

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,

Petitioner,

v.

SHERRYWEAR LLC,

Patent Owner.

IPR2024-01126

Patent 10,219,550

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

TABLE OF CONTENTS

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.....1

II. THE PETITIONER HAS FAILED TO SHOW THAT THE EXAMINER
MATERIALLY ERRED 4

III. CONCLUSION.....7

TABLE OF AUTHORITIES

Cases

<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH</i> , IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020).....	1
<i>Apple Inc. v. Samsung Elecs. Co.</i> , 839 F.3d 1034, 1048 (Fed. Cir. 2016)	7
<i>Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.</i> , 876 F.3d 1350, 1363 (Fed. Cir. 2017)	6
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 at 22. (PTAB Dec. 15, 2017)	1, 3
<i>Bradium Techs. LLC v. Iancu</i> , 923 F.3d 1032, 1047 (Fed. Cir. 2019).....	6
<i>Cont'l Can Co. USA v. Monsanto Co.</i> , 948 F.2d 1264, 1273 (Fed. Cir. 1991)	7
<i>Fusion Orthopedics, LLC v. Extremity Medical, LLC</i> , IPR2023-00894, Paper 15 at 34–35 and Paper 12 at 15-16 (Nov. 17, 2023).....	2
<i>In re Dulberg</i> , 289 F.2d 522, 523 (C.C.P.A. 1961)	4
<i>K/S HIMPP v. BRAGI GmbH</i> , IPR2023-01205, Paper 8 at 19–20 (Mar. 19, 2024).2	
<i>Mintz v. Dietz & Watson, Inc.</i> , 679 F.3d 1372, 1378 (Fed. Cir. 2012).....	7
<i>Oticon Med. AB v. Cochlear Ltd.</i> , IPR2019-00975, Paper No. 15 at 15 (P.T.A.B. Oct. 16, 2019).....	2
<i>Regents of the Univ. of California v. Eli Lilly & Co.</i> , 119 F.3d 1559, 1575 (Fed. Cir. 1997)	4

<i>UCB, Inc. v. Actavis Lab'ys UT, Inc.</i> , 65 F.4th 679, 692 (Fed. Cir. 2023).....	5
---	---

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
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	MacLaren (US 7585200)

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 or MacLaren because they were not used in rejections of the current application. However, MacLaren was used in rejections for parent and grandparent applications to the ‘550 patent; the Examiner was therefore aware of its disclosure and likely did consider it. Given that Petitioner identifies only trivial distinctions between MacLaren and Barg, York, or Handras, it is reasonable to conclude that Barg, York, and Handras are cumulative over MacLaren.

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.

Petitioner argues that Pintor does not teach away from combination with Barg, York, and/or Handras because it does not suggest such combinations would be inoperable. However, that is not the sole basis on which a reference can be found to teach away, as acknowledged in the sole precedential case the Petitioner cites. *See UCB, Inc. v. Actavis Lab'ys UT, Inc.*, 65 F.4th 679, 692 (Fed. Cir. 2023) . (“Tang does not criticize, discredit, or otherwise dissuade a skilled artisan from investigating the claimed range of ratios.”). In contrast, Pintor describes designs having features in common with Barg, York, and Handras as undesirable. Nike-1022 at Page 9, Col. 1, Lines 31-50. Thus, unlike in the cases cited by the

Petitioner, Pintor actively criticizes designs similar to Barg, York, and Handras.

See Bradium Techs. LLC v. Iancu, 923 F.3d 1032, 1047 (Fed. Cir. 2019) .

Moreover, even if the contrary teachings of Pintor did not rise to the level of teaching away, they still represent evidence of a lack of motivation to combine, suggesting that the Examiner’s failure to find the claims obvious over Barg, York, and/or Handras in view of Pintor was not in error. *See Arctic Cat Inc. v.*

Bombardier Recreational Prods. Inc., 876 F.3d 1350, 1363 (Fed. Cir. 2017)

(evidence that “may not rise to the level of teaching away” can still support a reasonable conclusion that there was no motivation to make a particular combination). Petitioner has not produced any authority supporting Petitioner’s proposition that motivations for or against combination must be found in the prior art references the Petitioner has identified as primary references. The combination of Handras, Barg, and/or York with Pintor can just as easily be described as modifying Pintor to include features of Handras, Barg, and/or York, and the question regarding motivation to combine can thus be affected in the teachings of any of the references to be combined.

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 ‘550 patent.

Dated: January 8, 2025

Respectfully submitted,
SherryWear LLC,
By its attorneys,

/s/ Micah T. Drayton (Reg. No. 69,906)

Caldwell Law LLC

200 Clarendon Street, 59th Floor

Boston, MA 02116

Telephone: 857-990-4942

E-mail: mdrayton@caldwelllaw.com

Katie Rubino, (Reg. No 76,990)

Caldwell Law LLC

200 Clarendon Street, 59th Floor

Boston, MA 02116

Telephone: 857-990-4914

E-mail: jameson@caldwelllaw.com

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

/s/ Micah T. Drayton (Reg. No. 69,906)

Caldwell Law LLC

200 Clarendon Street, 59th Floor

Boston, MA 02116

Telephone: 857-990-4942

E-mail:

mdrayton@caldwelllaw.com