

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKECHERS U.S.A., INC.,

Petitioner,

v.

NIKE, INC.,

Patent Owner.

Case IPR2025-00141

Patent No. 8,266,749

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S PRE-INSTITUTION
REPLY ON § 325(d) ISSUES**

The Board authorized Skechers to submit a “limited” reply on one issue: the application of the recent *Ecto World* decision to “the Section 325(d) issue” presented by Skechers’ Petition. Ex. 2009. In *Ecto World*, the Director held that “a petitioner must explain how the examiner erred” when “the asserted prior art is on an IDS, but the Examiner did not apply the reference.” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (P.T.A.B. May 19, 2025). Skechers’ Reply should have thus been limited to explaining how the Examiner allegedly erred with respect to prior art listed on an IDS, but not applied by the Examiner.

Disregarding the Board’s instruction, Skechers attempts to use this Reply to rewrite portions of the Petition wholly unaffected by the holding of *Ecto World*. For example, Skechers uses half its Reply to address alleged Examiner error with respect to Nishida—a reference featured in multiple rejections during prosecution of the ’749 Patent. This abuse of the Board’s authorization should be rejected.

But even if considered, Skechers’ Reply only underscores that denial of institution is warranted under § 325(d). Skechers does not dispute that the same or substantially the same art was before the Examiner during prosecution of the ’749 Patent. And Skechers presents no evidence of material Examiner error. Instead, Skechers mounts the type of arguments the Board has repeatedly held insufficient to demonstrate error. For at least these reasons, the Board should deny institution.

I. There Is No Dispute That The Same Or Substantially The Same Art Was Before The Examiner (*Advanced Bionics* Step One)

There is no dispute that each of the four references in Skechers' Petition—Nishida, McDonald, Orei, and Guenther—are the same or substantially the same as the references before the Examiner during the prosecution of the '749 Patent. Skechers admits that Nike successfully overcame multiple Examiner rejections based on Nishida. Paper 1 ("Petition") at 19–20. And Skechers does not dispute that McDonald is substantially the same as Nishida. POPR at 32–33. In its Reply, Skechers also now admits that Orei and Guenther¹ were before the examiner—despite expressly claiming the opposite in its Petition. *Compare* Petition at 109 (arguing that Orei and Guenther were "not before the Examiner") *with* Paper 16 ("Reply") at 1 and 1 n.1.

Skechers' only argument is that its *own translation* of Guenther differs from the machine translation that Nike submitted to the Patent Office. Reply at 1–3. But Skechers fails to cite *any authority* for the proposition that different translations of the same reference constitute different art under § 325(d). Nike was only required to include in its IDS (i) the identity of "each foreign patent," (ii) the "country or patent office which issued the patent," (iii) an "appropriate document number," (iv) "the

¹ Skechers drastically overstates the importance of Guenther, a secondary reference used for one single element in its obviousness Ground 2B. Petition at 105-107 (relying on Guenther for only element 1[a1]).

publication date,” and (v) “a legible copy” of “each foreign patent.” 37 C.F.R. § 1.98. Nike did just that. Ex. 1013 at 57 (identifying information required under 37 C.F.R. § 1.98). And Nike went further, including a translation of Guenther obtained from the European Patent Office. 37 C.F.R. § 1.98(a)(3)(ii); Ex. 1013 at 200–202.

But even if Guenther wasn’t previously before the Examiner, Skechers’ argument would still fail because Guenther is cumulative of Orei and Nishida. Skechers relies on the teachings of Orei and Nishdia to challenge the claim element 1[a1] in Grounds 1A and 2A. Petition at 34–38, 77–84 (citing Orei and Nishida for element 1[a1], “simultaneously knitting a textile element with a surrounding textile structure”). And like Orei and Nishida, Skechers relies on the teachings of Guenther in Ground 2B “[t]o the extent that Nishida’s web of material 1 is not understood to be a base for the web of material 1 ... as described under Element 1[a1].” Petition at 106. Thus, Guenther is substantially the same as Orei and Nishida. And thus Skechers’ Petition does not present *any* “substantially different arguments,” despite Skechers’ claim to the contrary. *See* Reply at 3.

II. Skechers Does Not Present Any Evidence of Examiner Error

Skechers mounts four arguments of alleged Examiner error. But none withstand scrutiny.

First, Skechers asserts that the Examiner erred by issuing only “one single §102 rejection based solely on Nishida.” Reply at 3–5. But that’s not true. The Examiner relied on Nishida in two separate office actions. POPR at 6–7, 32. More importantly, a petitioner cannot show material error simply by arguing that the Examiner failed to issue an adequate number of rejections. *See Universal Imaging v. Lexmark Int’l, Inc.*, IPR2019-01387, 2020 WL 959375, *5 (the absence of a rejection based upon the petitioned grounds “is not the end of [the Board’s] analysis”) (P.T.A.B. Feb. 27, 2020); *Google LLC v. Kewazinga Corp.*, IPR2021-00527, 2021 WL 3746361, *8 (P.T.A.B. Aug. 24, 2021). And a petitioner cannot show material error by arguing that the Examiner failed to reject the claims based on a particular combination of prior art references. *Sony Interactive v. Terminal Realty, Inc.*, IPR2020-00711, 2020 WL 6065188, *5 (P.T.A.B. Oct. 13, 2020).

Second, Skechers argues that the Examiner erred by allowing the ’749 Patent claims in view of Nishida’s teachings and knowledge in the art. Reply at 4–5. But a petitioner cannot demonstrate material error merely by offering a “different interpretation” of the prior art. *Regeneron Pharms., Inc. v. Kymab Ltd.*, IPR2020-00389, 2020 WL 2738613, *7 (P.T.A.B. May 26, 2020).

Third, Skechers argues that the Examiner erred by not issuing a rejection in view of Orei’s teachings. Reply at 4–5. As noted above, a petitioner cannot show material error by arguing that the Examiner failed to issue an adequate number of

rejections. *See Universal Imaging*, 2020 WL 959375 *5; *Google*, 2021 WL 3746361, *8. Nor can the petitioner show material error simply by arguing that the Examiner failed to reject the claims based on a particular combination of prior art references. *Sony*, 2020 WL 6065188, *5. And in this case, the teachings of Orei and Nishida are so similar that Skechers cannot plausibly argue that the Examiner overlooked Orei's teachings. *See* POPR at 16–21, 21–28.

Fourth, Skechers appears to argue that the expert testimony in Skechers' petition is new material not previously considered by the Examiner. Reply at 2, 3, 5. But Skechers never once explains how this expert testimony demonstrates a material error by the Examiner. Nor does Skechers explain how the expert testimony would have altered the Examiner's patentability analysis. Because Skechers "does not explain how this testimony serves to show, if at all, that the Examiner erred," this testimony does demonstrate material error. *Google*, 2021 WL 3746361 at *8; *Medtronic CoreValve LLC v. Speyside Medical, LLC*, IPR2021-00241, 2021 WL 3137302, *13 (P.T.A.B. Jul. 23, 2021).

Skechers has not presented any evidence of Examiner error. For these reasons and those set forth in Nike's POPR, the Board should deny institution.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies service on the Petitioner, pursuant to 37 C.F.R. § 42.6(e) and by agreement of counsel, by electronic (e-mail) delivery of a true copy of the foregoing **PATENT OWNER'S SUR-REPLY TO PETITIONER'S PRE-INSTITUTION REPLY ON § 325(d) ISSUES**, which was served on May 29, 2025 to the following Counsel for Petitioner via e-mail:

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