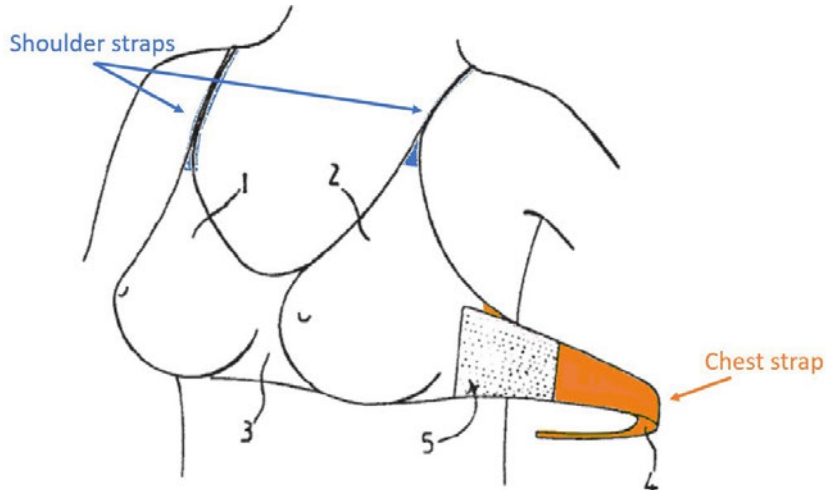
Patent Owner cannot contend that Vidal does not teach this limitation while maintaining that the Petitioner's own products do. This argument is fallacious for several reasons.

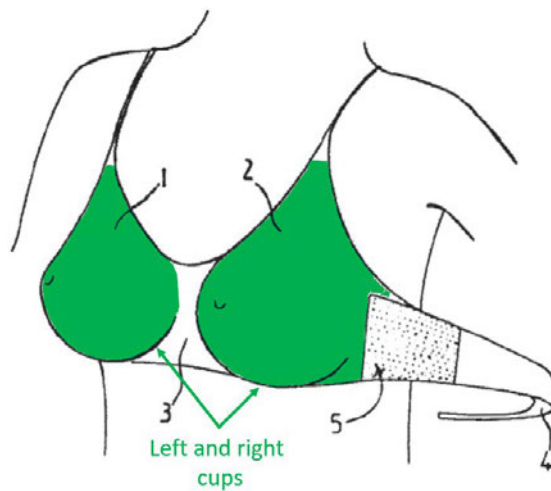
First, the Board is not expected to rule on questions of infringement in this matter. The degree to which the claims of the '016 patent read on the products the Petitioner produced after meeting with Ms. Goff would properly be a question to place before the District Court in the Copending Case. If the Petitioner wished to place the question of obviousness together with the question of infringement before a factfinder, they could do so by proceeding to trial in that case. A juror in the Copending Case would have an opportunity to inspect the Petitioner's products and to evaluate for themselves the degree to which the overlap occurs. They could likewise hear arguments from the Patent Owner and the Petitioner on the subject. None of this is or should be a part of the discussion before the Board.

Vidal contains no explicit teaching whatsoever regarding the relative position of the cup with the side pocket. Unlike the product samples and other details a juror could examine regarding the Petitioner's products, the entirety of the alleged teaching on this point in Vidal depends on a single figure which, while artistically compelling, does not clearly delineate the boundary between the cup and the chest strap:



the Petitioner attempts to aid the Board in finding that delineation through the use of color-coded regions to identify the cup portion of the bra and the strap portion—color-coded regions that support the Petitioner’s contention that the pocket in question crosses that line:





However, nothing in Vidal even implies that the boundary between the chest strap and the cup is where the Petitioner has placed it; the line could just as easily be placed an inch or two closer to the cups. the Petitioner, of course, is currently motivated to put the boundary in that spot, by their desire to match the teachings of Vidal to the claims of the '016 patent. This is a textbook case of impermissible hindsight: reading a teaching that does not exist into a prior art document to complete the elements of an invention. As the Petitioner themselves have contended in their petitions, the area of art this invention occupies represents a crowded field in which inventions are generally not technologically complex. The danger of hindsight is particularly high for this type of invention and should be rigorously eschewed. *See, e.g., Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1379 (Fed. Cir. 2012) (“Where the invention is less technologically complex, the need

for *Graham* findings can be important to ward against falling into the forbidden use of hindsight.”).

This risk of hindsight further infects the Petitioner’s alternative contention, that absent the teaching they have attempted to show, “it would have been obvious to a POSA in light of [Vidal] to slightly extend the length of the pocket onto the bra cup to increase the amount of storage in the pocket,” because a POSA “would have know that different pocket shapes and placements have known benefits and drawbacks.” In other words, any pocket shape or placement would be obvious, in general terms, and this one might be more desirable for reasons of comfort.

Without patents or other printed publications containing such a suggestion or motivation, this amounts to an argument that the placement and shape of pockets—a principal area of innovation in this field—is generally obvious as long as those choices could be said to have some advantage. If that were the case, NIKE themselves would not have succeeded in obtaining patents in this space. This is precisely why it is important to consult objective indicia in a field of this nature: it is otherwise too easy to pretend that any innovation is an obvious design choice in retrospect. *Cf. Mintz*, 679 F.3d at 1379.

Therefore, and for at least this reason, Petitioner has failed to demonstrate that Barg in view of Pintor teaches, suggests, or motivates each element of claim 1. Claims 2-7 depend, directly or indirectly, from claim 1. Accordingly, because the

Petition cannot demonstrate that claim 1 is obvious over Vidal and Pintor, Ground 1 fails on claims 2-7 as well.

2. The Objective Indicia Demonstrate that the Claims of the ‘016 Patent are Not Obvious over Barg in view of Pintor

The non-obviousness of the ‘016 claims is additionally and separately supported by evidence for various objective indicia of non-obviousness. “Objective indicia, or secondary considerations, of non-obviousness can be the “most probative and cogent evidence of non-obviousness.” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2012) , quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). “[O]bjective indicia constitute “independent evidence of nonobviousness.” *Id.*, quoting *Pressure Prods. Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308, 1319 (Fed.Cir.2010). Such evidence “may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Id.*, quoting *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed.Cir.1984).

Objective indicia of obviousness are especially crucial where the nature of the technology and the state of the art give rise to a heightened risk of impermissible hindsight. For example, “differences that may appear technologically minor,” such as a “simple variation on known themes,” are often

better assessed using “[s]uch objective indicia as commercial success, or filling an existing need,” especially in a crowded field. *Cont'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1273 (Fed. Cir. 1991). Likewise, “[w]here the invention is less technologically complex, the need for *Graham* findings can be important to ward against falling into the forbidden use of hindsight.” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1379 (Fed. Cir. 2012) .

NIKE argues at length that bras, pockets, and even bras with pockets have existed for decades. They also refer to the inventive landscape of bras with pockets as “saturated.” They also emphasize the relative simplicity of innovations in this space by quoting Ms. Goff as saying the idea for her invention “seemed pretty obvious” after she had conceived of it. *See* Exhibit SW-2002. This is precisely why objective indicia are so important in this case. NIKE, and Ms. Goff in her offhand comment to a local newspaper, are applying impermissible hindsight to the question of obviousness with regard to a technically simple invention in an old field. “These objective criteria help inoculate the obviousness analysis against hindsight. The objective indicia “guard against slipping into use of hindsight and to resist the temptation to read into the prior art the teachings of the invention in issue.” *Graham v. John Deere Co.*, 383 U.S. 1, 36, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2012) . The pocket bra was not obvious to Ms. Goff prior to her conception of it, and it was not

obvious to NIKE before Ms. Goff revealed her designs to NIKE's representatives. That innovations in pocket bras can be patentable is further demonstrated by the fact that NIKE filed and later obtained at least two patents on pocket bras following their interactions with Ms. Goff.

Objective criteria of non-obviousness can include such factors as evidence of copying of the subject invention, existence of licenses for the patents at issue, evidence of commercial success of the inventions, independent praise of the subject invention, and evidence of long-felt, unresolved need resolved by the subject invention. *Id.* at 1379. Each factor must have some nexus to the patent in question. *Fox Factory Inc. v. SRAM LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019). “The patentee is entitled to a presumption of nexus if evidence of secondary considerations is “tied to a specific product” that embodies and is “coextensive” with the claimed invention. *Id.* “This is true even when the product has additional, unclaimed features.” *PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 734, 747 (Fed. Cir. 2016). Here, the factual record includes substantial evidence for objective indicia, including evidence of copying, licenses to third parties, commercial success, long-felt unresolved need, and industry praise.

a) Copying

“Evidence of copying may include internal documents, direct evidence such as photos of patented features or disassembly of products, or access and similarity

to a patented product.” *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347-48 (Fed. Cir. 2013). Here there is significant evidence that NIKE copied the patented application in the ‘016 patent. NIKE received copies of patents and sample products from Ms. Goff prior to filing its patents or marketing any of the allegedly infringing products. *See* Exhibit SW-2001 at ¶¶ 11-17. Thus, NIKE had access to the patented products. *See Institut Pasteur*, 738 F.3d at 1347-48. As noted above, each of the Swoosh Pocket Bra, the Swoosh Bra, and the Swoosh on the Run has several points of similarity both to the product depicted and described in Ms. Goff’s patents as supplied to NIKE and to the product samples Ms. Goff sent to NIKE. There is also a claim chart showing a high degree of correspondence between features of the Swoosh Pocket Bra and the claims of the ‘016 patent, and another chart demonstrating a high degree of correspondence between the claims of the ‘016 patent and the Swoosh Bra. *See* Exhibits SW-2043 and SW-0248. This, combined with the evidence above, indicates a nexus between the copying and the patented invention. *See Fox Factory Inc.*, 944 F.3d at 1373; *PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d at 747.

There is further evidence of a nexus between NIKE products and patents and the other patents being challenged in the related IPR cases. There are claim charts indicating that the claims of the ‘036 patent read on or are highly coextensive with

the Swoosh on the Run, that the claims of the ‘510 patent read on or are highly coextensive with the Swoosh Pocket Bra, the Swoosh Bra, and the Swoosh on the Run, that the claims of the ‘551 patent read on or are highly coextensive with read on or are highly coextensive with the Swoosh Pocket Bra and the Swoosh Bra, that the claims of the ‘878 patent read on or are highly coextensive with the Swoosh Pocket Bra and the Swoosh Bra, that the claims of the ‘800 patent read on or are highly coextensive with the Swoosh Pocket Bra, the Swoosh Bra, and the Swoosh on the Run, that the claims of the ‘288 patent read on or are highly coextensive with the Swoosh on the Run, and that that the claims of the ‘550 patent read on or are highly coextensive with the Swoosh on the Run. *See* Exhibits SW-2043 through SW-2052 and SW-2054 through SW-2057. Therefore, there is extensive evidence of copying with regard to the ‘016 patent and related patents.

b) Licenses

Further support for the nonobviousness of the ‘016 patent is found in the licenses to competitors of the other patents in its family. “Licenses taken under a patent in suit may constitute evidence of nonobviousness,” provided the patentee demonstrates “‘a nexus between the merits of the invention and the licenses of record.’” *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). A nexus may be presumed, as before, where the product in question is coextensive with the claims

of the patent in question. *Fox Factory Inc. v. SRAM LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) . Here several patents in the ‘016 patent family have also been licensed to [REDACTED] Urban Savage, LLC, Rabbit LLC, and Senita. *See* Exhibits SW-2004 and SW-2007. There are multiple charts linking others of the Disputed Patents to products licensed under the above four licenses. *See* Exhibits SW-2011 through SW-2034. Each license further contains a provision whereby the licensee agrees to mark licensed products with the licensed patents, indicating a nexus between the licenses and the licensed patents.

c) Commercial Success

As further support for the non-obviousness of the ‘016 patent, there is some evidence of commercial success of products linked to the ‘016 patent and the other Disputed Patents. Where there is evidence of commercial success, and the “successful product is the invention disclosed and claimed in the patent, it is presumed that the commercial success is due to the patented invention.” *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997). Here, and as noted above, multiple products licensed under the Disputed Patents remain available for sale, suggesting that those products have been profitable. As noted above, the licensees acknowledged in each license that the licensed products practiced the invention described and claimed in the licensed patents. There is also

evidence that some licensed products described above have generated significant sales revenue. For instance Rabbit, LLC paid a lump sum of \$22,549.22, which amounted to 1% of gross revenues from the licensed products up to that point; Rabbit, LLC thus earned gross revenue in sales of at least 2.25 million dollars with respect to licensed products. SW-2006 at Terms 4.2 and 5.1.

d) Other Objective Indicia

As further support for the non-obviousness of the '016 patent, there is evidence of industry praise for products linked to the '016 patent and the other Disputed Patents. As noted above, at least one industry expert described the Pocket Bra as described and claimed in the Disputed Patents as “genius.” *See* SW-2003. Multiple women also informed Ms. Goff that the Pocket Bra as described and claimed in the Disputed Patents fulfilled a long-standing, unresolved need for improved storage about their person and other uses. *See* SW-2001 at ¶¶ 6 and 7.

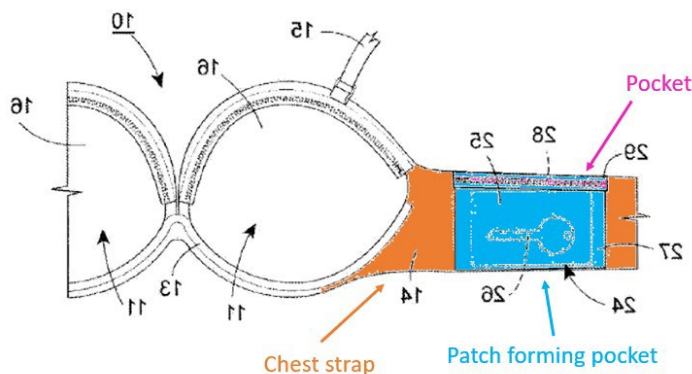
Therefore, and for at least the reasons set forth above, the Petitioner cannot succeed in demonstrating that the claims of the '016 patent are obvious in Ground 1 of the Petition.

B. Ground 2 Fails to Demonstrate Obviousness over Handras and Pintor in Light of the Objective Indicia

1. Petitioner Does Not Demonstrate that Handras in view of Pintor Teaches, Suggests, or Motivates Each Element of Claims 1-7

The Petitioner asserts that Handras alone renders each element of claim 1 of the '016 patent obvious. However, there are elements of claim 1 as claimed that Handras does not teach, suggest, or motivate. Furthermore, the objective indicia of non-obviousness weigh strongly against the conclusion that a person skilled in the art would consider any of claims 1-7 obvious over Handras in view of Pintor.

Handras does not teach, suggest, or motivate a “side pocket [that] extends onto the adjacent cup, such that each pocket spans both a part of the chest strap and the adjacent cup.” NIKE attempts to argue that Handras teaches this limitation, once again comparing it to the infringement contentions in the Copending Case. This contention is accompanied by the following illustration:



In contrast to the Petitioner's contentions regarding Vidal above, this picture does not even purport to teach that the pocket overlaps onto the cup. In contrast to the infringement conditions the Petitioner refers to, there is no reasonable argument that any part of this pocket extends onto the cup, and a finding that NIKE infringed this limitation would in no way compel the conclusion that Handras disclosed it.

Petitioner also argues as before that the markedly different pocket in the '016 patent would have occurred to a person skilled in the art because pocket placement and shapes would be well-known to such a person. Absent any teaching of a pocket so shaped and situated, Patent Owner contends that this is impermissible hindsight, attempting to argue that any innovation in this field is obvious due to its crowded nature and low degree of technical complexity. *Cf. Mintz v. Dietz & Watson, Inc.*, 679 F.3d at 1379.

Therefore, and for at least this reason, Petitioner has failed to demonstrate that Handras in view of Pintor teaches, suggests, or motivates each element of claim 1. Claims 2-7 depend, directly or indirectly, from claim 1. Accordingly, because the Petition cannot demonstrate that claim 1 is obvious over Handras and Pintor, Ground 2 fails on claims 2-7 as well.

2. The Objective Indicia Demonstrate that the Claims of the ‘016 Patent are Not Obvious over Handras in view of Pintor

The non-obviousness of the ‘016 claims is additionally and separately supported by evidence for various objective indicia of non-obviousness. As noted above, “Objective indicia, or secondary considerations, of non-obviousness can be the “most probative and cogent evidence of non-obviousness.” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2012) , quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). “[O]bjective indicia constitute “independent evidence of nonobviousness.” *Id.*, quoting *Pressure Prods. Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308, 1319 (Fed.Cir.2010). Such evidence “may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Id.*, quoting *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed.Cir.1984). Furthermore “differences that may appear technologically minor,” such as a “simple variation on known themes,” are often better assessed using “[s]uch objective indicia as commercial success, or filling an existing need,” especially in a crowded field. *Cont’l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1273 (Fed. Cir. 1991) . Likewise, “[w]here the invention is less technologically complex, the need for *Graham* findings can be

important to ward against falling into the forbidden use of hindsight.” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d at 1379.

Here, and as set forth above for Ground 1, the factual record includes substantial evidence for objective indicia, including evidence of copying, licenses to third parties, commercial success, long-felt unresolved need, and industry praise.

Therefore, and for at least the reasons set forth above, the Petitioner cannot succeed in demonstrating that the claims of the ‘016 patent are obvious in Ground 2 of the Petition.

Petitioner has thus failed to make a prima facie case that it has a reasonable likelihood of success on either Ground 1 or Ground 2, and the Board should accord these Grounds no weight in rendering its institution decision.

V. CONCLUSION

For these reasons, Petitioner has failed to meet its burden to show that it has a reasonable likelihood of success for at least one claim. Patent Owner requests that the Board reject the Petition and deny institution.

Dated: November 13, 2024

Respectfully submitted,
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By its attorneys,

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CERTIFICATION OF COMPLIANCE

This Preliminary Response complies with the word count limitation of 37 C.F.R. § 42.24(b)(1) because, according to the word processing system used to prepare this document, the Petition contains 7,153 words, excluding the cover page, signature block, the exhibit list, and the parts of the Petition exempted by 37 C.F.R. § 42.24(a)(1).

Dated: November 28, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on November 28, 2024, copies of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW UNDER 35 U.S.C. §§ 311-19 AND 37 C.F.R. § 41.100, ET SEQ. were served pursuant to 37 C.F.R. § 42.6 electronically on Petitioner by sending the copies to Nike-SherryWear@kirkland.com.

Dated: November 28, 2024

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