

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,
Petitioner,

v.

SHERRYWEAR LLC,
Patent Owner.

Case IPR2024-01125
Patent 9,808,036 B1

PATENT OWNER'S SUR-REPLY UNDER 37 C.F.R. § 42.23

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<i>Regents of the Univ. of California v. Eli Lilly & Co.</i> , 119 F.3d 1559, 1575 (Fed. Cir. 1997)	4

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-2005	EXPUNGED
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
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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)

Patent owner (hereinafter PO) files this Sur-Reply addressing arguments concerning § 325(d) pursuant to email authorization on December 17, 2024.

I. 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

Discretionary dismissal is appropriate where “the same or substantially the same art previously was presented to the Office” and the Office has not “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). Even if the same art was not considered during examination, newly introduced art is substantially the same are if it has no “probative differences” over the art considered by the Office. *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 22. (PTAB Dec. 15, 2017) (Precedential). This question of materiality is crucial here, as it would be trivially easy to find alternative prior art references that differ from those considered by the Examiner in inconsequential ways.

Petitioner appears to imply that discretionary denial is only appropriate where the same art was considered, but none of the cases Petitioner cites stands for that proposition. In the non-precedential case of *Fusion Orthopedics*, the Board did not consider substantial similarity because the patent owner in that matter did not

explicitly invoke § 325(d) at all and made no attempt to argue that the newly introduced reference was “substantially the same” as examined references. *Fusion Orthopedics, LLC v. Extremity Medical, LLC*, IPR2023-00894, Paper 15 at 34–35 and Paper 12 at 15-16 (Nov. 17, 2023). In the non-precedential case of *K/S HIMPP*, the Board ruled for institution because “there is no evidence or argument that [prior art] were previously considered by the Office **or cumulative of art that was in front of the Office.**” *K/S HIMPP v. BRAGI GmbH*, IPR2023-01205, Paper 8 at 19–20 (Mar. 19, 2024) (emphasis added). In *Oticon*, the Board considered whether a reference that had not been cited during examination was “substantially the same” as an examination reference and denied institution only because the latter included “different structures that serve[d] different purposes.” *Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper No. 15 at 15 (P.T.A.B. Oct. 16, 2019).

Here, Petitioner does not indicate, per *Oticon*, how any feature allegedly made obvious by Barg, York, or Handras include “different structures that serve different purposes” from those allegedly made obvious by Pintor. On the contrary, Petitioner argues that the claims as amended are obvious over Pintor. Paper 10 (Petitioner’s Reply to Patent Owner’s Sec/ 325(d) Arguments) at 5-6 (“Reply”) This implies that any teachings by Barg, etc. relevant to the patentability of the instant claims are taught by Pintor. Without acknowledging that the patented claims are obvious over any of Pintor, Barg, York, or Handras, and as argued in the

POPR, Barg, York, and Handras do not contain any differences from Pintor that are material to the question of patentability in this proceeding. *See* Paper 8, patent owner’s preliminary response at 13 *et seq.* (“POPR”).

Petitioner further argues that Pintor was not “considered” in the examination of the ‘036 patent because it was not explicitly used in a rejection. On the contrary, there is ample evidence to conclude the Examiner was aware of the relevant teachings of Pintor: Pintor was in the list of references the Examiner had before her for this matter, and had been explicitly considered for its teachings in the parent application which issued as the ‘288 patent.

As noted in the POPR, the Examiner had before her multiple additional references that render Barg, York, and Handras cumulative. Petitioner misconstrues PO’s argument on this point; it is not that Barg, York, and Handras are cumulative *because* MacLaren and Lee disclose bras with pockets, but that MacLaren and Lee are examples of the various references disclosing bras with pockets that were considered by the Examiner, which references render Barg, York, and Handras cumulative because of the lack of material differences between Barg, York, and Handras and the Examiner’s art. *Cf. Becton*, Paper 8 at 22.

As noted above, Petitioner argued that Pintor teaches all relevant features of the issued claims, which would suggest that Barg, York, and Handras do not provide probatively distinct teachings from Pintor. MacLaren and Lee represent

further examples of such teachings. For instance, the only from Barg, York and Handras that the Petitioner describes for MacLaren is the fact that MacLaren discloses a detachable pocket. However, making an object separable, without more, would not be considered a patentable distinction between the references. *See* MPEP § 2144.04(V)(C); *See also In re Dulberg*, 289 F.2d 522, 523 (C.C.P.A. 1961) . Petitioner does not describe anything else in Barg, York, and Handras that would “teach...more than what a reasonable examiner would consider to be taught” than MacLaren. *Regents of the Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1575 (Fed. Cir. 1997) .

Petitioner further argues that the Examiner did not consider Lee, and considered MacLaren “almost exclusively” for its “disclosure of stitching.” Reply at 4. PO disagrees: The Examiner received Lee in an IDS, and considered MacLaren for at least one other feature in addition to stitching. Ex. 1006 at 72-73. Moreover, in claiming that a person of skill in the art would be motivated to combine MacLaren with Pintor and Newman, the Examiner would have considered “similarities and differences in structure and function” between MacLaren and other prior art, and thus may be inferred to have considered the various additional features of MacLaren for at least that purpose. MPEP §2141.01(a)(II) Given that Petitioner identifies only trivial distinctions between MacLaren and Barg, York, or Handras, Barg, York, and Handras are cumulative over MacLaren.

It is also worth noting that Petitioner neglects entirely to address a further reference PO listed as rendering Barg, York, and Handras cumulative, U.S. Pat. App. Pub. No. 2012/0064799 to Rivers, which was also provided to the Examiner during prosecution and acknowledged as such. *See* POPR at 17. While Rivers does not render the patented claims obvious for largely the same reasons PO described in the POPR with regard to Barg, York, and Handras, particularly in light of the objective indicia of obviousness set forth in the POPR, Rivers does teach the elements that Petitioner ascribes to Barg, York, and Handras.

II. THE PETITIONER HAS FAILED TO SHOW THAT THE EXAMINER MATERIALLY ERRED

Petitioner argues that the Examiner materially erred in allowing the issued claims, because the Examiner did not have the benefit of Petitioner's expert testimony, the Examiner did not consider the Petitioner's prior art, and because the claims purportedly should not have been allowed over Pintor.

Taking the last point first, the argument that allowing the claims over Pintor was error is nothing more than an attempt to relitigate the original examination before the Board. The purpose of §325(d) is to give appropriate deference to the reasoning the Examiner made in finding claims patentable over existing references. Furthermore, and as noted above, the Petitioner's argument that Pintor rendered the patented claims obvious supports the conclusion that Barg, York, and Handras do

not add any material differences over the art already considered (e.g., Pintor, MacLaren, and Rivers). It can hardly be error to overlook prior art references that do not alter the obviousness analysis.

In addition, and as argued at length in the POPR, Pintor, Barg, York, and Handras do not render the patented claims obvious. All of the references lack teachings that are present in the patented claims. Perhaps more significantly, the objective criteria of nonobviousness, particularly the significant evidence of copying by NIKE itself, militate strongly against a finding of obviousness. *See, e.g., Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1378 (Fed. Cir. 2012) (Objective indicia are independent, and often most probative, evidence of obviousness). Petitioner’s own assertions to the effect that bras with pockets are not new or complex technology illustrate that in objective criteria are particularly crucial in this case. *See Cont’l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1273 (Fed. Cir. 1991)(“simple variation on known themes,” are often better assessed using objective criteria).

The objective criteria also illustrate a flaw in the Petitioner’s expert testimony. “Objective indicia of nonobviousness must be considered in every case where present.” *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1048 (Fed. Cir. 2016) . The only analysis in the expert opinion regarding objective indicia is peremptory and conclusory in nature. The expert in question either was unaware

evidence of copying by NIKE or of the instant invention or chose not to acknowledge it. Accordingly, the testimony regarding the likely motivations or conclusions of a person skilled in the art has been developed from an incomplete record of the relevant information and should not be accorded much weight.

III. CONCLUSION

For at least these reasons, denial under § 325(d) is appropriate, and the Board should deny institution of *inter partes* review of the '036 patent.

Dated: January 8, 2025

Respectfully submitted,
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 8, 2025, copies of the foregoing PATENT OWNER'S SUR-REPLY UNDER 37 C.F.R. § 42.23 were served pursuant to 37 C.F.R. § 42.6 electronically on Petitioner by sending the copies to Nike-SherryWear@kirkland.com.

Dated: January 8, 2025

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