

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,

Petitioner

v.

SHERRYWEAR LLC,

Patent Owner.

Case No. IPR2024-01126

U.S. Patent No. 10,219,550

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

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EXHIBIT LIST

Exhibit No.	Description¹
NIKE-1001	Declaration of Joyce Baran
NIKE-1002	Resume of Joyce Baran
NIKE-1003	Certified U.S. Patent No. 9,295,288 (filed Nov. 18, 2013)
NIKE-1004	Certified Prosecution File History for U.S. Patent No. 9,295,288
NIKE-1005	RESERVED
NIKE-1006	Certified Prosecution File History for U.S. Patent No. 9,808,036
NIKE-1007	Certified U.S. Patent No. 10,219,550 (filed Aug. 17, 2017)
NIKE-1008	Certified Prosecution File History for U.S. Patent No. 10,219,550
NIKE-1009	RESERVED
NIKE-1010	RESERVED
NIKE-1011	RESERVED
NIKE-1012	RESERVED
NIKE-1013	RESERVED
NIKE-1014	RESERVED
NIKE-1015	RESERVED

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

Exhibit No.	Description¹
NIKE-1016	RESERVED
NIKE-1017	RESERVED
NIKE-1018	RESERVED
NIKE-1019	U.S. Patent No. 3,518,998 (filed Feb. 8, 1968) (“Barg”)
NIKE-1020	U.S. Patent No. 2,920,628 (filed Oct. 7, 1958) (“York”)
NIKE-1021	U.S. Patent Application Publication No. 2014/0051331 (filed Aug. 20, 2012) (“Handras”)
NIKE-1022	U.S. Patent No. 7,753,759 (filed Sept. 29, 2008) (“Pintor”)
NIKE-1023	U.S. Patent Publication No. 2005/0037687(A1) (filed Aug. 12, 2003) (“Newman”)
NIKE-1024	U.S. Design Patent No. D597,279 (filed Oct. 26, 2008) (“Spillman”)
NIKE-1025	U.S. Design Patent No. D529,259 (filed Jan. 13, 2006) (“Faagau”)
NIKE-1026	EP211124(A1) (filed July 22, 1985) (“Vidai”) (Original)
NIKE-1027	EP211124(A1) (filed July 22, 1985) (“Vidai”) (Official Translation)
NIKE-1028	U.S. Patent Application Publication No. 2007/0298684 (filed June 21, 2006) (“Spagna”)
NIKE-1029	U.S. Design Patent No. 641,954 (filed Aug. 23, 2010) (“Glass”)
NIKE-1030	U.S. Patent Application Publication No. 2011/0223832 (filed Mar. 4, 2011) (“Rose”)

Exhibit No.	Description ¹
NIKE-1031	RESERVED
NIKE-1032	RESERVED
NIKE-1033	RESERVED
NIKE-1034	<i>Early Brassiere</i> , Google Arts & Culture, https://artsandculture.google.com/asset/early-brassiere/-gGoCcJIsFqA1g?hl=en .
NIKE-1035	Rebecca Unsworth, <i>Hands Deep in History: Pockets in Men and Women's Dress in Western Europe, c. 1480-1630</i> , THE COSTUME SOCIETY (Edinburgh Univ. Press 2017), https://www.euppublishing.com/doi/epub/10.3366/cost.2017.0022 .
NIKE-1036	Derek Gentile, <i>A comfortable convenience: County woman creates, patents the 'pocketbra'</i> , THE BERKSHIRE EAGLE (May 12, 2014), https://www.berkshireeagle.com/business/a-comfortable-convenience-county-woman-creates-patents-the-pocketbra/article_039dd3a3-29d7-58a7-aa5a-fd5dc171479f.html .
NIKE-1037	Kit-lun Yick et al., <i>Study of thermal–mechanical properties of polyurethane foam and the three-dimensional shape of molded bra cups</i> , 210 Journal of Materials Processing Technology at 116–21 (Aug. 2009)
NIKE-1038	RESERVED
NIKE-1039	RESERVED
NIKE-1040	RESERVED
NIKE-1041	RESERVED

Exhibit No.	Description ¹
NIKE-1042	RESERVED
NIKE-1043	RESERVED
NIKE-1044	RESERVED
NIKE-1045	RESERVED
NIKE-1046	MA Litigation Docket No. 31 (Scheduling Order)
NIKE-1047	LegalMetric District Report Massachusetts District Court in Patent Cases January 2019 to January 2024
NIKE-1048	LegalMetric Individual Judge Report on Judge Leo Sorokin in Patent Cases June 2014 to April 2023
NIKE-1049	Appendix A to SherryWear’s Answers and Objections to Nike’s First Set of Interrogatories (Response to Interrogatory No. 5) (Mar. 29, 2024).
NIKE-1050	RESERVED
NIKE-1051	RESERVED
NIKE-1052	RESERVED
NIKE-1053	<i>SherryWear v. Nike</i> , No. 1:23-cv-11599, Dkt. 69 (Order on Motion to Stay) (D. Mass. Sept. 3, 2024)
NIKE-1054	U.S. Patent No. 7,585,200 (filed Apr. 24, 2008) (“McLaren”)
NIKE-1055	U.S. Patent No. 5,496,205 (filed Nov. 22, 1994) (“Lee”)
NIKE-1056	RESERVED

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

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

PO argues that Part I of the *Advanced Bionics* framework is met because Barg, York, and Handras are allegedly cumulative of and not materially different from Pintor and are cumulative of McLaren (U.S. Patent No. 7,585,200; NIKE-1054) and Lee (U.S. Patent No. 5,496,205; NIKE-1055). A reference is only considered “cumulative” if it “teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO.” *Regents of the Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1575 (Fed. Cir. 1997). Barg, York, and Handras are materially different from Pintor and McLaren, and are not cumulative of Pintor, McLaren, or Lee. PO’s arguments to the contrary misconstrue Petitioner’s arguments and overly simplify the disclosures of Barg, York, and Handras.

First, PO admits, as it must, that Barg, York, and Handras—the three primary references relied on by Petitioner—were not before the Examiner during prosecution of the ’550 Patent. Paper 8 (Patent Owner’s Preliminary Response) at 13 (“POPR”). *Advanced Bionics* Part I is not satisfied for this reason alone, and discretionary denial is inappropriate. *E.g., Fusion Orthopedics, LLC v. Extremity Medical, LLC*,

IPR2023-00894, Paper 15 at 34–35 (Nov. 17, 2023) (instituting review, finding § 325(d) not sufficiently implicated because the primary reference for four of the seven grounds was not previously presented to the Office). Indeed, the Petition explains how Barg, York, and Handras alone each independently disclose and/or render claim 1 obvious, relying on Pintor only in the alternative, or as a secondary reference for certain dependent claims. *See* Petition, §§ IX.A, IX.B, IX.C. “Because [none] of those references was before the office, Patent Owner has not satisfied the first prong of the *Advanced Bionics* test,” and discretionary denial is not warranted. *K/S HIMPP v. BRAGI GmbH*, IPR2023-01205, Paper 8 at 19–20 (Mar. 19, 2024).

Second, PO wrongly contends “the Office [] explicitly consider[ed] a prior art reference (Pintor) for precisely the probative purpose the Petitioner now ascribes to Barg, York, and Handras”: “bras designed to store personal belongings.” POPR at 13. But the Examiner did not cite or discuss Pintor in any rejections during prosecution of the ’550. *See generally* NIKE-1008.

Third, though the Examiner did rely upon Pintor during prosecution of the ’288 patent—grandparent to the ’550—Barg, York, and Handras are each far more pertinent than Pintor. For example, the Applicant argued it would not have been obvious to modify Newman based on Pintor because Newman’s pockets were specifically designed to fit padding for a bra, not for storing the claimed items and

thus the proposed combination would not operate as intended. NIKE-1004 at 173–174 (“the claimed structures that the pocket of claim 1 is sized to receive are not a bra pad, and would not fit in the pocket of Pintor.”). The Applicant also amended the claims to require further specific pocket geometry. *Id.* at 167. The Examiner then allowed the claims without comment. *Id.* at 183 (Feb. 1, 2016 Notice of Allowance).

As discussed in the Petition, Barg, York, and Handras disclose and/or render obvious “patch[es] forming a pocket operatively associated with at least one of the left and right cups” each with “upper edge[s], a lower edge, and an exterior edge” coupled to “the bra adjacent to a lower edge of the at least one of the left and right cups, and the exterior edge of the patch coupled adjacent to the exterior edge of the at least one of the left and right cups” intended for storing “a non-padding item.” *E.g.*, Petition at 24–35, 37, 46–59, 24–35, 69–85. These references thus disclose exactly what the Applicant argued was not taught by Newman, Pintor, or the combination of Newman and Pintor. *See* NIKE-1004 at 173–174. PO’s attempt to distinguish *Oticon* is therefore misplaced, as Barg, York, and Handras disclose numerous “distinct feature[s] ... absent from the art the Examiner” previously considered. POPR at 14; *Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper No. 15 at 15–16 (P.T.A.B. Oct. 16, 2019) (precedential) (grounds did not involve substantially the same prior art or arguments where the petitioner relied on the same

primary reference considered in prosecution, but with the addition of a secondary reference not previously considered).

Third, PO’s argument that Barg, York, and Handras are cumulative of McLaren and Lee because they disclose “bras with pockets” oversimplifies the disclosures of Barg, York, and Handras and how a POSA would understand those disclosures. POPR at 14. While both McLaren and Lee were listed in the Information Disclosure Statement, neither reference were used in any rejections. *See* NIKE-1008. Thus, it is unclear to what extent the Examiner reviewed and relied upon McLaren or Lee. *Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00486, Paper 10 at 14–15 (P.T.A.B. July 15, 2015) (instituting review despite reference having been listed on IDSs initialed by the Examiner). Further, McLaren is directed to a pocket removably detached from the bra, and Lee—like Pintor—discloses a pocket on the cup but does not disclose a pocket shape that mimics the geometry of the bra cup, making Barg, York, and Handras more pertinent disclosures. NIKE-1054 at Abstract; NIKE-1055 at Fig. 2.

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

As discussed in the Petition, during the prosecution of the ’288 patent (the ’550 patent’s grandparent), the Examiner reviewed Pintor only as a secondary reference to Newman. Petition at 99. The Examiner also failed to consider any of the

decades-old references that disclose a patch forming a pocket on a bra cup intended to hold the personal items of the wearer that also satisfy the claimed pocket geometry and stitching requirements during the prosecutions of the '288 patent, the '036 patent ('550 patent's parent), and the '550 patent (*Becton* factor (e)). Thus, the Examiner materially erred. *Advanced Bionics*, Paper 6 at 10 (“[I]f the record of the Office's previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive.”). PO nevertheless argues no material error because the Examiner already “explicitly considered Pintor’s disclosure of a pocket for removable items.” POPR at 16. But allowing the Challenged Claims over Pintor *was* error.

For example, Pintor discloses “a brassiere containing concealed pockets for concealing objects such as portable electronic devices, keys, toiletries, money and other valuables, pepper spray, insulin pumps, inhalers, Syringes or other drug delivery devices.” NIKE-1022 at 4:59–62. Pintor further expressly discloses, “[a] pocket 30 [] provided on the interior surface 16A of a first breast cover 12A ... with the mouth 32 accessible to a hand (not shown) reaching into the breast cover” and that “the pocket can be formed from a pocket layer that is substantially rectangular, rounded rectangular, *or other suitable shape that has been attached to the interior surface of a breast cover using any known method such as sewing.*” NIKE-1022

at 5:37–41, 3:25–28. A POSA would thus have known that they could modify the disclosed pocket to match the size, shape, and location claimed in the '288 and '036 patents. *E.g.*, NIKE-1001 at ¶178–180; NIKE-1022 at 6:6–10, Figs. 1–3, 4, 7.

PO also argues that “Pintor teaches away from combination with Barg, York, Handras or similar designs,” and thus it was not error for the Examiner to “choos[e] not to combine them with Pintor.” POPR at 16–17. Not so. Pintor’s disclosures do not rise to the level of teaching away; rather, Pintor “merely expresses a general preference for an alternative invention.” *UCB, Inc. v. Actavis Lab’ys UT, Inc.*, 65 F.4th 679, 692 (Fed. Cir. 2023); *see also*, *Gator Tail, LLC v. Mud Buddy LLC*, 618 F. App’x 992, 999 (Fed. Cir. 2015) (“Nowhere does Saito suggest that using a horizontal engine would render the motor inoperable. It merely describes the benefits of its vertical engine when compared to the dominant prior art.”). Regardless, PO has Petitioner’s argument backwards, as Petitioner nowhere argues to modify Pintor based on the teachings of Barg, York, or Handras to create bras with bulky pockets on the front of the cups. *See* POPR at 16–17. Rather, Petitioner argues a POSA would know how to modify Barg, York, and Handras to include specific teachings from Pintor (*e.g.*, stitching, use of polyurethane, use of elastic material, and use of pocket for holding non-padding items). *See* Petition at 100–101. Nothing in Barg, York, Handras, teaches away from such modifications.

Petitioner also offers new evidence (*Becton* factor (f)) that was not available to the Examiner, such as the testimony of Ms. Baran (NIKE-1001). Ms. Baran provides important additional context for what a POSA would have known—such as pocket shapes, placement, and how to achieve a desired aesthetic and function—and how a POSA would have understood the disclosures of Barg, York, Handras, and Pintor including how to modify such disclosures to achieve a desired design. *E.g.*, NIKE-1001, ¶¶ 499–627. Indeed, in the additional evidence, Ms. Baran explains, among other things, how a person of skill would have easily understood how Barg, York, Handras, and Pintor specifically disclose exactly what the Applicant argued the combination of Newman and Pintor failed to teach in the ’550’s parent applications—a bra with cup-sized pockets for the storage of a handheld electronic device, keys, and/or pills. *See* NIKE-1004 at 173–74; *see also*, NIKE-1006 at 93–95. Since the Examiner lacked this evidence, the Examiner did not appreciate that a POSA would have easily known how to modify the prior art’s teachings, and Pintor in particular, with a high expectation of success, rendering the Challenged Claims obvious.

III. CONCLUSION

For the foregoing reasons, denial under § 325(d) is inappropriate, and the Board should institute *inter partes* review of the ’550 patent.

Date: December 27, 2024

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CERTIFICATE OF SERVICE

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

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