

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,
Petitioner,

v.

SHERRYWEAR LLC,
Patent Owner.

IPR2024-01127
Patent 10,219,551 B1

Before MEREDITH C. PETRAVICK, LYNNE H. BROWNE, and
JON M. JURGOVAN, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

Nike, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–8, 12, 13, and 15–18 of U.S. Patent No. 10,219,551 B1 (Ex. 1015, “the ’551 patent”). Paper 1 (“Pet.”). SherryWear, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our prior permission, Petitioner filed a Preliminary Reply. Paper 10 (“Prelim. Reply”). Also, with our prior permission Patent Owner filed a Preliminary Sur-reply. Paper 12 (“Prelim. Sur-reply”).

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

After considering the Petition, the Preliminary Response, the Preliminary Reply, the Preliminary Sur-reply, and the evidence of record, we determine the information presented shows a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one of the challenged claims of the ’551 patent. Accordingly, we institute an *inter partes* review of claims 1–8, 12, 13, and 15–18 of the ’551 patent on the grounds asserted in the Petition.

B. Real Parties in Interest

Petitioner identifies Nike, Inc. as the real party-in-interest. Pet. 4. Patent Owner identifies SherryWear, LLC as the real party-in-interest. Paper 3, 1.

C. Related Matters

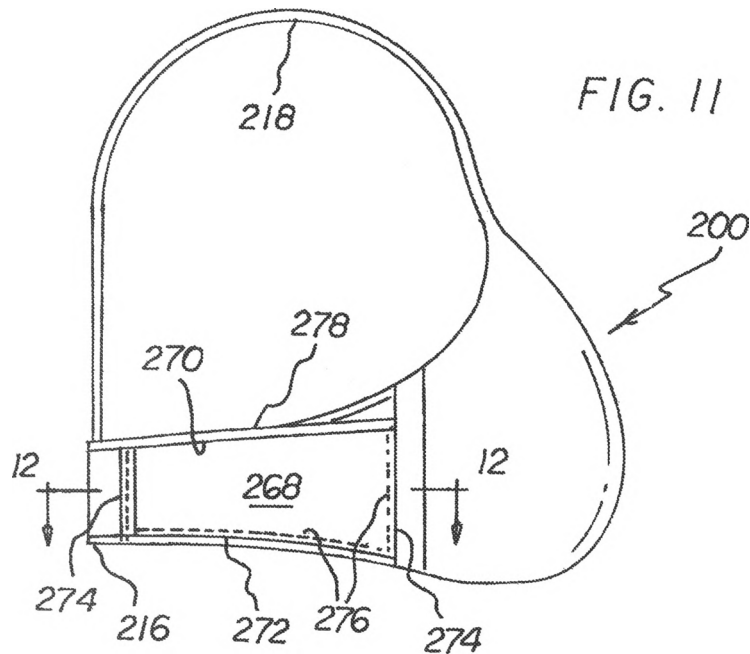
The parties identify *SherryWear, LLC, v. Nike, Inc.*, No. 1:23-cv-11599 (D. Mass), filed July 17, 2023, as a related proceeding. Pet. 4; Paper 3, 1. Petitioner also notes that it has filed *inter partes* review petitions on every patent (in addition to the '551 patent) asserted in the related litigation, identifying IPR2024-01122 (challenging U.S. Patent No. 9,289,016), IPR2024-01123 (challenging U.S. Patent No. 9,295,288), IPR2024-01124 (challenging U.S. Patent No. 9,723,878), IPR2024-01125 (challenging U.S. Patent No. 9,808,036), IPR2024-01126 (challenging U.S. Patent No. 10,219,550), IPR2024-01127 (challenging U.S. Patent No. 10,219,551), IPR2024-01128 (challenging U.S. Patent No. 10,244,800), and IPR2024-01129 (challenging U.S. Patent No. 10,869,510) as the filed *inter partes* review petitions. Paper 5, 1.

Patent Owner also identifies pending U.S. Patent Application No. 18/223,363, which is a continuation application claiming priority to the '551 patent. Paper 3, 1.

D. The '551 patent

The '551 patent “relates to a pocket bra system and more particularly pertains 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. 1015, 1:7–12.

Figure 11, reproduced below, depicts a side view of pocket bra system 200. Ex. 1015, 3:25–26.



The '551 patent explains that side patch 268 forms a side pocket on each side of the chest strap. *Id.* at 5:38–39. Side patch 268 has horizontal upper edge 270 and lower edge 272 and vertical side edges 274. *Id.* at 5:39–41. The '551 patent states that side stitching 276 along lower edge 272 and side edges 274 forms upper opening 278 so “pocket 268 [is] formed between two layers of the chest strap [216] and defined by the stitching 276.” *Id.* at 5:42–46. According to an embodiment, “side pocket 268 may be configured to have the upper edge 270 and top edge of the chest strap aligned or nearly aligned.” *Id.* at 5:47–49.

E. Illustrative Claim

Petitioner challenges claims 1–8, 12, 13, and 15–18 of the '551 patent. Claims 1 and 16 are independent. Claims 2–8, 12, 13, and 15 depend directly or indirectly from claim 1. Claims 17 and 18 depend from claim 16.

Claim 1 is illustrative and reproduced below.¹

1. [1A] A pocketed bra assembly comprising:

[1B] a strap assembly including a chest strap;

[1C] a left cup and a right cup, each cup being an area to receive a breast of a wearer having inside and outside surfaces, [1D] the strap assembly being attached to the cups whereby the strap assembly holds the cups to a wearer, with the chest strap extending from the left cup towards the wearer's back and extending from the right cup towards the wearer's back;

[1E] a side patch on one of an inside or outside surface of the chest strap adjacent to at least one of the left cup and right cups, [F] an upper edge of side patch lying along the same edge lines as at least a portion of a top edge of the chest strap, [1G] the side patch forming an opening such that the side patch forms a pocket, [1H] the opening capable of repeated receiving and removal of an item when being worn by the wearer; and

[1I] an item removably positioned in the pocket.

Ex. 1015, 6:61–7:11.

F. Asserted Grounds

Petitioner asserts that claims 1–8, 12, 13, and 15–18 would have been unpatentable on the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Basis
1A	1–6, 8, 12, 13, 15–18	103	Vidal ^{2,3}

¹ For ease of reference, we include the bracketed designations provided in the Petition for the limitations of claim 1 (*see* Pet. xvi (Claims Appendix)).

² European Patent Application Publication EP 0 211 124 A1, published Feb. 25, 1987 (Ex. 1026), for which Petitioner submitted an official translation at Ex. 1027 (to which we cite).

³ As Patent Owner correctly observes, Petitioner often references this document as *Vidai*—which is incorrect because the inventor's name in Exhibit 1026 is in fact *Vidal*. *See* Prelim. Resp 21; Ex. 1026.

Ground	Claim(s) Challenged	35 U.S.C. §	Basis
1B	7	103	Vidal, Spagna, ⁴ Glass ⁵
2A	1–6, 8, 12, 13, 15–18	103	Handras ⁶
2B	7	103	Handras, Spagna, Glass

Petitioner relies on the Declaration of Joyce Baran. Ex. 1001.

Patent Owner submits an Affidavit (Ex. 2001) of Sharon Goff, who is the inventor of the '551 patent.

II. ANALYSIS

A. Legal Standards

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d, 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review). Although we may indicate in this Decision that certain Patent Owner arguments are not persuasive, in doing so we do not shift the ultimate burden from Petitioner.

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a

⁴ U.S. Patent Application Publication No. 2007/0298684 A1, published Dec. 27, 2007 (Ex. 1028).

⁵ U.S. Design Patent No. D641,954 S, published Jul. 26, 2011 (Ex. 1029).

⁶ U.S. Patent Application Publication No. 2014/0051331 A1, published Feb. 20, 2014 (Ex. 1021).

whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations).⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

The Supreme Court explained in *KSR International Co. v. Teleflex Inc.* that

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (alteration in original)).

“Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1327 (Fed. Cir. 2016) (citations omitted).

⁷ Patent Owner presents evidence of secondary considerations. See Prelim. Resp. 1–12, 23–29, 32–33.

“[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360–61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of skill in the art “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.” Pet. 17–18 (citing Ex. 1001 ¶ 155). Petitioner asserts further that “[f]ormal education in a relevant field, such as fashion and textile design, may compensate for less experience.” *Id.* Patent Owner does not address the level of ordinary skill in the art. *See generally* Prelim. Resp.

For purposes of this Decision, we adopt Petitioner’s proposed definition of a person of ordinary skill in the pertinent art, as it is consistent with the ’551 patent and the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

C. Claim Construction

In an *inter partes* review proceeding, a patent claim shall be construed 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) (as amended Oct. 11, 2018). Our rule adopts the same claim construction standard used by Article III federal courts, which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. Under this standard, the words of a claim are generally given their

“ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention. *See Phillips*, 415 F.3d at 1312–13. In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Id.* at 1315–17.

The parties do not present any claim constructions, and we determine that no formal 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.’”)

D. Discretion under 35 U.S.C. 325(d)

Patent Owner contends that we should exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition, applying our precedential decision in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). Prelim. Resp. 13–20. Specifically, Patent Owner contends that “[t]he Board should deny institution because the Petition relies exclusively on art over which the Office allowed the challenged claims during prosecution, or art that adds nothing material to over the art the Office considered.” Prelim. Resp. 13.

In evaluating arguments under § 325(d), we use a two-part framework to assess: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the

patentability of challenged claims. *Advanced Bionics*, Paper 6 at 8. In applying the two-part framework, we consider the non-exclusive factors set forth in *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential in relevant part) (“*Becton, Dickinson*”), which “provide useful insight into how to apply the framework” under § 325(d). *Id.* at 9. Those non-exclusive factors include:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, Paper 8 at 17–18. “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to

whether the petitioner has demonstrated a material error by the Office.”

Advanced Bionics, Paper 6 at 10.⁸

*1. The Same or Substantially the Same Art or Arguments
Previously Presented to the Office*

Applying the *Advanced Bionics* framework, we first determine whether the same or substantially the same art or arguments were presented previously to the Office.

a) Petitioner’s Assertions

Petitioner asserts that “none of the grounds here involve the same or substantially the same prior art or arguments previously before the PTO.” Pet. 76. According to Petitioner, “[t]he primary references Vida[l], Spagna, and Glass were not cited or considered during prosecution of the ’551” and “[w]hile *Handras* was 1 of 41 references cited by the Examiner during prosecution (NIKE-1016, at 66), it did not form the basis of a rejection.” *Id.* (citing *Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00486, Paper 10 at 14–15 (PTAB, July 15, 2015)).

b) Patent Owner’s Response

Patent Owner contends that *Handras* “was considered by the Examiner, but was not used as a basis for a rejection.” Prelim. Resp. 15. Patent Owner contends further that *Vidal* is the same or substantially the same as *Boatright*, “which was used for a rejection in the parent ‘878 patent.”⁹ *Id.*

⁸ We note that the analysis underlying the exercise of discretion under 35 U.S.C. § 325(d) does not necessarily consider the merits of the challenges raised in the Petition.

⁹ U.S. Patent No. 9,723,878 B1.

In support of its assertions Patent Owner contends that Vidal, like Boatright, “does not have an upper edge of the cup [that] the lies ‘along a same edge line as at least a portion of a top edge of the chest strap’” and that “Petitioner is relying on a newly asserted reference ‘in the same manner as the Examiner relied on’ another reference during prosecution; so the former was not materially different from the latter.” Prelim. Resp. 15–16 (citing *Advanced Bionics*, IPR2019-00975, Paper 6 at 8). According to Patent Owner, “Vidal has no probative purpose beyond the art the Office considered, and thus represent substantially the same art that was already considered during the original prosecution of the ‘551 patent.” *Id.* at 16 (citing *Becton* at 22).

Patent Owner also contends that Vidal and Handras are cumulative of Sherwood (“used [] in a nonfinal rejection of the parent application to teach a bra with a pocket on a chest strap”) and Gentry (“provided by the Applicant in an IDS and considered by the Examiner”). Prelim. Resp. 17–18.

c) Petitioner’s Reply

Petitioner replies that “Patent Owner does not dispute that Vida[l]—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” and that Patent Owner does not “allege that Spagna or Glass are substantially similar to any of the art or arguments before the Examiner.” Prelim. Reply 1 (citing Prelim. Resp 8). Petitioner asserts 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.” *Id.* at 1–2 (citing *Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper No. 15 at 15–16 (PTAB Oct. 16, 2019) (precedential); *Fusion Orthopedics, LLC v. Extremity Medical, LLC*, IPR2023-00894, Paper 15 at 34–35 (PTAB Nov. 17, 2023)). Thus, according to Petitioner “*Advanced Bionics* Part I is not satisfied for this reason alone, and discretionary denial is inappropriate.” *Id.* at 2.

Petitioner replies further that Patent Owner’s “argument that Vida[l] 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.” Pet. Reply 2 (citing Prelim. Resp. 14). According to Petitioner,

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.

Id. (citing Ex. 1012, 93–94; Ex. 1004, 176). Petitioner asserts that Patent Owner “should not be permitted to take a contrary position now.” *Id.* at 2–3 (citing *Veeam Software Corp. v. Hybir Inc.*, IPR2020-01037 (PTAB Dec. 4, 2020))¹⁰.

In addition, Petitioner replies that “the disclosures of Vida[l] and Handras are more salient than Sherwood” because “Sherwood teaches a mastectomy bra with pockets for the permanent insert of padded prostheses,” whereas, “the pockets disclosed in Vida[l] and Handras are expressly

¹⁰ Petitioner’s citation does not include the paper and page numbers for this citation.

directed to the removable storage of non-padding items.” Pet. Reply 3 (citing Ex. 1012, 93–94).

Petitioner also replies that “Vida[1], unlike Boatright, shows the top edge of the side patch aligning with the top edge of the strap.” Pet. Reply 3–4 (citing Ex. 1027, Fig. 1; Ex. 1056, Fig. 5D). Petitioner asserts that “[t]his difference in disclosures is material to the patentability of the ’550 Patent.” *Id.* at 4.

Finally, Petitioner replies that “[b]ecause it is unclear to what extent the Examiner reviewed or relied upon the disclosures of Handras or Gentry (or Sherwood), discretionary denial is inappropriate.” Pet. Reply 4 (citing *Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00486, Paper 10 at 14–15 (PTAB July 15, 2015)). Petitioner replies further that “[t]his is especially true where, as here, Handras is considered in combination with references not previously before the Examiner (Spagna and Glass).” *Id.* (citing *Oticon*, Patent 15, 15–16).

d) Patent Owner’s Sur-reply

Patent Owner responds that “none of the cases Petitioner cites stands for [the] proposition” “that discretionary denial is only appropriate where the same art was considered.” Prelim. Sur-reply 1. Patent Owner responds further that “Petitioner does not dispute that Handras was before the Examiner during prosecution of the ’551 patent” and that “neither Spagna nor Glass is relied upon by the Petitioner with regard to the independent claims, because it has no teachings relevant to the patentability of those claims.” Prelim. Sur-reply 2.

Turning to Vidal, Patent Owner contend that “Petitioner has identified no teachings of Vidal differing from Handras that are pertinent to the

patentability of the patented claims” and “Vidal does not contain any differences from Handras that are material to the question of patentability in this proceeding.” *Id.* at 3. Specifically, Patent Owner contends that “Vidal contains no explicit teaching regarding the alignment of the top edge of the chest strap and the top edge of the patch in Vidal.” *Id.* Thus, according to Patent Owner, “the teaching Petitioner describes as making Vidal more pertinent than Boatright *does not exist* in Vidal.” *Id.*

Finally, Patent Owner responds that “Vidal and Han[dr]as are both cumulative over Gentry” which was “presented to the Examiner in an IDS and acknowledged as such.” Prelim. Sur-reply 4 (citing Ex. 1016, 66). Specifically, Patent Owner contends that “Vidal and Handras do not contain any differences from Gentry that are material to the question of patentability in this proceeding.” *Id.*

e) *Discussion*

As Patent Owner does not argue that Spagna or Glass are the same or substantially the same art previously presented to the Office, we confine our discussion to Vidal and Handras.

We agree with Petitioner that the record fails to show that Vidal is cumulative of Boatright. During prosecution of the '878 patent (which is a parent of the '551 patent at issue in this proceeding), Boatright was distinguished because it did not have an upper edge of the cup that lies “along a same edge line as at least a portion of a top edge of the chest strap,” as required by claim 1. Prelim. Resp. 15 (citing Ex. 2066, 105). Vidal shows “an upper edge of the side patch lying along a same edge line as *at least portion* of the top edge of the chest strap” (as required by claim 1) in that Vidal’s Figure shows such alignment. Moreover, Vidal states that the

shape of its pocket (i.e. side patch) “can be adapted to the shape of the side strap.” Ex. 1027, 3:19–20. Given these disclosures, Vidal is not cumulative of Boatright. As to Sherwood and Gentry, Patent Owner’s arguments that these references relate to bras with pockets such that Vidal is cumulative to them are unconvincing as Vidal is relied upon to teach more than a bra with pockets. For these reasons, part one of the *Advance Bionics* framework is not satisfied for Vidal.

Both parties agree that Handras was presented to the Office in an Information Disclosure Statement. Pet. Reply 1; Prelim. Resp. 15. Accordingly, the first part of the framework is satisfied for Handras.

2. *Whether Petitioner has Demonstrated That the Office Erred in a Manner Material to the Patentability of the Challenged Claims*

Although the failure to satisfy part one of the *Advance Bionics* framework for Vidal provides one basis to refuse Patent Owner’s request to discretionarily deny institution, for completeness we also consider whether Petitioner shows a material error under part two of the framework for the challenges based on Handras.

a) *Petitioner’s Assertions*

Petitioner asserts that that the Office made a material error by not using Handras in a rejection of any claims.” Pet. 76. According to Petitioner, “[t]he Examiner’s silence with respect to Handras before allowing the ’551 claims reflects error and oversight.” *Id.*

b) *Patent Owner’s Response*

Patent Owner responds that “[t]he Petition contains no argument indicating a motivation to combine Handras with other references, and thus amounts to no more than a disagreement with the Examiner’s reasoning in

choosing not to reject based on Handras.” Prelim. Resp. 19. Patent Owner responds further that “[t]he Petitioner’s allegation of error amounts to no more than an invitation for the Board to substitute its judgement for that of the Examiner, and fails to give a reason why the Board should exercise its discretion to do so.” *Id.* Patent Owner contends that 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 recited in Claims 1 and 16 of the ‘551 patent” because “Handras 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. *Id.*

c) *Petitioner’s Reply*

Petitioner replies that “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.” Prelim. Reply 5 (citing Ex. 1021 ¶¶3–5, Figs. 1, 3, 5; Pet. 53–54). According to Petitioner, “[t]his is not merely ‘an invitation for the Board to substitute its judgement for that of the Examiner’; it is a demonstration of material error.” *Id.* (citing *Fubotv Media Inc. v. Dish Techs. L.L.C.*, No. IPR2024-00917 (PTAB Nov. 21, 2024); *Apple Inc. v. Geoscope Techs. Pte. Ltd.*, No. IPR2024-00031 (PTAB May 10, 2024)). In addition, Petitioner asserts that Patent Owner’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.” *Id.*

Petitioner replies further that “[t]he Examiner also materially erred in allowing the challenged claims over the Gentry reference.” Prelim. Reply 6. Petitioner asserts that “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.’” *Id.* (citing Ex. 2065, 2:19–24). Petitioner asserts further that “Gentry expressly discloses that ‘[t]he Closure 505 is illustrated as being located along the bottom margin of the Sport Bra Top Hem 545’” and that “the Examiner’s failure to recognize these express disclosures is material error.” *Id.* (citing Ex. 2065, at 5:56–57, Fig. 1).

d) Patent Owner’s Sur-reply

Patent Owner replies that “Gentry explicitly discloses a separation between the former and the latter, which are separated by at least the width of the ‘Sport Bra Top Hem’ at the bottom of which the upper patch edge in Gentry is located.” Prelim. Sur-reply 5 (citing Ex. 2065, 5:56–57, Fig. 1). Patent Owner replies further that “Petitioner’s argument that Gentry rendered the patented claims obvious supports the conclusion that Vidal and Handras do not add any material differences over the art already considered.” *Id.*

In addition, Patent Owner replies that “Handras does not contain any teaching indicating that it is designed to have objects inserted into or removed from the side pocket of Handras while the garment depicted in Handras is being worn.” Prelim. Sur-reply 5–6. According to Patent Owner, a “potential purpose for storage of items in an undergarment is concealment of those items.” *Id.* at 6. Patent Owner contends that “[a]bsent a teaching to the contrary, of which there is none, it would be reasonable for

the Examiner to conclude that the pocket is not designed for insertion and retrieval while the undergarment is being worn.” *Id.*

e) Discussion

We agree with Petitioner that the record shows that the Office erred in a manner material to the patentability of the challenged claims. Specifically, we agree with Petitioner that the Examiner erred in overlooking Handras’ teaching that “[i]t is an object of the invention to provide a pocket in a bra for receiving one of more items that is conveniently located for the wearer” Ex. 1021 ¶ 3 (quoted at Pet. 45). Handras explicitly states that the pocket is intended for storage of items such as “credit cards, car keys, cell phones, and the like.” *Id.* at ¶ 2. As these are items which a user would ordinarily need to access throughout the day, we agree with Petitioner that a person of ordinary skill in the art would understand Handras to teach pockets that are accessible while the bra is worn. *See* Pet. Reply 5.

3. Conclusion

Based on our analysis within the *Advanced Bionics* framework, we find that the Petitioner does not implicate § 325(d) in a manner sufficient to warrant discretionary denial, and we decline to exercise our discretion to deny institution.

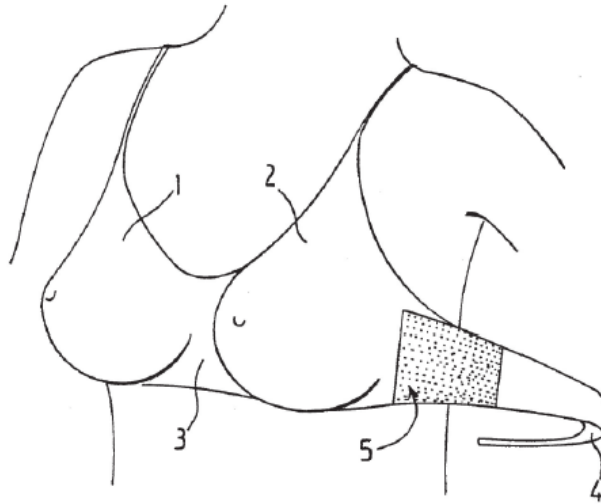
E. Prior Art

1. Summary of Vidal

Vidal is a publication of a European Patent Application titled “Wallet bra” and published on February 25, 1987. Ex. 1027, codes [11], [43], [54].¹¹ Vidal “relates to a wallet bra that allows its user to hide valuable objects

¹¹ We cite to the official translation of Vidal submitted by Petitioner.

such as, for example, bank notes, credit cards, or jewelry.” *Id.* at 1:1–3. Vidal’s only figure is reproduced below.



The bra illustrated in Vidal’s figure includes two cups 1 and 2 connected together by a piece of fabric 3, and two side strips 4 that extend each cup laterally and are provided at their ends with means allowing them to be hooked. *Id.* at 2:28–45. The bra includes a device for hiding valuable objects such as bank notes, credit cards, or jewelry. *Id.* This device is constituted of at least one pocket 5 that is arranged on a side strip 4. *Id.* Optionally, each side strip 4 may include a pocket 5. *Id.* This pocket 5 is arranged on the part of the side strip 4 that is located substantially under the corresponding arm of the user. *Id.*

Vidal explains that this pocket 5 may be constituted, in a first version of its invention, of the side strip 4 and of a piece of fabric of which at least three edges are combined with the side strip by sewing. *Id.* at 3:1–5. In another version of Vidal’s invention, side strip 4 is folded on itself, over a certain length, in order to manufacture this pocket 5. *Id.* at 3:8–20. Pocket 5 can be opened laterally or on its upper part. *Id.*

2. Summary of Spagna

Spagna is a U.S. patent application publication titled “Integrated Brassiere Pouch To Be Utilized with Medication Dispenser” and published December 27, 2007. Ex. 1028, codes [43], [54]. Spagna’s disclosed brassiere includes “an integrated pouch to accommodate an automated medication dispensing device” such as “an insulin pump.” *Id.* ¶ 8. Spagna’s Figure 2, reproduced below, illustrates a front view of the brassiere, Figure 3, reproduced below, illustrates the interior of the front of the brassiere of Figure 2 including an integrated pouch for supporting an automated medication dispensing device, and Figure 4, reproduced below, illustrates the interior view of the rear of the brassiere of Figure 2. *Id.* ¶¶ 13–15.

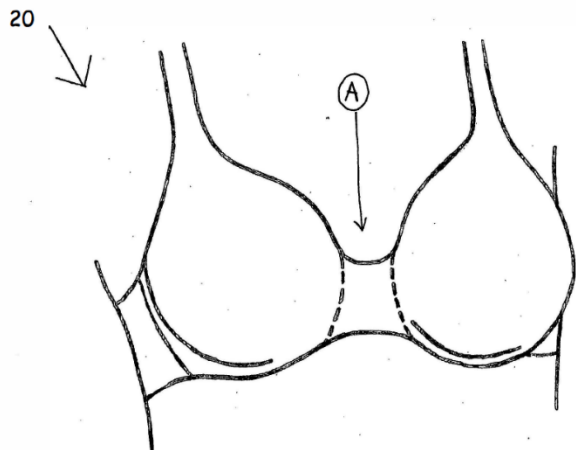


Fig. 2

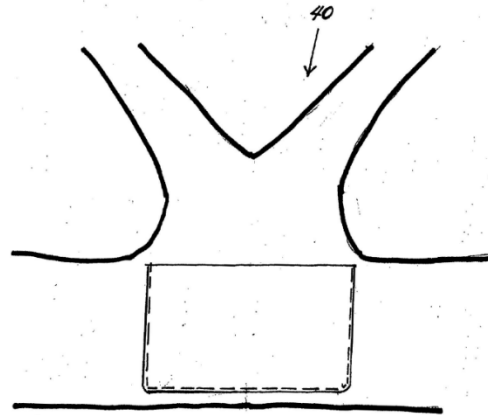


Fig. 4

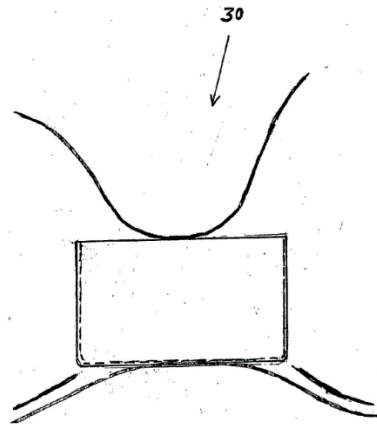


Fig. 3

Figures 2–4 illustrate brassieres including an integrated pouch for supporting an automated medication dispensing device. *Id.* ¶¶ 13–15. Specifically, Figure 2 illustrates a brassiere 20 where an optimal location for the dispensing device is at the center front A of the brassiere. *Id.* ¶ 17. Figure 3 illustrates the interior surface of the center front A of brassiere 20 of Figure 2, with a pouch 30 integrated into the interior surface of the brassiere. *Id.* ¶ 18. Figure 4 illustrates another embodiment in which an integrated pouch 40 similar to that of Figure 3 is placed on the interior surface of the back of brassiere 20, such that the integrated pouch may include a larger surface area than that of Figure 3 while having a lower profile. *Id.* ¶ 20.

3. Summary of Glass

Glass is a U.S. Design Patent that relates to a “sports bra with [a] water bottle pocket on back.” Ex. 1029, code (54). Figure 2, reproduced below, illustrates a rear-elevational view of a sports bra having a water bottle pocket. *Id.*

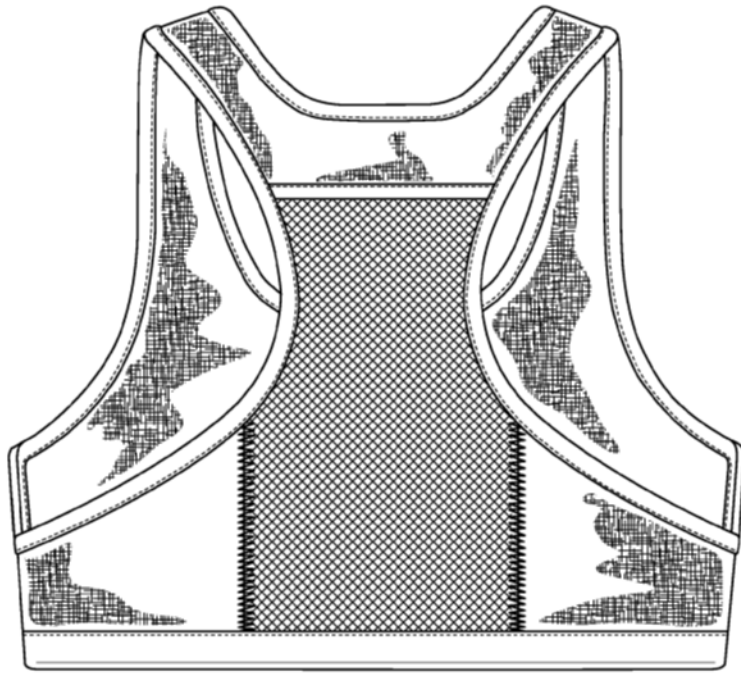


FIG. 2

4. *Summary of Handras*

Handras is a U.S. patent application publication titled “Bra with Storage Pocket” and published February 20, 2014. Ex. 1021, codes [43], [54]. Figure 3 of Handras, reproduced below, illustrates a view of a side panel of the bra of Figure 2 with a pocket. *Id.* ¶ 16.

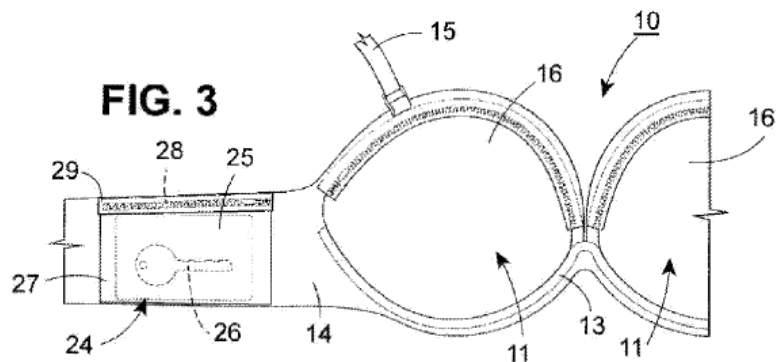


FIG. 3

As shown in Figure 3, each side panel 14 of bra 10 is provided with a pouch 24 for receiving a small item, such as a credit card 25 and a key 26. *Id.* ¶ 28. Pouch 24 is formed by a panel 27 of fabric sewn or otherwise secured to side panel 14, a zipper 28, and a flap 29 for covering over zipper 28. *Id.*

F. Ground 1A: Alleged Unpatentability of Claims 1–6, 8, 12, 13, and 15–18 Over Vidal

Petitioner asserts that claims 1–6, 8, 12, 13, and 15–18 are unpatentable over Vidal. Pet. 18–39. Patent Owner disagrees arguing that Vidal fails to disclose limitation [1F]. Prelim. Resp. 21–29.

1. Claim 1

We have reviewed Petitioner’s assertions, and the evidence, arguments, and testimony in support thereof, for all of the limitations of claim 1. As Patent Owner only disputes Petitioner’s assertions regarding limitation [1F], we focus our discussion on that limitation. Limitation [1F] requires “an upper edge of the side patch lying along the same edge line as at least a portion of a top edge of the chest strap.” Ex. 1015, 7:5–7.

Petitioner asserts that Vidal discloses a pocket that “is formed by a piece of fabric with upper and lower edges along the length of the strap, and side edges.” Pet. 23 (citing Ex. 1027, Fig. 1). Petitioner asserts further that Vidal “discloses a pocket formed ‘of the side strip and of a piece of fabric of which at least three edges are combined with the side strip by any suitable means, in particular by sewing.’” *Id.* (citing Ex. 1027, 3:2–5). Thus, according to Petitioner, a person of ordinary skill “would understand each patch to have edges along the length of the chest strap.” *Id.* (citing Ex. 1001 ¶ 1033).

Patent Owner responds that “the upper edge of the chest strap in this illustration can be seen clearly diverging from the upper edge of the patch, rather than ‘lying along a same edge line.’” Prelim. Resp. 22. Thus, according to Patent Owner, “Petitioner has failed to demonstrate that Vidal teaches, suggests, or motivates each element of” claim 1.

We agree with Petitioner that the record demonstrates that Vidal discloses limitation [1F]. This limitation merely requires that “an upper edge of the side patch” lie “along the same edge line as at least a *portion* of a top edge of the chest strap.” Ex. 1015, 7:5–7. As shown in its Figure, Vidal’s patch lies along a portion of its chest strap, even if it also diverges from that edge in another portion. As such, Vidal’s disclosure is sufficient to meet this limitation or at the very least suggest it to one of ordinary skill in the art.

Based on the evidence, arguments, and testimony of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that independent claim 1 would have been obvious in view of Vidal.

2. *Claim 16*

Claim 16 is similar to claim 1. *Compare* Ex. 1015, 6:61–7:11 *with id.* at 8:16–34. Petitioner’s assertions for claim 16 are also similar to its assertions for claim 1. *See* Pet. 36–38 (referring to corresponding limitations of claim 1 for its assertions for each limitation of claim 16).

Patent Owner addresses the limitations of claims 1 and 16 together. Prelim. Resp. 21–22. In particular, Patent Owner addresses the limitations of claims 1 and 16 pertaining to the upper edge of the patch lying along a same edge line together. *Id.*

For the reasons discussed in Section II.F.1 above, we have determined that the record sufficiently demonstrates that Vidal discloses or suggests the limitation pertaining to the upper edge of the patch lying along the same edge line for claim 1. For the same reasons, we likewise determine that the record sufficiently demonstrates that Vidal discloses or suggest this corresponding limitation in claim 16 (i.e. “the side patch upper edge lying along a same edge line as at least a portion of the top edge of the chest strap”). Ex. 1051, 8:29–31.

Based on the evidence, arguments, and testimony of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that independent claim 16 would have been obvious in view of Vidal.

3. *Claims 2–6, 8, 12, 13, 15, 17, and 18*

Claims 2–6, 8, 12, 13, and 15 depend from claim 1, and claims 17 and 18 depend from claim 16. Ex. 1015, 7:12–26, 7: 33–34, 8:1–8, 8:12–15, 8:35–38. Petitioner sets forth its assertions for claims 2–6, 8, 12, 13, and 15 on pages 25–36 of the Petition. For claim 17, Petitioner refers back to its assertions for claims 5 and 16, and for claim 18, Petitioner refers back to its assertions for claims 16 and 3. Pet. 38–39.

Patent Owner does not present separate arguments for the patentability of any of these challenged dependent claims. Prelim. Resp. 22. Rather, Patent Owner contends that “because the Petition cannot demonstrate that claims 1 and 16 are obvious over Vidal, Ground 1 fails on claims 2–15 and 17–20 as well.”¹² *Id.*

¹² We note that claims 9–11 and 14 are not challenged in the instant Petition. Pet. 1.

We have reviewed Petitioner’s assertions for claims 2–6, 8, 12, 13, 15, 17, and 18, as well as the evidence and testimony in support thereof. We determine that the record sufficiently demonstrates that Vidal discloses or suggest the limitations of claims 2–6, 8, 12, 13, 15, 17, and 18. Based on the evidence, arguments, and testimony of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that dependent claims 2–6, 8, 12, 13, 15, 17, and 18 would have been obvious in view of Vidal.

G. Ground 1B: Alleged Unpatentability of Claim 7 Over the Combined Teachings of Vidal and Spagna or Glass

Petitioner asserts that the combined teachings of Vidal and Spagna or Glass render claim 7 unpatentable. Pet. 39–40. Patent Owner contends that neither Spagna nor Glass “can cure the deficiency of Vidal with regard to Claim 1, at least because neither Spagna nor Glass teaches, suggests, or motivates a side pocket, let alone a side pocket as claimed in the ‘551 patent.” Prelim. Resp. 29–30. Patent Owner contends further that “[a]ccordingly, Ground 1B fails to demonstrate obviousness of claim 7 over Vidal in view of Spagna or Glass.” *Id.* at 30.

For the reasons discussed in Section II.F.1, we determined that Vidal has no such deficiency. We have reviewed Petitioner’s assertions pertaining to the limitations of claim 7, as well as the evidence, argument, and testimony in support thereof. We determine that the current record is sufficient to demonstrate that the combined teachings of Vidal and Spagna or Glass render claim 7 unpatentable. For these reasons, we further determine that Petitioner has demonstrated a reasonable likelihood of prevailing for claim 7 based on the challenge set forth in Ground 1B.

H. Ground 2A: Alleged Unpatentability of Claims 1–6, 8, 12, 13, and 15–18 Over Handras

Petitioner asserts that claims 1–6, 8, 12, 13, and 15–18 are unpatentable over Handras. Pet. 44–67. Patent Owner disagrees arguing that Handras does not disclose limitation [1H]. Prelim. Resp. 30–33.

1. Claim 1

We have reviewed Petitioner’s assertions, and the evidence, arguments, and testimony in support thereof, for all of the limitations of claim 1. As Patent Owner only disputes Petitioner’s assertions regarding limitation [1H], we focus our discussion on that limitation. Limitation [1H] requires an opening in a side patch “capable of repeated receiving and removal of an item when being worn by the wearer.” Ex. 1015, 7:8–10.

Petitioner asserts that “Handras contemplates the use of bra pockets ‘to hold items, such as, credit cards, car keys, cell phones and the like.’” Pet. 51–52 (citing Ex. 1021, Fig. 3, ¶¶ 2, 28). Petitioner asserts further that a person of skill in the art “would have understood that such a pocket is necessarily designed for temporarily holding items” and that Handras’ “pockets—designed with a ‘zipper’—necessarily had openings ‘capable of repeated receiving and removal of an item’ when worn.” *Id.* at 52 (citing Ex. 1001 ¶ 1088).

Patent Owner contends that “Handras does not contain an explicit teaching of a pocket with an ‘upper opening capable of repeated receiving and removal of an item when being worn by the wearer.’” Prelim. Resp. 30. Patent Owner contends further that “[t]he pocket in Handras is ‘provided on the inside’ of the chest strap” and as shown in Fig. 5 Handras’ pocket is “located directly under the armpit of the wearer, in a difficult location to access while the bra is worn, while in FIG. 1 the portion of the strap that

would bear the pocket is similarly tucked away.” *Id.* According to Patent Owner, “[t]his suggests that the inventor of Handras was contemplating a pocket easily accessible to the wearer in the sense that the wearer could remove the bra and access an item concealed in the pocket with relative ease, rather than that they could, or would attempt to, reach into the pocket while the bra was being worn.” *Id.* at 31. Thus, according to Patent Owner, Petitioner fails to demonstrate that Handras discloses or suggests this limitation.

We note that Petitioner’s position is supported by Ms. Baran’s declaration (Ex. 1001 ¶ 1088), as well as, Handras’ disclosure that its pocket is for holding “items, such as, credit cards, car keys, cell phones and the like” which are items a user would likely want to access without taking the bra off. We further note that Patent Owner’s position is only supported by attorney argument. On the current record, we determine that Handras’ disclosure is sufficient to meet this limitation or at the very least suggest it to one of ordinary skill in the art.

Based on the evidence, arguments, and testimony of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that independent claim 1 would have been obvious in view of Handras.

2. *Claim 16*

Petitioner’s assertions for claim 16 are also similar to its assertions for claim 1. *See* Pet. 64–66 (referring to corresponding limitations of claim 1 for its assertions for each limitation of claim 16).

Patent Owner addresses the limitations of claims 1 and 16 together. Prelim. Resp. 30–32. In particular, Patent Owner addresses the limitations

of claims 1 and 16 pertaining to the pocket having upper opening capable of repeated receiving and removable of an item together. *Id.*

For the reasons discussed in Section II.H.1 above, we have determined that the record sufficiently demonstrates that Handras discloses or suggests limitation [1H] pertaining to the pocket having upper opening capable of repeated receiving and removable of an item together for claim 1. For the same reasons, we likewise determine that the record sufficiently demonstrates that Handras discloses or suggest the corresponding limitation in claim 16 (i.e. “the opening capable of repeated receiving and removal of an item when being worn by the wearer”). Ex. 1015, 8:32–34.

Based on the evidence, arguments, and testimony of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that independent claim 16 would have been obvious in view of Handras.

3. *Claims 2–6, 8, 12, 13, 15, 17, and 18*

Claims 2–6, 8, 12, 13, and 15 depend from claim 1, and claims 17 and 18 depend from claim 16. Ex. 1015, 7:12–26, 7: 33–34, 8:1–8, 8:12–15, 8:35–38. Petitioner sets forth its assertions for claims 2–6, 8, 12, 13, and 15 on pages 53–64 of the Petition. For claim 17, Petitioner refers back to its assertions for claims 5 and 16, and for claim 18, Petitioner refers back to its assertions for claims 16 and 3. Pet. 66–67.

Patent Owner does not present separate arguments for the patentability of any of the challenged dependent claims. Prelim. Resp. 32. Rather, Patent Owner contends that “because the Petition cannot

demonstrate that claims 1 or 16 is obvious over Handras, Ground 1 fails on claims 2–15 and 17–20 as well.”¹³ *Id.*

We have reviewed Petitioner’s assertions for claims 2–6, 8, 12, 13, 15, 17, and 18, as well as the evidence and testimony in support thereof. We determine that the record sufficiently demonstrates that Handras discloses or suggest the limitations of claims 2–6, 8, 12, 13, 15, 17, and 18. Based on the evidence, arguments, and testimony of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that dependent claims 2–6, 8, 12, 13, 15, 17, and 18 would have been obvious in view of Handras.

I. Ground 2B: Alleged Unpatentability of Claim 7 Over the Combined Teachings of Handras and Spagna or Glass

Petitioner asserts that the combined teachings of Handras and Spagna or Glass render claim 7 unpatentable. Pet. 67–72. Patent Owner contends that neither Spagna nor Glass “can cure the deficiency of Handras with regard to Claim 1, at least because neither Spagna nor Glass teaches, suggests, or motivates a side pocket, let alone a side pocket as claimed in the ‘551 patent.” Prelim. Resp. 33–34. Patent Owner contends further that “[a]ccordingly, Ground [2]B¹⁴ fails to demonstrate obviousness of claim 7 over Handras in view of Spagna or Glass.” *Id.* at 30.

For the reasons discussed in Section II.H.1, we determined that Handras has no such deficiency. We have reviewed Petitioner’s assertions pertaining to the limitations of claim 7, as well as the evidence, arguments, and testimony in support thereof. We determine that the current record is

¹³

¹⁴ Patent Owner refers to “Ground 1B.” Prelim. Resp. 34. We understand this to be a typographical error.

sufficient to demonstrate that the combined teachings of Handras and Spagna or Glass render claim 7 unpatentable. For these reasons, we further determine that Petitioner has demonstrated a reasonable likelihood of prevailing for claim 7 based on the challenge set forth in Ground 2B. Based on the evidence, arguments, and testimony of record at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that dependent claim 7 would have been obvious in view of Handras.

J. Objective Indicia of Non-obviousness

Patent Owner submits evidence of objective indicia to support its argument that the claims of the '551 patent would not have been obvious. Prelim. Resp. 3–12, 23–29, 32–33.

1. Legal Standards

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, secondary considerations (objective evidence of non-obviousness) 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 indicia of non-obviousness.

In order to accord substantial weight to secondary considerations in an obviousness analysis, “the evidence of secondary considerations 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).

Although the 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) (emphasis added)); *Quanergy*, 24 F.4th at 1417. On the other hand, “[w]hen 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.

In the first, a patent owner may rely on a rebuttable presumption of nexus as follows:

As first recognized in *Demaco* . . . , a patentee is entitled to a rebuttable presumption of nexus between the asserted evidence of secondary considerations and a patent claim 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)) . . .

. . . 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.

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

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 secondary considerations.” *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. Based on the facts of the case in *Fox Factory*, the court found

that “nexus may not be presumed” because “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 and the court rejected arguments that the patent claims broadly cover the product. *Id.* at 1376–1377.

“A finding that a presumption of nexus is inappropriate does not end the inquiry into secondary considerations,” however. *Id.* at 1373. “To the contrary, the patent owner is still afforded an opportunity to prove nexus by showing that the evidence of secondary considerations 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 secondary consideration actually results 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 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.

a) Evidence Related to Nike Products

(1) Presumption of Nexus

“The presumption [of nexus] applies ‘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.’”

TalexMedical, LLC v. Becon Medical Limited, 2022 WL 2898934, at *8 (Fed. Cir. July 22, 2022) (citing *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))).

Patent Owner does not address nexus in its Preliminary Response. In comparing the claims to Nike’s Swoosh Pocket Bra, Swoosh Bra, and Swoosh on the Run (collectively, Nike Products) we understand Patent Owner to assert that the Nike Products are co-extensive with the claims of the ’551 patent. *See generally* Prelim. Resp. 3–12, 23–29, 32–33 (citing Exs. 2043–2063).

The difficulty with the claim charts and pictures submitted by Patent Owner is that they fail to establish that the Nike Products are coextensive with the ’551 patent’s claimed invention. For example, many of the claim charts do not relate to the ’551 patent and demonstrate that the Nike Products include many features not claimed by the ’551 patent. *See e.g.*, Ex. 2044 (discussing a back pocket).

Nexus, however, may still be shown if the evidence of secondary considerations is the direct result of the unique characteristics of the claimed invention. *See Fox Factory*, 944 F.3d at 1373–74 (“[T]he patent owner is still afforded an opportunity to prove nexus by showing that the evidence of secondary considerations is *the ‘direct result of the unique characteristics of*

the claimed invention.” (emphasis added)). We, thus, turn to Patent Owner’s evidence.

(2) *Copying*

Patent Owner asserts that the Nike Products are copies of the ’551 patent’s claimed invention because “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.” Prelim. Resp. 26. Sharon Goff testifies that she corresponded with Nike about her Pocket Bar and submitted examples of her products. *See* Exs. 2001, 2035.

We have reviewed the testimony of Sharon Goff and supporting evidence but do not see sufficient evidence of copying. Neither Sharon Goff’s testimony nor the Nike Idea Submission is specific to the ’551 patent’s claimed invention. *See generally* Exs. 2001, 2035. For example, none of the Nike Idea Submission pictures sufficiently shows the unique feature of the ’551 patent’s claimed invention, which includes an upper edge of the side patch lying along the same edge line as at least a portion of a top edge of the chest strap. *See, e.g.*, Ex. 2035, 4.

Patent Owner also relies upon two infringement claim charts as allegedly showing that Nike copied the ’551 patent’s claimed invention. Prelim. Resp. 26 (citing Exs. 2045, 2050). These exhibits, however, do not provide sufficient evidence to 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.”).

b) Evidence Related to Sharon Goff's Pocket Bra

(1) Presumption of Nexus

As discussed above, we understand Patent Owner to contend that Sharon Goff's Pocket Bra is co-extensive with the claims of the '551 patent. *See generally* Prelim. Resp. 3–12, 23–29, 32–33. Patent Owner, however, indicates 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”). Much of Patent Owner's evidence of objective indica relate to variations of the Pocket Bra that do not include the '551 patent's claim invention, which includes an upper edge of the side patch lying along the same edge line as at least a portion of a top edge of the chest strap. *E.g., see* Ex. 2008–2034 (infringement charts for other of Sharon Goff's patents).

Based on the record at this stage of the proceeding, we do not apply a presumption of nexus between the '551 patent's claimed invention and Sharon Goff's Pocket Bra.

We next evaluate Patent Owner's evidence of secondary considerations to determine whether the evidence is the direct result of the unique characteristics of the claimed invention.

(2) Licenses

Patent Owner argues that evidence of non-obviousness “is found in the licenses to competitors of the other patents in its family.” Prelim. Resp. 3, 27–28 (citing Ex. 2004, 2006, 2007).¹⁵ In particular, Patent Owner points

¹⁵ Ex. 2005 which is cited at page 3 has been expunged from the record.

to licenses to Urban Savage, LLC, Rabbit, LLC, and Senita. *Id.* at 3¹⁶, 27. Patent Owner asserts that a nexus exists because the licensees agree to mark their products with the licensed patents. *Id.* at 28.

However, none of the licenses to Urban Savage, LLC, Rabbit, LLC, Senita are for the '551 patent. *See* Ex. 2004, 9; Ex. 2006, 8.; Ex. 2007, 7.

We, thus, are not persuaded that there is a nexus between the alleged licenses and a unique feature of the '551 patent's claimed invention and that the evidence of licensing demonstrates non-obviousness of the '551 patent's claimed invention.

(3) Commercial Success

Relying upon the same licenses, Patent Owner argues that “there is some evidence of commercial success of products linked to the '551 patent and the other Disputed Patents.” Prelim. Resp. 28. 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 a gross revenue of at least 2.25 million dollars with respect to the licensed products. *Id.* at 29.

However, none of the licenses to Urban Savage, LLC, Rabbit, LLC, Senita are for the '551 patent. *See* Ex. 2004, 9; Ex. 2006, 8.; Ex. 2007, 7.

We, thus, are not persuaded that there is a nexus between the alleged commercial success and a unique feature of the '551 patent's claimed invention and that the evidence of commercial success demonstrates non-obviousness of the '551 patent's claimed invention.

¹⁶ Patent Owner points to another license but does not provide as evidence a copy of those license. *See* Prelim. Resp. 3; Ex. 3003. We cannot consider evidence that is not made of record.

(4) Industry Praise

Patent Owner asserts that there is “industry praise for products linked to the ’551 patent and the other Disputed Patents.” Prelim. Resp. 29.

As evidence of industry praise 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 which 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.” *Id.* at 2–3. 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 ’551 patent’s claimed invention, which includes an upper edge of the side patch lying along the same edge line as at least a portion of a top edge of the chest strap.

We, thus, are not persuaded that there is a nexus between this alleged industry praise and a unique feature of the ’551 patent’s claimed invention and that this evidence of industry praise demonstrates non-obviousness of the ’551 patent’s claimed invention.

As further evidence of industry praise, Patent Owner submits the testimony of the inventor of the ’551 patent Sharon Goff. Prelim. Resp. 29 (citing. Ex. 2001 ¶¶ 6–7). Sharon 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.

Sharon Goff’s testimony, however, does not sufficiently inform us which variation of the Pocket Bra is being praised. Further, we give little weight to the testimony of Sharon Goff, who, as the inventor, is an interested party, as to alleged industry praise spoken by others.

We, thus, are not persuaded that there is a nexus between this alleged industry praise and a unique feature of the ’551 patent’s claimed invention and that this evidence of alleged industry praise demonstrates non-obviousness of the ’551 patent’s claimed invention.

c) Conclusion as to Objective Indicia of Non-Obviousness

Given the above, on this record, we give little weight to Patent Owner’s objective evidence when determining whether the claimed invention as a whole would have been obvious to a skilled artisan.

III. CONCLUSION

After considering the evidence, arguments, and presented in this proceeding, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail in establishing that claim 1–8, 12, 13, and 15–19 are unpatentable.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claims 1–8, 12, 13, and 15–18 of the '551 patent on the unpatentability grounds asserted in the Petition; and

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

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