

CONFIDENTIAL – BOARD AND PARTIES ONLY

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,
Petitioner,

v.

SHERRYWEAR LLC,
Patent Owner.

IPR2024-01123
Patent 9,295,288 B1

Before LYNNE H. BROWNE, ZHENYU YANG, and
JON M. JURGOVAN, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Nike, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”), seeking *inter partes* review of claims 1–4, 11, and 12 of U.S. Patent No. 9,295,288 B1 (Ex. 1003,¹ “the ’288 patent”). SherryWear, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7. Both papers contained clerical errors. With our authorization (Exs. 3001, 3004), the parties refiled their respective paper. *See* Paper 8² (“Prelim. Resp.”); Paper 13 (“Pet.”). Also with our authorization (Ex. 3002), Petitioner filed a Reply (Paper 10), and Patent Owner filed a Sur-reply (Paper 11).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons provided below, we determine Petitioner has satisfied the threshold requirement set forth in 35 U.S.C. § 314(a). Accordingly, we institute *inter partes* review of all challenged claims based on all the grounds raised in the Petition.

A. Real Parties in Interest

Petitioner identifies Nike, Inc. as the real party in interest. Pet. 5. Patent Owner identifies SherryWear, LLC as the real party in interest. Paper 4, 1.

¹ Petitioner filed exhibits with only numbers. Any exhibit filed in the future must be given a short, descriptive name in addition to the number. For example, for Exhibit 1003, the description may be “the ’288 patent.”

² Patent Owner filed Paper 8 under seal. It also filed a redacted version of the Preliminary Response. *See* Paper 12.

B. Related Matters

The parties inform us that the '288 patent was asserted in *SherryWear, LLC v. Nike, Inc.*, Case No. 1:23-cv-11599 (D. Mass.). Pet. 5; Paper 4, 1. According to Petitioner, the district court case has been stayed. Paper 5.

Petitioner also filed petitions in IPR2024-01122, IPR2024-01124, IPR2024-01125, IPR2024-01126, IPR2024-01127, IPR2024-01128, and IPR2024-01129, challenging the other patents asserted in the district court. *Id.* n.1.

C. The '288 Patent

The '288 patent relates generally to “a pocket bra system,” and more particularly, “to removably receiving a handheld electronic device while providing support and shape to the breasts of a wearer, the receiving and supporting and shaping being done in a safe, convenient and economical manner.” Ex. 1003, 1:13–18.

The '288 patent explains the need for “a new and improved pocket bra system which may be easily and efficiently manufactured and marketed,” “is of durable and reliable constructions,” is “economically available to the buying public,” and that provides for “removably receiving a handheld electronic device while providing support and shape to the breasts of the wearer.” *Id.* at 2:8–29.

Figure 9 of the '288 patent, reproduced below, shows “a front elevational view of a pocket bra system constructed” to removably receive a handheld electronic device while providing support and shape to the breasts of the wearer. *Id.* at 2:65–67.

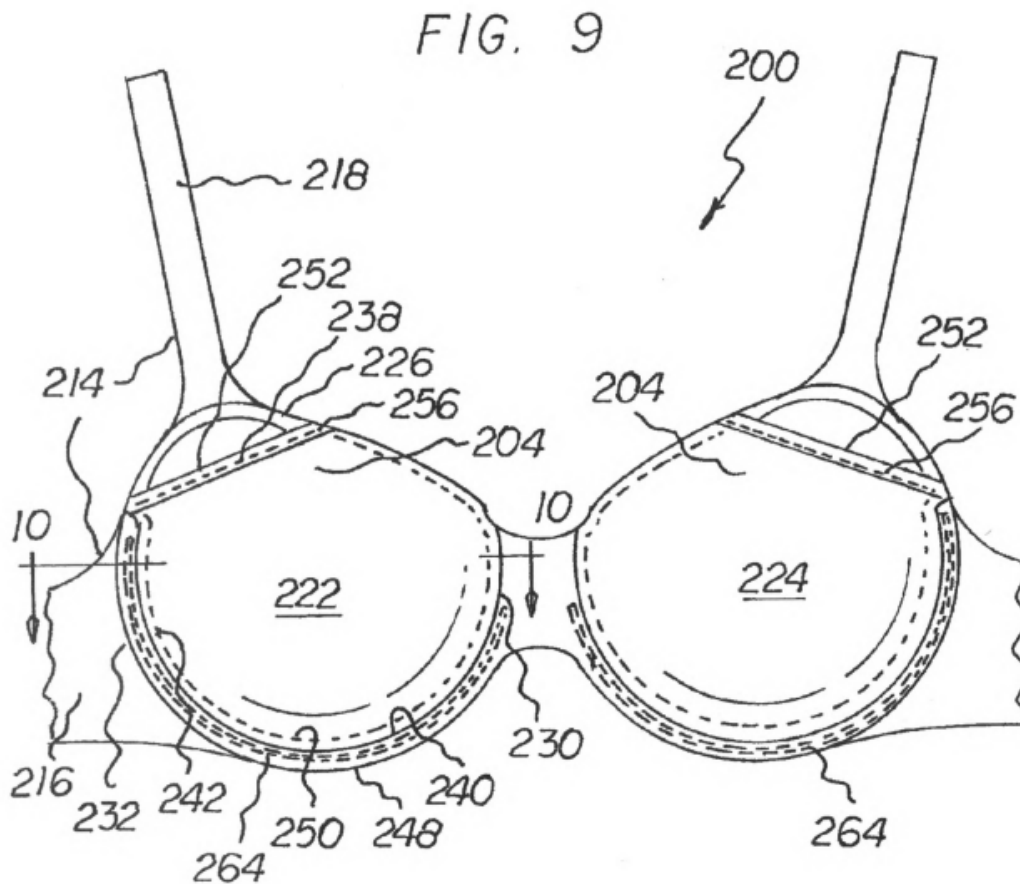


Figure 9, reproduced above, depicts “a pocket bra system 200,” with “a strap assembly 214 . . . formed of a chest strap 216 and shoulder straps 218,” “left and right cups 222, 224” that are attached to the strap assembly, and a “patch 236 [that] is operatively associated with each cup,” using “[s]titching 250 [that] couples the lower, interior and exterior edges of each patch to the lower, interior and exterior edges of an associated cup.” *Id.* at 4:43–61. The ’288 patent describes that “[p]ockets 260 are formed between the patches and the cups,” and that both the cups and pockets are “preferably fabricated of a resilient closed cell polyurethane foam with a thickness of from 2 to 4 millimeters.” *Id.* at 4:66–5:4. The pockets are intended for the placement of the handheld electronic device 46. *Id.* at 5:5–6.

D. Illustrative Claim

Of the challenged claims, claim 1 is independent. Claim 1 is illustrative of the claimed subject matter and is reproduced below.

1. A bra pocket system combination comprising:

a strap assembly including a chest strap and shoulder straps; left and right cups, each cup having inside and outside surfaces, the strap assembly being attached to the cups whereby the strap assembly adheres the cups to a wearer, each cup having curved upper, lower, interior body facing and opposite exterior edges;

a patch forming a pocket operatively associated with each cup, each patch having a linear upper edge and curved lower, interior body facing, and opposite exterior edges, each patch having inside and outside surfaces; stitching coupling the lower, interior body facing and opposite exterior edges of each patch to the lower, interior body facing, and opposite exterior edges of an associated cup;

a linear opening formed along the upper edge of each patch;

at least one of a handheld electronic device, keys, and pills removably positioned within the pocket of at least one of the left and right cups; and

wherein each patch curved lower interior body facing and opposite exterior edges are aligned with each curved lower interior body facing and opposite exterior edges, and wherein the stitching is along the curved lower interior body facing and opposite exterior edges of the patch, the linear upper edge of each patch crossing over a surface of the cup to form the linear opening.

Ex. 1003, 5:39–63.

E. Asserted Challenge to Patentability

Petitioner asserts the following challenge to patentability:

Claims Challenged	35 U.S.C. § ³	References
1–4, 11, 12	103	Barg, ⁴ Pintor ⁵
1–4, 11, 12	103	York, ⁶ Pintor
1–4, 11, 12	103	Handras, ⁷ Pintor

As support for its patentability challenge, Petitioner relies on the Declaration of Joyce Baran (Ex. 1001).

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe a claim term “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b) (2020). Under that standard, the words of a claim “are generally given their ordinary and customary meaning,” which is “the meaning that the term would have to

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. On its face, the ’288 patent claims priority, as a continuation-in-part, to an application filed before the effective date of AIA. Ex. 1003, code (63). Petitioner argues that the ’288 patent claims are “only entitled to priority of the filing date of the ’288[patent]—November 18, 2013—as PO concedes.” Pet. 6 (citing Ex. 1049). At this stage of the proceeding, Patent Owner does not dispute Petitioner’s assertion of the priority date. *See generally* Prelim. Resp. Accordingly, we apply the AIA version of § 103. Our analysis does not substantively depend on which version of the statute is applied.

⁴ Barg, US 3,518,998, issued July 7, 1970 (Ex. 1019, “Barg”).

⁵ Pintor et al., US 7,753,759 B2, issued July 13, 2010 (Ex. 1022, “Pintor”).

⁶ York, US 2,920,628, issued Jan. 12, 1960 (Ex. 1020, “York”).

⁷ Handras, US 2014/0051331 A1, published Feb. 20, 2014, filed Aug. 20, 2012 (Ex. 1021, “Handras”).

a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Neither Petitioner nor Patent Owner asserts that the Board needs to construe any particular terms to address the challenges raised in the Petition. *See generally* Pet.; Prelim. Resp.

On this record, we determine that no explicit claim construction is necessary for this decision. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms that . . . are in controversy, and only to the extent necessary to resolve the controversy.’”).

B. Level of Ordinary Skill in the Art

Petitioner asserts that “[a] POSA at the relevant time would have had at least two years of experience working in the design and or/construction of women’s exercise apparel, intimate apparel, and/or sports bras and bras, specifically,” and that “[f]ormal education in a relevant field, such as fashion and textile design, may compensate for less experience.” Pet. 17.

Patent Owner does not, at this point, dispute this proposed definition of the ordinarily skilled artisan. *See generally* Prelim. Resp.

For purposes of this Decision, we adopt Petitioner’s definition of the person of ordinary skill in the art as it appears consistent with the skill level reflected in the prior art of record and the disclosure of the ’288 patent.

C. Prior Art Disclosures

At this stage of the proceeding, Patent Owner does not dispute that the references asserted by Petitioner and discussed below qualify as prior art. *See generally* Prelim. Resp.

1. Barg

Barg relates to “a brassiere that has a pocket therein for storing valuables.” Ex. 1019, 1:18–20. Barg describes a brassiere with “an outer and inner portion to form the breast cups, which portions are equipped with a sealing means at their upper edges” that do “not interfere with the smooth outer and inner surface of the parts,” and “a top opening to provide a pocket.” *Id.* at 1:24–33.

Barg accomplishes this with the breast cups consisting of an outer section and inner section, which sections are attached to each other “along a peripheral edge at the side and bottom areas,” and which upper portions “support a hookless fastener,” and the “upper edges of the” outer and inner sections “form an area to form a pocket 23 when the hookless fastener 22 is opened.” *Id.* at 2:5–17. An example of a hookless fastener is a zipper. *Id.* at 2:17.

2. Pintor

Pintor relates to “brassieres containing concealed pockets for storing cell phones and other objects.” Ex. 1022, 1:19–21. Pintor discloses apparel “for wearing in contact with the breasts of a wearer to securely hold and conceal objects therein through the use of a pocket positioned in a manner that results in objects inside the pocket pressing breast tissue on the upper lateral side of the breast,” such that “the fatty breast tissue typically can be readily and comfortably deformed away from the object to minimize the visible bulk caused by the concealed objects, resulting in a natural appearance of the breast while compressed by the concealed objects.” *Id.* at 2:21–29.

Pintor describes that the “pocket 30 is provided on the interior surface 16A of a first breast cover 12A,” and “has a mouth 32 near the upper boundary 24 of the breast cover 12A of the article 10, with the mouth 32 accessible to a hand . . . reaching into the breast cover 12A between the shoulder strap 26A and the medial portion 22 of the article 10.” *Id.* at 5:37–42. Pintor describes that a “majority of the pocket 30 is positioned toward the lateral side 50A of the breast cover 12A.” *Id.* at 5:45–46.

3. York

York relates to “a brassiere in which is incorporated a pocket on the interior lower surface of the usual breast cup for receiving valuable articles such as jewelry, money or the like.” Ex. 1020, 1:15–19. York describes providing “a pocket in the breast cup of a brassiere” that is “formed by a polygonal member having the major portion of its periphery stitched to or otherwise secured to the inner surface of the breast cup” with “the upper edge thereof free and being detachably connected to the inner surface of the breast cup by virtue of a separable fastening element such as a snap fastener.” *Id.* at 1:20–27.

4. Handras

Handras relates to “a bra with one or more storage pockets.” Ex. 1021 ¶ 1. Handras describes “a bra comprised of a pair of cups wherein each cup is of multi-ply construction with a built-in pocket” that is “a concealed pocket” for “receiving one of more items” and “that does not present any aesthetically displeasing bulges due to the presence of one or more items in the pocket.” *Id.* ¶¶ 3–6.

D. Discretionary Denial

Institution of an *inter partes* review is discretionary. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (explaining that because 35 U.S.C. § 314 includes no mandate to institute review, “the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion”); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (stating that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”).

Under 35 U.S.C. § 325(d), in determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Our § 325(d) analysis employs a two-prong framework: (1) whether the arguments presented in the petition are the same or substantially the same as those previously presented to the Office; and (2) if so, whether the petitioner has demonstrated a material error by the Office in its prior consideration of those arguments. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (“*Advanced Bionics*”), 8 (PTAB Feb. 13, 2020) (precedential).

Patent Owner argues that we should exercise our discretion to deny institution under § 325(d). Prelim. Resp. 13–20; Sur-reply 1–6. Petitioner disagrees. Pet. 97–100; Reply 1–7. Below, we first review the prosecution history of the ’288 patent before evaluating the parties’ arguments.

1. Prosecution History of the '288 Patent

During prosecution, the examiner rejected the then-pending claims, among others, over Newman⁸ in view of Pintor. Ex. 1004, 151–52. The examiner states that Newman teaches all the limitations of then-pending claim 1, except “Newman does not disclose the pocket as holding the claimed items therein.” *Id.* at 151. According to the examiner, Pintor teaches this limitation and “it would have been obvious to one having ordinary skill in the art to store any item they desired in the brassiere pocket such as those claimed and as disclosed in Pinto[r].” *Id.* at 152.

In response, the applicant argued that “the pockets of Newman are specifically sized and formed to only accept a bra padding.” *Id.* at 173. According to the applicant, because “Newman’s focus is singular and its pocket is specifically sized for the bra pad only. . . Newman would not operate as intended based on the proposed combination.” *Id.* The applicant further contended that “the proposed combination would not be obvious to one having skill in the art because of the differing fields of operations between the padded bra and storage pocket.” *Id.* at 173–74. The applicant also amended the claims “primarily to correct matters of form and/or clarity.” *Id.* at 167–69, 172. Thereafter, the examiner allowed the claims. *Id.* at 187.

2. Analysis

Petitioner points out that Barg, York, and Handras were not considered during the prosecution of the '288 patent. Pet. 97. Patent Owner does not dispute this aspect of Petitioner’s argument. *See* Prelim. Resp. 15. Patent Owner contends, however, that Petitioner’s “newly introduced art has

⁸ US 2005/0037687 A1, published Feb. 17, 2005 (Ex. 1023, “Newman”).

no ‘probative differences’ over the art considered by the Office.” *Id.*

According to Patent Owner,

Petitioner argues that the probative value of each of Barg, York, and Handras over the art considered during prosecution is in disclosing “bras designed to store personal belongings,” which the Petitioner characterizes as the key point of distinction during examination. However, the Petitioner then proceeds to note that “the Examiner acknowledged Pintor’s disclosure of a handheld electronic device stored in a bra pocket.” In other words, the Office did explicitly consider a prior art reference (Pintor) for precisely the probative purpose the Petitioner now ascribes to Barg, York, and Handras Therefore, neither Barg, York, nor Handras has a probative purpose beyond the art the Office considered. Accordingly, Barg, York, and Handras represent substantially the same art that was already considered during the original prosecution of the ‘288 patent.

Id. at 16.

Petitioner responds that “Barg, York, and Handras are materially different from Pintor, and are not cumulative of Pintor” or the other patents and patent applications Patent Owner points to. Reply 1. According to Petitioner, “Barg, York, and Handras are each far more pertinent than Pintor,” and they “disclose exactly what the Applicant argued was not taught by Newman, Pintor, or the combination of Newman and Pintor.” *Id.* at 2–3.

For purposes of this Decision, we need not address in detail whether the references asserted in the Petition are substantially the same as Pintor, the art previously presented to the Patent Office.⁹ As discussed below, even

⁹ Patent Owner further asserts that 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, including U.S. 7,585,200 to McLaren, and U.S. 5,496,205 to Lee.” Prelim. Resp. 17. In a single sentence, Patent Owner states that “McLaren was considered by the examiner in a rejection of claim 10.” *See id.* Patent Owner

if the asserted references are substantially the same, we are persuaded Petitioner has demonstrated, under the second part of the *Advanced Bionics* framework, that the Office erred in a manner material to the patentability.

To determine whether Petitioner has sufficiently shown material error, we look at, for example, “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” *Advanced Bionics*, 9. As explained above, during prosecution of the ’288 patent, the examiner rejected the then-pending claims over Newman in view of Pintor. Ex. 1004, 151–52. Petitioner argues, however, that the examiner considered Pintor “only as a secondary reference to Newman.” Pet. 98. According to Petitioner, the examiner “overlooked how a POSA would have understood Pintor’s disclosures and what a POSA would have been motivated to do with them, especially in light of references like Barg, York, and Handras.” *Id.* at 9.

Patent Owner argues that the examiner did not err materially. Prelim. Resp. 18–19. Specifically, Patent Owner contends that the examiner “did consider the materially important element of a pocket configured to house removable items.” *Id.* at 18. Patent Owner points out that Newman “sufficed to demonstrate the chest strap, shoulder straps, cups, and elastic material claimed.” *Id.* at 19. According to Patent Owner, it was not error for the examiner, “having established the presence of those elements” in Newman, “to fail to repeat their existence” in Pintor. *Id.*

does not address the relevance of Lee. *See generally* Prelim. Resp. Such a bare bone assertion is insufficient to show those other patents and patent applications are cumulative to the prior art asserted in the Petition.

On this record, we find Petitioner’s argument more persuasive. Patent Owner does not dispute 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.”

Prelim. Resp. 18. The examiner, however, relied on Pintor for teaching a single limitation when rejecting the pending claim 1 as obvious over the combination of Newman and Pintor. Ex. 1004, 152 (stating that Pintor “discloses a brassiere with a pocket that holds the claimed items therein”). For all the other limitations, the examiner relied on Newman’s teaching. *Id.* at 151. Patent Owner is correct that, for that rejection, the examiner did not have to repeat Pintor’s teachings of the limitations taught in Newman. The examiner, however, failed to consider Pintor’s teaching in its entirety after the applicant distinguished the pending claim over Newman. *Id.* at 173 (“Newman’s focus is singular and its pocket is specifically sized for the bra pad only. . . Newman would not operate as intended based on the proposed combination.”). That, in our opinion, is material error.

We also find persuasive Petitioner’s argument that the examiner “overlooked how a POSA would have understood Pintor’s disclosures and what a POSA would have been motivated to do with them, especially in light of references like Barg, York, and Handras.” Pet. 9. In this respect, Petitioner offers the testimony of Joyce Baran (Ex. 1001) as additional evidence to “provide[] 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 Barg, York, Handras, and Pintor including how to modify such disclosures to achieve a desired design.” Reply 6.

In sum, we agree with Petitioner that by considering Pintor only in combination with Newman, the examiner materially erred in allowing the challenged claims. *See* Pet. 9. As a result, we decline to exercise our discretion to deny institution.

E. Alleged Obviousness over Barg and Pintor

Petitioner asserts that claims 1–4, 11, and 12 would have been obvious over the combination of Barg and Pintor. Pet. 22–48. Based on this record, and for at least the following reasons, we determine Petitioner has established a reasonable likelihood that it would prevail in this assertion.

We focus our analysis on independent claim 1. Petitioner provides detailed analysis to support its argument that the combination of Barg and Pintor teaches or suggests each limitation of claim 1. Pet. 22–38. Petitioner also contends that an ordinarily skilled artisan would have been motivated combine the teachings of the two references and would have had a reasonable expectation of success in doing so. *Id.* at 46–48.

Patent Owner contends that (1) Barg fails to disclose a linear upper edge, and Petitioner’s argument that a linear upper edge is obvious over Barg as an obvious design choice employs impermissible hindsight; (2) Pintor teaches away from combination with Barg or similar designs; and (3) objective indicia demonstrate the non-obviousness of the asserted claims. Prelim. Resp. 21–32.

Based on the current record, we find Petitioner’s argument persuasive, and for purposes of institution, we adopt the analysis as our own. Pet. 22–38, 46–48. We address Patent Owner’s counterarguments below.

1. Alleged Impermissible Hindsight

Claim 1 recites “a patch forming a pocket operatively associated with each cup, each patch having a linear upper edge.” It is undisputed that Barg does not teach the “linear upper edge.” *See* Pet. 29–30 (Petitioner acknowledging that Barg teaches a patch with a curved “upper edge”).

Petitioner argues that an ordinarily skilled artisan “would have understood there to be a finite number of edge designs for the patches,” and “would have further understood the degree of curvature of the edge of the patch to be a simple choice of design.” *Id.* at 30 (citing Ex. 1001 ¶ 178; Ex. 1022, 6:6–10). According to Petitioner, “straight” or “linear” pocket edges were well known. *Id.* at 31 (citing Ex. 1001 ¶ 179; Ex. 1022, 6:6–10; Ex. 1025, Fig. 2).

Importantly, Petitioner does not solely rely on the design-choice argument. Instead, Petitioner refers to Pintor for “expressly disclos[ing] a patch on the breast cups with a ‘substantially straight’ opening.” *Id.* (citing Ex. 1022, 6:6–10, Figs. 1, 2, 4, 7). Indeed, Pintor teaches that “[t]he shape of the [pocket opening] 32 is typically determined by the shape of the side 34D, which may be concave, as shown in FIG. 2, or may be substantially straight, convex, or have any combination of curved or linear components defining an aesthetically pleasing design.” Ex. 1022, 6:6–10.

Petitioner argues that an ordinarily skilled artisan “would have been motivated to make the top edge of the patch linear for secure holding of a rectangular item, such as an electronic device or rectangular key, ensuring the item is held snugly within.” Pet. 31 (citing Ex. 1001 ¶ 180). Petitioner further asserts that a linear upper edge would “help ensure the pocket’s visibility is obscured by the cup.” *Id.* (citing Ex. 1001 ¶ 180).

In sum, Petitioner relies on specific teaching in Pintor and un rebutted testimony of Ms. Baran to support its argument that an ordinarily skilled artisan would have had a reason to modify Barg’s patch with a curved upper edge to a linear upper edge. On this record and for purposes of this Decision, we find Petitioner does not resort to impermissible hindsight.

2. Alleged Teaching Away

Patent Owner contends that “Pintor teaches away from combination with Barg or similar designs.” Prelim. Resp. 23. Patent Owner argues that

In its “Description of Related Art” Pintor states that “brassieres with...pockets sewn into the front of the cups” are undesirable because they “cause the objects stored in the brassiere to become visible under clothing,” while “pockets covering much of the interior surface of the cups” are given as an example of a solution that “may not be optimally designed to secure various concealed objects, and may not provide a suitable aesthetic appearance with pockets that are adapted to conceal bulk by their position, angle and construction.”

Id. (citing Ex. 1022, 1:31–50). According to Patent Owner, “Barg can be interpreted” as “either or both of these disparaged categories of pocket bras.”

Id. Thus, Patent Owner concludes that “Pintor is critical of the design in Barg, and would teach a person skilled in the art away from combining the invention of Barg with the invention of Pintor.” *Id.* We are not persuaded by Patent Owner’s argument.

First, Barg emphasizes that its pocket for valuables is “no[t] conspicuous on the surface of the brassiere’s breast cups” and “will not be noticeable in the general appearance of the brassiere when in use.” Ex. 1019, 1:42–44, 2:19–20. In addition, Barg states that the construction of its pocket “may be varied in many ways without effecting the operativeness.” *Id.*

at 2:27–29. Thus, Barg does not appear to have the “visible under clothing” issue Petitioner points out.

Second, a reference 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.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). The mere disclosure of alternative designs, however, does not teach away, and “just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes.” *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012).

Here, as Patent Owner recognizes (Prelim. Resp. 23), Pintor merely states that “the position, size, angle and configuration of previously proposed pockets *may not be optimally designed*.” Ex. 1022, 1:45–47 (emphasis added). In other words, although Pintor points out certain shortcomings of prior-art pocket bras, it does not “criticize, discredit, or otherwise discourage the solution claimed.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

On this record and for purposes of this Decision, Patent Owner has not shown sufficiently that the references cited here discourage an ordinarily skilled artisan from modifying Barg’s patch having a curved upper edge with Pintor’s patch having a linear upper edge.

3. Objective Indicia

Patent Owner contends that various objective indicia demonstrate that the challenged claims would not have been obvious over the combination of Barg and Pintor. Prelim. Resp. 24–31. At this stage of the proceeding, Petitioner has not had any opportunity to address the evidence of objective

indicia. We encourage the parties to address these factual issues to fully develop the record during trial. Moreover, on this record and for the reasons explained below, we are not persuaded by Patent Owner’s argument.

a. Legal Standard

Objective evidence of non-obviousness “may often be the most probative and cogent evidence in the record” and “may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012). Thus, notwithstanding what the teachings of the prior art would have suggested to one skilled in the art, objective indicia may lead to a conclusion that the challenged claims would not have been obvious. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). Thus, our obviousness analysis includes consideration and weighing of Patent Owner’s evidence of objective indicia.

In order to accord substantial weight to objective indicia in an obviousness analysis, the evidence “must have a ‘nexus’ to the claims, *i.e.*, there must be ‘a legally and factually sufficient connection’ between the evidence and the patented invention.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019) (quoting *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988)); *Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.*, 24 F.4th 1406, 1417 (Fed. Cir. 2022).

A patent owner bears the initial burden of proving a nexus. *WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1359 (Fed. Cir. 1999). A presumption of nexus may be appropriate if the patent owner shows “the asserted objective evidence is tied to a specific product and that product

‘embodies the claimed features, and is coextensive with them.’” *Polaris Indus, Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)); *Quanergy*, 24 F.4th at 1417. On the other hand, when the product “is not coextensive with the patented invention—for example, if the patented invention is only a component of a commercially successful machine or process,” the patent owner is not entitled to a presumption of nexus. *Demaco*, 851 F.2d at 1392.

A patent owner may establish nexus, either through (1) the use of a rebuttable presumption that arises when certain conditions are met or (2) a direct showing of nexus.

A patent owner is entitled to a rebuttable presumption of nexus if the patentee shows that the asserted evidence is tied to a specific product and that the product “is the invention disclosed and claimed.” 851 F.2d at 1392 (emphasis added). That is, presuming nexus is appropriate “when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘embodies the claimed features, and is coextensive with them.’” *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)).

Fox Factory, Inc. v. SRAM LLC, 944 F.3d 1366, 1373 (Fed. Cir. 2019).

Whether a product is coextensive with the patented invention, and therefore whether a presumption of nexus is appropriate in a given case, is a question of fact. *Id.*

The court in *Fox Factory* further explained, with respect to a presumption of nexus, that “the degree of correspondence between a product and a patent claim falls along a spectrum,” and that “[a]lthough we do not require the patentee to prove perfect correspondence to meet the

co-extensiveness requirement, what we do require is that the patentee demonstrate that the product is essentially the claimed invention.” *Id.* at 1374.

The court in *Fox Factory* rejected the patent owner’s argument that the co-extensiveness requirement is simply an inquiry into “whether the patent claims broadly cover the product that is the subject of the evidence of” objective indicia. *Id.* at 1377. Thus, simply showing that a patent claim broadly covers the commercial product being asserted as objective evidence of non-obviousness is not enough to show they are coextensive. *Id.* That is because “[a] patent claim is not coextensive with a product that includes a ‘critical’ unclaimed feature that is claimed by a different patent and that materially impacts the product’s functionality.” *Id.* at 1375.

In contrast, “if the unclaimed features amount to nothing more than additional insignificant features, presuming nexus may nevertheless be appropriate.” *Id.* at 1374. Nexus may not be presumed if “there are one or more features not claimed by the [challenged patent] that materially impact the functionality” of the products on which patent owner’s presumption argument is based. *Id.* at 1376–1377.

“A finding that a presumption of nexus is inappropriate,” however “does not end the inquiry” into objective indicia. *Id.* at 1373. “To the contrary, the patent owner is still afforded an opportunity to prove nexus by showing that the evidence of [objective indicia] is the ‘direct result of the unique characteristics of the claimed invention.’” *Id.* at 1373–74 (quoting *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996)). Where the offered objective indicia “actually result[] from something other than what is both claimed and *novel* in the claim, there is no nexus to the merits of the claimed invention,”

meaning that “there must be a nexus to some aspect of the claim not already in the prior art.” *In re Kao*, 639 F.3d 1057, 1068–69 (Fed. Cir. 2011).

Ultimately, we must weigh a patent owner’s objective evidence in the context of whether the claimed invention as a whole would have been obvious to a skilled artisan. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1331–32 (Fed. Cir. 2016). Only if the patent owner presents a *prima facie* case of nexus does the burden of production shift to the patent challenger to adduce evidence showing that any commercial success or industry praise was due to extraneous factors other than the patented invention. *Demaco*, 851 F.2d at 1393.

b. Evidence Related to Nike Products

Patent Owner argues that “the claims of the ‘288 patent read on or are highly coextensive with [Nike’s] Swoosh on the Run.” Prelim. Resp. 28 (citing Exs. 2043–2052, 2054–2057). The evidence, however, do not support a conclusion that Nike’s Swoosh on the Run is coextensive with the ‘288 patent’s claimed invention. Indeed, Patent Owner submits claim charts allegedly showing that Nike’s Swoosh on the Run infringes not only the ‘288 patent (Ex. 2054), but also four other patents in the family (Exs. 2053, 2055–2057). Those other claim charts demonstrate that Swoosh on the Run includes many features not claimed in the ‘288 patent. *See e.g.*, Ex. 2055 (showing Swoosh on the Run has a back pocket). Thus, on this record, Patent Owner has not persuasively shown a rebuttable presumption of nexus between Nike’s Swoosh on the Run and the challenged claims.

Patent Owner asserts that “there is significant evidence that NIKE copied the patented application in the ‘288 patent.” Prelim. Resp. 27. According to Patent Owner, “NIKE received copies of patents and sample

products from [the named inventor of the '288 patent] Ms. Goff prior to filing its patents or marketing any of the allegedly infringing products.” *Id.* Patent Owner alleges that “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.” *Id.* Ms. Goff testifies that she corresponded with Nike about her Pocket Bar and submitted examples of her products. *See* Exs. 2001, 2035. Patent Owner also relies on the Swoosh on the Run infringement claim chart as allegedly showing that Nike copied the '288 patent’s claimed invention. Prelim. Resp. 27 (citing Ex. 2054¹⁰).

Patent Owner’s evidence, however, does not sufficiently demonstrate that a specific product was replicated. *See Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004) (“[C]opying requires the replication of a specific product.”). In addition, neither Ms. Goff’s testimony nor the Nike Idea Submission is specific to the '288 patent’s claimed invention. *See generally* Exs. 2001, 2035. For example, none of the pictures in the Nike Idea Submission sufficiently shows certain feature of the '288 patent’s claimed invention, which includes “a patch forming a pocket operatively associated with each cup, each patch having a linear upper edge.” *See, e.g.*, Ex. 2035, 2–4. On this record, Patent Owner has not presented sufficient evidence of copying.

¹⁰ Patent Owner cites Ex. 2053. Prelim. Resp. 27. That exhibit, however, is “‘036 Swoosh on the Run Chart,” and not related to the '288 patent. *Id.* at vii. For purposes of this Decision, we deem the error harmless and consider the correct exhibit, i.e., Exhibit 2054. We, however, request the parties strive to provide accurate citations in future submissions.

c. Evidence Related to Ms. Goff's Pocket Bra

Patent Owner contends that Ms. Goff's Pocket Bra is co-extensive with the '288 patents claimed invention. *See generally* Prelim. Resp. 1–3, 28–31. Patent Owner, however, states that there are multiple variants of Sharon Goff's Pocket Bra. Prelim Resp. 1 (“Ms. Goff invented several variations of bras with pockets, which are collectively referred to herein as variants of the Pocket Bra.”). Patent Owner's evidence of objective indicia, however, appears to relate to variations of the Pocket Bra that do not include the '288 patent's claim invention. *See* Prelim. Resp. vi (showing Exhibits 2008–2034 do not relate to the '288 patent). Thus, based on the record at this stage of the proceeding, we do not apply a presumption of nexus between the '288 patent's claimed invention and Ms. Goff's Pocket Bra.

Patent Owner argues that “[f]urther support for the nonobviousness of the '288 patent is found in the licenses to competitors of the '288 patent and other patents in its family.” Prelim. Resp. 3, 28–31 (citing Ex. 2004–2007, 2008–2034). In particular, Patent Owner points to licenses to Urban Savage, LLC, Rabbit LLC, and Senita.¹¹ *Id.* at 3, 33. Patent Owner asserts that a nexus exists because the licensees agree to mark their products with the licensed patents. *Id.* at 29.

None of the licenses, however, is for the '288 patent. *See* Ex. 2004, 9; Ex. 2006, 8; Ex. 2007, 7. Patent Owner contends that U.S. Patent No. 9,808,036, one of the patents licensed to Senita “has claims that are

¹¹ Patent Owner points to two other licenses but does not provide as evidence a copy of those license. *See* Prelim. Resp. 3; Paper 9, 1 (showing that Patent Owner sought to expunge Exhibit 2005, an allegedly confidential license). We cannot consider evidence not made of record.

closely related to the '288 patent, and mostly coextensive therewith.” Prelim. Resp. 29. We give this unsupported attorney argument little weight. Thus, on this record, we are not persuaded that there is a nexus between the licenses and a unique feature of the '288 patent's claimed invention and that the evidence of licensing demonstrates non-obviousness of the '288 patent's claimed invention.

Relying on the same licenses, Patent Owner argues that “there is some evidence of commercial success of products linked to the '288 patent and the other Disputed Patents.” Prelim. Resp. 30. According to Patent Owner, “multiple products licensed under the Disputed Patents remain available for sale, suggesting that those products have been profitable.” *Id.* Patent Owner also alleges that Rabbit, LLC “earned gross revenue in sales of at least 2.25 million dollars with respect to [the] licensed products.” *Id.* at 31 (citing Ex. 2006, terms 4.2, 5.1).

As explained above, none of the licenses Patent Owner relies on is for the '288 patent. *See* Ex. 2004, 9; Ex. 2006, 8; Ex. 2007, 7. Thus, on this record, we are not persuaded that there is a nexus between the alleged commercial success and a unique feature of the '288 patent's claimed invention and that the evidence of commercial success demonstrates non-obviousness of the '288 patent's claimed invention.

Patent Owner asserts that “there is some evidence of industry praise [for] products linked to the '288 patent and the other Disputed Patents.” Prelim. Resp. 31. As support, Patent Owner submits an article in which “one industry expert” described the Pocket Bra as “genius.” *Id.* (citing Ex. 2003). Exhibit 2003 is an article that describes a Pocket Bra featuring “two 10cm pockets sewn into each side panel in which to store your valuables” and

pockets that “are basically two slings under each arm.” Ex. 2003, 3. In the article, Chantelle Crabb, an alleged underwear expert, states that “[t]his sounds genius, because so many of us do this anyway — albeit not as elegantly.” *Id.* at 3.

Exhibit 2003, however, does not sufficiently inform us whether Chantelle Crabb evaluated a Pocket Bra having a unique feature of the ’288 patent’s claimed invention, which includes “a patch forming a pocket operatively associated with each cup, each patch having a linear upper edge.” Thus, on this record, we are not persuaded that there is a nexus between this alleged industry praise and a unique feature of the ’288 patent’s claimed invention and that this evidence of industry praise demonstrates non-obviousness of the ’288 patent’s claimed invention.

As further evidence of industry praise, Patent Owner submits the testimony of Ms. Goff. Prelim. Resp. 31 (citing. Ex. 2001 ¶¶ 6–7). Ms. Goff testifies that:

6. When I began marketing the Pocket Bra, I frequently spoke with women who had similar experiences to my own: a lack of useful places to stow items in their everyday clothing. Many of these women told me that the Pocket Bra had been or would be useful for resolving this issue.

7. For example, one mother contacted me to purchase one of the Pocket Bras so that her diabetic daughter could use it to store an insulin pump. I also received requests from other women asking me to produce the Pocket Bra in a wider range of sizes. These are both cases I mentioned in an interview with the Berkshire Eagle on May 12, 2014, which is provided with this affidavit as Exhibit SW-2002.

Ex. 2001 ¶¶ 6–7.

Ms. Goff’s testimony, however, does not sufficiently inform us which variation of the Pocket Bra is being praised. Further, Ms. Goff, as the sole

inventor, is an interested party. Thus, we give little weight to her testimony as to alleged industry praise spoken by others. On this record, we are not persuaded that there is a nexus between this alleged industry praise and a unique feature of the '288 patent's claimed invention and that this evidence of alleged industry praise demonstrates non-obviousness of the '288 patent's claimed invention.

d. Summary of Objective Indicia Analysis

Given the above, on this record, we give little weight to Patent Owner's evidence of objective indicia.

4. Summary

Based on the evidence and arguments of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that claim 1 would have been obvious in view of the combination of Barg and Pintor. We, thus, institute trial to review the challenged claims of the '288 patent.

Petitioner also asserts that the combination of Barg and Pintor teaches each limitation of claims 2–4, 11, and 12. Pet. 39–46. Patent Owner does not argue these claims separately. *See generally* Prelim. Resp. In any event, we institute an *inter partes* review as to all challenges raised in the Petition. *See SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018); *see also* 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

F. Alleged Obviousness over York and Pintor

Petitioner asserts that claims 1–4, 11, and 12 would have been obvious over the combination of York and Pintor. Pet. 49–70. Based on this

record, and for at least the following reasons, we determine Petitioner has established a reasonable likelihood that it would prevail in this assertion.

For claim 1, Petitioner provides detailed analysis to support its argument that the combination of York and Pintor teaches or suggests each limitation of claim 1. Pet. 49–63. Petitioner also contends that an ordinarily skilled artisan would have been motivated combine the teachings of the two references and would have had a reasonable expectation of success in doing so. *Id.* at 69–70.

Patent Owner presents essentially the same counterarguments here as those advanced to address the challenge based on the combination of Barg and Pintor. Specifically, Patent Owner contends that (1) York fails to disclose a linear upper edge, and Petitioner’s argument that a linear edge is obvious over York as an obvious design choice employs impermissible hindsight; (2) Pintor teaches away from combination with York or similar designs; and (3) objective indicia demonstrate the non-obviousness of the asserted claims. Prelim. Resp. 32–36.

Petitioner also asserts that the combination of York and Pintor teaches each limitation of claims 2–4, 11, and 12. Pet. 63–69. Patent Owner does not argue these claims separately. *See generally* Prelim. Resp.

Because we institute trial based on the combination of Barg and Pintor, we must review all challenged claims under all asserted grounds, including this one. Moreover, for the same reason as explained above, we are not persuaded by Patent Owner’s arguments. *See supra* II.E.

G. Ground 3: Obviousness over Handras and Pintor

Petitioner asserts that claims 1–4, 11, and 12 would have been obvious over the combination of Handras and Pintor. Pet. 70–93. Based on

this record, and for at least the following reasons, we determine Petitioner has established a reasonable likelihood that it would prevail in this assertion.

For claim 1, Petitioner provides detailed analysis to support its argument that the combination of Handras and Pintor teaches or suggests each limitation of claim 1. Pet. 70–86. Petitioner also contends that an ordinarily skilled artisan would have been motivated combine the teachings of the two references and would have had a reasonable expectation of success in doing so. *Id.* at 92–93.

Patent Owner presents essentially the same counterarguments here as those advanced to address the challenge based on the combination of Barg and Pintor. Specifically, Patent Owner contends that (1) Handras fails to disclose a linear upper edge, and Petitioner’s argument that a linear edge is obvious over Handras as an obvious design choice employs impermissible hindsight; (2) Pintor teaches away from combination with Handras or similar designs; and (3) objective indicia demonstrate the non-obviousness of the asserted claims. Prelim. Resp. 36–40.

Petitioner also asserts that the combination of Handras and Pintor teaches each limitation of claims 2–4, 11, and 12. Pet. 86–92. Patent Owner does not argue these claims separately. *See generally* Prelim. Resp.

Because we institute trial based on the combination of Barg and Pintor, we must review all challenged claims under all asserted grounds, including this one. Moreover, for the same reason as explained above, we are not persuaded by Patent Owner’s arguments. *See supra* II.E.

III. CONCLUSION

Based on the current record, and for the reasons explained above, we find Petitioner has demonstrated a reasonable likelihood that it would prevail

with respect to at least one claim challenged in the Petition. We therefore institute an *inter partes* review of all challenged claims on all asserted grounds.

We note that the papers submitted in this proceeding so far often lack accurate or adequate citation to the record. For example, in discussing the prosecution history, Petitioner cites Exhibit 1004. *See* Pet. 8–9. None of the pin cites, however, supports Petitioner’s position. Meanwhile, Patent Owner cites and quotes the Petition without offering any pin cite at all. *See generally* Prelim. Resp. We caution the parties that, in the future, the panel may disregard any discussion without proper citations.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted on all challenged claims of the ’288 patent based on all assert grounds set forth in the Petition; and

FURTHER ORDERED, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of a trial commencing on the entry date of this decision.

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Patent 9,295,288 B1

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