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13 UNITED STATES DISTRICT COURT
14 CENTRAL DISTRICT OF CALIFORNIA
15

16 NIKE, INC.,	)	Case No. 2:23-cv-09346-AB-PVC
	)	
17 Plaintiff,	)	
	)	SKECHERS U.S.A., INC.'S
18 vs.	)	PRELIMINARY INVALIDITY
	)	CONTENTIONS
19	)	
20 SKECHERS U.S.A., INC.,	)	
	)	
21 Defendant.	)	

Skechers U.S.A. v. Nike, Inc.
IPR2025-00141
Patent No. 8,266,749
Ex. 2005

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1 **I. INTRODUCTION**

2 Pursuant to the Court’s Scheduling Order Setting Pretrial and Trial Dates
3 (ECF No. 47), and the Court’s Order on Case Schedule (ECF No. 49), Defendant
4 Skechers U.S.A., Inc. (“Skechers” or “Defendant”) provides these Preliminary
5 Invalidity Contentions to Plaintiff Nike, Inc. (“Nike” or “Plaintiff”) for the
6 following patents (collectively, the “Asserted Patents”) and claims (collectively, the
7 “Asserted Claims”) identified as asserted in Nike’s March 1, 2024 Response to
8 Interrogatory No. 1 and Exhibits A-F attached thereto, which purport to be Nike’s
9 Initial Infringement Contentions (the “Apparent Infringement Contentions”¹):

- 10 • U.S. Patent No. 8,266,749 (the “749 Patent”) — Claims 1-8, 11-18, 21
11 (the “749 Asserted Claims”)
- 12 • U.S. Patent No. 9,060,562 (the “562 Patent”) — Claims 1-23 (the “562
13 Asserted Claims”)
- 14 • U.S. Patent No. 9,510,636 (the “636 Patent”) — Claims 1-27 (the “636
15 Asserted Claims”)
- 16 • U.S. Patent No. 9,730,484 (the “484 Patent”) — Claims 1, 5-9, 11-17 (the
17 “484 Asserted Claims”)
- 18 • U.S. Patent No. 9,918,511 (the “511 Patent”) — Claims 1-20 (the “511
19 Asserted Claims”)
- 20 • U.S. Patent No. 9,986,781 (the “781 Patent”) — Claims 1-20 (the “781
21 Asserted Claims”)

22 Skechers addresses the invalidity of the Asserted Claims below and concludes
23 with a description of the accompanying document production and identification of
24 additional reservations and explanations. These Preliminary Invalidity Contentions
25

26
27 ¹ Skechers notes that Nike did not serve infringement contentions on the date
28 agreed to by the parties, namely, March 22, 2024. Skechers therefore responds to the
Apparent Infringement Contentions appended to Nike’s interrogatory responses
served on March 1, 2024.

1 use the acronym “POSITA” to refer to a person having ordinary skill in the art to
2 which the claimed inventions pertain.

3 **II. PRIORITY DATE OF THE ASSERTED PATENTS AND CLAIMS**

4 The Asserted Patents claim entitlement on their face to the following priority
5 dates:

- 6 • The ’749 Patent claims entitlement to a priority date of March 3, 2004.
- 7 • The ’562 Patent claims entitlement to a priority date of February 20,
8 2012.
- 9 • The ’636 Patent claims entitlement to a priority date of February 20,
10 2012.
- 11 • The ’484 Patent claims entitlement to a priority date of November 10,
12 2006.
- 13 • The ’511 Patent claims entitlement to a priority date of March 3, 2004.
- 14 • The ’781 Patent claims entitlement to a priority date of March 3, 2004.

15 It is Nike’s burden to show entitlement to the priority dates, and Skechers
16 asserts that Nike has failed to, and cannot, meet that burden.

17 For example, both the ’562 and 636 Patents claim priority to U.S. Application
18 No. 13/400,511, but Nike has not shown that the ’562 and ’636 Asserted Claims are
19 supported by this application.

20 **III. ’749 PATENT**

21 **A. Prior Art References²**

22 Skechers identifies the following prior art presently known to Skechers to
23 anticipate the ’749 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
24 (e), and/or (g), either expressly or inherently as understood by a POSITA, and/or to
25 render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers

26
27 ² To the extent one or more prior art patents, publications, or products are
28 identified in the claim charts attached hereto but are not included in the tables and
lists below, those prior art patents, publications, or products should also be considered
as prior art to the ’749 Patent.

generally identifies and incorporates by reference herein all prior art and invalidity arguments asserted against the '749 Patent, whether during the original prosecution of the '749 Patent, before the Patent Trial and Appeals Board, or during any of the litigations previously filed by Nike involving the '749 Patent, including, for example, Case No. 3:21-cv-01780 (D. Or.) ("the adidas Litigation"), ITC Inv. No. 337-TA-1289 ("the adidas ITC Investigation"), Case No. 1:18-cv-10876 (D. Mass.) ("the Puma Litigation"), Case No. 1:23-cv-00771 (S.D.N.Y.) ("the lululemon Litigation"), or Case No. 1:23-cv-12666 (D. Mass.) ("the New Balance Litigation"). In addition, discovery is outgoing, and Skechers has served document requests and interrogatories for which responses are outstanding that Skechers expects to reveal additional prior art. Furthermore, Skechers is generally aware of information pertaining to prior art from other proceedings that is currently unavailable to Skechers, including because such information may be subject to a protective order. Once Skechers receives relevant information, it will timely supplement its invalidity contentions, as appropriate.

1. Prior Art Patents and Publications³

Prior Art	Date of Issue or Publication
US 1,538,263	2/2004
US 1,597,934	8/1926
US 1,803,554	5/1931
US 1,888,172	6/1932
US 1,902,780	3/1933
US 1,965,969	7/1934
US 2,161,472	6/1939
US 2,467,237	4/1949
US 2,675,631	4/1954

³ Skechers incorporates by reference all prior art references cited in the patents and publications listed herein and/or their file histories.

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Prior Art	Date of Issue or Publication
US 1,910,251	5/1933
US 2,001,293	7/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,314,098	3/1943
US 2,330, 199	9/1943
US 2,400,692	5/1946
US 2,440,393	4/1948
US 2,467.237	4/1949
US 2,538,673	1/1951
US 2,586,045	2/1952
US 2,598,217	5/1952
US 2,641,004	6/1953
US 2,675,631	4/1954
US 2,701,458	2/1955
US 2,714,813	8/1955
US 2,770,055	11/1956
US 3,372,415	3/1968
US 3,497,971	3/1970
US 3,694,940	10/1972
US 3,703,820	11/1972
US 3,835,555	9/1974
US 3,851,315	11/1974
US 3,882,697	5/1975
US 3,937,039	2/1976
US 3,985,003	10/1976
US 4,038,840	8/1977
US 4,150,498	4/1979

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Prior Art	Date of Issue or Publication
US 4,211,806	7/1980
US 4,255,949	3/1981
US 4,276,671	7/1981
US 4,317,292	3/1982
US 4,373,361	2/1983
US 4,430,811	2/1984
US 4,447,967	5/1984
US 4,494,266	1/1985
US 4,527,403	7/1985
US 4,531,525	7/1985
US 4,607,439	8/1986
US 4,663,946	5/1987
US 4,722,202	2/1988
US 4,785,558	11/1988
US 4,813,158	3/1989
US 4,852,272	8/1989
US 5,095,720	3/1992
US 5,099,588	3/1992
US 5,125,116	6/1992
US 5,253,434	10/1993
US 5,323,627	6/1994
US 5,345,638	9/1994
US 5,353,524	10/1994
US 5,385,036	1/1995
US 5,461,884	10/1995
US 5,511,323	4/1996
US 5,526,584	6/1996
US 5,566,396	10/1996

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Prior Art	Date of Issue or Publication
US 5,592,836	1/1997
US 5,711,168	1/1998
US 5,735,145	4/1998
US 5,746,013	5/1998
US 5,836,179	11/1998
US 5,955,172	9/1999
US 6,108,943	8/2000
US 6,192,717	2/2001
US 6,250,115	6/2001
US 6,272,888	8/2001
US 6,287,168	9/2001
US 6,308,438	10/2001
US 6,330,814	12/2001
US 6,477,865	11/2002
US 6,505,422	1/2003
US 6,558,784	5/2003
US 6,685,535	2/2004
US 6,691,535	2/2004
US 6,708,530	3/2004
US 6,899,591	5/2005
US 6,910,288	6/2005
US 6,931,762	8/2005
US 7,016,867	3/2006
US 7,051,460	5/2006
US 7,107,235	9/2006
US 7,155,846	1/2007
US 7,204,042	4/2007
US 7,208,196	4/2007

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Prior Art	Date of Issue or Publication
US 7,347,011	3/2008
US 7,350,321	4/2008
US 7,707,747	5/2010
US 7,814,598	10/2010
US 2001/0055684	12/2001
US 2002/0078599	6/2002
US 2003/0069807	4/2003
US 2003/0126762	7/2003
US 2004/0003629	1/2004
US 2004/0083625	5/2004
US 2004/0087230	5/2004
US 2004/0118018	6/2004
US 2004/0216332	11/2004
US 2005/0188564	9/2005
US 2005/0267775	12/2005
US 2006/0112595	6/2006
US 2006/0162190	6/2006
US 2006/0243000	11/2006
CN 1067566A	1/1993
CN 2187379Y	1/1995
CN 1411762	4/2003
CN 1429512	7/2003
DE 627878	3/1936
DE 29700546U1	5/1997
EP 0692563 A1	1/1996
EP 1437057	7/2004
GB 1539886	2/1979
IT SB20010061	1/2003

1		Prior Art	Date of Issue or Publication
2		JP S49-39620	10/1974
3		JP H1-178708	12/1989
4		JP 2001/16444	6/2001
5		JP 2002/065303	3/2002
6		JP 2002/129401	5/2002
7		JP H3-3203	1/1991
8		JP H6-113905	4/1994
9		JP 3118168U	12/2005
10		JP 2006000258	1/2006
11		KR 200251085	11/2001
12		KR 100299525	11/2001
13		KR 840001345	9/1984
14		KR 200297841	12/2002
15		KR 19980018846	6/1998
16		KR 20020033862	5/2002
17		KR 20010074977	8/2001
18		KR 20010012414	2/2001
19		KR 19990024704	4/1999
20		KR 910008958	10/1991
21		KR 20010088838	9/2001
22		WO 90/03744	4/1990
23		WO 92/22223	12/1992
24		WO 1998/043506	10/1998
25		Santoni S.p.A. publication: Knitting Wear, SM8 Top 1	No later than 3/3/2003
26		David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (3rd ed., Woodhead Publishing Ltd. 2001)	2001

Prior Art	Date of Issue or Publication
Paul Burall, CoID Design Awards, Design	6/1969
International Standard ISO 8117: Textile machinery – Knitting machines – Nominal diameters of circular machines	2/2003
Ardis Koester, Analyzing the Color, Design and Texture of Fabric	5/1993
Susanna E. Lewis & Julia Weissman, A Machine Knitter's Guide to Creating Fabrics	1986
Dr. Isabel B. Wingate, Fairchild's Dictionary of Textiles (6th ed.)	1979
Manuals for Stoll Flat Knitting Machinery	No later than 3/3/2003
Manuals for Santoni Circular Knitting Machinery	No later than 3/3/2003
Brandon Richard, Bargain Buys: 20 Sneaker Steals Found in Vintage Eastbay Catalogs, www.complex.com/sneakers/a/brandon-richard/vintage-eastbay-sneaker-prices	9/2015
Caroline Cox, Vintage Shoes (Carlton Books)	2008
1989 Reebok AXT SXT CXT Cross-Training Shoes Vintage Print Ad, www.ebay.com/itm/362604032836	1989
Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State	2000

Prior Art	Date of Issue or Publication
University Press)	
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
Stoll Sirix 100 / 200 Manual Part 1 and Part 2	NA

Skechers additionally identifies and relies on patent or publication references that describe or are otherwise related to the prior art products identified below.

2. Prior Art Products

Skechers also contends that the asserted claims of the '749 Patent are invalid based on public knowledge and uses and/or offers for sale or sales of products that are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the United States by other inventors who had not abandoned, suppressed, or concealed them under pre-AIA 35 U.S.C. § 102(g), and that anticipate or render obvious under 35 U.S.C. § 103 the asserted claims.

The following lists prior art products that invalidate under 35 U.S.C. § 102 or render obvious under 35 U.S.C. § 103 the asserted claims by the name of the item, and Skechers may rely on all versions of the following prior art products commercially sold, offered for sale, publicly known or used before the priority date of the '749 Patent, including things as well as documents describing the same:

Prior Art Product	Date of Public Use
Stoll Flat Knitting Machinery in operation within the United States	No later than 3/3/2003
Santoni Circular Knitting Machinery in operation within the United States	No later than 3/3/2003
Nike Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Air Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Aquasock, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/2001
adidas engineered warp footwear, publicly known, used, and/or on sale within the United States. Including: white and blue adidas 2000 Olympic Wrestling shoe, Olympic Rowing Shoe, adidas black and white Olympic sprinting shoes, adidas Olympic Boxing shoes, adidas Olympic marathon orange and white shoe, 2003 adistar RD shoe, adidas white and blue shoe 2003 a3 shoe, adidas YY Tenet Flower shoe, and adidas Climacool shoe	No later than 3/3/2003
Pan Am Slipper publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Capezio Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Karl Mayer Warp Knitting Machinery in operation within the United States	No later than 3/3/2003

Prior Art Product	Date of Public Use
Steve Blevins, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Robert Szanto for Simply Knitting Mills, Inc., publicly known, used, and/or on sale within United States	No later than 3/3/2003

Skechers' positions with respect to these references are stated on information and belief, and are supported by the information and documents that will be produced by Skechers, Nike, and/or third parties. Because discovery is not complete, Skechers continues to investigate these products and other relevant products, including those used, sold, and/or offered for sale by Nike, third parties, and Skechers and will supplement these disclosures if and as appropriate.

B. Invalidity Under 35 U.S.C. §§ 102 and 103

Nike asserts claims 1-8, 11-18, and 21 of the '749 Patent. All of those claims are invalid because they fail to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the attached claim charts. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Although Skechers has identified at least one citation per limitation for each reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. Rather, in an effort to focus the issues, Skechers has generally cited representative portions of identified references, even where a reference may contain additional support for a particular claim element. In addition, POSITAs generally read a prior art reference as a whole and in the context of other publications and literature. Thus, to understand and interpret any specific statement or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications and their general

1 scientific knowledge. Skechers may rely upon uncited portions of the prior art
2 references and on other publications and expert testimony to provide context, and as
3 aids to understanding and interpreting the portions that are cited. Skechers may also
4 rely on the prior art of record for any permissible purpose, including prior art
5 discussed in the '749 Patent specification itself, including to show that the '749
6 Patent is anticipated or obvious, show the state of the art, show motivation to
7 combine a reference with one or more other references, and to show the proper
8 scope of the claims. Skechers may also rely on uncited portions of the prior art
9 references, other disclosed publications, and the testimony of experts to establish
10 that a POSITA would have been motivated to modify or combine certain of the cited
11 references so as to render the claims obvious.

12 **1. Anticipation**

13 Some or all of the asserted claims of the '749 Patent are invalid as anticipated
14 under 35 U.S.C. § 102 based on each of the prior art references identified above and
15 in the included claim charts, which identify specific examples of where each
16 limitation of the asserted claims is found in the prior art references, either expressly
17 or inherently. As explained above, the cited portions of prior art references
18 identified in the attached claim charts are exemplary only and representative of the
19 content and teaching of the prior art references, and should be understood in the
20 context of the reference as a whole and as they would be understood by a POSITA.

21 **2. Obviousness**

22 To the extent any limitation is deemed not to be exactly met by an item of
23 prior art, any purported differences are such that the claimed subject matter as a
24 whole would have been obvious to a POSITA at the time of the alleged invention,
25 based on the state of the art and knowledge of those skilled in the art. The item of
26 prior art would, therefore, render the relevant claims invalid for obviousness under
27 35 U.S.C. § 103.

28 In addition, the references identified above render one or more asserted

1 claims of the '749 Patent obvious when the references are read in combination with
2 each other by a POSITA. Each and every reference identified is also relevant to the
3 state of the art at the time of the alleged invention. Any of the references disclosed
4 above may be combined to render obvious (and therefore invalid) each of Nike's
5 asserted claims. Skechers may rely upon a subset of the above identified references
6 or all of the references identified above for purposes of obviousness depending on
7 the Court's claim construction, positions taken by Nike during this litigation, and
8 further investigation and discovery. Skechers may rely on combinations with any
9 reference in the attached claim charts and any of the other references disclosed
10 herein with respect to the '749 Patent, including combinations with any of the
11 patents, publications or products identified herein as prior art to the '749 Patent.

12 Moreover, to the extent the foregoing references are found not to anticipate
13 the asserted claims, the foregoing references render the asserted claims obvious
14 either alone or in combination with common sense and/or one or more of the other
15 references identified above. As explained herein and/or in the accompanying charts,
16 it would have been obvious to a POSITA at the time of the alleged invention of the
17 asserted claims of the '749 Patent to combine the various references cited herein so
18 as to practice the asserted claims.

19 Motivations to combine the above items of prior art are present in the
20 references themselves, general knowledge of a POSITA, the prior art as a whole, or
21 the nature of the problems allegedly addressed by the '749 Patent. Combining the
22 references identified in the accompanying claim charts would have been obvious, as
23 the references identify and address the same technical issues and suggest very
24 similar solutions to those issues. Skechers reserves the right to amend or supplement
25 these invalidity contentions to identify additional reasons that combining the
26 references would be obvious to a POSITA.

27 In addition to the specific combinations of prior art and the specific
28 combinations of groups of prior art disclosed, Skechers reserves the right to rely on

1 any other combination of any prior art references disclosed herein. Skechers further
2 reserves the right to rely upon combinations disclosed within the prosecution history
3 of the references cited herein.

4 The obviousness combinations set forth in these contentions reflect Skechers'
5 present understanding of the potential scope of the claims that Nike appears to be
6 advocating and should not be seen as Skechers' acquiescence to Nike's
7 interpretation of the patent claims. Skechers reserves the right to amend or
8 supplement these contentions regarding anticipation or obviousness of the asserted
9 claims based on further information from Nike, the Court, other courts or decision-
10 makers in parallel proceedings, or any other source, including any changes Nike
11 makes to its Apparent Infringement Contentions, information discovered during
12 discovery, arguments made and positions taken by Nike in connection with the
13 petition for inter partes review filed by Skechers for the '749 Patent, or a claim
14 construction ruling by the Court. Skechers reserves the right to amend or
15 supplement these contentions to assert different support for each asserted limitation,
16 to cite different portions of each reference in support of any invalidity theory, to
17 assert different combinations, or to identify different references, as necessary. Nike
18 has not identified what elements or combinations it alleges were not known to a
19 POSITA. Therefore, for any claim limitation that Nike alleges is not disclosed in a
20 particular prior art reference, Skechers reserves the right to assert that any such
21 limitation is either inherent in the disclosed reference or obvious to a POSITA at the
22 time in light of the same, or that the limitation is disclosed in another of the
23 references disclosed above and, in combination, would have rendered the asserted
24 claim obvious.

25 Each of these combinations was obvious to try for a POSITA. In the field of
26 the '749 Patent, there was a design need or market pressure to solve a problem and
27 there were a finite number of identified, predictable solutions. A POSITA had good
28 reason to pursue the known options within his or her technical grasp including

1 combinations of the disclosures in the accompanying claim charts. Each of these
2 combinations is also the combination of familiar elements according to known
3 methods and yields predictable results. In the field of the '749 Patent, a great deal of
4 prior research and product designs were available and design incentives and other
5 market forces would prompt variations of it. Further reasons to combine the
6 references identified in the accompanying claim charts include the nature of the
7 problem being solved, the express, implied, and inherent teachings of the prior art,
8 and the knowledge of a POSITA that such combinations would have yielded
9 predictable results, and that such combinations would have represented known
10 alternatives to a POSITA. For each combination, there is a teaching, suggestion, and
11 motivation to combine both in the references to be combined themselves, as well as
12 in the art generally that was known to a POSITA. In any event, each limitation of
13 the '749 Patent is, and would have been at the time of the alleged invention, a
14 simple design choice representing a predictable variation within the skill of a
15 POSITA. Moreover, each limitation of the '749 Patent was well known in the art,
16 including well-known to POSITAs.

17 Additional prior art references rendering the asserted claims obvious, alone or
18 in combination with other references, including identification of combinations
19 showing obviousness, are identified in the accompanying claim charts, which
20 include exemplary citations for the '749 Asserted Claims showing specifically
21 where in each reference or combinations of references each asserted claim is found,
22 and an explanation of why the prior art renders the asserted claim obvious.

23 No showing of a specific motivation to combine prior art is required to
24 combine the references disclosed for any asserted patent in this document and in the
25 attached charts, as each combination of art would have yielded expected results and
26 at most would simply represent a known alternative to one of skill in the art. *See*
27 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
28 (“[W]e affirm the Board’s conclusion that the challenged claims would have been

1 obvious because modifying the Admitted Prior Art/Betts combination to include a
2 second recess was nothing more than the predictable application of known
3 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
4 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
5 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
6 combine test, and instead applying an “expansive and flexible” approach). Indeed,
7 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
8 automaton” and “in many cases a POSITA will be able to fit the teachings of
9 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
10 Nevertheless, in addition to the information contained in the obviousness sections of
11 this document and elsewhere in these contentions, Skechers hereby identify
12 motivations and reasons to combine.

13 One or more combinations of the prior art references identified above would
14 have been obvious because these references would have been combined using:
15 known methods to yield predictable results; known techniques in the same way; a
16 simple substitution of one known, equivalent element for another to obtain
17 predictable results; and/or a teaching, suggestion, or motivation in the prior art
18 generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) (“It
19 is simply a matter of common sense that the sleeve used in Down, in a towing
20 attachment quite similar to a hitch receiver/tow bar arrangement, could be combined
21 with a barbell-shaped hitch pin lock in order to address the known problem of
22 different aperture sizes in standard hitch receivers and the shelf-space problem
23 experienced by retailers.”); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344
24 (Fed. Cir. 2008) (“The asserted claims simply substitute a resistive electrical switch
25 for the mechanical pressure switch employed by the Gopher Zapper,” which “is a
26 textbook case of when the asserted claims involve a combination of familiar
27 elements according to known methods that does no more than yield predictable
28 results.” (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed.

1 Cir. 2004) (affirming the district court’s finding of “a motivation to combine
2 because the two references address precisely the same problem of underpinning
3 existing structural foundations” even though the record “does not feature an express
4 written teaching in the art to make this combination”); *see also Ecolab, Inc. v. FMC*
5 *Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869
6 F.3d at 1344.

7 In addition, it would have been obvious to try combining the prior art
8 references identified above because there were only a finite number of predictable
9 solutions and/or because known work in one field of endeavor prompted variations
10 based on predictable design incentives and/or market forces either in the same field
11 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
12 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
13 he could place the thickness sensor either above the presence sensor in the feed, so
14 that the paper contacts the thickness sensor before the presence sensor, or below so
15 that the paper contacts it after. Each of these two design choices is an obvious
16 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
17 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
18 skilled artisan may have preferred a delayed-release formulation over the claimed
19 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
20 of a particular combination need not be supported by a finding that the prior art
21 suggests that the combination claimed ... is the preferred, or most desirable,
22 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004))); *KSR*,
23 550 U.S. at 419-20. Further, the combinations of the prior art references identified
24 above and in the claim charts would have been obvious because the combinations
25 represent known potential options with a reasonable expectation of success. *See*
26 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

27 Additional evidence that there would have been a motivation to combine the
28 prior art references identified above includes the interrelated teachings of multiple

1 prior art references; the effects of demands known to the design community or
2 present in the marketplace; the existence of a known problem for which there was an
3 obvious solution encompassed by the '749 Asserted Claims; the existence of a
4 known need or problem in the field of the endeavor at the time of the alleged
5 inventions; and the background knowledge that would have been possessed by a
6 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
7 incentives and other market forces can prompt variations of it, either in the same
8 field or in another. If a person of ordinary skill in the art can implement a
9 predictable variation, and would see the benefit of doing so, § 103 likely bars its
10 patentability. Moreover, if a technique has been used to improve one device, and a
11 person of ordinary skill in the art would recognize that it would improve similar
12 devices in the same way, using the technique is obvious unless its actual application
13 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
14 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
15 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
16 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
17 2012).

18 The motivation to combine the teachings of the prior art references disclosed
19 herein is also found in the references themselves and in: (1) the nature of the
20 problem being solved; (2) the express, implied and inherent teachings of the prior
21 art; (3) the knowledge of POSITAs; (4) the predictable results obtained in
22 combining the different elements of the prior art; (5) the predictable results obtained
23 in simple substitution of one known element for another; (6) the use of a known
24 technique to improve similar devices, methods, or products in the same way; (7) the
25 predictable results obtained in applying a known technique to a known device,
26 method, or product ready for improvement; (8) the finite number of identified
27 predictable solutions that had a reasonable expectation of success; and (9) known
28 work in various technological fields that could be applied to the same or different

1 technological fields based on design incentives or other market forces. *See above*
2 for legal background regarding obviousness combinations and M.P.E.P. § 2143.

3 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
4 **Claims**

5 Skechers submits the following charts identifying specific locations in each
6 alleged item of prior art where each limitation of each asserted claim is found as
7 attached Exhibits 749-1 through 749-9. The contents of Exhibits 749-1 through 749-
8 9, in combination with the foregoing patents, publications, and products, anticipate
9 and/or render obvious the '749 Asserted Claims under 35 U.S.C. § 102, either
10 expressly or inherently, and under § 103, in each case, as understood by a POSITA.

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '749 Patent)
749-1	Nishida – U.S. Patent No. 5,345,638 ⁴
749-2	Zuckerman – U.S. Patent No. 2,047,724
749-3	Karl Mayer Warp Knitting System (“KM Warp System”)
749-4	Horii - Japanese Patent Application Publication No. H3-3203
749-5	Orei – U.S. Patent No. 7,051,460
749-6	Glidden – U.S. Patent No. 2,147,197; Fujita – U.S. Patent No. 6,272,888; and Mitchell – U.S. Patent No. 6,708,530
749-7	Shiomura – U.S. Patent No. 4,785,558; Fujita – U.S. Patent No. 6,272,888; and Mitchell – U.S. Patent No. 6,708,530
749-8	Lyden – U.S. Publication No. 2003/0069807
749-9	Nishida, Zuckerman, KM Warp System, Horii, Orei, Glidden, Shiomura, Fujita, Mitchell, and Lyden

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27 ⁴ An identification of a prior art reference for purposes of identifying an exhibit
28 should be understood to mean that the chart discloses not only bases for invalidity
based on that reference, but also that reference in combination with other references
identified or referred to in the chart.

1 **D. Invalidity Under 35 U.S.C. § 112**

2 **1. Legal Background Regarding The Definiteness, Enablement,**
3 **And Written Description Requirements**

4 Section 112 includes a definiteness requirement: “[T]he specification shall
5 conclude with one or more claims particularly pointing out and distinctly claiming
6 the subject matter which the applicant [or inventor or joint invention] regards as his
7 invention.” Pre-AIA 35 U.S.C. § 112, ¶ 2; AIA 35 U.S.C. § 112(b). “[A] patent is
8 invalid for indefiniteness if its claims, read in light of the patent’s specification and
9 prosecution history, fail to inform, with reasonable certainty, those skilled in the art
10 about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S.
11 Ct. 2120, 2124 (2014).

12 The definiteness requirement requires that the claim must set forth what the
13 applicant regards as the invention, and do so with sufficient particularity and
14 definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
15 2002). Where it would be apparent to one of skill in the art, based on the patent
16 specification, that the “invention” set forth in a claim is not what the patent
17 applicant regarded as the invention, the claim is invalid. *Id.*

18 Section 112 further includes an enablement requirement: “The specification
19 shall contain a written description . . . of the manner and process of making and
20 using [the invention] in such full, clear, concise and exact terms as to enable any
21 person skilled in the art to which it pertains, or with which it is most nearly
22 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
23 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
24 those skilled in the art how to make and use the full scope of the claimed invention
25 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
26 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
27 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
28 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of

1 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
2 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
3 F.3d at 1383-84.

4 Section 112 further includes a written description requirement: “The
5 specification shall contain a written description of the invention[.]” Pre-AIA 35
6 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). “To satisfy the written description
7 requirement, a patent applicant must convey with reasonable clarity to those skilled
8 in the art that, as of the filing date sought, he or she was in possession of the
9 invention.” *ICU Medical Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377
10 (Fed. Cir. 2009) (internal quotation marks and citations omitted); *see also Synthes*
11 *USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (Fed. Cir. 2013). “The test
12 [for written description support] requires an objective inquiry into the four corners
13 of the specification from the perspective of a POSITA. Based on that inquiry, the
14 specification must describe an invention understandable to that skilled artisan and
15 show that the inventor actually invented the invention claimed.” *Ariad Pharms.,*
16 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

17 The specification must describe the claimed invention in sufficient detail so
18 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
19 words in a specification or a claim, even an original claim, does not necessarily
20 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
21 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
22 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
23 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
24 description requirement ... is necessarily met as a matter of law because the claim
25 language appears *in ipsius verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
26 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

27 2. Invalidity Grounds Under 35 U.S.C. § 112

28 The grounds identified below both individually and collectively render the

1 '749 Asserted Claims invalid under the statutory requirements of § 112. By
2 identifying certain claim language below, Skechers does not imply that such
3 language is entitled to any patentable weight when comparing the claim as a whole
4 to the prior art. Skechers' identifications are made based on Skechers' present
5 understanding of the Asserted Claims and Nike's apparent interpretation of these
6 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
7 the right to amend these identifications, including in response to claim constructions
8 and claim interpretations that would render claim limitations not enabled, lacking in
9 written description, or indefinite.

10 **a. Lack of Enablement And Written Description**

11 Based on Skechers' present understanding of the Asserted Claims and Nike's
12 apparent interpretation of these claims as reflected in its Apparent Infringement
13 Contentions, the '749 Asserted Claims fail to satisfy the requirements of § 112
14 because the specification and original patent application fail to provide an enabling
15 disclosure of and written description support for at least the following limitations:

- 16 • "first area" (Claims 11, 21)
17 • "second area" (Claims 11, 21)
18 • "substantially planar configuration" (Claims 5, 15)
19 • "longitudinal edges" (Claims 6, 7, 16-18)
20 • "having at least one knitted texture that differs from a knitted texture in the
21 surrounding knitted textile structure" (Claims 1-20)

22 These claim terms/phrases as apparently construed and/or interpreted by Nike
23 violate the written description and/or enablement requirements of 35 U.S.C. § 112.
24 Each asserted claim of the '749 Patent is invalid as not containing a written
25 description of the invention, and of the manner and process of making and using it,
26 in such full, clear, concise and exact terms as to enable any person skilled in the art
27 to which it pertains, or with which it is most nearly connected, to make and use the
28 alleged invention. Moreover, based on Skechers' present understanding of Nike's

1 Apparent Infringement Contentions, each of the asserted claims in which these
2 claim terms/phrases appear lack written description because the specification of the
3 '749 Patent demonstrates that the patentee neither conceived of nor demonstrated
4 possession of all that Nike now contends the claims cover. In addition, based on
5 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
6 of the asserted claims in which these claim terms/phrases appear are invalid because
7 the specification fails to provide sufficient disclosure to enable any POSITA to
8 which it pertains, or with which it is most nearly connected, to implement the
9 invention without undue experimentation.

10 **b. Indefiniteness**

11 Based on Skechers' present understanding of the '749 Asserted Claims and
12 Nike's apparent interpretation of these claims as reflected in its Apparent
13 Infringement Contentions, the '749 Asserted Claims fail to satisfy the requirements
14 of § 112 because the precise scope of at least the terms listed below cannot be
15 determined with reasonable certainty by a POSITA when reading the claims in light
16 of the specification and prosecution history.

17 Based on Skechers' present understanding of Nike's Apparent Infringement
18 Contentions, the '749 Asserted Claims are invalid for reciting at least the following
19 claim terms/phrases:

- 20 • "substantially planar configuration" (Claims 5, 15)
- 21 • "longitudinal edges" (Claims 6, 7, 16-18)

22 Based on Skechers present understanding of Nike's Apparent Infringement
23 Contentions, at least one or more of these claim terms/phrases are indefinite because
24 they are inconsistent with and broader than the alleged invention disclosed in the
25 specification and given Nike's apparent constructions of the claims, any POSITA at
26 the time of the invention would not understand what is claimed, even when the
27 claims are read in light of the specification. To the extent that Nike ultimately
28 asserts any terms in a manner that makes clear the scope of such terms would not be

1 reasonably certain to a POSITA, Skechers reserves the right to seek a ruling that any
2 such term is indefinite.

3 **IV. '562 PATENT**

4 **A. Prior Art References⁵**

5 Skechers identifies the following prior art presently known to Skechers to
6 anticipate the '562 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
7 (e), and/or (g), either expressly or inherently as understood by a POSITA, and/or to
8 render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers
9 generally identifies and incorporates by reference herein all prior art and invalidity
10 arguments previously asserted against the '562 Patent, whether during the original
11 prosecution of the '562 Patent, before the Patent Trial and Appeals Board, or during
12 any of the litigations filed by Nike involving the '562 Patent, including, for
13 example, the adidas Litigation, the adidas ITC Investigation, or the New Balance
14 Litigation. In addition, discovery is ongoing, and Skechers has served document
15 requests and interrogatories for which responses are outstanding that Skechers
16 expects to reveal additional prior art. Furthermore, Skechers is generally aware of
17 information pertaining to prior art from other proceedings that is currently
18 unavailable to Skechers, including because such information may be subject to a
19 protective order. Once Skechers receives relevant information, it will timely
20 supplement its invalidity contentions, as appropriate.

21 **1. Prior Art Patents and Publications⁶**

Prior Art	Date of Issue or Publication
US RE18,804	4/1933

25 ⁵ To the extent one or more prior art patents, publications, or products are
26 identified in the claim charts attached hereto but are not included in the tables and
27 lists below, those prior art patents, publications, or products should also be considered
as prior art to the '562 Patent.

28 ⁶ Skechers incorporates by reference all prior art references cited in the patents
and publications listed herein and/or their file histories.

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Prior Art	Date of Issue or Publication
US 50,369	10/1865
US 601,192	3/1898
US 1,215,198	2/1917
US 1,597,934	8/1926
US 1,839,274	1/1932
US 1,888,172	11/1932
US 1,902,780	3/1933
US 1,910,251	5/1933
US 2,001,293	5/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,314,098	3/1943
US 2,330,199	9/1943
US 2,343,390	3/1944
US 2,400,692	5/1946
US 2,440,393	4/1948
US 2,569,764	10/1951
US 2,586,045	2/1952
US 2,608,078	8/1952
US 2,641,004	6/1953
US 2,675,631	4/1954
US 2,725,567	12/1955
US 3,694,940	10/1972
US 3,704,474	12/1972
US 3,766,566	10/1973
US 3,778,856	12/1973
US 3,583,081	6/1974
US 3,952,427	4/1976

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Prior Art	Date of Issue or Publication
US 3,972,086	8/1976
US 4,027,402	6/1977
US 4,031,586	6/1977
US 4,211,806	7/1980
US 4,216,662	8/1980
US 4,255,949	3/1981
US 4,317,292	3/1982
US 4,373,361	2/1983
US 4,447,967	5/1984
US 4,465,448	8/1984
US 4,499,741	2/1985
US 4,505,134	3/1985
US 4,607,439	8/1986
US 4,737,396	4/1988
US 4,750,339	6/1988
US 4,756,098	7/1988
US 4,785,558	11/1988
US 4,813,158	3/1989
US 5,095,720	3/1992
US 5,152,025	10/1992
US 5,192,601	3/1993
US 5,284,031	2/1994
US 5,337,493	8/1994
US 5,345,638	9/1994
US 5,353,524	10/1994
US 5,379,615	1/1995
US 5,461,884	10/1995
US 5,511,323	4/1996

1	Prior Art	Date of Issue or Publication
2	US 5,572,860	11/1996
3	US 5,575,090	11/1996
4	US 5,729,918	3/1998
5	US 5,735,145	4/1998
6	US 5,746,013	5/1998
7	US 5,784,806	7/1998
8	US 5,823,012	10/1998
9	US 6,029,376	2/2000
10	US 6,065,311	5/2000
11	US 6,192,716	2/2001
12	US 6,196,030	3/2001
13	US 6,216,494	4/2001
14	US 6,299,962	10/2001
15	US 6,308,438	10/2001
16	US 6,321,574	11/2001
17	US 6,333,105	12/2001
18	US 6,401,364	6/2002
19	US 6,449,879	9/2002
20	US 6,558,784	5/2003
21	US 6,588,237	7/2003
22	US 6,910,288	6/2005
23	US 6,931,762	8/2005
24	US 6,981,393	1/2006
25	US 6,986,269	1/2006
26	US 7,051,460	5/2006
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	US 7,347,011	3/2008

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Prior Art	Date of Issue or Publication
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US 7,770,306	8/2010
US 7,774,956	8/2010
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US 2005/0115284	6/2005
US 2005/0193592	9/2005
US 2005/0284000	12/2005

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Prior Art	Date of Issue or Publication
US 2005/0288615	12/2005
US 2007/0180730	8/2007
US 2007/0227040	10/2007
US 2007/0294920	12/2007
US 2008/0017294	1/2008
US 2008/0110048	5/2008
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Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
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Skechers additionally identifies and relies on patent or publication references that describe or are otherwise related to the prior art products identified below.

2. Prior Art Products

Skechers also contends that the asserted claims of the '562 Patent are invalid based on public knowledge and uses and/or offers for sale or sales of products that are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the United States by other inventors who had not abandoned, suppressed, or concealed them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious under 35 U.S.C. § 103 the asserted claims.

The following lists prior art products that invalidate under 35 U.S.C. § 102 or render obvious under 35 U.S.C. § 103 the asserted claims by the name of the item, and Skechers may rely on all versions of the following prior art products commercially sold, offered for sale, publicly known or used before the priority date of the '562 Patent, including things as well as documents describing the same:

Prior Art Product	Date of Public Use
Nike Huarache shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Nike Sock Dart shoe, publicly known, used, and/or on sale within the United States	No later than 5/2004
"Acom Footwear-Slipper Sock," from Northland Maine, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
Nike "Air Flow" shoe (SK# 258), publicly known, used, and/or on sale within the United States	No later than 1/1990
Reebok "Shaq Trainer" shoe, publicly known, used, and/or on sale within the United States	No later than 1995
Reebok "City Jam" shoe (SK# 506), publicly known, used, and/or on sale within the United States	No later than 1993
"Nova Cushion" shoe (SK# 01290), publicly known, used, and/or on sale within the United States	No later than 2006
Nike "Shox Laser" shoe, publicly known,	No later than

Prior Art Product	Date of Public Use
used, and/or on sale within the United States	7/2005
Nike "2:40" shoe, publicly known, used, and/or on sale within the United States	No later than 2005
Reebok "Summer Runner" shoe, publicly known, used, and/or on sale within the United States	No later than 2002
Reebok "Whiplash" shoe, publicly known, used, and/or on sale within the United States	No later than 1995
Nike Air Presto shoes, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Nike Sock Racer shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Das Wrestling shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Equipment Wrestling shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Barefoot shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Primeknit shoe, publicly known, used, and/or on sale within the United States	No later than 7/26/2012
Nike FlyKnit shoe, publicly known, used, and/or on sale within the United States	No later than 2/21/2012
Nike Flyknit Trainer+, publicly known, used, and/or on sale within the United States	No later than 2/21/2012
New Balance Minimus Life shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Tuxedo shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Adizero Infiknit Olympics, publicly known, used, and/or on sale within the United States	No later than 2/28/2013
adidas Hydroglide 2000, publicly known,	No later than

Prior Art Product	Date of Public Use
used, and/or on sale within the United States	2001
Nike Summer Runner, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas 2000 Sydney Olympics Collection, publicly known, used, and/or on sale within the United States	No later than 2001
Nike Presto Chanjo shoe, publicly known, used, and/or on sale within the United States	No later than 2001

Skechers' positions with respect to these references are stated on information and belief, and are supported by the information and documents that will be produced by Skechers, Nike, and/or third parties. Because discovery is not complete, Skechers continues to investigate these products and other relevant products, including those used, sold, and/or offered for sale by Nike, third parties, and Skechers and will supplement these disclosures if and as appropriate.

B. Invalidity Under 35 U.S.C. §§ 102 and 103

Nike asserts claims 1-23 of the '562 Patent. All of those claims are invalid because they fail to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the attached claim charts. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Although Skechers has identified at least one citation per limitation for each reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. Rather, in an effort to focus the issues, Skechers has generally cited representative portions of identified references, even where a reference may contain additional support for a particular claim element. In addition, POSITAs generally read a prior art reference as a whole and in the context of other

1 publications and literature. Thus, to understand and interpret any specific statement
2 or disclosure within a prior art reference, such persons would rely on other
3 information within the reference, along with other publications and their general
4 scientific knowledge. Skechers may rely upon uncited portions of the prior art
5 references and on other publications and expert testimony to provide context, and as
6 aids to understanding and interpreting the portions that are cited. Skechers may also
7 rely on the prior art of record for any permissible purpose, including prior art
8 discussed in the '562 Patent specification itself, including to show that the '562
9 Patent is anticipated or obvious, show the state of the art, show motivation to
10 combine a reference with one or more other references, and to show the proper
11 scope of the claims. Skechers may also rely on uncited portions of the prior art
12 references, other disclosed publications, and the testimony of experts to establish
13 that a POSITA would have been motivated to modify or combine certain of the cited
14 references so as to render the claims obvious.

15 **1. Anticipation**

16 Some or all of the asserted claims of the '562 Patent are invalid as anticipated
17 under 35 U.S.C. § 102 based on each of the prior art references identified above and
18 in the included claim charts, which identify specific examples of where each
19 limitation of the asserted claims is found in the prior art references, either expressly
20 or inherently. As explained above, the cited portions of prior art references
21 identified in the attached claim charts are exemplary only and representative of the
22 content and teaching of the prior art references, and should be understood in the
23 context of the reference as a whole and as they would be understood by a POSITA.

24 **2. Obviousness**

25 To the extent any limitation is deemed not to be exactly met by an item of
26 prior art, any purported differences are such that the claimed subject matter as a
27 whole would have been obvious to a POSITA at the time of the alleged invention,
28 based on the state of the art and knowledge of those skilled in the art. The item of

1 prior art would, therefore, render the relevant claims invalid for obviousness under
2 35 U.S.C. § 103.

3 In addition, the references identified above render one or more asserted
4 claims of the '562 Patent obvious when the references are read in combination with
5 each other by a POSITA. Each and every reference identified is also relevant to the
6 state of the art at the time of the alleged invention. Any of the references disclosed
7 above may be combined to render obvious (and therefore invalid) each of Nike's
8 asserted claims. Skechers may rely upon a subset of the above identified references
9 or all of the references identified above for purposes of obviousness depending on
10 the Court's claim construction, positions taken by Nike during this litigation, and
11 further investigation and discovery. Skechers may rely on combinations with any
12 reference in the attached claim charts and any of the other references disclosed
13 herein with respect to the '562 Patent, including combinations with any of the
14 patents, publications or products identified herein as prior art to the '562 Patent.

15 Moreover, to the extent the foregoing references are found not to anticipate
16 the asserted claims, the foregoing references render the asserted claims obvious
17 either alone or in combination with one or more of the other references identified
18 above. For example, as explained herein and/or in the accompanying charts, it
19 would have been obvious to a POSITA at the time of the alleged invention of the
20 asserted claims of the '562 Patent to modify or combine the various references cited
21 herein so as to practice the asserted claims.

22 Motivations to combine the above items of prior art are present in the
23 references themselves, general knowledge of a POSITA, the prior art as a whole, or
24 the nature of the problems allegedly addressed by the '562 Patent. Combining the
25 references identified in the accompanying claim charts would have been obvious, as
26 the references identify and address the same technical issues and suggest very
27 similar solutions to those issues. Skechers reserves the right to amend or supplement
28 these invalidity contentions to identify additional reasons that combining the

1 references would be obvious to a POSITA.

2 In addition to the specific combinations of prior art and the specific
3 combinations of groups of prior art disclosed, Skechers reserves the right to rely on
4 any other combination of any prior art references disclosed herein. Skechers further
5 reserves the right to rely upon combinations disclosed within the prosecution history
6 of the references cited herein.

7 The obviousness combinations set forth in these contentions reflect Skechers'
8 present understanding of the potential scope of the claims that Nike appears to be
9 advocating and should not be seen as Skechers' acquiescence to Nike's
10 interpretation of the patent claims. Skechers reserves the right to amend or
11 supplement these contentions regarding anticipation or obviousness of the asserted
12 claims based on further information from Nike, the Court, other courts or decision-
13 makers in parallel proceedings, or any other source including any changes Nike
14 makes to its Apparent Infringement Contentions, information discovered during
15 discovery, arguments made and positions taken by Nike, or a claim construction
16 ruling by the Court. Skechers reserves the right to amend or supplement these
17 contentions to assert different support for each asserted limitation, to cite different
18 portions of each reference in support of any invalidity theory, to assert different
19 combinations, or to identify different references, as necessary. Nike has not
20 identified what elements or combinations it alleges were not known to a POSITA.
21 Therefore, for any claim limitation that Nike alleges is not disclosed in a particular
22 prior art reference, Skechers reserves the right to assert that any such limitation is
23 either inherent in the disclosed reference or obvious to a POSITA at the time in light
24 of the same, or that the limitation is disclosed in another of the references disclosed
25 above and, in combination, would have rendered the asserted claim obvious.

26 Each of these combinations was obvious to try for a POSITA. In the field of
27 the '562 Patent, there was a design need or market pressure to solve a problem and
28 there were a finite number of identified, predictable solutions. A POSITA had good

1 reason to pursue the known options within his or her technical grasp including
2 combinations of the disclosures in the accompanying claim charts. Each of these
3 combinations is also the combination of familiar elements according to known
4 methods and yields predictable results. In the field of the '562 Patent, a great deal of
5 prior research and product designs were available and design incentives and other
6 market forces would prompt variations of it. Further reasons to combine the
7 references identified in the accompanying claim charts include the nature of the
8 problem being solved, the express, implied, and inherent teachings of the prior art,
9 and the knowledge of a POSITA that such combinations would have yielded
10 predictable results, and that such combinations would have represented known
11 alternatives to a POSITA. For each combination, there is a teaching, suggestion, and
12 motivation to combine both in the references to be combined themselves, as well as
13 in the art generally that was known to a POSITA. In any event, each limitation of
14 the '562 Patent is, and would have been at the time of the alleged invention, a
15 simple design choice representing a predictable variation within the skill of a
16 POSITA. Moreover, each limitation of the '562 Patent was well known in the art,
17 including well-known to POSITAs.

18 Additional prior art references rendering the asserted claims obvious, alone or
19 in combination with other references, including identification of combinations
20 showing obviousness, are identified in the accompanying claim charts, which
21 include exemplary citations for the '562 Asserted Claims showing specifically
22 where in each reference or combinations of references each asserted claim is found,
23 and an explanation of why the prior art renders the asserted claim obvious.

24 No showing of a specific motivation to combine prior art is required to
25 combine the references disclosed for any asserted patent in this document and in the
26 attached charts, as each combination of art would have yielded expected results and
27 at most would simply represent a known alternative to one of skill in the art. *See*
28 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)

1 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
2 obvious because modifying the Admitted Prior Art/Betts combination to include a
3 second recess was nothing more than the predictable application of known
4 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
5 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
6 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
7 combine test, and instead applying an “expansive and flexible” approach). Indeed,
8 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
9 automaton” and “in many cases a POSITA will be able to fit the teachings of
10 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
11 Nevertheless, in addition to the information contained in the obviousness sections of
12 this document and elsewhere in these contentions, Skechers hereby identify
13 motivations and reasons to combine.

14 One or more combinations of the prior art references identified above would
15 have been obvious because these references would have been combined using:
16 known methods to yield predictable results; known techniques in the same way; a
17 simple substitution of one known, equivalent element for another to obtain
18 predictable results; and/or a teaching, suggestion, or motivation in the prior art
19 generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) (“It
20 is simply a matter of common sense that the sleeve used in Down, in a towing
21 attachment quite similar to a hitch receiver/tow bar arrangement, could be combined
22 with a barbell-shaped hitch pin lock in order to address the known problem of
23 different aperture sizes in standard hitch receivers and the shelf-space problem
24 experienced by retailers.”); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344
25 (Fed. Cir. 2008) (“The asserted claims simply substitute a resistive electrical switch
26 for the mechanical pressure switch employed by the Gopher Zapper,” which “is a
27 textbook case of when the asserted claims involve a combination of familiar
28 elements according to known methods that does no more than yield predictable

1 results.” (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed.
2 Cir. 2004) (affirming the district court’s finding of “a motivation to combine
3 because the two references address precisely the same problem of underpinning
4 existing structural foundations” even though the record “does not feature an express
5 written teaching in the art to make this combination”); *see also Ecolab, Inc. v. FMC*
6 *Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869
7 F.3d at 1344

8 In addition, it would have been obvious to try combining the prior art
9 references identified above because there were only a finite number of predictable
10 solutions and/or because known work in one field of endeavor prompted variations
11 based on predictable design incentives and/or market forces either in the same field
12 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
13 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
14 he could place the thickness sensor either above the presence sensor in the feed, so
15 that the paper contacts the thickness sensor before the presence sensor, or below so
16 that the paper contacts it after. Each of these two design choices is an obvious
17 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
18 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
19 skilled artisan may have preferred a delayed-release formulation over the claimed
20 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
21 of a particular combination need not be supported by a finding that the prior art
22 suggests that the combination claimed ... is the preferred, or most desirable,
23 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004))); *KSR*,
24 550 U.S. at 419-20. Further, the combinations of the prior art references identified
25 above and in the claim charts would have been obvious because the combinations
26 represent known potential options with a reasonable expectation of success. *See*
27 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

28 Additional evidence that there would have been a motivation to combine the

1 prior art references identified above includes the interrelated teachings of multiple
2 prior art references; the effects of demands known to the design community or
3 present in the marketplace; the existence of a known problem for which there was an
4 obvious solution encompassed by the '562 Asserted Claims; the existence of a
5 known need or problem in the field of the endeavor at the time of the alleged
6 inventions; and the background knowledge that would have been possessed by a
7 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
8 incentives and other market forces can prompt variations of it, either in the same
9 field or in another. If a person of ordinary skill in the art can implement a
10 predictable variation, and would see the benefit of doing so, § 103 likely bars its
11 patentability. Moreover, if a technique has been used to improve one device, and a
12 person of ordinary skill in the art would recognize that it would improve similar
13 devices in the same way, using the technique is obvious unless its actual application
14 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
15 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
16 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
17 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
18 2012).

19 The motivation to combine the teachings of the prior art references disclosed
20 herein is also found in the references themselves and in: (1) the nature of the
21 problem being solved; (2) the express, implied and inherent teachings of the prior
22 art; (3) the knowledge of POSITAs; (4) the predictable results obtained in
23 combining the different elements of the prior art; (5) the predictable results obtained
24 in simple substitution of one known element for another; (6) the use of a known
25 technique to improve similar devices, methods, or products in the same way; (7) the
26 predictable results obtained in applying a known technique to a known device,
27 method, or product ready for improvement; (8) the finite number of identified
28 predictable solutions that had a reasonable expectation of success; and (9) known

work in various technological fields that could be applied to the same or different technological fields based on design incentives or other market forces. *See* above for legal background regarding obviousness combinations and M.P.E.P. § 2143.

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

Skechers submits the following charts identifying specific locations in each alleged item of prior art where each limitation of each asserted claim is found as attached Exhibits 562-1 through 562-9. The contents of Exhibits 562-1 through 562-9, in combination with the foregoing patents, publications, and products, anticipate and/or render obvious the '562 Asserted Claims under 35 U.S.C. § 102, either expressly or inherently, and under § 103, in each case, as understood by a POSITA.

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '562 Patent)
562-1	Glidden – U.S. Patent No. 2,147,197 ⁷
562-2	Dua '956 – U.S. Patent No. 7,774,956
562-3	Joha – U.S. Patent No. RE 18,804
562-4	Bell – U.S. Patent App. Pub. No. 2010/0077634
562-5	Clark – U.S. Patent No. 2,440,393
562-6	Horii - Japanese Patent App. Pub. No. H3-3203
562-7	Li – Chinese Patent App. Pub. No. 2187379Y
562-8	Dua '592 – U.S. Patent App. Pub. No. 2005/0193592
562-9	Glidden, Dua '956, Joha, Bell, Clark, Horii, Li, and Dua '592

⁷ An identification of a prior art reference for purposes of identifying an exhibit should be understood to mean that the chart discloses not only bases for invalidity based on that reference, but also that reference in combination with other references identified or referred to in the chart.

1 **D. Invalidity Under 35 U.S.C. § 112**

2 **1. Legal Background Regarding The Definiteness, Enablement,**
3 **And Written Description Requirements**

4 Section 112 includes a definiteness requirement: “[T]he specification shall
5 conclude with one or more claims particularly pointing out and distinctly claiming
6 the subject matter which the applicant regards as his invention.” Pre-AIA 35 U.S.C.
7 § 112, ¶ 2; AIA 35 U.S.C. § 112(b). “[A] patent is invalid for indefiniteness if its
8 claims, read in light of the patent’s specification and prosecution history, fail to
9 inform, with reasonable certainty, those skilled in the art about the scope of the
10 invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

11 The definiteness requirement requires that the claim must set forth what the
12 applicant regards as the invention, and do so with sufficient particularity and
13 definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
14 2002). Where it would be apparent to one of skill in the art, based on the patent
15 specification, that the “invention” set forth in a claim is not what the patent
16 applicant regarded as the invention, the claim is invalid. *Id.*

17 Section 112 further includes an enablement requirement: “The specification
18 shall contain a written description . . . of the manner and process of making and
19 using [the invention] in such full, clear, concise and exact terms as to enable any
20 person skilled in the art to which it pertains, or with which it is most nearly
21 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
22 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
23 those skilled in the art how to make and use the full scope of the claimed invention
24 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
25 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
26 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
27 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
28 the claim or does not enable the full scope of the claim, there is no enablement. *AK*

1 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
2 F.3d at 1383-84.

3 Section 112 further includes a written description requirement: “The
4 specification shall contain a written description of the invention[.]” Pre-AIA 35
5 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). “To satisfy the written description
6 requirement, a patent applicant must convey with reasonable clarity to those skilled
7 in the art that, as of the filing date sought, he or she was in possession of the
8 invention.” *ICU Medical Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377
9 (Fed. Cir. 2009) (internal quotation marks and citations omitted); *see also Synthes*
10 *USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (Fed. Cir. 2013). “The test
11 [for written description support] requires an objective inquiry into the four corners
12 of the specification from the perspective of a POSITA. Based on that inquiry, the
13 specification must describe an invention understandable to that skilled artisan and
14 show that the inventor actually invented the invention claimed.” *Ariad Pharms.,*
15 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

16 The specification must describe the claimed invention in sufficient detail so
17 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
18 words in a specification or a claim, even an original claim, does not necessarily
19 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
20 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
21 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
22 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
23 description requirement ... is necessarily met as a matter of law because the claim
24 language appears *in ipsius verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
25 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

26 2. Invalidity Grounds Under 35 U.S.C. § 112

27 The grounds identified below both individually and collectively render the
28 ’562 Asserted Claims invalid under the statutory requirements of § 112. By

1 identifying certain claim language below, Skechers does not imply that such
2 language is entitled to any patentable weight when comparing the claim as a whole
3 to the prior art. Skechers' identifications are made based on Skechers' present
4 understanding of the Asserted Claims and Nike's apparent interpretation of these
5 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
6 the right to amend these identifications, including in response to claim constructions
7 and claim interpretations that would render claim limitations not enabled, lacking in
8 written description, or indefinite.

9 **a. Lack of Enablement And Written Description**

10 Based on Skechers' present understanding of the Asserted Claims and Nike's
11 apparent interpretation of these claims as reflected in its Apparent Infringement
12 Contentions, the '562 Asserted Claims fail to satisfy the requirements of § 112
13 because the specification and original patent application fail to provide an enabling
14 disclosure of and written description support for at least the following limitations:

- 15 • "knitting an integral knit tongue that is of unitary knit construction with
16 the upper with the knitting machine, the integral knit tongue extending
17 through a throat area of the knitted component" (Claim 1)
- 18 • "knitting an integral knit tongue that is of unitary knit construction with
19 the upper with at least one of the first feeder and the second feeder of the
20 knitting machine, the integral knit tongue extending through a throat area
21 of the knitted component" (Claim 8)
- 22 • "the integral knit tongue is joined by knitting with the knitting machine to:
23 (1) a forward portion of the throat area, and (2) at least along a portion of
24 both of a lateral side and a medial side of the throat area of the knitted
25 component extending through a portion of a length of the throat area in a
26 longitudinal direction from the forward portion to an ankle opening of the
27 upper." (Claims 1, 8, 16)
- 28 • "forming a course with the knitting machine that joins the integral knit

1 tongue to the upper” (Claim 4)

2 These claim terms/phrases as apparently construed and/or interpreted by Nike
3 violate the written description and/or enablement requirements of 35 U.S.C. § 112.
4 Each asserted claim of the '562 Patent is invalid as not containing a written
5 description of the invention, and of the manner and process of making and using it,
6 in such full, clear, concise and exact terms as to enable any person skilled in the art
7 to which it pertains, or with which it is most nearly connected, to make and use the
8 alleged invention. Moreover, based on Skechers' present understanding of Nike's
9 Apparent Infringement Contentions, each of the asserted claims in which these
10 claim terms/phrases appear lack written description because the specification of the
11 '562 Patent demonstrates that the patentee neither conceived of nor demonstrated
12 possession of all that Nike now contends the claims cover. In addition, based on
13 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
14 of the asserted claims in which these claim terms/phrases appear are invalid because
15 the specification fails to provide sufficient disclosure to enable any POSITA to
16 which it pertains, or with which it is most nearly connected, to implement the
17 invention without undue experimentation.

18 **b. Indefiniteness**

19 Based on Skechers' present understanding of the '562 Asserted Claims and
20 Nike's apparent interpretation of these claims as reflected in its Apparent
21 Infringement Contentions, the '562 Asserted Claims fail to satisfy the requirements
22 of § 112 because the precise scope of at least the terms listed below cannot be
23 determined with reasonable certainty by a POSITA when reading the claims in light
24 of the specification and prosecution history.

25 Based on Skechers' present understanding of Nike's Apparent Infringement
26 Contentions, the '562 Asserted Claims are invalid for reciting at least the following
27 claim terms/phrases:

- 28
 - “throat area” (Claims 1, 5, 8, 13, 14, 16, 20, 21)

- “forward portion of the throat area” (Claims 1, 5, 8, 13, 16, 20)
- “integral knit tongue” (Claims 1, 3, 4, 6-10, 12-17, 19-21)

Based on Skechers present understanding of Nike’s Apparent infringement contentions, at least one or more of these claim terms/phrases are indefinite because they are inconsistent with and broader than the alleged invention disclosed in the specification and given Nike’s apparent constructions of the claims, any POSITA at the time of the invention would not understand what is claimed, even when the claims are read in light of the specification. To the extent that Nike ultimately asserts any terms in a manner that makes clear the scope of such terms would not be reasonably certain to a POSITA, Skechers reserves the right to seek a ruling that any such term is indefinite.

E. Invalidity Under the Doctrine of Double Patenting

The ’562 patent is also invalid for obvious-type double patenting. “[T]he obviousness-type double patenting doctrine prohibits an inventor from extending his right to exclude through claims in a later-expiring patent that are not patentably distinct from the claims of the inventor’s earlier-expiring patent[.]” *Gilead Scis., Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1210 (Fed. Cir. 2014). Both the ’562 and ’626 Patents issued from continuations-in-part of U.S. Patent App. No. 13/400,511 (the “’511 Application”), now Patent No. 8,448, 474 (the “’474 Patent”), and are subject to patent term extensions of 141 days and 703 days, respectively. Therefore, the ’474, ’562, and ’636 Patents respectively have the expiration dates of February 20, 2032, July 10, 2032, and January 23, 2034. Moreover, U.S. Patent Nos. 8,621,891 (the “’891 Patent”), 9,032,763 (the “’763 Patent”), 9,420,844 (the “’844 Patent”) all issued from a continuation or continuation-in-part application of the ’511 Application, and also have an expiration date of February 20, 2032. Because the ’562 Patent is a later-expiring patent than the ’474, ’891, 763, and 844 Patents, and its claims are obvious variations of those of the ’474, ’891, 763, and 844 Patents, the ’562 Asserted Claims are invalid and/or unenforceable for this

1 additional reason. *See, e.g., In re Collect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023).

2 **V. '636 PATENT**

3 **A. Prior Art References⁸**

4 Skechers identifies the following prior art presently known to Skechers to
5 anticipate the '636 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
6 (e), and/or (g), either expressly or inherently as understood by a POSITA, and/or to
7 render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers
8 generally identifies and incorporates by reference herein all prior art and invalidity
9 arguments previously asserted against the '636 Patent, whether during the original
10 prosecution of the '636 Patent, before the Patent Trial and Appeals Board, or during
11 any of the litigations filed by Nike involving the '636 Patent, including, for
12 example, the adidas Litigation or the New Balance Litigation. In addition,
13 discovery is ongoing, and Skechers has served document requests and
14 interrogatories for which responses are outstanding that Skechers expects to reveal
15 additional prior art. Furthermore, Skechers is generally aware of information
16 pertaining to prior art from other proceedings that is currently unavailable to
17 Skechers, including because such information may be subject to a protective order.
18 Once Skechers receives relevant information, it will timely supplement its invalidity
19 contentions, as appropriate.

20 **1. Prior Art Patents and Publications⁹**

Prior Art	Date of Issue or Publication
US RE18,804	4/1933
US 601,192	3/1898

25 ⁸ To the extent one or more prior art patents, publications, or products are
26 identified in the claim charts attached hereto but are not included in the tables and
27 lists below, those prior art patents, publications, or products should also be considered
as prior art to the '636 Patent.

28 ⁹ Skechers incorporates by reference all prior art references cited in the patents
and publications listed herein and/or their file histories.

1	Prior Art	Date of Issue or Publication
2	US 1,215,198	2/1917
3	US 1,597,934	8/1926
4	US 1,839,274	1/1932
5	US 1,888,172	11/1932
6	US 1,902,780	3/1933
7	US 1,910,251	5/1933
8	US 2,001,293	5/1935
9	US 2,034,091	3/1936
10	US 2,047,724	7/1936
11	US 2,147,197	2/1939
12	US 2,314,098	3/1943
13	US 2,330,199	9/1943
14	US 2,343,390	3/1944
15	US 2,400,692	5/1946
16	US 2,440,393	4/1948
17	US 2,569,764	10/1951
18	US 2,586,045	2/1952
19	US 2,608,078	8/1952
20	US 2,641,004	6/1953
21	US 2,675,631	4/1954
22	US 2,994,322	8/1961
23	US 3,583,081	6/1971
24	US 3,694,940	10/1972
25	US 3,704,474	12/1972
26	US 3,766,566	10/1973
27	US 3,778,856	12/1973
28	US 3,952,427	4/1976
	US 3,972,086	8/1976

1	Prior Art	Date of Issue or Publication
2	US 4,027,402	6/1977
3	US 4,031,586	6/1977
4	US 4,211,806	7/1980
5	US 4,232,458	11/1980
6	US 4,255,949	3/1981
7	US 4,258,480	3/1981
8	US 4,317,292	3/1982
9	US 4,373,361	2/1983
10	US 4,447,967	5/1984
11	US 4,465,448	8/1984
12	US 4,499,741	2/1985
13	US 4,607,439	8/1986
14	US 4,737,396	4/1988
15	US 4,750,339	6/1988
16	US 4,756,098	7/1988
17	US 4,785,558	11/1988
18	US 4,813,158	3/1989
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20	US 5,031,423	7/1991
21	US 5,095,720	3/1992
22	US 5,117,567	6/1992
23	US 5,152,025	10/1992
24	US 5,192,601	3/1993
25	US 5,337,493	8/1994
26	US 5,345,638	9/1994
27	US 5,353,524	10/1994
28	US 5,371,957	12/1994
	US 5,461,884	10/1995

1	Prior Art	Date of Issue or Publication
2	US 5,511,323	4/1996
3	US 5,572,860	11/1996
4	US 5,575,090	11/1996
5	US 5,623,840	4/1997
6	US 5,729,918	3/1998
7	US 5,735,145	4/1998
8	US 5,746,013	5/1998
9	US 5,765,296	6/1998
10	US 5,784,806	7/1998
11	US 5,823,012	10/1998
12	US 5,884,419	3/1999
13	US 5,996,189	12/1999
14	US 6,029,376	2/2000
15	US 6,032,387	3/2000
16	US 6,052,921	4/2000
17	US 6,088,936	7/2000
18	US 6,151,802	11/2000
19	US 6,170,175	1/2001
20	US 6,308,438	10/2001
21	US 6,321,574	11/2001
22	US 6,333,105	12/2001
23	US 6,401,364	6/2002
24	US 6,449,879	9/2002
25	US 6,558,784	5/2003
26	US 6,588,237	7/2003
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	US 6,922,917	8/2005

1	Prior Art	Date of Issue or Publication
2	US 6,931,762	8/2005
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4	US 7,051,460	5/2006
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6	US 7,347,011	3/2008
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9	US 7,568,298	8/2009
10	US 7,624,518	12/2009
11	US 7,682,219	3/2010
12	US 7,752,775	7/2010
13	US 7,770,306	8/2010
14	US 7,774,956	8/2010
15	US 7,814,598	10/2010
16	US 8,132,340	3/2012
17	US 8,196,317	6/2012
18	US 8,215,033	7/2012
19	US 8,225,530	7/2012
20	US 8,266,749	9/2012
21	US 8,448,474	5/2013
22	US 8,490,299	7/2013
23	US 8,621,891	1/2014
24	US 8,650,916	2/2014
25	US 8,745,895	6/2014
26	US 8,800,172	8/2014
27	US 2001/0055684	12/2001
28	US 2002/0078599	6/2002
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3	US 2003/0126762	7/2003
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5	US 2003/0200679	10/2003
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7	US 2004/0181972	9/2004
8	US 2004/0237348	12/2004
9	US 2005/0115284	6/2005
10	US 2005/0193592	9/2005
11	US 2005/0273.988	12/2005
12	US 2005/0284000	12/2005
13	US 2005/0288615	12/2005
14	US 2006/0059715	3/2006
15	US 2006/0162187	7/2006
16	US 2007/0022627	2/2007
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8	CN 102271548	12/2011
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J. Power, <i>9.6 Weft Knitwear in Fashion Applications</i> , in <i>Advances in Apparel Production</i> (Catherine Fairhurst, ed. 2008)	2008
Hong, H., A. Filho, et al. <i>The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine</i> , India Journal of Fibre and Textile Research, 1994, 19: 189-189	1994
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Innovations in Knitting, www.textileworld.com/textile-world/knitting-apparel/2009/09/innovations-in-knitting/	9/2009
Jenny Underwood, The Design of 3D Shape Knitted Preforms (PhD Dissertation), School of Fashion and Textiles, Design and Social Context Portfolio, RMIT University	11/2009
F. Saiffee, The Influence of Knitwear on Smart Wearables	2009
N. Gokarneshan & R. Alagirusamy, Weaving of 3D Fabrics: A Critical Appreciation of the Developments, Textile Progress, 41(1): 1-58	2009
Dorin Ionesi, et al., Three-Dimensional Knitted Fabric with Technical Destination, Bulletinul Institutului Politehnic Din Iași	2010

Prior Art	Date of Issue or Publication
Technology/Machinery, Santoni Seamless Innovations for Sports and Active Markets, www.innovationintextiles.com/technology-machinery-equipment/santoni-seamless-innovations-for-sports-and-active-markets	2/2011
Knitting industry, Flat Knitting: Adidas Unveils Adizero Primknit Running Shoe, www.knittingindustry.com/flat-knitting/adidas-unveils-adizero-primeknit-running-shoe	7/2012
Knitting Project – “Converse” Baby Booties!!!, amandaleaps.blogspot.com/2012/01/knitting-project-converse-baby-booties.html	1/2012
Fibres/Yarns/Fabrics, Nike Flyknit – A Seamlessly Knitted Running Shoe!, www.innovationintextiles.com/nike-flyknit-a-seamlessly-knitted-running-shoe	2/2012
Mohammad Imrul Khorshed, Studies on the Quality Control Procedure of Cutting Department in Footwear Industry (BS Dissertation), The University of Dhaka	2007
Brandon Richard, Bargain Buys: 20 Sneaker Steals Found in Vintage Eastbay Catalogs, www.complex.com/sneakers/a/brandon-richard/vintage-eastbay-sneaker-prices	9/2015
Caroline Cox, Vintage Shoes (Carlton Books)	2008
1989 Reebok AXT SXT CXT Cross-Training Shoes Vintage Print Ad, www.ebay.com/itm/362604032836	1989
Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes,	12/2019

Prior Art	Date of Issue or Publication
https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974

Skechers additionally identifies and relies on patent or publication references that describe or are otherwise related to the prior art products identified below.

2. Prior Art Products

Skechers also contends that the asserted claims of the '636 Patent are invalid

1 based on public knowledge and uses and/or offers for sale or sales of products that
2 are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the
3 United States by other inventors who had not abandoned, suppressed, or concealed
4 them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious
5 under 35 U.S.C. § 103 the asserted claims.

6 The following lists prior art products that invalidate under 35 U.S.C. § 102 or
7 render obvious under 35 U.S.C. § 103 the asserted claims by the name of the item,
8 and Skechers may rely on all versions of the following prior art products
9 commercially sold, offered for sale, publicly known or used before the priority date
10 of the '636 Patent, including things as well as documents describing the same:

Prior Art Product	Date of Public Use
Nike Huarache shoe, publicly known, used, and/or on sale within the United States, at least as early as February 20, 2011	No later than 2/20/2011
Nike Sock Dart shoe, publicly known, used, and/or on sale within the United States, at least as early as May 26, 2004	No later than 5/2004
“Acorn Footwear-Slipper Sock,” from Northland Maine, publicly known, used, and/or on sale within the United States, at least one year prior to Dec. 18, 2002.	No later than 12/18/2001
Arcopedico Shoes, publicly known, used, and/or on sale within the United States, at least one year prior to Dec. 18, 2002	No later than 12/18/2001
Nike “Air Flow” shoe (SK# 258), publicly known, used, and/or on sale within the United States, at least as early as January 30, 1990	No later than 1/1990
Reebok “Shaq Trainer” shoe, publicly known, used, and/or on sale within the United States, at least as early as 1995	No later than 1995
Reebok “City Jam” shoe (SK# 506), publicly known, used, and/or on sale within the United States, at least as early as 1993	No later than 1993

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Prior Art Product	Date of Public Use
“Nova Cushion” shoe (SK# 01290), publicly known, used, and/or on sale within the United States, at least as early as 2006	No later than 2006
Nike “Shox Laser” shoe, publicly known, used, and/or on sale within the United States, at least as early as July 2005	No later than 7/2005
Nike “2:40” shoe, publicly known, used, and/or on sale within the United States, at least as early as 2005	No later than 2005
Reebok “Summer Runner” shoe, publicly known, used, and/or on sale within the United States, at least as early as 2002	No later than 2005
Reebok “Whiplash” shoe, publicly known, used, and/or on sale within the United States, at least as early as 1995	No later than 2005
Nike Air Presto shoes, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Nike Sock Racer shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Das Wrestling shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Equipment Wrestling shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Barefoot shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Primeknit shoe, publicly known, used, and/or on sale within the United States	No later than 7/26/2012
Nike FlyKnit shoe, publicly known, used, and/or on sale within the United States	No later than 2/21/2012
Nike Flyknit Trainer+, publicly known, used, and/or on sale within the United States	No later than 2/21/2012
New Balance Minimus Life shoe, publicly known, used, and/or on sale within the United	No later than 2/20/2011

Prior Art Product	Date of Public Use
States	
Tuxedo shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Adizero Infiknit Olympics, publicly known, used, and/or on sale within the United States	No later than 2/28/2013
adidas Hydroglide 2000, publicly known, used, and/or on sale within the United States	No later than 2001
Nike Summer Runner, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas 2000 Sydney Olympics Collection, publicly known, used, and/or on sale within the United States	No later than 2001
Nike Presto Chanjo shoe, publicly known, used, and/or on sale within the United States	No later than 2001

Skechers' positions with respect to these references are stated on information and belief, and are supported by the information and documents that will be produced by Skechers, Nike, and/or third parties. Because discovery is not complete, Skechers continues to investigate these products and other relevant products, including those used, sold, and/or offered for sale by Nike, third parties, and Skechers and will supplement these disclosures if and as appropriate.

B. Invalidity Under 35 U.S.C. §§ 102 and 103

Nike asserts claims 1-27 of the '636 Patent. All of those claims are invalid because they fail to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the attached claim charts. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Although Skechers has identified at least one citation per limitation for each

1 reference, each and every disclosure of the same limitation in the same reference is
2 not necessarily identified. Rather, in an effort to focus the issues, Skechers has
3 generally cited representative portions of identified references, even where a
4 reference may contain additional support for a particular claim element. In addition,
5 POSITAs generally read a prior art reference as a whole and in the context of other
6 publications and literature. Thus, to understand and interpret any specific statement
7 or disclosure within a prior art reference, such persons would rely on other
8 information within the reference, along with other publications and their general
9 scientific knowledge. Skechers may rely upon uncited portions of the prior art
10 references and on other publications and expert testimony to provide context, and as
11 aids to understanding and interpreting the portions that are cited. Skechers may also
12 rely on the prior art of record for any permissible purpose, including prior art
13 discussed in the '636 Patent specification itself, including to show that the '636
14 Patent is anticipated or obvious, show the state of the art, show motivation to
15 combine a reference with one or more other references, and to show the proper
16 scope of the claims. Skechers may also rely on uncited portions of the prior art
17 references, other disclosed publications, and the testimony of experts to establish
18 that a POSITA would have been motivated to modify or combine certain of the cited
19 references so as to render the claims obvious.

20 **1. Anticipation**

21 Some or all of the asserted claims of the '636 Patent are invalid as anticipated
22 under 35 U.S.C. § 102 based on each of the prior art references identified above and
23 in the included claim charts, which identify specific examples of where each
24 limitation of the asserted claims is found in the prior art references, either expressly
25 or inherently. As explained above, the cited portions of prior art references
26 identified in the attached claim charts are exemplary only and representative of the
27 content and teaching of the prior art references, and should be understood in the
28 context of the reference as a whole and as they would be understood by a POSITA.

2. Obviousness

To the extent any limitation is deemed not to be exactly met by an item of prior art, any purported differences are such that the claimed subject matter as a whole would have been obvious to a POSITA at the time of the alleged invention, based on the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103.

In addition, the references identified above render one or more asserted claims of the '636 Patent obvious when the references are read in combination with each other by a POSITA. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined to render obvious (and therefore invalid) each of Nike's asserted claims. Skechers may rely upon a subset of the above identified references or all of the references identified above for purposes of obviousness depending on the Court's claim construction, positions taken by Nike during this litigation, and further investigation and discovery. Skechers may rely on combinations with any reference in the attached claim charts and any of the other references disclosed herein with respect to the '636 Patent, including combinations with any of the patents, publications or products identified herein as prior art to the '636 Patent.

Moreover, to the extent the foregoing references are found not to anticipate the asserted claims, the foregoing references render the asserted claims obvious either alone or in combination with one or more of the other references identified above. For example, as explained herein and/or in the accompanying charts, it would have been obvious to a POSITA at the time of the alleged invention of the asserted claims of the '636 Patent to modify or combine the various references cited herein so as to practice the asserted claims.

Motivations to combine the above items of prior art are present in the references themselves, general knowledge of a POSITA, the prior art as a whole, or

1 the nature of the problems allegedly addressed by the '636 Patent. Combining the
2 references identified in the accompanying claim charts would have been obvious, as
3 the references identify and address the same technical issues and suggest very
4 similar solutions to those issues. Skechers reserves the right to amend or supplement
5 these invalidity contentions to identify additional reasons that combining the
6 references would be obvious to a POSITA.

7 In addition to the specific combinations of prior art and the specific
8 combinations of groups of prior art disclosed, Skechers reserves the right to rely on
9 any other combination of any prior art references disclosed herein. Skechers further
10 reserves the right to rely upon combinations disclosed within the prosecution history
11 of the references cited herein.

12 The obviousness combinations set forth in these contentions reflect Skechers'
13 present understanding of the potential scope of the claims that Nike appears to be
14 advocating and should not be seen as Skechers' acquiescence to Nike's
15 interpretation of the patent claims. Skechers reserves the right to amend or
16 supplement these contentions regarding anticipation or obviousness of the asserted
17 claims based on further information from Nike, the Court, other courts or decision-
18 makers in parallel proceedings, or any other source including any changes Nike
19 makes to its Apparent Infringement Contentions, information discovered during
20 discovery, arguments made and positions taken by Nike, or a claim construction
21 ruling by the Court. Skechers reserves the right to amend or supplement these
22 contentions to assert different support for each asserted limitation, to cite different
23 portions of each reference in support of any invalidity theory, to assert different
24 combinations, or to identify different references, as necessary. Nike has not
25 identified what elements or combinations it alleges were not known to a POSITA.
26 Therefore, for any claim limitation that Nike alleges is not disclosed in a particular
27 prior art reference, Skechers reserves the right to assert that any such limitation is
28 either inherent in the disclosed reference or obvious to a POSITA at the time in light

1 of the same, or that the limitation is disclosed in another of the references disclosed
2 above and, in combination, would have rendered the asserted claim obvious.

3 Each of these combinations was obvious to try for a POSITA. In the field of
4 the '636 Patent, there was a design need or market pressure to solve a problem and
5 there were a finite number of identified, predictable solutions. A POSITA had good
6 reason to pursue the known options within his or her technical grasp including
7 combinations of the disclosures in the accompanying claim charts. Each of these
8 combinations is also the combination of familiar elements according to known
9 methods and yields predictable results. In the field of the '636 Patent, a great deal of
10 prior research and product designs were available and design incentives and other
11 market forces would prompt variations of it. Further reasons to combine the
12 references identified in the accompanying claim charts include the nature of the
13 problem being solved, the express, implied, and inherent teachings of the prior art,
14 and the knowledge of a POSITA that such combinations would have yielded
15 predictable results, and that such combinations would have represented known
16 alternatives to a POSITA. For each combination, there is a teaching, suggestion, and
17 motivation to combine both in the references to be combined themselves, as well as
18 in the art generally that was known to a POSITA. In any event, each limitation of
19 the '636 Patent is, and would have been at the time of the alleged invention, a
20 simple design choice representing a predictable variation within the skill of a
21 POSITA. Moreover, each limitation of the '636 Patent was well known in the art,
22 including well-known to POSITAs.

23 Additional prior art references rendering the asserted claims obvious, alone or
24 in combination with other references, including identification of combinations
25 showing obviousness, are identified in the accompanying claim charts, which
26 include exemplary citations for the '636 Asserted Claims showing specifically
27 where in each reference or combinations of references each asserted claim is found,
28 and an explanation of why the prior art renders the asserted claim obvious.

1 No showing of a specific motivation to combine prior art is required to
2 combine the references disclosed for any asserted patent in this document and in the
3 attached charts, as each combination of art would have yielded expected results and
4 at most would simply represent a known alternative to one of skill in the art. *See*
5 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
6 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
7 obvious because modifying the Admitted Prior Art/Betts combination to include a
8 second recess was nothing more than the predictable application of known
9 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
10 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
11 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
12 combine test, and instead applying an “expansive and flexible” approach). Indeed,
13 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
14 automaton” and “in many cases a POSITA will be able to fit the teachings of
15 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
16 Nevertheless, in addition to the information contained in the obviousness sections of
17 this document and elsewhere in these contentions, Skechers hereby identify
18 motivations and reasons to combine.

19 One or more combinations of the prior art references identified above would
20 have been obvious because these references would have been combined using:
21 known methods to yield predictable results; known techniques in the same way; a
22 simple substitution of one known, equivalent element for another to obtain
23 predictable results; and/or a teaching, suggestion, or motivation in the prior art
24 generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) (“It
25 is simply a matter of common sense that the sleeve used in Down, in a towing
26 attachment quite similar to a hitch receiver/tow bar arrangement, could be combined
27 with a barbell-shaped hitch pin lock in order to address the known problem of
28 different aperture sizes in standard hitch receivers and the shelf-space problem

1 experienced by retailers.”); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344
2 (Fed. Cir. 2008) (“The asserted claims simply substitute a resistive electrical switch
3 for the mechanical pressure switch employed by the Gopher Zapper,” which “is a
4 textbook case of when the asserted claims involve a combination of familiar
5 elements according to known methods that does no more than yield predictable
6 results.” (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed.
7 Cir. 2004) (affirming the district court’s finding of “a motivation to combine
8 because the two references address precisely the same problem of underpinning
9 existing structural foundations” even though the record “does not feature an express
10 written teaching in the art to make this combination”); *see also Ecolab, Inc. v. FMC*
11 *Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869
12 F.3d at 1344.

13 In addition, it would have been obvious to try combining the prior art
14 references identified above because there were only a finite number of predictable
15 solutions and/or because known work in one field of endeavor prompted variations
16 based on predictable design incentives and/or market forces either in the same field
17 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
18 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
19 he could place the thickness sensor either above the presence sensor in the feed, so
20 that the paper contacts the thickness sensor before the presence sensor, or below so
21 that the paper contacts it after. Each of these two design choices is an obvious
22 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
23 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
24 skilled artisan may have preferred a delayed-release formulation over the claimed
25 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
26 of a particular combination need not be supported by a finding that the prior art
27 suggests that the combination claimed ... is the preferred, or most desirable,
28 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004))); *KSR*,

1 550 U.S. at 419-20. Further, the combinations of the prior art references identified
2 above and in the claim charts would have been obvious because the combinations
3 represent known potential options with a reasonable expectation of success. *See*
4 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

5 Additional evidence that there would have been a motivation to combine the
6 prior art references identified above includes the interrelated teachings of multiple
7 prior art references; the effects of demands known to the design community or
8 present in the marketplace; the existence of a known problem for which there was an
9 obvious solution encompassed by the '636 Asserted Claims; the existence of a
10 known need or problem in the field of the endeavor at the time of the alleged
11 inventions; and the background knowledge that would have been possessed by a
12 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
13 incentives and other market forces can prompt variations of it, either in the same
14 field or in another. If a person of ordinary skill in the art can implement a
15 predictable variation, and would see the benefit of doing so, § 103 likely bars its
16 patentability. Moreover, if a technique has been used to improve one device, and a
17 person of ordinary skill in the art would recognize that it would improve similar
18 devices in the same way, using the technique is obvious unless its actual application
19 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
20 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
21 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
22 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
23 2012).

24 The motivation to combine the teachings of the prior art references disclosed
25 herein is also found in the references themselves and in: (1) the nature of the
26 problem being solved; (2) the express, implied and inherent teachings of the prior
27 art; (3) the knowledge of POSITAs; (4) the predictable results obtained in
28 combining the different elements of the prior art; (5) the predictable results obtained

1 in simple substitution of one known element for another; (6) the use of a known
2 technique to improve similar devices, methods, or products in the same way; (7) the
3 predictable results obtained in applying a known technique to a known device,
4 method, or product ready for improvement; (8) the finite number of identified
5 predictable solutions that had a reasonable expectation of success; and (9) known
6 work in various technological fields that could be applied to the same or different
7 technological fields based on design incentives or other market forces. *See above*
8 for legal background regarding obviousness combinations and M.P.E.P. § 2143.

9 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
10 **Claims**

11 Skechers submits the following charts identifying specific locations in each
12 alleged item of prior art where each limitation of each asserted claim is found as
13 attached Exhibits 636-1 through 636-9. The contents of Exhibits 636-1 through 636-
14 9, in combination with the foregoing patents, publications, and products, anticipate
15 and/or render obvious the '636 Asserted Claims under 35 U.S.C. § 102, either
16 expressly or inherently, and under § 103, in each case, as understood by a POSITA.

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '636 Patent)
636-1	Glidden – U.S. Patent No. 2,147,197 ¹⁰
636-2	Dua '956 – U.S. Patent No. 7,774,956
636-3	Joha – U.S. Patent No. RE 18,804
636-4	Bell – U.S. Patent App. Pub. No. 2010/0077634
636-5	Clark – U.S. Patent No. 2,440,393
636-6	Horii - Japanese Patent App. Pub. No. H3-3203
636-7	Li – Chinese Patent App. Pub. No. 2187379Y

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¹⁰ An identification of a prior art reference for purposes of identifying an exhibit should be understood to mean that the chart discloses not only bases for invalidity based on that reference, but also that reference in combination with other references identified or referred to in the chart.

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '636 Patent)
636-8	Dua '592 – U.S. Patent App. Pub. No. 2005/0193592
636-9	Glidden, Dua '956, Joha, Bell, Clark, Horii, Li, and Dua '592

D. Invalidity Under 35 U.S.C. § 112

1. Legal Background Regarding The Definiteness, Enablement, And Written Description Requirements

Section 112 includes a definiteness requirement: “[T]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Pre-AIA 35 U.S.C. § 112, ¶ 2; AIA 35 U.S.C. § 112(b). “[A] patent is invalid for indefiniteness if its claims, read in light of the patent’s specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

The definiteness requirement requires that the claim must set forth what the applicant regards as the invention, and do so with sufficient particularity and definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002). Where it would be apparent to one of skill in the art, based on the patent specification, that the “invention” set forth in a claim is not what the patent applicant regarded as the invention, the claim is invalid. *Id.*

Section 112 further includes an enablement requirement: “The specification shall contain a written description . . . of the manner and process of making and using [the invention] in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach those skilled in the art how to make and use the full scope of the claimed invention

1 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
2 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
3 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
4 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
5 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
6 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
7 F.3d at 1383.

8 Section 112 further includes a written description requirement: “The
9 specification shall contain a written description of the invention[.]” Pre-AIA 35
10 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). “To satisfy the written description
11 requirement, a patent applicant must convey with reasonable clarity to those skilled
12 in the art that, as of the filing date sought, he or she was in possession of the
13 invention.” *ICU Medical Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377
14 (Fed. Cir. 2009) (internal quotation marks and citations omitted); *see also Synthes*
15 *USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (Fed. Cir. 2013). “The test
16 [for written description support] requires an objective inquiry into the four corners
17 of the specification from the perspective of a POSITA. Based on that inquiry, the
18 specification must describe an invention understandable to that skilled artisan and
19 show that the inventor actually invented the invention claimed.” *Ariad Pharms.,*
20 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

21 The specification must describe the claimed invention in sufficient detail so
22 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
23 words in a specification or a claim, even an original claim, does not necessarily
24 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
25 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
26 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
27 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
28 description requirement ... is necessarily met as a matter of law because the claim

1 language appears *in ipsis verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
2 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002)).

3 **2. Invalidity Grounds Under 35 U.S.C. § 112**

4 The grounds identified below both individually and collectively render the
5 ’636 Asserted Claims invalid under the statutory requirements of § 112. By
6 identifying certain claim language below, Skechers does not imply that such
7 language is entitled to any patentable weight when comparing the claim as a whole
8 to the prior art. Skechers’ identifications are made based on Skechers’ present
9 understanding of the Asserted Claims and Nike’s apparent interpretation of these
10 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
11 the right to amend these identifications, including in response to claim constructions
12 and claim interpretations that would render claim limitations not enabled, lacking in
13 written description, or indefinite.

14 **a. Lack of Enablement And Written Description**

15 Based on Skechers’ present understanding of the Asserted Claims and Nike’s
16 apparent interpretation of these claims as reflected in its Apparent Infringement
17 Contentions, the ’636 Asserted Claims fail to satisfy the requirements of § 112
18 because the specification and original patent application fail to provide an enabling
19 disclosure of and written description support for at least the following limitations:

- 20 • “the integral knit tongue is joined to a forward portion of the throat area
21 and at least along a portion of a lateral side and a medial side of the throat
22 area of the knitted component extending from the forward portion to an
23 ankle opening of the upper” (Claims 1, 13)
- 24 • “at least a second portion of the first knit element layer and the second knit
25 element layer are joined along the throat area of the knitted component”
26 (Claim 12, 24)
- 27 • “at least one raised element that is formed of unitary knit construction with
28 the upper and the integral knit tongue.” (Claims 4, 16, 26)

1 These claim terms/phrases as apparently construed and/or interpreted by Nike
2 violate the written description and/or enablement requirements of 35 U.S.C. § 112.
3 Each asserted claim of the '636 Patent is invalid as not containing a written
4 description of the invention, and of the manner and process of making and using it,
5 in such full, clear, concise and exact terms as to enable any person skilled in the art
6 to which it pertains, or with which it is most nearly connected, to make and use the
7 alleged invention. Moreover, based on Skechers' present understanding of Nike's
8 Apparent Infringement Contentions, each of the asserted claims in which these
9 claim terms/phrases appear lack written description because the specification of the
10 '636 Patent demonstrates that the patentee neither conceived of nor demonstrated
11 possession of all that Nike now contends the claims cover. In addition, based on
12 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
13 of the asserted claims in which these claim terms/phrases appear are invalid because
14 the specification fails to provide sufficient disclosure to enable any POSITA to
15 which it pertains, or with which it is most nearly connected, to implement the
16 invention without undue experimentation.

17 **b. Indefiniteness**

18 Based on Skechers' present understanding of the '636 Asserted Claims and
19 Nike's apparent interpretation of these claims as reflected in its Apparent
20 Infringement Contentions, the '562 Asserted Claims fail to satisfy the requirements
21 of § 112 because the precise scope of at least the terms listed below cannot be
22 determined with reasonable certainty by a POSITA when reading the claims in light
23 of the specification and prosecution history.

24 Based on Skechers' present understanding of Nike's Apparent Infringement
25 Contentions, the '636 Asserted Claims are invalid for reciting at least the following
26 claim terms/phrases:

- 27 • "raised element" (Claims 1-20, 27)
- 28 • "throat area" (Claims 1, 5, 7, 11-13, 18, 21, 23, 24)

- 1 • “forward portion of the throat area” (Claims 1, 7, 13, 18, 21)
- 2 • “integral knit tongue” (Claims 1-4, 7, 8, 10, 13-16, 18, 19, 21, 22, 25, 26)
- 3 • “knit structure” (Claims 3, 15)
- 4 • “the portion of the lateral side and the medial side” (Claim 7)
- 5 • “an integral knit tongue with the upper” (Claim 13)

6 Based on Skechers present understanding of Nike’s Apparent Infringement
7 Contentions, at least one or more of these claim terms/phrases are indefinite because
8 they are inconsistent with and broader than the alleged invention disclosed in the
9 specification and given Nike’s apparent constructions of the claims, any POSITA at
10 the time of the invention would not understand what is claimed, even when the
11 claims are read in light of the specification. To the extent that Nike ultimately
12 asserts any terms in a manner that makes clear the scope of such terms would not be
13 reasonably certain to a POSITA, Skechers reserves the right to seek a ruling that any
14 such term is indefinite.

15 **E. Invalidity Under the Doctrine of Double Patenting**

16 The ’636 patent is also invalid for obvious-type double patenting. “[T]he
17 obviousness-type double patenting doctrine prohibits an inventor from extending his
18 right to exclude through claims in a later-expiring patent that are not patentably
19 distinct from the claims of the inventor’s earlier-expiring patent[.]” *Gilead Scis.,*
20 *Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1210 (Fed. Cir. 2014). Both the ’562 and
21 ’626 Patents issued from continuations-in-part of U.S. Patent App. No. 13/400,511,
22 now Patent No. 8,448, 474 (the “’474 Patent”), and are subject to patent term
23 extensions of 141 days and 703 days, respectively. Therefore, the ’474, ’562, and
24 ’636 Patents respectively have the expiration dates of February 20, 2032, July 10,
25 2032, and January 23, 2034. Moreover, U.S. Patent Nos. 8,621,891 (the “’891
26 Patent”), 9,032,763 (the “’763 Patent”), 9,420,844 (the “’844 Patent”) all issued
27 from a continuation or continuation-in-part application of the ’511 Application, and
28 also have an expiration date of February 20, 2032. Because the ’636 Patent is a

1 later-expiring patent than the '474, '562, 891, 763, and 844 Patents, and its claims
2 are obvious variations of those of the '474, '562, 891, 763, and 844 Patents, the '636
3 Asserted Claims are invalid and/or unenforceable for this additional reason. *See*,
4 *e.g., In re Collect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023).

5 **VI. '484 PATENT**

6 **A. Prior Art References¹¹**

7 Skechers identifies the following prior art presently known to Skechers to
8 anticipate the '484 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
9 (e), and/or (g) or AIA 35 U.S.C. § 102, either expressly or inherently as understood
10 by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in
11 combination. Skechers generally identifies and incorporates by reference herein all
12 prior art and invalidity arguments previously asserted against the '484 Patent,
13 whether during the original prosecution of the '484 Patent, before the Patent Trial
14 and Appeals Board, or during any of the litigations filed by Nike involving the '484
15 Patent, including, for example, the lululemon Litigation or the New Balance
16 Litigation. In addition, discovery is ongoing, and Skechers has served document
17 requests and interrogatories for which responses are outstanding that Skechers
18 expects to reveal additional prior art. Furthermore, Skechers is generally aware of
19 information pertaining to prior art from other proceedings that is currently
20 unavailable to Skechers, including because such information may be subject to a
21 protective order. Once Skechers receives relevant information, it will timely
22 supplement its invalidity contentions, as appropriate.

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27 ¹¹ To the extent one or more prior art patents, publications, or products are
28 identified in the claim charts attached hereto but are not included in the tables and
lists below, those prior art patents, publications, or products should also be considered
as prior art to the '484 Patent.

1. Prior Art Patents and Publications¹²

Prior Art	Date of Issue or Publication
US 601,192	3/1898
US 924,605	6/1909
US, 1,215,198	2/1917
US 1,597,934	8/1926
US 1,729,816	10/1929
US 1,888,172	11/1932
US 1,902,780	3/1933
US 1,910,251	5/1933
US 2,001,293	5/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,314,098	3/1943
US 2,330,199	9/1943
US 2,376,399	10/1943
US 2,343,390	3/1944
US 2,400,692	5/1946
US 2,412,087	12/1946
US 2,440,393	4/1948
US 2,569,764	10/1951
US 2,586,045	2/1952
US 2,608,078	8/1952
US 2,641,004	6/1953
US 2,675,631	4/1954
US 2,707,381	5/1955
US 2,714,813	8/1955

¹² Skechers incorporates by reference all prior art references cited in the patents and publications listed herein and/or their file histories.

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Prior Art	Date of Issue or Publication
US 2,770,055	11/1956
US 2,904,980	9/1959
US 2,994,322	8/1961
US 3,114,213	12/1963
US 3,128,567	4/1964
US 3,284,827	11/1966
US 3,291,085	8/1964
US 3,402,323	9/1968
US 3,416,174	12/1968
US 3,583,081	6/1971
US 3,603,006	9/1971
US 3,641,603	2/1972
US 3,694,940	10/1972
US 3,704,474	12/1972
US 3,766,566	10/1973
US 3,778,856	12/1973
US 3,952,427	4/1976
US 3,972,086	8/1976
US 4,027,402	6/1977
US 4,031,586	6/1977
US 4,211,806	7/1980
US 4,232,458	11/1980
US 4,255,949	3/1981
US 4,258,480	3/1981
US 4,317,292	3/1982
US 4,342,159	8/1982
US 4,373,361	2/1983
US 4,430,811	2/1984

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Prior Art	Date of Issue or Publication
US 4,447,967	5/1984
US 4,465,448	8/1984
US 4,607,439	8/1986
US 4,646,727	3/1987
US 4,737,396	4/1988
US 4,750,339	6/1988
US 4,756,098	7/1988
US 4,785,558	11/1988
US 4,813,158	3/1989
US 4,878,504	11/1989
US 4,967,494	11/1990
US 4,998,722	3/1991
US 5,031,423	7/1991
US 5,067,260	11/1991
US 5,095,720	3/1992
US 5,117,567	6/1992
US 5,152,025	10/1992
US 5,192,601	3/1993
US 5,257,969	11/1993
US D346,686	5/1994
US 5,345,638	9/1994
US 5,353,524	10/1994
US 5,371,957	12/1994
US 5,377,430	1/1995
US 5,461,884	10/1995
US 5,511,323	4/1996
US 5,572,860	11/1996
US 5,575,090	11/1996

1	Prior Art	Date of Issue or Publication
2	US 5,623,840	4/1997
3	US 5,729,918	3/1998
4	US 5,735,145	4/1998
5	US 5,746,013	5/1998
6	US 5,765,296	6/1998
7	US 5,778,564	7/1998
8	US 5,884,419	3/1999
9	US 5,996,189	12/1999
10	US 6,029,376	2/2000
11	US 6,032,387	3/2000
12	US 6,052,921	4/2000
13	US 6,088,936	7/2000
14	US 6,151,802	11/2000
15	US 6,170,175	1/2001
16	US 6,227,010	5/2001
17	US 6,308,438	10/2001
18	US 6,333,105	12/2001
19	US 6,367,168	4/2002
20	US 6,389,715	5/2002
21	US 6,401,364	6/2002
22	US 6,558,784	5/2003
23	US 6,588,237	7/2003
24	US 6,631,569	10/2003
25	US 6,644,070	11/2003
26	US 6,763,610	7/2004
27	US 6,754,983	6/2004
28	US 6,910,288	6/2005
	US 6,922,917	8/2005

1	Prior Art	Date of Issue or Publication
2	US 6,931,762	8/2005
3	US 6,986,269	1/2006
4	US D517,297	3/2006
5	US 7,016,867	3/2006
6	US 7,051,460	5/2006
7	US 7,056,402	6/2006
8	US 7,107,235	9/2006
9	US 7,168,184	1/2007
10	US 7,347,011	3/2008
11	US 7,441,348	10/2008
12	US 7,543,397	6/2009
13	US 7,568,298	8/2009
14	US 7,637,032	12/2009
15	US 7,682,219	3/2010
16	US 7,774,956	8/2010
17	US 7,861,438	1/2011
18	US 8,215,132	7/2012
19	US 8,225,530	7/2012
20	US 8,448,474	5/2013
21	US 8,490,299	7/2013
22	US 8,544,191	10/2013
23	US 8,650,916	2/2014
24	US 8,887,411	11/2014
25	US 2002/0078599	6/2002
26	US 2002/0148258	10/2002
27	US 2003/0037462	2/2003
28	US 2003/0126762	7/2003
	US 2003/0191427	10/2003

1	Prior Art	Date of Issue or Publication
2	US 2004/0118018	6/2004
3	US 2004/0181972	9/2004
4	US 2004/0226191	11/2004
5	US 2005/0016023	1/2005
6	US 2005/0075027	4/2005
7	US 2005/0115284	6/2005
8	US 2005/0193592	9/2005
9	US 2005/0273988	12/2005
10	US 2005/0284000	12/2005
11	US 2006/0010931	1/2006
12	US 2006/0048413	3/2006
13	US 2006/0059715	3/2006
14	US 2006/0130359	6/2006
15	US 2006/0162187	7/2006
16	US 2007/0022627	2/2007
17	US 2007/0180730	8/2007
18	US 2007/0245595	10/2007
19	US 2007/0294920	12/2007
20	US 2008/0017294	1/2008
21	US 2008/0078102	4/2008
22	US 2008/0110048	5/2008
23	US 2008/0189830	8/2008
24	US 2008/0313939	12/2008
25	US 2009/0068908	3/2009
26	US 2009/0158621	6/2009
27	US 2010/0051132	3/2010
28	US 2010/0154256	6/2010
	US 2010/0170651	7/2010

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Prior Art	Date of Issue or Publication
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US 2011/0078921	4/2011
US 2012/0233882	9/2012
US 2012/0240429	9/2012
US 2012/0255201	10/2012
US 2012/0285043	11/2012
US 2013/0160323	6/2013
US 2013/0269209	10/2013
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US 2015/0075031	3/2015
CN 2187379Y	1/1995
CN 103556384	2/2014
CN 1882260A	12/2006
CN 2249104Y	3/1997
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Prior Art	Date of Issue or Publication
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EP 1972706 A1	9/2008
EP 2805638	11/2014
FR 2171172	9/1973
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GB 714,581	9/1954
GB 538865	8/1941
GB1539886	2/1979
GB 2018837	10/1979
GB 1023973	3/1966
GB 1106145	3/1968
GB 1603487	11/1981
JP S49-39620	10/1974
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JP H1-178708U	12/1989
JP H2-116806	9/1990
JP H06113905	4/1994
JP H08109553	4/1996
JP H11302943	11/1999
JP 2004-353146	12/2004
KR 900006205	8/1990
KR 20060061893	6/2006
KR 100695801	3/2007
KR 20070005915	1/2007
KR 20070102146	10/2007
KR 20060034632	4/2006

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Prior Art	Date of Issue or Publication
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KR 100564792	3/2006
KR 890001482	3/1989
KR 200374438Y1	1/2005
KR 200330686Y1	10/2003
KR 900004335	4/1990
NL 7304678	10/1974
TW 1228158 B	2/2005
TW 201402030 A	1/2014
TW M498500 U	4/2015
WO 9003744	4/1990
WO 0032861	6/2000
WO 0231247	4/2002
WO 2006/099911	9/2006
WO 2013/108506	7/2013
WO 2013/126313	8/2013
WO 2014/050289	4/2014
Letter from Bruce Huffa	12/2013
David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third ed., Woodhead Publishing Ltd. 2001)	2001
Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth-Verlag GmnH 2002)	2002
Hong, H., et al. <i>The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine</i> , India Journal of Fibre and Textile Research, 1994, 19: 189-189	9/1994
A.P. Mouritz, et al., Review of Applications for Advanced Three-Dimensional Fibre	1999

Prior Art	Date of Issue or Publication
Textile Composites, Composites: Part A 30 (1999) 1445-1461	
K.H. Leong, et al., The Potential of Knitting for Engineering Composites—A Review, Composites: Part A 31 (2000) 197-200	2000
T. Dias, et al., Knitting Seamless Three-Dimensional Shell Structures on Modern Electronic Flat Bed Knitting Machines, in Medical Textiles (Subhash Anand), pp. 36-43	12/2001
M. Legner, Medical Textiles with Specific Characteristics Produced on Flat Knitting Machines, in Medical Textiles (Subhash Anand), pp. 44-51	12/2001
Product Engineering – Interior Trim, pp. 194-226	2001
Welts, garment sequences and knitting to shape, pp. 179-193	2001
Manufacture of 3D Fibre Preforms	2002
S. Bramel, Key Trends in Sportswear Design	2005
Carole Barenys, Two Needle Baby Booties	2006
Vickie Howell, Hugs and Stitches: Show Your Love for a New Babe by Knitting Him These Newborn Booties (May Media Group, LLC)	5-6/2007
Isidore Zamosky, Shoe Modifications in Lower-Extremity Orthotics, Journal of Rehabilitation Research and Development; Washington, Vol. 50, Iss. 6, pp. 54-95	2013
Brandon Richard, Bargain Buys: 20 Sneaker Steals Found in Vintage Eastbay Catalogs, www.complex.com/sneakers/a/brandon-richard/vintage-eastbay-sneaker-prices	9/2015
Caroline Cox, Vintage Shoes (Carlton Books)	2008
1989 Reebok AXT SXT CXT Cross-Training Shoes Vintage Print Ad, www.ebay.com/itm/362604032836	1989

Prior Art	Date of Issue or Publication
Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
Stoll Sirix 100 / 200 Manual Part 1 and Part 2	NA

1 Skechers additionally identifies and relies on patent or publication references
2 that describe or are otherwise related to the prior art products identified below.

3 2. Prior Art Products

4 Skechers also contends that the asserted claims of the '484 Patent are invalid
5 based on public knowledge and uses and/or offers for sale or sales of products that
6 are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the
7 United States by other inventors who had not abandoned, suppressed, or concealed
8 them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious
9 under 35 U.S.C. § 103 the asserted claims.

10 The following lists prior art products that invalidate under 35 U.S.C. § 102 or
11 render obvious under 35 U.S.C. § 103 the asserted claims by the name of the item,
12 and Skechers may rely on all versions of the following prior art products
13 commercially sold, offered for sale, publicly known or used before the priority date
14 of the '484 Patent, including things as well as documents describing the same:

Prior Art Product	Date of Public Use
Stoll Flat Knitting Machinery in operation within the United States	No later than 3/3/2003
Santoni Circular Knitting Machinery in operation within the United States	No later than 3/3/2003
Nike Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Air Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Aquasock, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
adidas engineered warp footwear, publicly known, used, and/or on sale within the United States. Including: white and blue adidas 2000 Olympic Wrestling shoe, Olympic Rowing	No later than 3/3/2003

Prior Art Product	Date of Public Use
Shoe, adidas black and white Olympic sprinting shoes, adidas Olympic Boxing shoes, adidas Olympic marathon orange and white shoe, 2003 adistar RD shoe, adidas white and blue shoe 2003 a3 shoe, adidas YY Tenet Flower shoe, and adidas Climacool shoe	
Pan Am Slipper publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Capezio Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Karl Mayer Warp Knitting Machinery in operation within the United States	No later than 3/3/2003
Steve Blevins, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Robert Szanto for Simply Knitting Mills, Inc., publicly known, used, and/or on sale within United States	No later than 3/3/2003

Skechers' positions with respect to these references are stated on information and belief, and are supported by the information and documents that will be produced by Skechers, Nike, and/or third parties. Because discovery is not complete, Skechers continues to investigate these products and other relevant products, including those used, sold, and/or offered for sale by Nike, third parties, and Skechers and will supplement these disclosures if and as appropriate.

B. Invalidity Under 35 U.S.C. §§ 102 and 103

Nike asserts claims 1, 5-9, 11-17 of the '484 Patent. All of those claims are invalid because they fail to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the attached claim charts. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

1 Although Skechers has identified at least one citation per limitation for each
2 reference, each and every disclosure of the same limitation in the same reference is
3 not necessarily identified. Rather, in an effort to focus the issues, Skechers has
4 generally cited representative portions of identified references, even where a
5 reference may contain additional support for a particular claim element. In addition,
6 POSITAs generally read a prior art reference as a whole and in the context of other
7 publications and literature. Thus, to understand and interpret any specific statement
8 or disclosure within a prior art reference, such persons would rely on other
9 information within the reference, along with other publications and their general
10 scientific knowledge. Skechers may rely upon uncited portions of the prior art
11 references and on other publications and expert testimony to provide context, and as
12 aids to understanding and interpreting the portions that are cited. Skechers may also
13 rely on the prior art of record for any permissible purpose, including prior art
14 discussed in the '484 Patent specification itself, including to show that the '484
15 Patent is anticipated or obvious, show the state of the art, show motivation to
16 combine a reference with one or more other references, and to show the proper
17 scope of the claims. Skechers may also rely on uncited portions of the prior art
18 references, other disclosed publications, and the testimony of experts to establish
19 that a POSITA would have been motivated to modify or combine certain of the cited
20 references so as to render the claims obvious.

21 **1. Anticipation**

22 Some or all of the asserted claims of the '484 Patent are invalid as anticipated
23 under 35 U.S.C. § 102 based on each of the prior art references identified above and
24 in the included claim charts, which identify specific examples of where each
25 limitation of the asserted claims is found in the prior art references, either expressly
26 or inherently. As explained above, the cited portions of prior art references
27 identified in the attached claim charts are exemplary only and representative of the
28 content and teaching of the prior art references, and should be understood in the

1 context of the reference as a whole and as they would be understood by a POSITA.

2 **2. Obviousness**

3 To the extent any limitation is deemed not to be exactly met by an item of
4 prior art, any purported differences are such that the claimed subject matter as a
5 whole would have been obvious to a POSITA at the time of the alleged invention,
6 based on the state of the art and knowledge of those skilled in the art. The item of
7 prior art would, therefore, render the relevant claims invalid for obviousness under
8 35 U.S.C. § 103.

9 In addition, the references identified above render one or more asserted
10 claims of the '484 Patent obvious when the references are read in combination with
11 each other by a POSITA. Each and every reference identified is also relevant to the
12 state of the art at the time of the alleged invention. Any of the references disclosed
13 above may be combined to render obvious (and therefore invalid) each of Nike's
14 asserted claims. Skechers may rely upon a subset of the above identified references
15 or all of the references identified above for purposes of obviousness depending on
16 the Court's claim construction, positions taken by Nike during this litigation, and
17 further investigation and discovery. Skechers may rely on combinations with any
18 reference in the attached claim charts and any of the other references disclosed
19 herein with respect to the '484 Patent, including combinations with any of the
20 patents, publications or products identified herein as prior art to the '484 Patent.

21 Moreover, to the extent the foregoing references are found not to anticipate
22 the asserted claims, the foregoing references render the asserted claims obvious
23 either alone or in combination with one or more of the other references identified
24 above. For example, as explained herein and/or in the accompanying charts, it
25 would have been obvious to a POSITA at the time of the alleged invention of the
26 asserted claims of the '484 Patent to modify or combine the various references cited
27 herein so as to practice the asserted claims.

28 Motivations to combine the above items of prior art are present in the

1 references themselves, general knowledge of a POSITA, the prior art as a whole, or
2 the nature of the problems allegedly addressed by the '484 Patent. Combining the
3 references identified in the accompanying claim charts would have been obvious, as
4 the references identify and address the same technical issues and suggest very
5 similar solutions to those issues. Skechers reserves the right to amend or supplement
6 these invalidity contentions to identify additional reasons that combining the
7 references would be obvious to a POSITA.

8 In addition to the specific combinations of prior art and the specific
9 combinations of groups of prior art disclosed, Skechers reserves the right to rely on
10 any other combination of any prior art references disclosed herein. Skechers further
11 reserves the right to rely upon combinations disclosed within the prosecution history
12 of the references cited herein.

13 The obviousness combinations set forth in these contentions reflect Skechers'
14 present understanding of the potential scope of the claims that Nike appears to be
15 advocating and should not be seen as Skechers' acquiescence to Nike's
16 interpretation of the patent claims. Skechers reserves the right to amend or
17 supplement these contentions regarding anticipation or obviousness of the asserted
18 claims based on further information from Nike, the Court, other courts or decision-
19 makers in parallel proceedings, or any other source including any changes Nike
20 makes to its Apparent Infringement Contentions, information discovered during
21 discovery, arguments made and positions taken by Nike, or a claim construction
22 ruling by the Court. Skechers reserves the right to amend or supplement these
23 contentions to assert different support for each asserted limitation, to cite different
24 portions of each reference in support of any invalidity theory, to assert different
25 combinations, or to identify different references, as necessary. Nike has not
26 identified what elements or combinations it alleges were not known to a POSITA.
27 Therefore, for any claim limitation that Nike alleges is not disclosed in a particular
28 prior art reference, Skechers reserves the right to assert that any such limitation is

1 either inherent in the disclosed reference or obvious to a POSITA at the time in light
2 of the same, or that the limitation is disclosed in another of the references disclosed
3 above and, in combination, would have rendered the asserted claim obvious.

4 Each of these combinations was obvious to try for a POSITA. In the field of
5 the '484 Patent, there was a design need or market pressure to solve a problem and
6 there were a finite number of identified, predictable solutions. A POSITA had good
7 reason to pursue the known options within his or her technical grasp including
8 combinations of the disclosures in the accompanying claim charts. Each of these
9 combinations is also the combination of familiar elements according to known
10 methods and yields predictable results. In the field of the '484 Patent, a great deal of
11 prior research and product designs were available and design incentives and other
12 market forces would prompt variations of it. Further reasons to combine the
13 references identified in the accompanying claim charts include the nature of the
14 problem being solved, the express, implied, and inherent teachings of the prior art,
15 and the knowledge of a POSITA that such combinations would have yielded
16 predictable results, and that such combinations would have represented known
17 alternatives to a POSITA. For each combination, there is a teaching, suggestion, and
18 motivation to combine both in the references to be combined themselves, as well as
19 in the art generally that was known to a POSITA. In any event, each limitation of
20 the '484 Patent is, and would have been at the time of the alleged invention, a
21 simple design choice representing a predictable variation within the skill of a
22 POSITA. Moreover, each limitation of the '484 Patent was well known in the art,
23 including well-known to POSITAs.

24 Additional prior art references rendering the asserted claims obvious, alone or
25 in combination with other references, including identification of combinations
26 showing obviousness, are identified in the accompanying claim charts, which
27 include exemplary citations for the '484 Asserted Claims showing specifically
28 where in each reference or combinations of references each asserted claim is found,

1 and an explanation of why the prior art renders the asserted claim obvious.

2 No showing of a specific motivation to combine prior art is required to
3 combine the references disclosed for any asserted patent in this document and in the
4 attached charts, as each combination of art would have yielded expected results and
5 at most would simply represent a known alternative to one of skill in the art. *See*
6 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
7 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
8 obvious because modifying the Admitted Prior Art/Betts combination to include a
9 second recess was nothing more than the predictable application of known
10 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
11 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
12 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
13 combine test, and instead applying an “expansive and flexible” approach). Indeed,
14 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
15 automaton” and “in many cases a POSITA will be able to fit the teachings of
16 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
17 Nevertheless, in addition to the information contained in the obviousness sections of
18 this document and elsewhere in these contentions, Skechers hereby identify
19 motivations and reasons to combine.

20 One or more combinations of the prior art references identified above would
21 have been obvious because these references would have been combined using:
22 known methods to yield predictable results; known techniques in the same way; a
23 simple substitution of one known, equivalent element for another to obtain
24 predictable results; and/or a teaching, suggestion, or motivation in the prior art
25 generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) (“It
26 is simply a matter of common sense that the sleeve used in Down, in a towing
27 attachment quite similar to a hitch receiver/tow bar arrangement, could be combined
28 with a barbell-shaped hitch pin lock in order to address the known problem of

1 different aperture sizes in standard hitch receivers and the shelf-space problem
2 experienced by retailers.”); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344
3 (Fed. Cir. 2008) (“The asserted claims simply substitute a resistive electrical switch
4 for the mechanical pressure switch employed by the Gopher Zapper,” which “is a
5 textbook case of when the asserted claims involve a combination of familiar
6 elements according to known methods that does no more than yield predictable
7 results.” (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed.
8 Cir. 2004) (affirming the district court’s finding of “a motivation to combine
9 because the two references address precisely the same problem of underpinning
10 existing structural foundations” even though the record “does not feature an express
11 written teaching in the art to make this combination”); *see also Ecolab, Inc. v. FMC*
12 *Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869
13 F.3d at 1344.

14 In addition, it would have been obvious to try combining the prior art
15 references identified above because there were only a finite number of predictable
16 solutions and/or because known work in one field of endeavor prompted variations
17 based on predictable design incentives and/or market forces either in the same field
18 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
19 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
20 he could place the thickness sensor either above the presence sensor in the feed, so
21 that the paper contacts the thickness sensor before the presence sensor, or below so
22 that the paper contacts it after. Each of these two design choices is an obvious
23 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
24 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
25 skilled artisan may have preferred a delayed-release formulation over the claimed
26 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
27 of a particular combination need not be supported by a finding that the prior art
28 suggests that the combination claimed ... is the preferred, or most desirable,

1 combination.” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004)); *KSR*,
2 550 U.S. at 419-20. Further, the combinations of the prior art references identified
3 above and in the claim charts would have been obvious because the combinations
4 represent known potential options with a reasonable expectation of success. *See*
5 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

6 Additional evidence that there would have been a motivation to combine the
7 prior art references identified above includes the interrelated teachings of multiple
8 prior art references; the effects of demands known to the design community or
9 present in the marketplace; the existence of a known problem for which there was an
10 obvious solution encompassed by the '484 Asserted Claims; the existence of a
11 known need or problem in the field of the endeavor at the time of the alleged
12 inventions; and the background knowledge that would have been possessed by a
13 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
14 incentives and other market forces can prompt variations of it, either in the same
15 field or in another. If a person of ordinary skill in the art can implement a
16 predictable variation, and would see the benefit of doing so, § 103 likely bars its
17 patentability. Moreover, if a technique has been used to improve one device, and a
18 person of ordinary skill in the art would recognize that it would improve similar
19 devices in the same way, using the technique is obvious unless its actual application
20 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
21 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
22 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
23 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
24 2012).

25 The motivation to combine the teachings of the prior art references disclosed
26 herein is also found in the references themselves and in: (1) the nature of the
27 problem being solved; (2) the express, implied and inherent teachings of the prior
28 art; (3) the knowledge of POSITAs; (4) the predictable results obtained in

1 combining the different elements of the prior art; (5) the predictable results obtained
2 in simple substitution of one known element for another; (6) the use of a known
3 technique to improve similar devices, methods, or products in the same way; (7) the
4 predictable results obtained in applying a known technique to a known device,
5 method, or product ready for improvement; (8) the finite number of identified
6 predictable solutions that had a reasonable expectation of success; and (9) known
7 work in various technological fields that could be applied to the same or different
8 technological fields based on design incentives or other market forces. *See above*
9 for legal background regarding obviousness combinations and M.P.E.P. § 2143.

10 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
11 **Claims**

12 Skechers submits the following charts identifying specific locations in each
13 alleged item of prior art where each limitation of each asserted claim is found as
14 attached Exhibits 484-1 through 484-9. The contents of Exhibits 484-1 through 484-
15 9, in combination with the foregoing patents, publications, and products, anticipate
16 and/or render obvious the '484 Asserted Claims under 35 U.S.C. § 102, either
17 expressly or inherently, and under § 103, in each case, as understood by a POSITA.

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '484 Patent)
484-1	Dua '592 – U.S. Publication No. 2005/0193592
484-2	Yamamoto – Japanese Publication No. JP 3118168U
484-3	Glidden – U.S. Patent No. 2,147,197
484-4	Li – Chinese Publication No. CN 2187379Y
484-5	Cusinato – European Patent No. EP 1338690
484-6	Clark – U.S. Patent No. 2,440,393
484-7	Horii – Japanese Publication No. H3-3203; Morimoto – Japanese Publication No. 2001-164444; Zuckerman – U.S. Patent No. 2,047,724
484-8	Doughty – U.S. Patent No. 2,675,631

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '484 Patent)
484-9	Dua '592, Yamamoto, Glidden, Li, Cusinato, Clark, Horii, Morimoto, Zuckerman, and Doughty

D. Invalidity Under 35 U.S.C. § 112

1. Legal Background Regarding The Definiteness, Enablement, And Written Description Requirements

Section 112 includes a definiteness requirement: “[T]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant [or the inventor or a joint inventor] regards as his invention.” Pre-AIA 35 U.S.C. § 112, ¶ 2; AIA 35 U.S.C. § 112(b). “[A] patent is invalid for indefiniteness if its claims, read in light of the patent’s specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

The definiteness requirement requires that the claim must set forth what the applicant regards as the invention, and do so with sufficient particularity and definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002). Where it would be apparent to one of skill in the art, based on the patent specification, that the “invention” set forth in a claim is not what the patent applicant regarded as the invention, the claim is invalid. *Id.*

Section 112 further includes an enablement requirement: “The specification shall contain a written description . . . of the manner and process of making and using [the invention] in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach those skilled in the art how to make and use the full scope of the claimed invention

1 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
2 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
3 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
4 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
5 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
6 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
7 F.3d at 1383-84.

8 Section 112 further includes a written description requirement: “The
9 specification shall contain a written description of the invention[.]” Pre-AIA 35
10 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). “To satisfy the written description
11 requirement, a patent applicant must convey with reasonable clarity to those skilled
12 in the art that, as of the filing date sought, he or she was in possession of the
13 invention.” *ICU Medical Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377
14 (Fed. Cir. 2009) (internal quotation marks and citations omitted); *see also Synthes*
15 *USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (Fed. Cir. 2013). “The test
16 [for written description support] requires an objective inquiry into the four corners
17 of the specification from the perspective of a POSITA. Based on that inquiry, the
18 specification must describe an invention understandable to that skilled artisan and
19 show that the inventor actually invented the invention claimed.” *Ariad Pharms.,*
20 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

21 The specification must describe the claimed invention in sufficient detail so
22 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
23 words in a specification or a claim, even an original claim, does not necessarily
24 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
25 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
26 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
27 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
28 description requirement ... is necessarily met as a matter of law because the claim

1 language appears *in ipso verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
2 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002)).

3 **2. Invalidity Grounds Under 35 U.S.C. § 112**

4 The grounds identified below both individually and collectively render the
5 ’484 Asserted Claims invalid under the statutory requirements of § 112. By
6 identifying certain claim language below, Skechers does not imply that such
7 language is entitled to any patentable weight when comparing the claim as a whole
8 to the prior art. Skechers’ identifications are made based on Skechers’ present
9 understanding of the Asserted Claims and Nike’s apparent interpretation of these
10 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
11 the right to amend these identifications, including in response to claim constructions
12 and claim interpretations that would render claim limitations not enabled, lacking in
13 written description, or indefinite.

14 **a. Lack of Enablement And Written Description**

15 Based on Skechers’ present understanding of the Asserted Claims and Nike’s
16 apparent interpretation of these claims as reflected in its Apparent Infringement
17 Contentions, the ’484 Asserted Claims fail to satisfy the requirements of § 112
18 because the specification and original patent application fail to provide an enabling
19 disclosure of and written description support for at least the following limitations:

- 20 • “a central portion having a domed, three-dimensional structure configured
21 for extending over the top of a foot” (Claims 1, 10, 11)
- 22 • “the domed, three-dimensional structure [is] shaped to extend above the
23 plane of the first side portion and the second side portion when the flat-
24 knitted element is in a flattened configuration” (Claims 1, 11)

25 These claim terms/phrases as apparently construed and/or interpreted by Nike
26 violate the written description and/or enablement requirements of 35 U.S.C. § 112.
27 Each asserted claim of the ’484 Patent is invalid as not containing a written
28 description of the invention, and of the manner and process of making and using it,

1 in such full, clear, concise and exact terms as to enable any person skilled in the art
2 to which it pertains, or with which it is most nearly connected, to make and use the
3 alleged invention. Moreover, based on Skechers' present understanding of Nike's
4 Apparent Infringement Contentions, each of the asserted claims in which these
5 claim terms/phrases appear lack written description because the specification of the
6 '484 Patent demonstrates that the patentee neither conceived of nor demonstrated
7 possession of all that Nike now contends the claims cover. In addition, based on
8 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
9 of the asserted claims in which these claim terms/phrases appear are invalid because
10 the specification fails to provide sufficient disclosure to enable any POSITA to
11 which it pertains, or with which it is most nearly connected, to implement the
12 invention without undue experimentation.

13 **b. Indefiniteness**

14 Based on Skechers' present understanding of the '484 Asserted Claims and
15 Nike's apparent interpretation of these claims as reflected in its Apparent
16 Infringement Contentions, the '484 Asserted Claims fail to satisfy the requirements
17 of § 112 because the precise scope of at least the terms listed below cannot be
18 determined with reasonable certainty by a POSITA when reading the claims in light
19 of the specification and prosecution history.

20 Based on Skechers' present understanding of Nike's Apparent Infringement
21 Contentions, the '484 Asserted Claims are invalid for reciting at least the following
22 claim terms/phrases:

- 23 • "first area" (Claims 7, 12-14)
- 24 • "second area" (Claims 7, 12-14)
- 25 • "first layer" (Claims 1, 2, 4, 10, 11)
- 26 • "second layer" (Claims 2, 4, 10)
- 27 • "domed, three-dimensional structure" (Claims 1, 10, 11)
- 28 • "overlapped loop" (Claim 10)

1 Based on Skechers present understanding of Nike's Apparent Infringement
2 Contentions, at least one or more of these claim terms/phrases are indefinite because
3 they are inconsistent with and broader than the alleged invention disclosed in the
4 specification and given Nike's apparent constructions of the claims, any POSITA at
5 the time of the invention would not understand what is claimed, even when the
6 claims are read in light of the specification. To the extent that Nike ultimately
7 asserts any terms in a manner that makes clear the scope of such terms would not be
8 reasonably certain to a POSITA, Skechers reserves the right to seek a ruling that any
9 such term is indefinite.

10 **VII. '511 PATENT**

11 **A. Prior Art References¹³**

12 Skechers identifies the following prior art presently known to Skechers to
13 anticipate the '511 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
14 (e), and/or (g) or AIA 35 U.S.C. § 102, either expressly or inherently as understood
15 by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in
16 combination. Skechers generally identifies and incorporates by reference herein all
17 prior art and invalidity arguments previously asserted against the '511 Patent,
18 whether during the original prosecution of the '511 Patent, before the Patent Trial
19 and Appeals Board, or during any of the litigations filed by Nike involving the '511
20 Patent, including, for example, the adidas Litigation, the adidas ITC Investigation,
21 or the New Balance Litigation. In addition, discovery is outgoing, and Skechers has
22 served document requests and interrogatories for which responses are outstanding
23 that Skechers expects to reveal additional prior art. Furthermore, Skechers is
24 generally aware of information pertaining to prior art from other proceedings that is
25

26 ¹³ To the extent one or more prior art patents, publications, or products are
27 identified in the claim charts attached hereto but are not included in the tables and
28 lists below, those prior art patents, publications, or products should also be considered
as prior art to the '511 Patent.

1 currently unavailable to Skechers, including because such information may be
2 subject to a protective order. Once Skechers receives relevant information, it will
3 timely supplement its invalidity contentions, as appropriate.

4 **1. Prior Art Patents and Publications¹⁴**

Prior Art	Date of Issue or Publication
US 601,192	3/1898
US 761,520	5/1904
US 1,215,198	2/1917
US 1,597,934	8/1926
US 1,803,554	5/1931
US 1,841,518	1/1932
US 1,888,172	11/1932
US 1,902,780	3/1933
US RE18,804	4/1933
US 1,910,251	5/1933
US 1,956,969	5/1934
US 2,001,293	5/1935
US 2,024,180	12/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,150,730	3/1939
US 2,161,472	6/1939
US 2,178,941	11/1939
US 2,314,098	3/1943
US 2,330,199	9/1943
US 2,343,390	3/1944

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28 ¹⁴ Skechers incorporates by reference all prior art references cited in the
patents and publications listed herein and/or their file histories.

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Prior Art	Date of Issue or Publication
US 2,400,692	5/1946
US 2,440,393	4/1949
US 2,467,237	4/1949
US 2,569,764	10/1951
US 2,586,045	2/1952
US 2,598,217	5/1952
US 2,603,891	7/1952
US 2,608,078	8/1952
US 2,641,004	6/1953
US 2,675,631	4/1954
US 2,714,813	8/1955
US 2,770,055	11/1956
US 2,848,885	8/1953
US 2,966,785	1/1961
US 2,994,372	8/1961
US 3,114,2J 3	12/1963
US 3,298,204	1/1967
US 3,372,415	3/1968
US 3,497,971	3/1970
US 3,583,081	6/1971
US 3,635,051	1/1972
US 3,694,940	10/1972
US 3,703,820	11/1972
US 3,704,474	12/1972
US 3,766,566	10/1973
US 3,769,723	11/1973
US 3,778,856	12/1973
US 3,835,555	9/1974

1	Prior Art	Date of Issue or Publication
2	US 3,851,315	11/1974
3	US 3,863,272	2/1975
4	US 3,882,697	5/1975
5	US 3,937,039	2/1976
6	US 3,952,427	4/1976
7	US 3,972,086	8/1976
8	US 3,985,003	10/1976
9	US 4,027,402	6/1977
10	US 4,031,586	6/1977
11	US 4,038,840	8/1977
12	US 4,057,981	11/1977
13	US 4,150,498	4/1979
14	US 4,151,662	5/1979
15	US 4,172,293	10/1979
16	US 4,183,156	1/1980
17	US 4,211,806	7/1980
18	US 4,219,945	9/1980
19	US 4,232,458	11/1980
20	US 4,255,949	3/1981
21	US 4,258,480	3/1981
22	US 4,317,292	3/1982
23	US 4,354,318	10/1982
24	US 4,373,361	2/1983
25	US 4,430,811	2/1984
26	US 4,438,574	3/1984
27	US 4,447,967	5/1984
28	US 4,465,448	8/1984
	US 4,494,266	1/1985

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Prior Art	Date of Issue or Publication
US 4,527,403	7/1985
US 4,531,525	7/1985
US 4,607,439	8/1986
US 4,624,115	11/1986
US 4,737,396	4/1988
US 4,750,339	6/1988
US 4,756,098	7/1988
US 4,785,558	11/1988
US 4,813,158	3/1989
US 5,031,423	7/1991
US 5,081,854	1/1992
US 5,095,720	3/1992
US 5,099,588	3/1992
US 5,117,567	6/1992
US 5,152,025	10/1992
US 5,192,601	3/1993
US 5,253,434	10/1993
US 5,343,639	9/1994
US 5,345,638	9/1994
US 5,353,523	10/1994
US 5,353,524	10/1994
US 5,371,957	12/1994
US 5,385,036	1/1995
US 5,461,884	10/1995
US 5,511,323	4/1996
US 5,526,584	6/1996
US 5,557,527	9/1996
US 5,566,396	10/1996

1	Prior Art	Date of Issue or Publication
2	US 5,572,860	11/1996
3	US 5,575,090	11/1996
4	US 5,604,997	2/1997
5	US 5,623,840	4/1997
6	US 5,709,107	1/1998
7	US 5,711,168	1/1998
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10	WO 98/20758	5/1998
11	WO 00/32861	6/2000
12	WO 02/31247	4/2002
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14	Circular Machines, International Standard, ISO 8117, Second Edition	2/2003
15	David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (3rd ed., Woodhead Publishing Ltd. 2001)	2001
16	Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth-Verlag GmnH 2002)	2002
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19	Bharat J. Gajjar, Warp Knit Fabrics Technologies	2007
20	J. Watel, The Milanese Machine: Little Progress Made in the Development of the Milanese Fabric	12/1921
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Billy Hunter, Nike Flyknit: Ready, Steady, Go!	7/2012
R. Shishoo, Textiles in sport (Woodhead Publishing Ltd. 2005)	2005
Manuals for Stoll Flat Knitting Machinery	No later than 3/3/2003
Hong et al. The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine. India Journal of Fibre and Textile Research, 1994, 19: 189-194	1994
Susanna E. Lewis et al., A Machine Knitter's Guide to Creating Fabrics	1986
Georga Tay, Fundamentals of Weft Knitted Fabrics	1996
Brandon Richard, Bargain Buys: 20 Sneaker Steals Found in Vintage Eastbay Catalogs, www.complex.com/sneakers/a/brandon-richard/vintage-eastbay-sneaker-prices	9/2015
Caroline Cox, Vintage Shoes (Carlton Books)	2008
1989 Reebok AXT SXT CXT Cross-Training Shoes Vintage Print Ad, www.ebay.com/itm/362604032836	1989
Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State	2000

Prior Art	Date of Issue or Publication
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1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
Desert Boots and Slippers, www.knitlist.com/97gift/desertboots.htm	2001
Stoll Sirix 100 / 200 Manual Part 1 and Part 2	NA

Skechers additionally identifies and relies on patent or publication references that describe or are otherwise related to the prior art products identified below.

2. Prior Art Products

Skechers also contends that the asserted claims of the '511 Patent are invalid based on public knowledge and uses and/or offers for sale or sales of products that are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the United States by other inventors who had not abandoned, suppressed, or concealed

1 them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious
2 under 35 U.S.C. § 103 the asserted claims.

3 The following lists prior art products that invalidate under 35 U.S.C. § 102 or
4 render obvious under 35 U.S.C. § 103 the asserted claims by the name of the item,
5 and Skechers may rely on all versions of the following prior art products
6 commercially sold, offered for sale, publicly known or used before the priority date
7 of the '511 Patent, including things as well as documents describing the same:

Prior Art Product	Date of Public Use
Stoll Flat Knitting Machinery in operation within the United States, at least as early as March 3, 2003	No later than 3/3/2003
Santoni Circular Knitting Machinery in operation within the United States	No later than 3/3/2003
Nike Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Air Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Aquasock, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
adidas engineered warp footwear, publicly known, used, and/or on sale within the United States. Including: white and blue adidas 2000 Olympic Wrestling shoe, Olympic Rowing Shoe, adidas black and white Olympic sprinting shoes, adidas Olympic Boxing shoes, adidas Olympic marathon orange and white shoe, 2003 adistar RD shoe, adidas white and blue shoe 2003 a3 shoe, adidas YY Tenet Flower shoe, and adidas Climacool shoe	No later than 3/3/2003
Pan Am Slipper publicly known, used, and/or on sale within the United States	No later than 3/3/2003

Prior Art Product	Date of Public Use
Capezio Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Karl Mayer Warp Knitting Machinery in operation within the United States	No later than 3/3/2003
Steve Blevins, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Robert Szanto for Simply Knitting Mills, Inc., publicly known, used, and/or on sale within United States	No later than 3/3/2003

Skechers' positions with respect to these references are stated on information and belief, and are supported by the information and documents that will be produced by Skechers, Nike, and/or third parties. Because discovery is not complete, Skechers continues to investigate these products and other relevant products, including those used, sold, and/or offered for sale by Nike, third parties, and Skechers and will supplement these disclosures if and as appropriate.

B. Invalidity Under 35 U.S.C. §§ 102 and 103

Nike asserts claims 1-21 of the '511 Patent. All of those claims are invalid because they fail to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the attached claim charts. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Although Skechers has identified at least one citation per limitation for each reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. Rather, in an effort to focus the issues, Skechers has generally cited representative portions of identified references, even where a reference may contain additional support for a particular claim element. In addition, POSITAs generally read a prior art reference as a whole and in the context of other

1 publications and literature. Thus, to understand and interpret any specific statement
2 or disclosure within a prior art reference, such persons would rely on other
3 information within the reference, along with other publications and their general
4 scientific knowledge. Skechers may rely upon uncited portions of the prior art
5 references and on other publications and expert testimony to provide context, and as
6 aids to understanding and interpreting the portions that are cited. Skechers may also
7 rely on the prior art of record for any permissible purpose, including prior art
8 discussed in the '511 Patent specification itself, including to show that the '511
9 Patent is anticipated or obvious, show the state of the art, show motivation to
10 combine a reference with one or more other references, and to show the proper
11 scope of the claims. Skechers may also rely on uncited portions of the prior art
12 references, other disclosed publications, and the testimony of experts to establish
13 that a POSITA would have been motivated to modify or combine certain of the cited
14 references so as to render the claims obvious.

15 **1. Anticipation**

16 Some or all of the asserted claims of the '511 Patent are invalid as anticipated
17 under 35 U.S.C. § 102 based on each of the prior art references identified above and
18 in the included claim charts, which identify specific examples of where each
19 limitation of the asserted claims is found in the prior art references, either expressly
20 or inherently. As explained above, the cited portions of prior art references
21 identified in the attached claim charts are exemplary only and representative of the
22 content and teaching of the prior art references, and should be understood in the
23 context of the reference as a whole and as they would be understood by a POSITA.

24 **2. Obviousness**

25 To the extent any limitation is deemed not to be exactly met by an item of
26 prior art, any purported differences are such that the claimed subject matter as a
27 whole would have been obvious to a POSITA at the time of the alleged invention,
28 based on the state of the art and knowledge of those skilled in the art. The item of

1 prior art would, therefore, render the relevant claims invalid for obviousness under
2 35 U.S.C. § 103.

3 In addition, the references identified above render one or more asserted
4 claims of the '511 Patent obvious when the references are read in combination with
5 each other by a POSITA. Each and every reference identified is also relevant to the
6 state of the art at the time of the alleged invention. Any of the references disclosed
7 above may be combined to render obvious (and therefore invalid) each of Nike's
8 asserted claims. Skechers may rely upon a subset of the above identified references
9 or all of the references identified above for purposes of obviousness depending on
10 the Court's claim construction, positions taken by Nike during this litigation, and
11 further investigation and discovery. Skechers may rely on combinations with any
12 reference in the attached claim charts and any of the other references disclosed
13 herein with respect to the '511 Patent, including combinations with any of the
14 patents, publications or products identified herein as prior art to the '511 Patent.

15 Moreover, to the extent the foregoing references are found not to anticipate
16 the asserted claims, the foregoing references render the asserted claims obvious
17 either alone or in combination with one or more of the other references identified
18 above. For example, as explained herein and/or in the accompanying charts, it
19 would have been obvious to a POSITA at the time of the alleged invention of the
20 asserted claims of the '511 Patent to modify or combine the various references cited
21 herein so as to practice the asserted claims.

22 Motivations to combine the above items of prior art are present in the
23 references themselves, general knowledge of a POSITA, the prior art as a whole, or
24 the nature of the problems allegedly addressed by the '511 Patent. Combining the
25 references identified in the accompanying claim charts would have been obvious, as
26 the references identify and address the same technical issues and suggest very
27 similar solutions to those issues. Skechers reserves the right to amend or supplement
28 these invalidity contentions to identify additional reasons that combining the

1 references would be obvious to a POSITA.

2 In addition to the specific combinations of prior art and the specific
3 combinations of groups of prior art disclosed, Skechers reserves the right to rely on
4 any other combination of any prior art references disclosed herein. Skechers further
5 reserves the right to rely upon combinations disclosed within the prosecution history
6 of the references cited herein.

7 The obviousness combinations set forth in these contentions reflect Skechers'
8 present understanding of the potential scope of the claims that Nike appears to be
9 advocating and should not be seen as Skechers' acquiescence to Nike's
10 interpretation of the patent claims. Skechers reserves the right to amend or
11 supplement these contentions regarding anticipation or obviousness of the asserted
12 claims based on further information from Nike, the Court, other courts or decision-
13 makers in parallel proceedings, or any other source including any changes Nike
14 makes to its Apparent Infringement Contentions, information discovered during
15 discovery, arguments made and positions taken by Nike, or a claim construction
16 ruling by the Court. Skechers reserves the right to amend or supplement these
17 contentions to assert different support for each asserted limitation, to cite different
18 portions of each reference in support of any invalidity theory, to assert different
19 combinations, or to identify different references, as necessary. Nike has not
20 identified what elements or combinations it alleges were not known to a POSITA.
21 Therefore, for any claim limitation that Nike alleges is not disclosed in a particular
22 prior art reference, Skechers reserves the right to assert that any such limitation is
23 either inherent in the disclosed reference or obvious to a POSITA at the time in light
24 of the same, or that the limitation is disclosed in another of the references disclosed
25 above and, in combination, would have rendered the asserted claim obvious.

26 Each of these combinations was obvious to try for a POSITA. In the field of
27 the '511 Patent, there was a design need or market pressure to solve a problem and
28 there were a finite number of identified, predictable solutions. A POSITA had good

1 reason to pursue the known options within his or her technical grasp including
2 combinations of the disclosures in the accompanying claim charts. Each of these
3 combinations is also the combination of familiar elements according to known
4 methods and yields predictable results. In the field of the '511 Patent, a great deal of
5 prior research and product designs were available and design incentives and other
6 market forces would prompt variations of it. Further reasons to combine the
7 references identified in the accompanying claim charts include the nature of the
8 problem being solved, the express, implied, and inherent teachings of the prior art,
9 and the knowledge of a POSITA that such combinations would have yielded
10 predictable results, and that such combinations would have represented known
11 alternatives to a POSITA. For each combination, there is a teaching, suggestion, and
12 motivation to combine both in the references to be combined themselves, as well as
13 in the art generally that was known to a POSITA. In any event, each limitation of
14 the '511 Patent is, and would have been at the time of the alleged invention, a
15 simple design choice representing a predictable variation within the skill of a
16 POSITA. Moreover, each limitation of the '511 Patent was well known in the art,
17 including well-known to POSITAs.

18 Additional prior art references rendering the asserted claims obvious, alone or
19 in combination with other references, including identification of combinations
20 showing obviousness, are identified in the accompanying claim charts, which
21 include exemplary citations for the '511 Asserted Claims showing specifically
22 where in each reference or combinations of references each asserted claim is found,
23 and an explanation of why the prior art renders the asserted claim obvious.

24 No showing of a specific motivation to combine prior art is required to
25 combine the references disclosed for any asserted patent in this document and in the
26 attached charts, as each combination of art would have yielded expected results and
27 at most would simply represent a known alternative to one of skill in the art. *See*
28 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)

1 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
2 obvious because modifying the Admitted Prior Art/Betts combination to include a
3 second recess was nothing more than the predictable application of known
4 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
5 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
6 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
7 combine test, and instead applying an “expansive and flexible” approach). Indeed,
8 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
9 automaton” and “in many cases a POSITA will be able to fit the teachings of
10 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
11 Nevertheless, in addition to the information contained in the obviousness sections of
12 this document and elsewhere in these contentions, Skechers hereby identify
13 motivations and reasons to combine.

14 One or more combinations of the prior art references identified above would
15 have been obvious because these references would have been combined using:
16 known methods to yield predictable results; known techniques in the same way; a
17 simple substitution of one known, equivalent element for another to obtain
18 predictable results; and/or a teaching, suggestion, or motivation in the prior art
19 generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) (“It
20 is simply a matter of common sense that the sleeve used in Down, in a towing
21 attachment quite similar to a hitch receiver/tow bar arrangement, could be combined
22 with a barbell-shaped hitch pin lock in order to address the known problem of
23 different aperture sizes in standard hitch receivers and the shelf-space problem
24 experienced by retailers.”); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344
25 (Fed. Cir. 2008) (“The asserted claims simply substitute a resistive electrical switch
26 for the mechanical pressure switch employed by the Gopher Zapper,” which “is a
27 textbook case of when the asserted claims involve a combination of familiar
28 elements according to known methods that does no more than yield predictable

1 results.” (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed.
2 Cir. 2004) (affirming the district court’s finding of “a motivation to combine
3 because the two references address precisely the same problem of underpinning
4 existing structural foundations” even though the record “does not feature an express
5 written teaching in the art to make this combination”); *see also Ecolab, Inc. v. FMC*
6 *Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869
7 F.3d at 1344.

8 In addition, it would have been obvious to try combining the prior art
9 references identified above because there were only a finite number of predictable
10 solutions and/or because known work in one field of endeavor prompted variations
11 based on predictable design incentives and/or market forces either in the same field
12 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
13 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
14 he could place the thickness sensor either above the presence sensor in the feed, so
15 that the paper contacts the thickness sensor before the presence sensor, or below so
16 that the paper contacts it after. Each of these two design choices is an obvious
17 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
18 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
19 skilled artisan may have preferred a delayed-release formulation over the claimed
20 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
21 of a particular combination need not be supported by a finding that the prior art
22 suggests that the combination claimed ... is the preferred, or most desirable,
23 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004))); *KSR*,
24 550 U.S. at 419-20. Further, the combinations of the prior art references identified
25 above and in the claim charts would have been obvious because the combinations
26 represent known potential options with a reasonable expectation of success. *See*
27 *Wyers v. Master Lock Co.*, 616 F.3d at 1242

28 Additional evidence that there would have been a motivation to combine the

1 prior art references identified above includes the interrelated teachings of multiple
2 prior art references; the effects of demands known to the design community or
3 present in the marketplace; the existence of a known problem for which there was an
4 obvious solution encompassed by the '511 Asserted Claims; the existence of a
5 known need or problem in the field of the endeavor at the time of the alleged
6 inventions; and the background knowledge that would have been possessed by a
7 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
8 incentives and other market forces can prompt variations of it, either in the same
9 field or in another. If a person of ordinary skill in the art can implement a
10 predictable variation, and would see the benefit of doing so, § 103 likely bars its
11 patentability. Moreover, if a technique has been used to improve one device, and a
12 person of ordinary skill in the art would recognize that it would improve similar
13 devices in the same way, using the technique is obvious unless its actual application
14 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
15 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
16 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
17 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
18 2012).

19 The motivation to combine the teachings of the prior art references disclosed
20 herein is also found in the references themselves and in: (1) the nature of the
21 problem being solved; (2) the express, implied and inherent teachings of the prior
22 art; (3) the knowledge of POSITAs; (4) the predictable results obtained in
23 combining the different elements of the prior art; (5) the predictable results obtained
24 in simple substitution of one known element for another; (6) the use of a known
25 technique to improve similar devices, methods, or products in the same way; (7) the
26 predictable results obtained in applying a known technique to a known device,
27 method, or product ready for improvement; (8) the finite number of identified
28 predictable solutions that had a reasonable expectation of success; and (9) known

work in various technological fields that could be applied to the same or different technological fields based on design incentives or other market forces. *See* above for legal background regarding obviousness combinations and M.P.E.P. § 2143.

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

Skechers submits the following charts identifying specific locations in each alleged item of prior art where each limitation of each asserted claim is found as attached Exhibits 511-1 through 511-9. The contents of Exhibits 511-1 through 511-9, in combination with the foregoing patents, publications, and products, anticipate and/or render obvious the '511 Asserted Claims under 35 U.S.C. § 102, either expressly or inherently, and under § 103, in each case, as understood by a POSITA.

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '511 Patent)
511-1	Glidden - U.S. Patent No. 2,147,197
511-2	Orei - U.S. Patent No. 7,051,460
511-3	Cusinato - European Patent Publication EP 1,338,690
511-4	The Hong Article - "The Development of 3dshaped knitted fabrics for technical purposes on a flat knitting machine"
511-5	Clark - U.S. Patent No. 2,440,393
511-6	Nishida - U.S. Patent No. 5,345,638
511-7	Joha - U.S. Patent No. RE 18,804
511-8	Li - Chinese Patent Application No. CN2187379Y
511-9	Glidden, Orei, Cusinato, The Hong Article, Clark, Nishida, Joha, and Li

D. Invalidity Under 35 U.S.C. § 112

1. Legal Background Regarding The Definiteness, Enablement, And Written Description Requirements

Section 112 includes a definiteness requirement: "[T]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming

1 the subject matter which the applicant regards as his invention.” Pre-AIA 35 U.S.C.
2 § 112, ¶ 2; AIA 35 U.S.C. § 112(b). “[A] patent is invalid for indefiniteness if its
3 claims, read in light of the patent’s specification and prosecution history, fail to
4 inform, with reasonable certainty, those skilled in the art about the scope of the
5 invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

6 The definiteness requirement requires that the claim must set forth what the
7 applicant regards as the invention, and do so with sufficient particularity and
8 definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
9 2002). Where it would be apparent to one of skill in the art, based on the patent
10 specification, that the “invention” set forth in a claim is not what the patent
11 applicant regarded as the invention, the claim is invalid. *Id.*

12 Section 112 further includes an enablement requirement: “The specification
13 shall contain a written description . . . of the manner and process of making and
14 using [the invention] in such full, clear, concise and exact terms as to enable any
15 person skilled in the art to which it pertains, or with which it is most nearly
16 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
17 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
18 those skilled in the art how to make and use the full scope of the claimed invention
19 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
20 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
21 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
22 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
23 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
24 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
25 F.3d at 1383-84.

26 Section 112 further includes a written description requirement: “The
27 specification shall contain a written description of the invention[.]” Pre-AIA 35
28 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). “To satisfy the written description

1 requirement, a patent applicant must convey with reasonable clarity to those skilled
2 in the art that, as of the filing date sought, he or she was in possession of the
3 invention.” *ICU Medical Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377
4 (Fed. Cir. 2009) (internal quotation marks and citations omitted); *see also Synthes*
5 *USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (Fed. Cir. 2013). “The test
6 [for written description support] requires an objective inquiry into the four corners
7 of the specification from the perspective of a POSITA. Based on that inquiry, the
8 specification must describe an invention understandable to that skilled artisan and
9 show that the inventor actually invented the invention claimed.” *Ariad Pharms.,*
10 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

11 The specification must describe the claimed invention in sufficient detail so
12 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
13 words in a specification or a claim, even an original claim, does not necessarily
14 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
15 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
16 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
17 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
18 description requirement ... is necessarily met as a matter of law because the claim
19 language appears *in ipsius verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
20 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

21 2. Invalidity Grounds Under 35 U.S.C. § 112

22 The grounds identified below both individually and collectively render the
23 ’511 Asserted Claims invalid under the statutory requirements of § 112. By
24 identifying certain claim language below, Skechers does not imply that such
25 language is entitled to any patentable weight when comparing the claim as a whole
26 to the prior art. Skechers’ identifications are made based on Skechers’ present
27 understanding of the Asserted Claims and Nike’s apparent interpretation of these
28 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves

1 the right to amend these identifications, including in response to claim constructions
2 and claim interpretations that would render claim limitations not enabled, lacking in
3 written description, or indefinite.

4 **a. Lack of Enablement And Written Description**

5 Based on Skechers' present understanding of the Asserted Claims and Nike's
6 apparent interpretation of these claims as reflected in its Apparent Infringement
7 Contentions, the '511 Asserted Claims fail to satisfy the requirements of § 112
8 because the specification and original patent application fail to provide an enabling
9 disclosure of and written description support for at least the following limitations:

- 10 • "a flat knit textile element comprising [] flat knit edges free of surrounding
11 textile structure such that the flat knit edges are not surrounded by textile
12 structure from which the textile element must be removed" (Claims 1, 15)
- 13 • "a flat knit textile element comprising [] a first knit strip having a first
14 property and a second knit strip having a second property that is different
15 from the first property" (Claims 1, 15)
- 16 • "the first knit strip and the second knit strip are positioned adjacent to each
17 other along one or more of a lateral side and a medial side of the upper"
18 (Claims 1, 15)
- 19 • "one or both of the first knit strip and the second knit strip comprises a
20 plurality of knit strips" (Claims 2
- 21 • "the first and second knit strips alternate with one another along one or
22 more of the lateral side and the medial side of the upper" (Claim 3)
- 23 • "the flat knit textile element comprises at least two first knit strips and at
24 least two second knit strips" (Claim 4)
- 25 • "the first knit strip and the second knit strip extend along the lateral side of
26 the upper from an instep region of the upper to an area proximate to a
27 lower region of the upper" (Claim 5)
- 28 • "the first knit strip and the second knit strip extend along the medial side

1 of the upper from an instep region of the upper to an area proximate to a
2 lower region of the upper” (Claim 6)

- 3 • “the first property comprises a first knit construction and the second
4 property comprises a second knit construction” (Claim 7)
- 5 • “the first property of the first knit strip comprises a smooth texture, and the
6 second property of the second knit strip comprises a rough texture” (Claim
7 8)
- 8 • “the first property of the first knit strip comprises a higher degree of
9 stretch than the second property of the second knit strip” (Claim 10)
- 10 • “the second property of the second knit strip comprises a higher degree of
11 stretch than the first property of the first knit strip” (Claim 11)
- 12 • “the first property comprises a first yarn type and the second property
13 comprises a second yarn type” (Claim 12)
- 14 • “the first yarn type of the first knit strip comprises at least one of a higher
15 biodegradability, moisture absorption, insulation, durability, and/or
16 hydrophobicity than the second yarn type of the second knit strip” (Claim
17 13)
- 18 • “the first yarn type of the first knit strip comprises at least one of a higher
19 strength, support, stiffness, recovery, fit and/or form than the second yarn
20 type of the second knit strip” (Claim 14)
- 21 • “the first property comprises one or more of a first knit construction and a
22 first yarn type and wherein the second property comprises one or more of a
23 first knit construction and a second yarn type” (Claim 16)
- 24 • “the flat knit textile element comprises a plurality of first knit strips
25 extending along the lateral side and the medial side of the upper and a
26 plurality of second knit strips extending along the lateral side and the
27 medial side of the upper” (Claim 17)
- 28 • “the first knit strip is parallel to the second knit strip” (Claim 18)

- 1 • “the first knit strip and the second knit strip extend along the lateral side of
- 2 the upper from an instep region of the upper to an area proximate to the
- 3 sole structure” (Claim 19)
- 4 • “the first knit strip and the second knit strip extend along the medial side
- 5 of the upper from an instep region of the upper to an area proximate to the
- 6 sole structure” (Claim 20)

7 These claim terms/phrases as apparently construed and/or interpreted by Nike
8 violate the written description and/or enablement requirements of 35 U.S.C. § 112.
9 Each asserted claim of the '511 Patent is invalid as not containing a written
10 description of the invention, and of the manner and process of making and using it,
11 in such full, clear, concise and exact terms as to enable any person skilled in the art
12 to which it pertains, or with which it is most nearly connected, to make and use the
13 alleged invention. Moreover, based on Skechers' present understanding of Nike's
14 Apparent Infringement Contentions, each of the asserted claims in which these
15 claim terms/phrases appear lack written description because the specification of the
16 '511 Patent demonstrates that the patentee neither conceived of nor demonstrated
17 possession of all that Nike now contends the claims cover. In addition, based on
18 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
19 of the asserted claims in which these claim terms/phrases appear are invalid because
20 the specification fails to provide sufficient disclosure to enable any POSITA to
21 which it pertains, or with which it is most nearly connected, to implement the
22 invention without undue experimentation.

23 **b. Indefiniteness**

24 Based on Skechers' present understanding of the '511 Asserted Claims and
25 Nike's apparent interpretation of these claims as reflected in its Apparent
26 Infringement Contentions, the '511 Asserted Claims fail to satisfy the requirements
27 of § 112 because the precise scope of at least the terms listed below cannot be
28 determined with reasonable certainty by a POSITA when reading the claims in light

1 of the specification and prosecution history.

2 Based on Skechers' present understanding of Nike's Apparent Infringement
3 Contentions, the '562 Asserted Claims are invalid for reciting at least the following
4 claim terms/phrases:

- 5 • "knit strip" (Claims 1-20)

6 Based on Skechers present understanding of Nike's Apparent Infringement
7 Contentions, at least one or more of these claim terms/phrases are indefinite because
8 they are inconsistent with and broader than the alleged invention disclosed in the
9 specification and given Nike's apparent constructions of the claims, any POSITA at
10 the time of the invention would not understand what is claimed, even when the
11 claims are read in light of the specification. To the extent that Nike ultimately
12 asserts any terms in a manner that makes clear the scope of such terms would not be
13 reasonably certain to a POSITA, Skechers reserves the right to seek a ruling that any
14 such term is indefinite.

15 **VIII. '781 PATENT**

16 **A. Prior Art References¹⁵**

17 Skechers identifies the following prior art presently known to Skechers to
18 anticipate the '781 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
19 (e), and/or (g) or AIA 35 U.S.C. § 102, either expressly or inherently as understood
20 by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in
21 combination. Skechers generally identifies and incorporates by reference herein all
22 prior art and invalidity arguments previously asserted against the '781 Patent,
23 whether during the original prosecution of the '781 Patent, before the Patent Trial
24 and Appeals Board, or during any of the litigations filed by Nike involving the '781

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27 ¹⁵ To the extent one or more prior art patents, publications, or products are
28 identified in the claim charts attached hereto but are not included in the tables and
lists below, those prior art patents, publications, or products should also be considered
as prior art to the '781 Patent.

1 Patent. In addition, discovery is outgoing, and Skechers has served document
2 requests and interrogatories for which responses are outstanding that Skechers
3 expects to reveal additional prior art. Furthermore, Skechers is generally aware of
4 information pertaining to prior art from other proceedings that is currently
5 unavailable to Skechers, including because such information may be subject to a
6 protective order. Once Skechers receives relevant information, it will timely
7 supplement its invalidity contentions, as appropriate.

8 **1. Prior Art Patents and Publications¹⁶**

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US 601,192	3/1898
US 761,520	5/1904
US 1,215,198	2/1917
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US 2,147,197	2/1939
US 2,150,730	3/1939
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28 ¹⁶ Skechers incorporates by reference all prior art references cited in the patents and publications listed herein and/or their file histories.

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1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
Stoll Sirix 100 / 200 Manual Part 1 and Part 2	NA

Skechers additionally identifies and relies on patent or publication references that describe or are otherwise related to the prior art products identified below.

2. Prior Art Products

Skechers also contends that the asserted claims of the '781 Patent are invalid based on public knowledge and uses and/or offers for sale or sales of products that are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the United States by other inventors who had not abandoned, suppressed, or concealed them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious

1 under 35 U.S.C. § 103 the asserted claims.

2 The following lists prior art products that invalidate under 35 U.S.C. § 102 or
3 render obvious under 35 U.S.C. § 103 the asserted claims by the name of the item,
4 and Skechers may rely on all versions of the following prior art products
5 commercially sold, offered for sale, publicly known or used before the priority date
6 of the '781 Patent, including things as well as documents describing the same:

Prior Art Product	Date of Public Use
Stoll Flat Knitting Machinery in operation within the United States	No later than 3/3/2003
Santoni Circular Knitting Machinery in operation within the United States	No later than 3/3/2003
Nike Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Air Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Aquasock, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
adidas engineered warp footwear, publicly known, used, and/or on sale within the United States. Including: white and blue adidas 2000 Olympic Wrestling shoe, Olympic Rowing Shoe, adidas black and white Olympic sprinting shoes, adidas Olympic Boxing shoes, adidas Olympic marathon orange and white shoe, 2003 adistar RD shoe, adidas white and blue shoe 2003 a3 shoe, adidas YY Tenet Flower shoe, and adidas Climacool shoe	No later than 3/3/2003
Pan Am Slipper publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Capezio Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003

Prior Art Product	Date of Public Use
Karl Mayer Warp Knitting Machinery in operation within the United States	No later than 3/3/2003
Steve Blevins, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Robert Szanto for Simply Knitting Mills, Inc., publicly known, used, and/or on sale within United States	No later than 3/3/2003

Skechers' positions with respect to these references are stated on information and belief, and are supported by the information and documents that will be produced by Skechers, Nike, and/or third parties. Because discovery is not complete, Skechers continues to investigate these products and other relevant products, including those used, sold, and/or offered for sale by Nike, third parties, and Skechers and will supplement these disclosures if and as appropriate.

B. Invalidity Under 35 U.S.C. §§ 102 and 103

Nike asserts claims 1-20 of the '781 Patent. All of those claims are invalid because they fail to meet one or more of the requirements for patentability. The individual bases for invalidity are provided below and in the attached claim charts. Each of the foregoing listed prior art documents, the underlying work, and/or the underlying apparatus or method qualifies as prior art under one or more sections of 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

Although Skechers has identified at least one citation per limitation for each reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. Rather, in an effort to focus the issues, Skechers has generally cited representative portions of identified references, even where a reference may contain additional support for a particular claim element. In addition, POSITAs generally read a prior art reference as a whole and in the context of other publications and literature. Thus, to understand and interpret any specific statement

1 or disclosure within a prior art reference, such persons would rely on other
2 information within the reference, along with other publications and their general
3 scientific knowledge. Skechers may rely upon uncited portions of the prior art
4 references and on other publications and expert testimony to provide context, and as
5 aids to understanding and interpreting the portions that are cited. Skechers may also
6 rely on the prior art of record for any permissible purpose, including prior art
7 discussed in the '562 Patent specification itself, including to show that the '781
8 Patent is anticipated or obvious, show the state of the art, show motivation to
9 combine a reference with one or more other references, and to show the proper
10 scope of the claims. Skechers may also rely on uncited portions of the prior art
11 references, other disclosed publications, and the testimony of experts to establish
12 that a POSITA would have been motivated to modify or combine certain of the cited
13 references so as to render the claims obvious.

14 **1. Anticipation**

15 Some or all of the asserted claims of the '781 Patent are invalid as anticipated
16 under 35 U.S.C. § 102 based on each of the prior art references identified above and
17 in the included claim charts, which identify specific examples of where each
18 limitation of the asserted claims is found in the prior art references, either expressly
19 or inherently. As explained above, the cited portions of prior art references
20 identified in the attached claim charts are exemplary only and representative of the
21 content and teaching of the prior art references, and should be understood in the
22 context of the reference as a whole and as they would be understood by a POSITA.

23 **2. Obviousness**

24 To the extent any limitation is deemed not to be exactly met by an item of
25 prior art, any purported differences are such that the claimed subject matter as a
26 whole would have been obvious to a POSITA at the time of the alleged invention,
27 based on the state of the art and knowledge of those skilled in the art. The item of
28 prior art would, therefore, render the relevant claims invalid for obviousness under

1 35 U.S.C. § 103.

2 In addition, the references identified above render one or more asserted
3 claims of the '781 Patent obvious when the references are read in combination with
4 each other by a POSITA. Each and every reference identified is also relevant to the
5 state of the art at the time of the alleged invention. Any of the references disclosed
6 above may be combined to render obvious (and therefore invalid) each of Nike's
7 asserted claims. Skechers may rely upon a subset of the above identified references
8 or all of the references identified above for purposes of obviousness depending on
9 the Court's claim construction, positions taken by Nike during this litigation, and
10 further investigation and discovery. Skechers may rely on combinations with any
11 reference in the attached claim charts and any of the other references disclosed
12 herein with respect to the '781 Patent, including combinations with any of the
13 patents, publications or products identified herein as prior art to the '781 Patent.

14 Moreover, to the extent the foregoing references are found not to anticipate
15 the asserted claims, the foregoing references render the asserted claims obvious
16 either alone or in combination with one or more of the other references identified
17 above. For example, as explained herein and/or in the accompanying charts, it
18 would have been obvious to a POSITA at the time of the alleged invention of the
19 asserted claims of the '781 Patent to modify or combine the various references cited
20 herein so as to practice the asserted claims.

21 Motivations to combine the above items of prior art are present in the
22 references themselves, general knowledge of a POSITA, the prior art as a whole, or
23 the nature of the problems allegedly addressed by the '781 Patent. Combining the
24 references identified in the accompanying claim charts would have been obvious, as
25 the references identify and address the same technical issues and suggest very
26 similar solutions to those issues. Skechers reserves the right to amend or supplement
27 these invalidity contentions to identify additional reasons that combining the
28 references would be obvious to a POSITA.

1 In addition to the specific combinations of prior art and the specific
2 combinations of groups of prior art disclosed, Skechers reserves the right to rely on
3 any other combination of any prior art references disclosed herein. Skechers further
4 reserves the right to rely upon combinations disclosed within the prosecution history
5 of the references cited herein.

6 The obviousness combinations set forth in these contentions reflect Skechers'
7 present understanding of the potential scope of the claims that Nike appears to be
8 advocating and should not be seen as Skechers' acquiescence to Nike's
9 interpretation of the patent claims. Skechers reserves the right to amend or
10 supplement these contentions regarding anticipation or obviousness of the asserted
11 claims based on further information from Nike, the Court, other courts or decision-
12 makers in parallel proceedings, or any other source including any changes Nike
13 makes to its Apparent Infringement Contentions, information discovered during
14 discovery, arguments made and positions taken by Nike, or a claim construction
15 ruling by the Court. Skechers reserves the right to amend or supplement these
16 contentions to assert different support for each asserted limitation, to cite different
17 portions of each reference in support of any invalidity theory, to assert different
18 combinations, or to identify different references, as necessary. Nike has not
19 identified what elements or combinations it alleges were not known to a POSITA.
20 Therefore, for any claim limitation that Nike alleges is not disclosed in a particular
21 prior art reference, Skechers reserves the right to assert that any such limitation is
22 either inherent in the disclosed reference or obvious to a POSITA at the time in light
23 of the same, or that the limitation is disclosed in another of the references disclosed
24 above and, in combination, would have rendered the asserted claim obvious.

25 Each of these combinations was obvious to try for a POSITA. In the field of
26 the '781 Patent, there was a design need or market pressure to solve a problem and
27 there were a finite number of identified, predictable solutions. A POSITA had good
28 reason to pursue the known options within his or her technical grasp including

1 combinations of the disclosures in the accompanying claim charts. Each of these
2 combinations is also the combination of familiar elements according to known
3 methods and yields predictable results. In the field of the '781 Patent, a great deal of
4 prior research and product designs were available and design incentives and other
5 market forces would prompt variations of it. Further reasons to combine the
6 references identified in the accompanying claim charts include the nature of the
7 problem being solved, the express, implied, and inherent teachings of the prior art,
8 and the knowledge of a POSITA that such combinations would have yielded
9 predictable results, and that such combinations would have represented known
10 alternatives to a POSITA. For each combination, there is a teaching, suggestion, and
11 motivation to combine both in the references to be combined themselves, as well as
12 in the art generally that was known to a POSITA. In any event, each limitation of
13 the '781 Patent is, and would have been at the time of the alleged invention, a
14 simple design choice representing a predictable variation within the skill of a
15 POSITA. Moreover, each limitation of the '781 Patent was well known in the art,
16 including well-known to POSITAs.

17 Additional prior art references rendering the asserted claims obvious, alone or
18 in combination with other references, including identification of combinations
19 showing obviousness, are identified in the accompanying claim charts, which
20 include exemplary citations for the '781 Asserted Claims showing specifically
21 where in each reference or combinations of references each asserted claim is found,
22 and an explanation of why the prior art renders the asserted claim obvious.

23 No showing of a specific motivation to combine prior art is required to
24 combine the references disclosed for any asserted patent in this document and in the
25 attached charts, as each combination of art would have yielded expected results and
26 at most would simply represent a known alternative to one of skill in the art. *See*
27 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
28 (“[W]e affirm the Board’s conclusion that the challenged claims would have been

1 obvious because modifying the Admitted Prior Art/Betts combination to include a
2 second recess was nothing more than the predictable application of known
3 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
4 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
5 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
6 combine test, and instead applying an “expansive and flexible” approach). Indeed,
7 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
8 automaton” and “in many cases a POSITA will be able to fit the teachings of
9 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
10 Nevertheless, in addition to the information contained in the obviousness sections of
11 this document and elsewhere in these contentions, Skechers hereby identify
12 motivations and reasons to combine.

13 One or more combinations of the prior art references identified above would
14 have been obvious because these references would have been combined using:
15 known methods to yield predictable results; known techniques in the same way; a
16 simple substitution of one known, equivalent element for another to obtain
17 predictable results; and/or a teaching, suggestion, or motivation in the prior art
18 generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) (“It
19 is simply a matter of common sense that the sleeve used in Down, in a towing
20 attachment quite similar to a hitch receiver/tow bar arrangement, could be combined
21 with a barbell-shaped hitch pin lock in order to address the known problem of
22 different aperture sizes in standard hitch receivers and the shelf-space problem
23 experienced by retailers.”); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344
24 (Fed. Cir. 2008) (“The asserted claims simply substitute a resistive electrical switch
25 for the mechanical pressure switch employed by the Gopher Zapper,” which “is a
26 textbook case of when the asserted claims involve a combination of familiar
27 elements according to known methods that does no more than yield predictable
28 results.” (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed.

1 Cir. 2004) (affirming the district court’s finding of “a motivation to combine
2 because the two references address precisely the same problem of underpinning
3 existing structural foundations” even though the record “does not feature an express
4 written teaching in the art to make this combination”); *see also Ecolab, Inc. v. FMC*
5 *Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869
6 F.3d at 1344.

7 In addition, it would have been obvious to try combining the prior art
8 references identified above because there were only a finite number of predictable
9 solutions and/or because known work in one field of endeavor prompted variations
10 based on predictable design incentives and/or market forces either in the same field
11 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
12 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
13 he could place the thickness sensor either above the presence sensor in the feed, so
14 that the paper contacts the thickness sensor before the presence sensor, or below so
15 that the paper contacts it after. Each of these two design choices is an obvious
16 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
17 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
18 skilled artisan may have preferred a delayed-release formulation over the claimed
19 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
20 of a particular combination need not be supported by a finding that the prior art
21 suggests that the combination claimed ... is the preferred, or most desirable,
22 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004)); *KSR*,
23 550 U.S. at 419-20. Further, the combinations of the prior art references identified
24 above and in the claim charts would have been obvious because the combinations
25 represent known potential options with a reasonable expectation of success. *See*
26 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

27 Additional evidence that there would have been a motivation to combine the
28 prior art references identified above includes the interrelated teachings of multiple

1 prior art references; the effects of demands known to the design community or
2 present in the marketplace; the existence of a known problem for which there was an
3 obvious solution encompassed by the '781 Asserted Claims; the existence of a
4 known need or problem in the field of the endeavor at the time of the alleged
5 inventions; and the background knowledge that would have been possessed by a
6 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
7 incentives and other market forces can prompt variations of it, either in the same
8 field or in another. If a person of ordinary skill in the art can implement a
9 predictable variation, and would see the benefit of doing so, § 103 likely bars its
10 patentability. Moreover, if a technique has been used to improve one device, and a
11 person of ordinary skill in the art would recognize that it would improve similar
12 devices in the same way, using the technique is obvious unless its actual application
13 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
14 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
15 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
16 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
17 2012).

18 The motivation to combine the teachings of the prior art references disclosed
19 herein is also found in the references themselves and in: (1) the nature of the
20 problem being solved; (2) the express, implied and inherent teachings of the prior
21 art; (3) the knowledge of POSITAs; (4) the predictable results obtained in
22 combining the different elements of the prior art; (5) the predictable results obtained
23 in simple substitution of one known element for another; (6) the use of a known
24 technique to improve similar devices, methods, or products in the same way; (7) the
25 predictable results obtained in applying a known technique to a known device,
26 method, or product ready for improvement; (8) the finite number of identified
27 predictable solutions that had a reasonable expectation of success; and (9) known
28 work in various technological fields that could be applied to the same or different

1 technological fields based on design incentives or other market forces. *See* above
2 for legal background regarding obviousness combinations and M.P.E.P. § 2143.

3 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
4 **Claims**

5 Skechers submits the following charts identifying specific locations in each
6 alleged item of prior art where each limitation of each asserted claim is found as
7 attached Exhibits 781-1 through 781-9. The contents of Exhibits 781-1 through 781-
8 9, in combination with the foregoing patents, publications, and products, anticipate
9 and/or render obvious the '781 Asserted Claims under 35 U.S.C. § 102, either
10 expressly or inherently, and under § 103, in each case, as understood by a POSITA.

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '781 Patent)
781-1	Glidden - U.S. Patent No. 2,147,197
781-2	Hong - Korean Patent Application No. KR 20-1983-0000987
781-3	Cusinato - European Patent Publication EP 1,338,690
781-4	The Hong Article - "The Development of 3dshaped knitted fabrics for technical purposes on a flat knitting machine"
781-5	Clark - U.S. Patent No. 2,440,393
781-6	Nishida - U.S. Patent No. 5,345,638
781-7	Joha - U.S. Patent No. RE 18,804
781-8	Li - Chinese Patent Application No. CN2187379Y
781-9	Glidden, Hong, Cusinato, The Hong Article, Clark, Nishida, Joha, and Li

23
24 **D. Invalidity Under 35 U.S.C. § 112**

25 **1. Legal Background Regarding The Definiteness, Enablement,**
26 **And Written Description Requirements**

27 Section 112 includes a definiteness requirement: "[T]he specification shall
28 conclude with one or more claims particularly pointing out and distinctly claiming

1 the subject matter which the applicant [or the inventor or a joint inventor] regards as
2 his invention.” Pre-AIA 35 U.S.C. § 112, ¶ 2; AIA 35 U.S.C. § 112(b). “[A] patent
3 is invalid for indefiniteness if its claims, read in light of the patent’s specification
4 and prosecution history, fail to inform, with reasonable certainty, those skilled in the
5 art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134
6 S. Ct. 2120, 2124 (2014).

7 The definiteness requirement requires that the claim must set forth what the
8 applicant regards as the invention, and do so with sufficient particularity and
9 definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
10 2002). Where it would be apparent to one of skill in the art, based on the patent
11 specification, that the “invention” set forth in a claim is not what the patent
12 applicant regarded as the invention, the claim is invalid. *Id.*

13 Section 112 further includes an enablement requirement: “The specification
14 shall contain a written description . . . of the manner and process of making and
15 using [the invention] in such full, clear, concise and exact terms as to enable any
16 person skilled in the art to which it pertains, or with which it is most nearly
17 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
18 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
19 those skilled in the art how to make and use the full scope of the claimed invention
20 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
21 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
22 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
23 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
24 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
25 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
26 F.3d at 1383-84.

27 Section 112 further includes a written description requirement: “The
28 specification shall contain a written description of the invention[.]” Pre-AIA 35

1 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). “To satisfy the written description
2 requirement, a patent applicant must convey with reasonable clarity to those skilled
3 in the art that, as of the filing date sought, he or she was in possession of the
4 invention.” *ICU Medical Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377
5 (*Fed. Cir. 2009*) (*internal quotation marks and citations omitted*); *see also Synthes*
6 *USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (*Fed. Cir. 2013*). “The test
7 [for written description support] requires an objective inquiry into the four corners
8 of the specification from the perspective of a POSITA. Based on that inquiry, the
9 specification must describe an invention understandable to that skilled artisan and
10 show that the inventor actually invented the invention claimed.” *Ariad Pharms.,*
11 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (*Fed. Cir. 2010*) (*en banc*).

12 The specification must describe the claimed invention in sufficient detail so
13 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
14 words in a specification or a claim, even an original claim, does not necessarily
15 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
16 923 (*Fed. Cir. 2004*) (*internal quotation marks and citations omitted*); *see also Nuvo*
17 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
18 1380 (*Fed. Cir. 2019*) (“We have expressly rejected the ‘argument that the written
19 description requirement ... is necessarily met as a matter of law because the claim
20 language appears *in ipsius verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
21 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (*Fed. Cir. 2002*))).

22 2. Invalidity Grounds Under 35 U.S.C. § 112

23 The grounds identified below both individually and collectively render the
24 ’781 Asserted Claims invalid under the statutory requirements of § 112. By
25 identifying certain claim language below, Skechers does not imply that such
26 language is entitled to any patentable weight when comparing the claim as a whole
27 to the prior art. Skechers’ identifications are made based on Skechers’ present
28 understanding of the Asserted Claims and Nike’s apparent interpretation of these

1 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
2 the right to amend these identifications, including in response to claim constructions
3 and claim interpretations that would render claim limitations not enabled, lacking in
4 written description, or indefinite.

5 **a. Lack of Enablement And Written Description**

6 Based on Skechers' present understanding of the Asserted Claims and Nike's
7 apparent interpretation of these claims as reflected in its Apparent Infringement
8 Contentions, the '781 Asserted Claims fail to satisfy the requirements of § 112
9 because the specification and original patent application fail to provide an enabling
10 disclosure of and written description support for at least the following limitations:

- 11 • "a flat knit textile element having [] flat knit edges free of surrounding
12 textile structure such that the flat knit edges are not surrounded by textile
13 structure from which the textile element must be removed" (Claims 1, 12)
- 14 • "the one or more ribs extending longitudinally comprises ribs spaced apart
15 from an area adjacent an instep region of the upper to an area adjacent a
16 lower region of the upper" (Claim 4)
- 17 • "the ribs are spaced apart at a uniform distance from the area adjacent the
18 instep region to the area adjacent the lower region" (Claim 6)
- 19 • "the one or more ribs are adjacent one or more regions having a smooth
20 texture" (Claim 7)
- 21 • "the one or more ribs comprise a plurality of ribs, at least one rib
22 terminating in the heel region and at least one rib terminating in the
23 midfoot region" (Claim 8)
- 24 • "the one or more ribs extending along the lateral side mirror the one or
25 more ribs extending longitudinally along the medial side" (Claim 10)
- 26 • "the one or more ribs comprise ribs of varying lengths" (Claim 11)
- 27 • "the one or more ribs on the lateral side and the one or more ribs on the
28 medial side extend from the forefoot region toward the heel region and

1 terminate in one of the midfoot region or the heel region” (Claim 12)

- 2 • “the one or more ribs on the lateral side and the one or more ribs on the
- 3 medial side each comprise ribs spaced apart from an area adjacent an
- 4 instep region of the upper to an area adjacent a lower region of the upper”
- 5 (Claim 15)
- 6 • “the ribs are spaced apart at a uniform distance” (Claim 16)
- 7 • “the one or more ribs on the lateral side and the one or more ribs on the
- 8 medial side are adjacent one or more regions having a smooth texture”
- 9 (Claim 17)
- 10 • “at least the one or more ribs on the lateral side comprise a plurality of
- 11 ribs, at least one rib terminating in the heel region and at least one rib
- 12 terminating in the midfoot region” (Claim 18)
- 13 • “the one or more ribs on the lateral side and the one or more ribs on the
- 14 medial side comprise ribs of varying lengths” (Claim 19)

15 These claim terms/phrases as apparently construed and/or interpreted by Nike

16 violate the written description and/or enablement requirements of 35 U.S.C. § 112.

17 Each asserted claim of the ’781 Patent is invalid as not containing a written

18 description of the invention, and of the manner and process of making and using it,

19 in such full, clear, concise and exact terms as to enable any person skilled in the art

20 to which it pertains, or with which it is most nearly connected, to make and use the

21 alleged invention. Moreover, based on Skechers’ present understanding of Nike’s

22 Apparent Infringement Contentions, each of the asserted claims in which these

23 claim terms/phrases appear lack written description because the specification of the

24 ’562 Patent demonstrates that the patentee neither conceived of nor demonstrated

25 possession of all that Nike now contends the claims cover. In addition, based on

26 Skechers’ present understanding of Nike’s Apparent Infringement Contentions, each

27 of the asserted claims in which these claim terms/phrases appear are invalid because

28 the specification fails to provide sufficient disclosure to enable any POSITA to

1 which it pertains, or with which it is most nearly connected, to implement the
2 invention without undue experimentation.

3 **b. Indefiniteness**

4 Based on Skechers' present understanding of the '781 Asserted Claims and
5 Nike's apparent interpretation of these claims as reflected in its Apparent
6 Infringement Contentions, the '781 Asserted Claims fail to satisfy the requirements
7 of § 112 because the precise scope of at least the terms listed below cannot be
8 determined with reasonable certainty by a POSITA when reading the claims in light
9 of the specification and prosecution history.

10 Based on Skechers' present understanding of Nike's Apparent Infringement
11 Contentions, the '781 Asserted Claims are invalid for reciting at least the following
12 claim terms/phrases:

- 13 • "a plurality of ribs" (Claims 1, 12)
- 14 • "one or more ribs" (Claims 2-4, 7-11, 13-15, 17-19)
- 15 • "midfoot region" (Claims 1, 8, 12, 18)

16 Based on Skechers present understanding of Nike's Apparent Infringement
17 Contentions, at least one or more of these claim terms/phrases are indefinite because
18 they are inconsistent with and broader than the alleged invention disclosed in the
19 specification and given Nike's apparent constructions of the claims, any POSITA at
20 the time of the invention would not understand what is claimed, even when the
21 claims are read in light of the specification. To the extent that Nike ultimately
22 asserts any terms in a manner that makes clear the scope of such terms would not be
23 reasonably certain to a POSITA, Skechers reserves the right to seek a ruling that any
24 such term is indefinite.

25 **IX. DOCUMENT PRODUCTION ACCOMPANYING PRELIMINARY**
26 **INVALIDITY CONTENTIONS**

27 Skechers is producing documents , including prior art in its possession
28 referenced above, as well as well specifications and schematics sufficient to show

elements of the accused products, including the following:

BegBates	EndBates
SKECHERS-9346-00000001	SKECHERS-9346-00041426
SKECHERS-9346-00041427	SKECHERS-9346-00043438
SKECHERS-9346-00043439	SKECHERS-9346-00051606
SKECHERS-9346-00054529	SKECHERS-9346-00054603
SKECHERS-9346-00055781	SKECHERS-9346-00055788
SKECHERS-9346-00055790	SKECHERS-9346-00059128
SKECHERS-9346-00059129	SKECHERS-9346-00059141
SKECHERS-9346-00059142	SKECHERS-9346-00059397
SKECHERS-9346-00059398	SKECHERS-9346-00059430
SKECHERS-9346-00059431	SKECHERS-9346-00059454

Skechers reserves the right to produce and rely on additional documents, for example, based on, additional information revealed or produced during discovery regarding Nike's allegations and/or amendments to Nike's Apparent Infringement Contentions as well as the IPR petitions filed by Skechers and/or third parties.

X. OTHER RESERVATIONS AND EXPLANATIONS

These Preliminary Invalidity Contentions and accompanying document productions are preliminary and subject to further revision as follows. Nothing in these contentions constitutes an admission concerning the priority date, conception date, or date of reduction to practice of the Asserted Claims. Skechers reserves the right to modify or supplement these Preliminary Invalidity Contentions, including in response to any positions taken or information disclosed regarding the priority date, conception date, or date of reduction to practice of the Asserted Claims. Skechers also reserves the right to modify or supplement these Preliminary Invalidity Contentions in response to any positions taken, information disclosed, or decisions made in any IPR proceedings.

For prior art patents and prior art publications identified in these Preliminary Invalidity Contentions, Skechers reserves the right to rely on the public use, offer for sale, sale, and/or actual products embodying the features described therein

1 uncovered during discovery. Skechers also reserves the right to rely on any related
2 patents and patent applications, foreign patent counterparts and foreign patent
3 applications of U.S. patents identified in these Preliminary Invalidity Contentions,
4 and U.S. counterparts of foreign patents and foreign patent applications identified in
5 these Preliminary Invalidity Contentions.

6 By including prior art that anticipates or renders obvious claims based on
7 Nike's apparent claim interpretations, Skechers is not agreeing that Nike's claim
8 interpretations are correct.

9 The accompanying invalidity claim charts provide examples of prior art that
10 discloses, either expressly or inherently, every limitation of certain claims and/or
11 teachings, suggestions and motivations through which a POSITA at the time of the
12 alleged invention would have considered the limitations obvious based on the state
13 of the art at the time, the differences between the claimed invention and the state of
14 the art, and the foreseeability from a technical perspective and/or marketing and/or
15 natural and expected evolution of the art. Where Skechers cites to a particular
16 figure in a reference, the citation should be understood to encompass the caption and
17 description of the figure and any text relating to the figure. Conversely, where
18 Skechers cite to particular text referring to a figure, the citation should be
19 understood to include the figure as well. As discovery and the IPR proceedings
20 progress and the scope and focus of the liability or invalidity issues become clearer,
21 Skechers may rely on uncited portions of the prior art.

22 Skechers reserves the right to revise their ultimate contentions concerning the
23 invalidity of asserted the Asserted Claims, which may change depending on
24 discovery taken in the case, the Court's or PTAB's construction of the Asserted
25 Claims, any findings as to the priority date of the Asserted Claims, and/or positions
26 that Nike or expert witness(es) may take concerning claim construction,
27 infringement, and/or invalidity issues in this case or in any IPR proceedings.

28 Skechers may rely on Nike's or any inventor's admissions concerning the

1 scope of prior art relevant to the Asserted Patents; the patent prosecution histories
2 for the Asserted Patents (including any history arising from any IPR proceedings);
3 any deposition testimony of the named inventors on the Asserted Patents; and the
4 papers filed and any evidence submitted by Nike in connection with this litigation or
5 any IPR proceedings. For example, Skechers reserves the right to assert that the
6 Asserted Claims are invalid under 35 U.S.C. § 101 or pre-AIA 35 U.S.C. § 102(f)
7 and/or in the event that Skechers obtains evidence that the named inventors did not
8 invent (either alone or in conjunction with others) the subject matter claimed in the
9 Asserted Patents. Should Skechers obtain such evidence, they will provide the
10 name(s) of the person(s) from whom and the circumstances under which the claimed
11 invention or any part of it was derived. Similarly, Skechers reserves the right to
12 right to assert that the Asserted Claims are invalid under pre-AIA 35 U.S.C.
13 § 102(d) or § 102(e) in the event that Skechers obtains evidence establishing that
14 one or more of the claimed inventions in the Asserted Claims was patented, caused
15 to patented, or subject to an inventor certificate meeting the provisions of § 102(d)
16 or was described in a patent or patent application meeting the provisions of § 102(e).

17 Prior art not included in this disclosure, whether known or not known to
18 Skechers, may become relevant. In particular, Skechers is currently unaware of the
19 extent, if any, to which Nike will contend that limitations of the Asserted Patents are
20 not disclosed in the prior art identified by Skechers. To the extent such an issue
21 arises, Skechers reserves the right to identify other references that would render
22 obvious the allegedly missing limitation(s) of the disclosed device or method.
23 Further, because discovery has only recently begun and because Skechers has not
24 yet completed its search for or analysis of relevant prior art, Skechers reserves the
25 right to revise, amend, and/or supplement the information provided herein, including
26 identifying, charting, and relying on additional references, should Skechers' further
27 search and analysis yield additional information or references, consistent with the
28 Federal Rules of Civil Procedure.

1 Additionally, because third-party discovery has not yet begun, Skechers
2 reserves the right to present additional items of prior art under 35 U.S.C. § 102
3 and/or § 103, located during the course of such discovery or further investigation,
4 and to assert invalidity under pre-AIA 35 U.S.C. §§ 102(c), (d), or (f), to the extent
5 that such discovery or investigation yields information forming the basis for such
6 invalidity. For example, Skechers may issue subpoenas to, and receive information
7 from, third parties believed to have knowledge, documentation, and/or corroborating
8 evidence concerning some of the prior art listed below and/or additional prior art.
9 These third parties include, without limitation, the authors, inventors, vendors, or
10 assignees of the references listed in these disclosures.

11 Skechers further reserves the right to modify or add additional contentions in
12 the event that Nike provides amended infringement contentions and to the extent the
13 Court orders or allows Nike to amend its infringement contentions.

14 Skechers incorporates in these Preliminary Invalidity Contentions, in full, all
15 prior art references cited in the Asserted Patents and their prosecution histories and
16 any applicable post-grant proceedings, including the *inter partes* reviews to be filed
17 by Skechers with respect to the all of the Asserted Patents .

18 Skechers further incorporates in these Preliminary Invalidity Contentions, in
19 full, the invalidity contentions, accompanying charts, cited prior art, and supporting
20 declarations and testimony asserted by adidas, lululemon, Puma, and New Balance
21 in the following actions: the adidas Litigation, the adidas ITC Investigation, the
22 Puma Litigation, the lululemon Litigation (including, *e.g.*, NIKE-SKX_0656342-
23 _0657108), and the New Balance Litigation. Skechers also incorporates, in full, the
24 petitions, prior art identified in the petitions, accompanying charts, and supporting
25 declarations and testimony from the *inter partes* reviews filed by adidas and
26 lululemon with respect to the '749 and '484 Patents (*e.g.*, IPR2016-00922,
27 IPR2023-01460, and IPR2024-00460), as well as the *inter partes* reviews to be filed
28 by Skechers and New Balance with respect to all of the Asserted Patents.

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Respectfully submitted,

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Attorneys for Defendant
And Counterclaim-Plaintiff
Skechers U.S.A., Inc.

1 **PROOF OF SERVICE**

2 I am employed in the County of Los Angeles, State of California. I am over the
3 age of 18 and not a party to the within action. My business address is 1800 Avenue
4 of the Stars, Suite 900, Los Angeles, California 90067.

5 On April 19, 2024, I served the foregoing document described as SKECHERS
6 U.S.A., INC.'S PRELIMINARY INVALIDITY CONTENTIONS on each
7 interested party, as follows:

8 xNike-v-Skechers-FW xNike-v-Skechers-FW@arnoldporter.com



10 (BY ELECTRONIC MAIL) I caused the foregoing document to be
11 served electronically by electronically mailing a true and correct copy
12 through Irell & Manella LLP's electronic mail system to the e-mail
13 address(es), as set forth above, and the transmission was reported as
14 complete and no error was reported.

15 Executed on April 19, 2024, at Los Angeles, California.

16 I declare under penalty of perjury under the laws of the United States of
17 America that the foregoing is true and correct.

18 Jim I. Manzano
19 (JManzano@irell.com)
20 (Type or print name)

21 /s/ Jim Manzano
22 (Signature)