

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,

Petitioner

v.

SHERRYWEAR LLC,

Patent Owner.

Case No. IPR2024-01127

U.S. Patent No. 10,219,551

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	RESERVED
NIKE-1007	RESERVED
NIKE-1008	RESERVED
NIKE-1009	Certified U.S. Patent No. 9,289,016 (filed Feb. 5, 2015)
NIKE-1010	RESERVED
NIKE-1011	RESERVED
NIKE-1012	Certified Prosecution File History for U.S. Patent No. 9,723,878
NIKE-1013	Certified U.S. Patent No. 10,244,800 (filed Jul. 12, 2017)
NIKE-1014	RESERVED
NIKE-1015	Certified U.S. Patent No. 10,219,551 (filed Dec. 8, 2017)
NIKE-1016	Certified Prosecution File History for U.S. Patent No. 10,219,551

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

Exhibit No.	Description¹
NIKE-1017	RESERVED
NIKE-1018	RESERVED
NIKE-1019	U.S. Patent No. 3,518,998 (filed Feb. 8, 1968) (“Barg”)
NIKE-1020	RESERVED
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”)
NIKE-1031	RESERVED
NIKE-1032	RESERVED

Exhibit No.	Description ¹
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.eupublishing.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	RESERVED
NIKE-1038	RESERVED
NIKE-1039	RESERVED
NIKE-1040	RESERVED
NIKE-1041	RESERVED
NIKE-1042	RESERVED
NIKE-1043	RESERVED
NIKE-1044	MA Litigation, SherryWear's Infringement Contentions, '551 Swoosh Bra Infringement Claim Chart

Exhibit No.	Description¹
NIKE-1045	MA Litigation, SherryWear's Infringement Contentions, '551 Swoosh Pocket Bra Infringement Claim Chart
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	RESERVED
NIKE-1055	RESERVED
NIKE-1056	U.S. Patent Application Publication No. U.S. 2011/0244758 (filed Mar. 30, 2010) ("Boatright")

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 Handras was cited in an Information Disclosure Statement, Vidai is purportedly cumulative of Boatright (U.S. 2011/0244758; NIKE-1056), and that Vidai and Handras are cumulative of Sherwood and Gentry. POPR at 12–14. 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). Petitioner’s Grounds are materially different from the disclosures of Boatright, Sherwood, and Gentry, and PO’s arguments to the contrary are incorrect and oversimplify the disclosures of Vidai and Handras.

First, Patent Owner does not dispute that Vidai—the primary reference for Ground 1—and Spagna and Glass—the secondary references used for both Grounds—were not before the Examiner during prosecution of the ’551 Patent. *See generally* Paper 8 (Patent Owner’s Preliminary Response) (“POPR”). Nor does PO allege that Spagna or Glass are substantially similar to any of the art or arguments before the Examiner. *See id.* The Board has 1 previously found that, where the

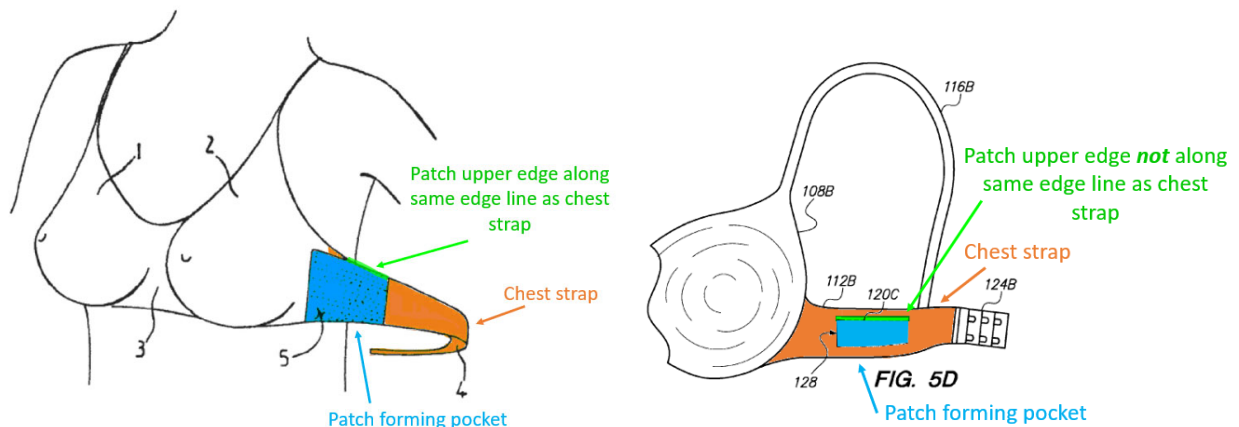
petitioner proposed grounds with the same primary reference considered in prosecution, but with the addition of a secondary reference not previously considered, the asserted grounds ***did not*** involve the same or substantially the same prior art or arguments. *See Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper No. 15 at 15–16 (P.T.A.B. Oct. 16, 2019) (precedential); *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). *Advanced Bionics* Part I is not satisfied for this reason alone, and discretionary denial is inappropriate.

Second, PO’s argument that Vidai and Handras are cumulative of Sherwood because both disclose “bras with pockets” and “bra[s] with a pocket on the chest strap” contradicts PO’s arguments during prosecution of the ’878, grandparent to the ’551 patent. *See* POPR at 14. Notably, Sherwood was not relied upon by the Examiner for any rejections during prosecution. *See* NIKE-1016. During prosecution of the ’878, the PO took the position that Sherwood “does not teach the side pocket” taught by the claims because Sherwood instead “teaches a mastectomy bra” designed to hold padding that compensates for removed tissue on the side of a wearer’s torso, the pockets of which are to be “closed permanently” with stitching once fitted to the wearer. NIKE-1012 at 93–94; *see also* NIKE-1004 at 176. PO

should not be permitted to take a contrary position now. *Veeam Software Corp. v. Hybir Inc.*, IPR2020-01037, 2020 WL 7121603, at *5 (P.T.A.B. Dec. 4, 2020) (declining to exercise discretion under § 325(d) where patent owner's arguments were contrary to arguments made during prosecution).

Third, the disclosures of Vidai and Handras are more salient than Sherwood. As the PO pointed out during the '878's prosecution, Sherwood teaches a mastectomy bra with pockets for the permanent insert of padded prostheses. *See, e.g.*, NIKE-1012 at 93–94. Conversely, the pockets disclosed in Vidai and Handras are expressly directed to the removable storage of non-padding items.

Fourth, PO is wrong that Vidai “is distinguishable for the same reason as Boatright . . . it does not have an upper edge of the [patch] [that] lies along a same edge line as at least a portion of a top edge of the chest strap.” POPR at 12–13 (internal quotations omitted). To the contrary, Vidai, unlike Boatright, shows the top edge of the side patch aligning with the top edge of the strap:



NIKE-1027 (Vidai) at Fig. 1 (left); NIKE-1056 (Boatright) at Fig. 5D (right). This difference in disclosures is material to the patentability of the '550 Patent.

Fifth, PO asserts that because Handras and Gentry were listed on the IDS, the art provided in the Petition is the same or substantially the same art. POPR at 12–14. PO admits, though, that Handras and Gentry were not used as a basis for rejection during the prosecution of the '551 Patent. *Id.* Because it is unclear to what extent the Examiner reviewed or relied upon the disclosures of Handras or Gentry (or Sherwood), discretionary denial is inappropriate. *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 initiated by the Examiner). This is especially true where, as here, Handras is considered in combination with references not previously before the Examiner (Spagna and Glass). *See Oticon*, Paper No. 15 at 15–16. Moreover, as explained below, the Examiner erred in overlooking Gentry's disclosures.

II. EVEN IF THE PETITIONER'S REFERENCES ARE CUMULATIVE, THE EXAMINER MATERIALLY ERRED (*ADVANCED BIONICS*, PART II)

PO argues no material error because the Examiner previously considered Handras. As noted above, it is unclear the extent to which the Examiner evaluated Handras with respect to the amended claims (*Becton* factor (c)), as it did not form the basis of a rejection. PO contends that to the extent the Examiner did consider

Handras, it was not material error to allow the Challenged Claims over Handras because the “Examiner may reasonably have concluded that Handras did not present a pocket capable of ‘receiving and removal of an item when being worn by the wearer,’” as Handras purportedly “discloses a patch on the inside of the chest strap in a location that is not readily accessible to a user while wearing the bra, and does not explicitly disclose that items can be stored and removed while the bra is being worn.” As demonstrated in the Petition, PO is wrong on all accounts. Handras *expressly* teaches that “[i]t is an object of the invention to provide a pocket in a bra for *receiving* one [or] more items *that is conveniently located for the wearer*” and that “*does not present any aesthetically displeasing bulges due to the presence of one or more items in the pocket*” while worn. *E.g.*, NIKE-1021 at [0003]–[0005], Figs. 1, 3, and 5; Petition at 53–54. This is not merely “an invitation for the Board to substitute its judgement for that of the Examiner”; it is a demonstration of material error. *Fubotv Media Inc. v. Dish Techs. L.L.C.*, No. IPR2024-00917, 2024 WL 4858758 at *13 (P.T.A.B. Nov. 21, 2024) (overlooking limitations taught by reference disclosed in IDS is material error); *Apple Inc. v. Geoscope Techs. Pte. Ltd.*, No. IPR2024-00031, 2024 WL 2107817 at *11 (P.T.A.B. May 10, 2024) (similar). And even if Handras did not provide such an express disclosure, PO’s argument that a POSA would understand Handras to teach a bra with pockets for storing personal items only when *not* worn borders on the absurd.

The Examiner also materially erred in allowing the challenged claims over the Gentry reference raised by PO for similar reasons. For example, Gentry discloses a “pocket in a wing of the bra” that may “comprise a closure, such as a zipper” designed to hold “items in the pocket.” SW-2065 2:19–24. During prosecution of the ’878, the Examiner viewed Gentry as a secondary reference to Boatright that taught pocket closures. NIKE-1012 at 106–07. Traversing rejection, Applicant amended the claims to require a patch upper edge that lies along a same edge line as at least a portion of a top edge of the chest strap and then argued that this limitation was not met by Boatright or Gentry. *Id.* at 119, 124–126. However, Gentry expressly discloses that “[t]he Closure 505 is illustrated as being located along the bottom margin of the Sport Bra Top Hem 545.” SW-2065 at 5:56–57, Fig. 1. Thus, the Examiner’s failure to recognize these express disclosures is material error.

Further, 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 Vidai and Handras, including how to modify such disclosures to achieve a desired design. 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 with a high

expectation of success, rendering the Challenged Claims obvious. *E.g.*, NIKE-1001, ¶¶ 1035–37.

III. CONCLUSION

For the foregoing reasons, denial under § 325(d) is inappropriate, and the Board should institute *inter partes* review of the '551 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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