8454305

THE UNITED STATES OF AMERICA

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UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

January 30, 2024

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APPLICATION NUMBER: ***15/610,089***
FILING DATE: ***May 31, 2017***
PATENT NUMBER: ***9986781***
ISSUE DATE: ***June 05, 2018***

Certified by

Performing the Functions and Duties of the
Under Secretary of Commerce
for Intellectual Property
and Director of the United States
Patent and Trademark Office

Doc Code: PA..
Document Description: Power of Attorney

PTO/AIA/82A (07-13)
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TRANSMITTAL FOR POWER OF ATTORNEY TO ONE OR MORE REGISTERED PRACTITIONERS

NOTE: This form is to be submitted with the Power of Attorney by Applicant form (PTO/AIA/82B) to identify the application to which the Power of Attorney is directed, in accordance with 37 CFR 1.5, unless the application number and filing date are identified in the Power of Attorney by Applicant form. If neither form PTO/AIA/82A nor form PTO/AIA82B identifies the application to which the Power of Attorney is directed, the Power of Attorney will not be recognized in the application.

Application Number	
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Title	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
Art Unit	Unassigned
Examiner Name	Unassigned
Attorney Docket Number	NIKE.276100/081313US82CON

SIGNATURE of Applicant or Patent Practitioner

Signature	/ELIZABETH A. LUCAS/	Date (Optional)	2017-05-31
Name	Elizabeth A. Lucas	Registration Number	74,247
Title (if Applicant is a juristic entity)			
Applicant Name (if Applicant is a juristic entity)			

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. If more than one applicant, use multiple forms.

☑ *Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.131, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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POWER OF ATTORNEY BY APPLICANT

I hereby revoke all previous powers of attorney given in the application identified in either the attached transmittal letter or the boxes below.

Application Number	Filing Date

(Note: The boxes above may be left blank if information is provided on form PTO/AIA/82A.)

☑ I hereby appoint the Patent Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above: 78342

OR

☐ I hereby appoint Practitioner(s) named in the attached list (form PTO/AIA/82C) as my/our attorney(s) or agent(s), and to transact all business in the United States Patent and Trademark Office connected therewith for the patent application referenced in the attached transmittal letter (form PTO/AIA/82A) or identified above. (Note: Complete form PTO/AIA/82C.)

Please recognize or change the correspondence address for the application identified in the attached transmittal letter or the boxes above to:

☑ The address associated with the above-mentioned Customer Number

OR

☐ The address associated with Customer Number:

OR

Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

I am the Applicant (if the Applicant is a juristic entity, list the Applicant name in the box):

☐ Inventor or Joint Inventor (title not required below)

☐ Legal Representative of a Deceased or Legally Incapacitated Inventor (title not required below)

☑ Assignee or Person to Whom the Inventor is Under an Obligation to Assign (provide signer's title if applicant is a juristic entity)

☐ Person Who Otherwise Shows Sufficient Proprietary Interest (e.g., a petition under 37 CFR 1.46(b)(2) was granted in the application or is concurrently being filed with this document) (provide signer's title if applicant is a juristic entity)

SIGNATURE of Applicant for Patent

The undersigned (whose title is supplied below) is authorized to act on behalf of the applicant (e.g., where the applicant is a juristic entity).

Signature	/John F. Coburn/	Date (Optional)	
Name	John F. Coburn III		
Title	VP & Corporate Secretary - Nike, Inc.		

NOTE: Signature - This form must be signed by the applicant in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. If more than one applicant, use multiple forms.

☐ Total of forms are submitted.

This collection of information is required by 37 CFR 1.131, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Doc Code: FAI.REQ
Document Description: Request First Action Interview

PTO/SB/413C (05-11)
Approved for use through 01/31/2013. OMB 0651-0031
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REQUEST FOR FIRST ACTION INTERVIEW (FULL PILOT PROGRAM)

Attorney Docket Number: NIKE.276100	Application Number (if known):	Filing date: 2017-05-31
First Named Inventor: BHUPESH DUA	Title: Article of Footwear Having A Textile Upper	

APPLICANT HEREBY REQUESTS A FIRST ACTION INTERVIEW IN THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.

1. The application must contain three (3) or fewer independent claims and twenty (20) or fewer total claims.

2. The application must not contain any multiple dependent claims.

3. By filing this request:

   Applicant is agreeing to make an election without traverse if the Office determines that the claims are not obviously directed to a single invention; and

   Applicant is agreeing not to request for a refund of the search fee and any excess claims fee paid in the application after the mailing or notification of the pre-interview communication prepared by the examiner.

4. Other attachments: _____

Signature /ELIZABETH A. LUCAS/	Date 2017-05-31
Name (Print/Typed) Elizabeth A. Lucas	Registration Number 74,247

Note: *This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.*

■ *Total of 1 forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/413C (05-11)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Instruction Sheet for Request for First Action Interview (Full Pilot Program)

(Not to be Submitted to the USPTO)

A grantable request must meet the following conditions:

1. The application must be a new non-reissue utility application filed under 35 U.S.C. 111(a) or an international application that has entered the national stage in compliance with 35 U.S.C. 371(c).

2. The application must contain three (3) or fewer independent claims and twenty (20) or fewer total claims. The application may not contain any multiple dependent claims.

3. The request must be filed electronically using the Office's electronic filing system, EFS-Web.

4. The claims must be directed to a single invention. If the Office determines that the claims are directed to multiple inventions (*e.g.*, in a restriction requirement), the applicant must make an election without traverse.

5. The request must be filed at least one day before a first Office action on the merits of the application appears in the Patent Application Information Retrieval (PAIR) system (*i.e.*, at least one day prior to the date when a first Office action on the merits, notice of allowability or allowance, or action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935) appears in the PAIR system). Applicant may check the status of the application using the PAIR system.

6. The request for a first action interview must include a statement that applicant agrees not to file a request for a refund of the search fee and any excess claims fees paid in the application after the mailing or notification of the Pre-Interview Communication. Any petition for express abandonment under 37 CFR 1.138(d), and request for a refund of the search fee and any excess claims fees, filed after the mailing or notification of the Pre-Interview Communication will not be granted.

For more information, see notice "Full First Action Interview Pilot Program" available on the USPTO web site at http://www.uspto.gov/patents/init_events/faipp_full.jsp

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Skechers EX1013-p. 6
Skechers v Nike

Doc Code: TRACK1.REQ
Document Description: TrackOne Request

PTO/AIA/424 (04-14)

CERTIFICATION AND REQUEST FOR PRIORITIZED EXAMINATION UNDER 37 CFR 1.102(e) (Page 1 of 1)

First Named Inventor:	BHUPESH DUA	Nonprovisional Application Number (if known):	
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER		

APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS PRIORITIZED EXAMINATION FOR THE ABOVE-IDENTIFIED APPLICATION.

1. The processing fee set forth in 37 CFR 1.17(i)(1) and the prioritized examination fee set forth in 37 CFR 1.17(c) have been filed with the request. The publication fee requirement is met because that fee, set forth in 37 CFR 1.18(d), is currently $0. The basic filing fee, search fee, and examination fee are filed with the request or have been already been paid. I understand that any required excess claims fees or application size fee must be paid for the application.

2. I understand that the application may not contain, or be amended to contain, more than four independent claims, more than thirty total claims, or any multiple dependent claims, and that any request for an extension of time will cause an outstanding Track I request to be dismissed.

3. The applicable box is checked below:

I. ☑ Original Application (Track One) - Prioritized Examination under § 1.102(e)(1)

i. (a) The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a). This certification and request is being filed with the utility application via EFS-Web.

---OR---

(b) The application is an original nonprovisional plant application filed under 35 U.S.C. 111(a). This certification and request is being filed with the plant application in paper.

ii. An executed inventor's oath or declaration under 37 CFR 1.63 or 37 CFR 1.64 for each inventor, **or** the application data sheet meeting the conditions specified in 37 CFR 1.53(f)(3)(i) is filed with the application.

II. ☐ Request for Continued Examination - Prioritized Examination under § 1.102(e)(2)

i. A request for continued examination has been filed with, or prior to, this form.
ii. If the application is a utility application, this certification and request is being filed via EFS-Web.
iii. The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a), or is a national stage entry under 35 U.S.C. 371.
iv. This certification and request is being filed prior to the mailing of a first Office action responsive to the request for continued examination.
v. No prior request for continued examination has been granted prioritized examination status under 37 CFR 1.102(e)(2).

Signature /ELIZABETH A. LUCAS/	Date 2017-05-31
Name (Print/Typed) Elizabeth A. Lucas	Practitioner Registration Number 74,247

Note: *This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.**

☑ *Total of 1 forms are submitted.

Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/AIA/01 (06-12)
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DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

Title of Invention	An Article of Footwear Having a Textile Upper

As the below named inventor, I hereby declare that:

This declaration is directed to:

☐ The attached application, or

☒ United States application or PCT international application number 14/079,748 filed on November 14, 2013.

The above-identified application was made or authorized to be made by me.

I believe that I am the original inventor or an original joint inventor of a claimed invention in the application.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

LEGAL NAME OF INVENTOR

Inventor: Bhupesh Dua Date (Optional): April 1, 2014

Signature: Bhupesh Dua

Note: An application data sheet (PTO/AIA/14 or equivalent), including naming the entire inventive entity, must accompany this form. Use an additional PTO/SB/AIA01 form for each additional inventor.

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 minute to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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Title of Invention	An Article of Footwear Having a Textile Upper

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☐ The attached application, or

☒ United States application or PCT international application number 14/079,748 filed on November 14, 2013.

The above-identified application was made or authorized to be made by me.

I believe that I am the original inventor or an original joint inventor of a claimed invention in the application.

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LEGAL NAME OF INVENTOR

Inventor: Edward N. Thomas Date (Optional): 04/17/2014

Signature: Edward N. Thomas

Note: An application data sheet (PTO/AIA/14 or equivalent), including naming the entire inventive entity, must accompany this form. Use an additional PTO/SB/AIA01 form for each additional inventor.

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If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Electronic Patent Application Fee Transmittal

Application Number:	
Filing Date:	
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Filer:	Elizabeth Ashley Lucas/Cheryl Neeley
Attorney Docket Number:	NIKE.276100/081313US82CON

Filed as Large Entity

Filing Fees for Track I Prioritized Examination - Nonprovisional Application under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
UTILITY APPLICATION FILING	1011	1	280	280
UTILITY SEARCH FEE	1111	1	600	600
UTILITY EXAMINATION FEE	1311	1	720	720
REQUEST FOR PRIORITIZED EXAMINATION	1817	1	4000	4000
Pages:				
Claims:				
Miscellaneous-Filing:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
PUBL. FEE- EARLY, VOLUNTARY, OR NORMAL	1504	1	0	0
PROCESSING FEE, EXCEPT PROV. APPLS.	1830	1	140	140

Petition:	
Patent-Appeals-and-Interference:	
Post-Allowance-and-Post-Issuance:	
Extension-of-Time:	
Miscellaneous:	
Total in USD ($)	**5740**

Electronic Acknowledgement Receipt

EFS ID:	29355091
Application Number:	15610089
International Application Number:	
Confirmation Number:	4757
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Customer Number:	78342
Filer:	Elizabeth Ashley Lucas/Cheryl Neeley
Filer Authorized By:	Elizabeth Ashley Lucas
Attorney Docket Number:	NIKE.276100/081313US82CON
Receipt Date:	31-MAY-2017
Filing Date:	
Time Stamp:	17:17:40
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	$5740
RAM confirmation Number	060117INTEFSW00005118192112
Deposit Account	192112
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ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

CROSS-REFERENCE TO RELATED APPLICATIONS

[0001] This application having attorney docket number NIKE.276100/081313US82CON and entitled "Article of Footwear Having A Textile Upper" a is a continuation of and claims priority to U.S. Patent Application No. 14/503,514, filed October 1, 2014, which is a division of and claims priority to U.S. Patent Application No. 14/079,748, filed November 14, 2013, which is a continuation of and claims priority to U.S. Patent Application No. 13/413,233, filed March 6, 2012, which is a continuation application of and claims priority to U.S. Patent Application No. 13/236,742, filed Sep. 20, 2011, now U.S. Pat. No. 8,266,749, issued Sept. 18, 2012, which is a continuation application of and claims priority to U.S. Patent Application No. 12/879,517, filed Sep. 10, 2010, now U.S. Pat. No. 8,042,288, issued Oct. 25, 2011, which is a continuation application of and claims priority to U.S. Patent Application No. 12/032,995, filed Feb. 18, 2008, now U.S. Pat. No. 7,814,598, issued Oct. 19, 2010, which is a divisional application of and claims priority to U.S. Patent Application No. 10/791,289, filed Mar. 3, 2004, now U.S. Pat. No. 7,347,011, issued Mar. 25, 2008, each of which applications are being entirely incorporated herein by reference.

BACKGROUND

[0002] The present invention relates to footwear. The invention concerns, more particularly, an article of footwear incorporating an upper that is at least partially formed from a textile material.

DESCRIPTION OF BACKGROUND ART

[0003] Conventional articles of athletic footwear include two primary elements, an upper and a sole structure. The upper provides a covering for the foot that securely receives and positions the foot with respect to the sole structure. In addition, the upper may have a configuration that protects the foot and provides ventilation, thereby cooling the foot and removing perspiration. The sole structure is secured to a lower surface of the upper and is generally positioned between the foot and the ground. In addition to attenuating ground reaction forces and absorbing energy (i.e., imparting cushioning), the sole structure may provide traction and control potentially harmful foot motion, such as over pronation. Accordingly, the upper and the sole structure operate cooperatively to provide a comfortable structure that is suited for a wide variety of ambulatory activities, such as walking and running. The general features and configuration of the conventional upper are discussed in greater detail below.

[0004] The upper forms a void on the interior of the footwear for receiving the foot. The void has the general shape of the foot, and access to the void is provided by an ankle opening. Accordingly, the upper extends over the instep and toe areas of the foot, along the medial and lateral sides of the foot, and around the heel area of the foot. A lacing system is often incorporated into the upper to selectively increase the size of the ankle opening and permit the wearer to modify certain dimensions of the upper, particularly girth, to accommodate feet with varying proportions. In addition, the upper may include a tongue that extends under the lacing system to enhance the comfort of the footwear, and the upper may include a heel counter to limit movement of the heel.

[0005] Various materials may be utilized in manufacturing the upper. The upper of an article of athletic footwear, for example, may be formed from multiple material layers that

include an exterior layer, an intermediate layer, and an interior layer. The materials forming the exterior layer of the upper may be selected based upon the properties of wear-resistance, flexibility, and air permeability, for example. With regard to the exterior layer, the toe area and the heel area may be formed of leather, synthetic leather, or a rubber material to impart a relatively high degree of wear-resistance. Leather, synthetic leather, and rubber materials may not exhibit the desired degree of flexibility and air permeability. Accordingly, various other areas of the exterior layer of the upper may be formed from a synthetic or natural textile. The exterior layer of the upper may be formed, therefore, from numerous material elements that each impart different properties to specific portions of the upper.

[0006] An intermediate layer of the upper may be formed from a lightweight polymer foam material that provides cushioning and protects the foot from objects that may contact the upper. Similarly, an interior layer of the upper may be formed of a moisture-wicking textile that removes perspiration from the area immediately surrounding the foot. In some articles of athletic footwear, the various layers may be joined with an adhesive, and stitching may be utilized to join elements within a single layer or to reinforce specific areas of the upper.

[0007] Although the materials selected for the upper vary significantly, textile materials often form at least a portion of the exterior layer and interior layer. A textile may be defined as any manufacture from fibers, filaments, or yarns characterized by flexibility, fineness, and a high ratio of length to thickness. Textiles generally fall into two categories. The first category includes textiles produced directly from webs of filaments or fibers by randomly interlocking to construct non-woven fabrics and felts. The second category includes textiles formed through a mechanical manipulation of yarn, thereby producing a woven fabric, for example.

[0008] Yarn is the raw material utilized to form textiles in the second category. In general, yarn is defined as an assembly having a substantial length and relatively small cross-section that is formed of at least one filament or a plurality of fibers. Fibers have a relatively short length and require spinning or twisting processes to produce a yarn of suitable length for use in textiles. Common examples of fibers are cotton and wool. Filaments, however, have an indefinite length and may merely be combined with other filaments to produce a yarn suitable for use in textiles. Modern filaments include a plurality of synthetic materials such as rayon, nylon, polyester, and polyacrylic, with silk being the primary, naturally-occurring exception. Yarn may be formed of a single filament, which is conventionally referred to as a monofilament yarn, or a plurality of individual filaments grouped together. Yarn may also include separate filaments formed of different materials, or the yarn may include filaments that are each formed of two or more different materials. Similar concepts also apply to yarns formed from fibers. Accordingly, yarns may have a variety of configurations that generally conform to the definition provided above.

[0009] The various techniques for mechanically manipulating yarn into a textile include interweaving, intertwining and twisting, and interlooping. Interweaving is the intersection of two yarns that cross and interweave at right angles to each other. The yarns utilized in interweaving are conventionally referred to as warp and weft. Intertwining and twisting encompasses procedures such as braiding and knotting where yarns intertwine with each other to form a textile. Interlooping involves the formation of a plurality of columns of intermeshed loops, with knitting being the most common method of interlooping.

[0010] The textiles utilized in footwear uppers generally provide a lightweight, air-permeable structure that is flexible and comfortably receives the foot. In order to impart other

properties to the footwear, including durability and stretch-resistance, additional materials are commonly combined with the textile, including leather, synthetic leather, or rubber, for example. With regard to durability, U.S. Pat. No. 4,447,967 to Zaino discloses an upper formed of a textile material that has a polymer material injected into specific zones to reinforce the zones against abrasion or other forms of wear. Regarding stretch resistance, U.S. Pat. No. 4,813,158 to Brown and U.S. Pat. No. 4,756,098 to Boggia both disclose a substantially inextensible material that is secured to the upper, thereby limiting the degree of stretch in specific portions of the upper.

[0011] From the perspective of manufacturing, utilizing multiple materials to impart different properties to an article of footwear may be an inefficient practice. For example, the various materials utilized in a conventional upper are not generally obtained from a single supplier. Accordingly, a manufacturing facility must coordinate the receipt of specific quantities of materials with multiple suppliers that may have distinct business practices or may be located in different regions or countries. The various materials may also require additional machinery or different assembly line techniques to cut or otherwise prepare the material for incorporation into the footwear. In addition, incorporating separate materials into an upper may involve a plurality of distinct manufacturing steps requiring multiple individuals. Employing multiple materials, in addition to textiles, may also detract from the breathability of footwear. Leather, synthetic leather, or rubber, for example, are not generally permeable to air. Accordingly, positioning leather, synthetic leather, or rubber on the exterior of the upper may inhibit air flow through the upper, thereby increasing the amount of perspiration, water vapor, and heat trapped within the upper and around the foot.

[0012] The present invention is an upper for an article of footwear, the upper incorporating a textile element formed with a knitting machine, for example. In one aspect of the

invention, the textile element has edges that are joined together to define at least a portion of a void for receiving a foot. In another aspect of the invention, the textile element has a first area and a second area of unitary construction. The first area is formed of a first stitch configuration, and the second area is formed of a second stitch configuration that is different from the first stitch configuration to impart varying textures to a surface of the textile element. The knitting machine may have a configuration that forms the textile element through either warp knitting or weft knitting.

[0013] Another aspect of the invention involves a method of manufacturing an article of footwear. The method includes a step of mechanically manipulating a yarn with a circular knitting machine, for example, to form a cylindrical textile structure. In addition, the method involves removing at least one textile element from the textile structure, and incorporating the textile element into an upper of the article of footwear.

[0014] In another aspect of the invention, an article of footwear has an upper and a sole structure secured to the upper. The upper incorporates a textile element formed with a knitting machine. The textile element is removed from a textile structure that includes an outline of the textile element, and the textile element has edges that are joined together to define at least a portion of a void for receiving a foot.

[0015] The advantages and features of novelty characterizing the present invention are pointed out with particularity in the appended claims. To gain an improved understanding of the advantages and features of novelty, however, reference may be made to the following descriptive matter and accompanying drawings that describe and illustrate various embodiments and concepts related to the invention.

BRIEF DESCRIPTION OF THE DRAWINGS

[0016] The foregoing Summary of the Invention, as well as the following Detailed Description of the Invention, will be better understood when read in conjunction with the accompanying drawings.

[0017] FIG. 1 is a lateral elevational view of an article of footwear having an upper in accordance with the present invention.

[0018] FIG. 2 is a lateral elevation view of the upper.

[0019] FIG. 3 is a top plan view of the upper.

[0020] FIG. 4 is a rear elevational view of the upper.

[0021] FIG. 5 is a bottom plan view of the upper.

[0022] FIG. 6 is a first cross-sectional view of the upper, as defined by section line 6-6 in FIG. 2.

[0023] FIG. 7 is a second cross-sectional view of the upper, as defined by section line 7-7 in FIG. 2.

[0024] FIG. 8 is a plan view of a textile element that forms at least a portion of the upper.

[0025] FIG. 9 is a perspective view of a textile structure that incorporates two of the textile element.

[0026] FIG. 10 is a plan view of another textile element.

[0027] FIG. 11 is a plan view of yet another textile element.

[0028] FIG. 12 is a lateral elevational view of another article of footwear having an upper in accordance with the present invention.

[0029] FIG. 13 is a lateral elevational view of yet another article of footwear having an upper in accordance with the present invention.

[0030] FIG. 14 is a cross-sectional view of the footwear depicted in FIG. 13, as defined by section line 14-14.

DETAILED DESCRIPTION

[0031] The following discussion and accompanying figures disclose an article of footwear 10 and a method of manufacturing footwear 10, or components thereof, in accordance with the present invention. Footwear 10 is depicted in the figures and discussed below as having a configuration that is suitable for athletic activities, particularly running. The concepts disclosed with respect to footwear 10 may, however, be applied to footwear styles that are specifically designed for a variety of other athletic activities, including basketball, baseball, football, soccer, walking, and hiking, for example, and may also be applied to various non-athletic footwear styles. Accordingly, one skilled in the relevant art will recognize that the concepts disclosed herein may be applied to a wide range of footwear styles and are not limited to the specific embodiments discussed below and depicted in the figures.

[0032] The primary elements of footwear 10 are depicted in FIG. 1 as being a sole structure 20 and an upper 30. Sole structure 20 is secured to a lower portion of upper 30 and provides a durable, wear-resistant component that imparts cushioning as footwear 10 impacts the ground. Upper 30 is at least partially formed from a textile element 40 that defines an interior void for comfortably receiving a foot and securing a position of the foot relative to sole structure 20. Various edges of textile element 40 are then secured together to form the shape of upper 30. In some embodiments, textile element 40 may form substantially all of upper 30, or textile element 40 may only be a portion of an upper.

[0033] Sole structure 20 has a generally conventional configuration that includes a midsole 21 and an outsole 22. Midsole 21 is secured to a lower portion of upper 30 and is formed of a polymer foam material, such as ethylvinylacetate or polyurethane. Accordingly, midsole 21 attenuates ground reaction forces and absorbs energy (i.e., provides cushioning) as sole structure 20 impacts the ground. To enhance the force attenuation and energy absorption characteristics of sole structure 20, midsole 21 may incorporate a fluid-filled bladder, as disclosed in U.S. Pat. Nos. 4, 183,156 and 4,219,945 to Rudy. Alternately or in combination, midsole 21 may incorporate a plurality of discrete, columnar support elements, as disclosed in U.S. Pat. Nos. 5,343,639 and 5,353,523 to Kilgore et al. Outsole 22 is secured to a lower surface of midsole21 and may be formed from carbon black rubber compound to provide a durable, wear-resistant surface for engaging the ground. Outsole 22 may also incorporate a textured lower surface to enhance the fraction characteristics of footwear 10. In addition, footwear 10 may include an insole (not depicted), which is a relatively thin, cushioning member located within upper 30 and adjacent to a plantar surface of the foot for enhancing the comfort of footwear 10.

[0034] Sole structure 20 is described above as having the elements of a conventional sole structure for athletic footwear. Other footwear styles, including, dress shoes and boots, for example, may have other types of conventional sole structures specifically tailored for use with the respective types of footwear. In addition to a conventional configuration, however, sole structure 20 may also exhibit a unique, non-conventional structure. Accordingly, the particular configuration of sole structure 20 may vary significantly within the scope of the present invention to include a wide range of configurations, whether conventional or non-conventional.

[0035] Upper 30 is depicted in FIGS. 2-7 as having a lateral region 31, an opposite medial region 32, an instep region 33, a lower region 34, and a heel region 35. Lateral region 31

extends through a longitudinal length of footwear 10 and is generally configured to contact and cover a lateral side of the foot. Medial region 32 has a similar configuration that generally corresponds with a medial side of the foot. Instep region 33 is positioned between lateral region 31 and medial region 32, and instep region 33 extends over an instep area of the foot. Lower region 34 forms a bottom surface of upper 30 and also extends through the longitudinal length of footwear 10. Heel region 35 forms a rear portion of upper 30 and is generally configured to contact and cover a heel area of the foot. In addition, lateral region 31, medial region 32, instep region 33, and heel region 35 cooperatively define an ankle opening 36 for providing the foot with access to the void within upper 30.

[0036] Upper 30 is at least partially formed from textile element 40, which forms regions 31-35, and may also include laces or other elements associated with a conventional upper for footwear. Textile element 40 is a single material element that is formed to exhibit a unitary (i.e., one-piece) construction, and textile element 40 is formed or otherwise shaped to extend around the foot. As depicted in FIGS. 2-7, textile element 40 forms both an exterior surface and an interior surface of upper 30. Textile element 40 may be formed as a part of a larger textile element. Textile element 40 is then removed from the larger textile element and various edges of textile element 40 are secured together to form the shape of upper 30. A plurality of seams 51-54 are formed, therefore, when joining the edges of the textile element. Seam 51 extends along the longitudinal length of lower region 34 and is centrally-located with respect to lateral region 31 and medial region 32. Seam 52 is also centrally-located and extends upward along heel region 35. A seam 53 is positioned in a forefoot area of upper 30 and joins a portion of lower region 34 with both of lateral region 31 and medial region 32. In addition, a seam 54 is positioned in a rear area of upper 30 and joins a portion of lower region 34 with heel region 35.

[0037] Textile element 40 exhibits the general shape depicted in FIG. 8 prior to the formation of seams 51-54. Following formation of seams 51-54, however, textile element 40 exhibits the shape of upper 30 depicted in FIGS. 2-7. Seams 51-54 are formed by securing various edges of textile element 40 together. More specifically, (1) seam 51 is formed by securing an edge 41 a with an edge 41b; (2) seam 52 is formed by securing an edge 42a with an edge 42b; (3) a first portion of seam 53 is formed by securing an edge 43a with an edge 43b; (4) a second portion of seam 53 is formed by securing an edge 43c with an edge 43d; (5) a first portion of seam 54 is formed by securing an edge 44a with an edge 44b; and (6) a second portion of seam 54 is formed by securing an edge 44c with an edge 44d. Referring to FIG. 8, the positions of regions 31-35 and ankle opening 36 are identified to provide a frame of reference relating to the various portions of textile element 40.

[0038] In order to join edges 41a and 41b to form seam 51, textile element 40 is folded or otherwise overlapped such that edge 41a is placed adjacent to edge 41b. Stitching, an adhesive, or heat bonding, for example, is then utilized to secure edge 41a and edge 41b. Textile element 40, as depicted in FIG. 8, has a generally planar configuration. Upon the formation of seam 51, however, one portion of textile element 40 overlaps the other portion of textile element 40. The volume between the overlapping portions effectively forms a portion of the void within upper 30 for receiving the foot.

[0039] The folding or overlapping of textile element 40 to form seam 51 places edge 42a adjacent to edge 42b, which facilitates the formation of seam 52. With reference to FIG. 8, an edge 45 forms a generally u-shaped area in textile element 40. Upon the joining of edges 42a and 42b to form seam 52, the u-shaped area becomes an aperture in textile element 40 and effectively forms ankle opening 36. Each of edges 43a-43d and edges 44a-44d are formed from a generally

v-shaped area of textile element 40. Accordingly, seams 53 and 54 may be formed by closing the v-shaped areas and securing the various edges together.

[0040] Following the formation of each of seams 51-54, the manufacturing of upper 30 is essentially complete. Various finishing steps may be performed, such as reinforcing ankle opening 36, for example. Upper 30 (i.e., textile element 40) is then secured to sole structure 20, with an adhesive, for example. The insole is then placed into the void within upper 30 and adjacent to lower region 34. In some embodiments, various reinforcing members may be added to the exterior or interior surface of upper 20 in order to limit the degree of stretch in upper 20 or provide enhanced wear-resistance. In addition, a lacing system may be added to provide adjustability.

[0041] Textile element 40 is a single material element with a unitary construction, as discussed above. As defined for purposes of the present invention, unitary construction is intended to express a configuration wherein portions of a textile element are not joined together by seams or other connections, as depicted with textile element 40 in FIG. 8. Although the various edges 41a-44d are joined together to form seams 51-54, the various portions of textile element 40 are formed as an unitary element without seams, as discussed below.

[0042] Textile element 40 is primarily formed from one or more yarns that are mechanically-manipulated through either an interweaving, intertwining and twisting, or interlooping process, for example. As discussed in the Background of the Invention section above, interweaving is the intersection of two yarns that cross and interweave at right angles to each other. The yarns utilized in interweaving are conventionally referred to as warp and weft. Intertwining and twisting encompasses procedures such as braiding and knotting where yarns intertwine with each other to form a textile. Interlooping involves the formation of a plurality of

columns of intermeshed loops, with knitting being the most common method of interlooping. Textile element 40 may, therefore, be formed from one of these processes for manufacturing a textile.

[0043] A variety of mechanical processes have been developed to manufacture a textile. In general, the mechanical processes may be classified as either warp knitting or weft knitting. With regard to warp knitting, various specific sub-types that may be utilized to manufacture a textile include tricot, raschel, and double needle-bar raschel (which further includes jacquard double needle-bar raschel). With regard to weft knitting, various specific sub-types that may be utilized to manufacture a textile include circular knitting and flat knitting. Various types of circular knitting include sock knitting (narrow tube), body garment (seamless or wide tube), and jacquard.

[0044] Textile element 40 may be formed through any of the mechanical processes discussed above. Accordingly, textile element 40 may be formed on either a warp knitting machine or a weft knitting machine. One suitable knitting machine for forming textile element 40 is a wide-tube circular knit jacquard machine. Another suitable knitting machine for forming textile element 40 is a wide-tube circular knitting machine that is produced in the Lonati Group by Santoni S.p.A. of Italy under the SM8 TOP1 model number. This Santoni S.p.A. wide-tube circular knitting machine may form a textile structure having a diameter that ranges from 10 inches to 20 inches, with 8 feeds for each diameter. The machine exhibits a maximum 140 revolutions per minute for 10 inch diameters, and a maximum 120 revolutions per minute for 13 inch diameters. Furthermore, the machine gauge is variable between 16, 22, 24, 26, 28, and 32 needles per inch, and is suitable for various needle gauges ranging from 48 to 75.

[0045] A wide-tube circular knitting machine, as produced by Santoni S.p.A., forms a generally cylindrical textile structure and is capable of forming various types of stitches within a single textile structure. In general, the wide-tube circular knitting machine may be programmed to alter the design on the textile structure through needle selection. That is, the type of stitch that is formed at each location on the textile structure may be selected by programming the wide-tube circular knitting machine such that specific needles either accept or do not accept yarn at each stitch location. In this manner, various patterns, textures, or designs may be selectively and purposefully imparted to the textile structure.

[0046] An example of a textile structure 60 that may be formed with a wide-tube circular knitting machine is depicted in FIG. 9. Textile structure 60 has a generally cylindrical configuration, and the types of stitches vary throughout textile structure 60 so that a pattern is formed with the outline of textile element 40. That is, differences in the stitches within textile structure 60 form an outline with the shape and proportions of textile element 40.

[0047] The Santoni S.p.A. wide-tube circular knitting machine may form a textile structure having a diameter that ranges from 10 inches to 16 inches, as discussed above. Assuming that textile structure 60 exhibits a diameter of 10 inches, then the circumference of textile structure 60 is approximately 31 inches. In many circumstances, the total width of textile element 40 will be approximately 12 inches, depending upon the size of footwear 10. The outlines for at least two textile elements 40 may, therefore, be formed on textile structure 60. Referring to FIG. 9, the outline of textile element 40 is depicted on a front portion of textile structure 60, and the outline of another textile element 40 is depicted on a rear portion of textile structure 60. Accordingly, a first textile element 40 and a second textile element 40 may be simultaneously formed in a single textile structure 60. As the diameter of textile element 60 is

increased or the width of textile element 40 decreases, however, an even greater number of textile elements 40 may be outlined on textile structure 60.

[0048] Textile structure 60 may be formed with a wide-tube circular knitting machine, as discussed above. The types of stitches that form textile structure 60 may be varied to form an outline of one or more textile elements 40 on textile structure 60. That is, the wide-tube circular knitting machine may be programmed to form different types of stitches in textile structure 60 so as to outline one or more textile elements 40. Each textile element 40 is then removed from textile structure 60 with a die-cutting, laser-cutting, or other conventional cutting operation. Once textile element 40 is removed from textile structure 60, seams 51-54 may be formed and textile element 40 may be incorporated into footwear 10.

[0049] The yarn forming textile element 40 may be generally defined as an assembly having a substantial length and relatively small cross-section that is formed of at least one filament or a plurality of fibers. Fibers have a relatively short length and require spinning or twisting processes to produce a yarn of suitable length for use in an interlooping process. Common examples of fibers are cotton and wool. Filaments, however, have an indefinite length and may merely be combined with other filaments to produce a yarn suitable for use in an interloping process. Modern filaments include a plurality of synthetic materials such as rayon, nylon, polyester, and acrylic, with silk being the primary, naturally-occurring exception. Yarn may be formed of a single filament (conventionally referred to as a monofilament yarn) or a plurality of individual filaments. Yarn may also be formed of separate filaments formed of different materials, or the yarn may be formed of filaments that are each formed of two or more different materials. Similar concepts also apply to yarns formed from fibers. Accordingly, yarns

may have a variety of configurations within the scope of the present invention that generally conform to the definition provided above.

[0050] In order to provide the stretch and recovery properties to upper 30, and particularly textile element 40, a yarn that incorporates an elastane fiber may be utilized. Elastane fibers are available from E.I. duPont de Nemours Company under the LYCRA trademark. Such fibers may have the configuration of covered LYCRA, wherein the fiber includes a LYCRA core that is surrounded by a nylon sheath. One suitable yarn, for example, includes a 70 denier elastane core that is covered with nylon having a 2 ply, 80 denier, 92 filament structure. Other fibers or filaments exhibiting elastic properties may also be utilized.

[0051] As discussed above, a yarn that incorporates elastane fibers is suitable for textile element 40. A plurality of other yarns, whether elastic or inelastic, are also suitable for textile element 40. The characteristics of the yarn selected for textile element 40 depend primarily upon the materials that form the various filaments and fibers. Cotton, for example, provides a soft hand, natural aesthetics, and biodegradability. Elastane fibers, as discussed above, provide substantial stretch and recoverability. Rayon provides high luster and moisture absorption. Wool also provides high moisture absorption, in addition to insulating properties. Polytetrafluoroethylene coatings may provide a low friction contact between the textile and the skin. Nylon is a durable and abrasion-resistant material with high strength. Finally, polyester is a hydrophobic material that also provides relatively high durability. Accordingly, the materials comprising the yarn may be selected to impart a variety of physical properties to textile element 40, and the physical properties may include, for example, strength, stretch, support, stiffness, recovery, fit, and form.

[0052] Textile element 40 is depicted as having a generally smooth, non-varied stitch configuration. That is, similar stitches are utilized throughout textile element 40 to impart a common texture to the various portions of textile element 40. As discussed above, however, a wide-tube circular knitting machine is generally capable of forming various types of stitches within a single textile structure. The wide-tube circular knitting machine may, therefore, vary the stitches within textile element 40 to produce various patterns, designs, or textures, for example. Various types of stitches may also be formed with other types of knitting machines. With reference to FIG. 10, a textile element 40' with the general shape of textile element 40 is depicted as having various areas with different textures. For example, a central area that corresponds with instep region 33 has a first texture 46' that is generally smooth. In addition, textile element 40' includes a second texture 47' that is a plurality of longitudinal ribs. When incorporated into footwear 10, the ribs will extend longitudinally along lateral region 31 and medial region 32, and the ribs may extend into heel region 35. The ribs may be present for aesthetic purposes, or may affect the stretch properties of upper 20, for example. Accordingly, textile element 40' exhibits areas with different textures in a single element of textile material.

[0053] Many conventional articles of footwear incorporate uppers with various material elements that each exhibit different properties. For example, a first material element may be smooth, and a second material element may be textured. The first and second material elements are then stitched together to form a portion of the conventional upper. Textile element 40' also exhibits smooth and textured areas. In contrast with the conventional upper, however, first texture 46' and second texture 47' are incorporated into a single, unitary element of textile, rather than two separate elements that are stitched or otherwise joined together.

[0054] A textile structure 40" is depicted in FIG. 11 and has the general shape of both textile element 40 and textile element 40'. Textile element 40" includes areas with three different textures. A first texture 46" is generally smooth and has the configuration of various strips that extends laterally across areas corresponding with lateral region 31, medial region 32, and instep region 33. Various portions of textile element 40" also include a second texture 47", which is generally rough in comparison with first texture 46". In addition, the area of textile element 40" corresponding with instep region 33 includes a third texture 48". The different textures 46"-48" are formed by merely varying the type of stitch formed by the wide-tube circular knitting machine at each location of textile element 40". Textures 46"-48" may exhibit aesthetic differences, or the differences may be structural. For example, the degree of stretch in areas with textures 46"-48" may be different, or the wear resistance of the areas may vary depending upon the stitch utilized. The air-permeability of textile element 40" may also vary in the different areas. Third texture 48" is formed to include a plurality of apertures that extend through textile element 40". The apertures may be formed by omitting stitches at specific locations during the wide-tube circular knitting process, and the apertures facilitate the transfer of air between the void within upper 20 and the area outside of upper 20. Accordingly, the various stitches formed in textile element 40", or one of textile elements 40 or 40', may be utilized to vary the texture, physical properties, or aesthetics of footwear 10 within a single, unitary element of material.

[0055] In addition to varying the stitch types to form textures 46'-47' and 46"-48", the type of yarn utilized in various areas of textile elements 40' and 40" may be changed to impart different properties. As discussed above, yarn may be formed from cotton, wool, elastane, rayon, nylon, and polyester, for example. Each of these yarn types may impart differing properties to the areas corresponding with textures 46'-47' and 46"-48". For example, elastane may be utilized

to impart stretch, wool may be utilized for insulation, and nylon may be utilized for durability. Accordingly, different yarn types may be utilized to impart different properties. The types of knitting that may be utilized to form different zones with different properties (e.g., yarn characteristics, textures, etc.) may vary significantly to include the various warp knitting and weft knitting processes discussed earlier, such as tricot, raschel, double needle-bar raschel, circular knitting, and flat knitting, for example.

[0056] An article of footwear 110 is depicted in FIG. 12 and includes a sole structure 120 and an upper 130. Upper 130 includes a textile element 140 having the general configuration of textile element 40. As with textile element 40, textile element 140 forms both an exterior surface and an interior surface of upper 130. In addition, upper 130 includes a lace 131 and a plurality of elements 132-135 that also form a portion of the exterior surface. Lace 131 extends through a plurality of apertures formed in textile element 140. The apertures may be formed by omitting stitches at specific locations. Element 132 is positioned in a forefoot area of footwear 110 and may be formed of leather or rubber, for example, to provide additional wear-resistance. Element 133 extends around the ankle opening to reinforce and limit stretch in the area of the ankle opening. Element 134 extends around the heel region to counter movement of the heel and seat the heel above sole structure 120. Furthermore, elements 135 are substantially inextensible strips of material, such as leather or synthetic leather, that limit stretch on the lateral side of footwear 110. Whereas upper 30 was almost exclusively formed by textile element 40, upper 130 also includes lace 131 and elements 132-135. Accordingly, an upper in accordance with the present invention may incorporate a plurality of additional components.

[0057] Another article of footwear 210 is depicted in FIGS. 13-14 and includes a sole structure 220 and an upper 230. Upper 230 includes a textile element 240 that forms an interior

layer. In addition, upper 230 includes an intermediate layer 250 and an exterior layer 260. As discussed in the Background of the Invention section above, the upper of a conventional article of footwear may be formed from multiple material layers that include an exterior layer, an intermediate layer, and an interior layer. The materials forming the exterior layer of the upper may be selected based upon the properties of wear-resistance, flexibility, and air permeability, for example. The intermediate layer of the upper may be formed from a lightweight polymer foam material that provides cushioning and protects the foot from objects that may contact the upper. Similarly, an interior layer of the upper may be formed of a moisture-wicking textile that removes perspiration from the area immediately surrounding the foot.

[0058] Upper 230 has a configuration that is similar to the configuration of the conventional upper in that various material layers are utilized. In contrast with the conventional upper, however, the interior layer is formed of textile element 240, which is manufactured through the process discussed above. That is, textile element 240 is a single element of textile that forms the interior layer of upper 230. A benefit to utilizing textile element 240 for the interior layer is that textile element 240 includes few seams that may contact the foot. In addition, the stitches utilized at various locations of textile element 240 may modify the texture of the interior surface of upper 230, thereby limiting the degree of slip that occurs between the foot and upper 230 or enhancing the air-permeability of upper 230 in specific locations.

[0059] Various warp knitting or weft knitting processes may be utilized to form textile element 40, or the various other textile elements discussed above. An advantage of this process is that various stitches may be incorporated into specific locations of textile element 40 to modify the physical properties or aesthetics of textile element 40. Whereas a conventional upper includes various elements that stitched or adhesively joined, textile element 40 is a single, unitary element

of material. From the perspective of manufacturing, utilizing multiple materials to impart different properties to an article of footwear may be an inefficient practice. By forming textile element 40 to be a single, unitary element of material, however, efficiency is increased in that upper 20 may include a single textile element, rather than numerous joined elements.

[0060] A variety of knitting processes may be utilized to form textile element 40, as discussed above. As a specific example, a jacquard double needle-bar raschel knitting machine may be utilized to form a flat textile structure, and may also be utilized to form the textile structure to have the configuration of a spacer mesh textile. Unlike textile structure 60, which exhibits a generally cylindrical configuration, the textile structure formed with the jacquard double needle-bar raschel knitting machine will have a flat configuration. Like textile structure 60, however, an outline of a textile element may be imparted to the textile structure formed with the jacquard double needle-bar raschel knitting machine. That is, differences in the stitches within the textile structure may form an outline with the shape and proportions of the intended textile element. Accordingly, the textile element may be removed from the textile structure and incorporated into footwear 10. In addition, the jacquard double needle-bar raschel knitting machine may be utilized to impart various textures, different properties, or different yarn types to the textile element. Similarly, other types of knitting, such as flat knitting, may be utilized within the scope of the present invention to impart various textures, different properties, or different yarn types to the textile element.

[0061] The present invention is disclosed above and in the accompanying drawings with reference to a variety of embodiments. The purpose served by the disclosure, however, is to provide an example of the various features and concepts related to the invention, not to limit the scope of the invention. One skilled in the relevant art will recognize that numerous variations and

modifications may be made to the embodiments described above without departing from the scope of the present invention, as defined by the appended claims.

CLAIMS

What is claimed is:

1. A method of manufacturing an article of footwear, the method comprising:

flat knitting a textile element having a shape of an upper in a planar configuration for the article of footwear, the knitted textile element including a plurality of flat knit edges defining the shape of the upper in the planar configuration, the flat knit edges being free of surrounding material from which the knitted textile element must be removed; and

incorporating the knitted textile element into the article of footwear.

2. The method according to claim 1, wherein the step of flat knitting the textile element further comprises:

knitting a lateral region;

knitting an opposite medial region;

knitting an instep region;

knitting a lower region; and

knitting a heel region.

3. The method according to claim 2, wherein the lateral region, the medial region, the instep region, the lower region, and the heel region are formed of unitary construction using at least one yarn.

4. The method according to claim 2, wherein the step of knitting the lower region includes a first flat knit edge and an opposite second flat knit edge.

5. The method according to claim 4, further comprising joining the first flat knit edge and the second flat knit edge to overlap portions of the knitted textile element and form a void within the upper for receiving a foot.

6. The method according to claim 2, wherein the step of knitting the heel region includes at least two flat knit edges.

7. The method according to claim 6, further comprising joining the at least two flat knit edges in the heel region.

8. The method according to claim 2, further comprising:

knitting at least two different textures in areas disposed in one or more of the lateral region, the medial region, the instep region, the lower region, and the heel region of the knitted textile element.

9. The method according to claim 3, further comprising:

knitting at least one first area disposed in one of the lateral region, the medial region, the instep region, the lower region, and the heel region using a first stitch type; and

knitting at least one second area disposed in another one of the lateral region, the medial region, the instep region, the lower region, and the heel region using a second stitch type, wherein the first stitch type and the second stitch type are different.

10. The method according to claim 3, further comprising:

knitting at least one first area disposed in one of the lateral region, the medial region, the instep region, the lower region, and the heel region using a first type of yarn; and

knitting at least one second area disposed in another one of the lateral region, the medial region, the instep region, the lower region, and the heel region using a second type of yarn, wherein the first type of yarn and the second type of yarn are different.

11. A method of manufacturing an article of footwear, the method comprising:

flat knitting a textile element having a shape of an upper in a planar configuration for the article of footwear, the knitted textile element including a plurality of flat knit edges defining the shape of the upper in the planar configuration, the flat knit edges being free of surrounding material from which the knitted textile element must be removed;

wherein the step of flat knitting the textile element comprises knitting at least a lateral region, an opposite medial region, an instep region, a lower region, and a heel region of unitary construction with each other to form a unitary element;

joining at least two of the plurality of flat knit edges together to form the upper having an interior void for receiving a foot; and

incorporating the knitted textile element having the shape of the upper into the article of footwear.

12. The method according to claim 11, wherein the step of flat knitting the textile element further comprises knitting flat knit edges including at least a first flat knit edge disposed along a first portion of the lower region of the knitted textile element, a second flat knit edge disposed along a second portion of the lower region of the knitted textile element, a third flat knit edge disposed along a first portion of the heel region and a fourth flat knit edge disposed along a second portion of the heel region.

13. The method according to claim 12, wherein the step of joining at least two of the plurality of flat knit edges together comprises joining at least the first flat knit edge and the second flat knit edge to form a first seam.

14. The method according to claim 13, wherein the step of joining at least two of the plurality of flat knit edges together further comprises joining at least the third flat knit edge and the fourth flat knit edge to form a second seam.

15. The method according to claim 14, further comprising knitting a fifth flat knit edge between the first portion of the heel region and the second portion of the heel region to form au-shaped area in the knitted textile element.

16. The method according to claim 15, wherein the step of joining the third flat knit edge and the fourth flat knit edge to form the second seam forms an ankle opening in the knitted textile element defined by the fifth flat knit edge.

17. The method according to claim 11, wherein the step of incorporating the knitted textile element having the shape of the upper into the article of footwear further comprises securing a sole structure to the lower region of the knitted textile element.

18. The method according to claim 11, wherein the knitted textile element forms portions of an exterior surface and an interior surface of the upper of the article of footwear.

19. The method according to claim 11, wherein the step of flat knitting the textile element further comprises:

knitting a first area disposed in one of the lateral region, the medial region, the instep region, the lower region, and the heel region of the knitted textile element with a first set of properties; and

knitting a second area disposed in another of the lateral region, the medial region, the instep region, the lower region, and the heel region of the knitted textile element with a second set of properties that is different from the first set of properties to impart varying characteristics to the textile element.

20. The method according to claim 19, wherein the first set of properties and the second set of properties are at least one of a stitch configuration and a yarn type.

ABSTRACT

An article of footwear and a method of manufacturing the article of footwear are disclosed. The footwear may include an upper and a sole structure. The upper incorporates a textile element with edges that are joined together to define at least a portion of a void for receiving a foot. The textile element may also have a first area and a second area with a unitary construction with varying stitch configurations. The upper may also incorporate longitudinal ribs extending along the lateral and/or medial sides of the upper. Various warp knitting or weft knitting processes may be utilized to form the textile element.

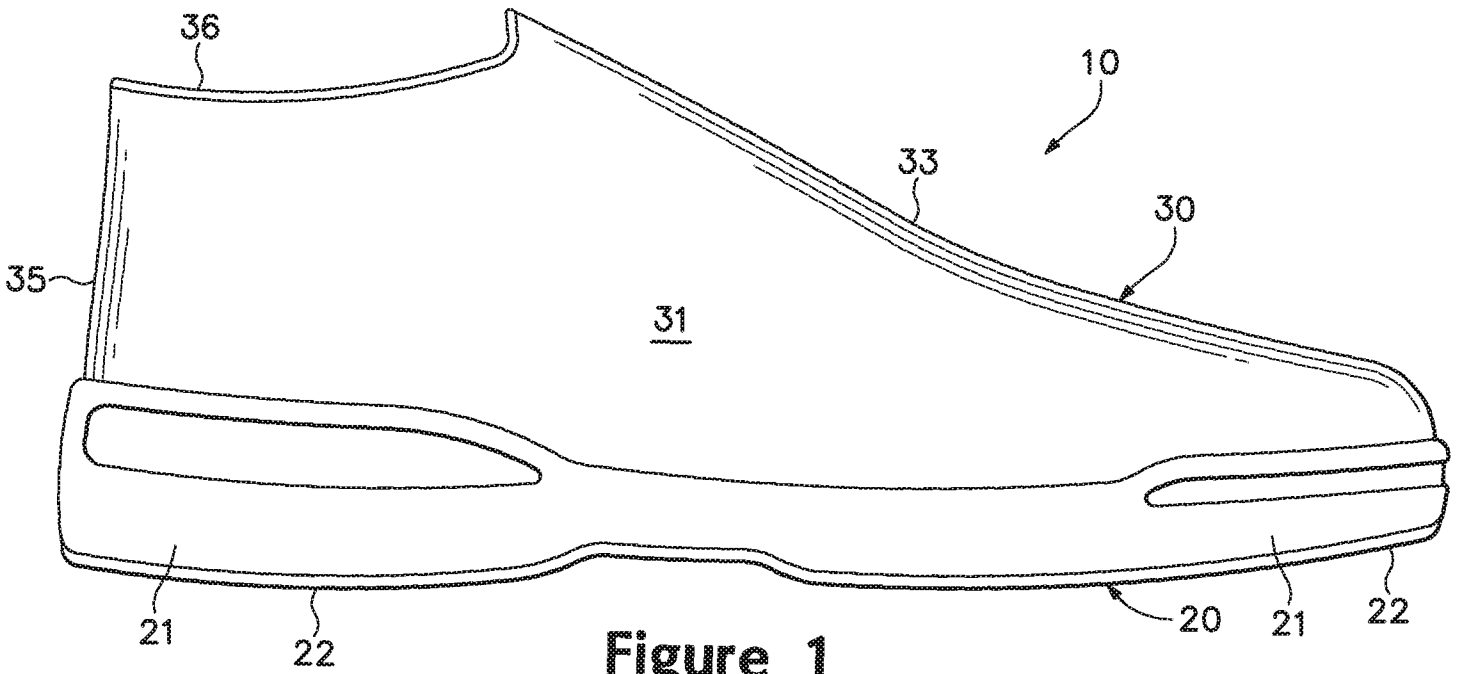


Figure 1

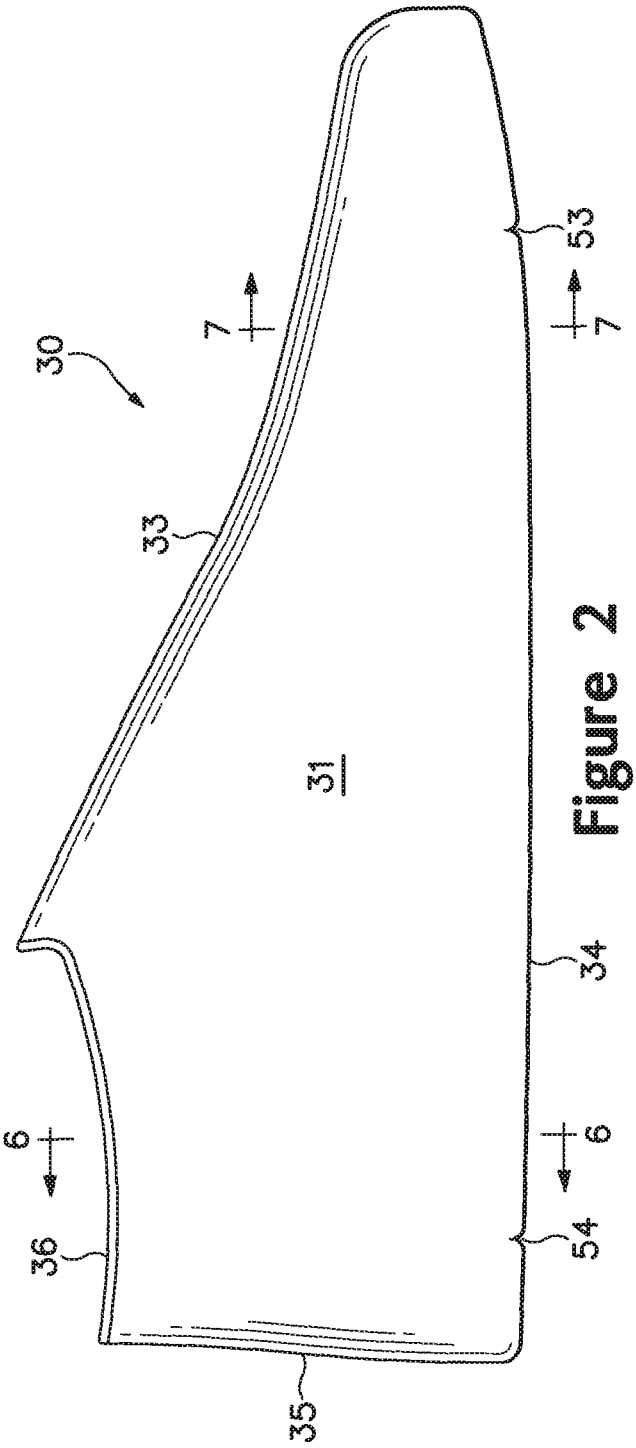


Figure 2

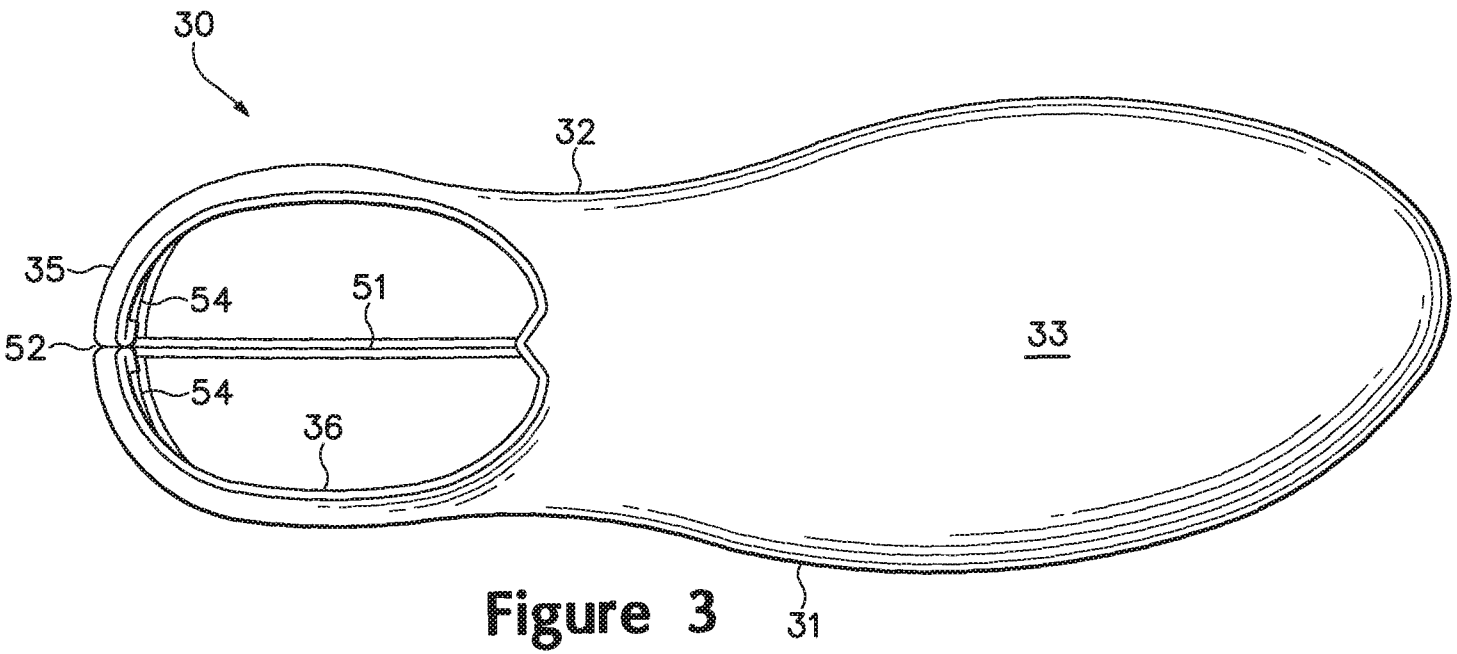


Figure 3

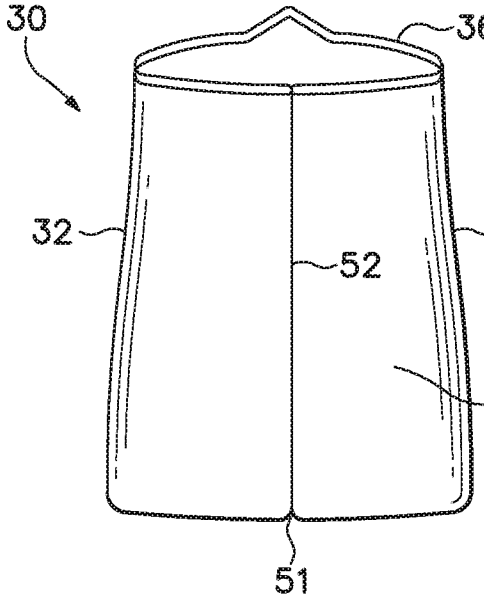


Figure 4

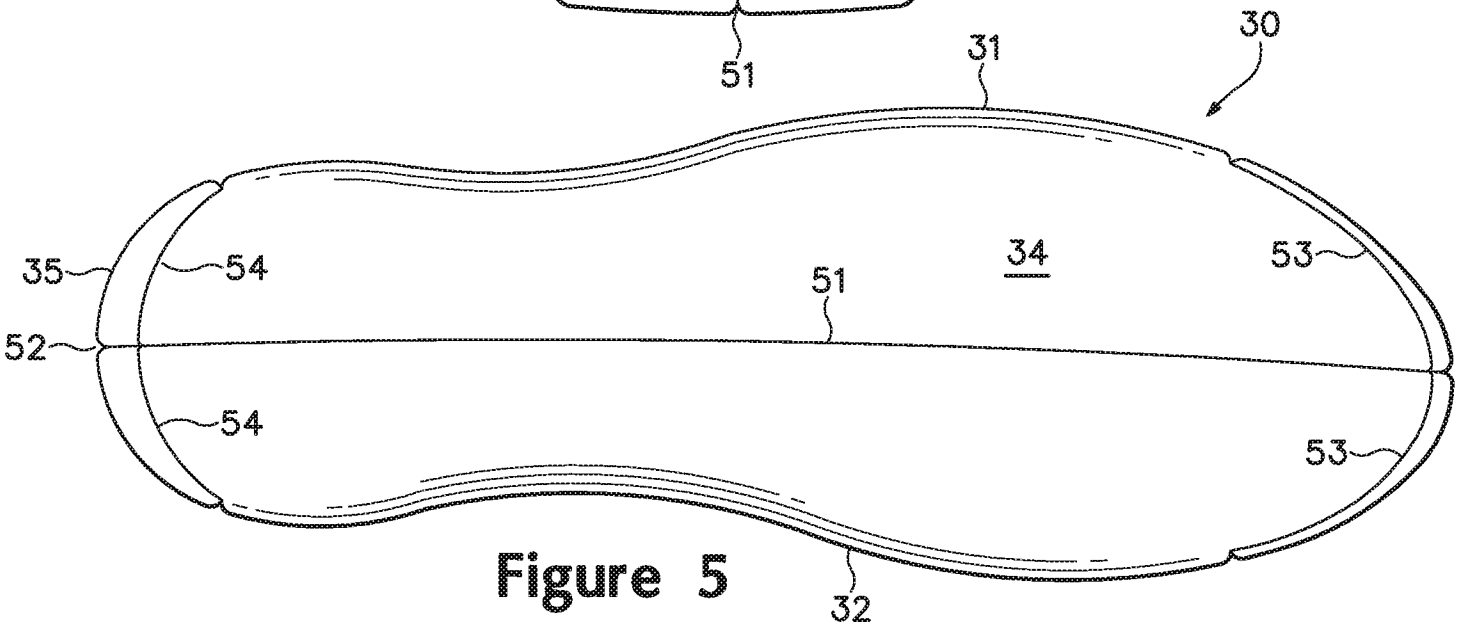


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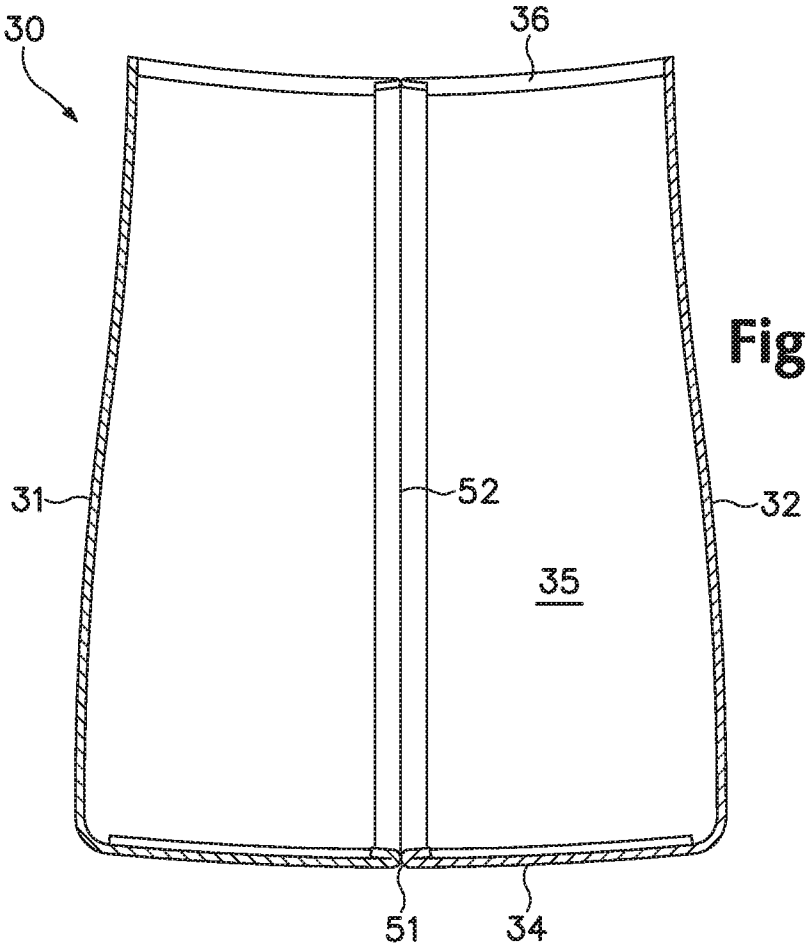


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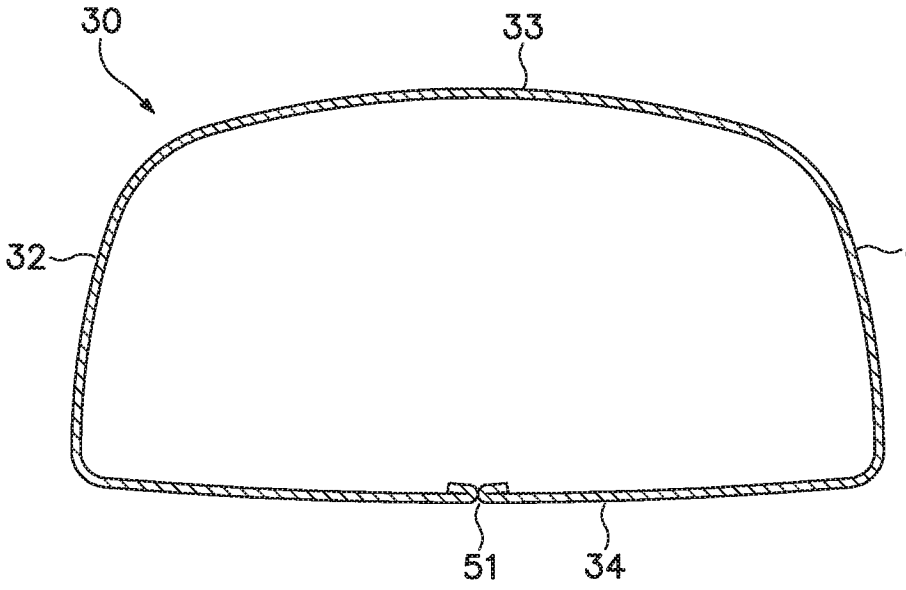


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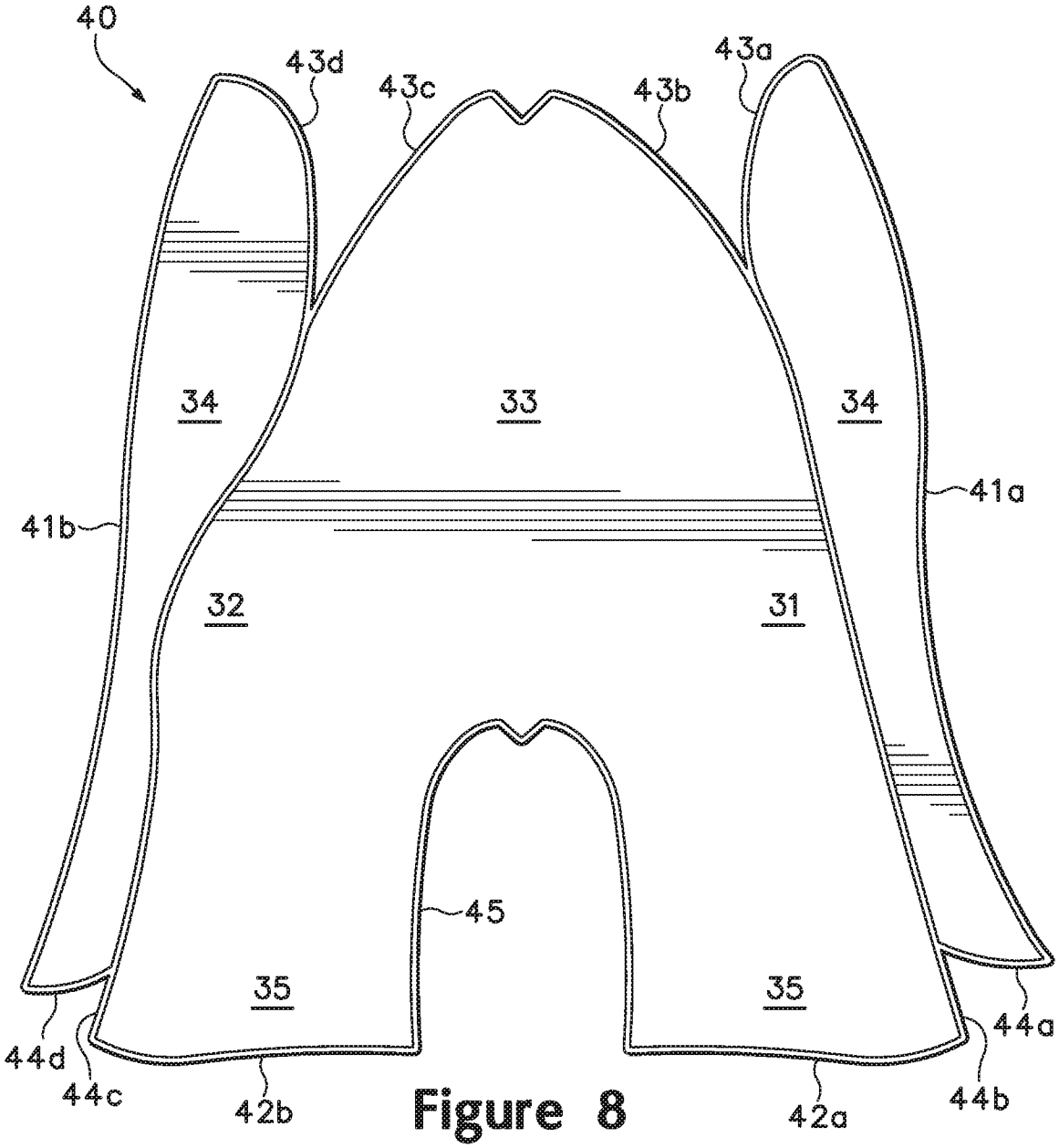

40
43d
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Figure 8

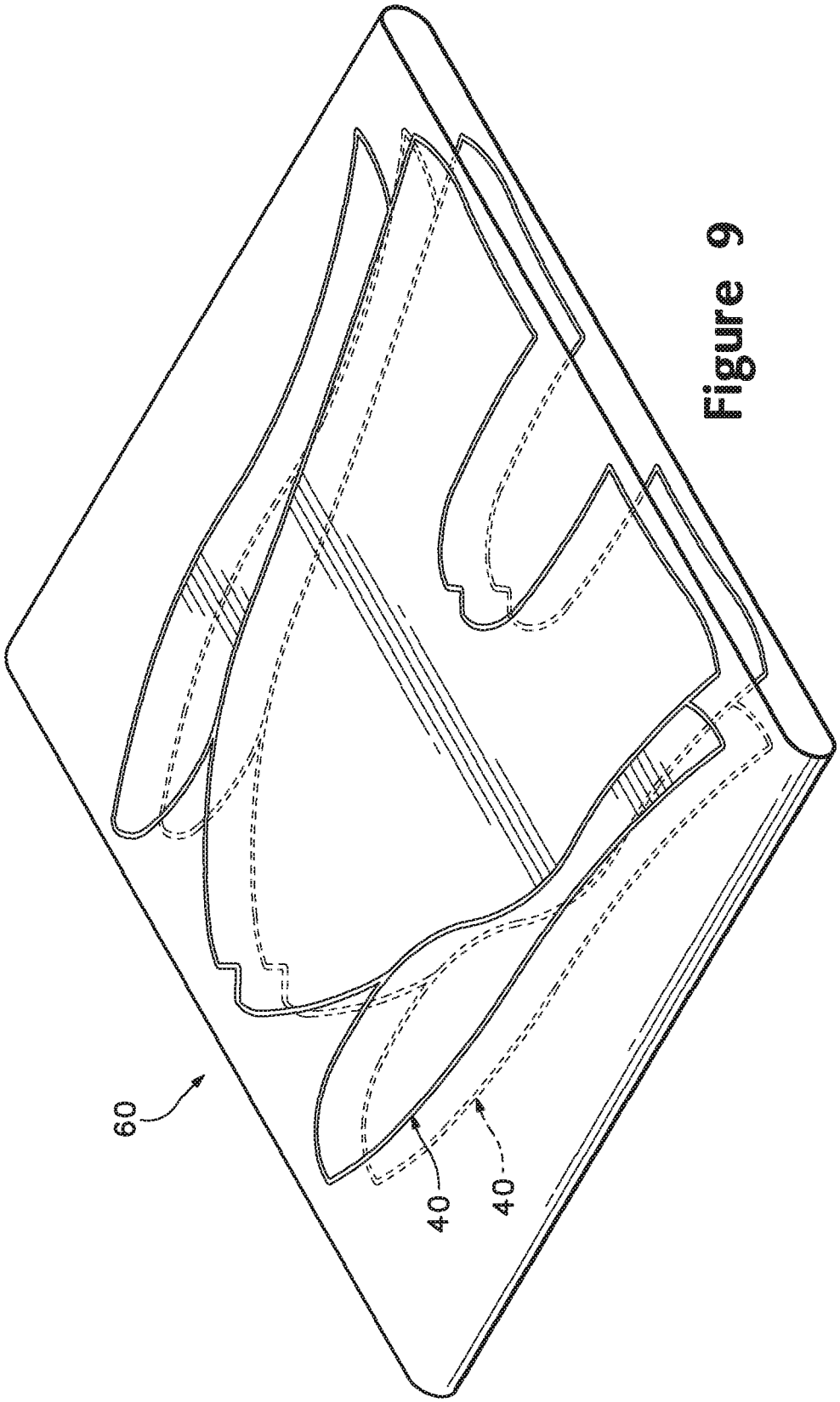


Figure 9

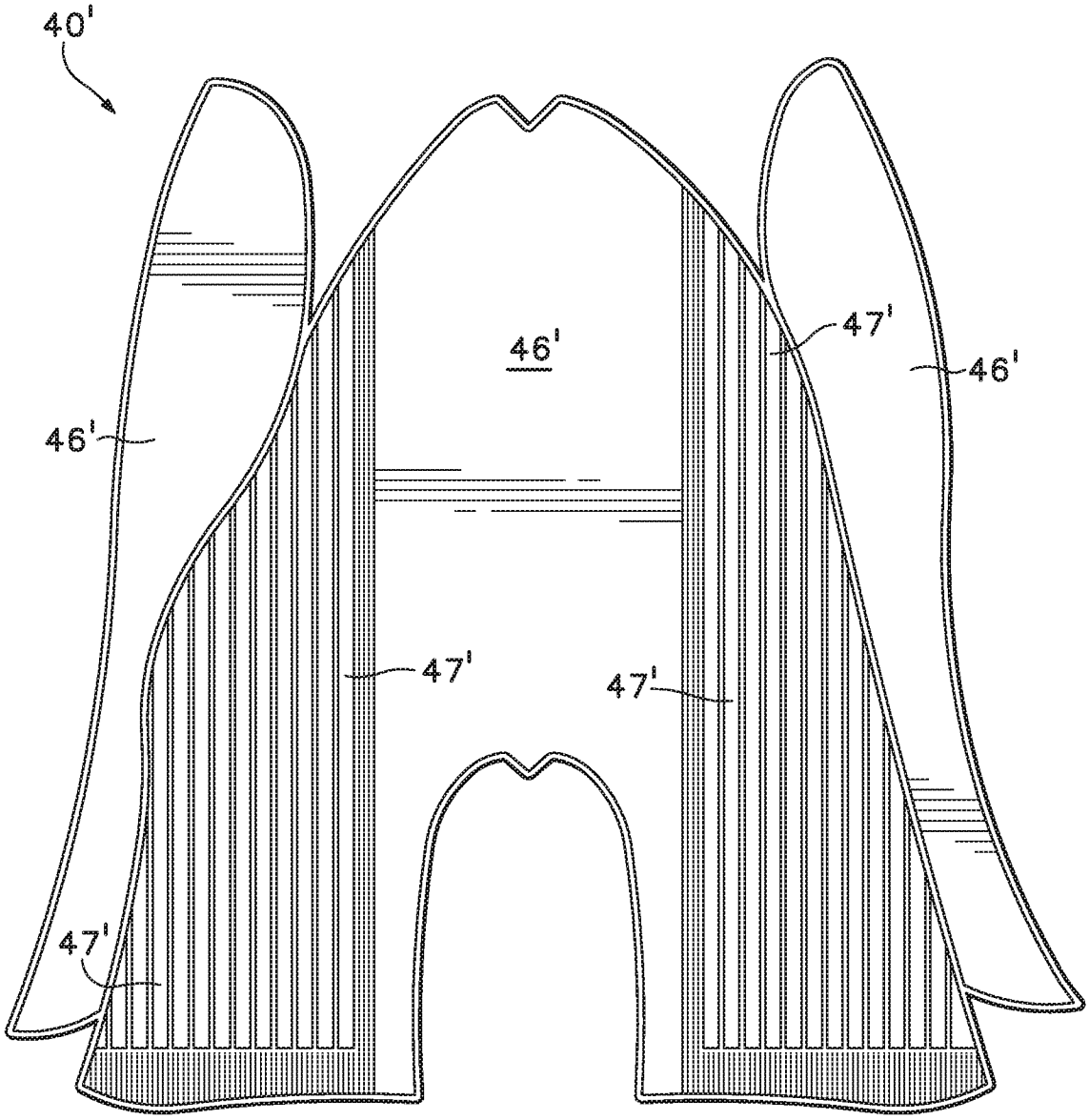


Figure 10

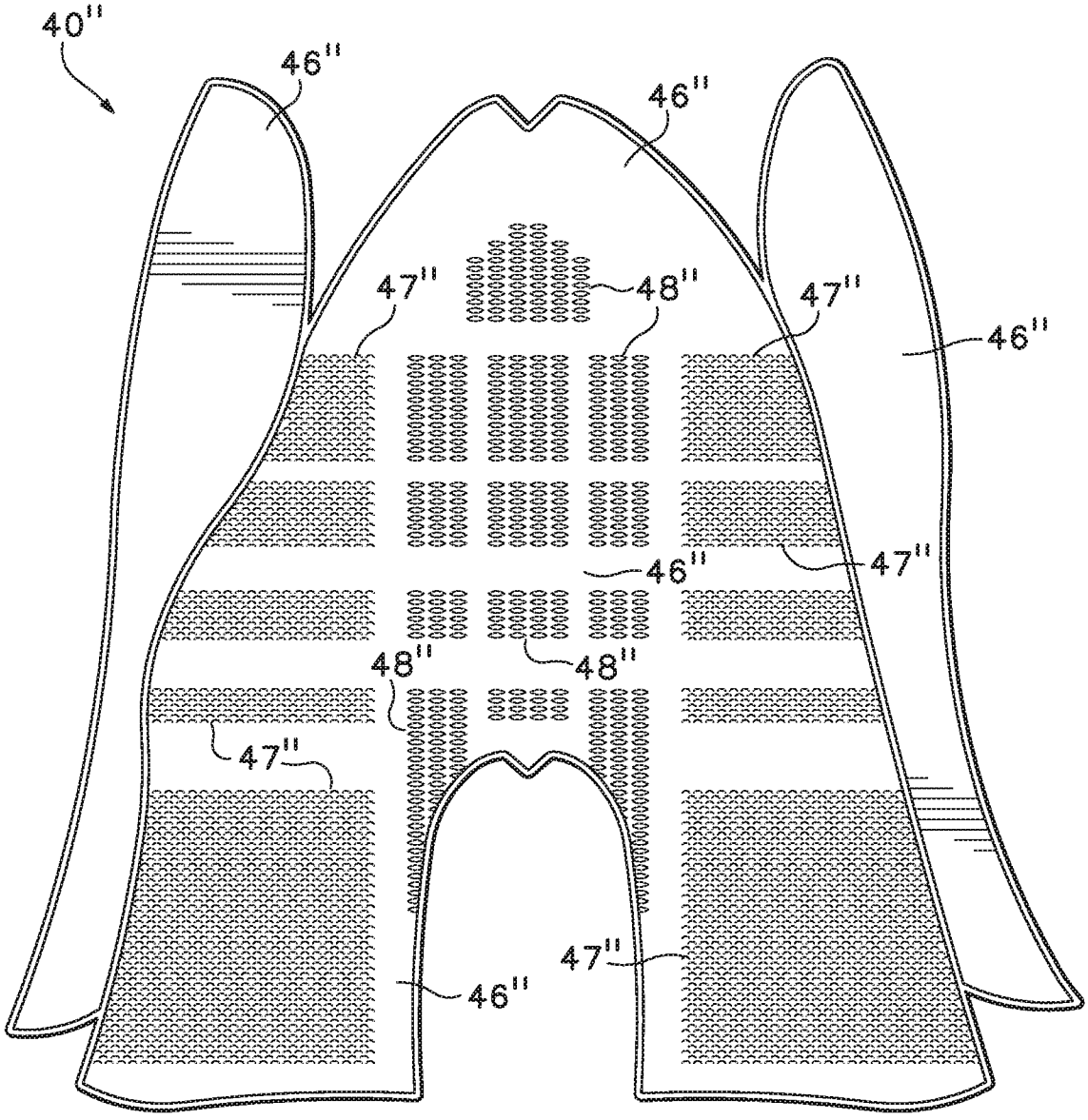


Figure 11

Skechers EX1013-p. 52
Skechers v Nike

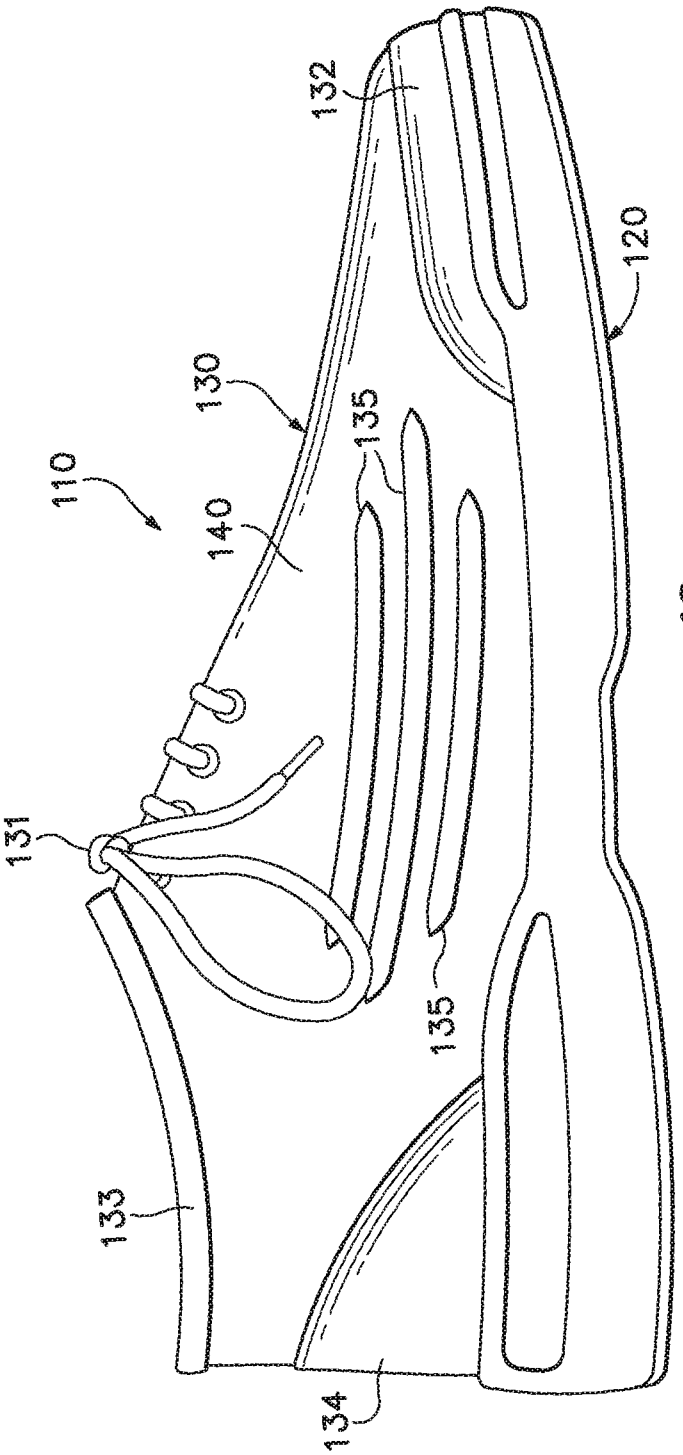


Figure 12

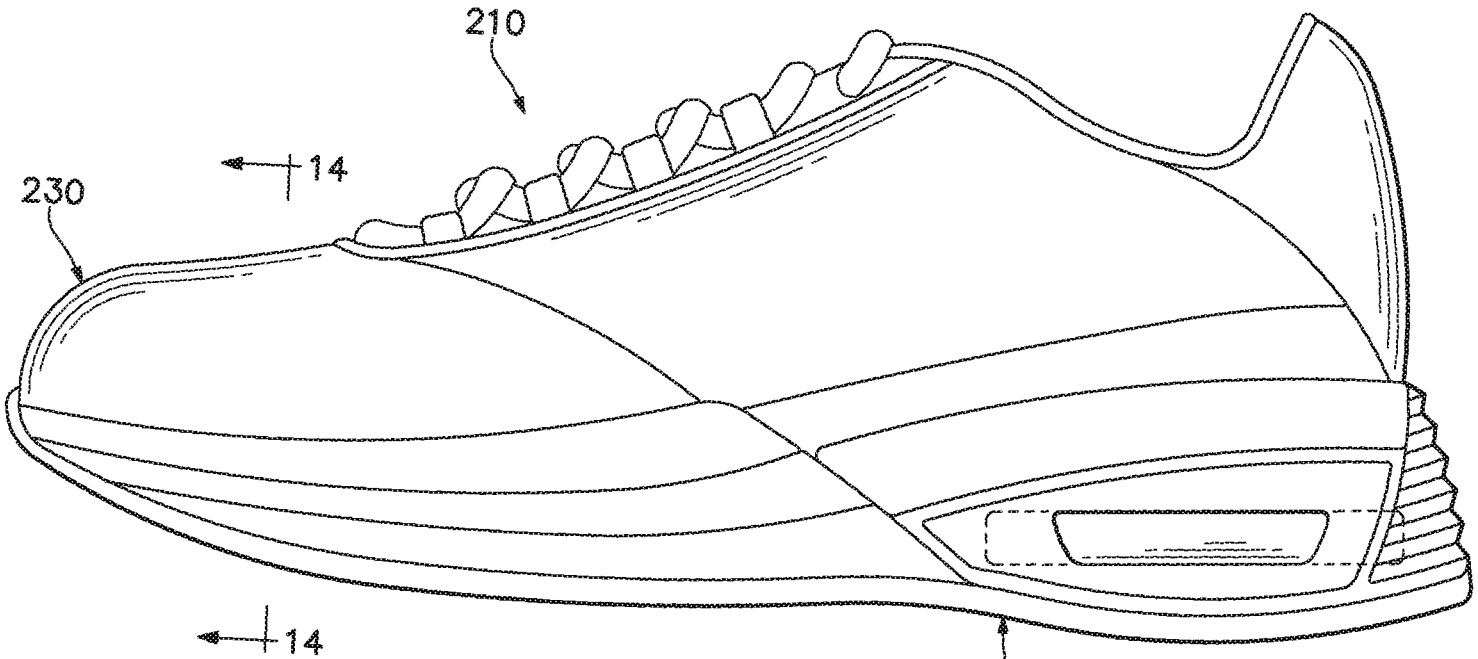


Figure 13

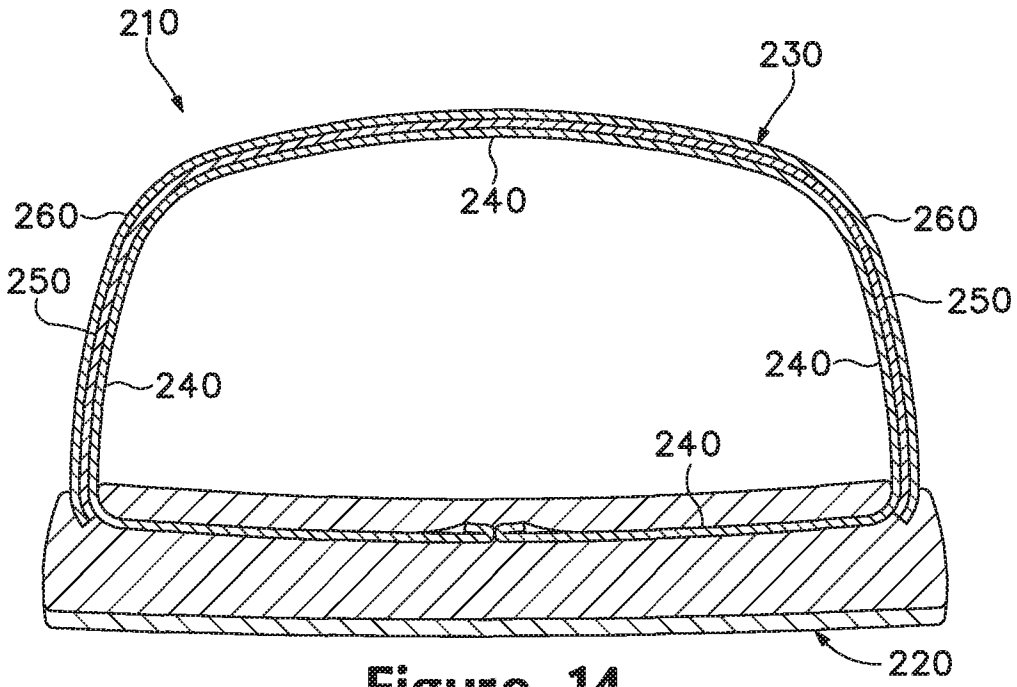


Figure 14

PTO/AIA/14 (11-15)
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Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76.
This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.

Secrecy Order 37 CFR 5.2:

☐ Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)

Inventor Information:

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Prefix	Given Name	Middle Name	Family Name	Suffix
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All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the **Add** button. Add

Correspondence Information:

Enter either Customer Number or complete the Correspondence Information section below.
For further information see 37 CFR 1.33(a).

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Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

☐ **An Address is being provided for the correspondence Information of this application.**

Customer Number	78342		
Email Address	ipdocket@shb.com	Add Email	Remove Email
Email Address	elucas@shb.com	Add Email	Remove Email

Application Information:

Title of the Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER		
Attorney Docket Number	NIKE.276100/081313US82CON	**Small Entity Status Claimed**	☐
Application Type	Nonprovisional		
Subject Matter	Utility		
Total Number of Drawing Sheets (if any)	12	**Suggested Figure for Publication (if any)**	10

Filing By Reference:

Only complete this section when filing an application by reference under 35 U.S.C. 111(c) and 37 CFR 1.57(a). Do not complete this section if application papers including a specification and any drawings are being filed. Any domestic benefit or foreign priority information must be provided in the appropriate section(s) below (i.e., "Domestic Benefit/National Stage Information" and "Foreign Priority Information").

For the purposes of a filing date under 37 CFR 1.53(b), the description and any drawings of the present application are replaced by this reference to the previously filed application, subject to conditions and requirements of 37 CFR 1.57(a).

Application number of the previously filed application	Filing date (YYYY-MM-DD)	Intellectual Property Authority or Country

Publication Information:

☐ Request Early Publication (Fee required at time of Request 37 CFR 1.219)

☐ **Request Not to Publish.** I hereby request that the attached application not be published under 35 U.S.C. 122(b) and certify that the invention disclosed in the attached application **has not and will not** be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

Representative Information:

Representative information should be provided for all practitioners having a power of attorney in the application. Providing this information in the Application Data Sheet does not constitute a power of attorney in the application (see 37 CFR 1.32).
Either enter Customer Number or complete the Representative Name section below. If both sections are completed the customer Number will be used for the Representative Information during processing.

Please Select One:	● Customer Number	US Patent Practitioner	○ Limited Recognition (37 CFR 11.9)
Customer Number	78342		

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing benefit claim information in the Application Data Sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the "Application Number" field blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing or 371(c) Date (YYYY-MM-DD)
	Continuation of	14/503514	2014-10-01
Prior Application Status	Abandoned		Remove
Application Number	Continuity Type	Prior Application Number	Filing or 371(c) Date (YYYY-MM-DD)
14/503514	Division of	14/079748	2013-11-14
Prior Application Status	Abandoned		Remove
Application Number	Continuity Type	Prior Application Number	Filing or 371(c) Date (YYYY-MM-DD)
14/079748	Continuation of	13/413233	2012-03-06
Prior Application Status	Patented		Remove

Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)
13/413233	Continuation of	13/236742	2011-09-20	8266749	2012-09-18
Prior Application Status	Patented				Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)
13/236742	Continuation of	12/879517	2010-09-10	8042288	2011-10-25
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Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)
12/879517	Continuation of	12/032995	2008-02-18	7814598	2010-10-19
Prior Application Status	Patented				Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)
12/032995	Division of	10/791289	2004-03-03	7347011	2008-03-25

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button. Add

Foreign Priority Information:

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

This section allows for the applicant to claim priority to a foreign application. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55. When priority is claimed to a foreign application that is eligible for retrieval under the priority document exchange program (PDX)[i] the information will be used by the Office to automatically attempt retrieval pursuant to 37 CFR 1.55(i)(1) and (2). Under the PDX program, applicant bears the ultimate responsibility for ensuring that a copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign priority application is filed, within the time period specified in 37 CFR 1.55(g)(1).

Remove

Application Number	Country[i]	Filing Date (YYYY-MM-DD)	Access Code[i] (if applicable)

Additional Foreign Priority Data may be generated within this form by selecting the **Add** button. Add

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

☐ This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.
NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

Authorization or Opt-Out of Authorization to Permit Access:

When this Application Data Sheet is properly signed and filed with the application, applicant has provided written authority to permit a participating foreign intellectual property (IP) office access to the instant application-as-filed (see paragraph A in subsection 1 below) and the European Patent Office (EPO) access to any search results from the instant application (see paragraph B in subsection 1 below).

Should applicant choose not to provide an authorization identified in subsection 1 below, applicant **must opt-out** of the authorization by checking the corresponding box A or B or both in subsection 2 below.

NOTE: This section of the Application Data Sheet is **ONLY** reviewed and processed with the **INITIAL** filing of an application. After the initial filing of an application, an Application Data Sheet cannot be used to provide or rescind authorization for access by a foreign IP office(s). Instead, Form PTO/SB/39 or PTO/SB/69 must be used as appropriate.

1. Authorization to Permit Access by a Foreign Intellectual Property Office(s)

A. Priority Document Exchange (PDX) - Unless box A in subsection 2 (opt-out of authorization) is checked, the undersigned hereby **grants the USPTO authority** to provide the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO), the World Intellectual Property Organization (WIPO), and any other foreign intellectual property office participating with the USPTO in a bilateral or multilateral priority document exchange agreement in which a foreign application claiming priority to the instant patent application is filed, access to: (1) the instant patent application-as-filed and its related bibliographic data, (2) any foreign or domestic application to which priority or benefit is claimed by the instant application and its related bibliographic data, and (3) the date of filing of this Authorization. See 37 CFR 1.14(h)(1).

B. Search Results from U.S. Application to EPO - Unless box B in subsection 2 (opt-out of authorization) is checked, the undersigned hereby **grants the USPTO authority** to provide the EPO access to the bibliographic data and search results from the instant patent application when a European patent application claiming priority to the instant patent application is filed. See 37 CFR 1.14(h)(2).

The applicant is reminded that the EPO's Rule 141(1) EPC (European Patent Convention) requires applicants to submit a copy of search results from the instant application without delay in a European patent application that claims priority to the instant application.

2. Opt-Out of Authorizations to Permit Access by a Foreign Intellectual Property Office(s)

☐ A. Applicant **DOES NOT** authorize the USPTO to permit a participating foreign IP office access to the instant application-as-filed. If this box is checked, the USPTO will not be providing a participating foreign IP office with any documents and information identified in subsection 1A above.

☐ B. Applicant **DOES NOT** authorize the USPTO to transmit to the EPO any search results from the instant patent application. If this box is checked, the USPTO will not be providing the EPO with search results from the instant application.

NOTE: Once the application has published or is otherwise publicly available, the USPTO may provide access to the application in accordance with 37 CFR 1.14.

PTO/AIA/14 (11-15)
Approved for use through 04/30/2017. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

Applicant Information:

Providing assignment information in this section does not substitute for compliance with any requirement of part 3 of Title 37 of CFR to have an assignment recorded by the Office.

Applicant 1 — Remove

If the applicant is the inventor (or the remaining joint inventor or inventors under 37 CFR 1.45), this section should not be completed. The information to be provided in this section is the name and address of the legal representative who is the applicant under 37 CFR 1.43; or the name and address of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under 37 CFR 1.46. If the applicant is an applicant under 37 CFR 1.46 (assignee, person to whom the inventor is obligated to assign, or person who otherwise shows sufficient proprietary interest) together with one or more joint inventors, then the joint inventor or inventors who are also the applicant should be identified in this section.

Clear

● Assignee	Legal Representative under 35 U.S.C. 117	Joint Inventor
Person to whom the inventor is obligated to assign.	Person who shows sufficient proprietary interest	

If applicant is the legal representative, indicate the authority to file the patent application, the inventor is:

Name of the Deceased or Legally Incapacitated Inventor:

If the Applicant is an Organization check here. ☒

Organization Name	NIKE, Inc.		
Mailing Address Information For Applicant:			
Address 1	One Bowerman Drive		
Address 2			
City	Beaverton	**State/Province**	OR
Country	US	Postal Code	97005-6453
Phone Number		Fax Number	
Email Address			

Additional Applicant Data may be generated within this form by selecting the Add button. Add

Assignee Information including Non-Applicant Assignee Information:

Providing assignment information in this section does not substitute for compliance with any requirement of part 3 of Title 37 of CFR to have an assignment recorded by the Office.

PTO/AIA/14 (11-15)
Approved for use through 04/30/2017. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

Assignee 1

Complete this section if assignee information, including non-applicant assignee information, is desired to be included on the patent application publication. An assignee-applicant identified in the "Applicant Information" section will appear on the patent application publication as an applicant. For an assignee-applicant, complete this section only if identification as an assignee is also desired on the patent application publication.

Remove

If the Assignee or Non-Applicant Assignee is an Organization check here. ☐

Prefix	**Given Name**	Middle Name	**Family Name**	Suffix

Mailing Address Information For Assignee including Non-Applicant Assignee:

Address 1			
Address 2			
City		**State/Province**	
Country i		Postal Code	
Phone Number		Fax Number	
Email Address			

Additional Assignee or Non-Applicant Assignee Data may be generated within this form by selecting the Add button. Add

Signature:

Remove

NOTE: This Application Data Sheet must be signed in accordance with 37 CFR 1.33(b). **However, if this Application Data Sheet is submitted with the INITIAL filing of the application and either box A or B is not checked in subsection 2 of the "Authorization or Opt-Out of Authorization to Permit Access" section, then this form must also be signed in accordance with 37 CFR 1.14(c).**

This Application Data Sheet **must** be signed by a patent practitioner if one or more of the applicants is a **juristic entity** (e.g., corporation or association). If the applicant is two or more joint inventors, this form must be signed by a patent practitioner, **all** joint inventors who are the applicant, or one or more joint inventor-applicants who have been given power of attorney (e.g., see USPTO Form PTO/AIA/81) on behalf of **all** joint inventor-applicants.

See 37 CFR 1.4(d) for the manner of making signatures and certifications.

Signature	/ELIZABETH A. LUCAS/			Date (YYYY-MM-DD)	2017-05-31
First Name	Elizabeth	Last Name	Lucas	Registration Number	74,247

Additional Signature may be generated within this form by selecting the Add button. Add

PTO/AIA/14 (11-15)
Approved for use through 04/30/2017. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	NIKE.276100/081313US82CON
	Application Number	
Title of Invention	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	

This collection of information is required by 37 CFR 1.76. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 23 minutes to complete, including gathering, preparing, and submitting the completed application data sheet form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1 The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3 A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent CooperationTreaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	15/610,089	Confirmation No. 4757
First Named Inventor	:	BHUPESH DUA	
Applicants	:	NIKE, Inc.	
Filed	:	05/31/2017	
Title	:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	
Group Art Unit	:	Not yet assigned	
Examiner	:	Not yet assigned	
Atty. Docket No.	:	NIKE.276100/081313US82CON	
Customer No.	:	78342	

VIA EFS – June 1, 2017

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRELIMINARY AMENDMENT

Applicant respectfully requests entry of the following preliminary amendment in the above-referenced application, filed May 31, 2017:

Amendments to the Claims: begin on page 2.

Remarks: begin on page 6.

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application.

Listing of Claims:

1–20. (Cancelled)

21. (New) An upper for an article of footwear, the upper comprising:

a flat knit textile element having: (1) flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed, and (2) a plurality of ribs integrally knitted into the flat knit textile element,

wherein one or more ribs extend longitudinally along one or more of a lateral side and a medial side of the upper.

22. (New) The upper of claim 21, wherein the one or more ribs extend into a heel region of the upper.

23. (New) The upper of claim 21, wherein the one or more ribs affect stretch properties of the upper.

24. (New) The upper of claim 21, wherein the one or more ribs extending longitudinally comprises ribs spaced apart from an area adjacent an instep region of the upper to an area adjacent a lower region of the upper.

25. (New) The upper of claim 24, wherein the lower region of the upper comprises a bottom surface of the upper.

26. (New) The upper of claim 24, wherein the ribs are spaced apart at a uniform distance from the area adjacent the instep region to the area adjacent the lower region.

27. (New) The upper of claim 21, wherein the one or more ribs are adjacent one or more regions having a smooth texture.

28. (New) The upper of claim 21, wherein at least one rib within the one or more ribs extends continuously from a forefoot region of the upper to a heel region of the upper.

29. (New) The upper of claim 21, wherein the one or more ribs includes one or more ribs extending longitudinally along the lateral side and one or more ribs extending longitudinally along the medial side.

30. (New) The upper of claim 29, wherein the one or more ribs extending along the lateral side mirror the one or more ribs extending longitudinally along the medial side.

31. (New) The upper of claim 21, wherein the one or more ribs comprise ribs of varying lengths.

32. (New) An article of footwear comprising:

an upper comprising:

a flat knit textile element having: (1) flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed, and (2) a plurality of ribs integrally knitted into the flat knit textile element,

wherein the plurality of ribs include one or more ribs extending longitudinally along a lateral side and one or more ribs extending longitudinally along a medial side of the upper.

33. (New) The article of footwear of claim 32, wherein the one or more ribs on the lateral side and the one or more ribs on the medial side extend into a heel region of the upper.

34. (New) The article of footwear of claim 32, wherein the one or more ribs on the lateral side and the one or more ribs on the medial side affect stretch properties of the upper.

35. (New) The article of footwear of claim 32, wherein the one or more ribs on the lateral side and the one or more ribs on the medial side each comprise ribs spaced apart from an area adjacent an instep region of the upper to an area adjacent a lower region of the upper.

36. (New) The article of footwear of claim 35, wherein the ribs are spaced apart at a uniform distance.

37. (New) The article of footwear of claim 32, wherein the one or more ribs on the lateral side and the one or more ribs on the medial side are adjacent one or more regions having a smooth texture.

38. (New) The article of footwear of claim 32, wherein at least one rib on the lateral side and at least one rib on the medial side extend continuously from a forefoot region of the upper to a heel region of the upper.

39. (New) The article of footwear of claim 32, wherein the one or more ribs on the lateral side and the one or more ribs on the medial side comprise ribs of varying lengths.

40. (New) The article of footwear of claim 32 further comprising a sole structure secured to the upper.

REMARKS

Claims 1–20 have been cancelled, and claims 21–40 have been added, leaving claims 21–40 for consideration upon entry of the present amendment. Each of claims 21–40 is believed to be in condition for allowance, and such favorable action is respectfully requested.

If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone at 816.559.2282 or via email at elucas@shb.com (such communication via email is expressly allowed). It is believed that no fee is due in conjunction with the present communication. However, the Commissioner is authorized to charge any amount required to Deposit Account No. 19-2112, referencing Attorney Docket Number NIKE.276100/081313US82CON.

Respectfully submitted,

/ELIZABETH A. LUCAS/

Elizabeth A. Lucas
Reg. No. 74,247

EAL
SHOOK, HARDY & BACON L.L.P.
2555 Grand Boulevard
Kansas City, MO 64108-2613
816-559-2697

Electronic Acknowledgement Receipt

EFS ID:	29367863
Application Number:	15610089
International Application Number:	
Confirmation Number:	4757
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Customer Number:	78342
Filer:	Elizabeth Ashley Lucas/Cheryl Neeley
Filer Authorized By:	Elizabeth Ashley Lucas
Attorney Docket Number:	NIKE.276100/081313US82CON
Receipt Date:	01-JUN-2017
Filing Date:	
Time Stamp:	15:52:10
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Preliminary Amendment	276100_Preliminary_Amendment.pdf	31713 f8c379d794aacd968ff16169aff8c3ed88fedb68	no	6

Warnings:

Information:	
Total Files Size (in bytes):	31713

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

PATENT APPLICATION FEE DETERMINATION RECORD

Substitute for Form PTO-875

Application or Docket Number: 15/610,089

APPLICATION AS FILED - PART I

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA	SMALL ENTITY RATE($)	SMALL ENTITY FEE($)	OR	OTHER THAN SMALL ENTITY RATE($)	OTHER THAN SMALL ENTITY FEE($)
BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A			N/A	280
SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A			N/A	600
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A			N/A	720
TOTAL CLAIMS (37 CFR 1.16(i))	20 minus 20 =	*			OR	x 80 =	0.00
INDEPENDENT CLAIMS (37 CFR 1.16(h))	2 minus 3 =	*				x 420 =	0.00
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).						0.00
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))							0.00
			TOTAL			TOTAL	1600

* If the difference in column 1 is less than zero, enter "0" in column 2.

APPLICATION AS AMENDED - PART II

		(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	SMALL ENTITY RATE($)	SMALL ENTITY ADDITIONAL FEE($)	OR	OTHER THAN SMALL ENTITY RATE($)	OTHER THAN SMALL ENTITY ADDITIONAL FEE($)
AMENDMENT A	Total (37 CFR 1.16(i))	*	Minus	**	=	x =		OR	x =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x =		OR	x =	
	Application Size Fee (37 CFR 1.16(s))									
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
						TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	

		(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	SMALL ENTITY RATE($)	SMALL ENTITY ADDITIONAL FEE($)	OR	OTHER THAN SMALL ENTITY RATE($)	OTHER THAN SMALL ENTITY ADDITIONAL FEE($)
AMENDMENT B	Total (37 CFR 1.16(i))	*	Minus	**	=	x =		OR	x =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x =		OR	x =	
	Application Size Fee (37 CFR 1.16(s))									
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
						TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest Number Previously Paid For" (Total or Independent) is the highest found in the appropriate box in column 1.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
15/610,089	05/31/2017	3765	1600	NIKE.276100/081313US82CON	20	2

CONFIRMATION NO. 4757

FILING RECEIPT

78342
SHOOK, HARDY & BACON L.L.P.
(NIKE, INC.)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD.
KANSAS CITY, MO 64108-2613

OC000000091933273

Date Mailed: 06/09/2017

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Inventor(s)

BHUPESH DUA, Portland, OR;
EDWARD NATHANIAL THOMAS, Portland, OR;

Applicant(s)

NIKE, Inc., Beaverton, OR;

Power of Attorney: The patent practitioners associated with Customer Number 78342

Domestic Priority data as claimed by applicant

This application is a CON of 14/503,514 10/01/2014
which is a DIV of 14/079,748 11/14/2013 ABN
which is a CON of 13/413,233 03/06/2012 ABN
which is a CON of 13/236,742 09/20/2011 PAT 8266749
which is a CON of 12/879,517 09/10/2010 PAT 8042288
which is a CON of 12/032,995 02/18/2008 PAT 7814598
which is a DIV of 10/791,289 03/03/2004 PAT 7347011

Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.) - None.
Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

Permission to Access Application via Priority Document Exchange: Yes

Permission to Access Search Results: Yes

Applicant may provide or rescind an authorization for access using Form PTO/SB/39 or Form PTO/SB/69 as appropriate.

If Required, Foreign Filing License Granted: 06/07/2017

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 15/610,089**

Projected Publication Date: 09/14/2017

Non-Publication Request: No

Early Publication Request: No

Title

ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

Preliminary Class

036

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: No

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific

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Application	Document	Mailroom Date	Attorney Docket No.
15610089	APP.FILE.REC	06/09/2017	NIKE.276100/081313US82CON

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INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD.
KANSAS CITY MO 64108-2613

MAILED
JUN 13 2017
OFFICE OF PETITIONS

Doc Code: TRACK1.GRANT

Decision Granting Request for Prioritized Examination (Track I or After RCE)	Application No.: 15/610,089

1. THE REQUEST FILED May 31, 2017 IS **GRANTED.**

The above-identified application has met the requirements for prioritized examination

A. ☒ for an original nonprovisional application (Track I).
B. ☐ for an application undergoing continued examination (RCE).

2. **The above-identified application will undergo prioritized examination.** The application will be accorded special status throughout its entire course of prosecution until one of the following occurs:

A. filing a **petition for extension of time** to extend the time period for filing a reply;

B. filing an **amendment to amend the application to contain more than four independent claims, more than thirty total claims**, or a multiple dependent claim;

C. filing a **request for continued examination**;

D. filing a notice of appeal;

E. filing a request for suspension of action;

F. mailing of a notice of allowance;

G. mailing of a final Office action;

H. completion of examination as defined in 37 CFR 41.102; or

I. abandonment of the application.

Telephone inquiries with regard to this decision should be directed to Brian W. Brown at 571-272-5338.

/Brian W. Brown/
[*Signature*]

Petitions Examiner, Office of Petitions
(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/610,089	05/31/2017	BHUPESH DUA	NIKE.276100/081313US82CON	4757

78342 7590 06/22/2017

SHOOK, HARDY & BACON L.L.P.
(NIKE, INC.)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD.
KANSAS CITY, MO 64108-2613

EXAMINER
BAYS, MARIE D

ART UNIT	PAPER NUMBER
3765	

NOTIFICATION DATE	DELIVERY MODE
06/22/2017	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Notice of References Cited	Application/Control No. 15/610,089	Applicant(s)/Patent Under Reexamination DUA ET AL.	
	Examiner MARIE BAYS	Art Unit 3765	Page 1 of 2

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-2,147,197 A	02-1939	GLIDDEN ALFRED A	A43B1/02	36/3A
*	B	US-2004/0118018 A1	06-2004	Dua, Bhupesh	A43B1/04	36/45
*	C	US-2005/0115284 A1	06-2005	Dua, Bhupesh	A43B1/04	66/178R
*	D	US-6,910,288 B2	06-2005	Dua; Bhupesh	A43B1/04	12/146C
*	E	US-6,931,762 B1	08-2005	Dua; Bhupesh	A43B1/04	12/142G
*	F	US-6,986,269 B2	01-2006	Dua; Bhupesh	A43B1/04	66/177
*	G	US-2006/0130359 A1	06-2006	Dua; Bhupesh	A43B1/04	36/9R
*	H	US-7,347,011 B2	03-2008	Dua; Bhupesh	A43B1/04	36/10
*	I	US-2010/0199520 A1	08-2010	Dua; Bhupesh	A43B1/04	36/87
*	J	US-2012/0159813 A1	06-2012	Dua; Bhupesh	A43B1/04	36/84
*	K	US-2015/0013080 A1	01-2015	Thomas; Edward N.	A43B1/04	12/142R
*	L	US-2016/0088893 A1	03-2016	Meir; Adrian	A43B1/04	36/84
*	M	US-2016/0088894 A1	03-2016	Meir; Adrian	A43B1/04	36/9R

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Notice of References Cited	Application/Control No. 15/610,089	Applicant(s)/Patent Under Reexamination DUA ET AL.	
	Examiner MARIE BAYS	Art Unit 3765	Page 2 of 2

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-2016/0208421 A1	07-2016	Baines; Simon John	A43B1/04	1/1
	B	US-				
	C	US-				
	D	US-				
	E	US-				
	F	US-				
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	I	US-				
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First Action Interview Pilot Program Pre-Interview Communication	Application No. 15/610,089	Applicant(s) DUA ET AL.	
	Examiner MARIE BAYS	Art Unit 3765	AIA (First Inventor to File) Status No

-The MAILING OR NOTIFICATION DATE of this communication appears on the cover sheet with the correspondence address -

THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **ONE MONTH OR THIRTY (30) DAYS,** WHICHEVER IS LONGER, FROM THE MAILING OR NOTIFICATION DATE OF THIS COMMUNICATION.

This time period for reply is extendable under 37 CFR 1.136(a) for only ONE additional MONTH.

This communication constitutes notice under 37 CFR 1.136(a)(1)(i).

Applicant must, within the time period for reply, file: (1) A letter requesting not to have a first action interview; (2) A reply under 37 CFR 1.111 waiving the first action interview and First Action Interview Office Action; or (3) An Applicant Initiated Interview Request Form (PTOL-413A) electronically via EFS-Web, accompanied by a proposed amendment or arguments, and schedule the interview within 2 months from the filing of the request. A failure to respond to this communication will be treated as a request not to have an interview. If applicant waives the First Action Interview Office Action, the instant Pre-Interview Communication is deemed the first Office Action on the Merits. The next subsequent Office action may be made final if appropriate. See MPEP 706.07(a).

Status

1)☐ Responsive to communication(s) filed on _____.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

Disposition of Claims

2)☒ Claim(s) *21-40* is/are pending in the application.

2a) Of the above claim(s) _____ is/are withdrawn from consideration.

3)☐ Claim(s) _____ is/are allowed.

4)☒ Claim(s) *21-40* is/are rejected.

5)☐ Claim(s) _____ is/are objected to.

6)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

7)☐ The specification is objected to by the Examiner.

8)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

9)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

Contact Information

Examiner's Telephone Number: (571)272-4559

Examiner's Typical Work Schedule: M-Th 6:30-4:00

Supervisor's Name: Khoa Huynh

Supervisor's Telephone Number: 571-272-4888

Attachment(s)	
1) ☒ Notice of References Cited (PTO-892)	3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
2) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.	4) ☐ Other: _____.

First Action Interview Pilot Program Pre-Interview Communication	**Application No.** 15/610,089	**Applicant(s)** DUA ET AL.	
	Examiner MARIE BAYS	**Art Unit** 3765	**AIA (First Inventor to File) Status** No

Notification of Rejection(s) and/or Objection(s)

#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection
	21-40	DUA 6910288; 2004/01180	102/103	Dua shows a knitted (interlooped, see paragraph [0046] of the PGPub) upper (130) with a plurality of ribs (134) which are considered to be integrally knitted and extend longitudinally on the medial and lateral sides with varying lengths (see paragraph [0041] as claimed.[

Expanded Discussion/Commentary

		In reference to the language directed towards the "flat knit" and "flat knit edges", this language has been treated as product by process limitations.

DATE: 19 June, 2017	/Marie Bays/ Primary Examiner Art Unit: 3765	

Notice of References Cited	Application/Control No. 15/610,089	Applicant(s)/Patent Under Reexamination DUA ET AL.	
	Examiner MARIE BAYS	Art Unit 3765	Page 1 of 2

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*	A	US-2,147,197 A	02-1939	GLIDDEN ALFRED A	A43B1/02	36/3A
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*	C	US-2005/0115284 A1	06-2005	Dua, Bhupesh	A43B1/04	66/178R
*	D	US-6,910,288 B2	06-2005	Dua; Bhupesh	A43B1/04	12/146C
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*	M	US-2016/0088894 A1	03-2016	Meir; Adrian	A43B1/04	36/9R

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	Examiner MARIE BAYS	Art Unit 3765	Page 2 of 2

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	D	US-				
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Application	Document	Mailroom Date	Attorney Docket No.
15610089	OA.FAI.PRELM	06/22/2017	NIKE.276100/081313US82CON
	892	06/22/2017	NIKE.276100/081313US82CON

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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 15/610,089	Filing Date 05/31/2017	☐ To be Mailed

ENTITY: ☒ LARGE ☐ SMALL ☐ MICRO

APPLICATION AS FILED – PART I

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA	RATE ($)	FEE ($)
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	
☐ SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A	
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*	X $ =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*	X $ =	
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	

APPLICATION AS AMENDED – PART II

AMENDMENT **06/09/2017**

	(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	RATE ($)	ADDITIONAL FEE ($)
Total (37 CFR 1.16(i))	* 20	Minus	** 20	= 0	X $80 =	0
Independent (37 CFR 1.16(h))	* 3	Minus	***3	= 0	X $420 =	0
☐ Application Size Fee (37 CFR 1.16(s))						
☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	0

AMENDMENT

	(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	RATE ($)	ADDITIONAL FEE ($)
Total (37 CFR 1.16(i))	*	Minus	**	=	X $ =	
Independent (37 CFR 1.16(h))	*	Minus	***	=	X $ =	
☐ Application Size Fee (37 CFR 1.16(s))						
☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/610,089	05/31/2017	BHUPESH DUA	NIKE.276100/081313US82CON	4757

78342 7590 07/20/2017

SHOOK, HARDY & BACON L.L.P.
(NIKE, INC.)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD.
KANSAS CITY, MO 64108-2613

EXAMINER
BAYS, MARIE D

ART UNIT	PAPER NUMBER
3765	

NOTIFICATION DATE	DELIVERY MODE
07/20/2017	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@SHB.COM
IPRCDKT@SHB.COM
nike_docketing@cardinal-ip.com

Applicant-Initiated Interview Summary	**Application No.** 15/610,089	**Applicant(s)** DUA ET AL.	
	Examiner MARIE BAYS	**Art Unit** 3765	

All participants (applicant, applicant's representative, PTO personnel):

(1) *MARIE BAYS*. (3)_____.

(2) *Liz Lucas*. (4)_____.

Date of Interview: *17 July 2017*.

Type: ☒ Telephonic ☐ Video Conference
☐ Personal [copy given to: ☐ applicant ☐ applicant's representative]

Exhibit shown or demonstration conducted: ☐ Yes ☒ No.
If Yes, brief description: _____.

Issues Discussed ☐101 ☐112 ☒102 ☒103 ☐Others
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: *21-40*.

Identification of prior art discussed: *Dua*.

Substance of Interview
(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicant argued that "flat knit edges" have a specific finished edge which would not be present in a cut edge and that the phrase "ribs integrally knitted" inherently have structure in the art of knitting that would not be the same as the fused rib structure shown by Dua. Applicants' representative is going to give the Examiner a known definition in the art for the integrally knitted ribs and after such, the Examiner plans to pass the case to Allowance with a reasons for allowance including the definitions of "flat knit edges" and "ribs integrally knitted"..

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

☐ Attachment

	/Marie Bays/ Primary 3765 7/17/17

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews
Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.
All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:
- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:
1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
   (The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

To: IPDOCKET@SHB.COM,IPRCDKT@SHB.COM,nike_docketing@cardinal-ip.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 78342

Jul 20, 2017 04:05:35 AM

Dear PAIR Customer:

SHOOK, HARDY & BACON L.L.P.
(NIKE, INC.)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD.
KANSAS CITY, MO 64108-2613
UNITED STATES

The following USPTO patent application(s) associated with your Customer Number, 78342 , have new outgoing correspondence. This correspondence is now available for viewing in Private PAIR.

The official date of notification of the outgoing correspondence will be indicated on the form PTOL-90 accompanying the correspondence.

Disclaimer:
The list of documents shown below is provided as a courtesy and is not part of the official file wrapper. The content of the images shown in PAIR is the official record.

Application	Document	Mailroom Date	Attorney Docket No.
15610089	INTV.SUM.APP	07/20/2017	NIKE.276100/081313US82CON

To view your correspondence online or update your email addresses, please visit us anytime at https://sportal.uspto.gov/secure/myportal/privatepair.

If you have any questions, please email the Electronic Business Center (EBC) at EBC@uspto.gov with 'e-Office Action' on the subject line or call 1-866-217-9197 during the following hours:

Monday - Friday 6:00 a.m. to 12:00 a.m.

Thank you for prompt attention to this notice,

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

PTO/SB/08a (03-15)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

U.S.PATENTS Remove

Examiner Initial*	Cite No	Patent Number	Kind Code[1]	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1					

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Examiner Initial*	Cite No	Publication Number	Kind Code[1]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1					

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Examiner Initial*	Cite No	Foreign Document Number[3]	Country Code[2] i	Kind Code[4]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T[5]
	1							

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NON-PATENT LITERATURE DOCUMENTS Remove

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T[5]

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	15610089
	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

	1	Petitioner Adidas AG's Request for Rehearing Under 37 C.F.R. § 42.71 On The Decision Not to Institute Inter Partes Review for Inter Partes Review IPR2017-00263, dated July 7, 2017, 17 pages.
	2	Petitioner Adidas AG's Request for Rehearing Under 37 C.F.R. § 42.71 On The Decision Not to Institute Inter Partes Review for Inter Partes Review IPR2017-00264, dated July 7, 2017, 17 pages.
	3	Petitioner's Demonstratives for Inter Partes Review IPR2016-00921, dated July 10, 2017 and for Inter Partes Review IPR2016-00922, 84 pages.
	4	Patent Owner NIKE's Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00921, dated July 11,2017, 3 pages.
	5	Petitioner's Updated Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00921, dated July 11,2017, 4 pages.
	6	Patent Owner NIKE Inc.'s Demonstratives for Inter Partes Review IPR2016-00921, dated July 11, 2017 and for Inter Partes Review IPR2016-00922, 27 pages.
	7	Patent Owner NIKE's Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00922, dated July 11, 2017, 3 pages.
	8	Petitioner's Updated Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00922, dated July 11, 2017, 4 pages.

If you wish to add additional non-patent literature document citation information please click the Add button Add

EXAMINER SIGNATURE

Examiner Signature		Date Considered	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1] See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. [2] Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). [3] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [4] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [5] Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

☒ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ A certification statement is not submitted herewith.

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/ELIZABETH A. LUCAS/	Date (YYYY-MM-DD)	2017-07-24
Name/Print	Elizabeth A. Lucas	Registration Number	74247

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Patent Application Fee Transmittal

Application Number:	15610089
Filing Date:	31-May-2017
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Filer:	Elizabeth Ashley Lucas
Attorney Docket Number:	NIKE.276100/081313US82CON

Filed as Large Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Miscellaneous:				
Submission- Information Disclosure Stmt	1806	1	180	180
		Total in USD ($)		**180**

Electronic Acknowledgement Receipt

EFS ID:	29852573
Application Number:	15610089
International Application Number:	
Confirmation Number:	4757
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Customer Number:	78342
Filer:	Elizabeth Ashley Lucas/Cheryl Neeley
Filer Authorized By:	Elizabeth Ashley Lucas
Attorney Docket Number:	NIKE.276100/081313US82CON
Receipt Date:	24-JUL-2017
Filing Date:	31-MAY-2017
Time Stamp:	19:16:22
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	CARD
Payment was successfully received in RAM	$180
RAM confirmation Number	072517INTEFSW19174300
Deposit Account	
Authorized User	
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Non Patent Literature	276100_1_NPL_01_Petitioner_Adidas_AGs_Request_for_Rehearing_IPR2017_00263.pdf	882564 d9df302135c2fb330cb33c70fc682990f496fe54	no	17
Warnings:					
Information:					
2	Non Patent Literature	276100_1_NPL_02_Petitioner_Adidas_AGs_Request_for_Rehearing_IPR2017_00264.pdf	875289 dbbbcbc26b6260bb355aa83862ce294d26b2006b	no	17
Warnings:					
Information:					
3	Non Patent Literature	276100_1_NPL_03_Petitioners_Demonstratives_for_Inter_Partes_Review_IPR2016_00921.pdf	16827100 7839e71d7b13a0e55307c8cae27261ae8f2f7d82	no	84
Warnings:					
Information:					
4	Non Patent Literature	276100_1_NPL_04_Patent_Owner_NIKEs_Exhibit_List_IPR2016_00921.pdf	49041 4130403185739c3d1e9e110a302471afba60f7b6	no	3
Warnings:					
Information:					
5	Non Patent Literature	276100_1_NPL_05_Petitioners_Updated_Exhibit_List_IPR2016_00921.pdf	88185 e1cc77b5f45776b75ac90aec1cf4a0ffa5b287b6	no	4
Warnings:					
Information:					
6	Non Patent Literature	276100_1_NPL_06_Petitioners_Demonstratives_for_Inter_Partes_Review_IPR2016_00922.pdf	3250996 7aa73081d2bb66044e7c77a42b6b65d0a5b66a61	no	27
Warnings:					
Information:					

7	Non Patent Literature	276100_1_NPL_07_Patent_Owner_NIKEs_Exhibit_List_IPR2016_00922.pdf	49199 243ad9723a01566e465c0af4af7dddbeba58a5fa	no	3
Warnings:					
Information:					
8	Non Patent Literature	276100_1_NPL_08_Petitioners_Updated_Exhibit_List_IPR2016_00922.pdf	83378 189d44dc8a73f22a9ba6e729da4ec91b4a0d34bd	no	4
Warnings:					
Information:					
9	Transmittal Letter	276100_IDS_Cover_Letter.pdf	15812 b1b889159707e0f36ef66f09e808db56fdc05f99	no	1
Warnings:					
Information:					
10	Information Disclosure Statement (IDS) Form (SB08)	276100_IDS_1.PDF	1035398 67c17d243890bc772dbb06f106e95b9ece52bcad	no	4
Warnings:					
Information:					
A U.S. Patent Number Citation or a U.S. Publication Number Citation is required in the Information Disclosure Statement (IDS) form for autoloading of data into USPTO systems. You may remove the form to add the required data in order to correct the Informational Message if you are citing U.S. References. If you chose not to include U.S. References, the image of the form will be processed and be made available within the Image File Wrapper (IFW) system. However, no data will be extracted from this form. Any additional data such as Foreign Patent Documents or Non Patent Literature will be manually reviewed and keyed into USPTO systems.					
11	Fee Worksheet (SB06)	fee-info.pdf	30920 54902482f04c46bc02f2edb7709028a1c118cd2a	no	2
Warnings:					
Information:					
			Total Files Size (in bytes):	23187882	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner

v.

Nike, Inc.
Patent Owner

Patent No. 8,042,288
Filing Date: September 10, 2010
Issue Date: October 25, 2011
Title: ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

Inter Partes Review No. 2017-00263

PETITIONER ADIDAS AG'S REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71 ON THE DECISION NOT TO INSTITUTE *INTER PARTES* REVIEW

adidas AG ("Petitioner") respectfully requests reconsideration based on the Board's misapprehension and/or oversight of key facts and misapplication of law in denying institution under 35 U.S.C. § 325(d). This Request is timely as filed within 30 days of the Decision Denying Institution. *See* IPR2016-00263 ("'263 IPR"), Paper 9 (June 7, 2017); 37 C.F.R. § 42.71(d)(2).

I. STATEMENT OF MATERIAL FACTS

On April 19, 2016, Petitioner petitioned *inter partes* review of claims 1-38 of U.S. Patent No. 8,042,288 ("the '288 patent"), namely IPR2016-00920 ("'920 IPR"). *See* '920 IPR, Paper 1. On the same day, Petitioner petitioned for *inter partes* review of claims 1-13 of U.S. Patent No. 7,814,598 ("'598 patent"), namely IPR2016-00921 ("'921 IPR") and petitioned for *inter partes* review of claims 1-9, 11-19, and 21 of U.S. Patent No. 8,266,749 ("'749 patent"), namely IPR2016-00922 ("'922 IPR"). *See* '921 IPR, Paper 1; '922 IPR, Paper 1.

The '288 patent is a continuation of the '598 patent, and the '749 patent is a continuation of the '288 patent. The '598 patent is a divisional of U.S. Patent No. 7,347,011 ("'011 patent"). The Board instituted *inter partes* review of claims 1-16, 19-34, 36, and 39-46 of the '011 patent as anticipated by U.S. Patent No. 5,345,638 to Nishida ("Nishida"), claims 1-16 and 19-46 of the '011 patent as obvious over Nishida, and claims 16-18 of the '011 patent as being anticipated by and obvious over Glidden. *See* IPR2013-00067 ("'067 IPR"), Paper 18.

Skechers EX1013-p. 105
Skechers v Nike

The claims of the '598 patent and the '749 patent are written as method claims, whereas the claims of the '288 patent and the '011 patent are written as article claims. While styled differently, the subject matter recited in the claims of the '598, '749, '288, and '011 patents is substantially overlapping -- so much so that the Patent Owner was required to submit a terminal disclaimer for the '749 patent over the claims of the '598 patent. *See* '922 IPR, Exh. 1002, Jan. 13, 2012 Terminal Disclaimer. Likewise, the Patent Owner was required to submit a terminal disclaimer for the '288 patent over the claims of the '011 patent. *See* '263 IPR, Exh. 1002, March 25, 2011 Terminal Disclaimer.

The '288 patent claims overlap with the claims of the '598 and '749 patents, with the only exception being the '288 patent's claims 8 and 14-20 that add a limitation of a three-layered configuration. Thus, the only features recited in the '288 patent that are not recited in the '598 and '749 patents relate to the location of the textile element among layers and/or surfaces of the upper ('288 patent, claims [14D], 8, and 18-20), and the specific types of varying properties among the textile element, such as being rougher/smoother or having rib structures ('288 patent, claims 15-16).

Notably, the features recited in claims [14D], 8, and 18-20 of the '288 patent are identical to those recited in claims 7-9, 13, 20-23, 29-31, 42, and 46 of the '011

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patent, each of which the Board previously instituted proceedings as anticipated by and obvious over Nishida. *See* '067 IPR, Paper 18.

On October 20, 2016, the Board instituted review of claims 1-13 of the '598 patent and claims 1-9, 11-19, and 21 of the '749 patent. *See* '921 IPR, Paper 6; '922 IPR, Paper 6. Specifically, in both cases, the Board determined that all of the claims were obvious over U.S. Patent No. 3,985,003 to Reed ("Reed") in combination with Nishida. *See id.*

In contrast, the Board denied institution of claims 1-38 of the '288 patent, stating that "we are not satisfied that the Petition provides adequate explanation or is appropriately precise and specific in articulating the basis of the proposed ground to warrant institution of an *inter partes* review on that ground." '920 IPR, Paper 6 at 5. Specifically, the ground that was not adopted was an obviousness combination based on Nishida (as the primary reference) with reference to Reed (for circular knitting), U.S. Patent No. 4,785,558 to Shiomura (for three layers), and U.S. Patent No. 6,779,369 to Shepherd (for showing Shiomura's three layers could be made on a circular knitting machine). *See* '920 IPR, Paper 6.

Upon receiving the Board's decision denying institution, and given the substantial overlap in subject matter of the '288 patent claims with the '598, '749, and '011 patent claims -- *where the Board had instituted inter partes review based on the same art* – Petitioner believed the only rational explanation was that the

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Board was unable to *substantively* evaluate the prior art or its applicability to the challenged claims. The Board seemed to particularly object to the ground as presented in the '920 petition because it not only included Nishida as the primary reference plus Reed, but also included Shiomura and Shepherd which were not being applied to all of the challenged claims. The Board specifically stated "[t]he noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the ground by the panel," which Petitioner understood to mean that the '920 petition had not been evaluated for substance. '920 IPR, Paper 6 at 7.

Petitioner thus prepared new grounds for presentation, *this time using Reed as the primary reference*. Rather than using the Board's denial of the '920 IPR petition for instruction on how to correct the petition, Petitioner followed the guidance of the two related and instituted petitions for the '598 and '749 patents, and presented new grounds in a manner that had previously been accepted by the Board. Thus, Petitioner separated the claims that did not recite multiple layers into a separate petition from those that arguably did, resulting in one ground challenging claims 1-7, 9-13, and 21-38, and a separate ground and petition challenging claims 8 and 14-20 (the '263 IPR petition). Both grounds are based on Reed as the primary reference in combination with Nishida, and the latter ground is also in combination with Shiomura to specifically show the teaching of a three-

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layered disclosure. Petitioner determined that Shepherd's additional disclosure regarding the three-layered circular knitting was not necessary in view of the new combination with Reed as the base reference. For both grounds, Petitioner provided additional explicit details regarding the location of each feature within the relevant reference, and supporting evidence in the form of new expert declarations. In order to comply with the rule change regarding word count, Petitioner filed each ground in separate petitions, namely the '263 IPR and IPR2017-00264 ("'264 IPR").[1]

On June 7, 2017, the Board denied institution of the '263 IPR and '264 IPR petitions under 35 U.S.C. § 325(d), reasoning that (1) *the same or substantially the same prior art or arguments* previously were presented to the Office, (2) the public interest in having unpatentable claims canceled does not outweigh the chance that granting the petition may result in harassment of the patent owner, and (3) the change in rules between the '920 IPR and the '263 IPR was unpersuasive because the change was published before the '263 IPR filing. '263 IPR, Paper 9 at 7-10; *see also* '264 IPR, Paper 9 at 7-10.

II. STANDARD OF REVIEW

37 C.F.R. § 42.71(c) allows a party to request a rehearing on a decision by the Board on whether to institute a trial. When considering a motion for rehearing

[1]Petitioner also identified an additional ground of anticipation based on Nishida for claims 36-38 in the '264 IPR petition.

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a decision on institution, the Board reviews the decision for an abuse of discretion. *Id.* An abuse of discretion may be found if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

As is noted above, at issue in the present request for rehearing is the Board's reliance on 35 U.S.C. § 325(d) in denying institution. Section 325(d) provides:

> In determining whether to institute or order a proceeding . . . the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

This provision does not itself prohibit filing subsequent petitions to challenge a given patent. Indeed, the Board has routinely instituted more than a single IPR proceeding for a patent based on serial petitions. The Board has repeatedly instituted *inter partes* review proceedings involving follow-on petitions where the prior petition was denied without substantive evaluation of the prior art or its applicability to the challenged claims. *See, e.g., Arista Networks, Inc. v. Cisco Sys., Inc.*, No. IPR2016-00309, Paper 8, at 7 (PTAB June 11, 2016)

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(declining to exercise discretion under 35 U.S.C. § 325(d) in part because "[a]lthough Petitioner also challenged the independent claims based on a combination of Amara and Habraken [in Petitioner's prior petition], we did not address that ground substantively because we found it insufficiently articulated."); *Par Pharm., Inc. et al. v. Jazz Pharms., Inc.*, No. IPR2015-00546, Paper 25, at 23-24 (PTAB July 28, 2015) (instituting IPR proceeding because "even assuming Petitioner asserts grounds that are identical to art and arguments presented in the earlier CBM cases, decisions denying institution in those cases do not address the merits of any ground raised in the Petitions."); *Coalition for Affordable Drugs (ADROCA) LLC v. Acorda Therapeutics, Inc.*, No. IPR2015-01853, Paper 13, at 12-13 (PTAB Mar. 11, 2016); *Apotex Inc. v. Wyeth LLC*, No. IPR2015-00873, Paper 8, at 10 (PTAB Sept. 16, 2015); *Arris Grp., Inc. v. C-Cation Techs., LLC*, No. IPR2015-00635, Paper 19, at 8-9 (PTAB July 31, 2015).

III. ARGUMENT

The '263 IPR decision demonstrates an abuse of discretion in denying institution of the '263 IPR petition. First, in finding that the '263 IPR petition contains art and arguments that are "substantially the same" as those presented in the '920 IPR petition, the Board overlooks the fact that the petition features different grounds which rely on different base references, different combinations of secondary references, and provide markedly different arguments regarding

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obviousness. Specifically, Petitioner relied upon the Board's institution decisions on related patents and relied on Reed as the primary reference. Second, the decision represents an unreasonable judgment in weighing public interest and harrassment factors because it ignores the fact that the subject matter of the challenged claims of the '288 patent largely overlaps other claims in the same family for which the Board already instituted review based on the same prior art. Public interest in addressing patentability of similar claims based on similar art and arguments is maximized, while potential for harrassment is minimized given on-going proceedings addressing similar art and issues.

A. The Board Misapprehended that the '263 IPR Petition Contains Art and Arguments That Are Substantially the Same as Those in the '920 IPR Petition.

Substantial evidence does not support the Board's finding that the art and arguments presented in the '263 IPR petition are substantially the same as those in the '920 IPR petition. To the contrary, the arguments are materially different with respect to the primary references and the obviousness combinations presented.

1. The '263 IPR petition is based on a different primary reference.

As an initial matter, the primary reference upon which the '263 IPR petition relies, namely Reed, is merely used as a secondary reference in the '920 IPR petition. *Compare* '920 IPR, Paper 1 at 7 *with* '263 IPR, Paper 1 at 6. The Board

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apparently failed to identify this marked difference, as it re-ordered the references from what was provided in the '263 IPR petition (as correctly shown below)

Ground	35 U.S.C.	Claims	References
1	103(a)	8 and 14-20	Reed, Nishida, and Shiomura

to the listing below, which indicates that Nishida is the primary reference. *Compare* '263 IPR, Paper 1 at 6 *with* '263 IPR, Paper 9 at 5. As further evidence that the Board misapprehended this difference, the Decision states that "Petitioner is challenging claims 8 and 14-20 of the '288 patent as allegedly rendered obvious by the combined teachings of *Nishida, Reed, and Shiomura*." '263 IPR, Paper 9 at 7 (emphasis added).

References	Basis	Challenged Claims
Nishida, Reed, and Shiomura	35 U.S.C. § 103(a)	8 and 14–20

Id. at 5.

By misapprehending this key factual difference between the '920 IPR and the '263 IPR petitions, the Board reached a factual conclusion that is not supported by substantial evidence.

2. The '263 IPR petition presents significantly different arguments in making obviousness combinations.

In the '920 IPR Decision, the Board denied institution in part on the finding that the '920 IPR petition "cited to portions of Nishida for all features of [claim 1], and also submits parallel citation in some cases to portions of Reed. The Petition

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does not provide adequate explanation as to what features adidas contends are absent from Nishida that it also must rely on content of Reed to meet the challenged claims." '920 IPR, Paper 6 at 6.

In contrast, the '263 IPR petition contains no such arguments premised on multiple, alternative combinations of Nishida, Reed, Shiomura, and Shepherd. Instead, in addressing the same limitations, the '263 IPR petition states the features found in Reed and the features from Nishida that would have been obvious to combine with Reed. As just one example, for element [14B], the '263 IPR petition states:

> Reed describes that the textile element is circular-knitted. (Ex. 1003, ¶89-90.) To the extent that Reed does not explicitly state that the circular-knitted textile element can be used to form an upper for an article of footwear, Nishida describes using conventional textile processes, such as weaving and/or knitting and/or embroidering, and program-controlled web of material production devices to form a textile structure with a single or a plurality of textile elements in the shape of a shoe upper. (Ex. 1003, ¶91-92.) The POSA would have understood that circular knitting is a conventional textile process. (Ex. 1003, ¶91.)

'263 IPR, Paper 1 at 16.

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Moreover, by beginning with Reed as the primary reference instead of Nishida, the POSA's motivation to combine the references is presented differently. These distinct differences are described in detail in each petition. *Compare* '920 IPR, Paper 1 at 11-13 *with* '263 IPR, Paper 1 at 11-15.

3. The Board's Determination that It had Substantively Evaluated the Arguments in the '920 IPR Petition is Contradicted.

In denying the '263 IPR petition, the Board states that it evaluated the arguments and evidence presented in the previously denied '920 IPR petition. The Board relies on the single statement in the Conclusion of the '920 IPR Decision, stating "*[h]aving evaluated the Petition*, we determine that [Petitioner] has not shown a reasonable likelihood of success in any of its challenges to claims 1-38 of the '288 patent." '263 IPR, Paper 9 at 8 (quoting '920 IPR, Paper 6 at 8) (emphasis and alterations in original). However, this statement is contradicted by the Board's substantive discussion in the '920 IPR Decision of the grounds presented that states the "noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the ground by the panel . . . Accordingly, we deny the ground and do not institute *inter partes* review based on that ground." '920 IPR, Paper 6 at 7.

In denying the '263 IPR petition, the Board stated that it may not have been able to fully evaluate the evidence and arguments in the petition due to vagueness

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in the presentation, but such vagueness should not benefit the Petitioner. '263 IPR, Paper 9 at 8. However, here Petitioner has not sought any such benefit. Rather, as explained above, Petitioner chose a different route in the '263 IPR petition, premised on a different ground that had already been deemed acceptable to the Board.

4. The Board's Decision to Deny Institution is Inconsistent with Previous Board Decisions.

As explained above, the Board has repeatedly instituted *inter partes* review proceedings involving follow-on petitions under similar circumstances. For example, in *Arista Networks, Inc. v. Cisco Sys., Inc.*, No. IPR2016-00309, Paper 8 (PTAB June 11, 2016), the Board declined to exercise its discretion under 35 U.S.C. § 325(d). In the facts of that proceeding, the Board had previously denied a petition filed by petitioner Arista asserting 5 different references which resulted in 8 separate grounds. *See Arista Networks, Inc. v. Cisco Sys., Inc.*, No. IPR2015-00974, Paper 7 (PTAB Oct. 6, 2015). Arista argued the challenged claims were anticipated by Amara and raised seven additional grounds of obviousness, all based on Amara as the principle reference. *See id.* at 6. In denying the petition, the Board provided a detailed analysis of Arista's anticipation arguments based on Amara and specifically pointed out where Amara's disclosure was lacking. *Id.* at 7-14. However, with respect to several of the obviousness grounds which were based on various combinations of Amara with secondary references Habraken,

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Modberg, Subramanian and Hendel, the Board determined "that the Petition does not identify with sufficient particularity the ground on which the challenge to the independent claims is based." *Id.* at 15-16. The Board concluded that the "Petition, therefore, fails to identify with sufficient specificity the differences between the claimed invention and the prior art." *Id.* at 17.

The Board was later presented with a follow-on petition from Arista that presented four separate obviousness grounds, each based on Amara as the principle reference. IPR2016-00309, Paper 8, at 6. This new petition filed by Arista only replaced one of the original five references, Habraken, but included Modberg, Subramanian and Hendel. *Id.* When urged by the patent owner to deny the petition under § 325(d) (the third petition filed by the same petitioner related to the same patent), the Board stated "we are not persuaded that Petitioner's arguments based on the combination of Amara and CoreBuilder are the same or substantially the same as those previously presented because we have not previously addressed substantively a challenge… based on obviousness over Amara." *Id.* at 7.

In the present case, much like in *Arista*, the Board stated that the '920 IPR petition, which challenged claims 1-38 as obvious based on Nishida as a primary reference, "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, [Petitioner] identifies the limitations of the claim in the prior art." '920 IPR, Paper 6 at 5. Nevertheless, when presented with a new

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obviousness argument in the '263 IPR petition challenging only claims 8 and 14-20 based on Reed as the primary reference in combination with Nishida and Shiomura, the Board exercised its discretion under § 325(d), denying the petition and departing from its reasoning in *Arista,* despite never having previously addressed obviousness over Reed.

B. The Board's Determination That Public Interest In Having Unpatentable Claims Canceled Does Not Outweigh Concern Over Patent Owner Harassment Represents An Unreasonable Judgment in Weighing Relevant Factors.

As described above, practically every recited feature of the challenged claims can be found in one or more claims of the '598, '749, and '011 patents, where the Board has instituted *inter partes* review.

As *Polygroup Ltd. v. Willis Elec. Co., Ltd.*, No. IPR2016-00801 determined, reviewing a follow-on petition where the Board had instituted a separate review proceeding between the same parties on the same or similar grounds for similar claims of a different patent is especially appropriate. IPR2016-00801, Paper 8. That is because "the parties and the Board are already committed to reviewing the issues raised herein, and there is little additional burden to do so here" and "it strikes us as inefficient, from a global perspective, for the Board to decide issues in [the related IPR proceeding] and for a district court to decide the same issues with respect to the [patent challenged in the follow-on petition]." *Id.* at 16.

This rationale squarely applies here. By denying institution of the '288

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patent, the Board gives insufficient weight to the public interest in having unpatentable claims canceled – a particularly appropriate factor where the Board has, in the context of the '921 and '922 IPRs, done much of the work needed to determine the unpatentability of these claims based on this combination of prior art that uses Reed as a primary reference.

The Decision acknowledges that "it is in the public interest that unpatentable claims are cancelled." '263 IPR, Paper 6 at 8. Should the Board deny reconsideration, this interest will be frustrated, despite the already existing investment of party and public resources in addressing patentability of similarly claimed subject matter. Petitioner respectfully submits that the Board committed an error in judgment in finding these considerations outweighed by other factors. Accordingly, Petitioner requests that the Board reconsider its decision to deny institution of the '263 IPR petition.

IV. CONCLUSION

For the foregoing reasons, Petitioner adidas AG respectfully requests that the Board grant this request for rehearing.

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
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Lead Counsel for Petitioner

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of **PETITIONER ADIDAS AG'S REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71 ON THE DECISION NOT TO INSTITUTE *INTER PARTES* REVIEW** has been served on July 7, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner

v.

Nike, Inc.
Patent Owner

Patent No. 8,042,288
Filing Date: September 10, 2010
Issue Date: October 25, 2011
Title: ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

Inter Partes Review No. 2017-00264

PETITIONER ADIDAS AG'S REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71 ON THE DECISION NOT TO INSTITUTE *INTER PARTES* REVIEW

adidas AG ("Petitioner") respectfully requests reconsideration based on the Board's misapprehension and/or oversight of key facts and misapplication of law in denying institution under 35 U.S.C. § 325(d). This Request is timely as filed within 30 days of the Decision Denying Institution. *See* IPR2016-00264 ("'264 IPR"), Paper 9 (June 7, 2017); 37 C.F.R. § 42.71(d)(2).

I. STATEMENT OF MATERIAL FACTS

On April 19, 2016, Petitioner petitioned *inter partes* review of claims 1-38 of U.S. Patent No. 8,042,288 ("the '288 patent"), namely IPR2016-00920 ("'920 IPR"). *See* '920 IPR, Paper 1. On the same day, Petitioner petitioned for *inter partes* review of claims 1-13 of U.S. Patent No. 7,814,598 ("'598 patent"), namely IPR2016-00921 ("'921 IPR") and petitioned for *inter partes* review of claims 1-9, 11-19, and 21 of U.S. Patent No. 8,266,749 ("'749 patent"), namely IPR2016-00922 ("'922 IPR"). *See* '921 IPR, Paper 1; '922 IPR, Paper 1.

The '288 patent is a continuation application of the '598 patent, and the '749 patent is a continuation of the '288 patent. The '598 patent is a divisional application of U.S. Patent No. 7,347,011 ("'011 patent"). The Board previously instituted an *inter partes* review of claims 1-16, 19-34, 36, and 39-46 of the '011 patent as being anticipated by U.S. Patent No. 5,345,638 to Nishida ("Nishida"), claims 1-16 and 19-46 of the '011 patent as being obvious over Nishida, and

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claims 16-18 of the '011 patent as being anticipated by and obvious over Glidden, namely IPR2013-00067 ("'067 IPR"). *See* '067 IPR, Paper 18.

The claims of the '598 patent and the '749 patent are written as method claims, whereas the claims of the '288 patent and the '011 patent are written as article claims. While styled differently, the subject matter recited in the claims of the '598, '749, '288, and '011 patents is substantially overlapping -- so much so that the Patent Owner was required to submit a terminal disclaimer for the '749 patent over the claims of the '598 patent. *See* '922 IPR, Exh. 1002, Jan. 13, 2012 Terminal Disclaimer. Likewise, the Patent Owner was required to submit a terminal disclaimer for the '288 patent over the claims of the '011 patent. *See* '263 IPR, Exh. 1002, March 25, 2011 Terminal Disclaimer.

On October 20, 2016, the Board instituted review of claims 1-13 of the '598 patent and claims 1-9, 11-19, and 21 of the '749 patent. *See* '921 IPR, Paper 6; '922 IPR, Paper 6. Specifically, in both cases, the Board determined that all of the claims were obvious over U.S. Patent No. 3,985,003 to Reed ("Reed") in combination with Nishida. *See id.*

In contrast, the Board denied institution of claims 1-38 of the '288 patent, stating that "we are not satisfied that the Petition provides adequate explanation or is appropriately precise and specific in articulating the basis of the proposed ground to warrant institution of an *inter partes* review on that ground." '920 IPR,

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Paper 6 at 5. Specifically, the ground that was not adopted was an obviousness combination based on Nishida (as the primary reference) with reference to Reed (for circular knitting), U.S. Patent No. 4,785,558 to Shiomura (for three layers), and U.S. Patent No. 6,779,369 to Shepherd (for showing Shiomura's three layers could be made on a circular knitting machine). *See* '920 IPR, Paper 6.

Upon receiving the Board's decision denying institution, and given the substantial overlap in subject matter of the '288 patent claims with the '598, '749, and '011 patent claims -- *where the Board had instituted inter partes review based on the same art* – Petitioner believed the only rational explanation was that the Board was unable to *substantively* evaluate the prior art or its applicability to the challenged claims. The Board seemed to particularly object to the ground as presented in the '920 petition because it not only included Nishida as the primary reference plus Reed, but also included Shiomura and Shepherd which were not being applied to all of the challenged claims. The Board specifically stated "[t]he noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the ground by the panel," which Petitioner understood to mean that the '920 petition had not been evaluated for substance. '920 IPR, Paper 6 at 7.

Petitioner thus prepared new grounds for presentation, *this time using Reed as the primary reference*. Rather than using the Board's denial of the '920 IPR

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petition for instruction on how to correct the petition, Petitioner followed the guidance of the two related and instituted petitions for the '598 and '749 patents, and presented new grounds in a manner that had previously been accepted by the Board. Thus, Petitioner separated the claims that did not recite multiple layers into a separate petition from those that arguably did, resulting in one ground challenging claims 1-7, 9-13, and 21-38 (the '264 IPR petition), and a separate ground and petition challenging claims 8 and 14-20. Both grounds are based on Reed as the primary reference in combination with Nishida, and the latter ground is also in combination with Shiomura to specifically show the teaching of a three-layered disclosure. Petitioner determined that Shepherd's additional disclosure regarding the three-layered circular knitting was not necessary in view of the new combination with Reed as the base reference. For both grounds, Petitioner provided additional explicit details regarding the location of each feature within the relevant reference, and supporting evidence in the form of new expert declarations. In order to comply with the rule change regarding word count, Petitioner filed each ground in separate petitions, namely the '264 IPR and IPR2017-00263 ("'263 IPR"). Petitioner also identified an additional ground of anticipation based on Nishida for claims 36-38 in the '264 IPR petition.

On June 7, 2017, the Board denied institution of the '263 IPR and '264 IPR petitions under 35 U.S.C. § 325(d), reasoning that (1) *the same or substantially the*

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same prior art or arguments previously were presented to the Office, (2) the public interest in having unpatentable claims canceled does not outweigh the chance that granting the petition may result in harassment of the patent owner, and (3) the change in rules between the '920 IPR and the '264 IPR was unpersuasive because the change was published before the '264 IPR filing. '264 IPR, Paper 9 at 7-10; *see also* '263 IPR, Paper 9 at 7-10.

II. STANDARD OF REVIEW

37 C.F.R. § 42.71(c) allows a party to request a rehearing on a decision by the Board on whether to institute a trial. When considering a motion for rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. *Id.* An abuse of discretion may be found if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

As is noted above, at issue in the present request for rehearing is the Board's reliance on 35 U.S.C. § 325(d) in denying institution. Section 325(d) provides:

> In determining whether to institute or order a proceeding . . . the Director may take into account whether, and reject the petition or

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request because, the same or substantially the same prior art or arguments previously were presented to the Office.

This provision does not itself prohibit filing subsequent petitions to challenge a given patent. The Board has repeatedly instituted *inter partes* review proceedings involving follow-on petitions where the prior petition was denied without substantive evaluation of the prior art or its applicability to the challenged claims. *See, e.g.*, *Arista Networks, Inc. v. Cisco Sys., Inc.*, No. IPR2016-00309, Paper No. 8, at p. 7 (PTAB June 11, 2016) (declining to exercise discretion under 35 U.S.C. § 325(d) in part because "[a]lthough Petitioner also challenged the independent claims based on a combination of Amara and Habraken [in Petitioner's prior petition], we did not address that ground substantively because we found it insufficiently articulated."); *Par Pharm., Inc. et al. v. Jazz Pharms., Inc.*, No. IPR2015-00546, Paper No. 25, at pp. 23-24 (PTAB July 28, 2015) (instituting IPR proceeding because "even assuming Petitioner asserts grounds that are identical to art and arguments presented in the earlier CBM cases, decisions denying institution in those cases do not address the merits of any ground raised in the Petitions."); *Coalition for Affordable Drugs (ADROCA) LLC v. Acorda Therapeutics, Inc.*, No. IPR2015-01853, Paper 13, at 12-13 (PTAB Mar. 11, 2016); *Apotex Inc. v. Wyeth LLC*, No. IPR2015-00873, Paper 8, at 10 (PTAB Sept. 16,

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2015); *Arris Grp., Inc. v. C-Cation Techs., LLC*, No. IPR2015-00635, Paper 19, at 8-9 (PTAB July 31, 2015).

III. ARGUMENT

The '264 IPR decision demonstrates an abuse of discretion in denying institution of the '264 IPR petition. First, in finding that the '264 IPR petition contains art and arguments that are "substantially the same" as those presented in the '920 IPR petition, the Board overlooks the fact that the petition features different grounds which rely on different base references, different combinations of secondary references, and provide markedly different arguments regarding obviousness. The '264 IPR petition even presents a new anticipation argument. Specifically, Petitioner relied upon the Board's institution decisions on related patents and relied on Reed as the primary reference for its obviousness challenge. Second, the decision represents an unreasonable judgment in weighing public interest and harrassment factors because it ignores the fact that the subject matter of the challenged claims of the '288 patent largely overlaps with other claims in the same family for which the Board already instituted review based on the same prior art. Public interest in addressing patentability of similar claims based on similar art and arguments is maximized, while potential for harrassment is minimized given on-going proceedings addressing similar art and issues.

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A. The Board Misapprehended that the '264 IPR Petition Contains Art and Arguments That Are Substantially the Same as Those in the '920 IPR Petition.

Substantial evidence does not support the Board's finding that the art and arguments presented in the '264 IPR petition are substantially the same as those in the '920 IPR petition. To the contrary, the arguments are materially different with respect to the primary references and the obviousness combinations presented, as well as the new anticipation argument.

1. The '264 IPR petition is based on a different primary reference.

As an initial matter, the primary reference upon which the '264 IPR petition relies, namely Reed, is merely used as a secondary reference in the '920 IPR petition. *Compare* '920 IPR, Paper 1 at 7 *with* '264 IPR, Paper 1 at 7. The Board apparently failed to identify this marked difference, as it re-ordered the references from what was provided in the '264 IPR petition (as correctly shown below)

Ground	35 U.S.C.	Claims	References
1	103(a)	1-7, 9-13, 21-38	Reed and Nishida
2	102(b)	36-38	Nishida

to the listing below, which indicates that Nishida is the primary reference. *Compare* '264 IPR, Paper 1 at 7 *with* '264 IPR, Paper 9 at 6-7. As further evidence that the Board misapprehended this difference, the Decision states that "Petitioner is challenging claims 36–38 of the '288 patent as anticipated by

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Nishida and claims 1–7, 9–13, and 21–38 as rendered obvious by the combined teachings of *Nishida and Reed*." '264 IPR, Paper 9 at 7 (emphasis added).

Reference(s)	Basis	Challenged Claim
Nishida and Reed	35 U.S.C. § 103(a)	1–7, 9–13, and 21–38
Nishida	35 U.S.C. § 102(b)	36–38

Id. at 5.

By misapprehending this key factual difference between the '920 IPR and the '264 IPR petitions, the Board reached a factual conclusion that is not supported by substantial evidence.

2. The '264 IPR petition presents significantly different arguments in making obviousness combinations.

In the '920 IPR Decision, the Board denied institution in part on the finding that the '920 IPR petition "cited to portions of Nishida for all features of [claim 1], and also submits parallel citation in some cases to portions of Reed. The Petition does not provide adequate explanation as to what features adidas contends are absent from Nishida that it also must rely on content of Reed to meet the challenged claims." '920 IPR, Paper 6 at 6.

In contrast, the '264 IPR petition contains no such arguments premised on multiple, alternative combinations of Nishida and Reed, Shiomura, and Shepherd. Instead, in addressing the same limitations, the '264 IPR petition states the features found in Reed and the features from Nishida that would have been obvious to

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combine with Reed. As just one example, for element [1B.1], the '264 IPR petition states:

> Reed describes that the textile element is circular-knitted. (Ex. 1003, ¶89-90.) To the extent that Reed does not explicitly state that the circular-knitted textile element can be used to form an upper for an article of footwear, Nishida describes using conventional textile processes, such as weaving and/or knitting and/or embroidering, and program-controlled web of material production devices to form a textile structure with a single or a plurality of textile elements in the shape of a shoe upper. (Ex. 1003, ¶91-92.) The POSA would have understood that circular knitting is a conventional textile process. (Ex. 1003, ¶91.)

'264 IPR, Paper 1 at 14-15.

Moreover, by beginning with Reed as the primary reference instead of Nishida, the POSA's motivation to combine the references is presented differently. These distinct differences are described in detail in each petition. *Compare* '920 IPR, Paper 1 at 11-13 *with* '264 IPR, Paper 1 at 11-13.

As a result, Petitioner presented arguments in the '264 IPR petition that substantially differ from those presented in the '920 IPR petition. Therefore, substantial evidence does not support the Board's contrary finding.

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3. The Board's Determination that It had Substantively Evaluated the Arguments in the '920 IPR Petition is Contradicted.

In denying the '264 IPR petition, the Board states that it evaluated the arguments and evidence presented in the previously denied '920 IPR petition. The Board relies on the single statement in the Conclusion of the '920 IPR Decision, stating "*[h]aving evaluated the Petition*, we determine that [Petitioner] has not shown a reasonable likelihood of success in any of its challenges to claims 1-38 of the '288 patent." '264 IPR, Paper 9 at 8 (quoting '920 IPR, Paper 6 at 8) (emphasis and alterations in original). However, this statement is contradicted by the Board's substantive discussion in the '920 IPR Decision of the grounds presented that states the "noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the ground by the panel . . . Accordingly, we deny the ground and do not institute *inter partes* review based on that ground." '920 IPR, Paper 6 at 7.

In denying the '264 IPR petition, the Board stated that it may not have been able to fully evaluate the evidence and arguments in the petition due to vagueness in the presentation, but such vagueness should not benefit the Petitioner. '264 IPR, Paper 9 at 8. However, here Petitioner has not sought any such benefit. Rather, as explained above, Petitioner chose a different route in the '264 IPR petition,

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premised on a different ground that had already been deemed acceptable to the Board.

4. The Board's Decision to Deny Institution is Inconsistent with Previous Board Decisions.

As explained above, the Board has repeatedly instituted *inter partes* review proceedings involving follow-on petitions under similar circumstances. For example, in *Arista Networks, Inc. v. Cisco Sys., Inc.*, No. IPR2016-00309, Paper 8 (PTAB June 11, 2016), the Board declined to exercise its discretion under 35 U.S.C. § 325(d). In the facts of that proceeding, the Board had previously denied a petition filed by petitioner Arista asserting 5 different references which resulted in 8 separate grounds. *Arista Networks, Inc. v. Cisco Sys., Inc.*, No. IPR2015-00974, Paper 7 (PTAB Oct. 6, 2015). Arista argued the challenged claims were anticipated by Amara and raised seven additional grounds of obviousness, all based on Amara as the principle reference. *See id.* at 6. In denying the petition, the Board provided a detailed analysis of Arista's anticipation arguments based on Amara, and specifically pointed out where Amara's disclosure was lacking. *Id.* at 7-14. However, with respect to several of the obviousness grounds which were based on various combinations of Amara with secondary references Habraken, Modberg, Subramanian and Hendel, the Board determined "that the Petition does not identify with sufficient particularity the ground on which the challenge to the independent claims is based." *Id.* at 15-16. The Board concluded that the "Petition, therefore,

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fails to identify with sufficient specificity the differences between the claimed invention and the prior art." *Id.* at 17.

The Board was later presented with a follow-on petition from Arista that presented four separate obviousness grounds, each based on Amara as the principle reference. IPR2016-00309, Paper No. 8, at p. 6. This new petition filed by Arista only replaced one of the original five references, Habraken, but included Modberg, Subramanian and Hendel. *Id.* When urged by the patent owner to deny the petition under § 325(d) (the third petition filed by the same petitioner related to the same patent), the Board stated "we are not persuaded that Petitioner's arguments based on the combination of Amara and CoreBuilder are the same or substantially the same as those previously presented because we have not previously addressed substantively a challenge… based on obviousness over Amara." *Id.* at 7.

In the present case, much like in *Arista*, the Board stated that the '920 IPR petition, which challenged claims 1-38 as obvious based on Nishida as a primary reference, "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, [Petitioner] identifies the limitations of the claim in the prior art." '920 IPR, Paper 6 at 5. Nevertheless, when presented with a new obviousness argument in the '264 IPR petition challenging only claims 1-7, 9-13, and 21-38 based on Reed as the primary reference in combination with Nishida, and claims 36-38 based on anticipation by Nishida alone, the Board exercised its

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discretion under § 325(d), denying the petition and departing from its reasoning in *Arista,* despite never having previously addressed obviousness over Reed or anticipation by Nishida.

B. The Board's Determination That Public Interest In Having Unpatentable Claims Canceled Does Not Outweigh Concern Over Patent Owner Harassment Represents An Unreasonable Judgment in Weighing Relevant Factors.

As described above, practically every recited feature of the challenged claims can be found in one or more claims of the '598, '749, and '011 patents, where the Board has instituted *inter partes* review.

As *Polygroup Ltd. v. Willis Elec. Co., Ltd.*, No. IPR2016-00801 determined, reviewing a follow-on petition where the Board had instituted a separate review proceeding between the same parties on the same or similar grounds for similar claims of a different patent is especially appropriate. IPR2016-00801, Paper 8. That is because "the parties and the Board are already committed to reviewing the issues raised herein, and there is little additional burden to do so here" and "it strikes us as inefficient, from a global perspective, for the Board to decide issues in [the related IPR proceeding] and for a district court to decide the same issues with respect to the [patent challenged in the follow-on petition]." *Id.* at 16.

This rationale squarely applies here. By denying institution of the '288 patent, the Board gives insufficient weight to the public interest in having unpatentable claims canceled – a particularly appropriate factor where the Board

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has, in the context of the '921 and '922 IPRs, done much of the work needed to determine the unpatentability of these claims based on this combination of prior art that uses Reed as a primary reference.

The Decision acknowledges that "it is in the public interest that unpatentable claims are cancelled." '264 IPR, Paper 6 at 8-9. Should the Board deny reconsideration, this interest will be frustrated, despite the already existing investment of party and public resources in addressing patentability of similarly claimed subject matter. Petitioner respectfully submits that the Board committed an error in judgment in finding these considerations outweighed by other factors. Accordingly, Petitioner requests that the Board reconsider its decision to deny institution of the '264 IPR petition.

IV. CONCLUSION

For the foregoing reasons, Petitioner adidas AG respectfully requests that the Board grant this request for rehearing.

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of **PETITIONER ADIDAS AG'S REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71 ON THE DECISION NOT TO INSTITUTE *INTER PARTES* REVIEW** has been served on July 7, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

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Dated: July 7, 2017

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adidas AG (Petitioner) v. NIKE, Inc. (Patent Owner)

IPR2016-00921 (U.S. Patent 7,814,598)

IPR2016-00922 (U.S. Patent 8,266,749)

Petitioner's Demonstratives

United States Patent Trial and Appeal Board

July 12, 2017

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Instituted Grounds of Unpatentability

Claims – 598 Patent	Prior Art
1-13	Reed + Nishida

Claims – 749 Patent	Prior Art
1-9, 11-19, and 21	Reed + Nishida

IPR2016-00921, Institution Decision, Paper 6, at 20.
IPR2016-00922, Institution Decision, Paper 6, at 21.

U.S. Patent No. 3,985,003 to Reed

- Reed discloses a method of manufacturing a wearable item, which includes, among other things,
  - Mechanically manipulating a yarn with a circular-knitting machine to form a cylindrical textile structure with textile elements located in different portions of the textile structure;
  - Removing the textile elements from the textile structure; and
  - Incorporating the textile elements "to form all types of garments worn by men, women, and children."

IPR2016-00921, Institution Decision, Paper 6, at 12 (citing Ex. 1006, 1:33-35, 2:22-25, 2:29-31, 3:12-19, 5:56-58, 5:67-6:5).
IPR2016-00922, *id.*

Reed's Textile Element Is Formed by Interknitting Two Circular Knitted Tubes to Form a Pattern Outline

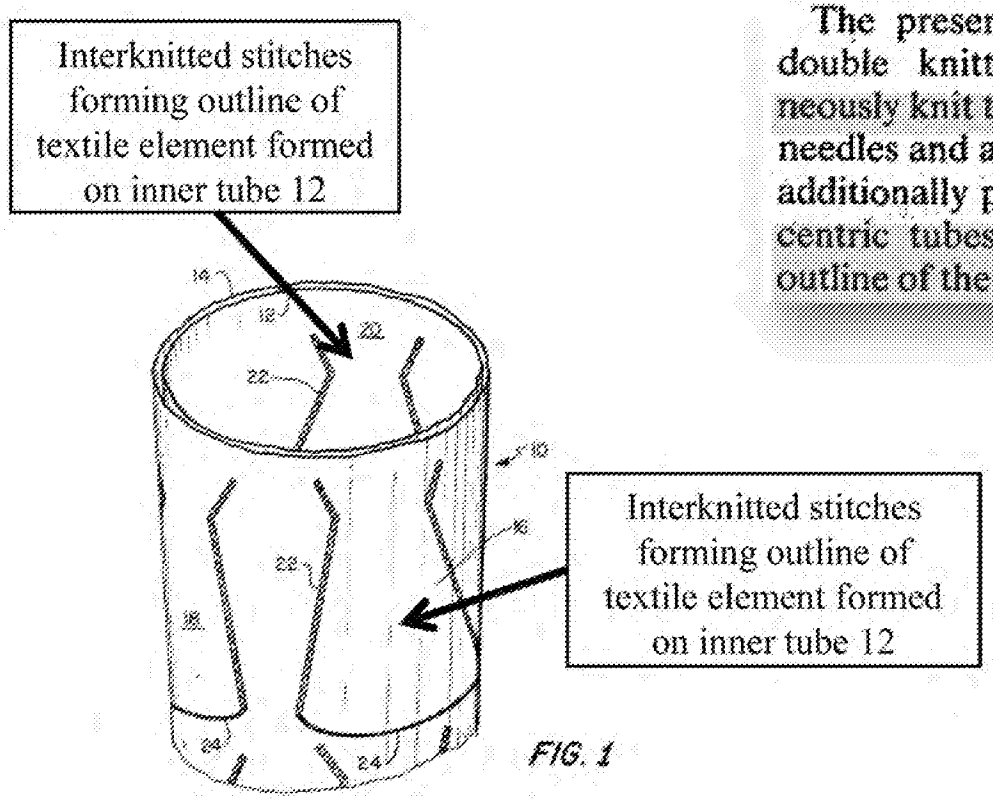


FIG. 1

The present invention uses an electronic circular double knitting machine programmed to simultaneously knit two concentric tubes, one on the dial set of needles and a second on the cylinder set of needles and additionally programmed to interconnect the two concentric tubes by a knit interlock stitch to form the outline of the design of a garment.

IPR2016-00921, IPR Petition, Paper 1, at 14-15 (citing Ex. 1006, 1:58-64, FIG. 1; Ex. 1003, ¶ 98).
IPR2016-00922, *id.*

Reed's Textile Element May be Removed by Cutting Along an Interknitted Stitch Outline

The garments **16, 18** and **20** are outlined by a plurality of interconnecting knitted stitches **22** and **24.** The interconnecting knitting **22** not only forms the outline of the garments **16, 18** and **20,** but joins the inner tube **12** to the outer tube **14** so as to create a seam. The interconnecting knitting **24** is merely to define the lower outline of the skirt upon which the pattern may be cut.

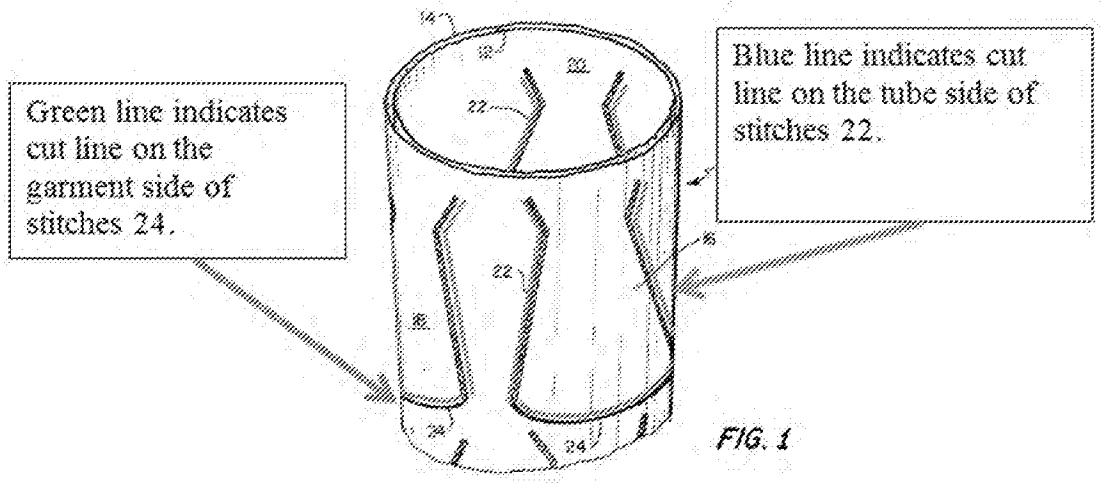


FIG. 1

IPR2016-00921, Petitioner's Reply, Paper 10, at 17 (citing Ex. 1006, 3:9-15, FIG. 1; Ex. 1003, ¶ 103).
IPR2016-00922, Petitioner's Reply, Paper 10, at 16-17 (citing *id.*).

U.S. Patent No. 5,345,638 to Nishida

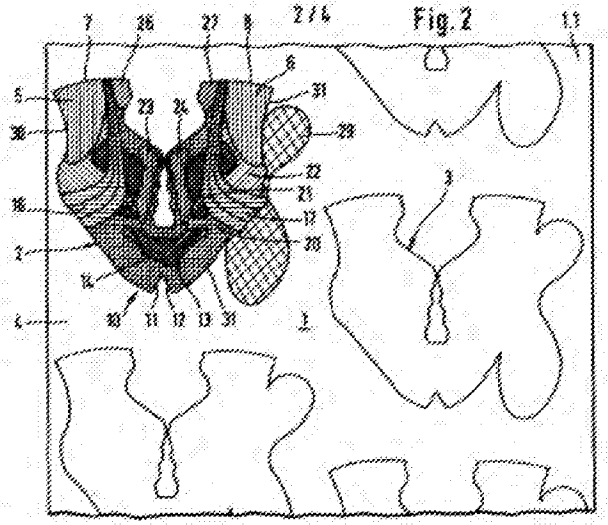
- Nishida discloses production of a shoe upper by
  - Cutting out a layout in the form of the shoe upper from a web of material and;
  - Shaping the shoe upper by connecting material parts of the layout.

IPR2016-00921, Institution Decision, Paper 6, at 14-15 (citing Ex. 1009, Abstract).
IPR2016-00922, *id.*

Nishida's Textile Element Is Formed by Knitting a Web of Material with a Layout

In FIGS. **1** and **2**, a web of material is identified by **1**, and is produced by a conventional textile process, tier example, by weaving and/or knitting and/or embroidering.

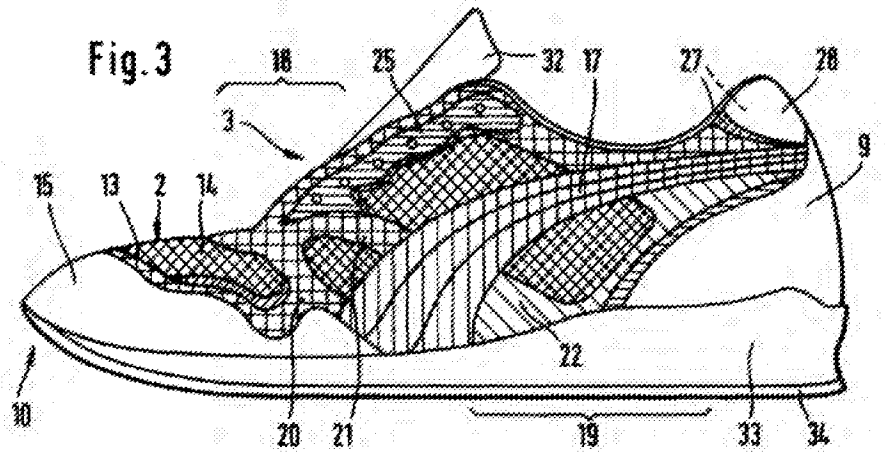
in the production of a web of material, both the patterns or partial patterns in the form of layouts of the shoe upper and the patterns or partial patterns in the form of a sole part, are produced by a fabric printing process (which is generally well known in the textile industry) on the web of material and/or by a textile production process inside the web of material;



IPR2016-00921, IPR Petition, Paper 1, at 15, 19 (citing Ex. 1009, 1:50-56, 3:6-9, Ex. 1003, ¶¶ 96, 113).
IPR2016-00922, IPR Petition, Paper 1, at 21-22 (citing *id.*).

Nishida's Cut-Out Textile Element is Shaped into a Shoe Upper

This invention relates to a process for the production of a shoe shaped part using a web of material with a plurality of patterns in the form of the layout of a shoe upper, cutting out these layouts from the web of material and stitching the parts of the shoe upper to a top part, and fastening the related part of the sole to the edge area of the cut-open outside edge of the assigned layout and to a shoe shaped part produced according to this process.



IPR2016-00921, IPR Petition, Paper 1, at 16 (citing Ex. 1009, 1:10-18, FIG. 3).
IPR2016-00922, IPR Petition, Paper 1, at 18-19 (citing *id.*).

Overview of Issues

- Level of Ordinary Skill in the Art
- Scope & Content of Reed & Nishida
- Motivation to Combine Reed & Nishida
- Weight Given to Mr. Holden's Unrebutted Testimony

IPR2016-00921, Owner's Response, Paper 9, at 3-4.
IPR2016-00922, *id.*

POSITA Has Several Reasons To Combine Reed and Nishida

	Reed	Nishida
Reed's application to garments suggests use for footwear.	The present invention may be used to form all types of garments worn by men, women and children - including underwear, outerwear and even full-fashion hosiery. Circular knitting machines have been used to make tubular, knitted garments, such as ladies' stockings, sweaters and other garments.	This invention relates to a process for the production of a shoe shaped part using a web of material with a plurality of patterns in the form of the layout of a shoe upper, cutting out these layouts from the web of material and stitching the parts of the shoe upper to a top
Reed's method of making textile elements is similar to Nishida's method of making layouts	Still another object is to provide a method for producing a plurality of garments formed about the circumference of a knitted tube. The present invention uses an electronic circular double knitting machine programmed to simultaneously knit two concentric tubes.	In FIGS. 1 and 2, a web of material is identified by 1, and is produced by a conventional textile process, tier example, by weaving and/or knitting and/or embroidering. The web of material 1 can be provided with a single or with a plurality of layouts 2 of the shape of a shoe upper 3, as it is represented from the side, for example, in FIG. 3.
Reed & Nishida recognize cost/waste reduction through computerized knitting.	Another object of the present invention is to provide a method of reducing the cost of manufacturing of garments by using the versatility of a computerized electronic knitting machine.	It is of further advantage in the process according to the present invention that the individual patterns or partial patterns already can be produced directly in the production of the web of material in the desired shoe size, by which the cutting waste can be still further limited, since the individual patterns or partial patterns in the provided size can directly adjoin one another. As already indicated, any sizes and different upper designs can be produced by computer-controlled programs, starting from corresponding basic Here, there is no question that skilled artisans knew of the desire to reduce waste when producing wearable, knitted shoe uppers because that problem is expressly recognized in Nishida.

POSITA Has Several Reasons To Combine Reed and Nishida

	Reed	Nishida
Reed's application to garments suggests use for footwear.	IPR2016-00921, Petitioner's Reply, Paper 10, at 12 (citing Ex. 1006, 5:56-57); IPR2016-00922, *id.* IPR2016-00921, IPR Petition, Paper 1, at 12 (citing Ex. 1006, 1:33-35); IPR2016-00922, *id.*	IPR2016-00921, IPR Petition, Paper 1, at 12 (citing Ex. 1009, 1:10-14); IPR2016-00922, IPR Petition, Paper 1, at 11 (citing *id.*).
Reed's method of making textile elements is similar to Nishida's method of making layouts	IPR2016-00921, Petitioner's Reply, Paper 10, at 6, 11 (citing Ex. 1006, 1:58-60, 2:29-31); IPR2016-00922, *id.*	IPR2016-00921, Petitioner's Reply, Paper 10, at 12 (citing Ex. 1009, 3:6-11); IPR2016-00922, *id.*
Reed & Nishida recognize cost/waste reduction through computerized knitting.	IPR2016-00921, Petitioner's Reply, Paper 10, at 11 (citing Ex. 1006, 2:22-25); IPR2016-00922, *id.*	IPR2016-00921, Petitioner's Reply, Paper 10, at 10, 12 (citing Ex. 1009, 2:27-33, 4:53-55; *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1338 (Fed. Cir. 2016)); IPR2016-00922, *id.*

It is Undisputed that the Reed/Nishida Combination Teach All Elements of 598 Patent, Claims 1 and 9

[1A], [9A] A method of manufacturing an article of footwear, the method comprising steps of:	✓
[1B], [9B] mechanically-manipulating a yarn with a wide-tube circular knitting machine to form a cylindrical textile structure having an outline of at least one textile element;	✓
[1C], [9C] removing at least one textile element from the textile structure; and	✓
[1D], [9D] incorporating the textile element into an upper of the article of footwear.	✓

IPR2016-00921, IPR Petition, Paper 1, at 14-16, 19-20.

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It is Undisputed that the Reed/Nishida Combination Teach All But One Element of 749 Patent, Claims 1 and 13

[1A], [13A] A method of manufacturing an article of footwear, the method comprising:	✓
[1B], [13B] simultaneously knitting a first textile element and a second textile element simultaneously with knitting a surrounding textile structure,	✓
[13C] the first knitted textile element located within a first portion of the knitted textile structure, the second knitted textile element located within a second portion of the knitted textile structure,	✓
[1C], [13E] removing the first and second knitted textile elements from the surrounding knitted textile structure; and	✓
[1E], [13F] incorporating at least one of the first and second knitted textile elements into an upper of the article of footwear.	✓

IPR2016-00922, IPR Petition, Paper 1, at 13-19, 20-21.

Owner Only Disputes Whether the Reed/Nishida Combination Discloses "Texture" Element of 749 Patent, Claims 1 and 13

[1C], the knitted textile element having at least one knitted texture that differs from a knitted texture in the surrounding knitted textile structure;
[13D] varying at least one of the types of stitches or the types of yarns in the knitted textile structure to impart a texture to the first and second knitted textile elements different from a texture of the knitted textile structure extending between the first and second portions;

***Underlined text are the only features that Owner relies on to distinguish 749 Patent, claims 1 and 13 from the Reed/Nishida combination.**

IPR2016-00922, Owner's Response, Paper 9, at 50-55.

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Owner Disputes Whether the Reed/Nishida Combination Discloses "To Impart" or "Forming Apertures" Features of Dependent Claims

598 Patent, [4], [11] The method recited in claim 1 9, wherein the step of mechanically manipulating

- includes forming the textile element to include a first area and a second area with a unitary construction,
- the first area being formed of a first stitch configuration, and
- the second area being formed of a second stitch configuration that is different from the first stitch configuration <u>to impart varying textures</u> to a surface of the textile element.

749 Patent, [11], [21] The method of claim 1 13, wherein simultaneously knitting a the first knitted textile element simultaneously with a surrounding knitted textile structure

- includes forming the first knitted textile element to include a first area and a second area with a unitary construction,
- the first area being formed of a first stitch configuration, and
- the second area being formed of a second stitch configuration that is different from the first stitch configuration <u>to impart varying textures</u> to a surface of the first knitted textile element.

598 Patent, [6] The method recited in claim 1, wherein the step of mechanically manipulating includes <u>forming apertures</u> in the textile element.

***<u>Underlined</u> text are the only features that Owner relies on to distinguish 598 Patent, dependent claims 4, 6, and 11, and 749 Patent, dependent claims 11 and 21 from the Reed/Nishida combination.**

IPR2016-00921, Owner's Response, Paper 9, at 45-55.
IPR2016-00922, Owner's Response, Paper 9, at 55-58.

Mr. Holden Provided His Understanding of the Level of Ordinary Skill in the Art

34. In my opinion, the person of ordinary skill in the art for the Nike patents would have at least a few years of experience in the footwear industry, possibly with a focus in one specific area (such as merchandising, design, product development, commercialization, and/or manufacturing), but would also have a broader understanding of shoemaking in general, as all aspects are so interdependent on each other. A person of ordinary skill would have an understanding of the product cycle for the process of designing, developing, and bringing a new product to market. He or she would also understand that there are some key review milestones where upper material designs are reviewed and considered, such as textiles, leathers, synthetics, or other types of materials used for upper construction. A person of ordinary skill would have some understanding and knowledge of the available and varied ranges of typical construction methods within a product cycle. In addition, a person of ordinary skill would have a basic knowledge of the functional requirements of footwear and a comprehensive understanding of the range of material choices, as well as construction techniques and processes used to create the various parts of a shoe and to assemble them in an effective manner.

IPR2016-00921, IPR Petition, Paper 1, at 8-9 (citing Ex. 1003, ¶ 34).
IPR2016-00922, IPR Petition, Paper 1, at 8 (citing *id.*).

Level of Ordinary Skill in the Art is Not Low

- Owner's 598 Response at 13 and 749 Response at 16-17 incorrectly asserts that "a few years of experience in the footwear industry" shows the level of ordinary skill is "low."

> In doing so, Petitioner concedes the level of ordinary skill was low, stating that a person of ordinary skill would have only "a few years of experience in the footwear industry." (*Id.*)

- But Mr. Holden testified that *at least* a few years of experience is needed to gain a well-rounded range of knowledge and understanding of:
  - Shoemaking;
  - Product design;
  - Upper material designs; and
  - Construction techniques and processes.

IPR2016-00921, Petitioner's Reply, Paper 10, at 2 (citing Ex. 1003, ¶ 34; Ex. 2004, 129:1-18).
IPR2016-00922, *id.*

Level of Ordinary Skill in the Art is Not Low

- Owner's Expert provided a similar definition in IPR2013-00067 for the parent of the 598 & 749 patents:

> 52. It is my opinion that a person of ordinary skill in the art (POSITA) at the time of the invention for the '011 Patent would have a few years of experience with design and development of footwear and knowledge of textiles used in such footwear. For purposes of this proceeding, I have assumed that the invention date is around the filing date of the '011 application, *i.e.*, March 2004.

IPR2016-00921, Petitioner's Reply, Paper 10, at 2 (citing IPR2013-00067, Ex. 2010, ¶ 52).
IPR2016-00922, *id.*

Level of Ordinary Skill in the Art Does Not Require Hands-On Knitting Machine Experience

- Level of skill does not require operating machinery.

Mr. Holden

A. I consider knitting to be one of the many types of materials that I've been exposed to over a 30-plus career, and I've looked at thousands of knitting applications and -- and machinery and factories. My primary expertise is footwear.

I understand how they work. I understand the capabilities and the evolving capabilities of any of these industries, but it would be dangerous and unacceptable for me to try to attempt to run machinery, to program machinery, to do any of those type of operations at manufacturers who do any of the technologies you mentioned before, but also any of the technologies that I work with.

Owner's Expert in IPR2013-00067

A. I'm sure I have at one point. I'm not totally positive, but I've seen many machines. I've never spent a lot of time at them -- with them, but I've been in a lot of factories. So I never spent time watching necessarily the fabric being produced, but I've probably seen a machine for this type of knitting.

IPR2016-00921, Petitioner's Reply, Paper 10, at 2-3 (citing Ex. 2004, 72:18-25; IPR2013-00067, Ex. 1015, 38:18-23).
IPR2016-00922, *id.*

Petitioner Properly Analyzed the Full Scope of Reed

- Owner's 598 Response at 19 and 749 Response at 24 asserts that Reed's description of the "present invention" limits Reed to preseamed garments, citing inapposite cases holding that claim scope disavowal is assessed for purposes of claim construction.
- For analyzing prior art, the rule is that: "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck,* 699 F.2d 1331, 1332-33 (Fed. Cir. 1983)).
- Reed, in fact, discloses both finished, preseamed garments and post-seamed garments (e.g., lined garments).

IPR2016-00921, Petitioner's Reply, Paper 10, at 6-7 (citing Ex. 1006, 1:64-2:1, 3:61-4:8, 6:10-17; Ex. 2004, 141:13-20, 142:2-17, 143:15-21; Ex. 1003, ¶¶ 105, 117).
IPR2016-00922, *id.*

Reed is Not Limited to Exclusively Preseamed Embodiments

- Reed describes at least two embodiments:
  - "Finished garment" embodiments, in which the preseamed sides may eliminate the need for further seaming and assembly.
  - "Lined garment section" embodiments, in which conventional assembly and seaming is still needed to achieve a finished garment.

IPR2016-00921, Petitioner's Reply, Paper 10, at 6-7 (citing Ex. 1006, 1:64-2:1, 3:61-4:8, 6:10-17; Ex. 2004, 141:13-20, 142:2-17, 143:15-21; Ex. 1003, ¶¶ 105, 117).
IPR2016-00922, *id.*

Reed's "Finished Garment" Embodiment

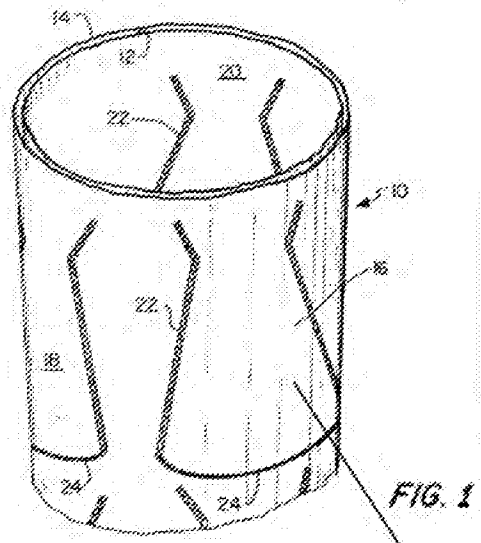
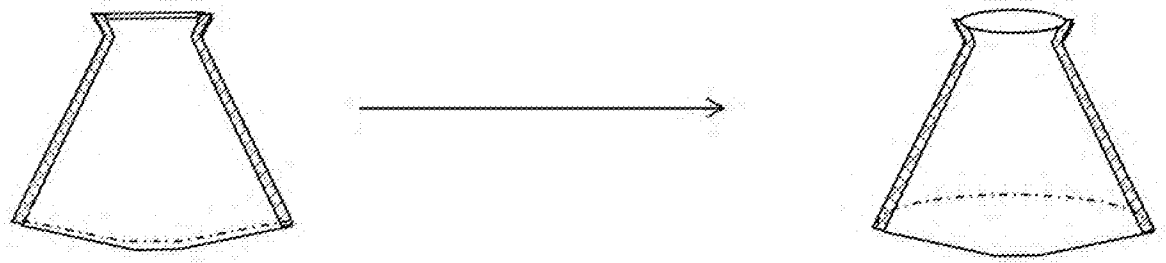
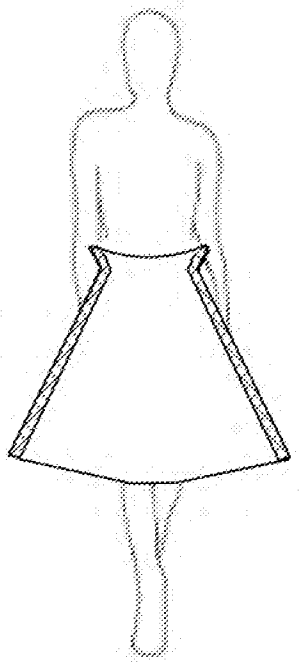


FIG. 1

The resulting knitted structure will have two layers of single fabric knitted or seamed together in the shape of the desired garment wherein the anatomy of the user would fit between the single knitted fabrics instead of in the center of the tubes.





IPR2016-00921, Petitioner's Reply, Paper 10, at 6 (citing Ex. 1006, 1:64-2:1, FIG. 1; Ex. 2004, 142:2-17).
IPR2016-00922, *id.*

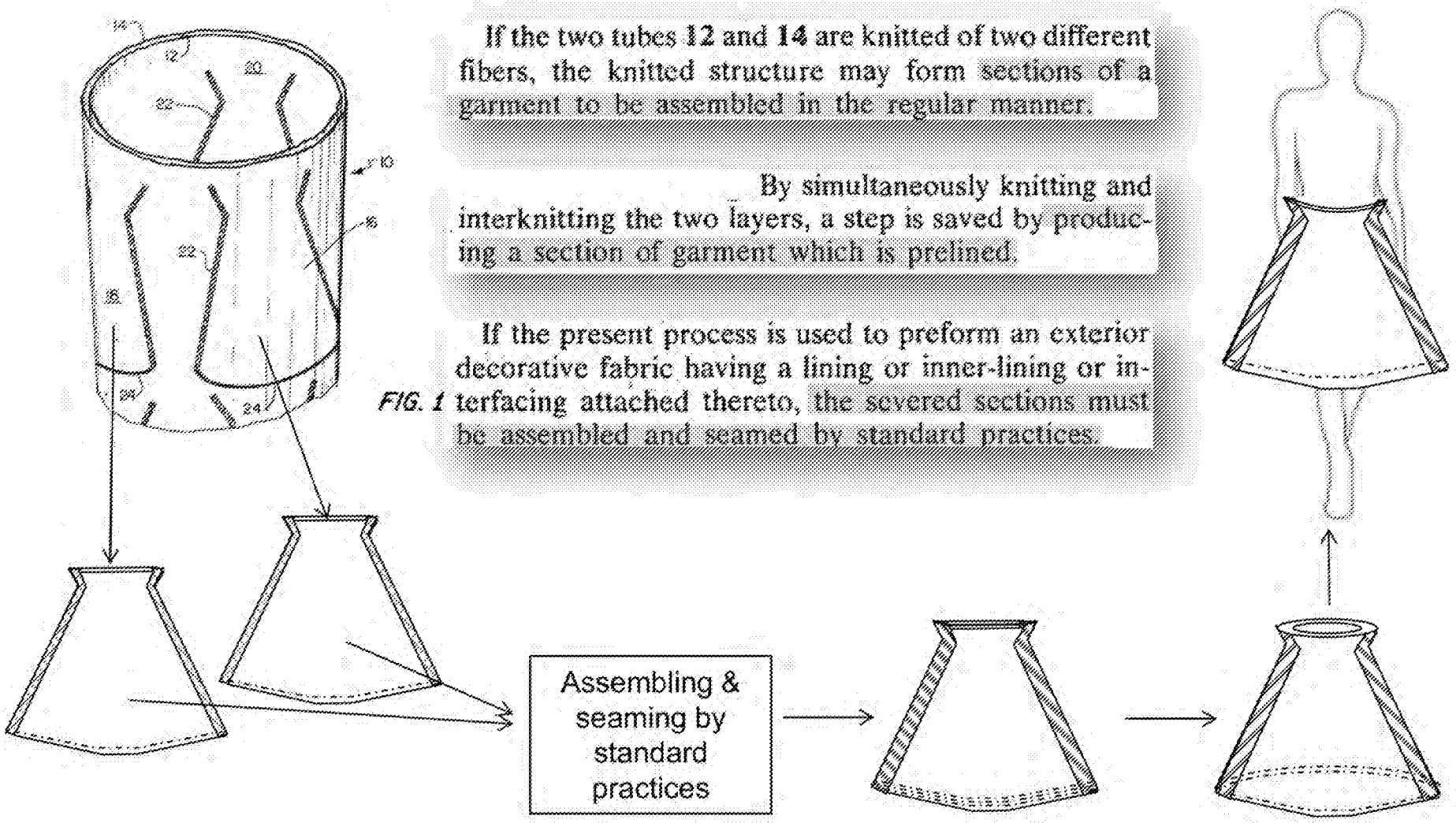
Reed's "Lined Garment Section" Embodiment

If the two tubes **12** and **14** are knitted of two different fibers, the knitted structure may form sections of a garment to be assembled in the regular manner.

By simultaneously knitting and interknitting the two layers, a step is saved by producing a section of garment which is prelined.

If the present process is used to preform an exterior decorative fabric having a lining or inner-lining or interfacing attached thereto, the severed sections must be assembled and seamed by standard practices.

FIG. 1



IPR2016-00921, Petitioner's Reply, Paper 10, at 6-7 (citing Ex. 1006, 3:61-64, 3:66-68, 6:10-13, FIG. 1), Ex. 2004, 141:13-20, 143:15-21; Ex. 1003, ¶¶ 105, 117).
IPR2016-00922, *Id.*

Petitioner Properly Analyzed the Full Scope of Nishida

- Owner's 598 Response at 23-24 and 749 Response at 28-29 asserts that Nishida's description of the "primary object of this invention" being "to further develop" the previously known process for making shoe parts described in German Patent No. 627 878 limits Nishida to "printing or producing layouts on the preexisting backing, just like the German Patent," but has provided no authority to support its position.
- "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33 (Fed. Cir. 1983).

IPR2016-00921, Petitioner's Reply, Paper 10, at 8.
IPR2016-00922, *id.*

Owner's Varied Characterizations of Nishida

- In the 598 and 749 Patent IPR proceedings and the 749 Patent prosecution:

> Nishida teaches achieving that objective by producing a web of material just like in the German Patent. (Ex. 1009, 1:48-2:53.) The web of material has two primary components – a preexisting backing and one or more layouts printed or produced on the backing. (*Id.*, 1:40-2:53 and 3:6-26.) The backing is formed prior to the production of the layouts. (*Id.*)

- In IPR2013-00067 (parent of the 598 and 749 Patents):

> Nishida's "layout" is surrounded by a textile structure from which it must be removed.

- In the 749 Patent IPR proceeding:

> When read in context, that portion of Nishida does not provide that the layouts and the area surrounding the layouts are simultaneously formed, but rather it describes an embodiment where there are no surrounding areas at all because the layouts occupy the entire web of material. (Ex. 1009, 2:27-33.)

IPR2016-00921, Petitioner's Reply, Paper 10, at 8-9 (citing IPR2016-00922, Ex. 1002, 1/13/2012 Response, pp. 6-8; IPR2013-00067, Paper 31, pp. 6-7; IPR2016-00922, Owner's Response, Paper 9, at 53).
IPR2016-00922, *id.*

Nishida Describes a Layout Produced On a Web of Material or Inside a Web of Material

> in the production of a web of material, both the patterns or partial patterns in the form of layouts of the shoe upper and the patterns or partial patterns in the form of a sole part, are produced by a fabric printing process (which is generally well known in the textile industry) on the web of material and/or by a textile production process inside the web of material;

- Owner's 598 Response at 25 and 749 Response at 29 incorrectly replaces "inside" with "onto" when describing the textile production process.

> The layouts are printed (with a fabric printing process) or produced (with a textile production process) onto the preexisting backing. (*Id.*, 1:50-56; 2:20-26, 3:13-15, and 5:45-52.)

IPR2016-00921, Petitioner's Reply, Paper 10, at 9 (citing Ex. 1009, 1:50-56).
IPR2016-00922, *id.*

Nishida Describes Simultaneously Producing a Web of Material and a Layout Inside the Web of Material

In FIGS. **1** and **2**, a web of material is identified by **1**, and is produced by a conventional textile process, tier example, by weaving and/or knitting and/or embroidering.

For this purpose, a web of material (**1**) is used to produce layouts (**2**) by different production measures, such as different styles, yarn material, color, material thickness, single layer or multilayer type of material or the like, at the same time with the production of web of material (**1**),

in the production of a web of material, both the patterns or partial patterns in the form of layouts of the shoe upper and the patterns or partial patterns in the form of a sole part, are produced by a fabric printing process (which is generally well known in the textile industry) on the web of material and/or by a textile production process inside the web of material;

IPR2016-00921, Petitioner's Reply, Paper 10, at 8-10, 12 (citing Ex. 1009, Abstract, 1:50-56, 3:6-9).
IPR2016-00922, *id.*

Mr. Holden Confirmed that Nishida Describes Simultaneously Producing a Layout With a Web of Material

98. Reed and Nishida describe that one or more textile elements are formed simultaneously with the surrounding textile structure.

100. Similarly, Nishida states that "[a]s can be seen, ***any number of layouts 2 in the most varied configurations and/or designs as well as of different sizes can be produced on a single web of material 1***. For this purpose, above all, ***the use of program-controlled, particularly computer-controlled, production devices is advantageous***, so that style, color, design, size or the like can be varied at will." Nishida, 4:12-18 (emphasis added); *see also* 2:40-41; 4:53-54; 5:64-65.

101. Nishida goes on to explain that "***only just those parts of the web of material*** are ***produced*** in the necessary quality, thickness, multilayers or the like ***which correspond to the pattern or to an area of a pattern of the shoe upper or the related shoe part***. The ***remaining area of the web of material*** in contrast can consist of a simple, lightweight or inexpensive material quality, which ***holds together only the patterns or areas of such patterns in the web of material*** after their completion." Nishida, 2:12-20 (emphasis added); *see also* Abstract; 1:40-2:5; 2:11-2:25; 2:40-54; 3:6-26; 3:43-58; 3:59-4:9; 4:11-18; 4:47-55; 5:27-40; 5:45-6:2.

IPR2016-00921, Petitioner's Reply, Paper 10, at 9-10 (citing Ex. 1009, 2:12-20; Ex. 1003, ¶ 101); IPR Petition, Paper 1, at 14, 19 (citing Ex. 1003, ¶¶ 98, 100--101);
IPR2016-00922, Petitioner's Reply, Paper 10, at 9 (citing Ex. 1009, 2:12-20; Ex. 1003, ¶ 101); IPR Petition, Paper 1, at 13 (citing Ex. 1003, ¶¶ 98, 100-101).

POSITA Has Several Reasons To Combine Reed and Nishida

	Reed	Nishida
Reed's application to garments suggests use for footwear.	The present invention may be used to form all types of garments worn by men, women and children - including underwear, outerwear and even full-fashion hosiery. Circular knitting machines have been used to make tubular, knitted garments, such as ladies' stockings, sweaters and other garments.	This invention relates to a process for the production of a shoe shaped part using a web of material with a plurality of patterns in the form of the layout of a shoe upper, cutting out these layouts from the web of material and stitching the parts of the shoe upper to a top
Reed's method of making textile elements is similar to Nishida's method of making layouts	Still another object is to provide a method for producing a plurality of garments formed about the circumference of a knitted tube. The present invention uses an electronic circular double knitting machine programmed to simultaneously knit two concentric tubes.	In FIGS. 1 and 2, a web of material is identified by 1, and is produced by a conventional textile process, tier example, by weaving and/or knitting and/or embroidering. The web of material 1 can be provided with a single or with a plurality of layouts 2 of the shape of a shoe upper 3, as it is represented from the side, for example, in FIG. 3.
Reed & Nishida recognize cost/waste reduction through computerized knitting.	Another object of the present invention is to provide a method of reducing the cost of manufacturing of garments by using the versatility of a computerized electronic knitting machine.	It is of further advantage in the process according to the present invention that the individual patterns or partial patterns already can be produced directly in the production of the web of material in the desired shoe size, by which the cutting waste can be still further limited, since the individual patterns or partial patterns in the provided size can directly adjoin one another. As already indicated, any sizes and different upper designs can be produced by computer-controlled programs, starting from corresponding basic Here, there is no question that skilled artisans knew of the desire to reduce waste when producing wearable, knitted shoe uppers because that problem is expressly recognized in Nishida.

See Slide 11.

Mr. Holden Confirmed that Reed's Discussion of Garments Suggests Use for Footwear

131. Reed's explicit statement that "[t]he present invention may be used to form all types of garments worn by men, women and children" (Reed, 5:56-57) in combination with Reed's explicit reference to the fact that footwear items, such as stockings, were conventionally knit with circular knitting machines (Reed, 1:33-44), would have suggested to a person of ordinary skill in the relevant art at least as of March 3, 2004 that Reed's process could be used to form all types of articles of clothing including footwear, particularly since "clothing" is understood to refer to all things that people wear to cover their bodies. Specifically, the skilled person would have understood Reed's reference to "all types of garments" to include tops, pants, shorts, skirts, dresses, suits, outerwear, underwear, footwear, headwear, nightwear, swimwear, and accessories (such as headbands, scarves, bandanas, handkerchiefs, neckties, gloves, cummerbunds, etc.).

132. With this understanding, the skilled person would have been motivated to use Reed's process to produce textile elements for all types of clothing, including forming textile elements to be incorporated into footwear as described in Nishida, as such a design choice would have been predictable and well known to a person with ordinary skill in the art.

IPR2016-00921, IPR Petition, Paper 1, at 12-13 (citing Ex. 1003, ¶¶ 131, 132).
IPR2016-00922, IPR Petition, Paper 1, at 11-12 (citing *id.*).

Mr. Holden Confirmed that Reed and Nishida are Directed to Cost/Waste Reduction

134. Additionally, Reed and Nishida are directed to reducing costs associated with producing textile elements using the latest advances in knitting technology. Reed states that "[a]nother object of the present invention is to provide a method of reducing the cost of manufacturing of garments by using the versatility of a computerized electronic knitting machine" and that "[s]till another object is to provide a method for producing a plurality of garments formed about the circumference of a knitted tube." Reed, 2:22-31. Given the variety of sizes of shoe uppers and the fact that including multiple uppers around circumference of a circular knitted tube directly increases efficiency, the skilled person would have been motivated to use Reed's process to produce textiles for shoe uppers, particularly in view of the improvements in single needle selection that allows for specific control over stitch configurations in different parts of the upper.

IPR2016-00921, Petitioner's Reply, Paper 10, at 11 (citing Ex. 1003 ¶134).
IPR2016-00922, *id.*

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Mr. Holden Confirmed That Reed and Nishida Describe Analogous Computerized Knitting Processes

133. Moreover, the skilled person would have found Nishida's process of producing textile elements to be analogous art to Reed's process, as both are directed to methods of simultaneously forming textile articles within a surrounding textile structure using "program-controlled web of material production devices" (as described in Nishida, 2:40-41; 4:15-17; 4:53-54; 5:64-65) and a "computerized electronic knitting machine" (as described in Reed, 1:58-59; 2:23-25); removing the textile element from the surrounding textile structure; and incorporating the textile element into a wearable item. Nishida, Abstract; 1:10-18; 1:40-2:37; 2:40-47; 3:6-52; 3:59-4:5; 4:12-60; 5:3-26; 5:63-6:2; 6:36-38; FIGS. 1-3; Reed, 1:58-64; 2:14-16; 2:22-31; 3:1-19; 3:58-60; 4:68-5:18; 5:56-57; 5:67-6:5; FIGS. 1, 2A, 2-6.

IPR2016-00921, IPR Petition, Paper 1, at 13 (citing Ex. 1003, ¶ 133).
IPR2016-00922, IPR Petition, Paper 1, at 12 (citing *id.*).

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POSITA Has Several Reasons To Combine Reed and Nishida

- "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. … [I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).
- Owner provides no evidence to contradict the incentives and market forces identified, nor evidence that using Reed's circular knitting technique to produce shoe uppers as in Nishida is an actual application beyond the skilled artisan.
- Petitioner's expert testimony showing multiple motivations to combine thus stands unrebutted.

Owner's Remaining Critiques on Motivation to Combine Do Not Rebut Obviousness

- Whether a POSITA would have been aware of the problem in the 598/749 patents
- Whether Reed is analogous art
- Why a POSITA would have been motivated to combine Reed and Nishida
- How a POSITA would have combined Reed and Nishida
- Whether the combination renders Reed inoperable for its intended purpose
- Whether Reed teaches away from the combination

IPR2016-00921, Owner's Response, Paper 9, at 28-44
IPR2016-00922, Owner's Response, Paper 9, at 32-48.

Leo Pharmaceuticals Is Inapplicable

- The Federal Circuit already distinguished *Leo* in this context when addressing the parent of the 598 & 749 patents by finding that Nishida expressly recognized the need for waste reduction.

> Persons of skill in the art cannot have tried and failed to solve the problem if they were never aware of that problem to begin with. Thus, the number of years that passed between the prior art and the claimed invention may be a relevant factor to underscore that skilled artisans had long failed to appreciate the problem solved by that invention. Here, there is no question that skilled artisans knew of the desire to reduce waste when producing wearable, knitted shoe uppers because that problem is expressly recognized in Nishida. Thus, *Leo Pharmaceuticals* does not control the present case.

Nike, Inc. v. Adidas AG, 812 F.3d 1326, 1338 (Fed. Cir. 2016).

POSITA Knew of the Problem Addressed by the 598 and 749 Patents

- Owner asserts that the 598 and 749 Patents only address problem of "making footwear uppers from multiple materials."

From the perspective of manufacturing, utilizing multiple materials to impart different properties to an article of footwear may be an inefficient practice. For example, the various materials utilized in a conventional upper are not generally obtained from a single supplier. Accordingly, a manufacturing facility must coordinate the receipt of specific quantities of materials with multiple suppliers that may have distinct business practices or may be located in different regions or countries. The various materials may also require additional machinery or different assembly line techniques to cut or otherwise prepare the material for incorporation into the footwear. In addition, incorporating separate materials into an upper may involve a plurality of distinct manufacturing steps requiring multiple individuals. Employing multiple materials, in addition to textiles, may also detract from the breathability of footwear. Leather, synthetic leather, or rubber, for example, are not generally permeable to air. Accordingly, positioning leather, synthetic leather, or rubber on the exterior of the upper may inhibit air flow through the upper, thereby increasing the amount of perspiration, water vapor, and heat trapped within the upper and around the foot.

1 2 3 4 5 6

- But the reason the 598 and 749 patents discourage using multiple materials is:

(a) because it is inefficient and costly, as it creates a need for additional machinery, suppliers, multiple manufacturing steps, etc.; and

(b) it detracts from the breathability of footwear.

IPR2016-00921, Petitioner's Reply, Paper 10, at 11 (citing Ex. 1001, 3:3-23).
IPR2016-00922, *id.*

Mr. Holden Confirmed that the 598 and 749 Patents Identify Multiple Problems

47. The Nike patents explain that using multiple materials to impart different properties to different parts of the upper is an inefficient practice because, for example, materials must often be obtained from multiple suppliers located in different places and different materials may require different machinery or numerous distinct manufacturing steps. '598 patent, 3:3-16. In addition, the Nike patents explain that using multiple materials in the upper may detract from breathability of the shoe, and specifically that leather, synthetic leather, and rubber inhibit air flow. '598 patent, 3:16-23.

48. Thus, the problems that the Nike patents identify are (1) inefficiencies and cost in using multiple materials, and (2) poor breathability of materials like leather (natural or synthetic) and rubber. The proposed solution of the Nike patents is to make a textile upper as a single material element with a unitary construction.

IPR2016-00921, Petitioner's Reply, Paper 10, at 11 (citing Ex. 1003, ¶¶ 47-48).
IPR2016-00922, *id.*

Reed and Nishida Address the Same Problems as Those Stated in the 598 and 749 Patents

Reed

Another object of the present invention is to provide a method of reducing the cost of manufacturing of garments by using the versatility of a computerized electronic knitting machine.

Nishida

It is of further advantage in the process according to the present invention that the individual patterns or partial patterns already can be produced directly in the production of the web of material in the desired shoe size, by which the cutting waste can be still further limited, since the individual patterns or partial patterns in the provided size can directly adjoin one another.

The type of production can, additionally, insure that the toe area **14** has a good air exchange capability. For example, this can be achieved by a net-like woven or knitted structure.

IPR2016-00921, Petitioner's Reply, Paper 10, at 11 (citing Ex. 1006, 2:22-25; Ex. 1009, 2:27-33, 3:49-52; Ex. 1003, ¶¶ 134-135).
IPR2016-00922, *id.*

Reed is Analogous Art

Prior art is analogous and can be applied in an obviousness combination if it either

(1) "is from the same field of endeavor, regardless of the problem addressed"

or

(2) "is reasonably pertinent to the particular problem with which the inventor is involved."

Unwired Planet, LLC v. Google Inc., 841 F.3d 995, 1000–01 (Fed. Cir. 2016) (quoting *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992)).

Prong 1: Reed is From the Same Field of Endeavor as the 598 and 749 Patents

598 and 749 Patents

The present invention relates to footwear. The invention concerns, more particularly, an article of footwear incorporating an upper that is at least partially formed from a textile material.

Reed

The present invention relates generally to knitted garments and more particularly to a garment which is preseamed and preformed on a circular knitting machine.

"The field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field." *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1001 (Fed. Cir. 2016).

IPR2016-00921, Petitioner's Reply, Paper 10, at 13 (citing Ex. 1001, 1:18-21); Owner's Response, Paper 9, at 38 (citing Ex. 1006, 1:8-11).
IPR2016-00922, Petitioner's Reply, Paper 10, at 13 (citing *id.*); Owner's Response, Paper 9, at 43 (citing *Id*).

Prong 1: Mr. Holden Confirms that the Garment and Apparel Industries are in the Same Field of Endeavor

Q. (By Mr. Harris) I'm asking you: Are there any differences between footwear and apparel, in your mind?
A. There are differences, but some of those differences are also similarities.
Q. Okay. So let's talk about the differences that are also similarities.
A. Sure.
Q. What's a difference between footwear and apparel that is also a similarity?
A. Footwear, apparel, hats, accessories all use patterns. So that's -- that is a commonality.
Q. And it's also a difference?
A. And it's also a difference because the patterns are a difference. The patterns themselves are different, in that a pattern for a certain part of the body will differ in its shape from a pattern that is made for a body or for a foot or for a hat or for -- but they're also almost exactly the same, in that they all use a pattern. They all start with a pattern.
Q. When you use the term "pattern," which you have used it several times now, what do you mean? What's a pattern?
A. Generally, a pattern is an outline.

Again, there are more similarities between the apparel industry and the footwear industry than there are differences.

Q. -- can you think of one example where a footwear product is different than an apparel product?
A. Again, even if I say that the bottom is not part of -- is only for footwear, then I could show you footie pajamas which have bottoms on them and they're apparel.
Q. So the answer's no?
A. I really can't think of any particular example that would not have -- conversely have an exception to that rule.

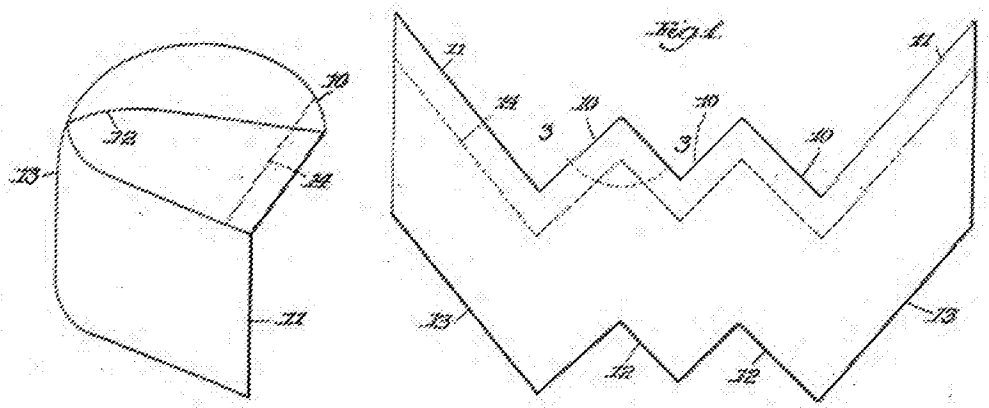
IPR2016-00921, Petitioner's Reply, Paper 10, at 13-14 (citing Ex. 2004, 26:5-7, 27:11-28:10, 38:11-21).
IPR2016-00922, Petitioner's Reply, Paper 10, at 13 (citing *id.*).

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Federal Circuit Confirms Substantial Evidence Supports PTAB Finding That Nishida and Schuessler I, II Are in Similar Fields

- Like Nishida, the 598 and 749 Patents describe forming a textile product in the form of shoe uppers from a textile material.
- Like Schuessler I and II, which describes knitting a cap on a knitting machine as shown in FIGs 1-2 below, Reed describes forming a textile product in the form of garments (e.g., skirts, shirts, pants dresses, hosiery) from a textile material.

The Board found that one of skill in the art would have reason to combine Nishida and the Schuessler References because these references are in similar fields and address the same problem. Nike asserts that the Board's finding lacks substantial evidence because the processes in these references are sufficiently different such that a person of skill in the art would not think to combine them. According to Nike, Nishida discloses a "subtractive" process, which requires the additional step of cutting the textile from a larger textile web. Nike contends that Nishida's subtractive process bears no resemblance to the "additive" process in the Schuessler References, where the textile shape is created by flat knitting to shape in the first instance. Nike's argument is not persuasive.



IPR2016-00921, Petitioner's Reply, Paper 10, at 13 (citing Ex. 1001, 1:18-21, Ex. 1006, 5:56-57; *Nike*, 812, F.3d at 1337).
IPR2016-00922, *id.*

Prong 2: Reed is Reasonably Pertinent to the Problem of the 598 and 749 Patents

598 and 749 Patents

From the perspective of manufacturing, utilizing multiple materials to impart different properties to an article of footwear may be an inefficient practice. For example, the various materials utilized in a conventional upper are not generally obtained from a single supplier. Accordingly, a manufacturing facility must coordinate the receipt of specific quantities of materials with multiple suppliers that may have distinct business practices or may be located in different regions or countries. The various materials may also require additional machinery or different assembly line techniques to cut or otherwise prepare the material for incorporation into the footwear. In addition, incorporating separate materials into an upper may involve a plurality of distinct manufacturing steps requiring multiple individuals. Employing multiple materials, in addition to textiles, may also detract from the breathability of footwear. Leather, synthetic leather, or rubber, for example, are not generally permeable to air. Accordingly, positioning leather, synthetic leather, or rubber on the exterior of the upper may inhibit air flow through the upper, thereby increasing the amount of perspiration, water vapor, and heat trapped within the upper and around the foot.

That is, the type of stitch that is formed at each location on the textile structure may be selected by programming the wide-tube circular knitting machine such that specific needles either accept or do not accept yarn at each stitch location. In this manner, various patterns, textures, or designs may be selectively and purposefully imparted to the textile structure.

Reed

Another object of the present invention is to provide a method of reducing the cost of manufacturing of garments by using the versatility of a computerized electronic knitting machine.

When the computer began to be used as pattern preparation equipment for electronic double knit machines in the early 1970's, an era of unlimited pattern potential began. Heretofore, with mechanical type pattern machines, maximum pattern widths were approximately 144 wales wide, 324 courses high. Computer electronic knitting brought about the possibilities of making patterns and designs of up to three million stitches (previously approximately 50,000 was maximum). With this system, patterns and designs are possible that before could not be made.

IPR2016-00921, Petitioner's Reply, Paper 10, at 11 (citing Ex. 1001, 3:3-23), 14 (citing Ex. 1001, 7:31-37; Ex. 1006, 1:45-55, 2:22-25).
IPR2016-00922, *id.*

Prong 2: Reed is Reasonably Pertinent to the Problem of the 598 and 749 Patents

- It is legal error for "courts and patent examiners [to] look only to the problem the patentee was trying to solve. . . . Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007); *see also Nike*, 812 F.3d at 1337.

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Skechers v Nike

Reed Suggests How a POSITA Would Combine Reed and Nishida

- Reed suggests to the POSITA that its process could be used to make shoe uppers.

> The present invention may be used to form all types of garments worn by men, women and children - including underwear, outerwear and even full-fashion hosiery.

- The 598 and 749 patents define textiles broadly – not just as shoe uppers.

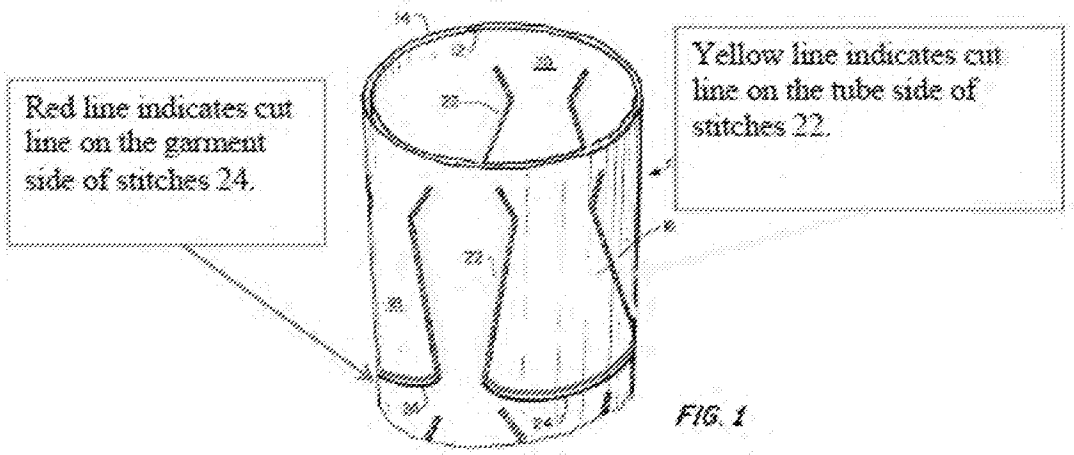
> Although the materials selected for the upper vary significantly, textile materials often form at least a portion of the exterior layer and interior layer. A textile may be defined as any manufacture from fibers, filaments, or yarns characterized by flexibility, fineness, and a high ratio of length to thickness. Textiles generally fall into two categories. The first category includes textiles produced directly from webs of filaments or fibers by randomly interlocking to construct non-woven fabrics and felts.

IPR2016-00921, Petitioner's Reply, Paper 10, at 12, 16 (citing Ex. 1006, 5:56-57; Ex. 1003, ¶131-132; Ex. 1001, 2:15-23).
IPR2016-00922, *id.*

Reed is Operable When Combined with Nishida

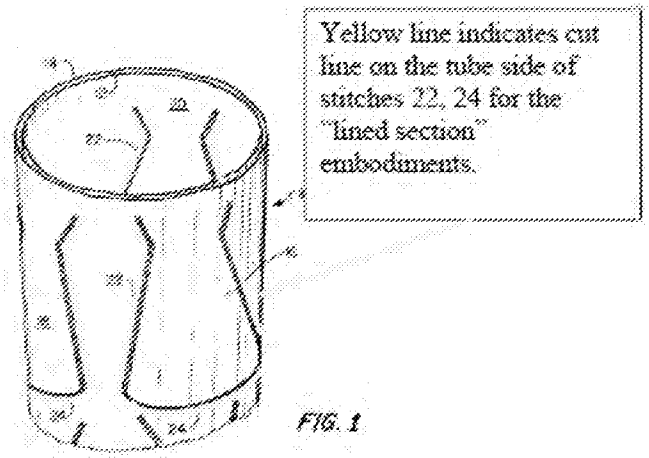
"Finished Garment"

- Sides cut along yellow lines to keep seams with the garment.
- Bottom cut along red line to remove seam from the garment to form an opening for a person's body.



"Lined Garment Section"

- Sides and bottom cut along yellow lines to keep seams with the garment.



IPR2016-00921, Petitioner's Reply, Paper 10, at 17 (citing Ex. 1006, 3:9-15, FIG. 1.).
IPR2016-00922, Petitioner's Reply, Paper 10, at 16-17 (citing *Id.*).

Reed is Operable When Combined with Nishida

- In both the "finished garment" and "lined garment section" embodiments, the outlines are interknitted in layered form.
- That is consistent with Nishida:

> Optionally, in this case, the material can be woven or knitted in two or more layers or can be especially thick or additionally embroidered.

IPR2016-00921, Petitioner's Reply, Paper 10, at 16-18 (citing Ex. 1006, 3:9-15, Ex. 1003, ¶103; Ex. 1009, 3:67-68).
IPR2016-00922, *id.*

Owner Does Not Establish Any "Teaching Away"

Meiresonne v. Google, Inc., 849 F.3d 1379, 1382-83 (2017) (citation omitted):

- A reference teaches away "when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken" in the claim. A reference that "merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into" the claimed invention does not teach away.
- The fact that Finseth describes descriptive text as "[o]ften[ ] ... cursory, if not cryptic" does not automatically convert the reference to one that teaches away from combining text descriptions with a rollover window. This description implies only that text descriptions may be incomplete or insufficient to fully understand the content. Finseth does not say or imply that text descriptions are "unreliable," "misleading," "wrong," or "inaccurate," which might lead one of ordinary skill in the art to discard text descriptions completely.

Reed Does Not Teach Away From Combination with Nishida

- Reed identifies more objectives than simply preseaming.

1 An object of the present invention is to provide a method for preseaming and preforming knitted garments.

2 Another object of the present invention is to provide a method of reducing the cost of manufacturing of garments by using the versatility of a computerized electronic knitting machine.

3 A further object of the invention is to produce a weft knitted garment preseamed and preformed on a circular knitting machine.

4 Still another object is to provide a method for producing a plurality of garments formed about the circumference of a knitted tube.

5 An even further object is to provide a knitted structure where a garment is formed from two juxtaposed sections of a tube so that the anatomy of the user fits between the single juxtaposed layers.

IPR2016-00921, Petitioner's Reply, Paper 10, at 11 (citing Ex. 1006, 2:22-31).
IPR2016-00922, *id.*

Reed Does Not Teach Away From Combination with Nishida

- Reed's "lined garment sections" embodiments still require conventional assembly and seaming to form a finished product.

> If the present process is used to preform an exterior decorative fabric having a lining or inner-lining or interfacing attached thereto, the severed sections must be assembled and seamed by standard practices.

- Owner's 598 Response at 39 and 749 Response at 48 admits that Nishida's disclosure is similar.

> Nishida teaches producing a layout on a preexisting web of material, cutting the layout out of the web of material, shaping and folding the layout so that corresponding edges align, and then seaming those corresponding edges together to complete the upper and related sole. (*Id.*)

IPR2016-00921, Petitioner's Reply, Paper 10, at 20 (citing Ex. 1006, 6:10-13).
IPR2016-00922, *id.*

Owner Disputes Whether the Reed/Nishida Combination Discloses One Element of 749 Patent, Claims 1 and 13

[1C], the knitted textile element having at least one knitted texture (α) that differs from a knitted texture (β) in the surrounding knitted textile structure;
[13D] varying at least one of the types of stitches or the types of yarns in the knitted textile structure to impart a texture (α) to the first and second knitted textile elements different from a texture (β) of the knitted textile structure extending between the first and second portions;

***Underlined text are the only features that Owner relies on to distinguish 749 Patent, claims 1 and 13 from the Reed/Nishida combination.**

IPR2016-00922, Owner's Response, Paper 9, at 50-55.

Skechers EX1013-p. 188
Skechers v Nike

Mr. Holden Confirms That Reed Discloses the [1C] Feature

109. Reed goes on to explain that "once the knitted structure 10 is removed from the knitting machine, the individual garments may be severed by cutting along the outline formed by the interconnecting stitches represented by the X's and O's." Reed, 5:67-6:3; *see also* 4:61-64; FIGS. 2, 2A (reproduced below), 3A-3E (reproduced below). As illustrated in the attached claim chart for claim 1C of the '749 patent, because the interknitted stitches are part of the garments 16, 18, 20, they form a texture in the garments that is different from the texture in the surrounding textile structure.

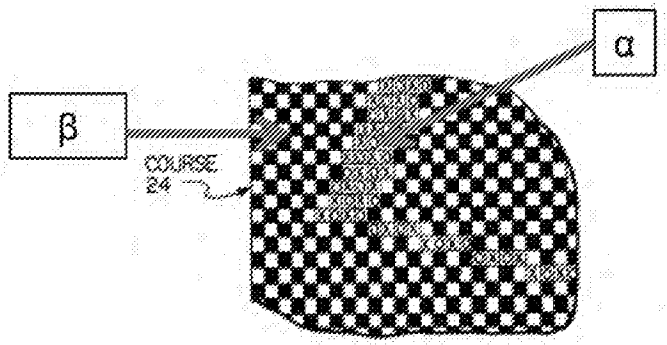
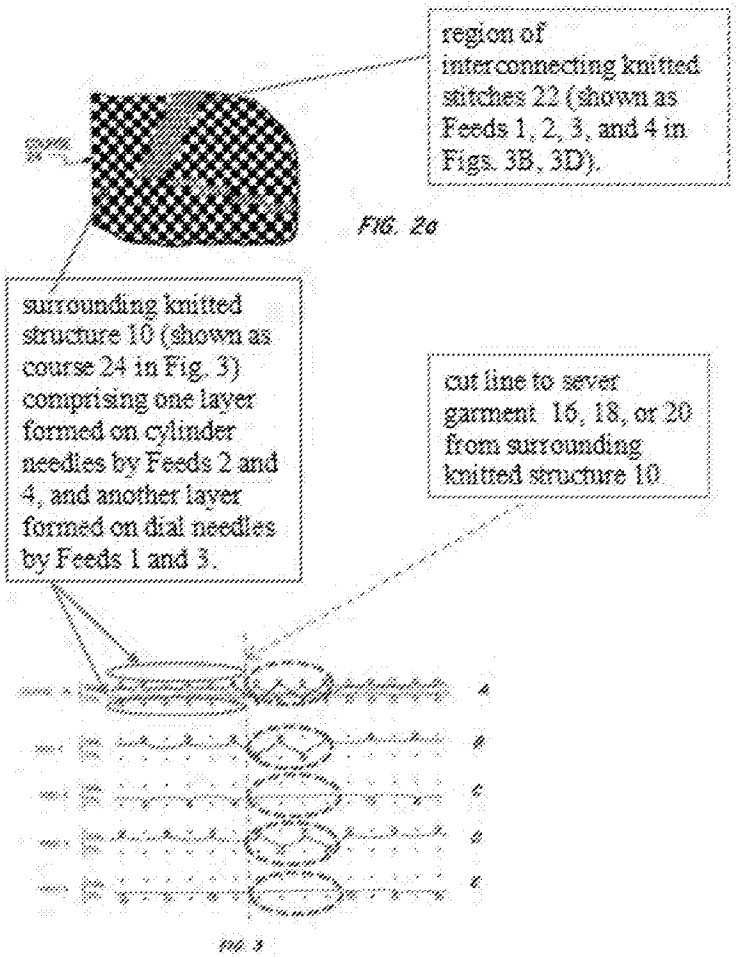


FIG. 2a



IPR2016-00922, Petitioner's Reply, Paper 10, at 21 (citing Ex. 1003, ¶ 109; Ex. 1009, FIGS. 2a, 3).

Mr. Holden Confirms That Reed Discloses the [13D] Feature

108. For example, Reed describes that the edges of the garments 16, 18, 20 are formed by interknitted stitches, whereas the remainder of the garments 16, 18, 20 are formed by non-interknitted stitches. Specifically, Reed describes that the outline of the garments 16, 18, 20 is formed with interknitted stitches (shown in X's and O's in FIG. 2), which are formed by feeds 1, 2, 3, and 4 on needles 7, 9, 8, and 10 (as shown in FIGS. 3B and 3D). Reed, 5:3-18; FIGS. 3A-3E. In contrast, "two feeds [i.e., feeds 1, 3 for the dial needles] are used for one course of the inner tube 12 and two feeds [i.e., feeds 2, 4 for the cylinder needles] are used for the outer tube 14." Reed, 4:61-64; FIGS. 2, 2A, 3A-3E.

109. Reed goes on to explain that "once the knitted structure 10 is removed from the knitting machine, the individual garments may be severed by cutting along the outline formed by the interconnecting stitches represented by the X's and O's." Reed, 5:67-6:3; *see also* 4:61-64; FIGS. 2, 2A (reproduced below), 3A-3E (reproduced below). As illustrated in the attached claim chart for claim 1C of the '749 patent, because the interknitted stitches are part of the garments 16, 18, 20, they form a texture in the garments that is different from the texture in the surrounding textile structure.

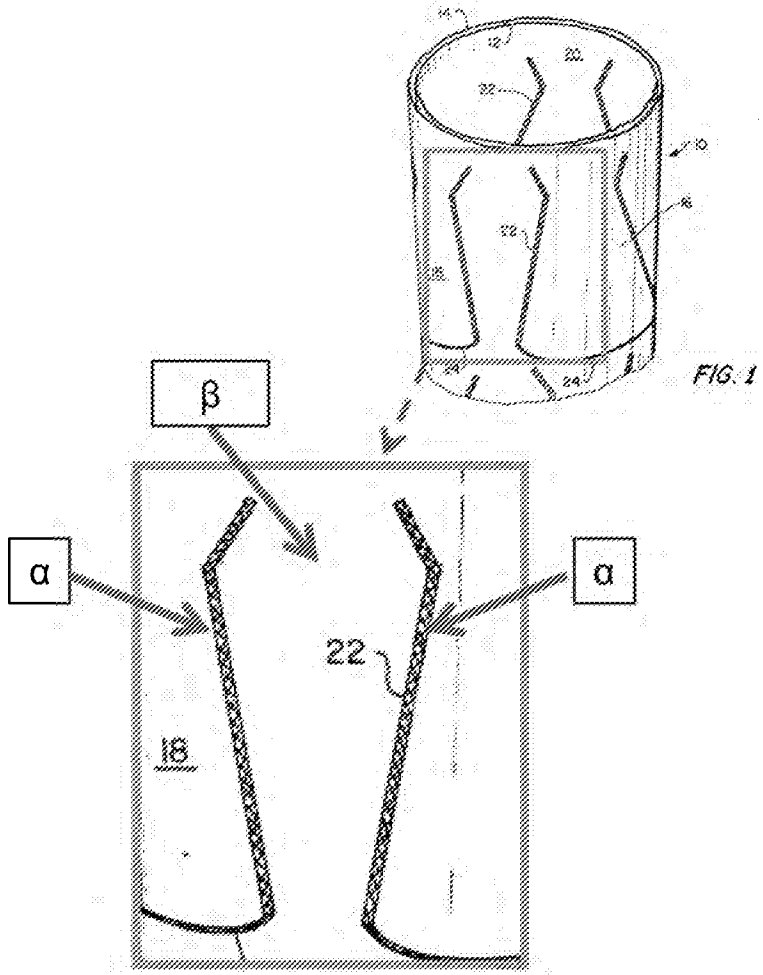


FIG. 1

IPR2016-00922, Petitioner's Reply, Paper 10, at 21 (citing Ex. 1003, ¶¶ 108-109).

Nishida Discloses the [1C], [13D] Feature

- Owner's 749 Response at 51-52 acknowledges that Nishida teaches a "web of material having different textures" but disputes whether there is any clear disclosure of *where* the textures differ.

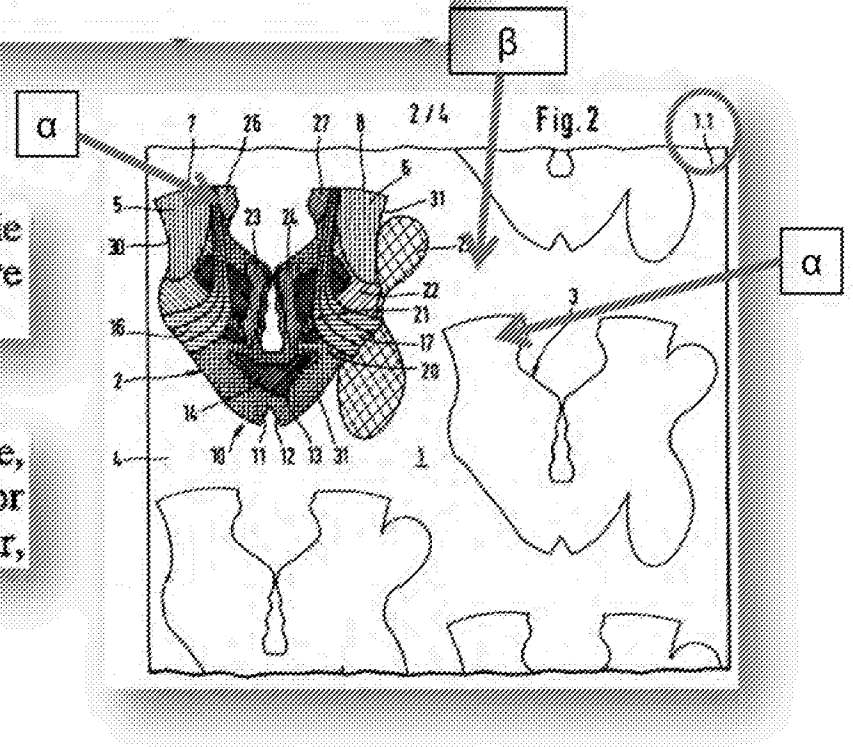
> Nishida does not teach either element [1B] or [1C] of claim 1. As the examiner explained during prosecution of the '749 patent, Nishida "may disclose a web of material having different textures, but there is no clear disclosure of the textures differing such that the textile element has a texture which is different than the texture of the surrounding textile structure and that the textile element and the surround structure are simultaneously knitted." (Ex. 1002, 278.) Furthermore, the examiner also explained that "Nishida does not provide any clear disclosure of where the differing textures are located." (*Id.*)

Nishida Discloses the [1C], [13D] Feature

The remaining area of the web of material in contrast can consist of a simple, lightweight or inexpensive material quality, which holds together only the patterns or areas of such patterns in the web of material after their completion.

In FIGS. 1 and 2, unfinished surface areas, which lie outside layouts 2 for shoe upper 3 or for tongue 40, are shown with position number 1.1.

For example, these surface areas 1.1 can be produced like a gauze or with low to very low warp and/or filling gauge and/or,



IPR2016-00922, Petitioner's Reply, Paper 10, at 22-23 (citing Ex. 1009, 2:15-20, 4:61, 5:50-51, FIG. 2).

Mr. Holden Confirms That Nishida Discloses the [1C], [13D] Feature

110. As described in Section IX.D above, Nishida states that "[a]s can be seen, ***any number of layouts 2 in the most varied configurations and/or designs as well as of different sizes can be produced on a single web of material 1***. For this purpose, above all, ***the use of program-controlled, particularly computer-controlled, production devices is advantageous***, so that style, color, design, size or the like can be varied at will." Nishida, 4:12-18 (emphasis added); *see also* 2:40-41; 4:53-54; 5:64-65.

111. Nishida goes on to explain that "only just those parts of the web of material are produced in the necessary quality, thickness, multilayers or the like which correspond to the pattern or to an area of a pattern of the shoe upper or the related shoe part. The remaining area of the web of material in contrast can consist of a simple, lightweight or inexpensive material quality, which holds together only the patterns or areas of such patterns in the web of material after their completion." Nishida, 2:12-20; *see also* Abstract; 1:40-2:5; 2:11-25; 2:40-54; 3:6-26; 3:43-58; 3:59-4:9; 4:11-18; 4:47-55; 5:27-40; 5:45-6:2.

IPR2016-00922, IPR Petition, Paper 1, at 17 (citing Ex. 1003, ¶¶ 110-111).

It is Undisputed that Reed Discloses the [1B] Feature

- 749 Patent, clam 1[B]: "simultaneously knitting a textile element with a surrounding textile structure."

> The present invention uses an electronic circular double knitting machine programmed to simultaneously knit two concentric tubes, one on the dial set of needles and a second on the cylinder set of needles and additionally programmed to interconnect the two concentric tubes by a knit interlock stitch to form the outline of the design of a garment.

IPR2016-00922, IPR Petition, Paper 1, at 14-15 (citing Ex. 1006, 1:58-64).

Mr. Holden Confirms That Reed Discloses the [1B] Feature

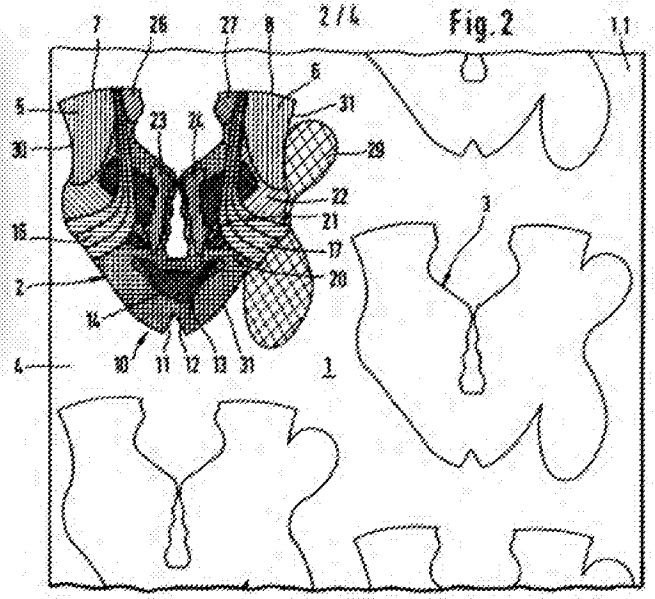
98. Reed and Nishida describe that one or more textile elements are formed simultaneously with the surrounding textile structure. Reed states that "[t]he present invention uses an electronic circular double knitting machine programmed to ***simultaneously knit two concentric tubes***, one on the dial set of needles and a second on the cylinder set of needles and additionally programmed to interconnect the two concentric tubes by a knit interlock stitch ***to form the outline of the design of a garment.***" Reed, 1:58-64 (emphasis added). A person of ordinary skill in the relevant art at least as of March 3, 2004 would have understood that the textile element and the surrounding textile structure are produced simultaneously in the circular knitting machine due to the way that a circular knitting machine forms the consecutive courses around the circumference of the circular knitting machine. Because each consecutive course of the circular knitting machine forms a portion of the textile element and the surrounding textile structure, the circular knitting machine forms the textile element simultaneously with the surrounding textile structure.

IPR2016-00922, IPR Petition, Paper 1, at 14 (citing Ex. 1003, ¶ 98).

Nishida Discloses the [1B] Feature

- Owner incorrectly asserts that the layout is not formed simultaneously with the surrounding textile.

For this purpose, a web of material (1) is used to produce layouts (2) by different production measures, such as different styles, yarn material, color, material thickness, single layer or multilayer type of material or the like, at the same time with the production of web of material (1),



- Nishida's FIGs. 1-2 and 4-5 show the layouts within a surrounding web of material.

IPR2016-00922, Petitioner's Reply, Paper 10, at 23-24 (citing Owner's Response, Paper 9, p. 53; Ex. 1009, Abstract, FIG. 2).

Mr. Holden Confirmed that Nishida Discloses the [1B] Feature

98. Reed and Nishida describe that one or more textile elements are formed simultaneously with the surrounding textile structure.

100. Similarly, Nishida states that "[a]s can be seen, ***any number of layouts 2 in the most varied configurations and/or designs as well as of different sizes can be produced on a single web of material 1***. For this purpose, above all, ***the use of program-controlled, particularly computer-controlled, production devices is advantageous***, so that style, color, design, size or the like can be varied at will." Nishida, 4:12-18 (emphasis added); *see also* 2:40-41; 4:53-54; 5:64-65.

101. Nishida goes on to explain that "***only just those parts of the web of material*** are ***produced*** in the necessary quality, thickness, multilayers or the like ***which correspond to the pattern or to an area of a pattern of the shoe upper or the related shoe part***. The ***remaining area of the web of material*** in contrast can consist of a simple, lightweight or inexpensive material quality, which ***holds together only the patterns or areas of such patterns in the web of material*** after their completion." Nishida, 2:12-20 (emphasis added); *see also* Abstract; 1:40-2:5; 2:11-2:25; 2:40-54; 3:6-26; 3:43-58; 3:59-4:9; 4:11-18; 4:47-55; 5:27-40; 5:45-6:2.

IPR2016-00922, IPR Petition, Paper 1, at 13-14 (citing Ex. 1003, ¶ 98, 100-101).

Owner Disputes Whether the Reed/Nishida Combination Discloses "To Impart" Feature of 598 Patent, Claims 4, 11, and 749 Patent, Claims 11, 21

598 Patent, [4], [11] The method recited in claim 1 9, wherein the step of mechanically manipulating

- includes forming the textile element to include a first area and a second area with a unitary construction,
- the first area being formed of a first stitch configuration, and
- the second area being formed of a second stitch configuration that is different from the first stitch configuration <u>to impart varying textures</u> to a surface of the textile element.

749 Patent, [11], [21] The method of claim 1 13, wherein simultaneously knitting a the first knitted textile element simultaneously with a surrounding knitted textile structure

- includes forming the first knitted textile element to include a first area and a second area with a unitary construction,
- the first area being formed of a first stitch configuration, and
- the second area being formed of a second stitch configuration that is different from the first stitch configuration <u>to impart varying textures</u> to a surface of the first knitted textile element.

***<u>Underlined</u> text are the only features that Owner relies on to distinguish 598 Patent, dependent claims 4 and 11, and 749 Patent, dependent claims 11 and 21 from the Reed/Nishida combination.**

IPR2016-00921, Owner's Response, Paper 9, at 45-50.
IPR2016-00922, Owner's Response, Paper 9, at 55-56.

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BRI Construction of "To Impart" Feature

- 598 Patent, claims 4, 11; 749 Patent, claims 11, 21: "a second stitch configuration that is different from the first stitch configuration to ***impart*** varying textures."
- 598 and 749 patents describe formation of different textures by varying stitch type:

> The different textures **46"-48"** are formed by merely varying the type of stitch formed by the wide-tube circular knitting machine at each location of textile element **40"**. Textures **46"-48"** may exhibit aesthetic differences, or the differences may be structural. For example, the degree of stretch in areas with textures **46"-48"** may be different, or the wear resistance of the areas may vary depending upon the stitch utilized. The air-permeability of textile element **40"** may also vary in the different areas.

- 598 and 749 patents also disclose that "similar stitches are utilized throughout textile element 40 to impart a common texture," while "vary[ing] the stitches within textile element 40 [will] produce various . . . textures."
- According to Merriam-Webster, "impart" means to give, convey, or grant from.
- Under BRI standard, the presence of the different stitch configurations gives or bestows the varying textures.

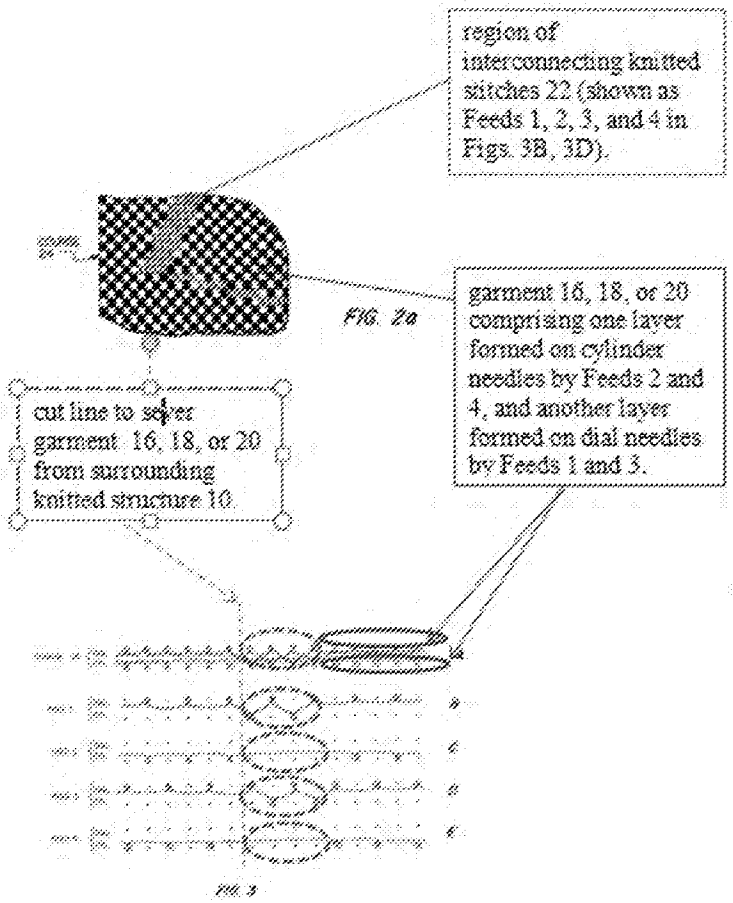
IPR2016-00921, Petitioner's Reply, Paper 10, at 21 (citing Ex. 1014; Ex. 1001, 8:62-64, 9:1-4); Institution Decision, Paper 6, at 6.
IPR2016-00922, Petitioner's Reply, Paper 10, at 24 (citing *id.*); *id.*

Board's Discussion of the "To Impart" Feature

The different textures 46″-48″ are formed *by merely varying the type of stitch formed* by the wide-tube circular knitting machine at each location of textile element 40″. Textures 46″-48″ may exhibit aesthetic differences, or the differences may be structural. . . . The air-permeability of textile element 40″ may also vary in the different areas.

IPR2016-00921, Institution Decision, Paper 6, at 6.
IPR2016-00922, *id.*

Mr. Holden Confirms that Reed Discloses the "To Impart" Feature In Two Ways



115. First, as described in Section IX.G above, Reed describes that the edges of the garments 16, 18, 20 are formed by interknitted stitches, whereas the remainder of the garments 16, 18, 20 are formed by non-interknitted stitches. Specifically, Reed describes that the outline of the garments 16, 18, 20 is formed with interknitted stitches (shown in X's and O's in FIG. 2), which are formed by feeds 1, 2, 3, and 4 on needles 7, 9, 8, and 10 (as shown in FIG. 3B and 3D). Reed, 5:3-18, FIGS. 3A-3E. In contrast, "two feeds [i.e., feeds 1, 3 for the dial needles] are used for one course of the inner tube 12 and two feeds [i.e., feeds 2, 4 for the cylinder needles] are used for the outer tube 14." Reed, 4:61-64; FIGS. 2A, 3A-3E.

116. Reed goes on to explain that "once the knitted structure 10 is removed from the knitting machine, the individual garments may be severed by cutting along the outline formed by the interconnecting stitches represented by the X's and O's." Reed, 5:67-6:3; *see also* 4:61-64; FIGS. 2, 2A (reproduced below), 3A-3E (reproduced below). As illustrated in the attached claim charts for claim 8 of the '749 patent and claim 4 of the '598 patent, because the interknitted stitches are part of the garments 16, 18, 20, and the garments 16, 18, 20 also comprise areas that are only formed as part of the outer tube 14 or the inner tube 12, the garments 16, 18, 20 have a plurality of different knitted textures formed by varying at least one of the stitch type and the yarn type.

IPR2016-00921, Petitioner's Reply, Paper 10, at 21-22 (citing Ex. 1003, ¶¶ 115, 116).
IPR2016-00922, Petitioner's Reply, Paper 10, at 24-25 (citing *Id*).

Mr. Holden Confirms that Reed Discloses the "To Impart" Feature In Two Ways

117. Second, Reed also goes on to describe how the two layers 12, 14 themselves may be formed of different yarns or stitch configurations. "If the two tubes 12 and 14 are knitted of two different fibers, the knitted structure may form sections of a garment to be assembled in the regular manner. For example, the outside tube 14 may be a normal decorative fabric wherein the inner tube 12 may be formed of a material such as lining. By simultaneously knitting and interknitting the two layers, a step is saved by producing a section of garment which is prelined. Similarly, the layer 12 (instead of being lining) may be interfacing, which is attached to the outside layer 14 and again saves a step in the manufacture of garments. Another example where two different fibers are used to make the inner and outer tubing would be in the foundation garment industry, where the inner fabric could be cotton or other soft fibers and the outer fabric would be lycra or elasticized yarns." Reed, 3:61-4:9.

IPR2016-00921, Petitioner's Reply, Paper 10, at 21 (citing Ex. 1003, ¶117).
IPR2016-00922, Petitioner's Reply, Paper 10, at 25 (citing *id.*).

Mr. Holden Confirms That The Presence of Different Stitches Can Impart a Perceived Texture Difference

Q. Do you have an opinion on what "texture" would mean to a person of ordinary skill in the art in the context of the '598 patent marked as Exhibit 1001?

A. Yeah. So my understanding of this would be when you are having those courses, when you're having the variation in the needle configurations and it is varying the color or the -- the -- the creation of an outline or the creation of a pattern or the creation of whatever it may be within the outline, those would be varying types of textures.

Q. So different colors, in your opinion, are different textures?

A. Different colors could be part of different textures --

Q. Can you feel a texture?

A. Not necessarily. Texture, in my opinion, also has something to do with patterns, because people perceive certain patterns to have depth and -- and texture to them.

Q. What do you mean when you say "people perceive certain patterns to have depth...to them"?

A. So if you knit a pattern that has black and red together, people perceive that sometimes to have a texture to it, to be a somewhat rough texture, even though one could make the argument that it's smooth.

Q. So in your hypothetical, if you knitted a pattern that has black and red together, would that pattern have a texture, in your opinion?

A. It may or may not.

Q. How would you determine whether that pattern has a texture?

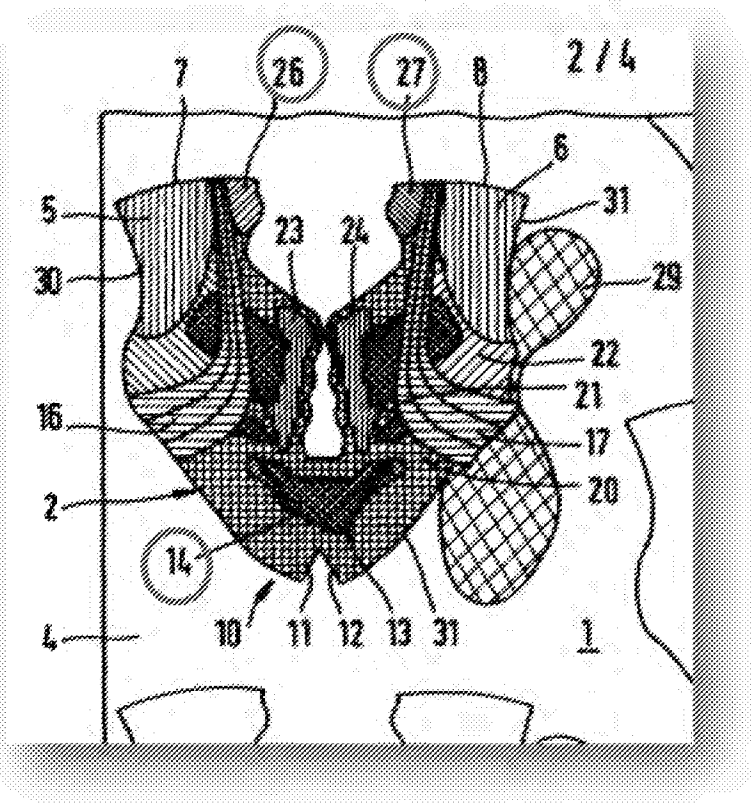
A. So in this case, if you are creating an outline and it's in red and it may be just a different yarn than the -- the other parts that are not creating that outline, people still could perceive a texture to that, even though it may or may not be, you know, smooth or rough or another type of texture.

IPR2016-00921, Petitioner's Reply, Paper 10, at 4 (citing Ex. 2004, 177:11-25; 178:20-179:19).
IPR2016-00922, *id.*

Nishida Discloses the "To Impart" Feature

Finally, in the embodiment according to FIGS. **1** and **2**, with layout **2** on the web of material **1**, areas **26** and **27** are produced in a configuration, color or style that is different from the other areas.

Since, generally, toe area **14** is designed to be relatively deformably soft or elastic, and optionally, also permeable to air, the web of material **1**, in toe area **14**, according to the present invention, is correspondingly designed by suitable selection of the weave pattern, knit pattern and/or the material used, such as, for example, Silk or plastic. The type of production can, additionally, insure that the toe area **14** has a good air exchange capability. For example, this can be achieved by a net-like woven or knitted structure.



IPR2016-00921, Petitioner's Reply, Paper 10, at 22-23 (citing Ex. 1009, 3:43-52, 4:6-9).
IPR2016-00922, Petitioner's Reply, Paper 10, at 25-26 (citing *id.*).

Mr. Holden Confirms that Nishida Discloses the "To Impart" Feature

118. Nishida similarly describes that "in the embodiment according to FIGS. 1 and 2, with layout 2 on the web of material 1, ***areas 26 and 27 are produced in a configuration***, color or style ***that is different from the other areas.***" Nishida, 4:6-9 (emphasis added). "With the use of program-controlled web of material production devices, after a one-time creation of the program, the size of the layout corresponding to the shoe size, the woven or ***knitted type of individual areas or contours***, the type of fiber or yarn and/or the color ***can be selected almost at will.***" Nishida, 2:40-45 (emphasis added); *see also* Abstract; 1:65-69; 3:15-26; 3:47-48; 4:12-28; 4:48-55; 5:56-6:2.

119. For example, the Nike patents describe varying the "stitch type" as a way to vary the type of texture in different areas, and as separate from varying the type of yarn. '598 Patent, 9:32-49; 9:53-61. Nishida specifically describes using different materials, different compositions (such as twisted or parallel processing or the like), and different knit types or knit patterns, therefore describing for the skilled person using different stitch configurations in different areas as a way to give the textile element different properties in different areas. Nishida, Abstract; 1:65-69; 2:40-45; 3:15-26; 3:47-48; 4:6-9; 4:12-28; 4:48-55; 5:56-6:2.

IPR2016-00921, Petitioner's Reply, Paper 10, at 22 (citing ¶118); IPR Petition, Paper 1, at 22 (citing Ex. 1003, ¶¶ 118-119).
IPR2016-00922, Petitioner's Reply, Paper 10, at 25 (citing ¶118); IPR Petition, Paper 1, at 26-27 (citing Ex. 1003, ¶¶ 118-119).

Owner Disputes Whether the Reed/Nishida Combination Discloses the Feature of 598 Patent, Claim 6

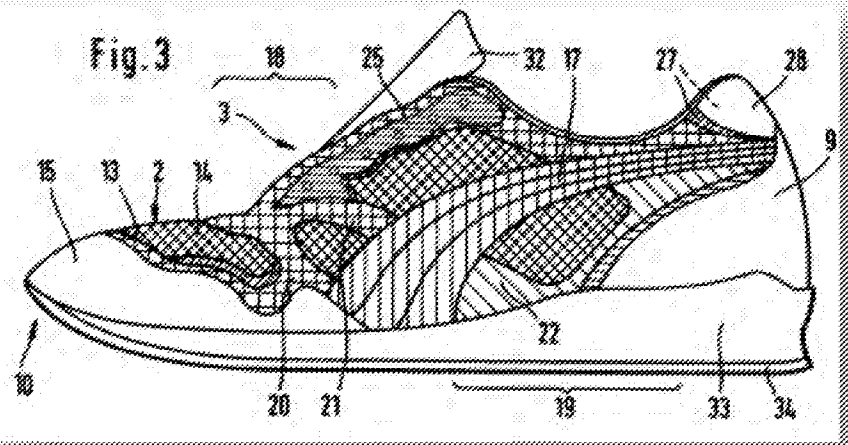
598 Patent, [6] The method recited in claim 1, wherein the step of mechanically manipulating includes forming apertures in the textile element.

***Underlined text is the only feature that Owner relies on to distinguish 598 Patent, dependent claim 6 from the Reed/Nishida combination.**

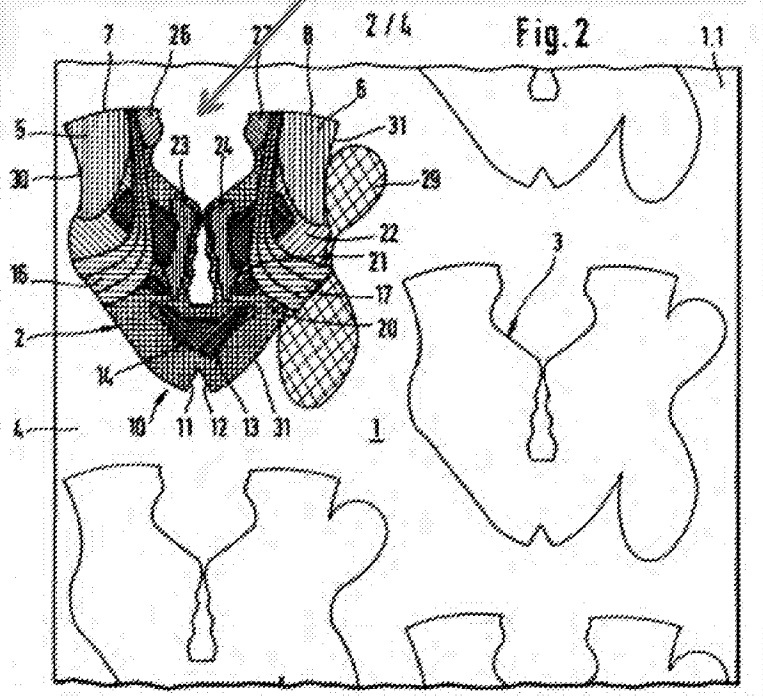
IPR2016-00921, Owner's Response, Paper 9, at 50-55.

Nishida Discloses the "Apertures" Feature

The type of production can, additionally, insure that the toe area **14** has a good air exchange capability. For example, this can be achieved by a net-like woven or knitted structure.



U-shaped area in layout 2 forms ankle opening 36



IPR2016-00921, Petitioner's Reply, Paper 10, at 23-25 (citing Ex. 1009, FIGS. 2, 3, 3:49-52).

Mr. Holden Confirms that Nishida Discloses the "Aperture" Feature

128. With respect to the first type of "ankle opening" aperture, Nishida discloses that the u-shaped area in the layout 2 forms an ankle opening 36 when formed into the shoe upper. *See* Nishida, FIGS. 1-5.

129. With respect to the second type of "air-permeability" apertures, Nishida discloses that the "type of production can, additionally, insure that the toe area 14 has a good air exchange capability. For example, this can be achieved by a ***net-like woven or knitted structure.***" Nishida, 3:49-52 (emphasis added); *see alt* 3:43-52; 3:66-4:5; 6:25-31.

130. With respect to the third type of "lace hole" apertures, Nishida describes lacing strips that may be layered over the net-like structure to reinforce that structure and holes formed in the lacing strips may be aligned with the existing holes in the net-like structure. Nishida, 4:1-5. Thus, Nishida explains that "the lacing areas 23 and 24 *can be made dimensionally stable* in corresponding manners, especially *if, for example, no additional trimmings, such as the lacing strips 25, shown in FIG. 3, are to be applied.*" Nishida, 4:1-5 (emphasis added). Nishida thus recognizes that (a) the lacing strips are optional and may not be applied; (b) that the net-like structure may itself then be used or (c) if no lacing strips are applied and the net-like structure is used, then the lacing areas can be further stabilized via an embroidery. Nishida, 4:31-38. However, if the additional lacing strips and embroidery are not added, the textile element still includes the net-like structure in the lacing area.

- Mr. Holden's testimony that "the textile element still includes the net-like structure in the lacing area" is unrebutted.

IPR2016-00921, Petitioner's Reply, Paper 10, at 23-25 (citing Ex. 1003, ¶130); IPR Petition, Paper 1, at 26-27 (citing Ex. 1003, ¶¶ 128-130)

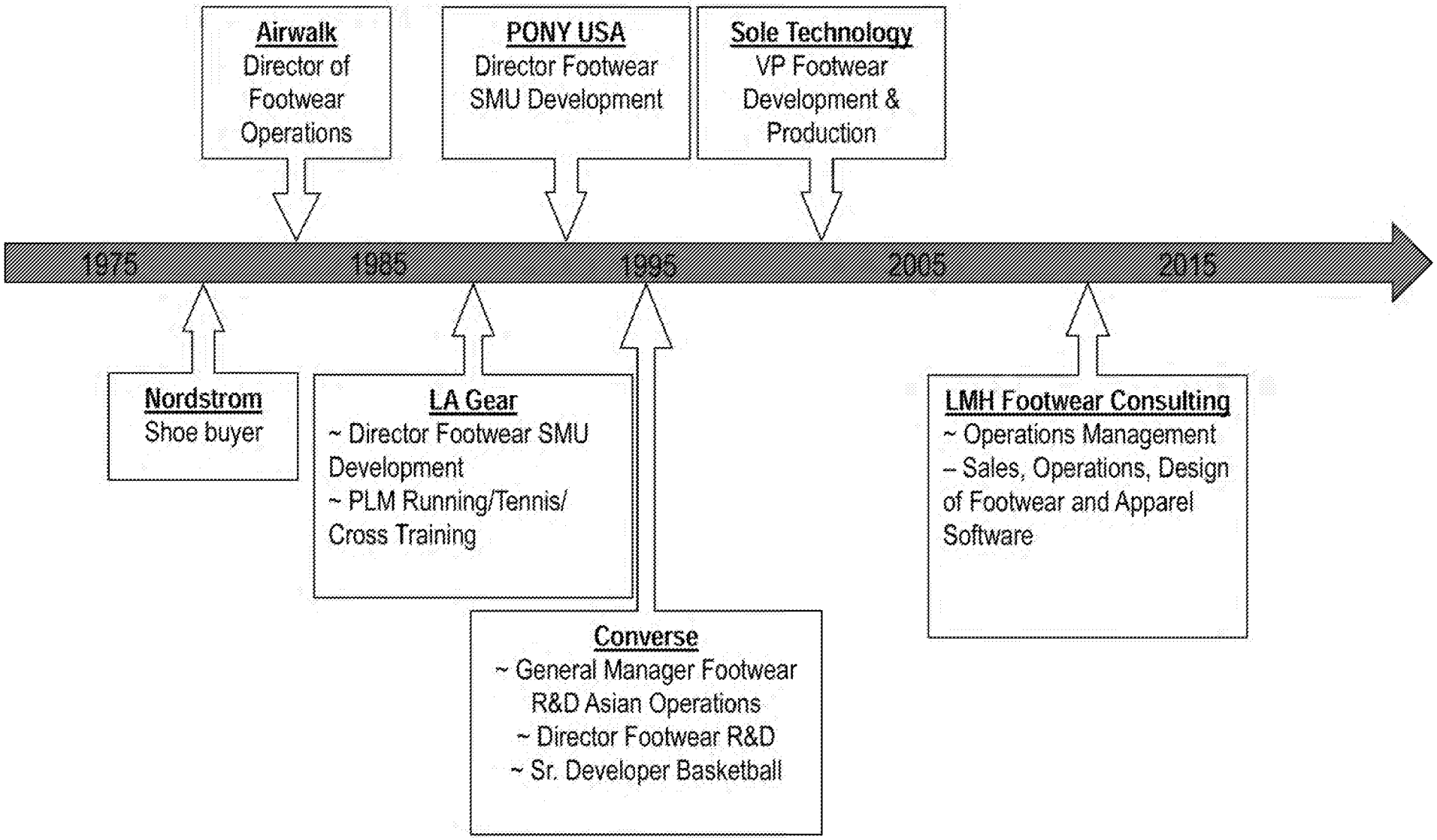
The Net-like Structure Forms "Apertures" and is Made as Part of the Layout

> Nishida's "net-like" structure describes the textile itself, not the formation of apertures during the production process of the layout. (Ex. 1009, 3:43-52.)

- Owner's 598 Response at 52 admits the net-like structure is part of the textile itself.
- But, if Nishida describes the textile itself (as Owner states), it must also describe that the textile of the toe area is formed as part of the knitting process because the toe area is formed as part of the knitted layout.

IPR2016-00921, Petitioner's Reply, Paper 10, at 24.

Mr. Holden's Extensive Footwear Experience and Knowledge



IPR2016-00921, IPR Petition, Paper 1, Ex. 1004.
IPR2016-00922, *id.*

Mr. Holden's Extensive Footwear Experience and Knowledge

- Mr. Holden has worked in the shoe business for almost 40 years, beginning in retail, then quickly transitioning to design, development, and manufacturing.
- Mr. Holden lived in Asia for more than 10 years, and has made shoes of almost every type in Korea, Taiwan, China, Indonesia, Malaysia, Vietnam, Brazil, Mexico, Macao, Spain, Italy, Thailand, and the Philippines.
- Mr. Holden has worked in almost every aspect of design, development, operations, commercialization, quality control, and supply chain, with executive responsibility for the design, development, operations, commercialization, quality control, and supply chain of footwear products worldwide.
- Mr. Holden has developed and/or designed "many, many thousands" of distinct shoe styles in his career.

IPR2016-00921, IPR Petition, Paper 1, Ex. 1003, at ¶¶ 5-10; Owner's Response, Paper 9, at 14 (citing Ex. 2004, 60:16-22, 71:22-73:3, 73:23-74:14); *see also* Ex. 2004, 57:2-19.
IPR2016-00922, *id.*

Mr. Holden's Level of Research and Analysis Confirm Substantial Weight Applies

- Reviewed videos demonstrating circular knitting machine operation and techniques.
- Spent extensive time reviewing prior art references and treatises.
- Provided detailed supporting citations for his opinions.

Q. Okay. Mr. Holden, how long do you estimate you spent analyzing and reviewing the Reed reference when preparing your declaration in this matter?
A. In terms of hours?
Q. Hours --
A. Days?
Q. -- or days, whatever's easiest for you to quantify it. Just an estimate.
A. I don't know exactly, but many, many days, many hours, many -- many days that I've gone over it over -- over a period of time. Not the only fo- -- focus, but part of the focus. So hard for me to quantify.

- Mr. Holden's experience and analysis confirm substantial weight should be provided his opinions. *Compare Square, Inc. v. Think Computer Corp.*, No. CBM2014-00159, Paper No. 47 at p. 28, 2015 WL 7695141, at *13 (PTAB Nov. 27, 2015) ("any purported inconsistencies or gaps in knowledge are vastly outweighed by [expert's] background, analysis, and supporting evidence, which we find credible and persuasive overall."). .

IPR2016-00921, IPR Petition, Paper 1, Ex. 1003, at ¶¶ 3-5; Petitioner's Reply, Paper 10, at 7 (citing Ex. 2004, 141:13-20), *see also* Ex. 2004, 140:14-141:2; IPR2016-00922, *id.*

Owner's Declaration Mechanics Critique is a "Waste of Time"

- "First, it does not matter how a declaration for direct testimony is prepared, who suggested what, what changes were made, how drafts and the final declaration were transmitted to a witness for signature, etc. If a witness signed a declaration, a good starting point is to presume that the witness agrees with the content of the declaration apart from who wrote it and how many changes were made or why they were made." *Pevarello v. Lan*, Pat. Int. No. 105,394 MPT, Paper No. 85, at 21, 2007 WL 594728, at *11 (BPAI Jan. 12, 2007).
- "We find that the manner of [Expert's] testimony is completely in line with typical testimony before the Board, and agree with Petitioner that, absent much further elaboration and analysis (which we do not authorize), Patent Owner's line of inquiry concerning the mechanics of declaration preparation is 'a waste of time, both for the witness and the Board.'" *Square, Inc. v. Think Computer Corp.*, No. CBM2014-00159, Paper No. 47 at pp. 26-27, 2015 WL 7695141, at *13 (PTAB Nov. 27, 2015) (quoting *Pevarello, supra.*)

Owner's Declaration Mechanics Critique is Unsupported

- Owner Response at 15 falsely asserts that Mr. Holden admitted that he did not author his declaration.

> He admitted during cross-examination that Petitioner's counsel wrote the declaration for him. (Ex. 2004, 12:5-11.)

- But Mr. Holden's actual testimony confirms that his declaration contains his own description of his opinions.

5 Q. Did you personally write the declaration
6 that is marked Exhibit 1003?
7 A. I worked with counsel one on one to
8 basically give her a verbal description of my
9 opinions and -- and my thoughts on the -- on these
10 issues, and she did the actual typing of the
11 document.

12 Q. Did you do any of the actual typing of the
13 document that's marked Exhibit 1003?
14 A. I may have put into my own words some
15 certain parts of it to give her, you know, a more
16 clarified description, but basically I narrated
17 through the document the -- the descriptions that
18 were my own.

IPR2016-00921, Petitioner's Reply, Paper 10, at 3 (citing Ex. 2004, 12:7-11, 12:12-18); Owner's Response, Paper 9, at 15 (citing Ex. 2004, 12:5-11).
IPR2016-00922, Petitioner's Reply, Paper 10, at 3 (citing Ex. 2004, 12:7-11, 12:12-18); Owner's Response, Paper 9, at 19 (citing Ex. 2004, 12:5-11).

Owner's "Texture" Critiques are Unpersuasive

- "Texture" was not submitted for construction, but Mr. Holden explained the skilled artisan's understanding of the phrase.

Q. Do you have an opinion on what "texture" would mean to a person of ordinary skill in the art in the context of the '598 patent marked as Exhibit 1001?
A. Yeah. So my understanding of this would be when you are having those courses, when you're having the variation in the needle configurations and it is varying the color or the -- the -- the creation of an outline or the creation of a pattern or the creation of whatever it may be within the outline, those would be varying types of textures.
Q. So different colors, in your opinion, are different textures?
A. Different colors could be part of different textures --

Q. Can you feel a texture?
A. Not necessarily. Texture, in my opinion, also has something to do with patterns, because people perceive certain patterns to have depth and -- and texture to them.
Q. What do you mean when you say "people perceive certain patterns to have depth...to them"?
A. So if you knit a pattern that has black and red together, people perceive that sometimes to have a texture to it, to be a somewhat rough texture, even though one could make the argument that it's smooth.
Q. So in your hypothetical, if you knitted a pattern that has black and red together, would that pattern have a texture, in your opinion?
A. It may or may not.
Q. How would you determine whether that pattern has a texture?
A. So in this case, if you are creating an outline and it's in red and it may be just a different yarn than the -- the other parts that are not creating that outline, people still could perceive a texture to that, even though it may or may not be, you know, smooth or rough or another type of texture.

IPR2016-00921, Petitioner's Reply, Paper 10, at 4 (citing Ex. 2004, 177:11-25, 178:20-179:19).
IPR2016-00922, *id.*

Owner's "Texture" Critiques are Unpersuasive

- Owner's Response at 16 offers an unsupported attorney argument critique:

> Mr. Holden even offered the incredible testimony that a color is texture in the context of the '598 patent. (*Id.*)

- But the art unequivocally confirms Mr. Holden's testimony:

Texture: visual and hand

Another aspect of textile design is texture, which includes the [redacted] The sensation from touching, holding, or squeezing fabrics is referred to as "hand." Terms that describe texture overlap between the visual surface appearance and the hand include: clingy-rigid, cold-warm, crisp-limp, dry-moist, firm-flexible, heavy-light, opaque-transparent, pliable-stiff, rough-smooth, shiny-dull, stretchy-stable, and thick-thin.

- And, as the Board noted, the 598 and 749 patents also confirm Mr. Holden's testimony:

The different textures 46″-48″ are formed *by merely varying the type of stitch formed* by the wide-tube circular knitting machine at each location of textile element 40″. Textures 46″-48″ may exhibit aesthetic differences, or the differences may be structural. . . . The air-permeability of textile element 40″ may also vary in the different areas.

IPR2016-00921, Petitioner's Reply, Paper 10, at 4-5 (citing Ex. 1013, p. 5); Institution Decision, Paper 6, at 6 (citing Ex. 1001, 9:39-47).
IPR2016-00922. *id.*

Owner's "Stitch" or Knit Configuration Critiques are Unpersuasive

- "Stitch" or "knit" configuration was not submitted for construction, but Mr. Holden addressed the terms:

THE WITNESS: To give you a more complete answer, I would want to refer to Spencer. But off the top of my head -- and I would -- you know, don't -- didn't memorize all of the types of -- of -- of stitch configurations or knitting configurations, so I can't give you an -- a -- a complete answer about that particular question.

Q. (By Mr. Harris) Can you tell me what a stitch configuration is?
A. In what context?
Q. In any context. Do you have in your mind any definition of a stitch configuration?
MS. WILLIAMS: Objection.
THE WITNESS: I don't recall that that was part of my declaration or anything that I was asked to opine on, so...
Q. (By Mr. Harris) Okay. Do you understand what a knit configuration is?
A. I -- again, I would refer you to the text of a knit configuration. I generally have an understanding of what a knit configuration is, but I would refer to the text to get a more complete answer to that question.
Q. What's your general understanding of a knit configuration?
A. As it applies to almost any type of configuration, basically it is -- it relates to the design, possibly the outline, of how a process is applied.

IPR2016-00921, Petitioner's Reply, Paper 10, at 4 (citing Ex. 2004, 78:22-79:18); Owner's Response, Paper 9, at 16 (citing Ex. 2004, 78:14-21).
IPR2016-00922, Petitioner's Reply, Paper 10, at 4 (citing Ex. 2004, 78:22-79:18); Owner's Response, Paper 9, at 21 (citing Ex. 2004, 78:14-21).

Owner's Reed Term Critiques are Unpersuasive

- Reed uses "knit interlock stitch," "interknitted stitch," "interconnecting knitted stitches," and "interconnecting knitting" interchangeably.
- Reed's "interknitted" or "interlock" terms were not part of any disclosure relied upon or in dispute and, in any event, Mr. Holden appropriately referenced the treatise identified in his declaration.

Q. So as you sit here right now, you can't describe to me what a knit interlock stitch is; is that correct?
A. And I don't believe --
MS. WILLIAMS: Objection.
THE WITNESS: Yeah. I don't believe that I was asked to opine on that particular issue. I have seen it in here. To give you a more proper description, I would refer to the text, as with any.

Q. (By Mr. Harris) Mr. Holden, what is an interknitted stitch?
MS. WILLIAMS: Object to form.
THE WITNESS: So any of these references to types of stitch I may have heard in the course -- or been exposed to in the course of over 30 years in working with footwear and apparel, but in this particular case, to give an exact answer, I would defer to the text, especially a text such as Spencer, which gives a very thorough and complete description of that particular process or that particular action.

Q. (By Mr. Harris) So besides pointing to Spencer, you can't, as you sit here right now, give me a definition of "interknitted stitch"; correct?
A. I cannot --
MS. WILLIAMS: Objection. Mischaracterizes.
THE WITNESS: To give you a more complete answer, I would want to refer to Spencer. But off the top of my head -- and I would -- you know, don't -- didn't memorize all of the types of -- of -- of stitch configurations or knitting configurations, so I can't give you an -- a -- a complete answer about that particular question.

IPR2016-00921, Petitioner's Reply, at 4-5, 6 (citing Ex. 1006, 1:58-64), 17 (citing Ex. 1006, 3:9-15); IPR Petition, Paper 1, at 21, 23 (citing Ex. 1006, 5:3-18), Owner's Response, Paper 9, at 16 (citing Ex. 2004, 77:4-13, 77:20-78:21).
IPR2016-00922, Petitioner's Reply, at 4-5, 6 (citing Ex. 1006, 1:58-64), 16 (citing Ex. 1006, 3:9-15); IPR Petition, Paper 1, at 16, 17, 26, 27 (citing Ex. 1006, 5:3-18), Owner's Response, Paper 9, at 21 (citing Ex. 2004, 77:4-13, 77:20-78:21).

Owner's Reed Term Critiques are Unpersuasive

7.1 Introduction

Four primary structures – plain, rib, interlock and purl – are the base structures from which all weft knitted fabrics and garments are derived. Each is composed of a different combination of face and reverse meshed stitches, knitted on a particular arrangement of needle beds. Each primary structure may exist alone, in a modified form with stitches other than normal cleared loops, or in combination with another primary structure in a garment-length sequence.

All weft knitted fabric is liable to unrove (unravel), or ladder, from the course knitted last, unless special 'locking courses' are knitted, or unless it is specially seamed or finished.

Plain is produced by the needles knitting as a single set, drawing the loops away from the technical back and towards the technical face side of the fabric.

Rib requires two sets of needles operating in between each other so that wales of face stitches and wales of reverse stitches are knitted on each side of the fabric.

Interlock was originally derived from rib but requires a special arrangement of needles knitting back-to-back in an alternate sequence of two sets, so that the two courses of loops show wales of face loops on each side of the fabric exactly in line with each other, thus hiding the appearance of the reverse loops.

9.1 Knitted stitches

Weft knitted stitches described so far have been composed entirely of knitted loops. A *knitted loop stitch* is produced when a needle receives a new loop and knocks-over the old loop that it held from the previous knitting cycle. The old loop then becomes a needle loop of normal configuration.

Other types of stitch may be produced on each of the four-needle arrangement base structures by varying the timing of the intermeshing sequence of the old and new loops. These stitches may be deliberately selected as part of the design of the weft knitted structure or they may be produced accidentally by a malfunction of the knitting action so that they occur as fabric faults. When these stitches are deliberately selected, a preponderance of knitted loop stitches is necessary within the structure in order to maintain its requisite physical properties.

The needles generally produce knitted loop stitches prior to the commencement, and at the termination, of these selected stitches, and there are usually certain needles that are knitting normally during the same cycles as those in which these stitches are produced.

Apart from the knitted loop stitch, the two most commonly-produced stitches are the *float stitch* and the *tuck stitch*. Each is produced with a *held loop* and shows its own particular loop most clearly on the reverse side of the stitch because the limbs of the held loop cover it from view on the face side.

7.4 Interlock structure

Although the American *Scott and Williams* Patent of 1908 for interlock was extended for 20 years, underwear manufacturers found the needles expensive, especially on the larger 20 inch (51 cm) diameter model. Suitable lustery twist cotton yarn only became available in 1925, and the first stationary cam-box machine appeared in 1930.

Originally, interlock was knitted almost solely in cotton on 20 gauge (needles per inch) machines for underwear, a typical weight being 5 oz per square yard (170g per square metre) using 1/40's s cotton, but from the 1950s onwards, 18 gauge machines were developed for knitting double-jersey for semi-tailored suiting because the open-width fabric could be finished on existing equipment. As the machines became more versatile in their capabilities, the range of structures became greater.

Interlock has the technical face of plain fabric on both sides, but its smooth surface cannot be stretched out to reveal the reverse meshed loop wales because the wales on each side are exactly opposite to each other and are locked together (fig. 7.14). Each interlock pattern row (often termed an '*interlock course*') requires two feeder courses, each with a separate yarn that knits on separate alternate needles, producing two half-gauge 1 × 1 rib courses whose sinker loops cross over each other. Thus, odd feeders will produce alternate wales of loops on each side and even feeders will produce the other wales.

Interlock relaxes by about 30–40 per cent or more, compared with its knitted width, so that a 30-inch (76cm) diameter machine will produce a tube of 94-inch (2.4m) open width which finishes at 60–66 inches (1.5–1.7m) wide. It is a balanced, smooth, stable structure that lies flat without curl. Like 1 × 1 rib, it will not unrove from the end knitted first, but it is thicker, heavier and narrower than rib of equivalent gauge, and requires a finer, better, more expensive yarn.

As only alternate needles knit at a feeder, interlock machines can be produced in finer gauges than rib, with less danger of press-offs. Interlock knitting is, however, more of a problem than rib knitting. Because productivity is half, less feeders can be accommodated, and there are finer tolerances. When two different-coloured

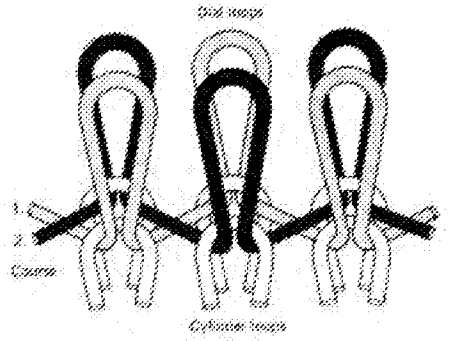


Fig. 7.14 Interlock fabric structure.

IPR2016-00921, Petitioner's Reply, Paper 10, at 5 (citing Ex. 1003, ¶12); IPR Petition, Paper 1, Ex. 1010, at 87, 100, 117.
IPR2016-00922, *id.*

Owner's Nishida Critiques are Unpersuasive

- Mr. Holden repeatedly provided comprehensive answers to questions regarding Nishida.

Q. Okay. So I'm asking you what Nishida means when Nishida says, "...cutting out [the] layouts from the web of material and stitching the parts of the shoe upper to a top part." What does that mean in Nishida?

A. So, okay, again, as you -- if you are doing the knitting process and you are knitting the outline and the patterns of the outline, the inside of the outline, into a circular web of materials, then that would be the pattern that you are cutting then out of a web of materials.

Q. Okay. So that's the first part?

A. Okay.

Q. And then the second part is "stitching the parts of the shoe upper to a top part."

What's that mean?

A. I think -- I'm not really clear exactly what that means, but I see that -- that it is then taking that and fastening related part to the sole edge of the cut-open outside edge of the assigned layout.

And in Nishida's patent -- in Nishida's drawing, they have -- for example, the tongue is separate and would need to be restitched and the outsole, the -- excuse me, the -- the inside lining material would be -- have to be -- and cut out of the web of materials and then stitched together to create the inner lining that would then be attached to the sole. So that is how I would construe this reading through this.

Q. Well, so you just described the next part of the sentence, but the part of the --

A. Yeah.

Q. -- sentence that I was asking you about was "stitching the parts of the shoe upper to a top part," and I think I heard you testify that you're not exactly sure what that means.

A. I'm not exactly because it's not clearly descriptive, but my -- in -- in further reading of Nishida and looking at the patterns described, they have -- in this web, they have that -- the -- the sock, if you will, and the tongue separated.

So I assume that they're talking about, especially in the case of -- the sock has to be stitched, the heel has to be stitched, seamed

IPR2016-00921, Petitioner's Reply, Paper 10, at 5 (citing Ex. 2004, 164:4-165:23).
IPR2016-00922, *id.*

Owner's 325(d) Arguments Are Improper

- *Square, Inc. v. Think Computer Corp.*, No. CBM2014-00159, Paper No. 47 at p. 28, 2015 WL 7695141, at *13 (PTAB Nov. 27, 2015) (Rejecting patentee's argument to dismiss trial after institution based on similar art presented in prosecution because "35 U.S.C. § 325(d) is normally exercised in a Decision on Institution," and "we have already conducted a full trial in this proceeding subsequent to a Decision on Institution.").

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00921
Patent No. 7,814,598

PATENT OWNER'S EXHIBIT LIST
(AS OF JULY 11, 2017)

LIST OF EXHIBITS

2004	Transcript of the Deposition of Lenny M. Holden (January 10, 2017)
2005	Patent Owner NIKE's Demonstratives for Use at Oral Hearing

Date: July 11, 2017

Respectfully submitted,

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The undersigned hereby certifies that a copy of the foregoing was served on July 11, 2017, by email directed to the attorneys of record for Petitioner as follows:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
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Nike, Inc.
Patent Owner

Case IPR2016-00921
Patent No. 7,814,598

PETITIONER'S EXHIBIT LIST
(AS OF JULY 11, 2017)

LIST OF EXHIBITS

1001	U.S. Patent No. 7,814,598
1002	File History for U.S. Patent No. 7,814,598
1003	Declaration of Lenny Holden
1004	C.V. for Lenny Holden
1005	Form PTO-SB/42 (7,814,598)
1006	U.S. Patent No. 3,985,003 to Reed
1007	U.S. Patent No. 4,038,840 to Castello
1008	U.S. Patent No. 6,330,814 to Fujiwara
1009	U.S. Patent No. 5,345,638 to Nishida
1010	David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third Ed., Woodhead Publishing Ltd. 2001)
1011	Paul Burall, "CoID Design Awards," Design, June 1969, pp. 46-47
1012	ISO 8117:2003(E) Textile machinery - Knitting machines - Nominal diameters of circular machines
1013	Ardis W. Koester, "Analyzing the Color, Design, and Texture of Fabric," Oregon State University Extension Service, May 1993
1014	Definition of "Impart" from Merriam-Webster
1015	Declaration of Tiffany L. Williams
1016	Petitioner's Demonstratives

Dated: July 11, 2017

By: /s/ Mitchell G. Stockwell

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG,
Petitioner

v.

NIKE, Inc.,
Patent Owner

Case IPR2016-00921 (Patent 7,814,598)
Case IPR2016-00922 (Patent 8,266,749)

PATENT OWNER NIKE, INC.'S DEMONSTRATIVES

Skechers EX1013-p. 229
Skechers v Nike

Overview of the ’598 and ’749 Patents

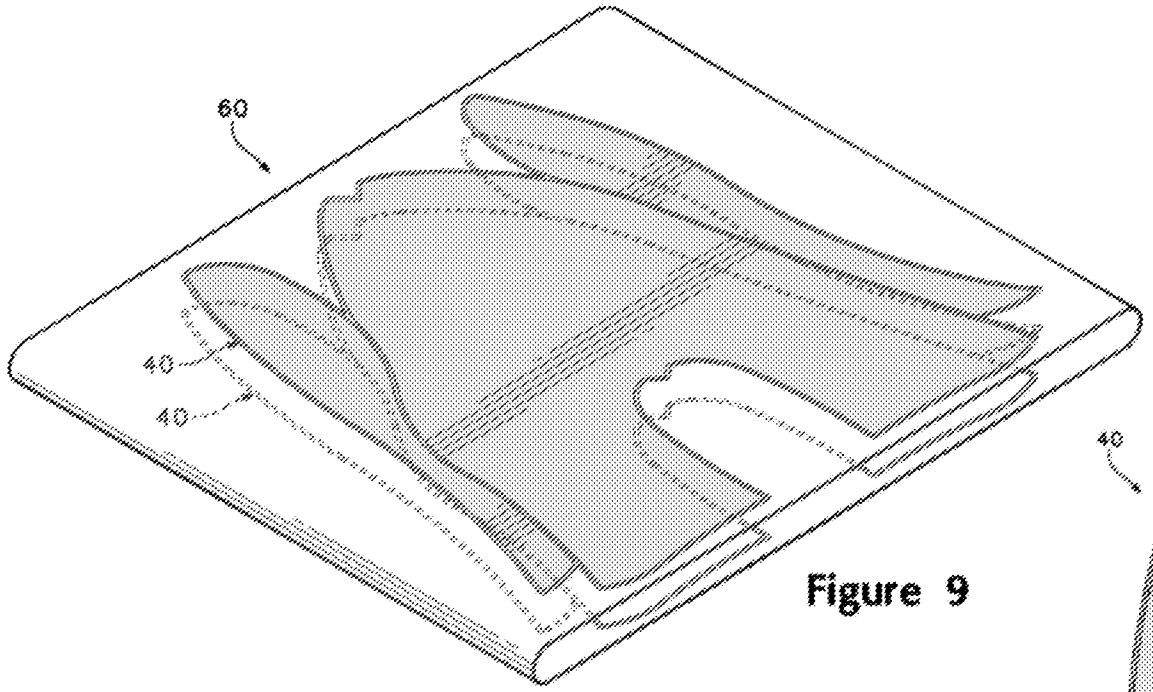


Figure 9

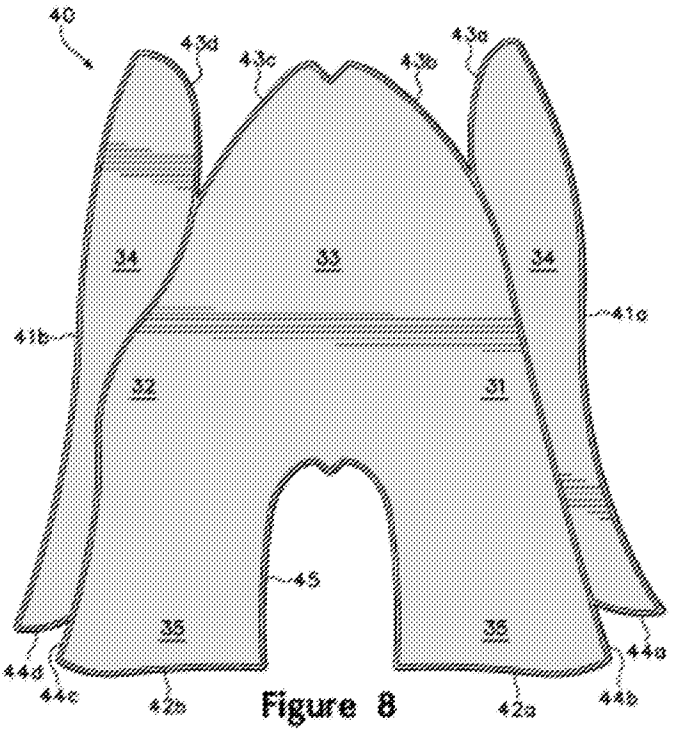


Figure 8

Source
IPR2016-00921 PO Response, pp. 5-10
IPR2016-00922 PO Response, pp. 5-10
Exhibit 1001, Figures 8-9

Overview of the ’598 and ’749 Patents

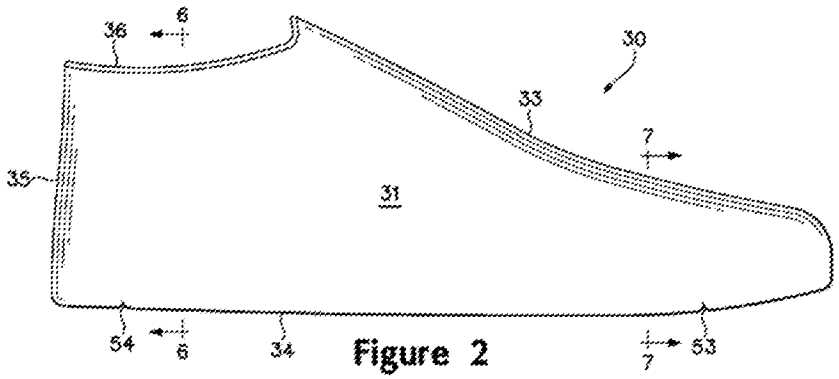


Figure 2

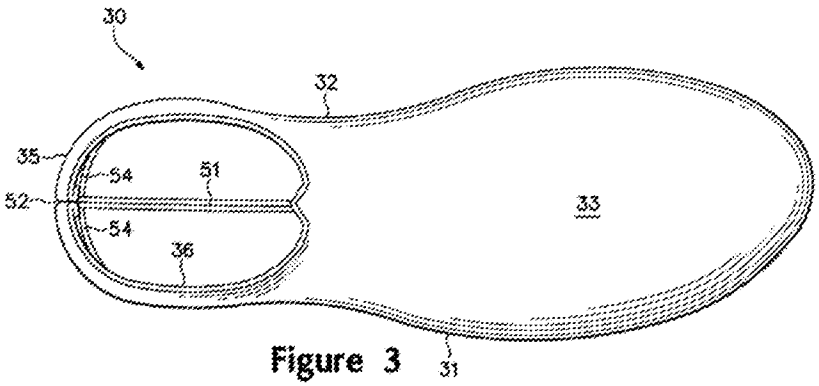


Figure 3

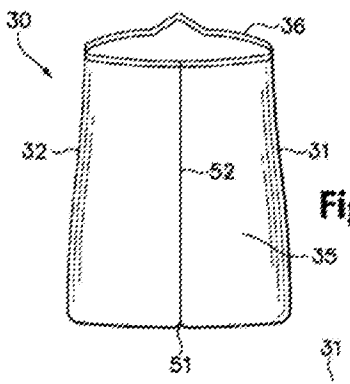


Figure 4

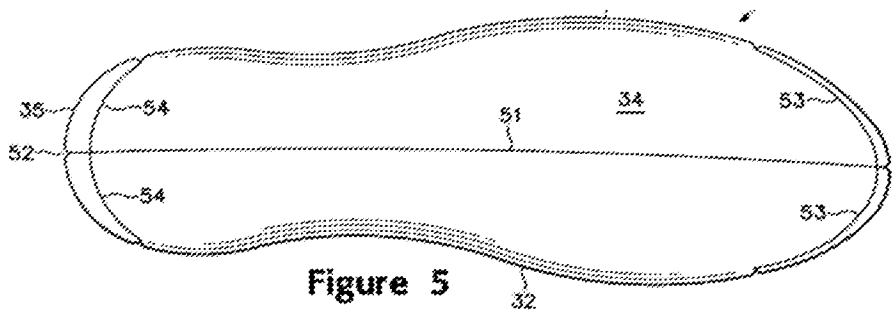


Figure 5

Source
IPR2016-00921 PO Response, pp. 5-10
IPR2016-00922 PO Response, pp. 5-10
Exhibit 1001, Figures 2-5

Overview of the ’598 and ’749 Patents

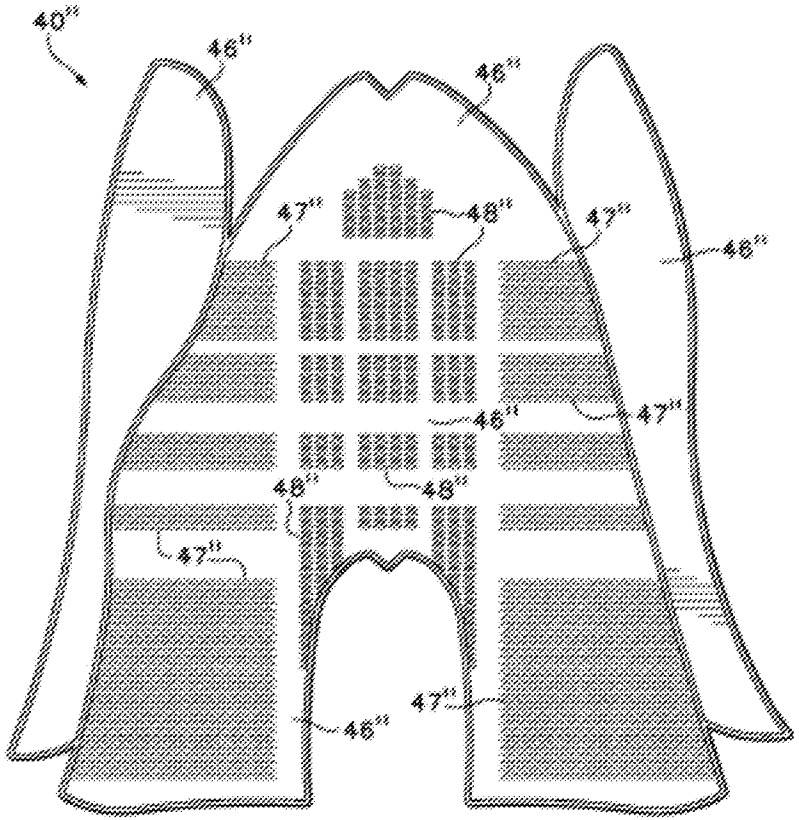


Figure 11

Source
IPR2016-00921 PO Response, pp. 5-10
IPR2016-00922 PO Response, pp. 5-10
Exhibit 1001, Figure 11

Skechers EX1013-p. 232
Skechers v Nike

Representative Claims

Claim 1 of the '598 Patent

1. A method of manufacturing an article of footwear, the method comprising steps of:

mechanically-manipulating a yarn with a circular knitting machine to form a cylindrical textile structure;

removing at least one textile element from the textile structure;

incorporating the textile element into an upper of the article of footwear.

Claim 1 of the '749 Patent

1. A method of manufacturing an article of footwear, the method comprising:

simultaneously knitting a textile element with a surrounding textile structure, the knitted textile element having at least one knitted texture that differs from a knitted texture in the surrounding knitted textile structure;

removing the knitted textile element from the surrounding knitted textile structure;

incorporating the knitted textile element into the article of footwear.

Source

IPR2016-00921 PO Response, p. 5

IPR2016-00922 PO Response, p. 5

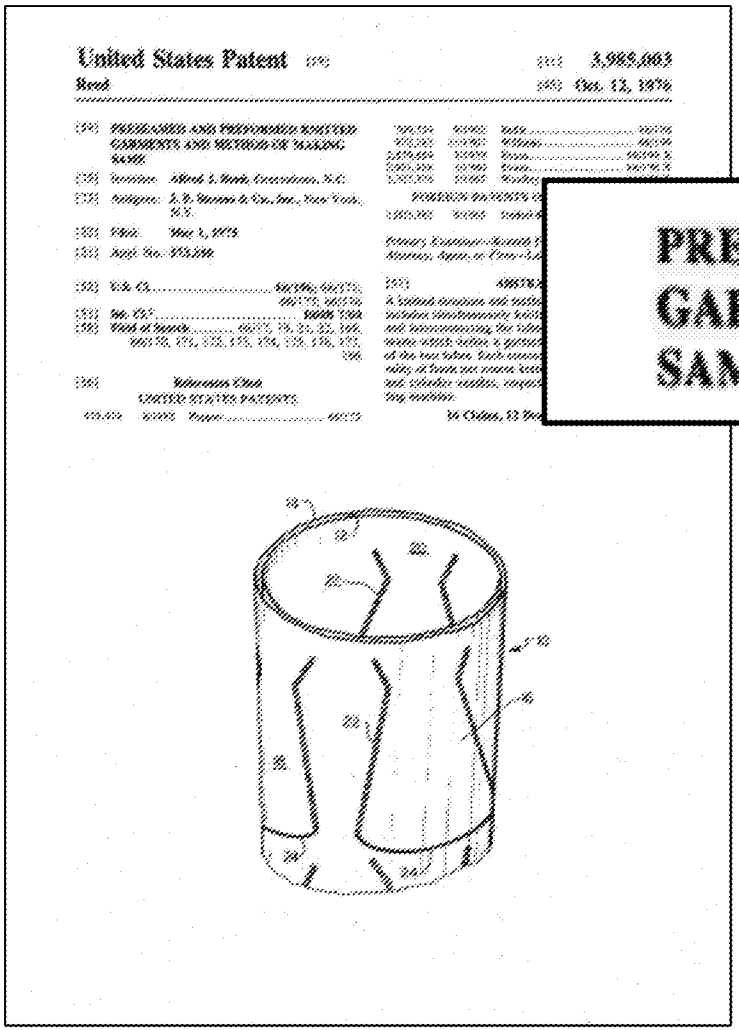
Instituted Grounds

Patent	Claims	Basis	References
'598 patent	1-13	35 USC 103(a)	Reed and Nishida
'749 patent	1-9, 11-19, 21	35 USC 103(a)	Reed and Nishida

Source
IPR2016-00921 Institution Decision, p. 22
IPR2016-00922 Institution Decision, p. 23

Skechers EX1013-p. 234
Skechers v Nike

Reed – Preseamed Garment



United States Patent

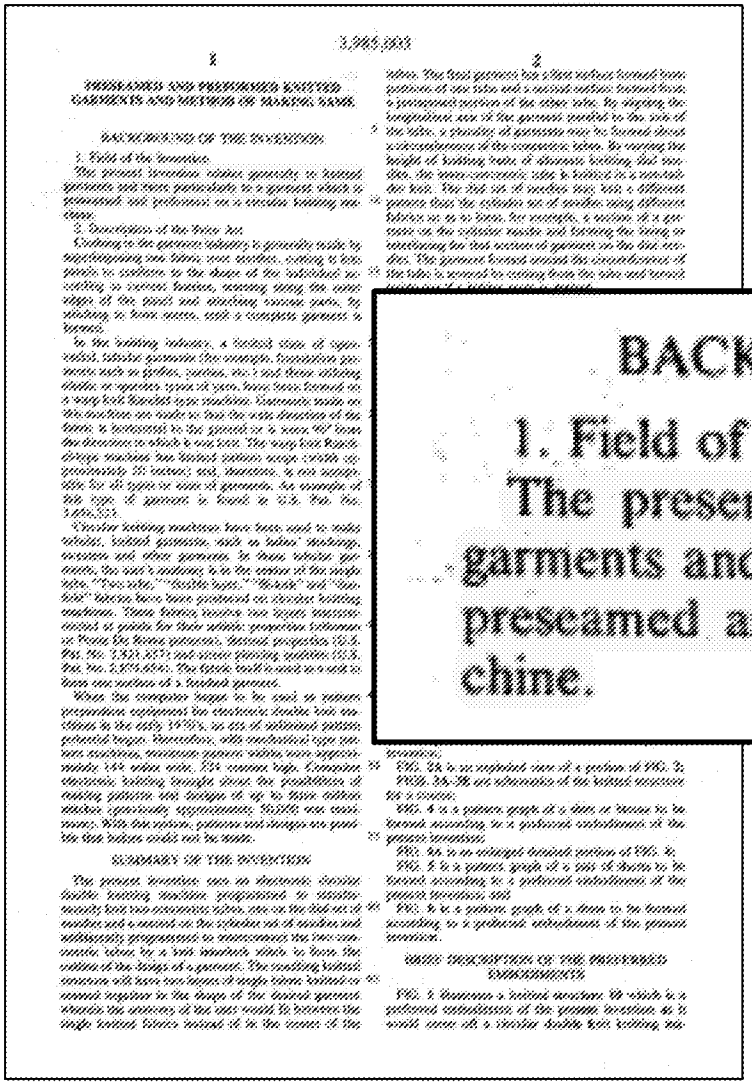
Reed

PRESEAMED AND PREFORMED KNITTED GARMENTS AND METHOD OF MAKING SAME

Source
IPR2016-00921 PO Response, pp. 19-23
IPR2016-00922 PO Response, pp. 24-27
Exhibit 1006, p. 1

Skechers EX1013-p. 235
Skechers v Nike

Reed – Preseamed Garment



BACKGROUND OF THE INVENTION

1. Field of the Invention

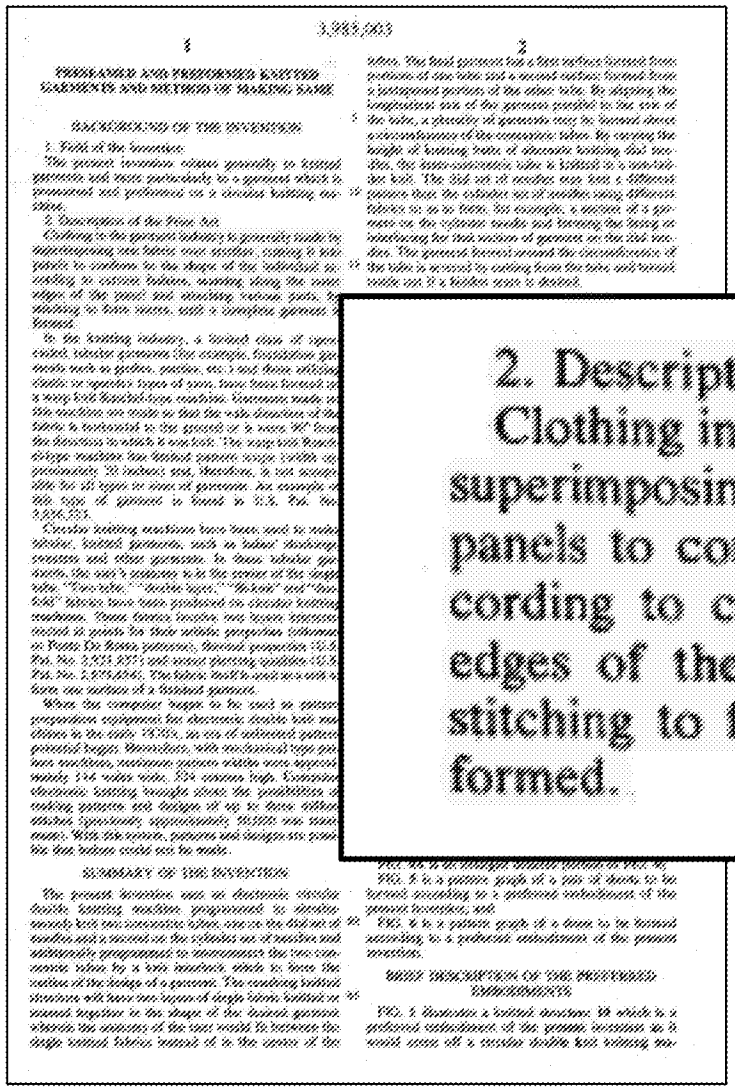
The present invention relates generally to knitted garments and more particularly to a garment which is preseamed and preformed on a circular knitting machine.

Source

IPR2016-00921 PO Response, pp. 19-23
IPR2016-00922 PO Response, pp. 24-27
Exhibit 1006, at 1:8-11

Skechers EX1013-p. 236
Skechers v Nike

Reed – Preseamed Garment



2. Description of the Prior Art

Clothing in the garment industry is generally made by superimposing one fabric over another, cutting it into panels to conform to the shape of the individual according to current fashion, seaming along the outer edges of the panel and attaching various parts, by stitching to form seams, until a complete garment is formed.

Source

IPR2016-00921 PO Response, pp. 19-23

IPR2016-00922 PO Response, pp. 24-27

Exhibit 1006, at 1:13-19

Skechers EX1013-p. 237
Skechers v Nike

Reed – Preseamed Garment

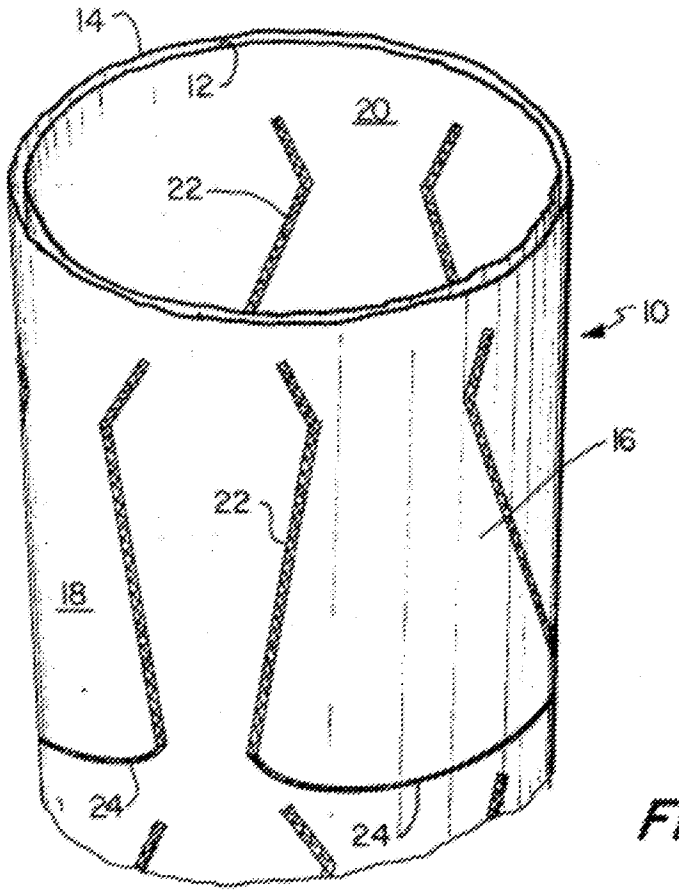
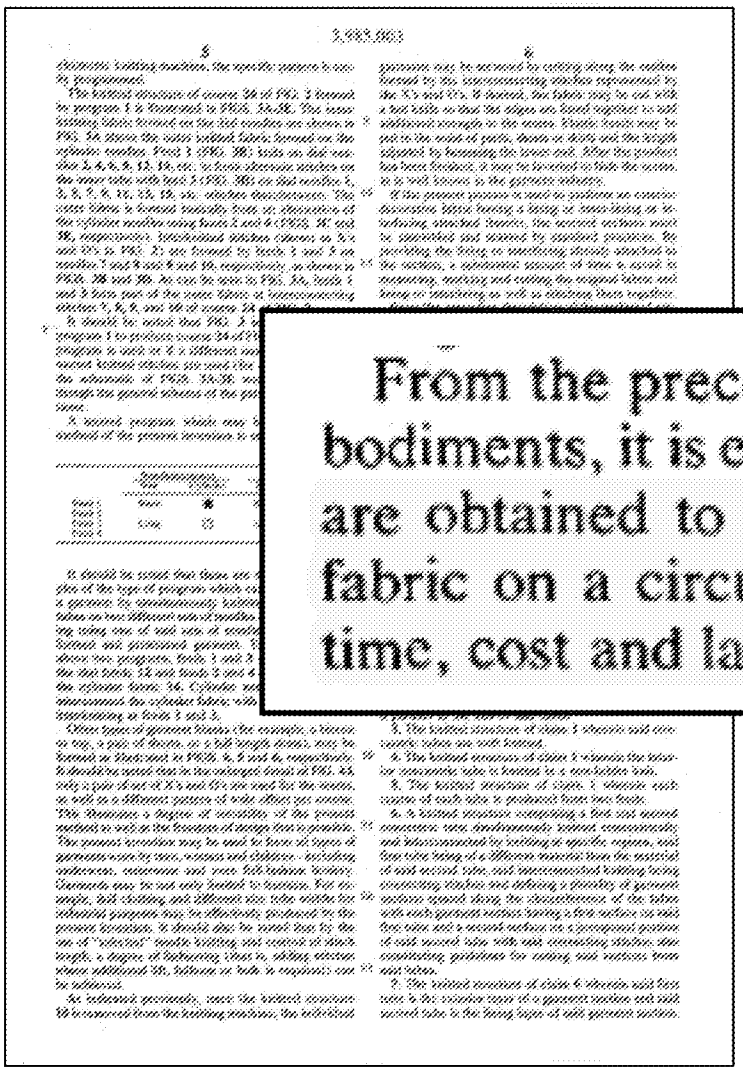


FIG. 1

Source
IPR2016-00921 PO Response, pp. 19-23
IPR2016-00922 PO Response, pp. 24-27
Exhibit 1006, Figure 1

Reed – Preseamed Garment

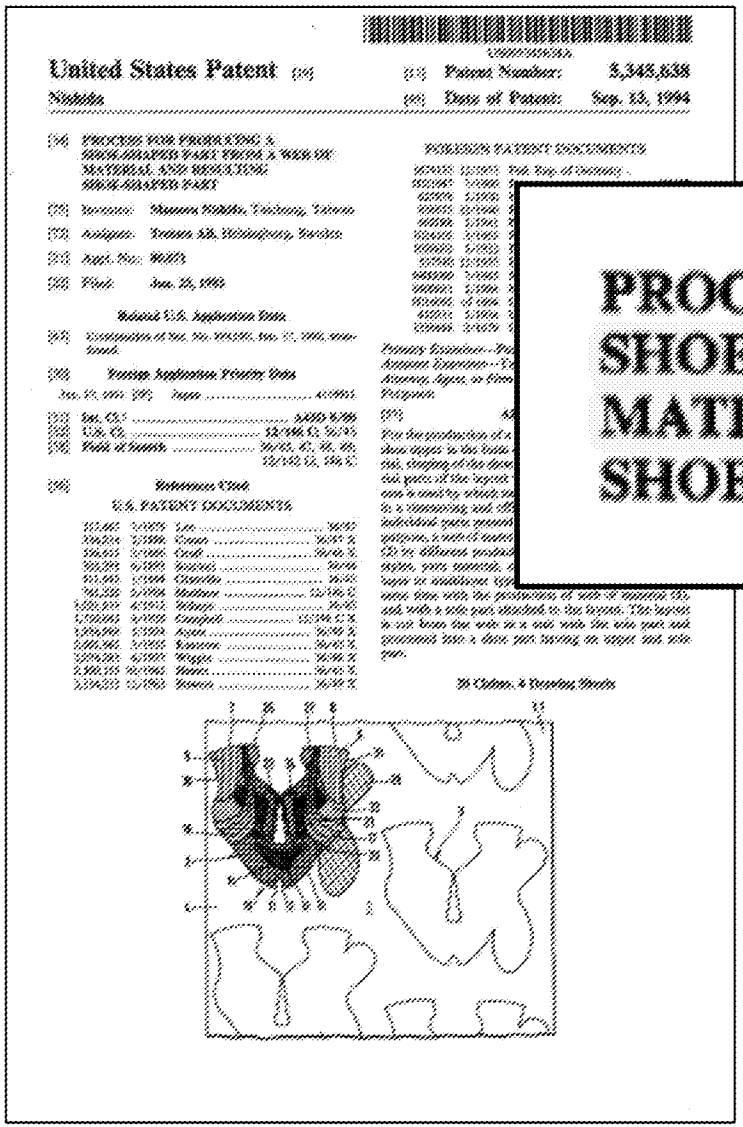


From the preceding description of the preferred embodiments, it is evident that the objects of the invention are obtained to produce a preformed and preseamed fabric on a circular knitting machine so as to reduce time, cost and labor involved in making garments.

Source
IPR2016-00921 PO Response, pp. 19-23
IPR2016-00922 PO Response, pp. 24-27
Exhibit 1006, at 6:18-21

Skechers EX1013-p. 239
Skechers v Nike

Nishida – Layout on/in a preexisting web of material



United States Patent [19]

Nishida

[11] Patent Number: 5,345,638

[45] Date of Patent: Sep. 13, 1994

PROCESS FOR PRODUCING A SHOE-SHAPED PART FROM A WEB OF MATERIAL AND RESULTING SHOE-SHAPED PART

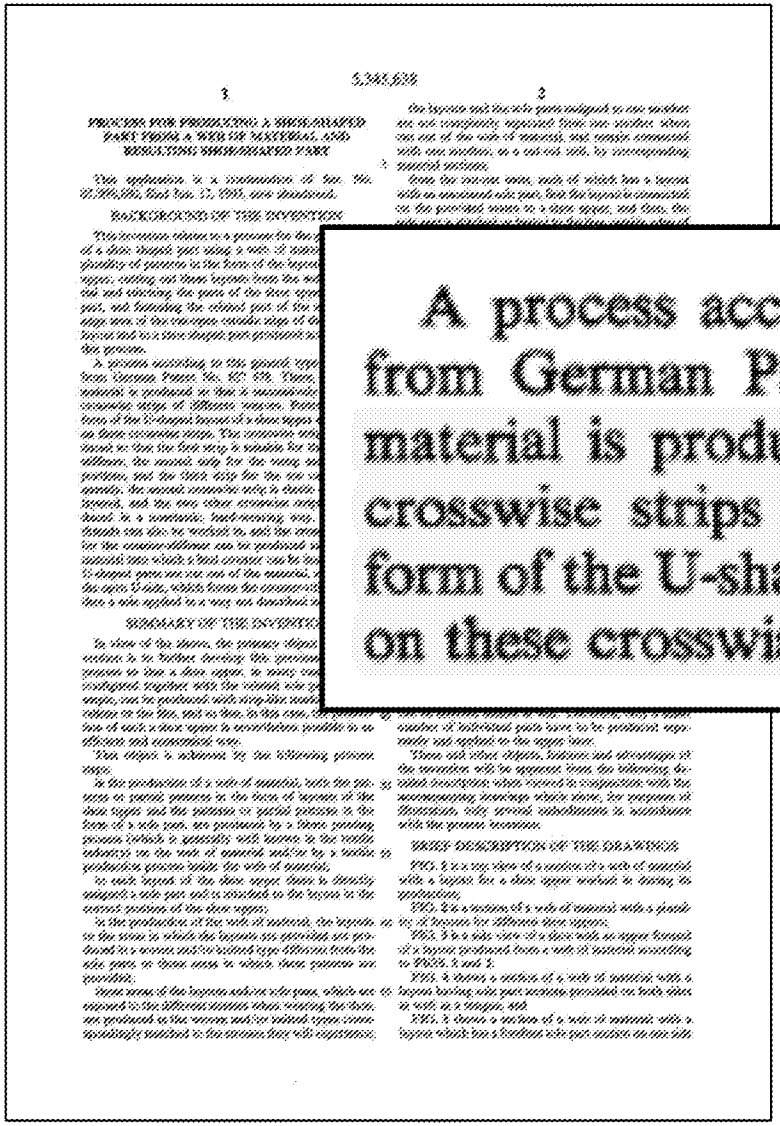
Source

IPR2016-00921 PO Response, pp. 23-27

IPR2016-00922 PO Response, pp. 28-31

Exhibit 1009, p. 1

Nishida – Layout on/in a preexisting web of material



A process according to this general type is known from German Patent No. 627 878. There, a web of material is produced so that it successively has three crosswise strips of different weaves. Patterns in the form of the U-shaped layout of a shoe upper are printed on these crosswise strips.

Source
IPR2016-00921 PO Response, pp. 23-27
IPR2016-00922 PO Response, pp. 28-31
Exhibit 1009, at 1:19-24

Skechers EX1013-p. 241
Skechers v Nike

Nishida – Layout on/in a preexisting web of material



SUMMARY OF THE INVENTION

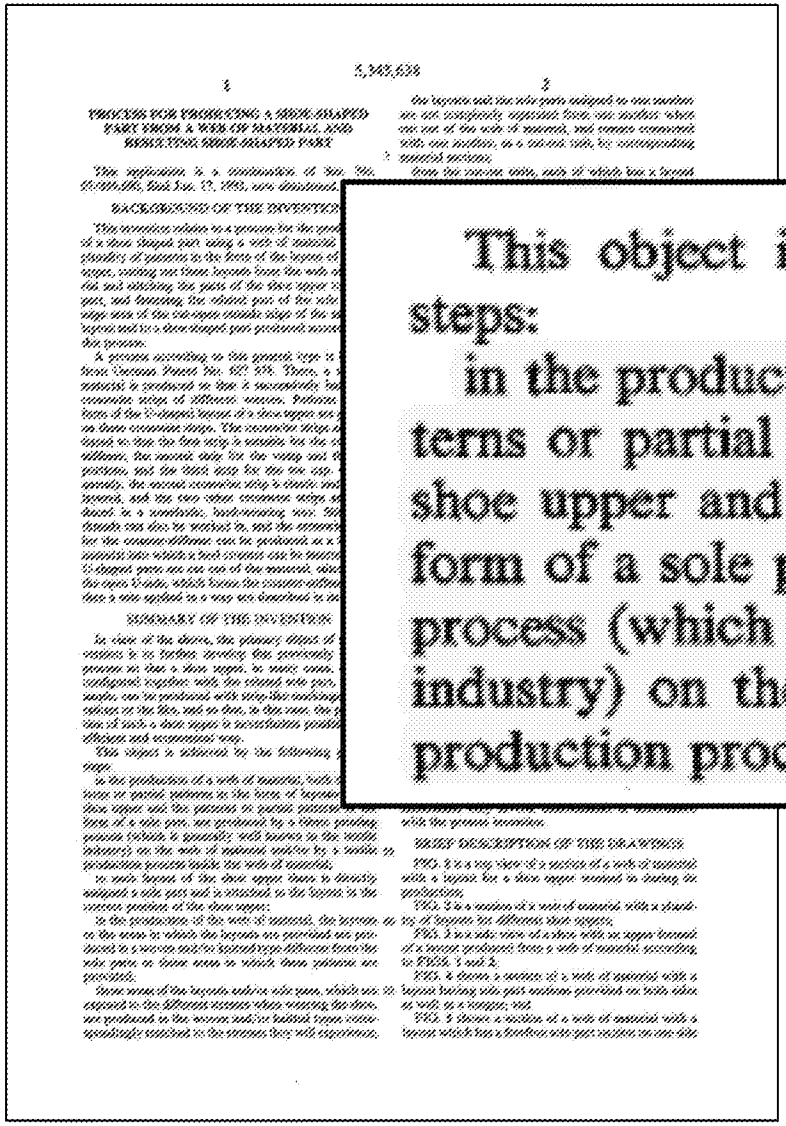
In view of the above, the primary object of this invention is to further develop this previously known process so that a shoe upper, in many cases, can be configured together with the related sole part,

Source

IPR2016-00921 PO Response, pp. 23-27
IPR2016-00922 PO Response, pp. 28-31
Exhibit 1009, at 1:40-43

Skechers EX1013-p. 242
Skechers v Nike

Nishida – Layout on/in a preexisting web of material



This object is achieved by the following process steps:

in the production of a web of material, both the patterns or partial patterns in the form of layouts of the shoe upper and the patterns or partial patterns in the form of a sole part, are produced by a fabric printing process (which is generally well known in the textile industry) on the web of material and/or by a textile production process inside the web of material;

Source

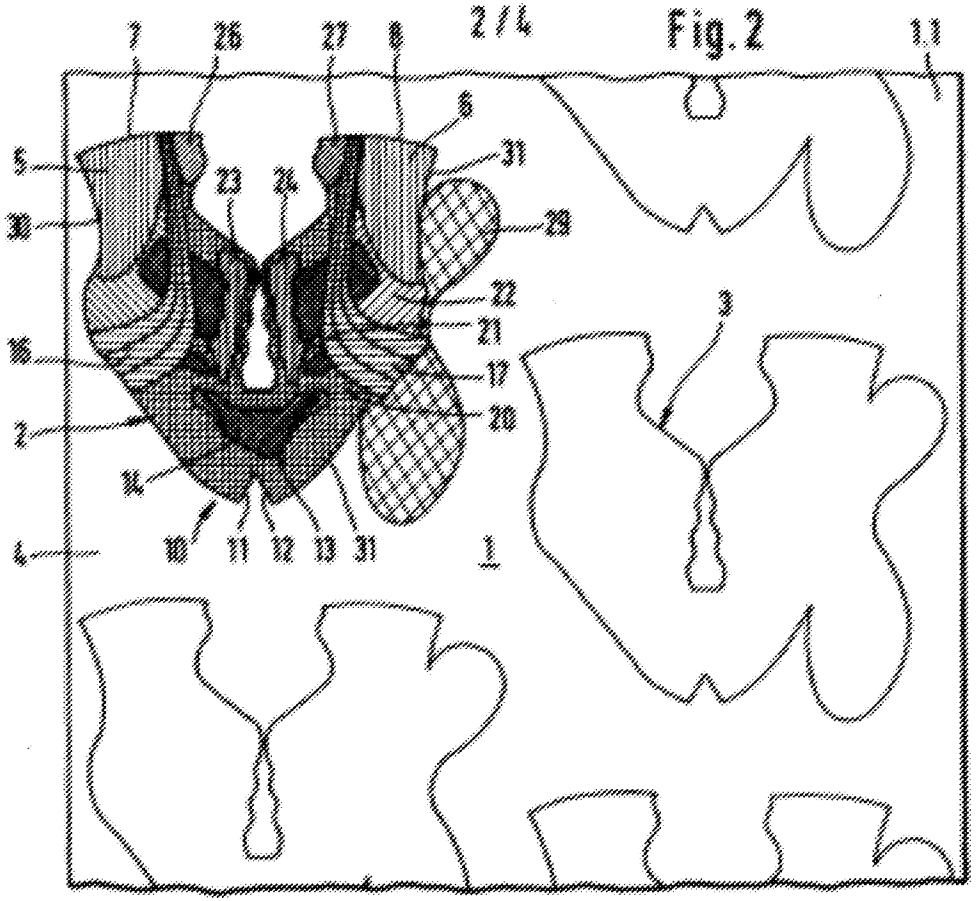
IPR2016-00921 PO Response, pp. 23-27

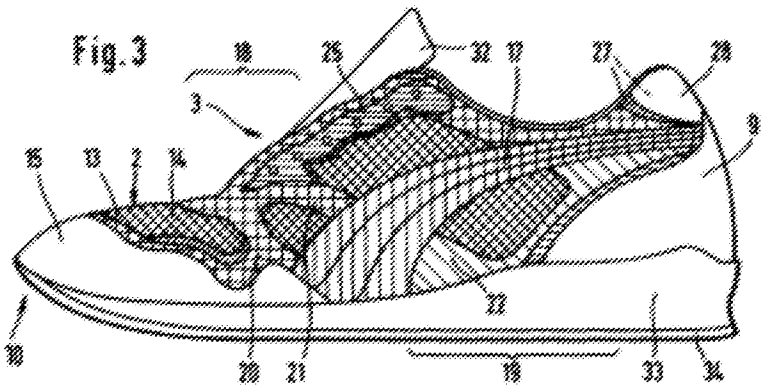
IPR2016-00922 PO Response, pp. 28-31

Exhibit 1009, at 1:48-56

Skechers EX1013-p. 243
Skechers v Nike

Nishida – Layout on/in a preexisting web of material

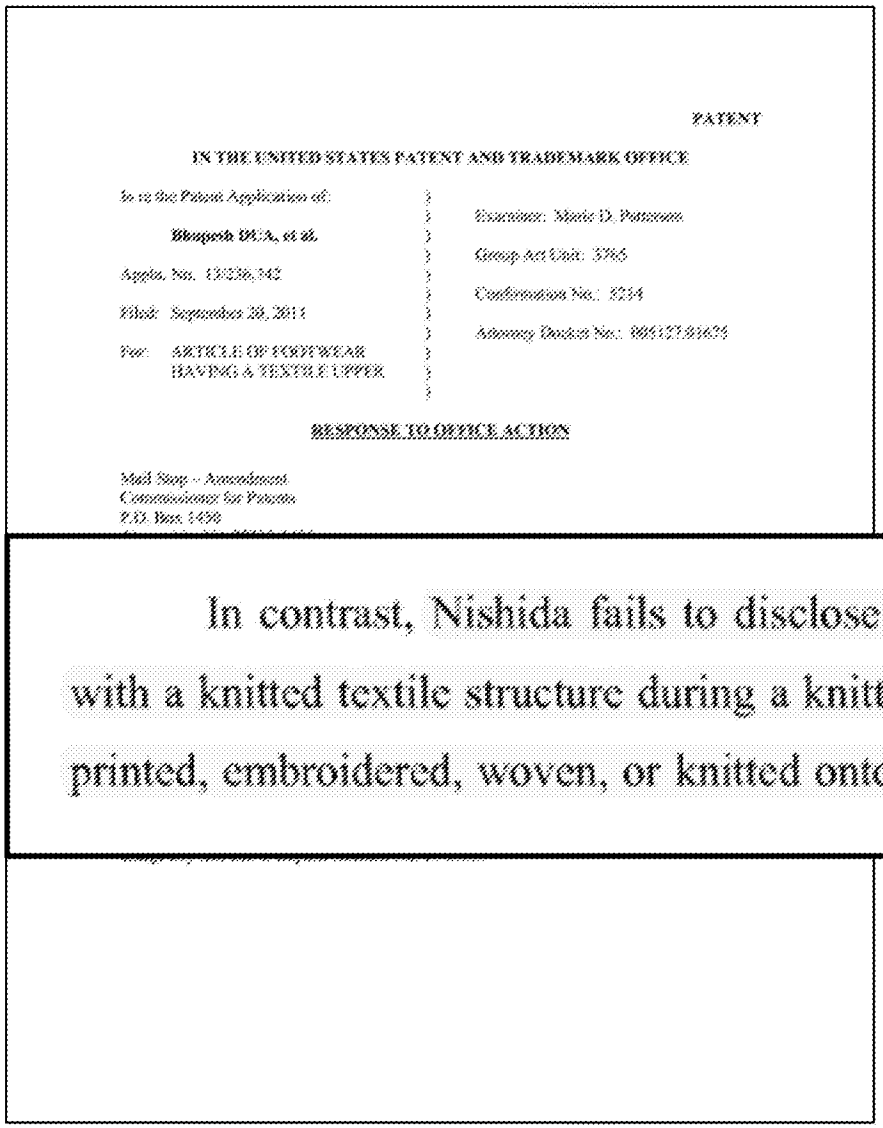




Source
IPR2016-00921 PO Response, pp. 23-27
IPR2016-00922 PO Response, pp. 28-31
Exhibit 1009, Figures 2 and 3

Skechers EX1013-p. 244
Skechers v Nike

Nishida – Layout on/in a preexisting web of material



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of:

Examiner: Marie D. Patterson

Group Art Unit: 3765

Confirmation No.: 8234

Attorney Docket No.: 8001.0161.01

For: ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

RESPONSE TO OFFICE ACTION

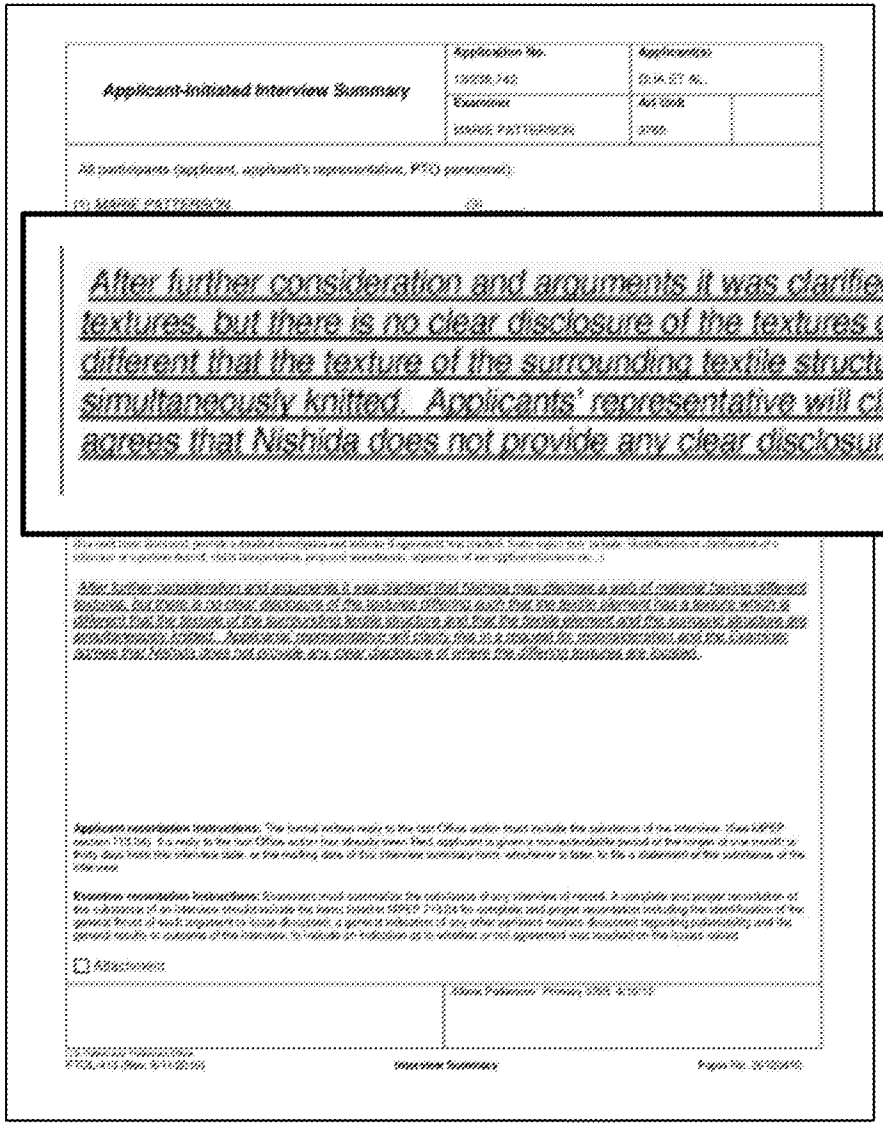
Mail Stop – Amendment
Commissioner for Patents
P.O. Box 1450

In contrast, Nishida fails to disclose a knitted textile element *simultaneously* formed with a knitted textile structure during a knitting process. Nishida discloses that layouts 2 are printed, embroidered, woven, or knitted onto a *pre-existing* backing material 4.

Source
IPR2016-00922 PO Response, p. 11
IPR2016-00922 Exhibit 1002, p. 259

Skechers EX1013-p. 245
Skechers v Nike

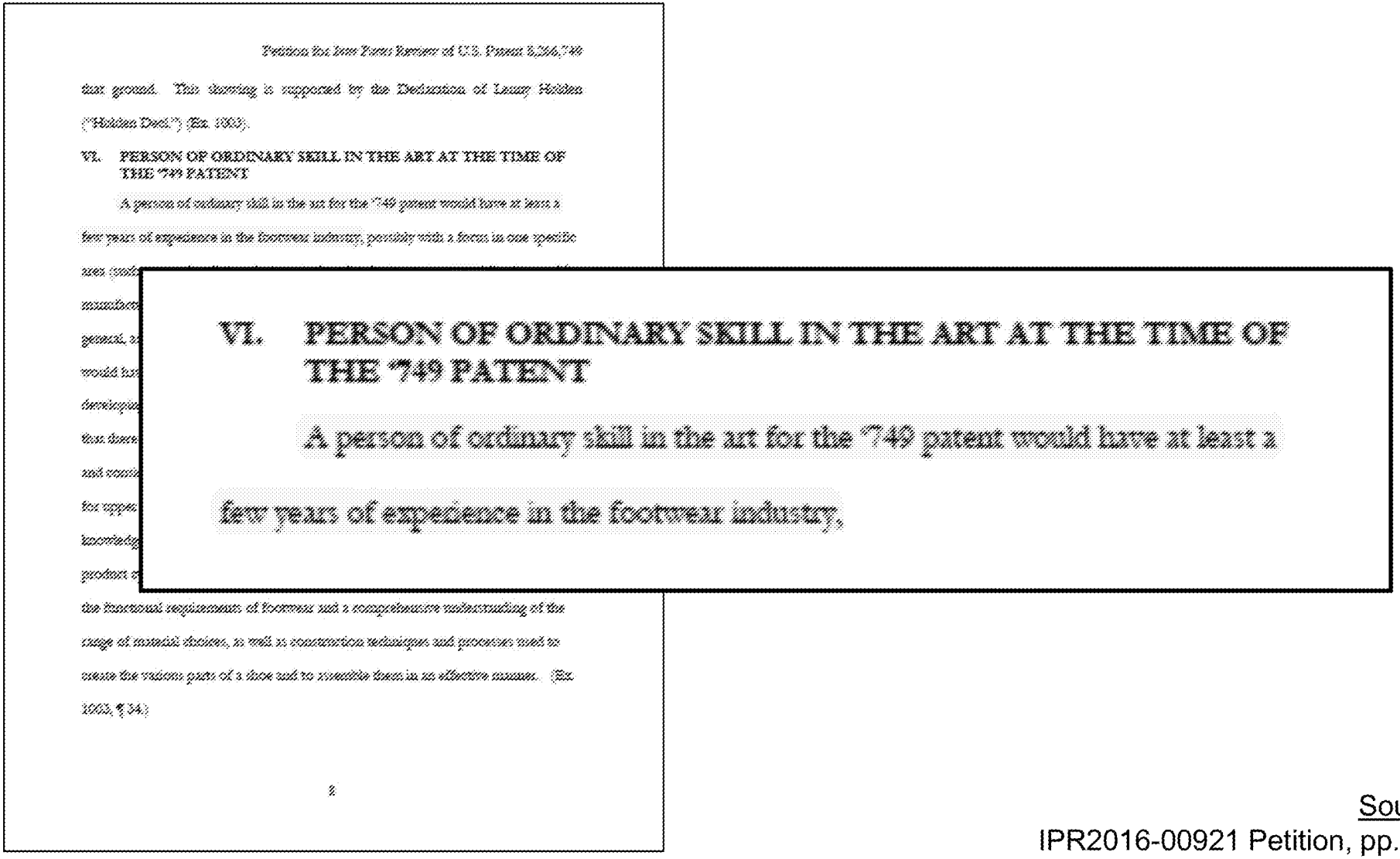
Nishida – Layout on/in a preexisting web of material



Source
IPR2016-00922 PO Response, p. 14
IPR2016-00922 Exhibit 1002, p. 278

Skechers EX1013-p. 246
Skechers v Nike

Petitioner failed to carry its burden



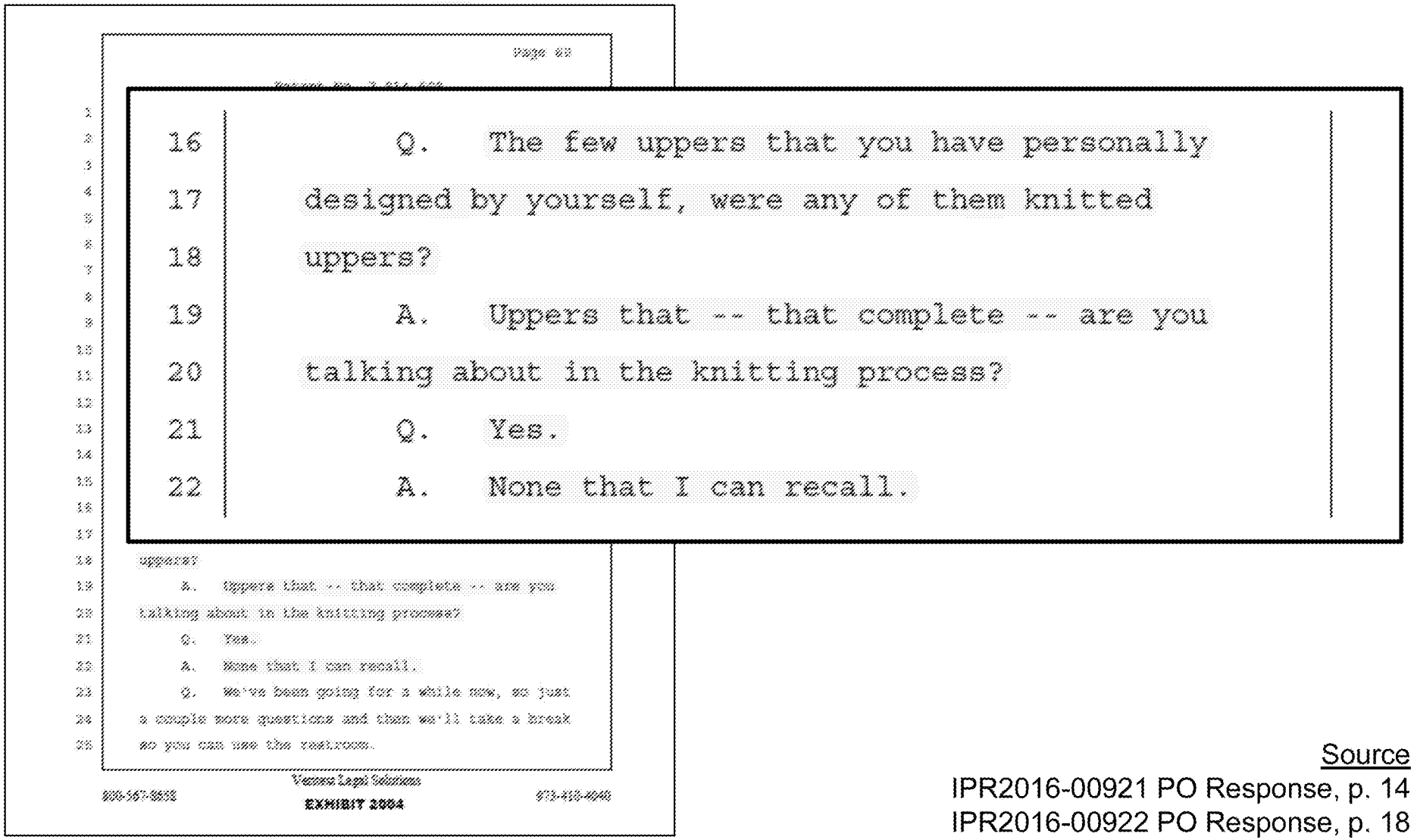
VI. PERSON OF ORDINARY SKILL IN THE ART AT THE TIME OF THE '749 PATENT

A person of ordinary skill in the art for the '749 patent would have at least a few years of experience in the footwear industry,

Source
IPR2016-00921 Petition, pp. 8-9
IPR2016-00922 Petition, p. 8

Skechers EX1013-p. 247
Skechers v Nike

Petitioner failed to carry its burden



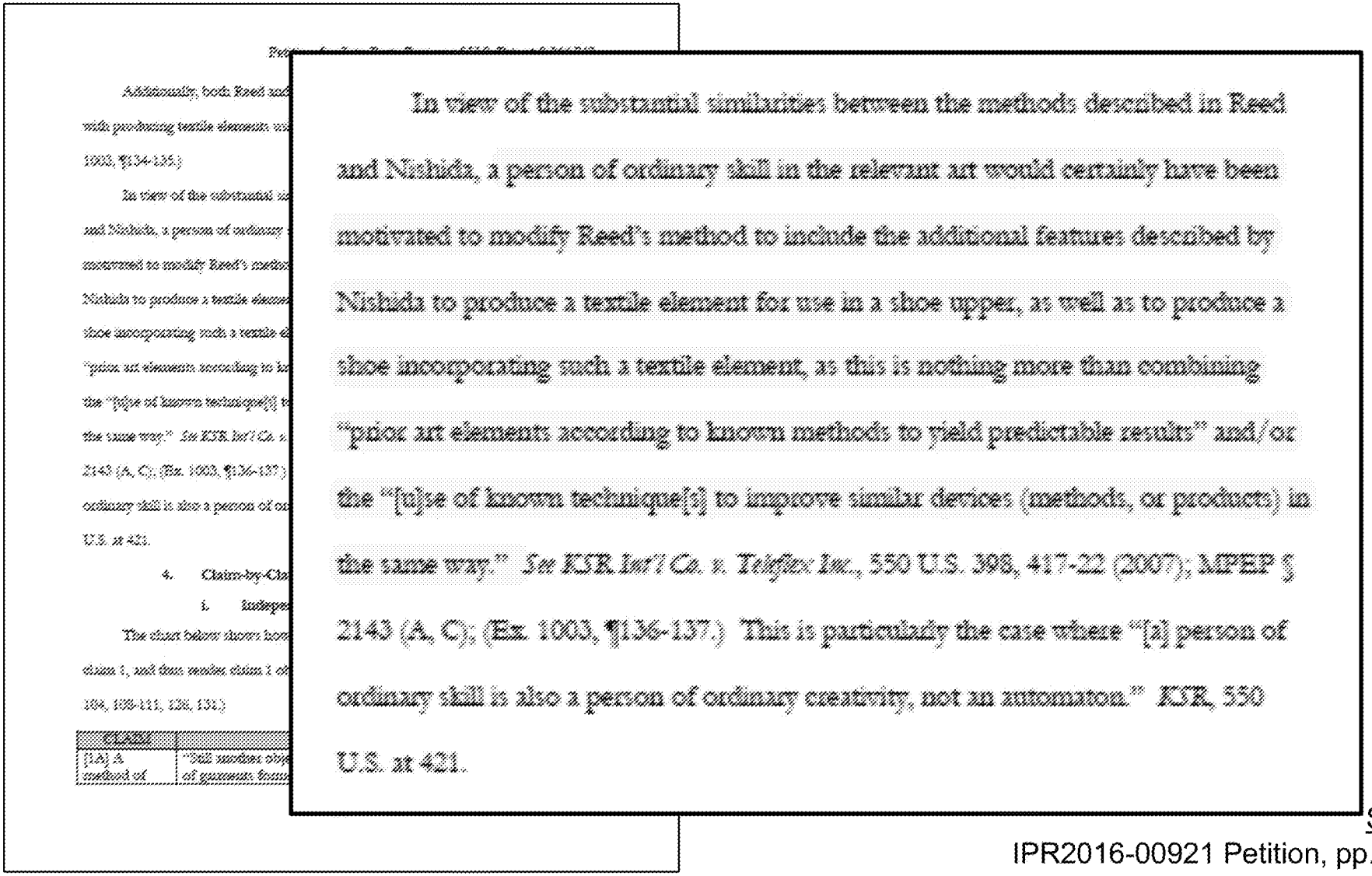
16 Q. The few uppers that you have personally
17 designed by yourself, were any of them knitted
18 uppers?
19 A. Uppers that -- that complete -- are you
20 talking about in the knitting process?
21 Q. Yes.
22 A. None that I can recall.

uppers?
A. Uppers that -- that complete -- are you talking about in the knitting process?
Q. Yes.
A. None that I can recall.
Q. We've been going for a while now, so just a couple more questions and then we'll take a break so you can use the restroom.

EXHIBIT 2004

Source
IPR2016-00921 PO Response, p. 14
IPR2016-00922 PO Response, p. 18
Exhibit 2004, 60:16-22

Petitioner failed to carry its burden



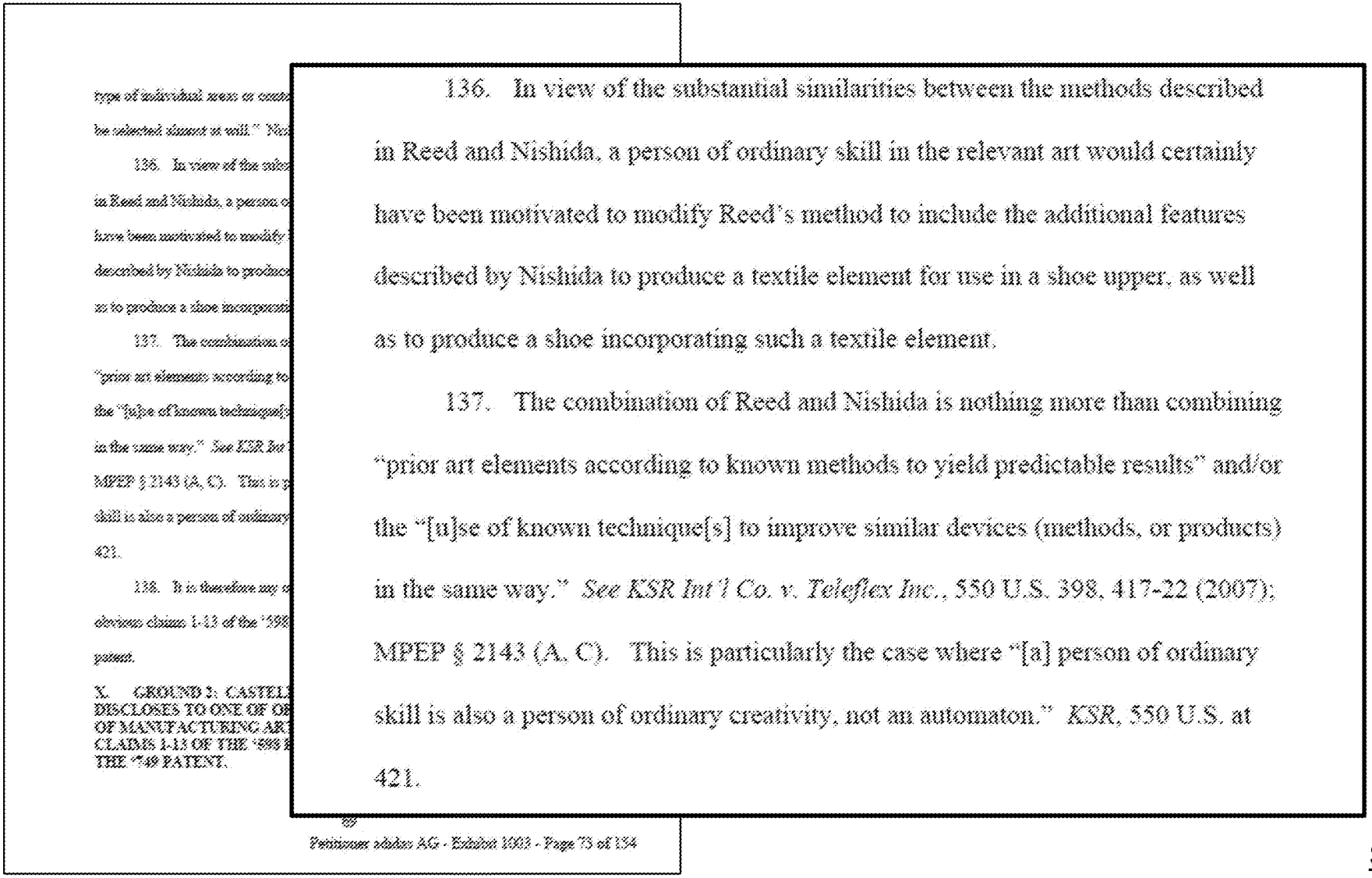
In view of the substantial similarities between the methods described in Reed and Nishida, a person of ordinary skill in the relevant art would certainly have been motivated to modify Reed's method to include the additional features described by Nishida to produce a textile element for use in a shoe upper, as well as to produce a shoe incorporating such a textile element, as this is nothing more than combining "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-22 (2007); MPEP § 2143 (A, C); (Ex. 1003, ¶136-137.) This is particularly the case where "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 421.

Source

IPR2016-00921 Petition, pp. 13-14
IPR2016-00922 Petition, p. 13

Skechers EX1013-p. 249
Skechers v Nike

Petitioner failed to carry its burden



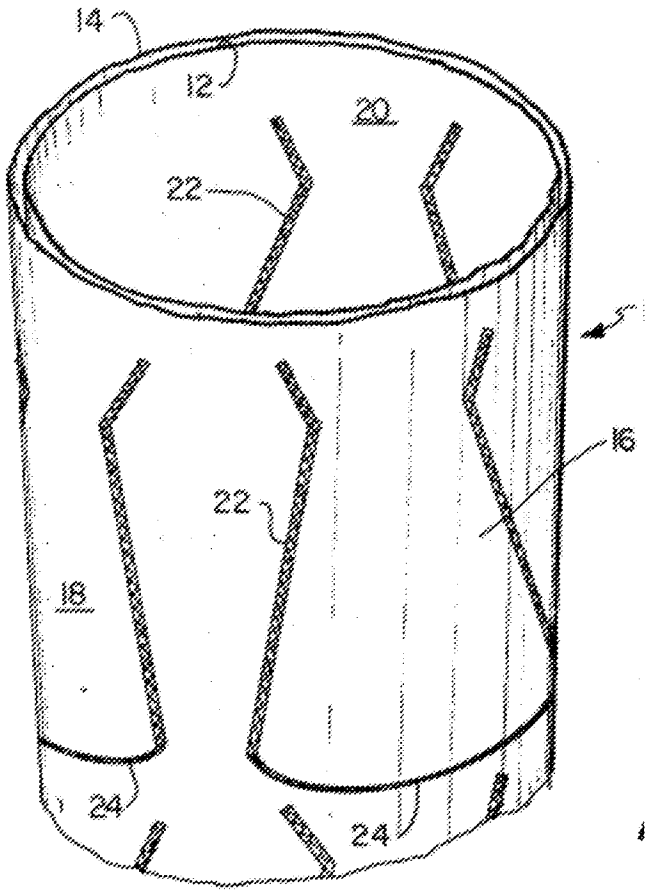
136. In view of the substantial similarities between the methods described in Reed and Nishida, a person of ordinary skill in the relevant art would certainly have been motivated to modify Reed's method to include the additional features described by Nishida to produce a textile element for use in a shoe upper, as well as to produce a shoe incorporating such a textile element.

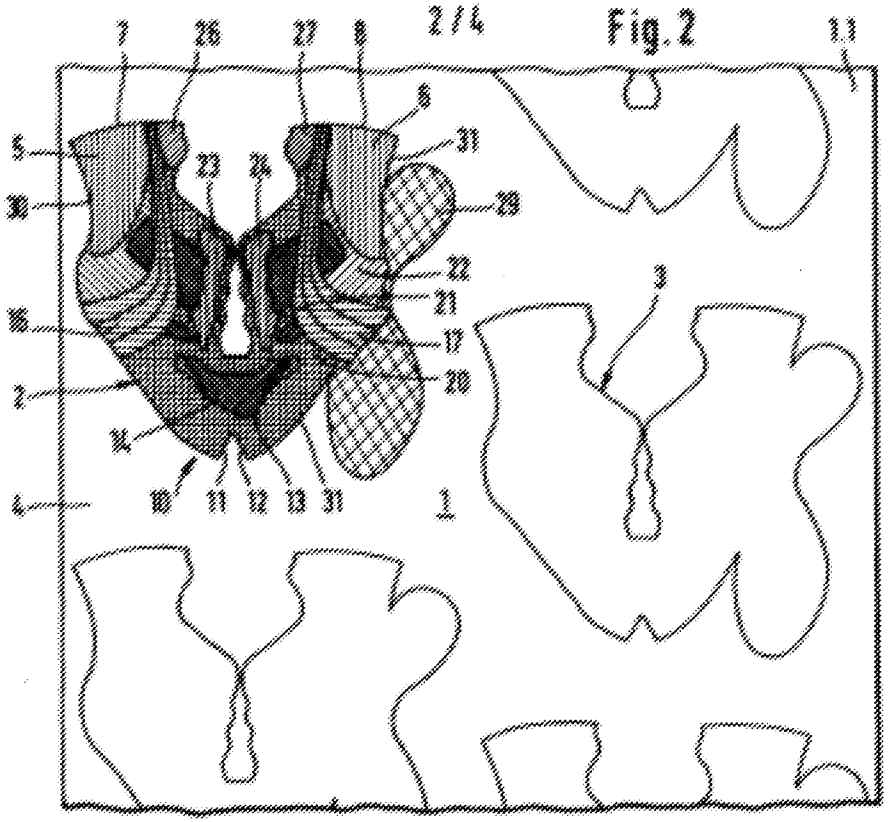
137. The combination of Reed and Nishida is nothing more than combining "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-22 (2007); MPEP § 2143 (A, C). This is particularly the case where "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 421.

Petitioner adidas AG - Exhibit 1003 - Page 73 of 134

Source
Exhibit 1003, Paragraphs 136-137

Reed and Nishida cannot be combined





Source
IPR2016-00921 PO Response, pp. 19-27
IPR2016-00922 PO Response, pp. 24-31
Exhibit 1006, Figure 1; Exhibit 1009, Figure 2

Skechers EX1013-p. 251
Skechers v Nike

Reed and Nishida do not disclose all claim limitations

Claim 4 of '598 Patent	Claim 11 of '598 Patent
The method recited in claim 1, wherein the step of mechanically manipulating includes forming the textile element to include a first area and a second area with a unitary construction, ***the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying textures*** to a surface of the textile element.	The method recited in claim 9, wherein the step of mechanically manipulating includes forming the textile element to include a first area and a second area with a unitary construction, ***the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying textures*** to a surface of the textile element.

Source
IPR2016-00921 PO Response, pp. 45-50
IPR2016-00921 Exhibit 1001, Claims 4 and 11

Skechers EX1013-p. 252
Skechers v Nike

Reed and Nishida do not disclose all claim limitations

Claim 6 of '598 Patent
The method recited in claim 1, wherein the step of mechanically manipulating includes ***forming apertures in the textile element***.

Source
IPR2016-00921 PO Response, pp. 50-55
IPR2016-00921 Exhibit 1001, Claim 6

Skechers EX1013-p. 253
Skechers v Nike

Reed and Nishida do not disclose all claim limitations

Claims 1-9, 11-19, 21 of the '749 Patent

A method of manufacturing an article of footwear, the method comprising:

simultaneously knitting a textile element with a surrounding textile structure, the knitted textile element having at least one knitted texture that differs from a knitted texture in the surrounding knitted textile structure;

removing the knitted textile element from the surrounding knitted textile structure;

incorporating the knitted textile element into the article of footwear.

Source
IPR2016-00922 PO Response, pp. 50-55
IPR2016-00922 Exhibit 1001, Claims 1-9, 11-19, 21

Reed and Nishida do not disclose all claim limitations

Claim 11 of '749 Patent	Claim 21 of '749 Patent
The method of claim 1, wherein simultaneously knitting a textile element with a surrounding textile structure includes forming the knitted textile element to include a first area and a second area with a unitary construction, ***the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying textures*** to a surface of the knitted textile element.	The method of claim 13, wherein knitting the first knitted textile element simultaneously with a surrounding knitted textile structure includes forming the first knitted textile element to include a first area and a second area with a unitary construction, ***the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying textures*** to a surface of the first knitted textile element.

Source

IPR2016-00922 PO Response, pp. 55-58

IPR2016-00922 Exhibit 1001, Claims 11 and 21

Skechers EX1013-p. 255
Skechers v Nike

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00922
Patent No. 8,266,749

PATENT OWNER'S EXHIBIT LIST
(AS OF JULY 11, 2017)

LIST OF EXHIBITS

2004	Transcript of the Deposition of Lenny M. Holden (January 10, 2017)
2005	Patent Owner NIKE's Demonstratives for Use at Oral Hearing

Date: July 11, 2017

Respectfully submitted,

/Christopher J. Renk/

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Michael J. Harris
BANNER & WITCOFF, LTD.
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Chicago, Illinois 60606

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on July 11, 2017, by email directed to the attorneys of record for Petitioner as follows:

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/s/ Aaron P. Bowling
Aaron P. Bowling
Banner & Witcoff, Ltd.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case: IPR2016-00922

Patent 8,266,749

PETITIONER'S EXHIBIT LIST
(AS OF JULY 11, 2017)

LIST OF EXHIBITS

1001	U.S. Patent No. 8,266,749 ("the '749 patent")
1002	File History for U.S. Patent No. 8,266,749 ("'749 file history")
1003	Declaration of Lenny Holden ("Holden Decl.")
1004	C.V. for Lenny Holden
1005	Form PTO-SB/42
1006	U.S. Patent No. 3,985,003 to Reed ("Reed")
1007	U.S. Patent No. 4,038,840 to Castello ("Castello")
1008	U.S. Patent No. 6,330,814 to Fujiwara ("Fujiwara")
1009	U.S. Patent No. 5,345,638 to Nishida ("Nishida")
1010	David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third Ed., Woodhead Publishing Ltd. 2001) ("Spencer")
1011	Paul Burall, "CoID Design Awards," Design, June 1969, pp. 46-47 ("Burall")
1012	ISO 8117:2003(E) Textile machinery - Knitting machines - Nominal diameters of circular machines ("ISO 8117")
1013	Ardis W. Koester, "Analyzing the Color, Design, and Texture of Fabric," Oregon State University Extension Service, May 1993 ("Koester")
1014	Definition of "Impart" from Merriam-Webster
1015	Declaration of Tiffany L. Williams
1016	Petitioner's Demonstratives

Dated: July 11, 2017

By: /s/ Mitchell G. Stockwell

Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

Lead Counsel	Back-Up Counsel
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S EXHIBIT LIST** has been served on July 11, 2017, by email directed to the attorneys of record for Patent Owner as follows:

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bwlitdocket@bannerwitcoff.com

Dated: July 11, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	15/610,089	Confirmation No. 4757
Inventor	:	Bhupesh Dua	
Applicants	:	NIKE, Inc.	
Filed	:	5/31/2017	
Title	:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	
Group Art Unit	:	3765	
Examiner	:	Marie D. Bays	
Matter No.	:	NIKE.276100/08-1313US82CON	
Customer No.	:	78342	

VIA EFS – 7/24/2017

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

IDS SUBMISSION

This correspondence is being submitted with an Information Disclosure Statement pursuant to 37 C.F.R. § 1.97. Due to the number of references, the IDS is separated into multiple forms. Accordingly, Applicant hereby submits IDS forms 1-11 as this IDS submission. Each IDS form corresponds to an IDS form filed in the Application No. 14/503,514 from which this pending application depends. Pursuant to 37 C.F.R. § 1.97(c)(2), Applicant submits herewith the fee set forth in § 1.17(g) for the IDS submission.

Respectfully submitted,

/ELIZABETH A. LUCAS/

Elizabeth A. Lucas
Reg. No. 74,247

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SHOOK, HARDY & BACON L.L.P.
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Fax: 816-421-5547

8298658
8298658 v1

Skechers EX1013-p. 263
Skechers v Nike

PTO/SB/08a (03-15)
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

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Examiner Initial*	Cite No	Patent Number	Kind Code[1]	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
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Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T[5]

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	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

	1	Decision Denying Institution of Inter Partes Review Under 37 C.F.R. § 42.108 for Inter Partes Review IPR2017-00263 dated June 7, 2017, 11 pages.	
	2	Decision Denying Institution of Inter Partes Review Under 37 C.F.R. § 42.108 for Inter Partes Review IPR2017-00264 dated June 7, 2017, 12 pages.	
	3	Patent Owner Nike Inc.'s Request for Oral Argument for Inter Partes Review IPR2016-00921 dated June 12, 2017, 4 pages.	
	4	Petitioner's Request for Oral Argument for Inter Partes Review IPR2016-00921 dated June 12, 2017, 4 pages.	
	5	Patent Owner Nike Inc.'s Request for Oral Argument for Inter Partes Review IPR2016-00922 dated June 12, 2017, 4 pages.	
	6	Petitioner's Request for Oral Argument for Inter Partes Review IPR2016-00922 dated June 12, 2017, 4 pages.	
	7	ORDER Oral Hearing Under 37 C.F.R. § 42.70 for Inter Partes Review IPR2016-00921 and for Inter Partes Review IPR2016-00922 dated June 14, 2017, 6 pages.	

If you wish to add additional non-patent literature document citation information please click the Add button Add

EXAMINER SIGNATURE

Examiner Signature		Date Considered	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1] See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. [2] Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). [3] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [4] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [5] Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	15610089
	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

☒ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ A certification statement is not submitted herewith.

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/ELIZABETH A. LUCAS/	Date (YYYY-MM-DD)	2017-07-24
Name/Print	Elizabeth A. Lucas	Registration Number	74247

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

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4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Acknowledgement Receipt

EFS ID:	29854751
Application Number:	15610089
International Application Number:	
Confirmation Number:	4757
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Customer Number:	78342
Filer:	Elizabeth Ashley Lucas
Filer Authorized By:	
Attorney Docket Number:	NIKE.276100/081313US82CON
Receipt Date:	24-JUL-2017
Filing Date:	31-MAY-2017
Time Stamp:	19:20:23
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Non Patent Literature	276100_2_NPL_03_Nikes_Request_Oral_Argument_Inter_Partes_Review_IPR2016_00921_dated_June_12_2017.pdf	111461 f7a547a95e6c06f5c440ce4099730feef81dbc07	no	4

Warnings:

Information:					
2	Non Patent Literature	276100_2_NPL_04_Petitioners_Oral_Argument_Inter_Partes_Review_IPR2016_00921_dated_6_12_17.pdf	111454 4804aa635fd53c9b71440d61ba28a2cf4466b3b5	no	4
Warnings:					
Information:					
3	Non Patent Literature	276100_2_NPL_05_Nike_Requests_Oral_Argument_Inter_Partes_Review_IPR2016_00922_dated_6_12_17.pdf	111448 24eb9f0c9a7635d750a98f74ac458999a9a0d005	no	4
Warnings:					
Information:					
4	Non Patent Literature	276100_2_NPL_01_Decision_Denying_Inter_Partes_Review_IPR2017_00263_dated_June_7_2017.pdf	4488648 42bd00cdcfbfa915933e4bafd6610dfddacbfbc6	no	11
Warnings:					
Information:					
5	Non Patent Literature	276100_2_NPL_02_Decision_Denying_Inter_Partes_Review_IPR2017_00264_dated_June_7_2017.pdf	4681354 6cb9b44c32034b78951092baf3eed8713e22fa4c	no	12
Warnings:					
Information:					
6	Non Patent Literature	276100_2_NPL_06_Petitioners_Request_Oral_Argument_Inter_Partes_Review_IPR2016_00922_06_12_17.pdf	111442 5bb6c90cc8d80121dea2ea13116e838b5afd7529	no	4
Warnings:					
Information:					
7	Non Patent Literature	276100_2_NPL_07_Order_6_14_17_Oral_Hearing_IPR2016_00921_and_IPR2016_00922.pdf	2409153 89a8208e99636480f7f2b667c448e36981e7f264	no	6
Warnings:					
Information:					
8	Transmittal Letter	276100_IDS_Cover_Letter.pdf	15812 b1b889159707e0f36ef66f09e808db56fdc05f99	no	1
Warnings:					
Information:					

9	Information Disclosure Statement (IDS) Form (SB08)	276100_IDS_2.PDF	1035219 dd5dce14b5ecffcf8d139f8c81521072dc260100	no	4

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If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00921
Patent No. 7,814,598

PATENT OWNER NIKE, INC.'S REQUEST FOR ORAL ARGUMENT

Patent Owner NIKE, Inc. ("NIKE") requests oral argument pursuant to 37 CFR § 42.70(a). Oral argument is currently scheduled for July 12, 2017. (*See* Scheduling Order (Paper No. 7) entered October 21, 2016.)

NIKE requests a combined argument and transcript for IPR2016-00921 and IPR2016-00922. These two *inter partes* reviews involve related patents and the same prior art references, they have been on the same schedule throughout the proceedings, and they are both scheduled for oral argument on the same day with the same panel.

Without waiving consideration of any issue not identified below, NIKE requests 60 minutes per side at oral argument to address the following issues:

1. The construction of certain terms of (a) U.S. Patent No. 7,814,598 ("the '598 Patent"), which is the subject of the IPR2016-00921 proceeding, and (b) U.S. Patent No. 8,266,749 ("the '749 Patent"), which is the subject of the IPR2016-00922 proceeding;

2. For IPR2016-00921, whether Petitioner has met its burden, under 35 U.S.C. § 316(e), in proving the instituted ground of unpatentability: claims 1-13 of the '598 Patent under 35 U.S.C. § 103(a) by Reed and Nishida;

3. For IPR2016-00922, whether Petitioner has met its burden, under 35 U.S.C. § 316(e), in proving the instituted ground of unpatentability: claims 1–9, 11–19, and 21 of the '749 Patent under 35 U.S.C. § 103(a) by Reed and Nishida;

4. The weight, if any, to be given to the testimony of Petitioner's identified expert;

5. Any issues identified by Petitioner in its Request for Oral Argument;

6. Rebuttal to Petitioner's presentation on all matters;

7. Any other issues raised in papers filed in this proceeding, including issues raised in papers yet to be filed, such as Motions to Exclude; and

8. Any other issues the Board deems necessary for issuing a final written decision.

NIKE requests permission to use audio/visual equipment to display possible demonstratives, a PowerPoint presentation, and exhibits, including the use of a computer, projector, Elmo, and screen.

Date: June 12, 2017

Respectfully submitted,

/Christopher J. Renk/

Christopher J. Renk
Michael J. Harris
BANNER & WITCOFF, LTD.
10 South Wacker Drive, Suite 3000
Chicago, Illinois 60606

Skechers EX1013-p. 273
Skechers v Nike

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on June 12, 2017, by email directed to the attorneys of record for Petitioner as follows:

Mitchell G. Stockwell
Vaibhav P. Kadaba
Tiffany L. Williams
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/s/ *Aaron P. Bowling*
Aaron P. Bowling
Banner & Witcoff, Ltd.

Skechers EX1013-p. 274
Skechers v Nike

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00921
Patent No. 7,814,598

PATENT OWNER NIKE, INC.'S REQUEST FOR ORAL ARGUMENT

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Date: June 12, 2017

Respectfully submitted,

/Christopher J. Renk/

Christopher J. Renk
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Chicago, Illinois 60606

Skechers EX1013-p. 277
Skechers v Nike

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on June 12, 2017, by email directed to the attorneys of record for Petitioner as follows:

Mitchell G. Stockwell
Vaibhav P. Kadaba
Tiffany L. Williams
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/s/ *Aaron P. Bowling*
Aaron P. Bowling
Banner & Witcoff, Ltd.

Skechers EX1013-p. 278
Skechers v Nike

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00922
Patent No. 8,266,749

PATENT OWNER NIKE, INC.'S REQUEST FOR ORAL ARGUMENT

Patent Owner NIKE, Inc. ("NIKE") requests oral argument pursuant to 37 CFR § 42.70(a). Oral argument is currently scheduled for July 12, 2017. (*See* Scheduling Order (Paper No. 7) entered October 21, 2016.)

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Date: June 12, 2017

Respectfully submitted,

/Christopher J. Renk/

Christopher J. Renk
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10 South Wacker Drive, Suite 3000
Chicago, Illinois 60606

Skechers EX1013-p. 281
Skechers v Nike

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on June 12, 2017, by email directed to the attorneys of record for Petitioner as follows:

Mitchell G. Stockwell
Vaibhav P. Kadaba
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1100 Peachtree Street, NE, Suite 2800
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/s/ *Aaron P. Bowling*
Aaron P. Bowling
Banner & Witcoff, Ltd.

Trials@uspto.gov
571-272-7822

Paper 9
Date Entered: June 7, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG,
Petitioner,

v.

Nike, Inc.,
Patent Owner.

Case IPR2017-00263
Patent 8,042,288 B2

Before JOSIAH C. COCKS, MICHAEL J. FITZPATRICK, and JAMES B. ARPIN, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

adidas AG ("Petitioner") filed a Petition to institute *inter partes* review of claims 8 and 14–20 of U.S. Patent No. 8,042,288 B2 (Ex. 1001, "the '288 patent"). Paper 1 ("Pet."). Nike, Inc. ("Patent Owner") filed a corrected Preliminary Response. Paper 7 ("Prelim. Resp.")

Having considered the Petition, the corrected Preliminary Response, and the evidence of record, we determine that the Petition presents the same or substantially the same art or arguments as those previously presented to the Office in IPR2016-00920. Accordingly, we exercise our discretion under 35 U.S.C. § 325(d) and deny institution of *inter partes* review as to any of claims 8 and 14–20 of the '288 patent based on any of the grounds asserted in the instant Petition.

B. Related Matters

Both parties describe this *inter partes* review as related to IPR2013-00067 involving U.S. Patent 7,347,011 B2. Pet. 1; Paper 3, 2. In addition to identifying IPR2016-00920, in which Petitioner previously challenged claims 1–38 of the '288 patent (Pet. 40; Prelim. Resp. 1; Paper 3, 2; Paper 8, 1), Petitioner identifies a second Petition for *inter partes* review challenging claims 1–7, 9–13, and 21–38 of the '288 patent. Paper 8, 1. Further, Petitioner identifies two additional *inter partes* review proceedings as related to the instant proceeding: (1) IPR2016-00921 involving U.S. Patent No. 7,814,598 B2; and (2) IPR2016-00922 involving U.S. Patent No. 8,266,749 B2. Pet. 2; Paper 3, 2.

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Skechers v Nike

C. The '288 Patent

The '288 patent is entitled "Article of Footwear Having a Textile Upper." Ex. 1001, Title. The '288 patent characterizes its disclosure as being directed to an "upper incorporating a textile element formed with a knitting machine." *Id.* at 3:27–29. Figures 1 and 8 of the '288 patent are reproduced below.

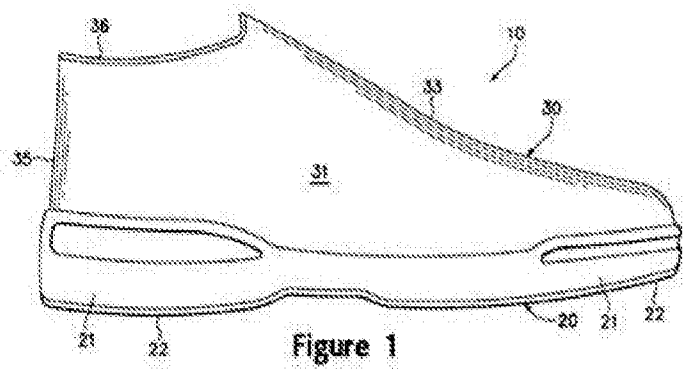


Figure 1

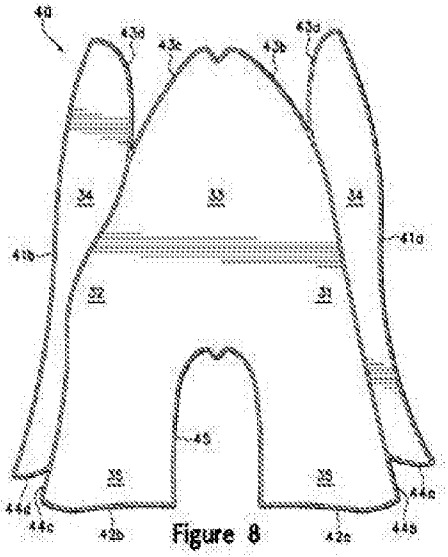


Figure 8

Figure 1 depicts "a lateral elevational view of an article of footwear having an upper." *Id.* at 4:1–2. Figure 8 depicts "a plan view of a textile element that forms at least a portion of the upper." *Id.* at 4:11–12. As shown in Figure 1, article of footwear 10 including sole structure 20 and upper 30. *Id.* at 4:43–44. Upper 30 is at least partially formed from textile element 40, which, as shown in Figure 8, forms regions 31–35, and "is a single material element that is formed to exhibit a unitary (i.e., one-piece) construction. *Id.* at 5:38–44.

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D. Illustrative Claims

Claim 14 is independent, and claims 15–20 depend directly from claim 14. Ex. 1001, 12:22–57. Claim 8 is depends from unchallenged independent claim 1. *Id.* at 12:4–7. Although claim 1 is not challenged expressly in the instant Petition, Petitioner's challenge to dependent claim 8 would have required us to consider whether the applied art teaches or suggests the limitations recited in claim 1. Consequently, claim 1 is illustrative and is reproduced below:

> 1. An article of footwear comprising:
>
> an upper incorporating a circular-knitted textile element having a plurality of knit constructions, the circular-knitted textile element being removed from a circular-knitted textile structure, and further having longitudinal edges that are joined together to define at least a portion of a void for receiving a foot; and
>
> a sole structure secured to the upper.

Id. at 11:44–51.

E. Applied References and Declaration

Petitioner relies on the following references and declaration in support of its asserted grounds of unpatentability.

Exhibit No.	**Reference**
1003	Declaration of Lenny M. Holden
1006	U.S. Patent No. 3,985,003 to Reed ("Reed")
1007	U.S. Patent No. 5,345,638 to Nishida ("Nishida")
1008	U.S. Patent No. 4,785,558 to Shiomura ("Shiomura")

Pet. iii.

F. Asserted Grounds of Unpatentability

Petitioner contends that claims 8 and 14–20 of the '288 patent are unpatentable under 35 U.S.C. § 103(a) on the following ground:

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References	Basis	Challenged Claims
Nishida, Reed, and Shiomura	35 U.S.C. § 103(a)	8 and 14–20

Pet. 8. In the earlier petition in IPR2016-00920, Petitioner challenged claims 1–38 of the '288 patent as unpatentable under 35 U.S.C. § 103(a) on the following grounds:

References	Basis	Challenged Claim
Nishida, Reed, Shiomura, and Shepherd	35 U.S.C. § 103(a)	1–38
Nishida, Castello, Fujiwara, Shiomura, and Shepherd	35 U.S.C. § 103(a)	1–38

IPR2016-00920, Paper 6, 4–5; *see* Prelim. Resp. 3. Further, in support of the grounds asserted in IPR2016-00920, Petitioner also relied on the declaration testimony of Mr. Holden (IPR2016-00920, Ex. 1003).

II. ANALYSIS

A. Denial of Institution of Inter Partes Review in IPR2016-00920

In IPR2016-00920, this same panel reviewed the grounds asserted in the petition, and we were not satisfied that the petition provided adequate explanation or was appropriately precise and specific in articulating the basis of the proposed grounds to warrant institution of an *inter partes* review. IPR2016-00920, Paper 6, 5.

Pursuant to 35 U.S.C. § 312(a), a petition may be considered only if it "identifies, in writing and with particularity each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." In IPR2016-00920, the deficiency in the petition lay in its failure to identify "with particularity" the grounds and evidence that form the underlying basis for Petitioner's patentability challenges. *Id.* For instance, with respect to claim 1, the

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petition cited to portions of Nishida for all of the limitations of claim 1, and also submitted parallel citations for certain limitations to portions of Reed. *Id.* at 6. The petition in IPR2016-00920, however, did not provide adequate explanation of which limitations Petitioner contended were absent from Nishida and which it was relying upon Reed to supply. *Id.* Moreover, the first ground asserted in the petition in IPR2016-00920 was presented as based on the combined teachings of Nishida, Reed, Shimura, and Shepherd,[1] yet Petitioner provided no explanation as to how or why Shimura's and Shepherd's teachings were germane to claim 1. *Id.*

After reviewing the entirety of the proposed ground, we concluded that the petition tended to demonstrate that the teachings of Shimura and Shepherd might be pertinent in some fashion only to a small subset of the involved claims (i.e., claims 7, 18, 26, 34, and 38), rather than to all of claims 1–38, as was alleged in the petition. *Id.* Further still, with respect to that small subset of claims, Shiomura and Shepherd appeared to be applied in parallel with one another apparently to account for the same additional claim limitations, but Petitioner left unexplained why it was necessary that both of those references were named in the asserted ground. *Id.* Consequently, we determined that the proposed ground based on Nishida, Reed, Shiomura, and Shepherd contained defects with respect to each of challenged claims 1–38, on which Petitioner sought *inter partes* review. *Id.* at 7. Accordingly, having *evaluated* the petition in IPR2016-00920, we determine that Petitioner had not shown a reasonable likelihood of success in

[1] U.S. Patent No. 6,779,369 B2 to Shepherd.

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any of its challenges to claims 1–38 of the '288 patent, and we ultimately *denied* institution of *inter partes* review on all grounds. *Id.* at 8.

B. Assertion of Refined Grounds in the Instant Petition

In the instant Petition, Petitioner challenges a subset of the claims challenged in IPR2016-00920 based on a subset of the references relied upon in the first ground asserted in IPR2016-00920. Pet. 6–7. In particular, in IPR2016-00920, Petitioner challenged claims 1–38 of the '288 patent as allegedly rendered obvious by the combined teachings of Nishida, Reed, Shiomura, and Shepherd; but, in the instant proceeding, Petitioner is challenging claims 8 and 14–20 of the '288 patent as allegedly rendered obvious by the combined teachings of Nishida, Reed, and Shiomura. *Id.*

C. 35 U.S.C. § 325(d)

We have discretion whether to institute any *inter partes* review. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. Our discretion may be guided by 35 U.S.C. § 325(d), which provides that "the Director may take into account whether, and reject the petition or request because, *the same or substantially the same prior art or arguments* previously were presented to the Office" (emphasis added).

Petitioner was aware of the issues created under 35 U.S.C. § 325(d) by the filing of the instant Petition and attempted to address them preemptively. Pet. 39–43. Specifically, Petitioner presents three arguments as to why we should not exercise our discretion to deny institution under 35 U.S.C. § 325(d). We are not persuaded by Petitioner's arguments.

First, Petitioner argues that the instant Petition presents arguments the Office has not considered previously; and, thus, Petitioner is not seeking a

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"second bite at the apple." Pet. 40–41; *but see* Prelim. Resp. 6 (Patent Owner argues to the contrary.). In particular, Petitioner argues that we denied the earlier petition "without substantively addressing its merits because the Board was 'not satisfied that the Petition provides adequate explanation or is appropriately precise and specific in articulating the basis of the proposed ground to warrant institution of an *inter partes* review on that ground.'" Pet. 41 (quoting IPR2016-00920, Paper 6, 5). This argument is erroneous.

As we stated in the decision denying institution in IPR2016-00920, *"[h]aving evaluated the Petition*, we determine that [Petitioner] has not shown a reasonable likelihood of success in any of its challenges to claims 1–38 of the '288 patent." IPR2016-00920, Paper 6, 8 (emphasis added). Thus, we denied institution in the earlier petition only after evaluating the arguments and evidence presented. Moreover, to the extent that we may have been unable to evaluate fully any argument or evidence, or both, which Petitioner presented in the earlier petition, that was Petitioner's fault, and not ours. *See* IPR2016-00920, Paper 6, 6 ("Vagueness in the presentation of a ground does not benefit a petitioner.").

Second, Petitioner argues that "instituting this Petition will protect the public's interests without harassing the Patent Owner or burdening the Board." Pet. 41. This argument also is unavailing. Generally, it is in the public interest that unpatentable claims are cancelled. However, Congress contemplated and expressly authorized the denial of petitions without regard to the patentability of the challenged claims under certain circumstances. Section 325(d) is but one example. *See* 35 U.S.C. § 317 (termination upon settlement); *but see Apple, Inc. v. Smartflash LLC*, Case CBM2015-00015,

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at 6 (PTAB Nov. 4, 2015) (Paper 49) ("There is a public interest in resolving the issues raised by these challenges because the record is fully developed."). Moreover, each petition is evaluated on its merits and allowing a petitioner to refine a poorly drafted petition based on guidance provided by the Board's denial of that petition may be deemed to result in harassment of the patent owner. Prelim. Resp. 7–10; *see Travelocity.com L.P v. Cronos Technologies, LLC*, Case CBM2015-00047, at 13 (PTAB June 15, 2015) (Paper 7) ("Moreover, a decision on a petition for covered business method review is not simply part of a feedback loop by which a petitioner may perfect its challenges through a subsequent filing.").

Third, Petitioner argues that "the Board has been willing to revisit a [p]etitioner's arguments from a previously denied petition in a second petition when the law has changed." Pet. 42. In particular, Petitioner argues that:

> When Petitioner in this case filed the Prior Petition, the rules limited the number of pages allowed in an IPR petition. Since the Prior Petition included numerous diagrams and figures, Petitioner's ability to address all thirty-eight claims in the '288 patent with precise and specific articulations for each asserted ground of invalidity was restricted under the page number limitation. Subsequent to the filing of the Prior Petition, on May 2, 2016, the rules changed to include word count limits instead of page count limits, which is a more equitable approach for Petitions that include numerous diagrams and figures. Thus, the equities weigh in Petitioner's favor of being able to present arguments under the new word count requirements.

Id. (citations omitted). This argument is unpersuasive and ignores both the facts of this case and those surrounding the rule change.

Petitioner's earlier petition was filed on April 19, 2016, and, although Petitioner is correct that, on May 2, 2016, new final rules went into effect

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which changed the previous page limit to a word count limit, the final rule change was published on April 1, 2016. Consequently, Petitioner was fully aware of the change *before* it filed the earlier petition on April 19, 2016. IPR2016-00920, Paper 3, 1. Further, Petitioner was not prevented then from filing multiple petitions, as it has done now, filing two petitions (IPR2017-00263 and IPR2017-00264) each challenging a subset of the claims of the '288 patent. In fact, the Board has advised petitioners to consider exactly this strategy in the comments to our original Final Rules (77 Fed. Reg. 48612, 48635 (Aug. 14, 2012) (Response to Comment 91 ("Alternatively, the filing of multiple petitions directed to subsets of related claims should be considered.")) or, alternatively, a motion to waive page limits (Office Trial Practice Guide, 77 Fed. Reg. 48756, 48762–63 (Aug. 14, 2012)). Finally, we are aware of no litigation between these parties; hence, there apparently was no bar that prevented Petitioner from filing its earlier petition *after* the new rules went into effect. Pet. 1–2; Paper 8, 1–2; *see* 35 U.S.C. § 315(b).

Based on our consideration of the parties' filings, we exercise our discretion and decline to institute *inter partes* review as to any of the challenged claims.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion under 35 U.S.C. § 325(d) and deny institution of a trial in connection with this proceeding.

IV. ORDER

It is ORDERED that the Petition is *denied*, and no trial is instituted.

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571-272-7822

Paper 9
Date Entered: June 7, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG,
Petitioner,

v.

Nike, Inc.,
Patent Owner.

Case IPR2017-00264
Patent 8,042,288 B2

Before JOSIAH C. COCKS, MICHAEL J. FITZPATRICK, and JAMES B. ARPIN, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

adidas AG ("Petitioner") filed a Petition to institute *inter partes* review of claims 1–7, 9–13, and 21–38 of U.S. Patent No. 8,042,288 B2 (Ex. 1001, "the '288 patent"). Paper 1 ("Pet."). Nike, Inc. ("Patent Owner") filed a corrected Preliminary Response. Paper 7 ("Prelim. Resp.")

Having considered the Petition, the corrected Preliminary Response, and the evidence of record, we determine that the Petition presents the same or substantially the same art or arguments as those previously presented to the Office in IPR2016-00920. Accordingly, we exercise our discretion under 35 U.S.C. § 325(d) and deny institution of *inter partes* review as to any of claims 1–7, 9–13, and 21–38 of the '288 patent based on any of the grounds asserted in the instant Petition.

B. Related Matters

Both parties describe this *inter partes* review as related to IPR2013-00067 involving U.S. Patent 7,347,011 B2. Pet. 1; Paper 3, 2. In addition to identifying IPR2016-00920, in which Petitioner previously challenged claims 1–38 of the '288 patent (Pet. 48; Prelim. Resp. 1; Paper 3, 2; Paper 8, 1), Petitioner identifies a second Petition for *inter partes* review challenging claims 8 and 14–20 of the '288 patent. Paper 8, 1. Further, Petitioner identifies two additional *inter partes* review proceedings as related to the instant proceeding: (1) IPR2016-00921 involving U.S. Patent No. 7,814,598 B2; and (2) IPR2016-00922 involving U.S. Patent No. 8,266,749 B2. Pet. 2; Paper 3, 2.

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C. The '288 Patent

The '288 patent is entitled "Article of Footwear Having a Textile Upper." Ex. 1001, Title. The '288 patent characterizes its disclosure as being directed to an "upper incorporating a textile element formed with a knitting machine." *Id.* at 3:27–29. Figures 1 and 8 of the '288 patent are reproduced below.

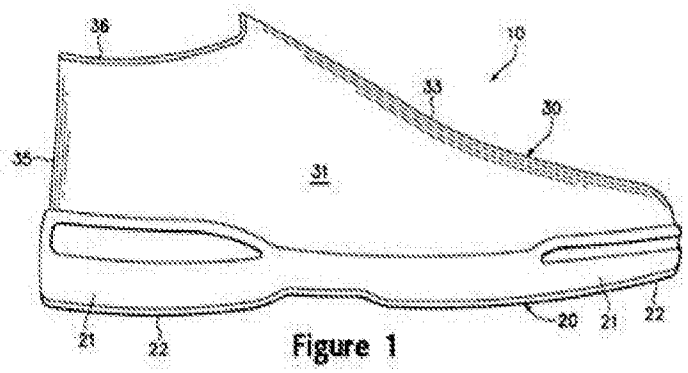


Figure 1

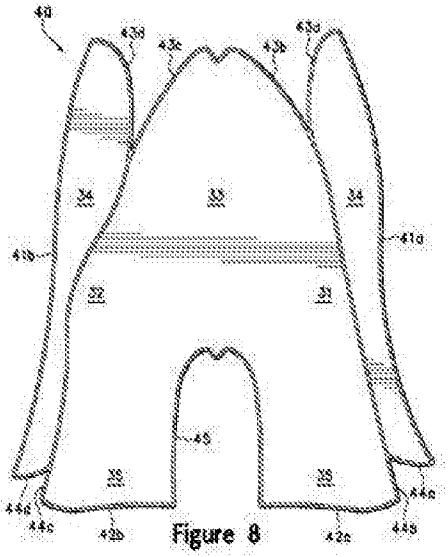


Figure 8

Figure 1 depicts "a lateral elevational view of an article of footwear having an upper." *Id.* at 4:1–2. Figure 8 depicts "a plan view of a textile element that forms at least a portion of the upper." *Id.* at 4:11–12. As shown in Figure 1, article of footwear 10 including sole structure 20 and upper 30. *Id.* at 4:43–44. Upper 30 is at least partially formed from textile element 40, which, as shown in Figure 8, forms regions 31–35, and "is a single material element that is formed to exhibit a unitary (i.e., one-piece) construction. *Id.* at 5:38–44.

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D. Illustrative Claims

Claims 1, 21, 29, and 36 are independent; and claims 2–7 and 9–13 depend directly or indirectly from claim 1;[1] claims 22–28 depend directly from claim 21; claims 30–35 depend directly or indirectly from claim 29; and claims 37 and 38 depend directly from claim 36. Ex. 1001, 11:44–12:3, 12:8–21, 12:58–14:37. Claim 1 is illustrative and is reproduced below:

> 1. An article of footwear comprising:
>
> an upper incorporating a circular-knitted textile element having a plurality of knit constructions, the circular-knitted textile element being removed from a circular-knitted textile structure, and further having longitudinal edges that are joined together to define at least a portion of a void for receiving a foot; and
>
> a sole structure secured to the upper.

Id. at 11:44–51.

E. Applied References and Declaration

Petitioner relies on the following references and declaration in support of its asserted grounds of unpatentability.

Exhibit No.	Reference
1003	Declaration of Lenny M. Holden
1006	U.S. Patent No. 3,985,003 to Reed ("Reed")
1007	U.S. Patent No. 5,345,638 to Nishida ("Nishida")

[1] Although claim 1 is not expressly challenged in the petition in the related proceeding, IPR2017-00263, claim 8, which depends directly from claim 1, is challenged in that petition. IPR2017-00263, Paper 1, 1; *see* Ex. 1001, 12:4–7. Therefore, with respect to claim 8, Petitioner asserts that limitations of claim 1 are taught or suggested by the combined teachings of Nishida, Reed, and Shiomura in IPR2017-00263. Consequently, IPR2017-00263 and IPR2017-00264 include substantially overlapping challenges to the claims of the '288 patent.

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Pet. iii.

F. Asserted Grounds of Unpatentability

Petitioner contends that claims 1–7, 9–13, and 21–38 of the '288 patent are unpatentable under 35 U.S.C. § 103 on the following ground:

Reference(s)	Basis	Challenged Claim
Nishida and Reed	35 U.S.C. § 103(a)	1–7, 9–13, and 21–38
Nishida	35 U.S.C. § 102(b)	36–38

Pet. 7. In the earlier petition in IPR2016-00920, Petitioner challenged claims 1–38 of the '288 patent as unpatentable under 35 U.S.C. § 103(a) on the following grounds:

References	Basis	Challenged Claim
Nishida, Reed, Shiomura, and Shepherd	35 U.S.C. § 103(a)	1–38
Nishida, Castello, Fujiwara, Shiomura, and Shepherd	35 U.S.C. § 103(a)	1–38

IPR2016-00920, Paper 6, 3; *see* Prelim. Resp. 3. Further, in support of the grounds asserted in IPR2016-00920, Petitioner also relied on the declaration testimony of Mr. Holden (IPR2016-00920, Ex. 1003).

II. ANALYSIS

A. Denial of Institution of Inter Partes Review in IPR2016-00920

In IPR2016-00920, this same panel reviewed the grounds asserted in the petition, and we were not satisfied that the petition provided adequate explanation or was appropriately precise and specific in articulating the basis of the proposed grounds to warrant institution of an *inter partes* review. IPR2016-00920, Paper 6, 5.

Pursuant to 35 U.S.C. § 312(a), a petition may be considered only if it "identifies, in writing and with particularity each claim challenged, the

grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." In IPR2016-00920, the deficiency in the petition lay in its failure to identify "with particularity" the grounds and evidence that form the underlying basis for Petitioner's patentability challenge. *Id.* For instance, with respect to claim 1, the petition cited to portions of Nishida for all of the limitations of claim 1, and also submitted parallel citations for certain limitations to portions of Reed. *Id.* at 6. The petition in IPR2016-00920, however, did not provide adequate explanation of which limitations Petitioner contended were absent from Nishida and which it was relying upon Reed to supply. *Id.* Moreover, the first ground asserted in the petition in IPR2016-00920 was presented as based on the combined teachings of Nishida, Reed, Shiomura,[2] and Shepherd,[3] yet Petitioner provided no explanation as to how or why Shiomura's and Shepherd's teachings were germane to claim 1. *Id.*

After reviewing the entirety of the proposed ground, we concluded that the petition tended to demonstrate that the teachings of Shiomura and Shepherd might be pertinent in some fashion only to a small subset of the involved claims (i.e., claims 7, 18, 26, 34, and 38), rather than to all of claims 1–38, as was alleged in the petition. *Id.* Further still, with respect to that small subset of claims, Shiomura and Shepherd appeared to be applied in parallel with one another apparently to account for the same additional claim limitations, but Petitioner left unexplained why it was necessary that both of those references were named in the asserted ground. *Id.* Consequently, we determined that the proposed ground based on Nishida,

[2] U.S. Patent No. 4,785,558 to Shiomura.
[3] U.S. Patent No. 6,779,369 B2 to Shepherd.

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Reed, Shiomura, and Shepherd contained defects with respect to each of challenged claims 1–38, on which Petitioner sought *inter partes* review. *Id.* at 7. Accordingly, having *evaluated* the petition in IPR2016-00920, we determined that Petitioner had not shown a reasonable likelihood of success in any of its challenges to claims 1–38 of the '288 patent, and we ultimately *denied* institution of *inter partes* review on all grounds. *Id.* at 8.

B. Assertion of Refined Grounds in the Instant Petition

In the instant Petition, Petitioner challenges a subset of the claims challenged in IPR2016-00920 based on a subset of the references relied upon in the first ground asserted in IPR2016-00920. Pet. 6–7. In particular, in IPR2016-00920, Petitioner challenged claims 1–38 of the '288 patent as allegedly rendered obvious by the combined teachings of Nishida, Reed, Shiomura, and Shepherd; but, in the instant proceeding, Petitioner is challenging claims 36–38 of the '288 patent as anticipated by Nishida and claims 1–7, 9–13, and 21–38 as rendered obvious by the combined teachings of Nishida and Reed. *Id.* Further, we note that claims 36–38 are challenged on alternative anticipation and obviousness grounds.

C. 35 U.S.C. § 325(d)

We have discretion whether to institute any *inter partes* review. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. Our discretion may be guided by 35 U.S.C. § 325(d), which provides that "the Director may take into account whether, and reject the petition or request because, *the same or substantially the same prior art or arguments* previously were presented to the Office" (emphasis added).

Petitioner was aware of the issues created under 35 U.S.C. § 325(d) by the filing of the instant Petition and attempted to address them

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preemptively. Pet. 48–52. Specifically, Petitioner presents three arguments as to why we should not exercise our discretion to deny institution under 35 U.S.C. § 325(d). We are not persuaded by Petitioner's arguments.

First, Petitioner argues that the instant Petition presents arguments the Office has not considered previously; and, thus, Petitioner is not seeking a "second bite at the apple." Pet. 49–50; *but see* Prelim. Resp. 5–6 (Patent Owner argues to the contrary.). In particular, Petitioner argues that we denied the earlier petition "without substantively addressing its merits because the Board was 'not satisfied that the Petition provides adequate explanation or is appropriately precise and specific in articulating the basis of the proposed ground to warrant institution of an *inter partes* review on that ground.'" Pet. 50 (quoting IPR2016-00920, Paper 6, 5). This argument is erroneous.

As we stated in the decision denying institution in IPR2016-00920, *"[h]aving evaluated the Petition*, we determine that [Petitioner] has not shown a reasonable likelihood of success in any of its challenges to claims 1–38 of the '288 patent." IPR2016-00920, Paper 6, 8 (emphasis added). Thus, we denied institution in the earlier petition only after evaluating the arguments and evidence presented. Moreover, to the extent that we may have been unable to evaluate fully any argument or evidence, or both, which Petitioner presented in the earlier petition, that was Petitioner's fault, and not ours. *See* IPR2016-00920, Paper 6, 6 ("Vagueness in the presentation of a ground does not benefit a petitioner.").

Second, Petitioner argues that "instituting this Petition will protect the public's interests without harassing the Patent Owner or burdening the Board." Pet. 50. This argument also is unavailing. Generally, it is in the

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public interest that unpatentable claims are cancelled. However, Congress contemplated and expressly authorized the denial of petitions without regard to the patentability of the challenged claims under certain circumstances. Section 325(d) is but one example. *See* 35 U.S.C. § 317 (termination upon settlement); *but see Apple, Inc. v. Smartflash LLC*, Case CBM2015-00015, at 6 (PTAB Nov. 4, 2015) (Paper 49) ("There is a public interest in resolving the issues raised by these challenges because the record is fully developed."). Moreover, each petition is evaluated on its merits and allowing a petitioner to refine a poorly drafted petition based on guidance provided by the Board's denial of that petition may be deemed to result in harassment of the patent owner. Prelim. Resp. 8–10; *see Travelocity.com L.P v. Cronos Technologies, LLC*, Case CBM2015-00047, at 13 (PTAB June 15, 2015) (Paper 7) ("Moreover, a decision on a petition for covered business method review is not simply part of a feedback loop by which a petitioner may perfect its challenges through a subsequent filing.").

Third, Petitioner argues that "the Board has been willing to revisit a [p]etitioner's arguments from a previously denied petition in a second petition when the law has changed." Pet. 51–52. In particular, Petitioner argues that:

> When Petitioner in this case filed the Prior Petition, the rules limited the number of pages allowed in an IPR petition. Since the Prior Petition included numerous diagrams and figures, Petitioner's ability to address all thirty-eight claims in the '288 patent with precise and specific articulations for each asserted ground of invalidity was restricted under the page number limitation. Subsequent to the filing of the Prior Petition, on May 2, 2016, the rules changed to include word count limits instead of page count limits, which is a more equitable approach for Petitions that include numerous diagrams and figures. Thus, the

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> equities weigh in Petitioner's favor of being able to present arguments under the new word count requirements.

Id. (citations omitted). This argument is unpersuasive and ignores both the facts of this case and those surrounding the rule change.

Petitioner's earlier petition was filed on April 19, 2016, and, although Petitioner is correct that, on May 2, 2016, new final rules went into effect which changed the previous page limit to a word count limit, the final rule change was published on April 1, 2016. Consequently, Petitioner was fully aware of the change *before* it filed the earlier petition on April 19, 2016. IPR2016-00920, Paper 3, 1. Further, Petitioner was not prevented then from filing multiple petitions, as it has done now, filing two petitions (IPR2017-00263 and IPR2017-00264) each challenging a subset of the claims of the '288 patent. In fact, the Board has advised petitioners to consider exactly this strategy in the comments to our original Final Rules (77 Fed. Reg. 48612, 48635 (Aug. 14, 2012) (Response to Comment 91 ("Alternatively, the filing of multiple petitions directed to subsets of related claims should be considered.")) or, alternatively, a motion to waive page limits (Office Trial Practice Guide, 77 Fed. Reg. 48756, 48762–63 (Aug. 14, 2012)). Finally, we are aware of no litigation between these parties; hence, there apparently was no bar that prevented Petitioner from filing its earlier petition *after* the new rules went into effect. Pet. 1–2; Paper 8, 1–2; *see* 35 U.S.C. § 315(b).

Based on our consideration of the parties' filings, we exercise our discretion and decline to institute *inter partes* review as to any of the challenged claims.

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III. CONCLUSION

For the foregoing reasons, we exercise our discretion under 35 U.S.C. § 325(d) and deny institution of a trial in connection with this proceeding.

IV. ORDER

It is ORDERED that the Petition is *denied*, and no trial is instituted.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00922
Patent No. 8,266,749

PATENT OWNER NIKE, INC.'S REQUEST FOR ORAL ARGUMENT

Patent Owner NIKE, Inc. ("NIKE") requests oral argument pursuant to 37 CFR § 42.70(a). Oral argument is currently scheduled for July 12, 2017. (*See* Scheduling Order (Paper No. 7) entered October 21, 2016.)

NIKE requests a combined argument and transcript for IPR2016-00921 and IPR2016-00922. These two *inter partes* reviews involve related patents and the same prior art references, they have been on the same schedule throughout the proceedings, and they are both scheduled for oral argument on the same day with the same panel.

Without waiving consideration of any issue not identified below, NIKE requests 60 minutes per side at oral argument to address the following issues:

1. The construction of certain terms of (a) U.S. Patent No. 7,814,598 ("the '598 Patent"), which is the subject of the IPR2016-00921 proceeding, and (b) U.S. Patent No. 8,266,749 ("the '749 Patent"), which is the subject of the IPR2016-00922 proceeding;

2. For IPR2016-00921, whether Petitioner has met its burden, under 35 U.S.C. § 316(e), in proving the instituted ground of unpatentability: claims 1-13 of the '598 Patent under 35 U.S.C. § 103(a) by Reed and Nishida;

3. For IPR2016-00922, whether Petitioner has met its burden, under 35 U.S.C. § 316(e), in proving the instituted ground of unpatentability: claims 1–9, 11–19, and 21 of the '749 Patent under 35 U.S.C. § 103(a) by Reed and Nishida;

4. The weight, if any, to be given to the testimony of Petitioner's identified expert;

5. Any issues identified by Petitioner in its Request for Oral Argument;

6. Rebuttal to Petitioner's presentation on all matters;

7. Any other issues raised in papers filed in this proceeding, including issues raised in papers yet to be filed, such as Motions to Exclude; and

8. Any other issues the Board deems necessary for issuing a final written decision.

NIKE requests permission to use audio/visual equipment to display possible demonstratives, a PowerPoint presentation, and exhibits, including the use of a computer, projector, Elmo, and screen.

Date: June 12, 2017

Respectfully submitted,

/Christopher J. Renk/

Christopher J. Renk
Michael J. Harris
BANNER & WITCOFF, LTD.
10 South Wacker Drive, Suite 3000
Chicago, Illinois 60606

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on June 12, 2017, by email directed to the attorneys of record for Petitioner as follows:

Mitchell G. Stockwell
Vaibhav P. Kadaba
Tiffany L. Williams
Kilpatrick Townsend & Stockton LLP
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mstockwell@kilpatricktownsend.com
wkadaba@kilpatricktownsend.com
tiwilliams@kilpatricktownsend.com

/s/ *Aaron P. Bowling*
Aaron P. Bowling
Banner & Witcoff, Ltd.

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Skechers v Nike

Trials@uspto.gov
571-272-7822

Paper 17
Entered: June 14, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG,
Petitioner,

v.

NIKE, Inc.,
Patent Owner.

Case IPR2016-00921(Patent 7,814,598 B2)
Case IPR2016-00922 (Patent 8,226,749 B2)[1]

Before JOSIAH C. COCKS, MICHAEL J. FITZPATRICK, and JAMES B. ARPIN, *Administrative Patent Judges.*

ARPIN, *Administrative Patent Judge.*

ORDER
Oral Hearing
37 C.F.R. § 42.70

[1] This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties are not authorized to use a multiple case caption.

The Scheduling Orders for the above-captioned cases set July 12, 2017, as the date for oral hearings for Cases IPR2016-00921 and IPR2016-00922, if requested by the parties and granted by the Board. IPR2016-00921, Paper 7, 9; IPR2016-00922, Paper 7, 9.[2] Petitioner and Patent Owner have requested a consolidated oral hearing for these cases. *See* IPR2016-00921, Papers 15 and 16. The parties' requests for an oral hearing are *granted.*

Each party has requested an hour to present its arguments for both cases. *See* IPR2016-00921, Papers 15, 1; IPR2016-00922, Paper 16, 1. Nevertheless, because there are a limited number of references and grounds asserted in each case, because of the similarities between the Specifications of each challenged patent, because of the similar constructions of the claim terms in each case, and because there are no additional motions currently filed in either case; a consolidated oral hearing will be heard, and each party will have a total of forty-five (45) minutes to present its arguments for both cases. In each case, because Petitioner bears the burden of persuasion on the instituted challenges, Petitioner will open the hearing by presenting its arguments regarding the challenged claims for which we instituted each review. Petitioner may reserve time for rebuttal arguments. Patent Owner then will respond to Petitioner's arguments. Petitioner then may present rebuttal arguments during its reserved rebuttal time. **To the extent that any argument or evidence shall apply only to one case, the party presenting that argument or evidence must make the limited applicability of its argument or evidence clear.**

The consolidated hearing for these cases will commence at 1:00 PM Eastern Time on July 12, 2017, on the ninth floor of the U.S. Patent and Trademark Office,

[2] Throughout the remainder of this Order, we cite to the papers filed in IPR2016-00921. The parties have filed similar papers in IPR2016-00922.

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Madison Building East, 600 Dulany Street, Alexandria, Virginia. The hearing will be open to the public for in-person attendance, to be accommodated on a first-come, first-served basis. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

Pursuant to 37 C.F.R. § 42.70(b), demonstrative exhibits for each case must be served no later than seven (7) business days before the hearing date. The demonstrative exhibits for each case shall be filed with the Board no later than the time of the hearing. **Demonstrative exhibits are not evidence, but merely a visual aid at the hearing. Further, demonstrative exhibits shall not introduce new arguments or evidence, but instead, should cite only to arguments and evidence already in the record for these cases in which they are filed.** The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits.

The parties should attempt in good faith to resolve any objections to demonstratives prior to involving the Board. The parties *must* initiate a conference call with the Board at least two (2) business days before the hearing to present any *unresolved* objection regarding the propriety of any demonstrative exhibit. Any unresolved objection to demonstrative exhibits that is not timely presented to the Board shall be deemed waived. Because the demonstrative exhibits are not evidence, may not present new arguments, and shall not be considered apart from arguments and evidence properly of record in these cases, the Board asks the parties to confine demonstrative exhibit objections to those identifying egregious violations that are prejudicial to the administration of justice. To aid in the preparation of an accurate transcript, each party shall provide paper copies of its

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demonstratives to the court reporter on the day of the oral hearing. Such paper copies shall **not** become part of the record of these cases.

The parties are reminded that each presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number), paper, or exhibit referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript. The parties also should note that one member of the panel will be attending the hearing electronically from a remote location and that, if any demonstrative is not made fully available or visible to all of the judges presiding over the hearing, that demonstrative will not be considered. Because of limitations of the audio transmission systems in our hearing rooms, the presenter may speak only when standing at the hearing room lectern. If the parties have questions as to whether demonstrative exhibits would be sufficiently available and visible to each panel member, the parties are invited to contact the Board at (571) 272-9797.

The Board expects the lead counsel for each party to be present in person at the hearing. If a party anticipates that its lead counsel will not be attending the hearing, the parties should initiate a joint telephone conference with the Board no later than seven (7) business days prior to the hearing date to discuss the matter. Any counsel of record, however, may present a party's arguments.

Lead counsel and back-up counsel may use portable computers in the hearing room at the counsel tables and at the hearing room lectern. The parties may not use such computers to make an audio or video recording of the hearing or to link to the Internet during the hearing or from the hearing room. The parties are reminded to direct their requests for special equipment, e.g., audio-visual equipment, or accommodations to **Trials@uspto.gov**. *See* Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Requests for special equipment or accommodations will not be honored unless presented in a separate

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communication directed to the above e-mail address not less than five (5) days before the oral hearing. If the request is not received timely, the equipment may not be available or accommodations may not be possible on the day of the hearing. Please note, however, that information projected in the hearing room in Alexandria may not be visible to the panel member participating in the hearing from the remote location.

ORDER

It is

ORDERED that the hearing for these cases shall take place beginning at 1:00 PM Eastern Time on July 12, 2017, on the ninth floor of the U.S. Patent and Trademark Office, Madison Building East, 600 Dulany Street, Alexandria, Virginia.

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Skechers v Nike

PETITIONER:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	15/610,089	Confirmation No. 4757
Inventor	:	Bhupesh Dua	
Applicants	:	NIKE, Inc.	
Filed	:	5/31/2017	
Title	:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	
Group Art Unit	:	3765	
Examiner	:	Marie D. Bays	
Matter No.	:	NIKE.276100/08-1313US82CON	
Customer No.	:	78342	

VIA EFS – 7/24/2017

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

IDS SUBMISSION

This correspondence is being submitted with an Information Disclosure Statement pursuant to 37 C.F.R. § 1.97. Due to the number of references, the IDS is separated into multiple forms. Accordingly, Applicant hereby submits IDS forms 1-11 as this IDS submission. Each IDS form corresponds to an IDS form filed in the Application No. 14/503,514 from which this pending application depends. Pursuant to 37 C.F.R. § 1.97(c)(2), Applicant submits herewith the fee set forth in § 1.17(g) for the IDS submission.

Respectfully submitted,

/ELIZABETH A. LUCAS/

Elizabeth A. Lucas
Reg. No. 74,247

EAL
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8298658
8298658 v1

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (03-15)
Approved for use through 07/31/2016. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

U.S.PATENTS Remove

Examiner Initial*	Cite No	Patent Number	Kind Code[1]	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1					

If you wish to add additional U.S. Patent citation information please click the Add button. Add

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Examiner Initial*	Cite No	Publication Number	Kind Code[1]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1					

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Examiner Initial*	Cite No	Foreign Document Number[3]	Country Code[2] i	Kind Code[4]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T[5]
	1							

If you wish to add additional Foreign Patent Document citation information please click the Add button Add

NON-PATENT LITERATURE DOCUMENTS Remove

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T[5]

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	15610089
	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

	1	Petitioner Adidas AG's Notice of Supplemental Evidence in Response to Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(8)(1) for Inter Partes Review IPR2016-00921 dated May 12, 2017, 4 pages.	
	2	Petitioner's Exhibit List (as of May 12, 2017) for Inter Partes Review IPR2016-00921, dated May 12, 2017, 4 pages.	
	3	Declaration of Tiffany L. Williams, and submitted to the US Patent and Trademark Office on May 12, 2017 as Exhibit 1015 to the Petitioner Adidas AG's Notice of Supplemental Evidence in Response to Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(8)(1) for Inter Partes Review IPR2016-00921 dated May 12, 2017 and for Inter Partes Review IPR2016-00922.	
	4	Petitioner Adidas AG's Notice of Supplemental Evidence in Response to Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(8)(1) for Inter Partes Review IPR2016-00922 dated May 12, 2017, 4 pages.	
	5	Petitioner's Exhibit List (as of May 12, 2017) for Inter Partes Review IPR2016-00922, dated May 12,2017, 4 pages.	

If you wish to add additional non-patent literature document citation information please click the Add button Add

EXAMINER SIGNATURE

Examiner Signature		Date Considered	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1] See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. [2] Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). [3] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [4] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [5] Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	15610089
	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

☒ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ A certification statement is not submitted herewith.

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/ELIZABETH A. LUCAS/	Date (YYYY-MM-DD)	2017-07-24
Name/Print	Elizabeth A. Lucas	Registration Number	74247

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Acknowledgement Receipt

EFS ID:	29857029
Application Number:	15610089
International Application Number:	
Confirmation Number:	4757
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Customer Number:	78342
Filer:	Elizabeth Ashley Lucas
Filer Authorized By:	
Attorney Docket Number:	NIKE.276100/081313US82CON
Receipt Date:	24-JUL-2017
Filing Date:	31-MAY-2017
Time Stamp:	19:22:17
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Non Patent Literature	276100_3_NPL_01_Petitioners_Notice_Supplemental_Evidence_for_Review_Inter_Partes_PR2016_00921.pdf	103323 81459d3f5b025ac6180b11fd6f63bd5c122efdb6	no	4

Warnings:

Information:					
2	Non Patent Literature	276100_3_NPL_02_Petitioners_Exhibit_List05_12_17_for_Inter_Partes_Review_IPR2016_00921_05_12_17.pdf	73253 1cd1ce9516d278407a44ad6ac454d975f739c1ee	no	4
Warnings:					
Information:					
3	Non Patent Literature	276100_3_NPL_03_Declaration_T_Williams_Ex_1015_IPR2016_00921_05_12_17_Inter_Partes_IPR2016_00922.pdf	625239 7d518da37bd84c52a4fc592aed59302fb7882f8e	no	2
Warnings:					
Information:					
4	Non Patent Literature	276100_3_NPL_04_Adidas_Notice_Supple_Evidence_Inter_Partes_Review_IPR2016_00922.pdf	103290 3ee0e73c3f46f665c4f2017a49913e6fcaf89dd6	no	4
Warnings:					
Information:					
5	Non Patent Literature	276100_3_NPL_05_Petitioners_Exhibit_List_05_12_17_for_Inter_Partes_Review_IPR2016_00922_05_12_17.pdf	73291 30a9ae12af75d1ad2b6397eddaba638468d7c6ed	no	4
Warnings:					
Information:					
6	Transmittal Letter	276100_IDS_Cover_Letter.pdf	15812 b1b889159707e0f36ef66f09e808db56fdc05f99	no	1
Warnings:					
Information:					
7	Information Disclosure Statement (IDS) Form (SB08)	276100_IDS_3.PDF	1035225 8e2847fb1b3f1f23ca1cac33a7ae4aebabae649f	no	4
Warnings:					
Information:					
A U.S. Patent Number Citation or a U.S. Publication Number Citation is required in the Information Disclosure Statement (IDS) form for autoloading of data into USPTO systems. You may remove the form to add the required data in order to correct the Informational Message if you are citing U.S. References. If you chose not to include U.S. References, the image of the form will be processed and be made available within the Image File Wrapper (IFW) system. However, no data will be extracted from this form. Any additional data such as Foreign Patent Documents or Non Patent Literature will be manually reviewed and keyed into USPTO systems.					
		Total Files Size (in bytes):	2029433		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner

v.
NIKE, Inc.
Patent Owner

Case IPR2016-00921
Patent No. 7,814,598

PETITIONER ADIDAS AG'S
NOTICE OF SUPPLEMENTAL EVIDENCE IN RESPONSE TO PATENT OWNER'S OBJECTIONS TO EVIDENCE UNDER 37 C.F.R. § 42.64(B)(1)

On April 28, 2017, Patent Owner NIKE, Inc. ("Owner") served its Objections to Admissibility of Evidence Served with Petitioner's Reply to Patent Owner's Response under 37 C.F.R. § 42.64(b)(1) in response to adidas AG's ("Petitioner") evidence served with Petitioner's Reply to Patent Owner's Response on April 21, 2017.

In response, Petitioner hereby submits the following Supplemental Evidence:

Exhibit	Description
Exhibit 1015	Declaration of Tiffany L. Williams

While Petitioner does not agree with the objections set forth by Owner, this supplemental evidence obviates the listed objections.

Petitioner notes that 37 C.F.R. § 42.64(b)(1) requires that evidentiary objections "must identify the grounds for the objection with sufficient particularity to allow for correction in the form of supplemental evidence." Many, if not all, of Owner's objections contain only conclusory references to the Federal Rules of Evidence and thus do not provide the required particularity. Petitioner thus reserves all rights to respond to any further explanations Owner is allowed to provide regarding its evidentiary objections. Petitioner further reserves the right to

rely on any testimony elicited from any of the declarants during any depositions that occur during these proceedings in responding to any objections maintained by Owner.

Dated: May 12, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

Lead Counsel	Back-Up Counsel
Mitchell G. Stockwell Reg. No. 39,389 mstockwell@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 815 6214	Vaibhav P. Kadaba Reg. No. 45,865 wkadaba@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 532 6959 Tiffany L. Williams Reg. No. 59,549 tiwilliams@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 815 6608

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER ADIDAS AG'S NOTICE OF SUPPLEMENTAL EVIDENCE IN RESPONSE TO PATENT OWNER'S OBJECTIONS TO EVIDENCE UNDER 37 C.F.R. § 42.64(B)(1)** have been served on May 12, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

Christopher J. Renk
Michael J. Harris
BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago, Illinois 60606
crenk@bannerwitcoff.com,
mharris@bannerwitcoff.com, and
bwlitdocket@bannerwitcoff.com

Dated: May 12, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case: IPR2016-00921
Patent 7,814,598

PETITIONER'S EXHIBIT LIST
(AS OF MAY 12, 2017)

LIST OF EXHIBITS

1001	U.S. Patent No. 7,814,598 ("the '598 patent")
1002	File History for U.S. Patent No. 7,814,598 ("'598 file history")
1003	Declaration of Lenny Holden ("Holden Decl.")
1004	C.V. for Lenny Holden
1005	Form PTO-SB/42
1006	U.S. Patent No. 3,985,003 to Reed ("Reed")
1007	U.S. Patent No. 4,038,840 to Castello ("Castello")
1008	U.S. Patent No. 6,330,814 to Fujiwara ("Fujiwara")
1009	U.S. Patent No. 5,345,638 to Nishida ("Nishida")
1010	David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third Ed., Woodhead Publishing Ltd. 2001) ("Spencer")
1011	Paul Burall, "CoID Design Awards," Design, June 1969, pp. 46-47 ("Burall")
1012	ISO 8117:2003(E) Textile machinery - Knitting machines - Nominal diameters of circular machines ("ISO 8117")
1013	Ardis W. Koester, "Analyzing the Color, Design, and Texture of Fabric," Oregon State University Extension Service, May 1993 ("Koester")
1014	Definition of "Impart" from Merriam-Webster
1015	Declaration of Tiffany L. Williams

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389

Lead Counsel	Back-Up Counsel
Mitchell G. Stockwell Reg. No. 39,389 mstockwell@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 815 6214	Vaibhav P. Kadaba Reg. No. 45,865 wkadaba@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 532 6959 Tiffany L. Williams Reg. No. 59,549 tiwilliams@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 815 6608

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S EXHIBIT LIST (AS OF MAY 12, 2017)** has been served on May 12, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

Christopher J. Renk
Michael J. Harris
BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
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mharris@bannerwitcoff.com, and
bwlitdocket@bannerwitcoff.com

Dated: May 12, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner

v.

NIKE, Inc.,
Patent Owner

Case No. IPR2016-00921
Patent No. 7,814,598

DECLARATION OF TIFFANY L. WILLIAMS

I, Tiffany L. Williams, do hereby declare as follows:

1. I am an attorney with the law firm Kilpatrick Townsend & Stockton LLP and I am appearing as back-up counsel for Petitioner adidas AG in the above-captioned proceeding. I am over the age of eighteen and competent to make this declaration based on my personal knowledge and documents maintained by my law firm in the ordinary course of business.

2. Exhibit 1013 filed in the above-referenced IPR proceeding is a true and correct copy of the article entitled "Analyzing the Color, Design, and Texture of Fabric," originally published in May 1978 and reprinted in May 1993 by the Oregon State University Extension Service.

3. Exhibit 1014 is a true and correct copy of the webpage "Impart | Definition of Impart by Merriam-Webster" dated April 10, 2017, which is available at http://www.merriam-webster.com/dictionary/impart.

4. I hereby declare under penalty of perjury under the laws of the United States of America that the foregoing statements are true and correct.

Executed on May 12, 2017

/s/ Tiffany L. Williams

Tiffany L. Williams
KILPATRICK TOWNSEND & STOCKTON LLP
1100 Peachtree Street, NE
Suite 2800
Atlanta, GA 30309
Telephone: (404) 815-6500
Facsimile: (404) 815-6555
tiwilliams@kilpatricktownsend.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner

v.
NIKE, Inc.
Patent Owner

Case IPR2016-00922
Patent No. 8,266,749

PETITIONER ADIDAS AG'S
NOTICE OF SUPPLEMENTAL EVIDENCE IN RESPONSE TO PATENT OWNER'S OBJECTIONS TO EVIDENCE UNDER 37 C.F.R. § 42.64(B)(1)

On April 28, 2017, Patent Owner NIKE, Inc. ("Owner") served its Objections to Admissibility of Evidence Served with Petitioner's Reply to Patent Owner's Response under 37 C.F.R. § 42.64(b)(1) in response to adidas AG's ("Petitioner") evidence served with Petitioner's Reply to Patent Owner's Response on April 21, 2017.

In response, Petitioner hereby submits the following Supplemental Evidence:

Exhibit	Description
Exhibit 1015	Declaration of Tiffany L. Williams

While Petitioner does not agree with the objections set forth by Owner, this supplemental evidence obviates the listed objections.

Petitioner notes that 37 C.F.R. § 42.64(b)(1) requires that evidentiary objections "must identify the grounds for the objection with sufficient particularity to allow for correction in the form of supplemental evidence." Many, if not all, of Owner's objections contain only conclusory references to the Federal Rules of Evidence and thus do not provide the required particularity. Petitioner thus reserves all rights to respond to any further explanations Owner is allowed to provide regarding its evidentiary objections. Petitioner further reserves the right to

rely on any testimony elicited from any of the declarants during any depositions that occur during these proceedings in responding to any objections maintained by Owner.

Dated: May 12, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

Lead Counsel	Back-Up Counsel
Mitchell G. Stockwell Reg. No. 39,389 mstockwell@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 815 6214	Vaibhav P. Kadaba Reg. No. 45,865 wkadaba@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 532 6959 Tiffany L. Williams Reg. No. 59,549 tiwilliams@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE Suite 2800 Atlanta, Georgia 30309 (404) 815 6608

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER ADIDAS AG'S NOTICE OF SUPPLEMENTAL EVIDENCE IN RESPONSE TO PATENT OWNER'S OBJECTIONS TO EVIDENCE UNDER 37 C.F.R. § 42.64(B)(1)** have been served on May 12, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

Christopher J. Renk
Michael J. Harris
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10 South Wacker Drive
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Chicago, Illinois 60606
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bwlitdocket@bannerwitcoff.com

Dated: May 12, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case: IPR2016-00922
Patent 8,266,749

PETITIONER'S EXHIBIT LIST
(AS OF MAY 12, 2017)

LIST OF EXHIBITS

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1002	File History for U.S. Patent No. 8,266,749 ("'749 file history")
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1006	U.S. Patent No. 3,985,003 to Reed ("Reed")
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1009	U.S. Patent No. 5,345,638 to Nishida ("Nishida")
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1014	Definition of "Impart" from Merriam-Webster
1015	Declaration of Tiffany L. Williams

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
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Christopher J. Renk
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Suite 3000
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bwlitdocket@bannerwitcoff.com

Dated: May 12, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	15/610,089	Confirmation No. 4757
Inventor	:	Bhupesh Dua	
Applicants	:	NIKE, Inc.	
Filed	:	5/31/2017	
Title	:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	
Group Art Unit	:	3765	
Examiner	:	Marie D. Bays	
Matter No.	:	NIKE.276100/08-1313US82CON	
Customer No.	:	78342	

VIA EFS – 7/24/2017

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

IDS SUBMISSION

This correspondence is being submitted with an Information Disclosure Statement pursuant to 37 C.F.R. § 1.97. Due to the number of references, the IDS is separated into multiple forms. Accordingly, Applicant hereby submits IDS forms 1-11 as this IDS submission. Each IDS form corresponds to an IDS form filed in the Application No. 14/503,514 from which this pending application depends. Pursuant to 37 C.F.R. § 1.97(c)(2), Applicant submits herewith the fee set forth in § 1.17(g) for the IDS submission.

Respectfully submitted,

/ELIZABETH A. LUCAS/

Elizabeth A. Lucas
Reg. No. 74,247

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SHOOK, HARDY & BACON L.L.P.
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Kansas City, MO 64108-2613
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8298658
8298658 v1

Skechers EX1013-p. 342
Skechers v Nike

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (03-15)
Approved for use through 07/31/2016. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	15610089
	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

	1	Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00921 dated April 21, 2017, 32 pages.	
	2	Petitioner's Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8 for Inter Partes Review IPR2016-00921, dated April 21, 2017, 5 pages.	
	3	Koester, A.W., "Analyzing the Color, Design and Texture of Fabric", Oregon State University Extension Service, 1993, 8 pages, and submitted to the US Patent and Trademark Office on April 21, 2017 as Exhibit 1013 to the Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00921 dated April 21, 2017 and for Inter Partes Review IPR2016-00922.	
	4	'Definition of 'Impart"', Merriam-Webster, printed on April 10, 2017 from the internet: hltgs://vvwvv.rnerriarn-webster. corn/diciionary/imQarl, 11 pages, and submitted to the US Patent and Trademark Office on April 21, 2017 as Exhibit 1014 to the Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00921 dated April 21, 2017 and for Inter Partes Review IPR2016-00922.	
	5	Patent Owner's Objections to Admissibility of Evidence Served With Petitioner's Reply to Patent Owner's Response Pursuant to 37 C.F.R. § 42.64(b) for Inter Partes Review IPR2016-00921 dated April28, 2017, 4 pages.	
	6	Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00922 dated April 21, 2017, 34 pages.	
	7	Petitioner's Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8 for Inter Partes Review IPR2016-00922, dated April 21, 2017, 5 pages.	
	8	Patent Owner's Objections to Admissibility of Evidence Served With Petitioner's Reply to Patent Owner's Response Pursuant to 37 C.F.R. § 42.64(b) for Inter Partes Review IPR2016-00922 dated April 28, 2017, 4 pages.	

If you wish to add additional non-patent literature document citation information please click the Add button Add

EXAMINER SIGNATURE

Examiner Signature		Date Considered	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1] See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. [2] Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). [3] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [4] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [5] Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

☒ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ A certification statement is not submitted herewith.

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/ELIZABETH A. LUCAS/	Date (YYYY-MM-DD)	2017-07-24
Name/Print	Elizabeth A. Lucas	Registration Number	74247

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Acknowledgement Receipt

EFS ID:	29857540
Application Number:	15610089
International Application Number:	
Confirmation Number:	4757
Title of Invention:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER
First Named Inventor/Applicant Name:	BHUPESH DUA
Customer Number:	78342
Filer:	Elizabeth Ashley Lucas
Filer Authorized By:	
Attorney Docket Number:	NIKE.276100/081313US82CON
Receipt Date:	24-JUL-2017
Filing Date:	31-MAY-2017
Time Stamp:	19:24:05
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Non Patent Literature	276100_4_NPL_01_Petitioners_Reply_to_Patent_Owners_Response_IPR2016_00921.pdf	1086446 ece8811dc3aa3834a4583f91368564404081ddb9	no	32

Warnings:

Information:					
2	Non Patent Literature	276100_4_NPL_02_Petitioners_Updated_Mandatory_Notices_IPR2016_00921.pdf	126381 45e800d7fe351727f7ec8253ae47ed0e940a0abc	no	5
Warnings:					
Information:					
3	Non Patent Literature	276100_4_NPL_03_Koester_Analyzing_Color_Design_Texture_of_Fabric_IPR2016_00921_and_IPR2016_00922.pdf	3834250 b1f36ca61eeec2d3e69639f9c60c453c14a0b3d1	no	8
Warnings:					
Information:					
4	Non Patent Literature	276100_4_NPL_04_Definition_of_IMPART_Meriam_Webster_IPR2016_00921_and_IPR2016_00922.pdf	599853 6d0355e1ed38182a12d882eecca5fdd039c344e5	no	11
Warnings:					
Information:					
5	Non Patent Literature	276100_4_NPL_05_Patent_Owners_Objections_to_Admissibility_of_Evidence_IPR2016_00921.pdf	101229 a3c813a92452e82aeaa570ad807e6dd0f639beee	no	4
Warnings:					
Information:					
6	Non Patent Literature	276100_4_NPL_06_Petitioners_Reply_to_Patent_Owners_Response_IPR2016_00922.pdf	1144097 635b948e9d25f744ad7dd5dae62c8d70bbe680a5	no	34
Warnings:					
Information:					
7	Non Patent Literature	276100_4_NPL_07_Petitioners_Updated_Mandatory_Notices_IPR2016_00922.pdf	128340 7e9ecb5ba8b633f3188caf4eafc116293b393af6	no	5
Warnings:					
Information:					
8	Non Patent Literature	276100_4_NPL_08_Patent_Owners_Objections_to_Admissibility_of_Evidence_IPR2016_00922.pdf	106955 8022241cdf1b5326016f8b5cead71aa3387514dc	no	4
Warnings:					
Information:					

9	Transmittal Letter	276100_IDS_Cover_Letter.pdf	15812 b1b889159707e0f36ef66f09e808db56fdc05f99	no	1
Warnings:					
Information:					
10	Information Disclosure Statement (IDS) Form (SB08)	276100_IDS_4.PDF	1035612 d1ffb100539207b8c5bd2ac747844d4a0ca3be87	no	4
Warnings:					
Information:					

A U.S. Patent Number Citation or a U.S. Publication Number Citation is required in the Information Disclosure Statement (IDS) form for autoloading of data into USPTO systems. You may remove the form to add the required data in order to correct the Informational Message if you are citing U.S. References. If you chose not to include U.S. References, the image of the form will be processed and be made available within the Image File Wrapper (IFW) system. However, no data will be extracted from this form. Any additional data such as Foreign Patent Documents or Non Patent Literature will be manually reviewed and keyed into USPTO systems.

Total Files Size (in bytes):	8178975

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case: IPR2016-00921
Patent 7,814,598

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

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1010	David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third Ed., Woodhead Publishing Ltd. 2001) ("Spencer")
1011	Paul Burall, "CoID Design Awards," Design, June 1969, pp. 46-47 ("Burall")
1012	ISO 8117:2003(E) Textile machinery - Knitting machines - Nominal diameters of circular machines ("ISO 8117")
1013	Ardis W. Koester, "Analyzing the Color, Design, and Texture of Fabric," Oregon State University Extension Service, May 1993 ("Koester")
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I. INTRODUCTION

Owner's Response is replete with attorney argument, yet provides no evidence for its strained arguments. Owner does not bother challenging the admissibility of Mr. Holden's expert testimony, and his extensive credentials and detailed analysis more than overcome Owner's weak attacks on weight. The evidentiary record alone thus confirms the Board's initial finding of a likely showing of obviousness.

None of Owner's other arguments overcome strong evidence of obviousness. Owner begins by seeking to avoid the full disclosure of Reed and Nishida, but its arguments are legally erroneous and factually flawed, particularly regarding motivation to combine. Reed and Nishida both show skilled artisans were aware of the key problem – manufacturing textile elements with greater speed and efficiency. Reed meets either prong of the analogous art test, and Petitioner's evidence establishes both how and why skilled artisans would combine Reed and Nishida. Owner's claims that such a combination would be inoperable, or that Reed teaches away from Nishida, are unsupported by the record.

The Reed and Nishida combination achieves the claimed subject matter. No hindsight was used to achieve that combination and Owner has not overcome Petitioner's demonstration of obviousness.

I. THE REED AND NISHIDA COMBINATION RENDERS THE CHALLENGED CLAIMS OBVIOUS.

A. The Level Of Ordinary Skill Is Neither Low Nor Requires Hands-On Knitting Machine Experience.

Owner incorrectly equates the "few years of experience in the footwear industry" a POSITA must have with a low skill level. Response, p. 13. But the POSITA must also have acquired knowledge and understanding of shoemaking, product design, upper material designs, and construction techniques. (Ex. 1003, ¶34; Ex. 2004, 129:1-18.) A POSITA with the necessary knowledge and understanding has a skill level far from "low."

Owner's related assertion that Petitioner's description is deficient because it lacks explicit analysis of all factors is legally erroneous. *See In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) ("[i]n a given case, every factor may not be present, and one or more factors may predominate."); MPEP § 2141.

Next, Owner's suggestion that the POSITA should also have operated knitting machines is unsupported. It is also inconsistent with Owner's own expert's testimony in the related review of U.S. Patent No. 7,347,011, where Mr. Tonkel opined that a "POSITA … would have a few years of experience with design and development of footwear and knowledge of textiles used in such footwear." (*See* IPR2013-00067, Ex. 2010, ¶52.) Like Mr. Holden, Mr. Tonkel's own knitting machine experience is limited to the machines he saw during factory

visits. (*See* IPR2013-00067, Ex. 1015, 38:18-23.)

In any event, Mr. Holden's unrebutted and credible testimony is that a POSITA would never be expected to operate a knitting machine, and such experience is unnecessary to gain an understanding of knitted materials and the overall capabilities of industrial knitting machines. (Ex. 2004, 71:22-76:7.)

B. Petitioner's Expert Is Credible And Persuasive.

Despite having offered Mr. Tonkel's testimony in the related matter, Owner presented no expert testimony here to substantiate its strained arguments. Nor did Owner challenge the admissibility of Mr. Holden's testimony. Mr. Holden's extensive experience, as well as the details of his analysis, demonstrate substantial weight should be accorded to his testimony.

Owner states that Mr. Holden "admitted during cross-examination that Petitioner's counsel wrote the declaration for him." Response, p. 15. Mr. Holden *actually* stated that "I worked with counsel one on one to basically give her a verbal description of my opinions and -- and my thoughts on the -- on these issues, and she did the actual typing of the document." (Ex. 2004, 12:7-11; *see also* 12:12-13:16.)

Owner's misrepresentation of the actual testimony is telling. So are the scant seven lines Owner devoted to this issue. The Board's recent decision in *Square, Inc. v. Think Computer Corporation* applies here. There, the Board held

that, when the manner of the expert's testimony is in line with typical testimony before the Board, and the expert's background, analysis, and supporting evidence are credible and persuasive, an inquiry into "the mechanics of declaration preparation is 'a waste of time, both for the witness and the Board.'" *Square, Inc. v. Think Computer Corp.*, No. CBM2014-00159, Paper No. 47 at pp. 26-27, 2015 WL 7695141, at *13 (PTAB Nov. 27, 2015) (quoting *Pevarello v. Lan*, Patent Interference 105, 394 MPT, Paper No. 85, slip op. at 19–21 (BPAI Jan. 12, 2007).) Likewise, in view of Mr. Holden's credible and persuasive background, analysis, and supporting evidence, any further analysis or inquiry into this issue is a waste of time for both the witness and the Board.

Owner next claims that Mr. Holden's testimony should be given no weight simply because he did not concisely define "stitch configuration" or "texture" — terms used in the '598 claims. Response, pp. 15-16. Neither of these terms were submitted for construction, and Mr. Holden was not asked to opine on construction of those terms. Nevertheless, Mr. Holden did explain his understanding of "stitch configuration." (Ex. 2004, 78:22-79:18.)

Likewise, Mr. Holden explained texture generally could be an actual texture or a perceived texture based on the arrangement of colors in a pattern. (Ex. 2004, 178:20-24; *see also* 177:1-178:19; 178:25-184:11.) Owner labels this testimony as being "incredible," but the art confirms otherwise (Ex. 1013, p. 5) and Owner has

provided no factual or evidentiary support of its claim.

Owner also critiqued Mr. Holden's inability to ***concisely*** define certain terms used by Reed. But the terms at play are not part of any disclosure relied upon or in dispute, and Mr. Holden was well within his rights to insist on referring to the treatise identified in his declaration that defined such terms. (Ex. 1003, ¶12.) Ability to memorize definitions is not a requirement for an expert, or any witness.

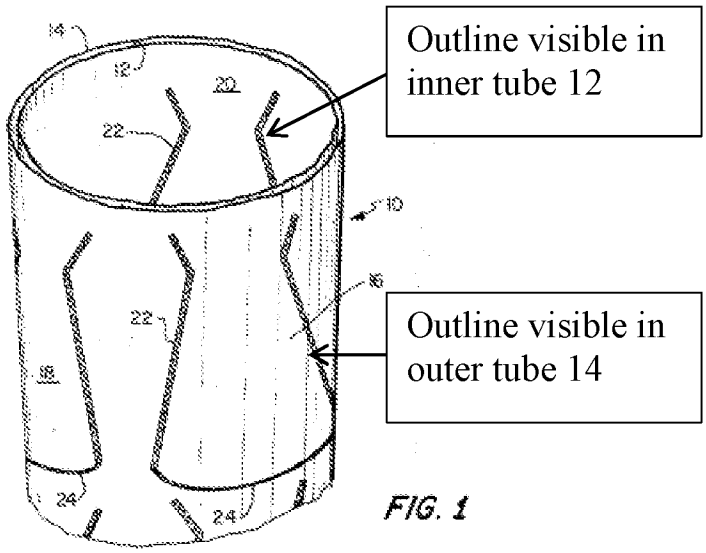
Owner then states that Mr. Holden "testified that he does not understand portions of Nishida's description of the invention disclosed in Nishida." Response, p. 17. This is false. Mr. Holden provided comprehensive answers to several questions regarding Nishida. (*See* Ex. 2004, 162:19-168:2.) Similarly, Owner critiques Mr. Holden for not reviewing a German patent identified in Nishida. But it never articulates why this lapse was so key that it impacts the weight of testimony. Nor can it. It is the full disclosure of Nishida that is legally relevant, not pieces thereof or even a separate German patent referenced therein.

C. Owner's Efforts To Ignore The Full Scope And Content Of Reed And Nishida Are Legally Erroneous And Factually Flawed.

Owner theorizes that Reed is limited to finished garments and Nishida cannot be combined with the finished garment embodiments. Neither proposition is correct.

1. Reed Describes A Method Of Forming Finished Garments and Layered Garment Sections.

Reed describes a circular knitting machine programmed to simultaneously knit an inner tube 12 and an outer tube 14. (Ex. 1006, 1:58-64; FIG. 1; Ex. 1003, ¶98.) The two tubes 12, 14 are interconnected through interconnecting knitted stitches 22, 24. *Id.* As a result, a garment outline is formed in the outer tube 14 and in the juxtaposed inner tube 12.



As Owner noted, Reed describes embodiments where these interconnected outlines can be severed from the tubes 12, 14 to form "finished, or nearly finished, garments." Response, p. 21. In these embodiments, the interconnected outlines form the back and front of a "finished garment," and the wearer's body is inserted between the two interconnected outlines. (Ex. 1006, 1:64-2:1; Ex. 2004, 142:2-17.)

But Reed ***also*** describes embodiments in which these interconnected outlines can be used to "form sections of a garment to be assembled in the regular manner." (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117; Ex. 2004, 141:13-20; 143:15-21.) In other words, the inner tube 12 outline becomes a lining attached to the outer tube 14 outline to form a lined section of a garment. *Id.* The lined section is then attached to another lined section by conventional seaming methods. *Id.* One lined section forms the garment back, and the other lined section forms the garment front. *Id.* Thus, Reed clearly describes "lined section" embodiments that are ***not*** limited to "finished garments."

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck,* 699 F.2d 1331, 1332-33 (Fed. Cir. 1983)). Owner's reliance on *Pacing Techs., LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015) and *Regents of Univ. of Minn. v. AGA Med. Corp.*, 717 F.3d 929, 936 (Fed. Cir. 2013) in an effort to avoid this controlling law is legally flawed. These cases hold that claim scope disavowal is assessed for purposes of claim construction, not for assessing the "full scope and content of the prior art," as Owner alleges. Response, pp. 19-20.

Finally, the distinction Owner seeks to draw is immaterial because Reed's "finished garment" and the "lined section" embodiments utilize the same

interconnected outlines. They differ only in how the outlines are removed from the tubes. In the "finished garment" embodiments, the outlines are separated from each other in certain locations to form openings for a person's body to fit through. (Ex. 1006, 1:64-2:1.) In the "lined section" embodiments, separating the outlines is unnecessary because a person's body is not positioned between the lining and the outer layer. (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117; Ex. 2004, 141:13-20.)

2. Owner's Efforts To Ignore Nishida's Full Disclosure Are Likewise Flawed.

As with Reed, Owner's assessment of Nishida again ignores controlling law by asserting that "Nishida teaches achieving [the related sole part] by producing a web of material just like in the German patent." Response, p. 24. Legally, the assertion deserves no weight and, factually, it is incorrect.

If Nishida were so limited, it would have confined itself to improving a weaving process because the "German patent" only describes weaving. Yet Nishida clearly states that "[i[]n FIGS. 1 and 2, a web of material is identified by 1, and is produced by a conventional textile process, for example, by weaving and/or knitting and/or embroidering." (Ex. 1009, 3:6-9; Ex. 1003, ¶78, 96.)

Owner next urges that Nishida discloses only applying a textile element to an existing backing, as it argued to the examiner of U.S. Patent No. 8,266,749, a

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child of the '598 patent. (*See* IPR2016-00922, Ex. 1002, 1/13/2012 Response, p. 6-8.) Owner's later positions regarding Nishida are wholly inconsistent, first asserting that Nishida is limited to a "'layout' [] surrounded by a textile structure from which it must be removed" (*See* IPR2013-00067, Paper 31, pp. 6-7), and asserting that Nishida is limited to a layout that *is* the entire web of material with no surrounding area, *i.e.* knit to shape. (*See* IPR2013-00922, Paper No. 9, p. 53.)

Nishida expressly states that "in the production of a web of material, both the patterns or partial patterns in the form of layouts of the shoe upper and the . . . sole part, *are produced by a fabric printing process* (which is generally well known in the textile industry) *on* the web of material and/or by *a textile production process inside* the web of material . . . ." (Ex. 1009, 1:50-56 (emphasis added); Ex. 1003, ¶113.) In other words, Nishida describes producing the layout *on* a web of material (e.g., embroidery) or *inside* the web of material (e.g., knitting). (Ex. 2004; 158:10-162:4; 168:22-170:13.)

In a flawed effort to rewrite Nishida's disclosure, Owner replaced "*inside*" with "*onto*" when describing this passage. Response, p. 25. But Nishida cannot be so rewritten. Indeed, Nishida explains that only the web parts that correspond to the shoe upper or shoe part are produced in the necessary quality, thickness, and/or multilayers, whereas the web parts that hold the patterns together are produced of a simple, lightweight, or inexpensive material, thus reinforcing the concept of

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producing layouts simultaneously with the surrounding portions of the web of material. (Ex. 1009, 2:12-20; Ex. 1003, ¶101.) Thus, Owner's strained reasoning for attempting to distinguish Nishida fails.

D. OWNER FAILED TO REBUT THE MOTIVATION TO COMBINE THE PRIOR ART.

1. The POSITA Knew Of The Problem Addressed By The '598 Patent.

Owner attempts to analogize this case to *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346 (Fed. Cir. 2013). But the Court has already distinguished *Leo* specifically in this context when addressing the parent of the '598 patent, which has an identical specification. The Court noted that the age of references can be relevant to show secondary considerations, but held that situation was inapplicable here because "there is no question that skilled artisans knew of the desire to reduce waste when producing wearable, knitted shoe uppers because that problem is expressly recognized in Nishida." *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1338 (Fed. Cir. 2016).

Furthermore, Owner's narrowly-stated problem of "making footwear uppers from multiple materials" is addressed by both Reed and Nishida. The '598 patent discourages using multiple materials because of the need for additional machinery, suppliers, etc. (Ex. 1001, 3:4-16.) But those complexities are not present in Reed and Nishida, as the same machinery and process is used to produce a knitted textile

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from a single yarn type or multiple yarn types. Moreover, the '598 patent is clear that the use of different yarn types is not the type of "multiple materials" with which it is concerned, as it encourages the use of "different yarn types" to "impart different properties." (Ex. 1001, 9:67-10:1.)

But Mr. Holden testified that the '598 patent identifies several additional problems: "(1) inefficiencies and cost in using multiple materials, and (2) poor breathability of materials like leather (natural or synthetic) and rubber." (Ex. 1001, 3:3-23; Ex. 1003, ¶47-48.) Reed and Nishida identify these same inefficiencies in producing textile products. (Ex. 1006, 2:22-31, 6:19-22; Ex. 1009, 2:27-47; Ex. 1003, ¶134-135.) Mr. Holden confirmed that a POSITA would consider these issues during product development. (Ex. 2004, 116:13-118:15.) Nishida also addresses the importance of air exchange in shoes. (Ex. 1009, 3:43-52.)

Moreover, *KSR* explicitly states that it is a legal error for "courts and patent examiners [to] look only to the problem the patentee was trying to solve. . . . Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007); *see also Nike*, 812 F.3d at 1337.

Here, in addition to the desire to reduce waste, the POSITA was aware of the

need to use computerized machinery control to produce knitted products more efficiently and with more versatility. (Ex. 2004, 83:25-85:8; 91:6-92:16.) Reed recognized the need to reduce manufacturing costs of "all types of garments worn by men, women and children" by using computerized knitting machines. (Ex. 1006, 1:45-55; 2:22-31, 5:56-57; Ex. 1003, ¶73, 75, 131-132, 134; Ex. 2004, 171:25-175:7.) Reed also explains the "unlimited pattern potential" afforded by computerized knitting. (Ex. 1006, 1:45-55.) Nishida recognized that computerized knitting could form knit configurations for more durable items, such as shoes, in a more efficient and inexpensive manner. (Ex. 1009, Abstract; 2:27-33; 3:6-11; 4:12-18; *see also* 2:40-45; 4:53-60; 5:45-49; 5:64-65; Ex. 1003, ¶76, 78, 135.) Nishida also identified the advantage and ease of varying the knit options through computerization. (Ex. 1009, 2:40-45.) This need to incorporate computerized knitting technology to improve efficiencies in shoe upper manufacturing and the importance of being able to vary patterns, designs, and textures is addressed in the '598 patent. (Ex. 1001, 7:29-37; Ex. 1003, ¶79.) Thus, the POSITA's motivation for combining Reed with Nishida is based on taking Reed's improvements in knitting technology that are applicable to all garments, and extending those improvements to shoe uppers, as described in Nishida. (Ex. 1003, ¶136.)

2. Reed Is Analogous Art To The '598 Patent.

Prior art is analogous and can be applied in an obviousness combination if it

either (1) "is from the same field of endeavor, regardless of the problem addressed" or (2) "is reasonably pertinent to the particular problem with which the inventor is involved." *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1000–01 (Fed. Cir. 2016). Reed meets both prongs.

First, Reed and the '598 patent are from the same field of endeavor. The '598 patent states that "[t]he present invention relates to footwear. The invention concerns, more particularly, an article of footwear incorporating *an upper that is at least partially formed from a textile material*." (Ex. 1001, 1:18-21 (emphasis added).) As the Court explained, "[t]he field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field." *Unwired Planet*, 841 F.3d at 1001.

The Court determined that Nishida and U.S. Patent Nos. 2,178,941 ("Schuessler I") and 2,150,730 ("Schuessler II") "are in similar fields and address the same problem." *Nike*, 812 F.3d at 1337. Like the '598 patent, Nishida describes forming a textile product in the form of shoe uppers from a textile material. Like Reed, Schuessler I and II describe forming a textile product in the form of garments (e.g., knitted caps) from a textile material. It therefore follows that the '598 patent and Reed are also from the same field of endeavor. (Ex. 1006, 5:56-57; Ex. 1003, ¶131.)

Mr. Holden affirmed this conclusion, stating that "there are more similarities

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between the apparel industry and the footwear industry than there are differences." (Ex. 2004, 26:5-7; *see also* 26:16-19.) "Again, even if I say that the bottom is not part of -- is only for footwear, then I could show you footie pajamas which have bottoms on them and they're apparel." (Ex. 2004, 38:14-17; *see also* 26:22-40:1.)

Reed likewise satisfies the second prong. The Court determined that Nishida, Schuessler I, and Schuessler II ""serve the same purpose' of efficiently creating knitted articles." *Nike*, 812 F.3d at 1337. Likewise, the '598 patent and Reed each identify a purpose to efficiently create knitted articles. (Ex. 1001, 3:13-16; Ex. 1006, 2:22-31; Ex. 1003, ¶47-48, 134.) The '598 patent also describes the benefit of altering the design and pattern of a textile structure using a programmable knitting machine, as does Reed. (Ex. 1001, 7:25-37; Ex. 1006, 1:45-55.) Thus, Reed is pertinent to the problem of the '598 patent.

Incredibly, Owner claims that a POSITA would not consider Reed because Mr. Holden lacks knitting machine operation experience. Response, p. 30. As detailed above, such experience is immaterial to the skilled artisan's ability to comprehend Reed. (Ex. 2004, 71:22-76:7.) Indeed, Mr. Holden explained that skilled artisans routinely rely on suppliers' knowledge of equipment capability, as Mr. Tonkel confirmed. (Ex. 2004, 113:1-10; *see* IPR2013-00067, Ex. 1015, 38:18-23.)

Owner also claims that a POSITA would not consider Reed because Mr.

Holden "testified that he did not understand much of Reed." Response, p. 30. That is false. At most, Mr. Holden declined to define, without reference to Spencer, terms of art from Reed when questioned without reference to Reed. (Ex. 2004, 76:8-81:18.)

When questioned about Reed in context, Mr. Holden readily described how certain embodiments of Reed's garment are seamed and cut, along with an explanation of knitting machine operation. (Ex. 2004, 142:13-148:22; 149:4-151:6.)

3. Petitioner Addressed Why A POSITA Would Have Been Motivated To Combine Reed And Nishida And How The POSITA Would Have Combined Them.

Mr. Holden declared that using Reed's process to produce textile elements for all types of clothing, including for footwear, is a simple design choice that is predictable and well known to the POSITA. (Ex. 1003, ¶132, 137.) This testimony stands unrebutted. Moreover, Mr. Holden testified, again unrebutted, that the key features a POSITA would consider for sourcing shoes include throughput, machine capabilities, maintenance, process control, and manufacturing location. (Ex. 2004, 115:4-15; 116:13-118:15; *see also* 120:7-10.) This testimony — based on over 40 years of footwear and apparel expertise — demonstrates that skilled artisans have ***always*** been motivated to improve manufacturing efficiencies. Plainly, this is a core reason as to ***why*** a POSITA would combine Reed with

Nishida.

As to the ***how*** question Owner raises, the record amply addresses that issue as well. First, Owner's "how argument" is inextricably linked to its (incorrect) argument that Reed is non-analogous art. Indeed, Reed's use of "all types of garments" and "stockings" is sufficient to suggest to the POSITA that its process could be used to make knitted uppers. Moreover, the '598 patent defines textile broadly as "any manufacture from fibers, filaments, or yarns…", not just shoe uppers. (Ex. 1001, 2:15-23.) As Mr. Holden explains, it is a POSITA's due diligence that drives selection of a manufacturing process with the capability to cost-effectively produce the layouts. (Ex. 2004, 119:1-13; *see also* 93:13-95:6; 113:1-118:15; 119:14-126:16.)

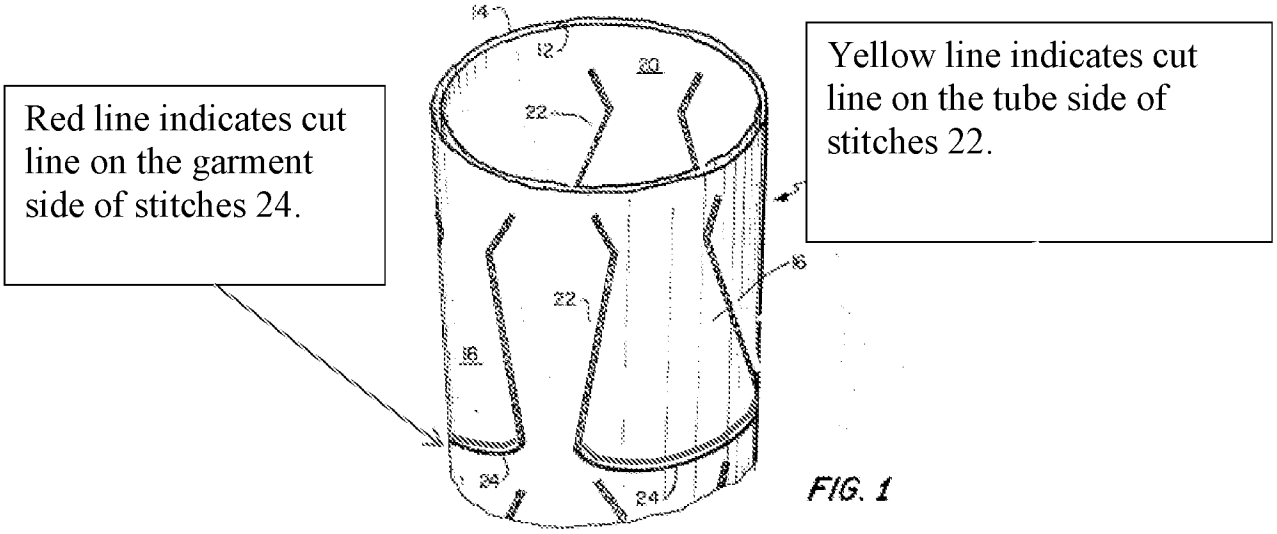
Thus, modifying the knitting manufacturing process to produce the shoe upper is nothing more than changing the machine programming. As Reed expressly states, "[t]he types of program used to form the final product is to be varied with the imagination of the programmer, as well as the type of product which may be formed." (Ex. 1006, 6:22-25; *see also* 4:68-5:2.) In short, Reed teaches how to modify itself to incorporate Nishida's layout.

4. Reed Is Operable When Combined With Nishida.

Owner's arguments that Reed is limited to the "finished garment" embodiments are irrelevant.

In both the "finished garment" and the "lined section" embodiments, the interconnected outlines in Reed are formed identically. Reed states that the same stitches 22, 24 can be used for outlining a cut line and preseaming (*e.g.*, stitches 22) or just for providing a cut line (*e.g.*, stiches 24). (Ex. 1006, 3:9-15; Ex. 1003, ¶103.)

For the "finished garment" embodiment, the sides are cut along the surrounding tube side of the stitches 22 (highlighted in yellow below) so that the seam remains with the garment. In contrast, the bottom is cut along the garment side of the stitches 24 (highlighted in red below) so that the seam is removed from the garment to provide an opening for the person's body between the layers.



For the "lined section" embodiments, the outline may be cut along the surrounding tube side of the stitches 22, 24 (highlighted in yellow below) so that all seams remain with the garment.

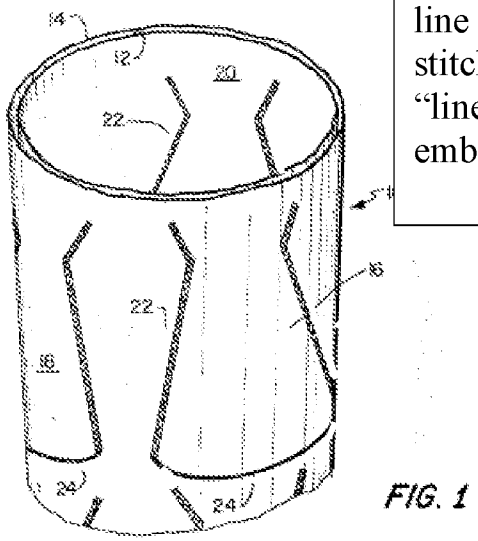


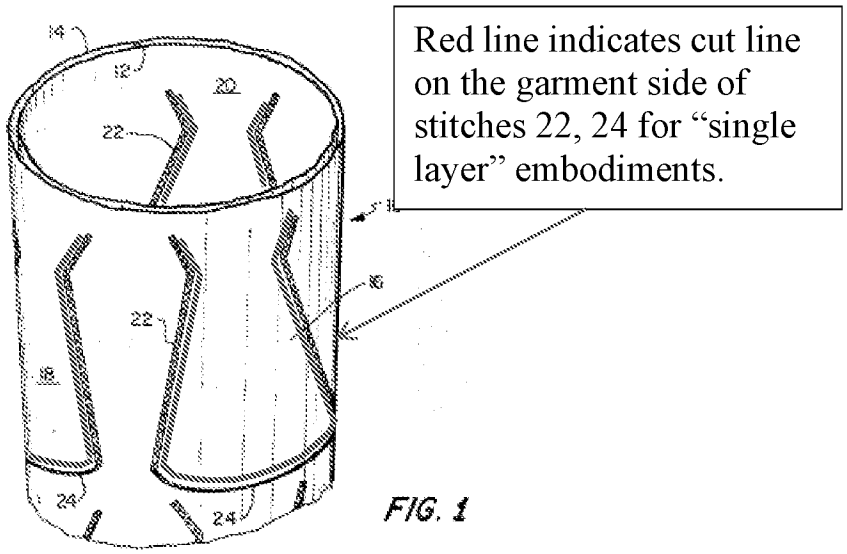
FIG. 1

Yellow line indicates cut line on the tube side of stitches 22, 24 for the "lined section" embodiments.

Even assuming that Reed was limited to the "finished garment" embodiments, when the outlines are modified to form a shoe upper instead of a garment, the outlines are still interknitted together in layered form. Therefore, the design is still fully operable and practices the claims. Indeed, Nishida says that "the material can be woven or knitted in two or more layers." (Ex. 1009, 3:67-68; *see also* Ex. 2004, 168:25-169:4.) As a POSITA would understand, the only way to form a layout knitted in two or more layers is to have at least some stitches that interconnect the two layers — as described by Reed in both the "finished garment" and the "lined section" embodiments.

To produce two single-layer layouts, the POSITA would simply cut along the garment side of stitches 22, 24 (highlighted in red below) so that all seams remain with the surrounding tube material, and the two layouts are no longer

connected to each other after removal from the tubes 12, 14. (Ex. 1006, 3:9-15, 5:67-6:3; Ex. 1003, ¶103, 112.) The two separated layouts are then processed and seamed along the edges, as described in both Reed and Nishida. (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117; Ex, 1009, 6:47-54; Ex. 1003, ¶124.)



5. Reed Does Not Teach Away From The Combination With Nishida.

Owner alleges that Reed "criticiz[es] prior art methods of manufacturing garments" because "they required the manufacturer to cut panels of a garment from larger textile and then seam the panels together to complete the garment." Response, p. 43.

Owner's reliance on *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) is misplaced. In *DePuy*, the Court recognized that "[a] reference does not teach away, however, if it merely expresses

a general preference for an alternative invention but does not 'criticize, discredit, or otherwise discourage' investigation into the invention claimed." *Id.* (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)).

Reed has not criticized, discredited, or discouraged the use of conventional clothing manufacturing. Rather, it has praised the advantages of computerized knitting. (Ex. 1006, 1:45-48.) Furthermore, Reed's "lined section" embodiments are assembled in exactly the same way that Owner claims Reed "teaches away" from doing. (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117.) "The absence of the further advantage that [the prior art] associates with [an optimal embodiment] is not a 'disadvantage' [of an alternative embodiment]," "and therefore [the prior art] cannot be regarded as teaching away from the [alternative embodiment]." *In re Inland Steel Co.*, 265 F.3d 1354, 1361 (Fed. Cir. 2001).

In view of Reed's unequivocal disclosure regarding the "lined section" embodiments, Reed does not teach away from embodiments where outlines are cut out of a web of material and seamed together to form a finished garment, which Owner notes is precisely the type of assembly required by Nishida. Response, pp. 43-44.

E. There Are No Differences Between the Claimed Subject Matter And The Reed/Nishida Combination.

1. Reed Discloses The "To Impart" Element.

The claim language at issue describes "a second stitch configuration that is different from the first stitch configuration to ***impart*** varying textures…." "Impart" means to give, convey, or grant from. (Ex. 1014.) That is consistent with the repeated use of "impart" in the specification. The '598 patent indeed discloses that "similar stitches are utilized throughout textile element 40 to impart a common texture" (Ex. 1001, 8:62-64), while "vary[ing] the stitches within textile element 40 [will] produce various . . . textures." *Id.*, 9:1-4. Thus, under the broadest reasonable construction ("BRI") standard, the claim language and specification make plain that the very presence of the different stitch configurations gives or bestows the varying textures.

Owner nonetheless urges that Reed does not expressly associate different stitch configurations with different textures. But Owner's argument is irrelevant under the BRI standard.

In any event, skilled artisans would plainly achieve the claimed subject matter given Reed's description of interknitted and non-interknitted stitches. (Ex. 1006, 3:61-4:9; 4:61-64; 5:63-6:3; FIGS. 2A, 3A-3E; Ex. 1003, ¶115-117.) "[A] prior art reference must be 'considered together with the knowledge of one of

ordinary skill in the pertinent art.'" *In re Paulsen*, 30 F.3d 1475, 1480–81 (Fed. Cir. 1994) (quoting *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)). The very presence of the different stitches in Reed "imparts" varying textures, a point that skilled artisans would understand. (Ex. 2004; 177:1-184:12.)

2. Nishida Also Discloses The "To Impart" Element.

Owner's treatment of Nishida is woefully inaccurate. First, Owner ignores Nishida's disclosure that explains the use of computerized knitting machines to select a particular knitted type for individual areas or contours within a particular layout. Response, pp. 48-49. Specifically, Nishida states that "[w]ith the use of program-controlled web of material production devices, after a one-time creation of the program, the size of the layout corresponding to the shoe size, the woven or *knitted type of individual areas or contours*, the type of fiber or yarn and/or the color *can be selected almost at will*." (Ex. 1009, 2:40-45 (emphasis added); Ex. 1003, ¶118.) This section alone discloses the features of claims 4 and 11.

Second, Owner claims that Nishida's description of a heel counter 28 applied to areas 26, 27 somehow negates Nishida's statement that "*areas 26 and 27 are produced in a configuration*, color or style *that is different from the other areas*." (Ex. 1009, 4:6-9 (emphasis added); Ex. 1003, ¶118.) Regardless of whether a heel counter 28 is applied, Nishida clearly describes *producing* these areas 26, 27 using a *configuration* different from the other areas. Nishida's

language is practically verbatim of the language of claims 4 and 11.

Third, Owner summarily states that *three different passages* from Nishida "only disclose varying materials, fibers, or yarns." Response, p. 49. Yet, in each passage, Nishida discusses the use of different types of stitch configurations to vary textures and properties in different areas of the layout. (Ex. 1009, 3:43-52; 5:63-6:2; 6:1-31 (emphasis added); Ex. 1003, ¶120-121.) As just one example, Nishida states:

"Since, generally, toe area 14 is designed to be relatively deformably *soft or elastic,* and optionally, also permeable to air, the web of material 1, in toe area 14, according to the present invention, *is* correspondingly designed by suitable selection of . . . *knit pattern* . . . . The type of production can, additionally, insure that the toe area 14 has a good air exchange capability. For example, this can be achieved by a *net-like* woven or *knitted structure*." (Ex. 1009, 3:43-52 (emphasis added); Ex. 1003, ¶120.)

In sum, there is no basis to conclude that Nishida "only discloses varying materials, fibers, or yarns," as Owner asserts.

3. Nishida Discloses Forming Apertures During The Knitting Process.

Even Owner does not assert that "forming apertures in the textile element" is limited to forming by omitting stitches. Nor can it do so because the specification

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is clear that an aperture may be formed in the textile element 40 "[u]pon the joining of edges 42a and 42b to form seam 52" to form ankle opening 36. (Ex. 1001, at 6:23-25.) Likewise, it is clear that the apertures aim to help "air permeability" by extending through the textile and only "may" be formed by omitting stitches. (*Id.* at 9:46-53.)

In Nishida, the u-shaped area in layout 2 forms an ankle opening. (Ex. 1009, FIGS. 1-5.) This is a direct corollary to the apertures forming the openings for the ankle in the '598 patent. Likewise, as with the '598 patent's description of air permeability, Nishida expressly discloses that its invention "can, additionally, insure that the toe area 14 has a good air exchange capability. For example, this can be achieved by a *net-like woven or knitted structure*." (Ex. 1009, 3:49-52 (emphasis added).) A net plainly has apertures and allows passage of air — exactly as described in the '598 patent.

Owner nevertheless asserts that "Nishida's 'net-like' structure describes the textile itself, not the formation of apertures during the production process of the layout." Response, p. 52. This argument is non-sensical. If Nishida describes the textile itself (as Owner concedes) it must *also* describe that the textile of the toe area is formed as part of the knitting process because the toe area is formed as part of the knitted layout.

As to Owner's alternative arguments on whether Nishida's lace holes are

also formed as part of the knitting process, Owner incorrectly asserts that Nishida's lace holes are formed by puncturing. Response, pp. 53-55. The paragraph relied on by Owner as providing the "puncturing" description never mentions anything about puncturing or piercing holes into the layout to form the lace holes. (Ex. 1009, 4:31-38.) Owner's reliance on what is portrayed in Figure 2 also fails because lace holes are not identified with any reference numbers. Therefore, it is inconclusive as to whether the lace holes are not shown in Figure 2 because they are not physically present in the layout (as Owner asserts) or because they were simply not depicted in the drawing. In any event, Mr. Holden's unrebutted and credible testimony is that, "if the additional lacing strips and embroidery are not added, the textile element still includes the net-like structure in the lacing area." (Ex. 1003, ¶130.)

II. OBVIOUSNESS ARGUMENTS ARE NOT TAINTED BY HINDSIGHT.

Owner's assertion that the obviousness analysis is tainted by hindsight is flawed.

First, both Reed and Nishida *affirmatively and expressly describe* using different stitch configurations to impart varying textures across a textile element surface, as discussed above.

Second, Reed and Nishida *are more broadly directed* to solving the problem

of inefficiencies, costs, and design variability associated with producing textile elements using conventional methods, as discussed above.

In sum, Owner's reasons for asserting an improper hindsight basis do not survive scrutiny.

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389

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CERTIFICATION UNDER 37 CFR §42.24(c)(1)

Under the provisions of 37 CFR §42.24(c)(1), the undersigned hereby certifies that the word count for the foregoing Petitioner's Reply totals 5,385, which is less than the 5,600 allowed under 37 CFR §42.24(c)(1).

Dated: April 21, 2017

By: /s/ Mitchell G. Stockwell
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Registration No. 39,389
Lead Counsel for Petitioner

Lead Counsel	Back-Up Counsel
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE** and **EXHIBITS 1013-1014** have been served on April 21, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

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Dated: April 21, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case: IPR2016-00921
Patent 7,814,598

PETITIONER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. §42.8, Petitioner, adidas AG, hereby submits the following Updated Mandatory Notices information:

II. MANDATORY NOTICES

A. Real Party in Interest under 37 C.F.R. § 42.8(b)(1)

There is no change to the identity of real party in interest provided in the Petition. In that filing, Petitioner identified the real party in interest as follows:

Petitioner, adidas AG, the ultimate parent of adidas International B.V., adidas North America, Inc., adidas America, Inc., and adidas International, Inc., is the real party-in-interest for the instant petition.

B. Related Matters under 37 C.F.R. § 42.8(b)(2)

In accordance with 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related proceedings that may affect, or be affected by, a decision in the proceeding:

Petition for *inter partes* review of claims 1-38 of U.S. Patent No. 8,042,288 (IPR2016-00920), filed simultaneously with the instant petition, and for which the Board denied institution. U.S. Patent No. 8,042,288 is a continuation application of the '598 patent.

Petition for *inter partes* review of claims 1-9, 11-19, and 21 of U.S. Patent No. 8,266,749 (IPR2017-00922), filed simultaneously with the instant petition. U.S. Patent No. 8,266,749 is a continuation of U.S. Patent No. 8,042,288. The

Board instituted *inter partes* review of claims 1-9, 11-19, and 21 of U.S. Patent No. 8,266,749.

Petition for *inter partes* review of claims 8 and 14-20 of U.S. Patent No. 8,042,288 (IPR2017-00263).

Petition for *inter partes* review of claims 1-7, 9-13, and 21-38 of U.S. Patent No. 8,042,288 (IPR2017-00264).

There is no change to the identity of the other related matters provided in the Petition. In that filing, Petitioner identified the related matters as follows:

The '598 patent is a divisional application of U.S. Patent No. 7,347,011 ("the '011 patent"). The Board instituted *inter partes* review of claims 1-46 of the '011 patent (IPR2013-00067), and Nike requested cancellation of claims 1-46 and proposed substitute claims 47-50. The Board granted the motion to cancel, but denied the motion as to the substitute claims. Nike appealed the Board's decision to the Federal Circuit (Case No. 2014-1719). The Federal Circuit issued a decision on February 11, 2016, which affirmed-in-part, vacated-in-part, and remanded the case to the Board for further proceedings on secondary consideration and patentability of dependent claim 49.

D. Designation of Lead Counsel and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)

There is no change to the designation of lead and backup counsel provided in the Petition. In that filing, Petitioner designated lead counsel and substitute back-up counsel as follows:

Lead Counsel	Back-Up Counsel
Mitchell G. Stockwell Reg. No. 39,389 mstockwell@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 815 6214	Vaibhav P. Kadaba Reg. No. 45,865 wkadaba@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 532 6959 Tiffany L. Williams Reg. No. 59,549 tiwilliams@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 815 6608

Petitioner continues to respectfully request that service be provided at the email addresses listed above.

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8** has been served on April 21, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

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Dated: April 21, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

6/97 = 4H 92116L → 6/98 = 4H 92116

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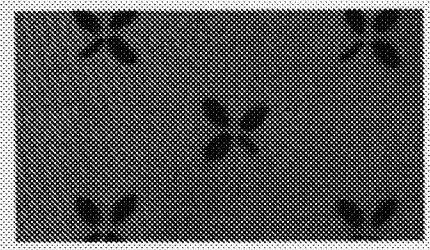
Analyzing the Color, Design, and Texture of Fabric

What attracts you to an item of clothing or fabric? The *color, design, visual texture,* and *hand* (or reaction to the touch of fabrics) are most likely to appeal to you and induce you to buy. These aesthetic or artistic values also influence how you feel about your clothing and yourself. While aesthetic values are personal, learning to analyze fabrics for their color, design, and texture will help you select clothing or coordinate patterns and fabrics. Aesthetic awareness and sensitivity can be developed or improved by analyzing fabrics for their aesthetic qualities.

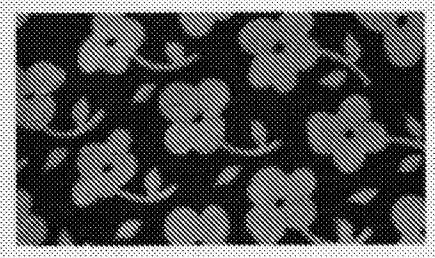
Color

Begin by looking at a fabric and thinking about the color qualities which attract you to it. Color has an emotional effect on people. We associate color with moods, including "feeling blue" or being "in the pink." Numerous studies identify the effects of color on people's reactions. Personal reactions to color are a result of social and cultural background, economic levels, and environmental influences. Color can attract, repel, advance, recede, stimulate, or quiet. Color affects one's feelings about personal appearance and well-being and also affects other persons' impressions and acceptance of us.

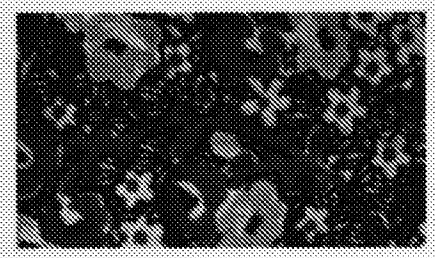
Learning to analyze color will help you select clothing and fabric that works the way you want. There are many ways of describing color in clothing and fabric. Try to determine the predominant color of a fabric. This is easy if the fabric is a solid color, but more difficult when several colors are used in a pattern or design. Even after you identify the color or colors of a fabric those colors may change. The source of light can affect the appearance of a color. Natural light varies during the day, and artificial lights come in different color tones. If possible, look at a fabric under the type of light where it will be used.



Dominant color in background



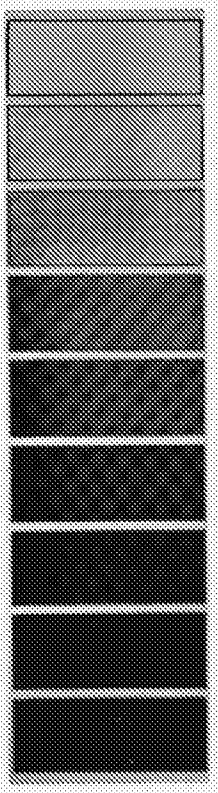
Pattern, background nearly equal



Pattern mixture of several colors

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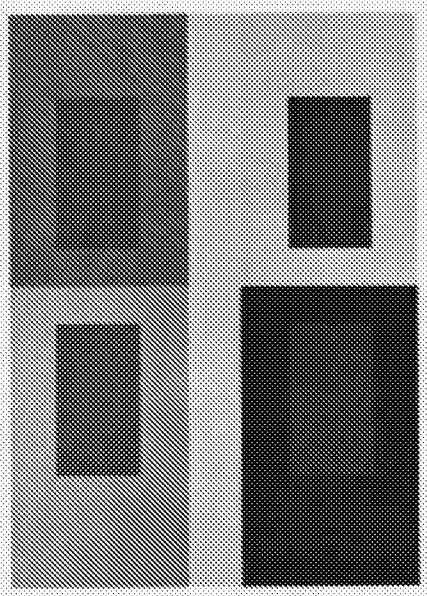


Light to dark gray scale

Colors relate to and interact with each other. The background or an adjacent area can make a color appear darker or lighter, brighter or grayer. The distance you are from a fabric can influence the color you see. Fabrics with small all-over designs, tiny stripes or checks, or tweeds may appear very different close up compared to a distance. Select linings, notions, and accessories for these fabrics by looking at the color harmony both close up and at a distance.

After determining the predominant color and any additional colors in a fabric, try to describe each color in basic terms such as red, red-orange, orange, yellow-orange, yellow, yellow-green, green, blue-green, blue, blue-violet, violet, or red-violet. These colors or hues are found in the rainbow or on a color wheel and are the basis for various color systems. True colors from a color wheel lack the red-blue or orange-yellow undertones that make fashion colors wearable and flattering to personal coloring.

Next consider whether the basic color has been changed by making it lighter or darker from the basic color. Then consider whether the color has been changed by making it brighter or grayer and duller. Fashion names such as raspberry, lime, or toast are used to sell certain colors. These names are effective only if you associate the color with the term being used. For more accurate descriptions of a color, use terms such as grayed, light yellow-orange in place of a fashion name such as honey.



Color influenced by surrounding color

While rules for using color are outdated, there are known visual illusions created by color you may wish to consider. In general, warm colors such as red, orange, and yellow are considered advancing, stimulating, and exciting. They make objects or shapes appear larger or more important. Cool colors such as blue, green, and violet are considered receding, quieting, and reserved. These colors make shapes and areas appear smaller and less important.

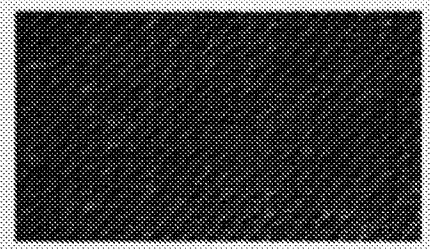
When any color is darkened or grayed, however, the area appears smaller and less well defined than when the color is lightened or brightened. If a color is a favorite, but not flattering to you, try wearing it in a small amount, such as an accessory, or wearing a variation of it. To decide whether a color is flattering to you, hold the garment or fabric in front of yourself as you look at a full length mirror. Consider how flattering the color is with your skin, hair, eyes, and figure.

It may not be easy to determine your personal coloring because you do not fit easily into a category. The following information may help determine your coloring.

- If your skin has undertones of rose-pink or brown with a reddish hue and your hair has blue undertones (such as platinum or ash blond, auburn red, and jet black or snow-white), your personal coloring is considered cool. Cool colors or colors with red or blue undertones will be easiest to wear.
- If your skin has undertones of peachy-pink or yellow to golden and your hair has golden undertones (such as honey or strawberry blond, rust red, brown or brownish black, or creamy white), your personal coloring is considered warm. Warm colors or colors with orange or yellow undertones will be the easiest to wear.

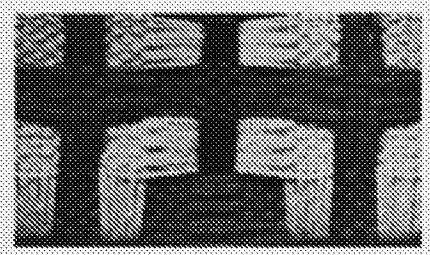
Look for the undertones that are flattering to your coloring and avoid those which drain color from your skin or make it appear too ruddy or sallow.

Now analyze the color of fabric from a textile design viewpoint. Color effects may be the result of applying color to the fiber, to the yarn, or to the fabric. Frequently it is not possible for the consumer to determine how the color is added, however, colorfastness is affected by the application during manufacture.

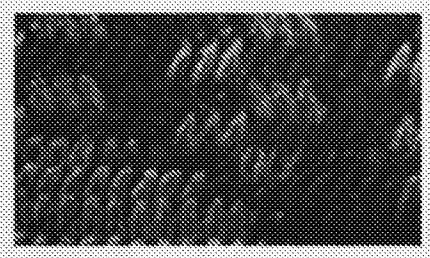


Heather dyed yarn in knit fabric

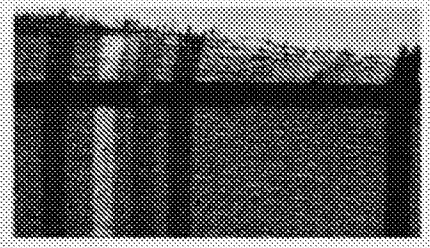
Usually color that is applied to the fiber or the yarn is considered to be the most durable and long lasting. However, with modern dyes and pigments fabric that is dyed or printed usually performs satisfactorily if used for the purpose it was manufactured. Examples of design that result from applying color to the fiber or yarn include most solid color fabircs, heathers, (vari-colored effects with a blend of light to dark shades), and woven-in or knit-in patterns. Prints are applied to the fabric after it is woven or knit and are distinguished by the color strength and sharpness on the right side of the fabric.



Woven-in pattern

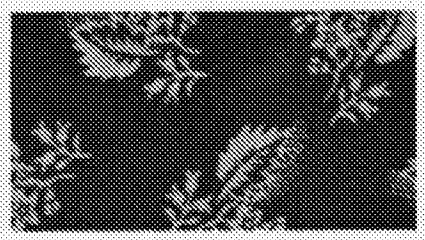


Knit-in pattern

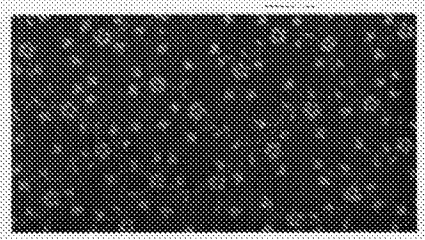


Geometric print does not follow crosswise yarn direction

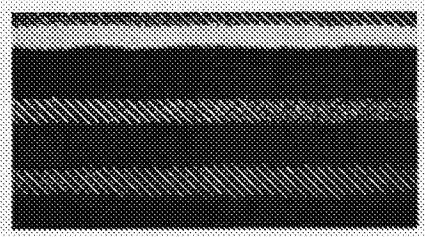
In checking the quality of fabric color at the time of purchase, look to see that the color is even. There should be no streaks or spots to indicate uneven dyeing. Check that the creaseline, fold, or shoulder area over a hanger is the same color as the rest of the fabric. A lighter color in this area indicates a poor quality dye that will rub off or fade easily. Geometric or symetrical prints should follow the lengthwise or crosswise yarn direction. If the print is not placed on the fabric correctly, it cannot be matched or lined up when constructed without distorting the fabric and the hang of the garment. In garments, long seams should hang straight in addition to having the design or print match.



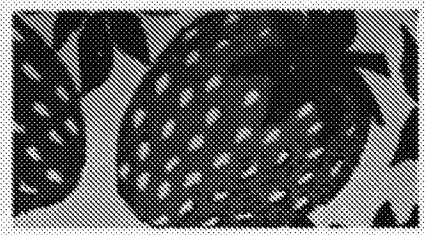
Larger motif



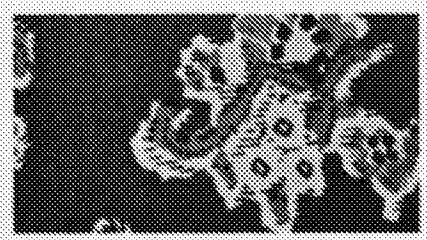
Smaller motif



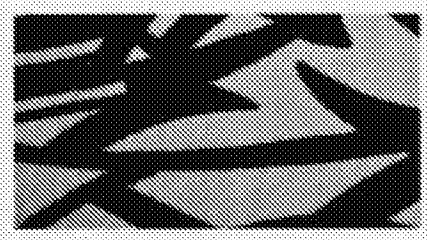
Printed geometric motif



Realistic motif



Stylized motif



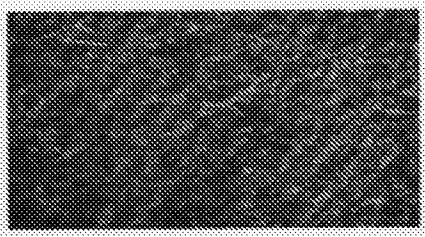
Abstract motif

Design

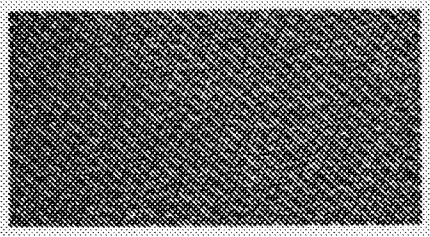
A textile design should look as effective when seamed, darted, gathered, and draped around the body as it does when viewed as a flat piece of fabric. The more contrast in the design and the larger and bolder the motifs, the more difficult it is to use the fabric to advantage. Softer outlines and smaller motifs are less frustrating to sew and are more effectively used in relation to the body.

The motifs or units of a textile design may be classified as *geometric, realistic, stylized,* and *abstract*. Geometric motifs such as stripes and plaids may be created during the weaving or knitting fabric construction process. If motifs are applied as prints after the fabric is constructed, be sure they are straight with the yarns of the fabric or the finished garment will be unsatisfactory. Geometric designs lead the eye. This may not be to your advantage if you are trying to conceal a figure irregularity. A high shoulder or an uneven waistline will be more obvious if the geometric design is not the same across the garment. A distinctively geometric design may dictate the garment styling and limit the possibilities for using the fabric. Geometric designs may require additional fabric in order to match the motifs during the layout and construction.

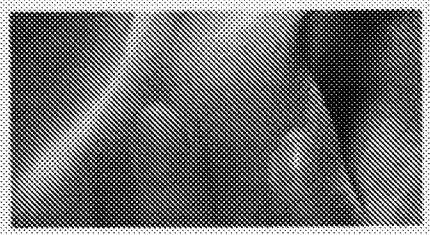
Realistic motifs are imitations or repeats of natural or man-made objects. Stylized motifs are simplified variations of natural or man-made objects that are no longer recognizable. Abstract motifs are combinations of color, size, and shape without relationship to natural or man-made objects. Realistic, stylized, and abstract motifs may be easier or more difficult to use depending on the size of the motif, the contrast between the motif and the background, and whether or not the design is multiple-direction or one-way. Smaller size motifs, softened shadings, and multiple-direction designs are easier to sew and wear.



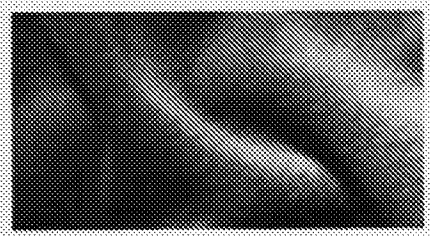
Warm texture, heavy weight



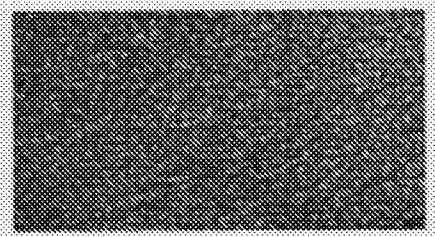
Crisp texture, medium weight



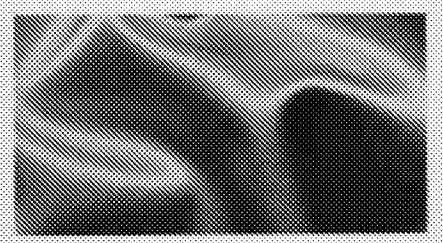
Transparent texture, sheer weight



Fuzzy thick texture, heavy weight



Rough texture, medium weight



Shiny texture, medium weight

Texture: visual and hand

Another aspect of textile design is texture, which includes the visual surface appearance and the feel of fabrics. The sensation from touching, holding, or squeezing fabrics is referred to as "hand." Terms that describe texture overlap between the visual surface appearance and the hand include: clingy-rigid, cold-warm, crisp-limp, dry-moist, firm-flexible, heavy-light, opaque-transparent, pliable-stiff, rough-smooth, shiny-dull, stretchy-stable, and thick-thin.

The texture of a fabric is also determined by the fiber, yarn, structure (weave, knit, etc.), and finish. Fibers are the smallest components of a fabric, but their characteristics strongly influence texture. For example, wool usually gives soft textures while linen gives crisp textures. Short lengths of staple fiber or long continuous filament fibers are twisted to form yarns. The type of fiber, the method of joining the fibers into yarn, and the amount of yarn twist can be varied to produce different textures of yarn.

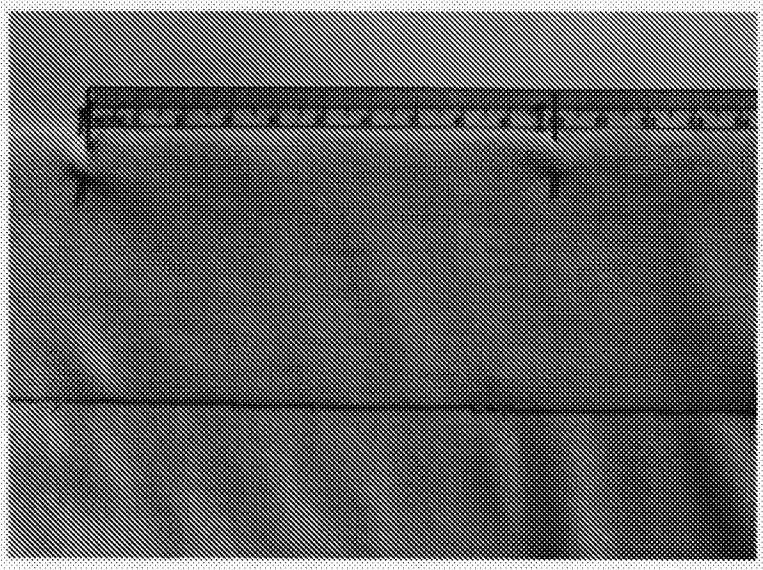
Fabric structure may be woven (one set of yarns inserted at right angles to another set that is held taut), knit (a series of interlocking loop stitches), non-woven (a web of man-made fibers held together by a resin, heat and pressure, or needle punching), or other construction such as felt or lace. The way the yarns are combined into the fabric structure determines aspects of texture such as the weight, flexibility, firmness or compressibility, and stability or stretchiness characteristics of the fabric. The looseness or tightness of yarn twist, the size of the yarn, and the closeness or openness of the fabric structure influence the durability of different textures. The most durable fabrics are generally those with tightly twisted smooth yarns combined to make a closely woven or knit fabric (such as woven gingham, gabardine, and smooth double knits). Clothing that will receive frequent wear is usually constructed from durable textures while special occasion clothing provides variety in less durable textures.

The fabric's weight and the flexibility or stiffness determine the silhouette and the shaping of the fabric to the body. Many patterns suggest the type of fabric suitable for that pattern. Over-the-counter fabric stores may label fabrics according to the type of garment suggested, but many times you must make the decision about the suitability for a garment or item.

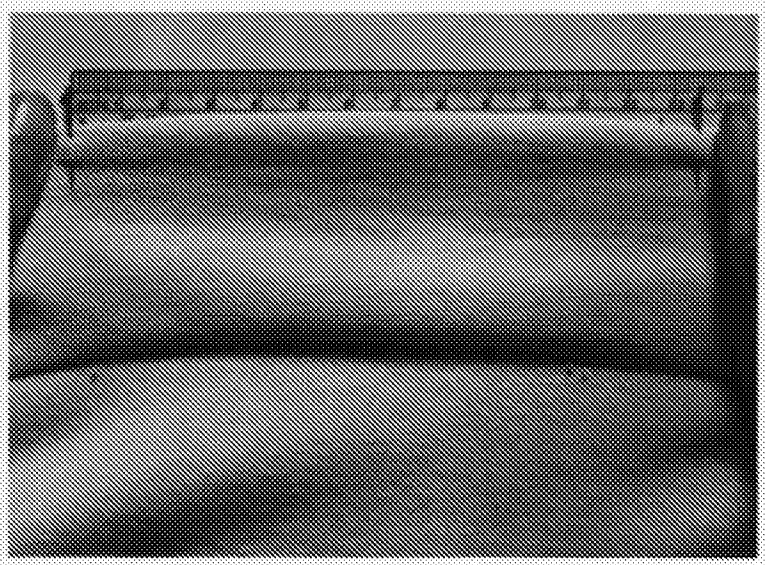
Another texture factor in suitability of a fabric for a specific use is the stability or stretchiness. Many knits have some stretchiness, but not all knits have equal amounts. Woven fabrics with stretch are also being developed; do not assume that because a fabric is a knit, it is stretchy, or if it is a woven fabric that it is stable.

Use pins and a ruler or the stretch gauge on the pattern envelope to determine the stretchability if the pattern calls for a stretchy fabric. Fold the fabric on the crosswise yarn direction or cross grain several inches from the cut or torn edge. Using pins or your thumbnails mark a 4 inch (10 cm) section. Gently but firmly stretch the fabric. If the fabric does not stretch or stretches less than 4 1/2 inches (11.5 cm) it is considered a stable fabric.

If the amount of stretch is at least 5 1/4 inches (13.5 cm), it is considered to be a moderate stretch fabric.

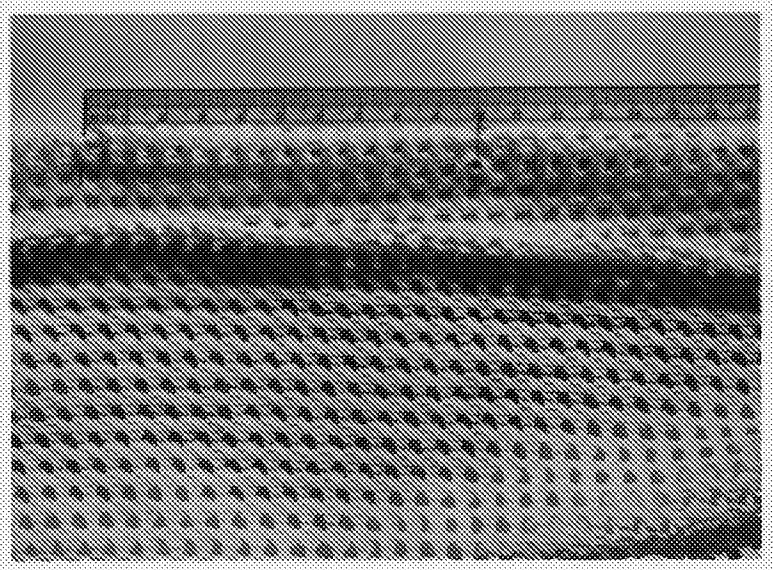


Single knit, measured relaxed

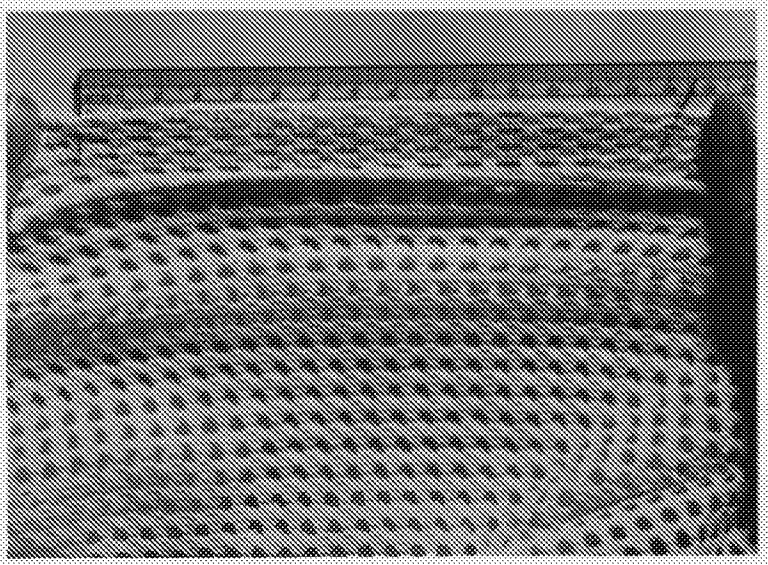


Single knit, stretched to determine "moderate stretch"

If it stretches to over 6 inches (15.3 cm), it is a stretchy fabric. Some patterns are designed to be used with moderate stretch or stretchy fabrics only.



Novelty mesh knit, measured relaxed



Novelty mesh knit, stretched to determine "stretchy"

After analyzing the fabric by itself for color, design, visual texture, and hand, analyze it in relation to the intended use. If you are going to use the fabric for a garment, ask yourself these questions: What type of garment is it, what kind of silhouette does it have, where are seams located, and what kind of construction details will use the fabric to advantage?

Consider also interfacing fabrics for support, shaping, and sharpness to edges, and lining fabrics to give finish and smoothness to the inside of the garment. While these fabrics do not have aesthetic values, they contribute to the beauty of fashion fabrics when both are well coordinated with garment designs.

Ardis W. Koester
Extension textiles and clothing specialist
Oregon State University

Selected References:

Brockman, Helen. *The Theory of Fashion Design*. John Wiley & Sons, Inc., 1965.

Erwin, Mabel D. & Lila A. Kinchen. *Clothing for Moderns*. 5th edition. Macmillan Publishing Co., Inc., 1974.

Kefgen, Mary & Phyllis Touchie-Specht. *Individuality in Clothing Selection and Personal Appearance*. 2nd edition. Macmillan Publishing Co., Inc., 1976.

McJimsey, Harriet T. *Art and Fashion in Clothing Selection*. 2nd edition. Iowa State University Press, 1975.

Reader's Digest. *Complete Guide to Sewing*. The Reader's Digest Association, Inc., 1976.

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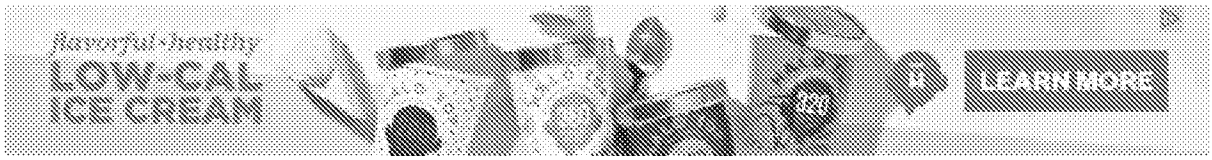
- GAMES
- BROWSE THESAURUS
- WORD OF THE DAY
- VIDEO
- MORE
  WORD OF THE DAY VIDEO WORDS AT PLAYFAVORITES
- WORDS AT PLAY
- FAVORITES

impart
×
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An Encyclopædia Britannica Company

- GAMES
- THESAURUS
- WORD OF THE DAY
- VIDEO
- WORDS AT PLAY
- FAVORITES

Follow:



impart

play
verb im·part \im-'pärt\
Popularity: Top 30% of words
Examples: *impart* in a sentence

- `
- `
- `

Writing? Check your grammar now!

Definition of *impart*

1. transitive verb

2. *1* : to give, convey, or grant from or as if from a store *her experience imparted authority to her words the flavor imparted by herbs*

3. *2* : to communicate the knowledge of : disclose *imparted my scheme to no one*

impartation

play \ˌim-ˌpär-ˈtā-shən\ *noun*

impartment

play \im-ˈpärt-mənt\ *noun*

See *impart* defined for English-language learners

See *impart* defined for kids

Examples of *impart* in a sentence

1. *Her presence imparted a sense of importance to the meeting.*

2. *The oil imparts a distinctive flavor to the sauce.*

3. *The chemicals imparted a bluish color to the paper.*

Origin and Etymology of *impart*

Middle English, from Anglo-French & Latin; Anglo-French *empartir*, from Latin *impartire*, from *in-* + *partire* to divide, part

First Known Use: 15th century

Petitioner adidas AG - Exhibit 1014 - Page 2 of 11
Skechers EX1013-p. 396
Skechers v Nike

impart Synonyms

Synonyms

conduct, convey, give, communicate, spread, transfer, transfuse, transmit

Related Words

deliver, hand over, surrender, turn over; broadcast, diffuse, disseminate, propagate; hand down, hand on; contaminate, infect, poison

Near Antonyms

catch, come down (with), contract

IMPART Defined for English Language Learners

impart

play
verb im·part \im-'pärt\

Definition of *impart for English Language Learners*

- : to give (something, such as a quality) to a thing
- : to make (something) known to someone

IMPART Defined for Kids

impart

play
verb im·part \im-'pärt\

Definition of *impart* for Students

imparted

;

imparting

1. *1* : to give or grant from or as if from a supply *The sun imparts warmth.*
2. *2* : to make known *She imparted the news.*

Learn More about *impart*

1. See words that rhyme with *impart*Thesaurus: All synonyms and antonyms for *impart*Spanish Central: Translation of *impart*Nglish: Translation of *impart* for Spanish speakersBritannica English: Translation of *impart* for Arabic speakers

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What made you want to look up *impart*? Please tell us where you read or heard it (including the quote, if possible).

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WORD OF THE DAY

widdershins

play

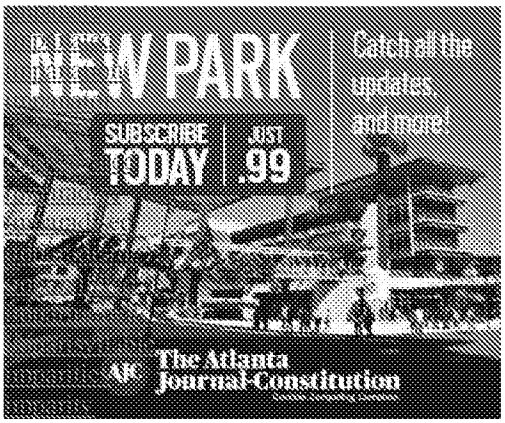
in a contrary direction

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Petitioner adidas AG - Exhibit 1014 - Page 4 of 11

Skechers EX1013-p. 398
Skechers v Nike



impark
TRENDING NOW
imparlance
impart volunteer 'Someone who does something without being forced to do it'
impartation

2. operationalize Bannon was removed from the National Security Council
3. filibuster 'An effort to prevent action in a legislature'
4. witch hunt Lookups spiked after the president used the phrase in a tweet
5. immunity 'Exemption from a charge, duty, obligation, office, tax, imposition, penalty, or service'

SEE ALL

BROWSE DICTIONARY

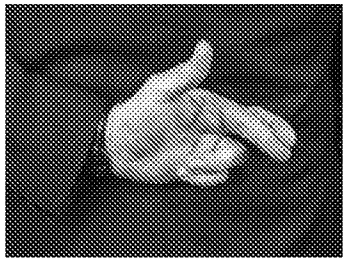
Previous

Next



WORD GAMES

Take a 3-minute break and test your skills!



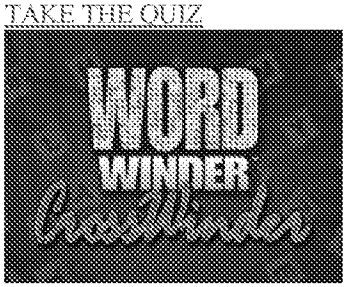
- Someone who pretends to be sick in order to avoid work is a:

- Duke-of-the-nether-willies malingerer
- fabricationist port-hound



Test your visual vocabulary with our 10-question challenge!

TAKE THE QUIZ

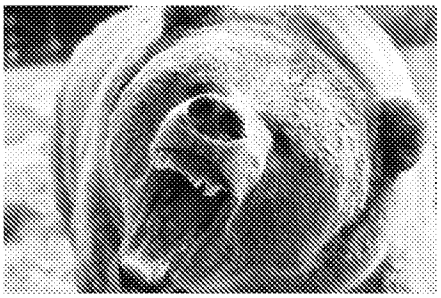


Test Your Knowledge - and learn some interesting things along the way.

TAKE THE QUIZ

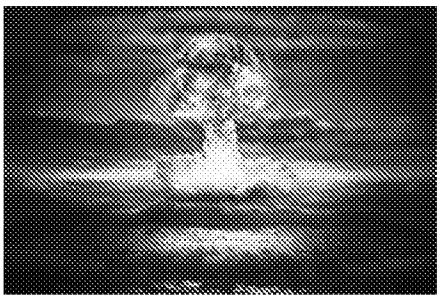
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Skechers v Nike

Words at Play



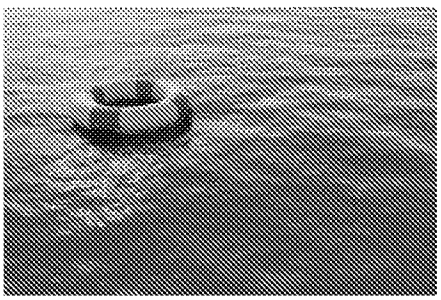
Should 'Aggravate' Only Be Used to Mean 'to Make Worse'?

A vexing usage controversy



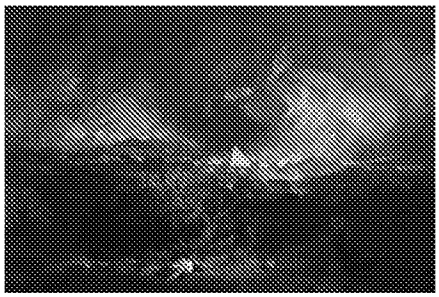
The Nuclear Option

Figurative use of the term 'nuclear option' is relatively new



7 False Etymologies

No, that's not where that word comes from



When to Use 'Smote' and When to Use 'Smitten'

It depends on who's doing the smiting

Ask the Editors

serial-comma

The Serial Comma

Why don't they call it the Merriam-Webster comma?

woman_shrug_shoulder

Is it 'I Could Care Less' or 'I Couldn't Care Less'?

Because we care

video-irregardless-grammar-peeve-blend-of-the-synonyms-irrespective-and-regardless

Irregardless

It is in fact a real word (but that doesn't mean you should use it).

video-moose-goose-weird-plurals

Weird Plurals

One goose, two geese. One moose, two... moose. What's up with that?

Word Games

alt-5761dbe2ba986

Liar, Liar Quiz

Test your knowledge of words for lies, liars, and those being lied to. In other words, everyone.

Petitioner adidas AG - Exhibit 1014 - Page 8 of 11
Skechers EX1013-p. 402
Skechers v Nike

Take the quiz

manet-jeanne-spring

March Words of the Day Quiz

Did you want a word of the day quiz? You got it.

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Name That Thing

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7 Good Stories That Just Aren't True

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Liar, Liar Quiz

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serial-comma

The Serial Comma

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00921
Patent No. 7,814,598

PATENT OWNER'S OBJECTIONS TO ADMISSIBILITY OF EVIDENCE SERVED WITH PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

Pursuant to 37 C.F.R. § 42.64(b), Patent Owner NIKE, Inc. objects as follows to the admissibility of evidence served with Petitioner's Reply to Patent Owner's Response.

Evidence	Objections
Exhibit 1013	**Lack of Foundation**: Petitioner has not provided sufficient explanation of what the exhibit is or what it allegedly shows. **FRE 402**: The exhibit is not relevant to any ground upon which trial was instituted.

	FRE 403: The exhibit's probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence. **FRE 801/802**: The exhibit is inadmissible hearsay if offered to prove the truth of any matter allegedly asserted therein. **FRE 901**: Petitioner has not authenticated the exhibit by producing evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.
Exhibit 1014	**Lack of Foundation**: Petitioner has not provided sufficient explanation of what the exhibit is or what it allegedly shows. **FRE 402**: The exhibit is not relevant to any ground upon which trial was instituted. **FRE 403**: The exhibit's probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence. **FRE 801/802**: The exhibit is inadmissible hearsay if offered to prove the truth of any matter allegedly asserted therein. **FRE 901**: Petitioner has not authenticated the exhibit by

Skechers EX1013-p. 407
Skechers v Nike

	producing evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.

Date: April 28, 2017

Respectfully submitted,

/Christopher J. Renk/

Christopher J. Renk
Michael J. Harris
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Chicago, Illinois 60606

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on April 28, 2017, by email directed to the attorneys of record for Petitioner as follows:

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Banner & Witcoff, Ltd.

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Skechers v Nike

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case: IPR2016-00922
Patent 8,266,749

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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1001	U.S. Patent No. 8,266,749 ("the '749 patent")
1002	File History for U.S. Patent No. 8,266,749 ("'749 file history")
1003	Declaration of Lenny Holden ("Holden Decl.")
1004	C.V. for Lenny Holden
1005	Form PTO-SB/42
1006	U.S. Patent No. 3,985,003 to Reed ("Reed")
1007	U.S. Patent No. 4,038,840 to Castello ("Castello")
1008	U.S. Patent No. 6,330,814 to Fujiwara ("Fujiwara")
1009	U.S. Patent No. 5,345,638 to Nishida ("Nishida")
1010	David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third Ed., Woodhead Publishing Ltd. 2001) ("Spencer")
1011	Paul Burall, "CoID Design Awards," Design, June 1969, pp. 46-47 ("Burall")
1012	ISO 8117:2003(E) Textile machinery - Knitting machines - Nominal diameters of circular machines ("ISO 8117")
1013	Ardis W. Koester, "Analyzing the Color, Design, and Texture of Fabric," Oregon State University Extension Service, May 1993 ("Koester")
1014	Definition of "Impart" from Merriam-Webster

I. INTRODUCTION

Owner's Response is replete with attorney argument, yet provides no evidence for its strained arguments. Owner does not bother challenging the admissibility of Mr. Holden's expert testimony, and his extensive credentials and detailed analysis more than overcome Owner's weak attacks on weight. The evidentiary record alone thus confirms the Board's initial finding of a likely showing of obviousness.

None of Owner's other arguments overcome strong evidence of obviousness. Owner begins by seeking to avoid the full disclosure of Reed and Nishida, but its arguments are legally erroneous and factually flawed, particularly regarding motivation to combine. Reed and Nishida both show skilled artisans were aware of the key problem – manufacturing textile elements with greater speed and efficiency. Reed meets either prong of the analogous art test, and Petitioner's evidence establishes both how and why skilled artisans would combine Reed and Nishida. Owner's claims that such a combination would be inoperable, or that Reed teaches away from Nishida, are unsupported by the record.

The Reed and Nishida combination achieves the claimed subject matter. No hindsight was used to achieve that combination and Owner has not overcome Petitioner's demonstration of obviousness.

II. THE REED AND NISHIDA COMBINATION RENDERS THE CHALLENGED CLAIMS OBVIOUS.

A. The Level Of Ordinary Skill Is Neither Low Nor Requires Hands-On Knitting Machine Experience.

Owner incorrectly equates the "few years of experience in the footwear industry" a POSITA must have with a low skill level. Response, pp. 16-17. But the POSITA must also have acquired knowledge and understanding of shoemaking, product design, upper material designs, and construction techniques. (Ex. 1003, ¶34; Ex. 2004, 129:1-18.) A POSITA with the necessary knowledge and understanding has a skill level far from "low."

Owner's related assertion that Petitioner's description is deficient because it lacks explicit analysis of all factors is legally erroneous. *See In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) ("[i]n a given case, every factor may not be present, and one or more factors may predominate."); MPEP § 2141.

Next, Owner's suggestion that the POSITA should also have operated knitting machines is unsupported. It is also inconsistent with Owner's own expert's testimony in the related review of U.S. Patent No. 7,347,011, where Mr. Tonkel opined that a "POSITA… would have a few years of experience with design and development of footwear and knowledge of textiles used in such footwear." (*See* IPR2013-00067, Ex. 2010, ¶52.) Like Mr. Holden, Mr. Tonkel's own knitting machine experience is limited to the machines he saw during factory

visits. (*See* IPR2013-00067, Ex. 1015, 38:18-23.)

In any event, Mr. Holden's unrebutted and credible testimony is that a POSITA would never be expected to operate a knitting machine, and such experience is unnecessary to gain an understanding of knitted materials and the overall capabilities of industrial knitting machines. (Ex. 2004, 71:22-76:7.)

B. Petitioner's Expert Is Credible And Persuasive.

Despite having offered Mr. Tonkel's testimony in the related matter, Owner presented no expert testimony here to substantiate its strained arguments. Nor did Owner challenge the admissibility of Mr. Holden's testimony. Mr. Holden's extensive experience, as well as the details of his analysis, demonstrate substantial weight should be accorded to his testimony.

Owner states that Mr. Holden "admitted during cross-examination that Petitioner's counsel wrote the declaration for him." Response, p. 19. Mr. Holden *actually* stated that "I worked with counsel one on one to basically give her a verbal description of my opinions and -- and my thoughts on the -- on these issues, and she did the actual typing of the document." (Ex. 2004, 12:7-11; *see also* 12:12-13:16.)

Owner's misrepresentation of the actual testimony is telling. So are the scant seven lines Owner devoted to this issue. The Board's recent decision in *Square, Inc. v. Think Computer Corporation* applies here. There, the Board held

that, when the manner of the expert's testimony is in line with typical testimony before the Board, and the expert's background, analysis, and supporting evidence are credible and persuasive, an inquiry into "the mechanics of declaration preparation is 'a waste of time, both for the witness and the Board.'" *Square, Inc. v. Think Computer Corp.*, No. CBM2014-00159, Paper No. 47 at pp. 26-27, 2015 WL 7695141, at *13 (PTAB Nov. 27, 2015) (quoting *Pevarello v. Lan*, Patent Interference 105, 394 MPT, Paper No. 85, slip op. at 19–21 (BPAI Jan. 12, 2007).) Likewise, in view of Mr. Holden's credible and persuasive background, analysis, and supporting evidence, any further analysis or inquiry into this issue is a waste of time for both the witness and the Board.

Owner next claims that Mr. Holden's testimony should be given no weight simply because he did not concisely define "stitch configuration" or "texture" — terms used in the '749 claims. Response, pp. 19-20. Neither of these terms were submitted for construction, and Mr. Holden was not asked to opine on construction of those terms. Nevertheless, Mr. Holden did explain his understanding of "stitch configuration." (Ex. 2004, 78:22-79:18.)

Likewise, Mr. Holden explained texture generally could be an actual texture or a perceived texture based on the arrangement of colors in a pattern. (Ex. 2004, 178:20-24; *see also* 177:1-178:19; 178:25-184:11.) Owner labels this testimony as being "incredible," but the art confirms otherwise (Ex. 1013, p. 5) and Owner has

provided no factual or evidentiary support of its claim.

Owner also critiqued Mr. Holden's inability to ***concisely*** define certain terms used by Reed. But the terms at play are not part of any disclosure relied upon or in dispute, and Mr. Holden was well within his rights to insist on referring to the treatise identified in his declaration that defined such terms. (Ex. 1003, ¶12.) Ability to memorize definitions is not a requirement for an expert, or any witness.

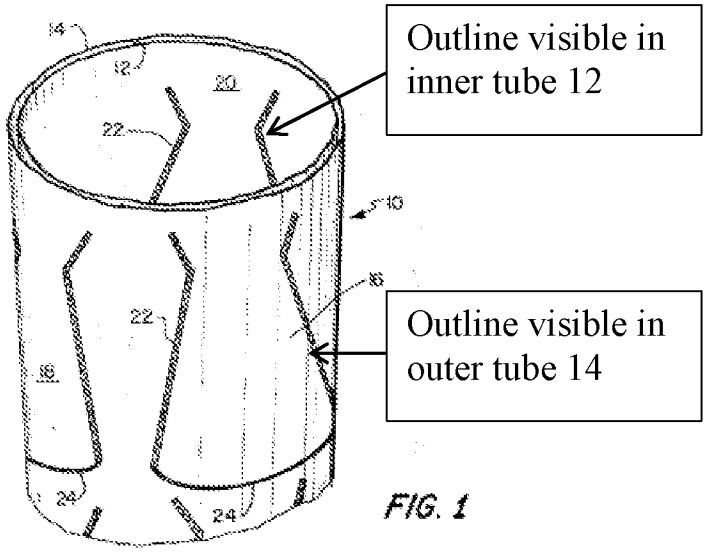
Owner then states that Mr. Holden "testified that he does not understand portions of Nishida's description of the invention disclosed in Nishida." Response, p. 21. This is false. Mr. Holden provided comprehensive answers to several questions regarding Nishida. (*See* Ex. 2004, 162:19-168:2.) Similarly, Owner critiques Mr. Holden for not reviewing a German patent identified in Nishida. But it never articulates why this lapse was so key that it impacts the weight of testimony. Nor can it. It is the full disclosure of Nishida that is legally relevant, not pieces thereof or even a separate German patent referenced therein.

C. Owner's Efforts To Ignore The Full Scope And Content Of Reed And Nishida Are Legally Erroneous And Factually Flawed.

Owner theorizes that Reed is limited to finished garments and Nishida cannot be combined with the finished garment embodiments. Neither proposition is correct.

1. Reed Describes A Method Of Forming Finished Garments and Layered Garment Sections.

Reed describes a circular knitting machine programmed to simultaneously knit an inner tube 12 and an outer tube 14. (Ex. 1006, 1:58-64; FIG. 1; Ex. 1003, ¶98.) The two tubes 12, 14 are interconnected through interconnecting knitted stitches 22, 24. *Id.* As a result, a garment outline is formed in the outer tube 14 and in the juxtaposed inner tube 12.



As Owner noted, Reed describes embodiments where these interconnected outlines can be severed from the tubes 12, 14 to form "finished, or nearly finished, garments." Response, p. 25. In these embodiments, the interconnected outlines form the back and front of a "finished garment," and the wearer's body is inserted between the two interconnected outlines. (Ex. 1006, 1:64-2:1; Ex. 2004, 142:2-17.)

But Reed ***also*** describes embodiments in which these interconnected outlines

can be used to "form sections of a garment to be assembled in the regular manner." (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117; Ex. 2004, 141:13-20; 143:15-21.) In other words, the inner tube 12 outline becomes a lining attached to the outer tube 14 outline to form a lined section of a garment. *Id.* The lined section is then attached to another lined section by conventional seaming methods. *Id.* One lined section forms the garment back, and the other lined section forms the garment front. *Id.* Thus, Reed clearly describes "lined section" embodiments that are ***not*** limited to "finished garments."

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck,* 699 F.2d 1331, 1332-33 (Fed. Cir. 1983)). Owner's reliance on *Pacing Techs., LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015) and *Regents of Univ. of Minn. v. AGA Med. Corp.*, 717 F.3d 929, 936 (Fed. Cir. 2013) in an effort to avoid this controlling law is legally flawed. These cases hold that claim scope disavowal is assessed for purposes of claim construction, not for assessing the "full scope and content of the prior art," as Owner alleges. Response, p. 24.

Finally, the distinction Owner seeks to draw is immaterial because Reed's "finished garment" and the "lined section" embodiments utilize the same interconnected outlines. They differ only in how the outlines are removed from the

tubes. In the "finished garment" embodiments, the outlines are separated from each other in certain locations to form openings for a person's body to fit through. (Ex. 1006, 1:64-2:1.) In the "lined section" embodiments, separating the outlines is unnecessary because a person's body is not positioned between the lining and the outer layer. (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117; Ex. 2004, 141:13-20.)

2. Owner's Efforts To Ignore Nishida's Full Disclosure Are Likewise Flawed.

As with Reed, Owner's assessment of Nishida again ignores controlling law by asserting that "Nishida teaches achieving [the related sole part] by producing a web of material just like in the German patent." Response, p. 29. Legally, the assertion deserves no weight and, factually, it is incorrect.

If Nishida were so limited, it would have confined itself to improving a weaving process because the "German patent" only describes weaving. Yet Nishida clearly states that "[i[]n FIGS. 1 and 2, a web of material is identified by 1, and is produced by a conventional textile process, for example, by weaving and/or knitting and/or embroidering." (Ex. 1009, 3:6-9; Ex. 1003, ¶78, 96.)

Owner next urges that Nishida discloses only applying a textile element to an existing backing, as it argued during prosecution. (Ex. 1002, 1/13/2012 Response, p. 6-8.) Owner's later positions regarding Nishida are wholly

inconsistent, first asserting that Nishida is limited to a "'layout' [] surrounded by a textile structure from which it must be removed" (*See* IPR2013-00067, Paper 31, pp. 6-7), and asserting that Nishida is limited to a layout that *is* the entire web of material with no surrounding area, *i.e.* knit to shape. Response, p. 53.

Nishida expressly states that "in the production of a web of material, both the patterns or partial patterns in the form of layouts of the shoe upper and the . . . sole part, *are produced by a fabric printing process* (which is generally well known in the textile industry) *on* the web of material and/or by *a textile production process inside* the web of material . . . ." (Ex. 1009, 1:50-56 (emphasis added); Ex. 1003, ¶113.) In other words, Nishida describes producing the layout *on* a web of material (e.g., embroidery) or *inside* the web of material (e.g., knitting). (Ex. 2004; 158:10-162:4; 168:22-170:13.)

In a flawed effort to rewrite Nishida's disclosure, Owner replaced "*inside*" with "*onto*" when describing this passage. Response, p. 29. But Nishida cannot be so rewritten. Indeed, Nishida explains that only the web parts that correspond to the shoe upper or shoe part are produced in the necessary quality, thickness, and/or multilayers, whereas the web parts that hold the patterns together are produced of a simple, lightweight, or inexpensive material, thus reinforcing the concept of producing layouts simultaneously with the surrounding portions of the web of material. (Ex. 1009, 2:12-20; Ex. 1003, ¶101.) Thus, Owner's strained reasoning

for attempting to distinguish Nishida fails.

D. OWNER FAILED TO REBUT THE MOTIVATION TO COMBINE THE PRIOR ART.

1. The POSITA Knew Of The Problem Addressed By The '749 Patent.

Owner attempts to analogize this case to *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346 (Fed. Cir. 2013). But the Court has already distinguished *Leo* specifically in this context when addressing the parent of the '749 patent, which has an identical specification. The Court noted that the age of references can be relevant to show secondary considerations, but held that situation was inapplicable here because "there is no question that skilled artisans knew of the desire to reduce waste when producing wearable, knitted shoe uppers because that problem is expressly recognized in Nishida." *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1338 (Fed. Cir. 2016).

Furthermore, Owner's narrowly-stated problem of "making footwear uppers from multiple materials" is addressed by both Reed and Nishida. The '749 patent discourages using multiple materials because of the need for additional machinery, suppliers, etc. (Ex. 1001, 3:4-16.) But those complexities are not present in Reed and Nishida, as the same machinery and process is used to produce a knitted textile from a single yarn type or multiple yarn types. Moreover, the '749 patent is clear that the use of different yarn types is not the type of "multiple materials" with

which it is concerned, as it encourages the use of "different yarn types" to "impart different properties." (Ex. 1001, 9:67-10:1.)

But Mr. Holden testified that the '749 patent identifies several additional problems: "(1) inefficiencies and cost in using multiple materials, and (2) poor breathability of materials like leather (natural or synthetic) and rubber." (Ex. 1001, 3:3-23; Ex. 1003, ¶47-48.) Reed and Nishida identify these same inefficiencies in producing textile products. (Ex. 1006, 2:22-31, 6:19-22; Ex. 1009, 2:27-47; Ex. 1003, ¶134-135.) Mr. Holden confirmed that a POSITA would consider these issues during product development. (Ex. 2004, 116:13-118:15.) Nishida also addresses the importance of air exchange in shoes. (Ex. 1009, 3:43-52.)

Moreover, *KSR* explicitly states that it is a legal error for "courts and patent examiners [to] look only to the problem the patentee was trying to solve. . . . Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007); *see also Nike*, 812 F.3d at 1337.

Here, in addition to the desire to reduce waste, the POSITA was aware of the need to use computerized machinery control to produce knitted products more efficiently and with more versatility. (Ex. 2004, 83:25-85:8; 91:6-92:16.) Reed

recognized the need to reduce manufacturing costs of "all types of garments worn by men, women and children" by using computerized knitting machines. (Ex. 1006, 1:45-55; 2:22-31, 5:56-57; Ex. 1003, ¶73, 75, 131-132, 134; Ex. 2004, 171:25-175:7.) Reed also explains the "unlimited pattern potential" afforded by computerized knitting. (Ex. 1006, 1:45-55.) Nishida recognized that computerized knitting could form knit configurations for more durable items, such as shoes, in a more efficient and inexpensive manner. (Ex. 1009, Abstract; 2:27-33; 3:6-11; 4:12-18; *see also* 2:40-45; 4:53-60; 5:45-49; 5:64-65; Ex. 1003, ¶76, 78, 135.) Nishida also identified the advantage and ease of varying the knit options through computerization. (Ex. 1009, 2:40-45.) This need to incorporate computerized knitting technology to improve efficiencies in shoe upper manufacturing and the importance of being able to vary patterns, designs, and textures is addressed in the '749 patent. (Ex. 1001, 7:29-37; Ex. 1003, ¶79.) Thus, the POSITA's motivation for combining Reed with Nishida is based on taking Reed's improvements in knitting technology that are applicable to all garments, and extending those improvements to shoe uppers, as described in Nishida. (Ex. 1003, ¶136.)

2. Reed Is Analogous Art To The '749 Patent.

Prior art is analogous and can be applied in an obviousness combination if it either (1) "is from the same field of endeavor, regardless of the problem addressed" or (2) "is reasonably pertinent to the particular problem with which the

inventor is involved." *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1000–01 (Fed. Cir. 2016). Reed meets both prongs.

First, Reed and the '749 patent are from the same field of endeavor. The '749 patent states that "[t]he present invention relates to footwear. The invention concerns, more particularly, an article of footwear incorporating *an upper that is at least partially formed from a textile material*." (Ex. 1001, 1:18-21 (emphasis added).) As the Court explained, "[t]he field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field." *Unwired Planet*, 841 F.3d at 1001.

The Court determined that Nishida and U.S. Patent Nos. 2,178,941 ("Schuessler I") and 2,150,730 ("Schuessler II") "are in similar fields and address the same problem." *Nike*, 812 F.3d at 1337. Like the '749 patent, Nishida describes forming a textile product in the form of shoe uppers from a textile material. Like Reed, Schuessler I and II describe forming a textile product in the form of garments (e.g., knitted caps) from a textile material. It therefore follows that the '749 patent and Reed are also from the same field of endeavor. (Ex. 1006, 5:56-57; Ex. 1003, ¶131.)

Mr. Holden affirmed this conclusion, stating that "there are more similarities between the apparel industry and the footwear industry than there are differences." (Ex. 2004, 26:5-7; *see also* 26:16-19; 38:14-17; 26:22-40:1.)

Reed likewise satisfies the second prong. The Court determined that Nishida, Schuessler I, and Schuessler II ""serve the same purpose' of efficiently creating knitted articles." *Nike*, 812 F.3d at 1337. Likewise, the '749 patent and Reed each identify a purpose to efficiently create knitted articles. (Ex. 1001, 3:13-16; Ex. 1006, 2:22-31; Ex. 1003, ¶47-48, 134.) The '749 patent also describes the benefit of altering the design and pattern of a textile structure using a programmable knitting machine, as does Reed. (Ex. 1001, 7:25-37; Ex. 1006, 1:45-55.) Thus, Reed is pertinent to the problem of the '749 patent.

Incredibly, Owner claims that a POSITA would not consider Reed because Mr. Holden lacks knitting machine operation experience. Response, pp. 34-35. As detailed above, such experience is immaterial to the skilled artisan's ability to comprehend Reed. (Ex. 2004, 71:22-76:7.) Indeed, Mr. Holden explained that skilled artisans routinely rely on suppliers' knowledge of equipment capability, as Mr. Tonkel confirmed. (Ex. 2004, 113:1-10; *see* IPR2013-00067, Ex. 1015, 38:18-23.)

Owner also claims that a POSITA would not consider Reed because Mr. Holden "testified that he did not understand much of Reed." Response, p. 35. That is false. At most, Mr. Holden declined to define, without reference to Spencer, terms of art from Reed when questioned without reference to Reed. (Ex. 2004, 76:8-81:18.)

Skechers EX1013-p. 427
Skechers v Nike

When questioned about Reed in context, Mr. Holden readily described how certain embodiments of Reed's garment are seamed and cut, along with an explanation of knitting machine operation. (Ex. 2004, 142:13-148:22; 149:4-151:6.)

3. Petitioner Addressed Why A POSITA Would Have Been Motivated To Combine Reed And Nishida And How The POSITA Would Have Combined Them.

Mr. Holden declared that using Reed's process to produce textile elements for all types of clothing, including for footwear, is a simple design choice that is predictable and well known to the POSITA. (Ex. 1003, ¶132, 137.) This testimony stands unrebutted. Moreover, Mr. Holden testified, again unrebutted, that the key features a POSITA would consider for sourcing shoes include throughput, machine capabilities, maintenance, process control, and manufacturing location. (Ex. 2004, 115:4-15; 116:13-118:15; *see also* 120:7-10.) This testimony — based on over 40 years of footwear and apparel expertise — demonstrates that skilled artisans have ***always*** been motivated to improve manufacturing efficiencies. Plainly, this is a core reason as to ***why*** a POSITA would combine Reed with Nishida.

As to the ***how*** question Owner raises, the record amply addresses that issue as well. First, Owner's how argument is inextricably linked to its (incorrect) argument that Reed is non-analogous art. Indeed, Reed's use of "all types of

garments" and "stockings" is sufficient to suggest to the POSITA that its process could be used to make knitted uppers. Moreover, the '749 patent defines textile broadly as "any manufacture from fibers, filaments, or yarns…", not just shoe uppers. (Ex. 1001, 2:15-23.) As Mr. Holden explains, it is a POSITA's due diligence that drives selection of a manufacturing process with the capability to cost-effectively produce the layouts. (Ex. 2004, 119:1-13; *see also* 93:13-95:6; 113:1-118:15; 119:14-126:16.)

Thus, modifying the knitting manufacturing process to produce the shoe upper is nothing more than changing the machine programming. As Reed expressly states, "[t]he types of program used to form the final product is to be varied with the imagination of the programmer, as well as the type of product which may be formed." (Ex. 1006, 6:22-25; *see also* 4:68-5:2.) In short, Reed teaches how to modify itself to incorporate Nishida's layout.

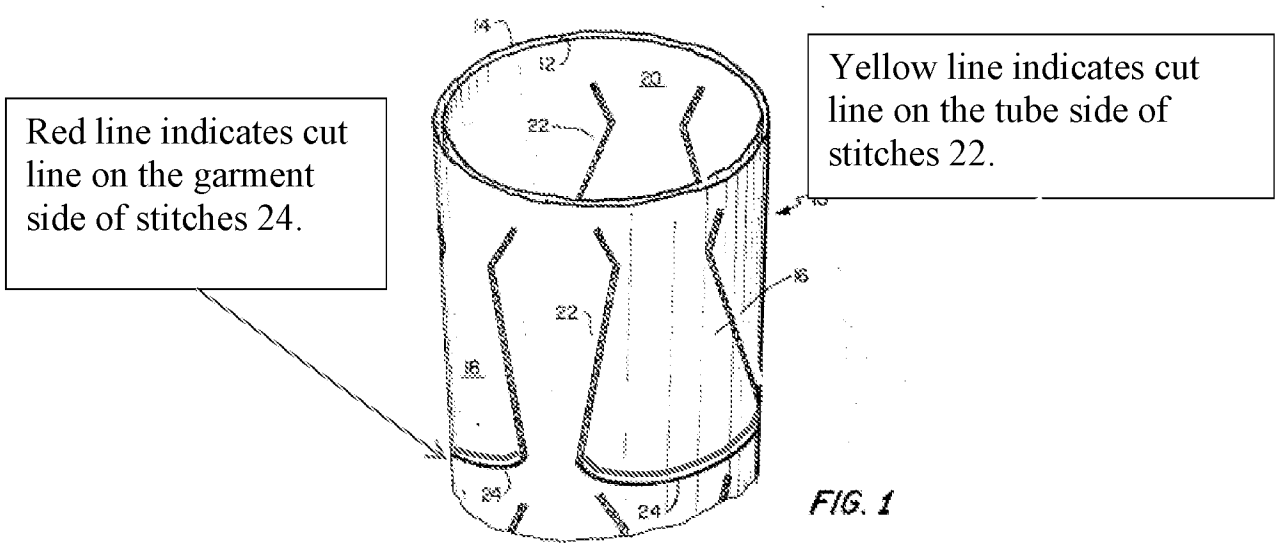
4. Reed Is Operable When Combined With Nishida.

Owner's arguments that Reed is limited to the "finished garment" embodiments are irrelevant.

In both the "finished garment" and the "lined section" embodiments, the interconnected outlines in Reed are formed identically. Reed states that the same stitches 22, 24 can be used for outlining a cut line and preseaming (*e.g.*, stitches 22) or just for providing a cut line (*e.g.*, stiches 24). (Ex. 1006, 3:9-15; Ex. 1003,

¶103.)

For the "finished garment" embodiment, the sides are cut along the surrounding tube side of the stitches 22 (highlighted in yellow below) so that the seam remains with the garment. In contrast, the bottom is cut along the garment side of the stitches 24 (highlighted in red below) so that the seam is removed from the garment to provide an opening for the person's body between the layers.



For the "lined section" embodiments, the outline may be cut along the surrounding tube side of the stitches 22, 24 (highlighted in yellow below) so that all seams remain with the garment.

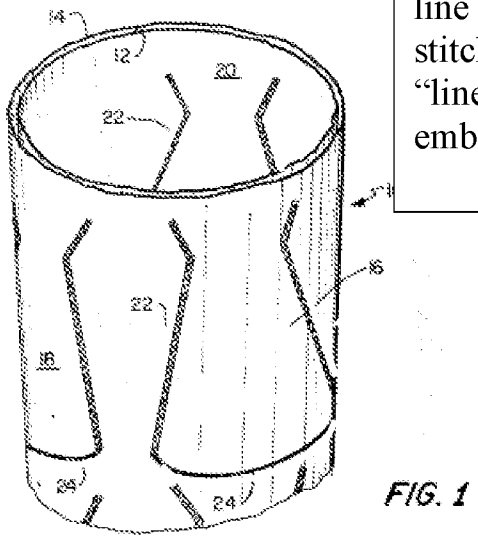


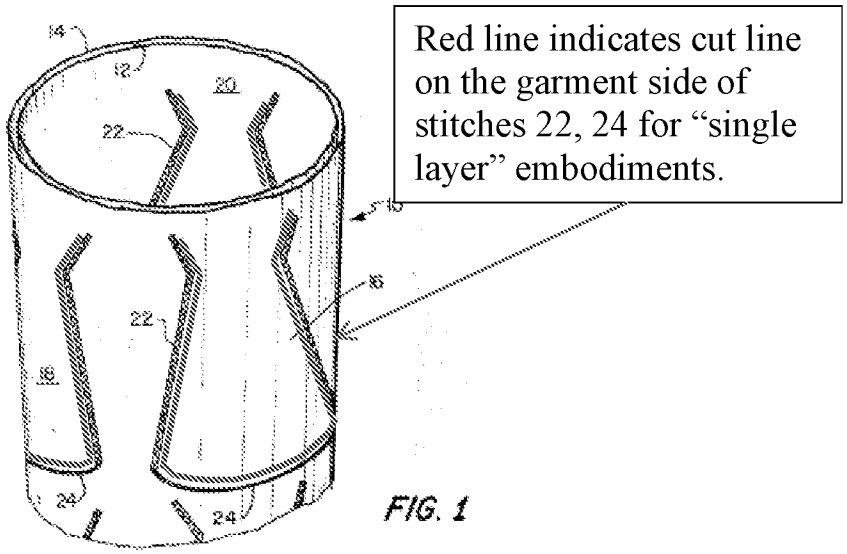
FIG. 1

Yellow line indicates cut line on the tube side of stitches 22, 24 for the "lined section" embodiments.

Even assuming that Reed was limited to the "finished garment" embodiments, when the outlines are modified to form a shoe upper instead of a garment, the outlines are still interknitted together in layered form. Therefore, the design is still fully operable and practices the claims. Indeed, Nishida says that "the material can be woven or knitted in two or more layers." (Ex. 1009, 3:67-68; *see also* Ex. 2004, 168:25-169:4.) As a POSITA would understand, the only way to form a layout knitted in two or more layers is to have at least some stitches that interconnect the two layers — as described by Reed in both the "finished garment" and the "lined section" embodiments.

To produce two single-layer layouts, the POSITA would simply cut along the garment side of stitches 22, 24 (highlighted in red below) so that all seams remain with the surrounding tube material, and the two layouts are no longer

connected to each other after removal from the tubes 12, 14. (Ex. 1006, 3:9-15, 5:67-6:3; Ex. 1003, ¶103, 112.) The two separated layouts are then processed and seamed along the edges, as described in both Reed and Nishida. (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117; Ex, 1009, 6:47-54; Ex. 1003, ¶124.)



5. Reed Does Not Teach Away From The Combination With Nishida.

Owner alleges that Reed "criticiz[es] prior art methods of manufacturing garments" because "they required the manufacturer to cut panels of a garment from larger textile and then seam the panels together to complete the garment." Response, pp. 47-48.

Owner's reliance on *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) is misplaced. In *DePuy*, the Court recognized that "[a] reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not 'criticize, discredit,

or otherwise discourage' investigation into the invention claimed." *Id.* (quoting *In re Fulton,* 391 F.3d 1195, 1201 (Fed. Cir. 2004)).

Reed has not criticized, discredited, or discouraged the use of conventional clothing manufacturing. Rather, it has praised the advantages of computerized knitting. (Ex. 1006, 1:45-48.) Furthermore, Reed's "lined section" embodiments are assembled in exactly the same way that Owner claims Reed "teaches away" from doing. (Ex. 1006, 3:61-4:8; 6:10-17; Ex. 1003, ¶105, 117.) "The absence of the further advantage that [the prior art] associates with [an optimal embodiment] is not a 'disadvantage' [of an alternative embodiment]," "and therefore [the prior art] cannot be regarded as teaching away from the [alternative embodiment]." *In re Inland Steel Co.*, 265 F.3d 1354, 1361 (Fed. Cir. 2001).

In view of Reed's unequivocal disclosure regarding the "lined section" embodiments, Reed does not teach away from embodiments where outlines are cut out of a web of material and seamed together to form a finished garment, which Owner notes is precisely the type of assembly required by Nishida. Response, p. 48.

E. There Are No Differences Between the Claimed Subject Matter And The Reed/Nishida Combination.

1. Reed Discloses Feature [1C].

Owner incorrectly states that Reed does not describe "the knitted textile element having at least one knitted texture that differs from a knitted texture in the

surrounding knitted textile structure" [1C].

The '749 patent's disclosure for this feature states: "the wide-tube circular knitting machine may be programmed to form different types of stitches in textile structure 60 so as to outline one or more textile elements 40." (Ex. 1001, 8:1-3.) This description is virtually identical to that of Reed. (Ex. 1006, 3:8-9; *see also* 4:61-64; 5:67-6:3; FIGS. 2, 2A, 3A-3E; Ex. 1003, ¶108-109.)

Additionally, because Reed's garment is made up of two different knit types, the surrounding web of material necessarily differs from at least one of these types.[1] (Ex. 1003, ¶109.)

Thus, Owner's argument fails, as this feature is clearly disclosed by Reed.

2. Nishida Discloses Features [1B] and [1C].

Owner asserts that Nishida does not disclose "simultaneously knitting a textile element with a surrounding textile structure" [1B] or feature [1C], relying strictly on the '749 patent prosecution history. To the extent Owner is challenging the Board's exercise of its discretion in granting institution by arguing that the examiner's analysis of Nishida is "unrebutted," Owner's arguments are incorrect, as the Board properly exercised its discretion to institute. Response, pp. 52-54.

[1] Claims 1 and 13 only require that the textile element have one knitted texture that differs from a knitted texture in the surrounding textile structure.

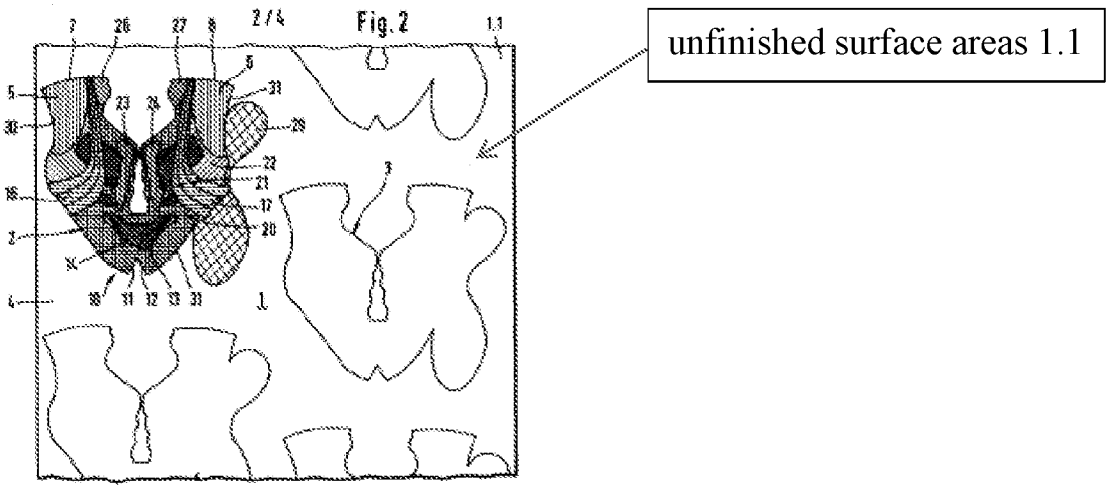
First, the examiner never considered Nishida in the context of 35 U.S.C. §103. Petitioner explained the examiner only considered Nishida as an anticipatory reference, noting that Petitioner has presented new references, arguments, and supporting evidence that were not before the examiner. Petition, p. 59.

Regarding element [1C], during prosecution, Owner admitted that Nishida teaches a "web of material having different textures." (*See* Ex. 1002, 4/13/2012 Interview Summary.) Owner, however, disputed whether there is any clear disclosure of where the textures differ in Nishida. *Id.* But in a 103 context, a POSITA would read Nishida's disclosure of using "simple, lightweight or inexpensive material quality" *in the remaining web of material* to hold together "parts of the web of material [that] are produced in the necessary quality, thickness, multilayer or the like" as a clear indication of a different texture for the layout than the surrounding material. (Ex. 1009, 2:12-20 (emphasis added); Ex. 1003, ¶160.)

Moreover, Nishida expressly teaches that the (1) web of material is knitted with a plurality of layouts, and (2) employing different knitting types for the shoe upper as compared to the sole part of the layout. (Ex. 1009, 1:50-56, 3:6-12; Ex. 1003, ¶113, 120.) If the shoe upper and the sole part are knitted with two different

knit types, then the surrounding web of material necessarily differs from at least one of these types.[2] The examiner failed to recognize this aspect of Nishida.

Nishida also describes that "unfinished surface areas" lie outside layouts 2. (Ex. 1009, 4:61.) These "surface areas 1.1 . . . can be produced like a gauze or with low to very low warp," which has a different texture than the layouts 2. (Ex. 1009, 5:50-51.)



Nishida also expressly teaches element [1B]. For example, Nishida states "a web of material (1) is used to produce layouts (2) . . . *at the same time* with the production of web of material (1)." (Ex. 1009, Abstract (emphasis added); *see also* 2:56-58.) Neither Owner nor the examiner considered this express teaching of Nishida during prosecution.

Owner also argues that Petitioner's citations relate to an embodiment of

[2] Claims 1 and 13 only require that the textile element have one knitted texture that differs from a knitted texture in the surrounding textile structure.

Nishida where the layouts are the entire web of material with no surrounding area, *i.e.* knit to shape. Response, p. 53. First, Owner's argument is unsupported and contradictory to its prior positions, as discussed above. Second, all of Nishida's figures show the layouts within a surrounding web of material.

Thus, the Board properly exercised its discretion in instituting the Petition, as Nishida clearly discloses these features for reasons not previously considered during prosecution.

3. Reed Discloses The "To Impart" Element.

The claim language at issue describes "a second stitch configuration that is different from the first stitch configuration to ***impart*** varying textures…." "Impart" means to give, convey, or grant from. (Ex. 1014.) That is consistent with the repeated use of "impart" in the specification. The '749 patent indeed discloses that "similar stitches are utilized throughout textile element 40 to impart a common texture" (Ex. 1001, 8:62-64), while "vary[ing] the stitches within textile element 40 [will] produce various . . . textures." *Id.*, 9:1-4. Thus, under the broadest reasonable construction ("BRI") standard, the claim language and specification make plain that the very presence of the different stitch configurations gives or bestows the varying textures.

Owner nonetheless urges that Reed does not expressly associate different stitch configurations with different textures. But Owner's argument is irrelevant

under the BRI standard.

In any event, skilled artisans would plainly achieve the claimed subject matter given Reed's description of interknitted and non-interknitted stitches. (Ex. 1006, 3:61-4:9; 4:61-64; 5:63-6:3; FIGS. 2A, 3A-3E; Ex. 1003, ¶115-117.) "[A] prior art reference must be 'considered together with the knowledge of one of ordinary skill in the pertinent art.'" *In re Paulsen*, 30 F.3d 1475, 1480–81 (Fed. Cir. 1994) (quoting *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)). The very presence of the different stitches in Reed "imparts" varying textures, a point that skilled artisans would understand. (Ex. 2004; 177:1-184:12.)

4. Nishida Also Discloses The "To Impart" Element.

Owner's treatment of Nishida is woefully inaccurate. First, Owner ignores Nishida's disclosure that explains the use of computerized knitting machines to select a particular knitted type for individual areas or contours within a particular layout. Response, pp. 56-57. Specifically, Nishida states that "[w]ith the use of program-controlled web of material production devices, after a one-time creation of the program, the size of the layout corresponding to the shoe size, the woven or *knitted type of individual areas or contours*, the type of fiber or yarn and/or the color *can be selected almost at will*." (Ex. 1009, 2:40-45 (emphasis added); Ex. 1003, ¶118.) This section alone discloses the features of claims 11 and 21.

Likewise, Owner also completely ignores *three different passages* from

Nishida that describe different stitch configurations. Response, pp. 56-57. Yet, in each passage, Nishida discusses the use of different types of stitch configurations to vary textures and properties in different areas of the layout. (Ex. 1009, 3:43-52; 5:63-6:2; 6:1-31 (emphasis added); Ex. 1003, ¶120-121.) As just one example, Nishida states:

"Since, generally, toe area 14 is designed to be relatively deformably *soft or elastic,* and optionally, also permeable to air, the web of material 1, in toe area 14, according to the present invention, *is* correspondingly designed by suitable selection of . . . *knit pattern* . . . . The type of production can, additionally, insure that the toe area 14 has a good air exchange capability. For example, this can be achieved by a *net-like* woven or *knitted structure*." (Ex. 1009, 3:43-52 (emphasis added); Ex. 1003, ¶120.)

Finally, Owner claims that Nishida's description of a heel counter 28 applied to areas 26, 27 somehow negates Nishida's statement that "*areas 26 and 27 are produced in a configuration*, color or style *that is different from the other areas*." (Ex. 1009, 4:6-9 (emphasis added); Ex. 1003, ¶120.) Regardless of whether a heel counter 28 is applied, Nishida clearly describes *producing* these areas 26, 27 using a *configuration* different from the other areas. Nishida's language is practically verbatim of the language of claims 11 and 21.

In sum, there is no basis to conclude that Nishida "only discloses varying materials, fibers, or yarns," as Owner asserts.

III. OBVIOUSNESS ARGUMENTS ARE NOT TAINTED BY HINDSIGHT.

Owner's assertion that the obviousness analysis is tainted by hindsight is flawed.

First, both Reed and Nishida *affirmatively and expressly describe* using different stitch configurations to impart varying textures across a textile element surface, as discussed above.

Second, Reed and Nishida *are more broadly directed* to solving the problem of inefficiencies, costs, and design variability associated with producing textile elements using conventional methods, as discussed above.

In sum, Owner's reasons for asserting an improper hindsight basis do not survive scrutiny.

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
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Registration No. 39,389

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Skechers v Nike

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CERTIFICATION UNDER 37 CFR §42.24(c)(1)

Under the provisions of 37 CFR §42.24(c)(1), the undersigned hereby certifies that the word count for the foregoing Petitioner's Reply totals 5,596, which is less than the 5,600 allowed under 37 CFR §42.24(c)(1).

Dated: April 21, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

Lead Counsel	Back-Up Counsel
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE** and **EXHIBITS 1013-1014** have been served on April 21, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

Christopher J. Renk
Michael J. Harris
BANNER & WITCOFF, LTD.
10 South Wacker Drive
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mharris@bannerwitcoff.com, and
bwlitdocket@bannerwitcoff.com

Dated: April 21, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case: IPR2016-00922
Patent 8,266,749

PETITIONER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. §42.8, Petitioner, adidas AG, hereby submits the following Updated Mandatory Notices information:

II. MANDATORY NOTICES

A. Real Party in Interest under 37 C.F.R. § 42.8(b)(1)

There is no change to the identity of real party in interest provided in the Petition. In that filing, Petitioner identified the real party in interest as follows:

Petitioner, adidas AG, the ultimate parent of adidas International B.V., adidas North America, Inc., adidas America, Inc., and adidas International, Inc., is the real party-in-interest for the instant petition.

B. Related Matters under 37 C.F.R. § 42.8(b)(2)

In accordance with 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related proceedings that may affect, or be affected by, a decision in the proceeding:

Petition for *inter partes* review of claims 1-38 of U.S. Patent No. 8,042,288 (IPR2016-00920), filed simultaneously with the instant petition, and for which the Board denied institution. The '749 patent is a continuation application of U.S. Patent No. 8,042,288, which is a continuation application of U.S. Patent No. 7,814,598.

Petition to *inter partes* review of claims 1-13 of U.S. Patent No. 7,814,598 (IPR2017-00921), filed simultaneously with the instant Petition. The Board instituted *inter partes* review of claims 1-13 of U.S. Patent No. 7,814,598.

Petition for *inter partes* review of claims 8 and 14-20 of U.S. Patent No. 8,042,288 (IPR2017-00263).

Petition for *inter partes* review of claims 1-7, 9-13, and 21-38 of U.S. Patent No. 8,042,288 (IPR2017-00264).

There is no change to the identity of the other related matters provided in the Petition. In that filing, Petitioner identified the related matters as follows:

The '749 patent is a continuation application of U.S. Patent No. 8,042,288, which is a continuation application of U.S. Patent No. 7,814,598, which is a divisional application of U.S. Patent No. 7,347,011 ("the '011 patent"). The Board instituted *inter partes* review of claims 1-46 of the '011 patent (IPR2013-00067), and Nike requested cancellation of claims 1-46 and proposed substitute claims 47-50. The Board granted the motion to cancel, but denied the motion as to the substitute claims. Nike appealed the Board's decision to the Federal Circuit (Case No. 2014-1719). The Federal Circuit issued a decision on February 11, 2016, which affirmed-in-part, vacated-in-part, and remanded the case to the Board for further proceedings on secondary consideration and patentability of dependent

Skechers EX1013-p. 446
Skechers v Nike

claim 49.

D. Designation of Lead Counsel and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)

There is no change to the designation of lead and backup counsel provided in the Petition. In that filing, Petitioner designated lead counsel and substitute back-up counsel as follows:

Lead Counsel	Back-Up Counsel
Mitchell G. Stockwell Reg. No. 39,389 mstockwell@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 815 6214	Vaibhav P. Kadaba Reg. No. 45,865 wkadaba@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 532 6959 Tiffany L. Williams Reg. No. 59,549 tiwilliams@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 815 6608

Petitioner continues to respectfully request that service be provided at the email addresses listed above.

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8** has been served on April 21, 2017, by First Class Mail and email directed to the attorneys of record for Patent Owner as follows:

Christopher J. Renk
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bwlitdocket@bannerwitcoff.com

Dated: April 21, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2016-00922
Patent No. 8,266,749

PATENT OWNER'S OBJECTIONS TO ADMISSIBILITY OF EVIDENCE SERVED WITH PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

Pursuant to 37 C.F.R. § 42.64(b), Patent Owner NIKE, Inc. objects as follows to the admissibility of evidence served with Petitioner's Reply to Patent Owner's Response.

Evidence	Objections
Exhibit 1013	**Lack of Foundation**: Petitioner has not provided sufficient explanation of what the exhibit is or what it allegedly shows. **FRE 402**: The exhibit is not relevant to any ground upon which trial was instituted.

	FRE 403: The exhibit's probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence. **FRE 801/802**: The exhibit is inadmissible hearsay if offered to prove the truth of any matter allegedly asserted therein. **FRE 901**: Petitioner has not authenticated the exhibit by producing evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.
Exhibit 1014	**Lack of Foundation**: Petitioner has not provided sufficient explanation of what the exhibit is or what it allegedly shows. **FRE 402**: The exhibit is not relevant to any ground upon which trial was instituted. **FRE 403**: The exhibit's probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence. **FRE 801/802**: The exhibit is inadmissible hearsay if offered to prove the truth of any matter allegedly asserted therein. **FRE 901**: Petitioner has not authenticated the exhibit by

	producing evidence sufficient to support a finding that the exhibit is what Petitioner claims it is.

Date: April 28, 2017

Respectfully submitted,

/Christopher J. Renk/

Christopher J. Renk
Michael J. Harris
BANNER & WITCOFF, LTD.
10 South Wacker Drive, Suite 3000
Chicago, Illinois 60606

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on April 28, 2017, by email directed to the attorneys of record for Petitioner as follows:

Mitchell G. Stockwell
Vaibhav P. Kadaba
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/s/ *Aaron P. Bowling*
Aaron P. Bowling
Banner & Witcoff, Ltd.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	15/610,089	Confirmation No. 4757
Inventor	:	Bhupesh Dua	
Applicants	:	NIKE, Inc.	
Filed	:	5/31/2017	
Title	:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	
Group Art Unit	:	3765	
Examiner	:	Marie D. Bays	
Matter No.	:	NIKE.276100/08-1313US82CON	
Customer No.	:	78342	

VIA EFS – 7/24/2017

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

IDS SUBMISSION

This correspondence is being submitted with an Information Disclosure Statement pursuant to 37 C.F.R. § 1.97. Due to the number of references, the IDS is separated into multiple forms. Accordingly, Applicant hereby submits IDS forms 1-11 as this IDS submission. Each IDS form corresponds to an IDS form filed in the Application No. 14/503,514 from which this pending application depends. Pursuant to 37 C.F.R. § 1.97(c)(2), Applicant submits herewith the fee set forth in § 1.17(g) for the IDS submission.

Respectfully submitted,

/ELIZABETH A. LUCAS/

Elizabeth A. Lucas
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8298658 v1

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PTO/SB/08a (03-15)
Approved for use through 07/31/2016. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

U.S.PATENTS Remove

Examiner Initial*	Cite No	Patent Number	Kind Code[1]	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	0761520		1904-05-31	Matthew	

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Examiner Initial*	Cite No	Publication Number	Kind Code[1]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	20080110049		2008-05-15	Sokolowski et al.	
	2	20130239625		2013-09-19	Meir et al.	

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	1							

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	15610089
	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T[5]
	1	Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00263 dated March 9, 2017, 24 pages.	
	2	Petition for Inter-Partes Review Under 35 U.S. C. §§ 311-319 and 37 C.F.R. § 42.100 et seq. (IPR2016-00920), filed April19, 2016, 67 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2001 to the Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00263 and for Inter Partes Review I PR20 17-00264.	
	3	Trial Instituted Document in IPR2016-00920 dated October 20, 2016, 8 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2002 to the Patent Owner Preliminary Response Under 37 C.F .R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00263 and for Inter Partes Review I PR20 17-00264.	
	4	Petition for Inter-Partes Review Under 35 U.S. C. §§ 311-319 and 37 C.F.R. § 42.100 et seq. (IPR2017-00264), filed November 14,2016, 59 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2003 to the Patent Owner Preliminary Response Under 37 C.F .R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00263.	
	5	Patent Owner Corrected Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00263 dated March 27, 2017, 24 pages.	
	6	Patent Owner Updated Mandatory Notice Under 37 C.F.R. § 42.8 for Inter Partes Review IPR2017-00263 dated March 28, 2017, 5 pages.	
	7	Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00264 dated March 9, 2017, 24 pages.	
	8	Petition for Inter-Partes Review Under 35 U.S. C. §§ 311-319 and 37 C.F.R. § 42.100 et seq. (IPR2017-00263), filed November 14, 2016, 50 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2003 to the Patent Owner Preliminary Response Under 37 C.F .R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00264.	
	9	Patent Owner Corrected Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00264 dated March 27, 2017, 24 pages.	
	10	Patent Owner Updated Mandatory Notice Under 37 C.F.R. § 42.8 for Inter Partes Review IPR2017-00264 dated March 28, 2017, 5 pages.	

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	15610089
	Filing Date	2017-05-31
	First Named Inventor	BHUPESH DUA
	Art Unit	3765
	Examiner Name	MARIE D. BAYS
	Attorney Docket Number	NIKE.276100/081313US82CON

	11	Office Action in corresponding U.S. Patent Application No. 15/358,723, dated April 5, 2017, 16 pages.

If you wish to add additional non-patent literature document citation information please click the Add button Add

EXAMINER SIGNATURE

Examiner Signature		Date Considered	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1] See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. [2] Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). [3] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [4] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [5] Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15610089
Filing Date	2017-05-31
First Named Inventor	BHUPESH DUA
Art Unit	3765
Examiner Name	MARIE D. BAYS
Attorney Docket Number	NIKE.276100/081313US82CON

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

☒ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ A certification statement is not submitted herewith.

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/ELIZABETH A. LUCAS/	Date (YYYY-MM-DD)	2017-07-24
Name/Print	Elizabeth A. Lucas	Registration Number	74247

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

EXHIBIT 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

adidas AG
Petitioner

v.

Nike, Inc.
Patent Owner

Patent No. 8,042,288
Filing Date: September 10, 2010
Issue Date: October 25, 2011
Title: ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

Inter Partes Review No. Unassigned

PETITION FOR *INTER PARTES* REVIEW
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *ET SEQ.*

Exhibit 2001

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F. Power of Attorney 3

G. Standing 3

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LIST OF EXHIBITS

PETITIONER EXHIBIT	DESCRIPTION
1001	U.S. Patent No. 8,042,288 ("the '288 patent")
1002	File History for U.S. Patent No. 8,042,288 ("'288 file history")
1003	Declaration of Lenny Holden ("Holden Decl.")
1004	C.V. for Lenny Holden
1005	Form PTO-SB/42
1006	U.S. Patent No. 3,985,003 to Reed ("Reed")
1007	U.S. Patent No. 4,038,840 to Castello ("Castello")
1008	U.S. Patent No. 6,330,814 to Fujiwara ("Fujiwara")
1009	U.S. Patent No. 5,345,638 to Nishida ("Nishida")
1010	David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third Ed., Woodhead Publishing Ltd. 2001) ("Spencer")
1011	Paul Burall, "CoID Design Awards," Design, June 1969, pp. 46-47 ("Burall")
1012	ISO 8117:2003(E) Textile machinery - Knitting machines - Nominal diameters of circular machines ("ISO 8117")
1013	U.S. Patent No. 4,785,558 to Shiomura ("Shiomura")
1014	U.S. Patent No. 6,779,369 to Shepherd ("Shepherd")

I. INTRODUCTION

Through counsel, real party in interest adidas AG ("Petitioner") hereby petitions for initiation of *inter partes* review of claims 1-38 of U.S. Patent No. 8,042,288 ("the '288 patent"), assigned to Nike, Inc. ("Patent Owner"). A copy of the '288 patent is attached as Exhibit 1001, and a copy of the prosecution history of the '288 patent is attached as Exhibit 1002.

II. MANDATORY NOTICES

A. Real Party in Interest

Petitioner, adidas AG, the ultimate parent of adidas International B.V., adidas North America, Inc., adidas America, Inc., and adidas International, Inc., is the real party-in-interest for the instant petition.

B. Related Matters

The '288 patent is a continuation application of U.S. Patent No. 7,814,598, which is a divisional application of U.S. Patent No. 7,347,011 ("the '011 patent"). The Board instituted *inter partes* review of claims 1-46 of the '011 patent (IPR2013-00067), and Nike requested cancellation of claims 1-46 and proposed substitute claims 47-50. The Board granted the motion to cancel, but denied the motion as to the substitute claims. Nike appealed the Board's decision to the Federal Circuit (Case No. 2014-1719). The Federal Circuit issued a decision on February 11, 2016, which affirmed-in-part, vacated-in-part, and remanded the case to the Board for further proceedings on secondary consideration and patentability of dependent claim 49.

C. Fee

This petition for *inter partes* review of 38 claims of the '288 patent is accompanied by a fee payment of $35,800 which includes the $12,600 *inter partes* review request fee and the $23,200 *inter partes* review post-institution fee. *See* 37 C.F.R. § 312(a)(1) and 37 C.F.R. § 42.15(a) and 42.103. Petitioner further authorizes a debit from Deposit Account 20-1430 for whatever additional payment is necessary in granting this petition.

D. Designation of Lead Counsel and Request for Authorization

Lead Counsel	Back-Up Counsel
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E. Service Information

As identified in the attached Certificate of Service, a copy of the present petition, in its entirety, is being served to the address of the attorney or agent of record. Petitioner, adidas AG, may be served at its counsel, Kilpatrick Townsend & Stockton LLP, at the e-mail addresses indicated above.

F. Power of Attorney

A power of attorney with the designation of counsel is filed herewith in accordance with 37 C.F.R. § 42.10(b).

G. Standing

Petitioner certifies that the '288 patent is eligible for *inter partes* review and further certifies that Petitioner is not barred or otherwise estopped from requesting *inter partes* review challenging the identified claims on the grounds identified herein.

III. THE '288 PATENT

A. Priority Date of the '288 Patent

The '288 patent issued on October 25, 2011 from Application No. 12/879,517 ("the '517 application"), filed on September 10, 2010. The '288 patent purports to be a continuation of Application No. 12/032,995, filed on February 18, 2008, now U.S. Patent No. 7,814,598 ("the '598 patent"). The '598 patent purports to be a division of Application No. 10/791,289, filed on March 3, 2004, now U.S. Patent No. 7,347,011. Thus, the earliest possible effective filing date for purposes of 35 U.S.C. §§ 102(a) and 102(b) is March 3, 2004.

B. Brief Description of the '288 Patent and Summary of the Prosecution History

The '288 patent relates to an article of footwear having a textile upper. (Ex. 1001, 1:19-22). The '288 patent specifically teaches that the upper incorporates a textile element, which may be formed with a knitting machine. (*Id.*, 3:27-29).

The '517 application was filed on September 10, 2010, with claims 1-39.

Original claims 1, 14, 22, 30, and 37 were directed to an article of footwear.

The PTO issued a first Office Action on the merits, rejecting claims 1-39 on the ground of nonstatutory double patenting over claims 1-46 of the '011 patent, and indicated that claims 1-39 would be allowed subject to the filing of a Proper Terminal Disclaimer over claims 1-46 of the '011 patent. (Ex. 1002, 3/4/2011 Office Action, pp. 2-3.) Applicants responded by submitting the necessary Terminal Disclaimer. (Ex. 1002, 3/25/2011 Response.)

The PTO then issued a non-final rejection of claims 1, 2, 7, 9-18, 20, 21, 30, 31, and 35-39 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,701,458 to Ducharme ("Ducharme"), and claims 8 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Ducharme in view of U.S. Patent No. 6,558,784 to Norton ("Norton"). (Ex. 1002, 4/4/2011 Office Action, pp. 2-3.) The Examiner indicated that claims 3-6 and 32-34 were allowable and that claims 22-29 were allowed. (*Id.*, at 3.)

Applicants responded by amending claims 1 and 30 to recite "longitudinal" edges; amending claim 14 to recite that "the upper includes an exterior layer, an intermediate layer, and an interior layer, and the circular-knitted textile element forms at least a portion of the interior layer"; and amending claim 37 to recite the knitted textile element "further having the edges joined together to form a seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper." (Ex. 1002, 5/16/2011 Response, pp. 2-9.) Applicants asserted that Ducharme

lacks a longitudinal seam and that neither Ducharme nor Norton discloses that the circular-knitted textile element forms at least a portion of the interior layer. (*Id.*, at 11-12.)

The Examiner then allowed claims 1-18 and 20-39, now renumbered as claims 1-38. (Ex. 1002, 6/24/2011 Notice of Allowance.) Applicants transmitted the issue fee payment on September 22, 2011, and the '288 patent issued on October 25, 2011. (Ex. 1002, 9/22/2011 Issue Fee Payment.)

IV. CLAIM CONSTRUCTION

A claim subject to *inter partes* review ("IPR") is given its "broadest reasonable construction ["BRI"] in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b). The words of the claim are, thus, given their plain meaning unless that meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Petitioner submits, for the purposes of the IPR only, that the majority of the claim terms are presumed to take on their broadest reasonable interpretation in view of the specification of the '288 patent.

A. "a first area and a second area with a unitary construction" (claim 14)

Claim 14 recites that the textile element includes "a first area and a second area with a unitary construction." As part of the IPR proceedings for the '011 patent, the Board construed this phrase to "require a textile element having a unitary construction *and* having a first area and a second area." *adidas AG v. Nike, Inc.*, IPR2013-00067,

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Paper No. 60, pp. 16-17, 2013 WL 8595550, at *7 (PTAB May 17, 2013). Because the '288 patent shares a common specification with the '011 patent and is a continuation of a division thereof, Petitioner requests that the Board construe the phrase in claim 14 to have the same meaning as its prior construction.

B. "the knitted textile element having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction" (claim 36)

Claim 36 recites "the knitted textile element having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction." As part of the IPR proceedings for the '011 patent, the Board construed this phrase to mean "two textile element areas, each having a unitary construction, but which areas may possess different structures, e.g., knit constructions or stitch configurations, resulting in different properties." *adidas AG v. Nike, Inc.*, IPR2013-00067, Paper No. 18, pp. 16-17, 2013 WL 8595550, at *7 (PTAB May 17, 2013). Because the '288 patent shares a common specification with the '011 patent and is a continuation of a division thereof, Petitioner requests that the Board construe the phrase in claim 36 to have the same meaning as its prior construction.

C. "wide-tube circular knitting machine" (claim 30)

Under the BRI standard, "wide-tube circular knitting machine" should be construed as: "a circular knitting machine with a nominal diameter of 7 inches or larger." The '288 patent uses "wide-tube circular knitting machine" to describe a

Santoni S.p.A. wide-tube circular knitting machine having a diameter that ranges from 10 inches to 20 inches (7:15-21), but provides no other definition or explanation for what is meant by "wide-tube circular knitting machine." The use of "wide-tube circular knitting machine" in the '288 patent is consistent with ISO 8117, an international knitting standard from 2003, which specifies that any circular knitting machine with a nominal diameter of 178 mm (7 inches) or larger is categorized as a large (or wide-tube) circular knitting machine. (Ex. 1003, ¶ 98.)

Petitioner submits that the remaining claim terms should be accorded their ordinary and customary meaning as understood by one of ordinary skill in the art. *See* 77 Fed. Reg. 48700 (2012). Any claim constructions presented either implicitly or explicitly in this proceeding should not be viewed as a concession as to the proper scope of any claim term in any future litigation proceeding.

V. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.104(b), Petitioner respectfully requests cancellation of claims 1-38 based on the following grounds:

Ground	35 U.S.C.	Claims	References
1	103(a)	1-38	Nishida, Reed, Shiomura, and Shepherd
2	103(a)	1-38	Nishida, Castello, Fujiwara, Shiomura, and Shepherd

Below is a discussion of why the challenged claims of the '288 patent are unpatentable under the statutory grounds raised, including claim charts specifying where each element of a challenged claim is met by the prior art. 37 C.F.R.

§ 42.104(b)(4). The showing in these sections establishes a reasonable likelihood of prevailing as to each ground of invalidity with respect to the challenged claims as to that ground. This showing is supported by the Declaration of Lenny Holden ("Holden Decl.") (Ex. 1003).

VI. PERSON OF ORDINARY SKILL IN THE ART AT THE TIME OF THE '288 PATENT

A person of ordinary skill in the art ("POSA") for the '288 patent would have at least a few years of experience in the footwear industry, possibly with a focus in one specific area (such as merchandising, design, product development, commercialization, and/or manufacturing), but would also have a broader understanding of shoemaking in general, as all aspects are so interdependent on each other. A POSA would have an understanding of the product cycle for the process of designing, developing, and bringing a new product to market. He or she would also understand that there are some key review milestones where upper material designs are reviewed and considered, such as textiles, leathers, synthetics, or other types of materials used for upper construction. The POSA would have some understanding and knowledge of the available and varied ranges of typical construction methods within a product cycle. In addition, a POSA would have a basic knowledge of the functional requirements of footwear and a comprehensive understanding of the range of material choices, as well as construction techniques and processes used to create the various parts of a shoe and to assemble them in an effective manner. (Ex. 1003,

¶34.)

VII. CLAIM-BY-CLAIM EXPLANATION OF GROUNDS

As detailed in the claim charts below, through the various identified prior art references or arguments, the majority of which were not before the Examiner during prosecution of the '288 patent and none of which were relied on by the Examiner to reject the claims of the '288 patent, all limitations of claims 1-38 of the '288 patent were well-known in the prior art. Regarding various combinations of prior art, the '288 patent claims merely recite the combination of "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-22 (2007); MPEP § 2143 (A, C).

A. Ground 1: Obviousness of Claims 1-38 in View of Nishida, Reed, Shiomura, and Shepherd.

1. Nishida (Ex. 1009)

Nishida (Ex. 1009) issued on September 13, 1994, before the March 3, 2004 earliest possible priority date claimed by the '288 patent. Nishida thus is prior art under 35 U.S.C. § 102(b). Nishida was never applied or discussed by the Examiner during prosecution, but it was disclosed during prosecution of the '288 patent. Nishida explicitly describes features of claims 1-38 of the '288 patent. Nishida describes an article of footwear, which includes, among other things: an upper incorporating a knitted textile element formed unitarily with a surrounding textile

structure, the knitted textile element being removed from the knitted textile structure, and a sole structure secured to the upper. (Ex. 1009, Abstract; 1:10-18; 1:40-2:5; 2:11-25; 2:34-37; 2:40-47; 3:6-26; 3:43-52; 3:59-4:5; 4:12-18; 4:25-60; 5:10-26; 5:64-65; FIGS. 1-3; Ex. 1003, ¶91, 93, 99-101, 105, 122.)

2. Reed (Ex. 1006)

Reed (Ex. 1006) issued on October 12, 1976, before the March 3, 2004 earliest possible priority date claimed by the '288 patent. Reed thus is prior art under 35 U.S.C. § 102(b). Reed was not cited during prosecution of the '288 patent and explicitly describes features of claims 1-38 of the '288 patent. Reed goes on to describe using a circular-knitting machine to knit one or more textile elements unitarily with a surrounding textile structure, the textile elements located in different portions of the textile structure; removing the textile element(s) from the textile structure; and incorporating the textile element(s) into any type of garment worn by men, women, and children, including stockings and hosiery. (Ex. 1006, Abstract; 1:58-64; 2:14-16; 2:22-31; 3:1-19; 3:58-60; 4:68-5:2; 5:56-57; 5:67-6:5; FIGS. 1, 2A, 2-6; Holden Decl. ¶92, 96-97, 103-104, 106.)

3. Shiomura (Ex. 1013)

Shiomura (Ex. 1013) issued on November 22, 1988, before the March 3, 2004 earliest possible priority date claimed by the '288 patent. Shiomura thus is prior art under 35 U.S.C. § 102(b). Shiomura was never applied or discussed by the Examiner during prosecution, but it was disclosed during prosecution of the '288 patent.

Shiomura explicitly describes features of claims 1-38 of the '288 patent. Shiomura describes an athletic shoe upper formed of an outer knit fabric layer, an inner knit fabric layer parallel to and spaced apart from the outer knit fabric layer, and a number of crossing threads that are interknitted between the outer and inner knit fabric layers. (Ex. 1013, 2:8-9; 2:20-22; 2:27-35; 2:45-54; FIGS. 1-4; Ex. 1003, ¶132-133.)

4. Shepherd (Ex. 1014)

Shepherd (Ex. 1014) has an effective U.S. filing date of July 31, 2003, before the March 3, 2004 earliest possible priority date claimed by the '288 patent. Shepherd thus is prior art under 35 U.S.C. § 102(e). Shepherd was not cited during prosecution of the '288 patent and explicitly describes features of claims 1-38 of the '288 patent. Shepherd describes a spacer fabric with weft knitted front and back layers coupled together by a network of spacer yarns, which are formed on a circular knitting machine. (Ex. 1014, 4:62-5:5; 5:12-18, FIGS. 1-2; Ex. 1003, ¶134-135.)

5. The Combination of Nishida, Reed, Shiomura, and Shepherd

Nishida's explicit statements that a method of producing knitted textiles for shoe uppers can be performed with any "conventional textile process . . . " such as "weaving and/or knitting and/or embroidering" (Ex. 1009, 3:6-9) and that "the use of program-controlled, particularly computer-controlled, production devices is advantageous, so that style, color, design, size or the like can be varied at will" (Ex. 1009, 4:12-18) would have suggested to a POSA at least as of March 3, 2004, that

Nishida's method of making shoes with uppers formed of textile fabrics could be performed with any knitting machine having computerized or programmable single needle selection capabilities. Ex. 1003, ¶154.)

With this understanding, the POSA would have been motivated to form articles of footwear as described in Nishida using Reed's computer-controlled circular knitting machinery and resulting textile element, as such a design choice would have been predictable and well known to a . (Ex. 1003, ¶155.)

The POSA would have found Nishida' process of producing textile elements to be analogous art to Reed's process, as both are directed to methods of simultaneously forming textile elements within a surrounding textile structure using programmable and/or computerized single needle selection technology, removing the textile elements, and incorporating the textile elements into a wearable item. (Ex. 1003, ¶156.) Additionally, both Nishida and Reed are directed to reducing costs associated with producing textile elements using the latest advances in knitting technology. (Ex. 1003, ¶157-158.)

The POSA would have been motivated to look to Shiomura and Shepherd for suggestions regarding knitted textile structures that meet the performance characteristics for athletic shoes. (Ex. 1013, 1:6-9; 1:38-41; Ex. 1003, ¶159.) Shiomura describes providing an athletic shoe upper with a combination of suitable elasticity with high air permeability. (Ex. 1013, 1:6-9; 1:38-41; Ex. 1003, ¶159.) Shepherd describes how to make this multilayered knitted spacer fabric using computer-

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controlled circular knitting machinery. (Ex. 1014, 4:53-7:47; Ex. 1003, ¶159.)

In view of the substantial similarities and overlap between Nishida, Reed, Shiomura, and Shepherd, a POSA would certainly have been motivated to modify Nishida's method to include the additional features described by Reed, Shiomura, and Shepherd to produce a textile element for use in a shoe upper, as well as to produce a shoe incorporating such a textile element, as this is nothing more than combining "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-22 (2007); MPEP § 2143 (A, C); Ex. 1003, ¶160-161.) This is particularly the case where "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 421.

6. Claim-by-Claim Analysis

i. Independent Claim 1

The chart below shows how Nishida and Reed disclose all of the limitations of claim 1, and thus render claim 1 obvious. (Ex. 1003, ¶91-93, 96-97, 99-106, 109-117, 118-119, 122.)

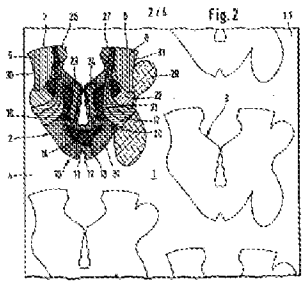
CLAIM	GROUND 1
[1A] An article of footwear comprising:	"This invention relates to a process for the production of a shoe shaped part . . . ." **Nishida**, 1:10-11; *see also* Abstract; 1:65-2:10; 2:26-33; 3:27-42; 4:19-30; 4:43-46; 5:3-26; 5:63-6:2. "Still another object is to provide a method for producing a plurality of garments formed about the circumference of a knitted tube."

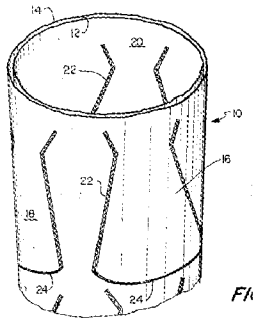
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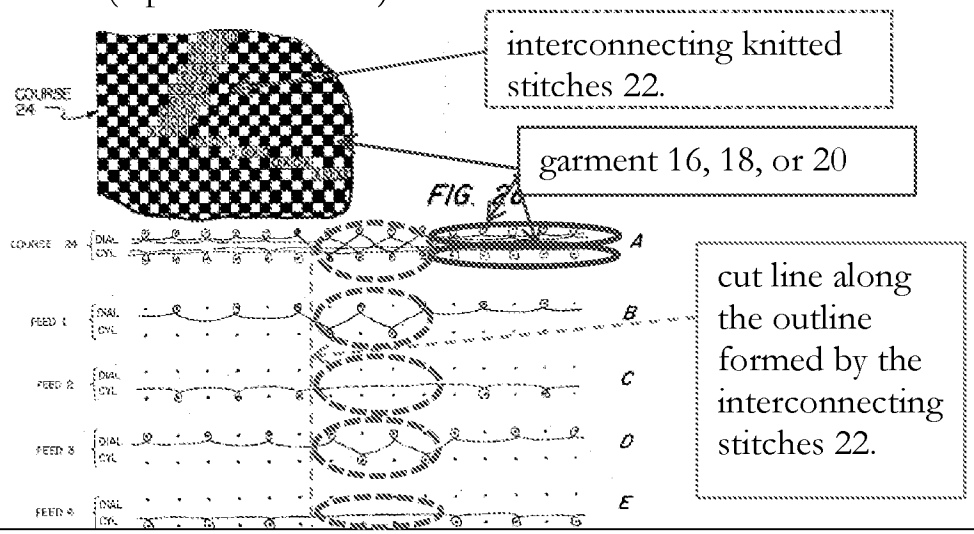
CLAIM	GROUND 1
	Reed, 2:29-31. "The present invention may be used to form all types of garments worn by men, women and children . . . ." **Reed**, 5:56-57.

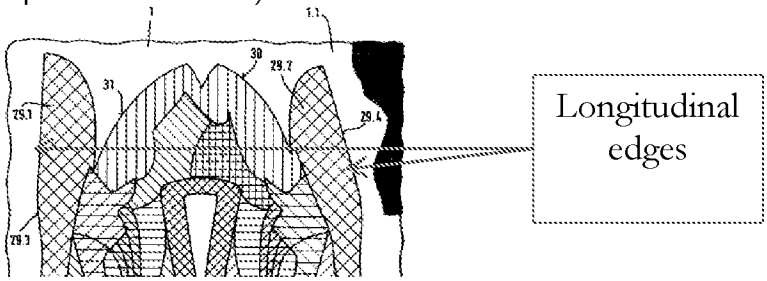
With respect to the [1B] limitation, Nishida states that "in the embodiment according to FIGS. 1 and 2, with layout 2 on the web of material 1, ***areas 26 and 27 are produced in a configuration***, color or style ***that is different from the other areas***." (Ex. 1009, 4:6-9 (emphasis added); Ex. 1003, ¶110-111.) The result is a textile element with multiple knit constructions. Nishida goes on to describe that these varying properties may include a varying elasticity, air permeability, absorptivity, softness, extensibility, wear resistance, and appearance. (Ex. 1003, ¶112-113.)

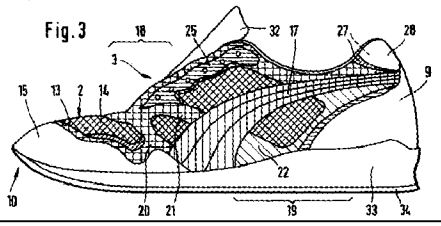
Reed similarly describes a circular-knitted textile element with a plurality of knit constructions in that the edges of the garments 16, 18, 20 are formed by interknitted stitches, whereas the remainder of the garments 16, 18, 20 are formed by non-interknitted stitches. (Ex. 1003, ¶115.) Thus, the garments 16, 18, 20 have a plurality of different knitted textures formed by varying at least one of the stitch type and the yarn type. (Ex. 1003, ¶116.) Reed also describes how the two layers 12, 14 themselves may be formed of different yarns or stitch configurations. (Ex. 1003, ¶117.)

CLAIM	GROUND 1
[1B] an upper incorporating a circular-knitted textile element having a plurality of knit	**Circular-knitted textile element:** "In FIGS. 1 and 2, a web of material is identified by 1, and is produced by a conventional textile process, for example, by weaving and/or knitting and/or embroidering." **Nishida**, 3:6-9; *see also* Abstract; 1:10-18; 1:47-2:5; 2:11-25; 2:40-47; 3:6-26; 3:43-52; 3:59- 

CLAIM	GROUND 1
constructions,	4:5; 4:12-18; 4:47-60; 5:64-65; FIGS. 1, 2 (reproduced at right). "As can be seen, ***any number of layouts 2 in the most varied configurations and/or designs as well as of different sizes can be produced on a single web of material 1***. For this purpose, above all, ***the use of program-controlled, particularly computer-controlled, production devices is advantageous***, so that style, color, design, size or the like can be varied at will." **Nishida**, 4:12-18 (emphasis added); *see also* Abstract; 1:40-2:5; 2:11-2:25; 2:40-54; 3:6-26; 3:43-4:9; 4:11-18; 4:47-55; 5:27-40; 5:45-6:2. "Another object of the present invention is to provide a method of reducing the cost of manufacturing of garments by using the versatility of a ***computerized electronic knitting machine***." **Reed**, 2:22-25 (emphasis added); *see also* 1:58-59; FIGS. 1-6. "The present invention uses an electronic circular double knitting machine programmed to ***simultaneously knit two concentric tubes***, one on the dial set of needles and a second on the cylinder set of needles and additionally programmed to interconnect the two concentric tubes by a knit interlock stitch ***to form the outline of the design of a garment***." **Reed**, 1:58-64 (emphasis added); FIG. 1 (reproduced at right); *see also* 3:5-7; 4:68-5:2.  **<u>Plurality of Knit Constructions:</u>** "Finally, in the embodiment according to FIGS. 1 and 2, with layout 2 on the web of material 1, ***areas 26 and 27 are produced in a configuration***, color or style ***that is different from the other areas***." **Nishida**, 4:6-9 (emphasis added); *see also* Abstract; 1:65-69; 2:40-45; 3:15-26; 3:43-48; 4:12-28; 4:48-55; 5:56-6:2. "[T]he layouts of the shoe upper and sole parts are ***produced by modifying the overall construction of the web of material*** in the locations of the layouts relative to that in portions thereof where the layouts of the shoe upper and the sole parts are not provided, ***using*** one of a ***different*** weaving and ***knitting type*** for the layouts

CLAIM	GROUND 1
	of the shoe upper than is used for producing the sole parts, said weaving and knitting types being matched to differing requirements for materials of the shoe upper and sole part of a shoe in relation to properties thereof including at least one of the properties of absorptivity,***air permeability***, ***softness***, ***extensibility***, wear resistance and appearance." **Nishida**, 6:1-31 (emphasis added); *see also* 5:63-6:2. "The knitted structure of course 24 of FIG. 2 formed by program 1 is illustrated in FIGS. 3A-3E. The inner knitting fabric formed on the dial needles are shown in FIG. 3A above the outer knitted fabric formed on the cylinder needles. Feed 1 (FIG. 3B) knits on dial needles 2, 4, 6, 8, 12, 14, etc. to form alternate stitches on the inner tube with feed 3 (FIG. 3D) on dial needles 1, 3, 5, 7, 9, 11, 13, 15, etc. stitches therebetween. The outer fabric is formed basically from an alternation of the cylinder needles using feeds 2 and 4 (FIGS. 3C and 3E, respectively). ***Interknitted stitches (shown as X's and O's in FIG. 2) are formed by feeds 1 and 3 on needles 7 and 9 and 8 and 10, respectively, as shown in FIGS. 3B and 3D. As can be seen in FIG. 3A, feeds 1 and 3 form part of the outer fabric at interconnecting stitches 7, 8, 9, and 10 of course 24 of FIG. 2***." **Reed**, 5:3-18 (emphasis added); FIGS. 3A-3E. "[O]nce the knitted structure 10 is removed from the knitting machine, the individual garments may be severed by cutting along the outline formed by the interconnecting stitches represented by the X's and O's." **Reed**, 5:67-6:3; *see also* 3:61-4:49; 4:61-64; FIGS. 2, 2A (reproduced below), 3A-3E (reproduced below). 

CLAIM	GROUND 1
[1C] the circular-knitted textile element being removed from a circular-knitted textile structure, and	"This invention relates to a process for the production of a shoe shaped part using a web of material with a plurality of patterns in the form of the layout of a shoe upper, ***cutting out these layouts from the web of material*** and stitching the parts of the shoe upper to a top part, and fastening the related part of the sole to the edge area of the cut-open outside edge of the assigned layout and to a shoe shaped part produced according to this process." **Nishida**, 1:10-18 (emphasis added); *see also* Abstract; 1:65-2:10; 2:20-25; 2:30-33; 3:31-35; 4:31-43. "As indicated previously, once the knitted structure 10 is removed from the knitting machine, ***the individual garments may be servered [sic] by cutting along the outline*** formed by the interconnecting stitches represented by the X's and O's. If desired, the ***fabric may be cut with a hot knife*** so that the edges are fused together to add additional strength to the seams." **Reed**, 5:67-6:5 (emphasis added); *see also* Abstract; 2:14-16; 3:12-19; 5:67-6:5; FIGS. 2, 4-6.
[1D] further having longitudinal edges that are joined together to define at least a portion of a void for receiving a foot; and	"With the embodiment according to FIG. 4, a sole part section 29.1 that extends over the entire length of the sole is provided on outside contour 31 in the approximate form of a half of sole part 29, and a sole part section 29.2 which forms the remainder of sole part 29 is provided on the outside contour 30. Both sole part sections 29.1 and 29.2 complement each other to complete sole part 29. ***In this case, their outside contours 29.3 and 29.4 are connected with one another, for example stitched and/or glued and/or fused or the like, preferably by a longitudinal seam***." **Nishida**, 5:3-13; FIG. 4 (reproduced below).  "[T]he sole part is formed of sole part sections which extend over the entire length of an insole to be formed and which are connected to outside contours of the layout of the shoe upper; and wherein outside edge portions of the sole part sections are fastened together, by producing a lengthwise seam, to form the sole part." **Nishida**, 6:47-54; *see also* 4:22-30; 6:5-41; FIGS. 3-4.

CLAIM	GROUND 1
[1E] a sole structure secured to the upper.	Nishida describes "***stitching parts of the layout*** of the cut-out unit on provided seams ***to form an upper of the shoe shaped part*** . . . ." **Nishida**, 6:36-38 (emphasis added). "Completed shoe upper 3 is then brought into a gluing, injection or casting mold, in which a midsole 33 and an outsole 34 are molded by known measures, as is represented in FIG. 3." **Nishida**, 4:43-46; *see also* Abstract; 1:40-47; 1:50-56; 1:60-2:5; 2:34-37; 2:40-45; 3:6-26; 3:46-48; 3:66-4:1; 4:13-18; 4:25-60; 5:10-26; FIG. 3 (reproduced at right). 

ii. Dependent Claim 2

The chart below shows how Nishida discloses the feature of claim 2, and thus renders claim 2 obvious. (Ex. 1003, ¶123.)

CLAIM	GROUND 1
[2] The article of footwear recited in claim 1, wherein the circular-knitted textile element forms at least a portion of a lateral side, a medial side, and an instep region of the upper.	"The individual parts or areas of shoe upper 3 can be representations of those areas on which a trimming, for example, a part resistant to wear, is applied. For example, ***areas 5 and 6*** are provided for applying ***an inside or outside heel counter 9*** (FIG. 3)." **Nishida**, 3:27-31 (emphasis added). "To reduce wear, a toe cap 15, represented in FIG. 3, can be applied, especially glued and/or stitched, on the front area, adjacent to front edge 13 of ***toe area 14***." **Nishida**, 3:39-42(emphasis added). "Areas 20, 21 and 22, identified in FIG. 3, ***running from instep area 18 to heel area 19*** . . . ." **Nishida**, 3:59-60 (emphasis added). *See also* **Nishida**, 3:15-4:46; 3:59-4:9; 5:3-8; FIGS. 1-5.

iii. Dependent Claims 3 and 31

Dependent claims 3 and 31 recite that "a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper." This limitation is substantially similar to element [1D]. As discussed in Section VII.A.6.i above with respect to element [1D], Nishida describes the features of claims 3 and 31,

and thus renders claims 3 and 31 obvious. (Ex. 1003, ¶118-119.)

iv. Dependent Claims 4 and 32

Claims 4 and 32 recite that "the edges include a pair of second edges that are joined to form a second seam extending along a heel region of the upper." The chart below shows how Nishida discloses the feature of claims 4 and 32, and thus renders claims 4 and 32 obvious. (Ex. 1003, ¶120.)

CLAIM	GROUND 1
[4] The article of footwear recited in claim 3, wherein the edges include a pair of second edges that are joined to form a second seam extending along a heel region of the upper.	"After cutting out layout 2 from the web of material 1, the edges 7 and 8 are stitched together and a heel seam thus is formed. Then, heel counter 9, represented in FIG. 3, is applied, for example, glued and/or stitched, to adjacent areas 5 and 6." **Nishida**, 3:31-36; *see also* 4:9-11; 6:5-41; FIGS. 2, 4.

v. Dependent Claim 5

Dependent claim 5 recites that the "second seam extends vertically." As discussed in Section VII.A.6.iv above, Nishida describes the feature of claim 5, and thus renders claim 5 obvious. (Ex. 1003, ¶120.)

vi. Dependent Claims 6, 22, and 33

Claims 6 and 33 recite that "wherein the edges include at least a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper" Claim 22 similarly recites that the "footwear includes a third seam extending through the forefoot area of the upper." The chart below shows how Nishida

discloses the feature of claims 6, 22, and 33, and thus renders claims 6, 22, and 33 obvious. (Ex. 1003, ¶121.)

CLAIM	GROUND 1
[6] The article of footwear recited in claim 4, wherein the edges include at least a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper.	"According to an advantageous further development of the invention, an individual part 29 in the form of an insole can be co-produced on layout 2 of shoe upper 3. After being cut out, this individual part 29 remains connected with layout 2, and after or during the shaping and fixing of shoe upper 3 from layout 2, part 29 is folded into the plane of the shoe sole and is fastened to the lower edge zone of the shoe upper 3. This lower edge zone is defined in layout 2 by outside contours 30 and 31, and the manner of its fastening can be, in a way known in the art, for example, by gluing, stitching, tacking or the like." **Nishida**, 4:19-30; FIG. 4; *see also* 3:37-42; 6:5-41; FIGS. 2, 4.

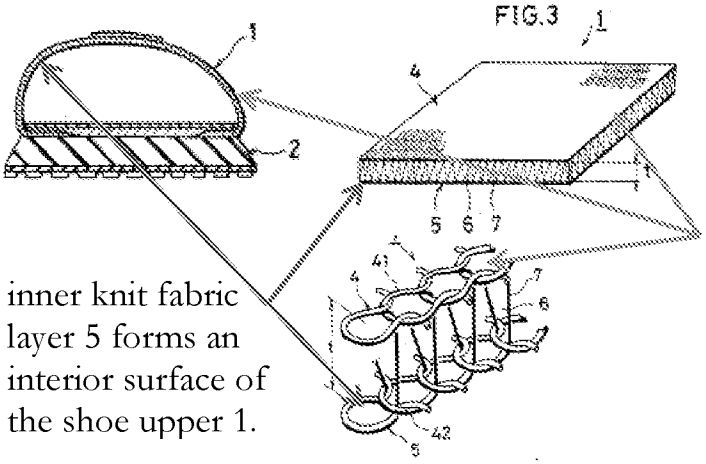
vii. Dependent Claims 7, 18, 26, 34, and 38

Dependent claims 7, 18, 26, 34, and 38 recite that the textile element "is ***one of*** an exterior layer, an intermediate layer, and an interior layer of the upper." The chart below shows how Nishida, Reed, Shiomura, and Shepherd disclose the features of claims 7, 18, 26, 34, and 38, and thus render claims 7, 18, 26, 34, and 38 obvious. (Ex. 1003, ¶126-135.)

First, the '288 patent explains that the only difference between the prior art multi-layered construction described in the Background Art of the '288 patent and the claimed invention is the use of the textile element as the inner layer. ('Ex. 1003, ¶126-128.) It would have been obvious to the POSA to replace the interior (or the exterior) fabric layer of a conventional multi-layered upper with a circular-knitted textile, such as the one collectively described in Nishida and Reed. (Ex. 1003, ¶129.)

Second, Shiomura replaces all three of the conventional upper layers with a new spacer fabric comprising three knitted layers. (Ex. 1003, ¶130-133.) Shepherd describes how the knitted layers of Shiomura may be knitted with a circular knitting machine. (Ex. 1003, ¶134-135.)

CLAIM	GROUND 1
[7] The article of footwear recited in claim 1, wherein the circular-knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	**Conventional Multilayered Upper With Interior Circular-Knitted Textile Layer Substituted in Place of Interior Fabric Layer** "***Areas 20, 21 and 22*** . . . ***can be woven or knitted in two or more layers*** or can be especially thick or additionally embroidered." **Nishida**, 3:59-4:1 (emphasis added); *see also* Abstract; 1:40-2:5; 2:11-2:25; 2:40-54; 3:6-26; 3:43-4:9; 4:11-18; 4:47-55; 5:27-40; 5:45-6:2.) "[T]he outside tube 14 may be a normal decorative fabric ***wherein the inner tube 12 may be formed of a material such as lining***." **Reed**, 3:64-66; (emphasis added). Reed, Abstract; 1:58-64; 2:22-25; 2:29-31; 3:5-7; 3:58-60; 3:67-4:3; 4:68-5:2; FIG. 1. **Multilayered Upper With Spacer Fabric Comprising Multiple Circular-Knit Layers** "As shown in FIGS. 3 and 4, the shoe upper 1 comprises an outer knit fabric layer 4, an inner knit fabric layer 5 provided parallel to the outer knit fabric layer 4 through a space 6, and a number of crossing threads 7 which cross the space 6. The outer knit fabric layer 4 is knitted from a yarn 41 while the inner knit fabric layer 5 is knitted from a yarn 42. The crossing threads 7 are interknitted to be bound into the outer and inner knit fabric layers 4, 5." **Shiomura**, 2:27-35; FIG. 1; FIGS. 2-4 (reproduced below); *see also* 2:20-22; 2:45-54.

CLAIM	GROUND 1
	 inner knit fabric layer 5 forms an interior surface of the shoe upper 1. outer knit fabric layer 4 forms an exterior surface of the shoe upper 1. "Referring to FIGS. 1 and 2 of the accompanying drawings, the weft knitted flat jacquard spacer fabric 10 includes a ***weft knitted jacquard pattern front layer 11*** and a ***weft knitted plain back layer 12*** disposed parallel to one another at a predetermined spacing and coupled together by a network of spacer yarns 13 which are preferably firmer and more resilient than the yarns of the face and back layers." **Shepherd**, 5:12-18 (emphasis added); *see also* 4:62-55; FIGS. 1-2.

viii. Dependent Claim 8

Dependent claim 8 recites that "the upper includes an exterior layer, an intermediate layer, and an interior layer, and the circular-knitted textile element forms at least a portion of the interior layer." As discussed in Section VII.A.6.vii above, the combinations of (1) the conventional three-layered upper described in the '288 patent, Nishida, and Reed, and (2) Shiomura and Shepherd, respectively, describe these features of claim 8, and thus render claim 8 obvious. (Ex. 1003, ¶136-138.)

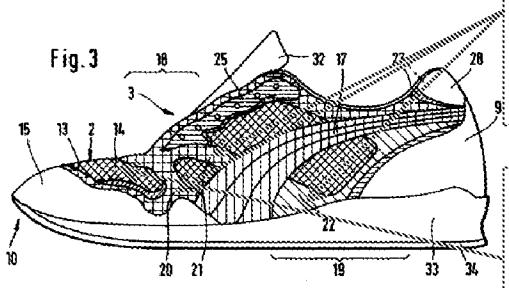
ix. Dependent Claims 9, 19, and 27

Claims 9, 19, and 27 recite that the textile element "forms at least a portion of both an interior surface and an exterior surface of the upper." The chart below shows

how Nishida and Reed disclose the features of claims 9, 19, and 27, and thus render claims 9, 19, and 27 obvious. (Ex. 1003, ¶146-148.)

Nishida describes that portions of the layouts 2 (such as areas 20, 21, 22, and toe area 14) are uncovered in the finished shoe and therefore form at least a portion of the exterior surface of the upper. (Ex. 1003, ¶146.)

Additionally, Reed discloses that the inner tube 12 may be formed as a lining, while the outer tube 12 may be formed as a normal decorative fabric. (Ex. 1003, ¶147.) It would have been obvious to the POSA at least as of March 3, 2004, that modifying Nishida's upper to incorporate the circular-knitted textile element of Reed would result in an upper with at least a portion of an interior surface formed by the inner tube 12 portion of Reed's circular-knitted textile and at least a portion of an exterior surface formed by Reed's circular-knitted outer tube 14 portion. (Ex. 1003, ¶148.)

CLAIM	GROUND 1
[9] The article of footwear recited in claim 1, wherein the circular-knitted textile element forms at least a portion of both an interior surface and an exterior surface of the upper.	**Nishida**, Abstract; 2:11-22; 2:37-39; 2:45-47; 3:6-15; 3:29-36; 3:39-42; 3:59-4:1; 4:9-11; FIG. 3; FIG. 3  Areas 20, 21, 22 of the layout 2 shown in the exterior view of the upper 3. Toe area 14 of the layout 2 shown in the exterior view of the upper 3. "[T]he outside tube 14 may be a normal decorative fabric ***wherein the inner tube 12 may be formed of a material such as lining***." **Reed**, 3:64-66; (emphasis added). Reed, Abstract; 1:58-64;

CLAIM	GROUND 1
	2:22-25; 2:29-31; 3:5-7; 3:58-60; 3:67-4:3; 4:68-5:2; FIG. 1.

x. Dependent Claims 10, 11, 12

Claim 10 recites that "at least one additional element is secured to the exterior surface and forms a portion of the exterior surface." Claim 11 adds that "the additional element secured to a forefoot area of the upper," and claim 12 adds that "the additional element is secured to a heel area of the upper." The chart below shows how Nishida discloses the features of claims 10, 11, and 12, and thus renders claims 10, 11, and 12 obvious. (Ex. 1003, ¶149.)

CLAIM	GROUND 1
[10] The article of footwear recited in claim 9, wherein at least one additional element is secured to the exterior surface and forms a portion of the exterior surface.	"The individual parts or areas of shoe upper 3 can be representations of those areas on which a trimming, for example, a part resistant to wear, is applied. For example, ***areas 5 and 6 are provided for applying*** an inside or ***outside heel counter 9*** (FIG. 3)." **Nishida**, 3:27-29 (emphasis added). "To reduce wear, ***a toe cap 15***, represented in FIG. 3, ***can be applied,*** especially glued and/or stitched, ***on the front area***, adjacent to front edge 13 of ***toe area 14***." **Nishida**, 3:39-42(emphasis added). *See also* **Nishida**, Abstract; 2:11-22; 2:37-39; 2:45-47; 3:6-15; 3:29-36; 3:6-15; 3:29-36; 3:39-42; 3:59-4:1; 4:9-11; FIG. 3.

xi. Dependent Claims 13, 20, and 35

Dependent claims 13, 20, and 35 recite that "the circular-knitted textile element forms an interior surface of the upper." As discussed in Section VII.A.6.vii above, the combinations of (1) the conventional three-layered upper described in the '288 patent, Nishida, and Reed and (2) Shiomura and Shepherd, respectively, describe these features of claims 13, 20, and 35, and thus render claims 13, 20, and 35 obvious. (Ex.

1003, ¶139-141.)

In addition, as described in Section VII.A.6.ix above with respect to claims 9, 19, and 27, Reed discloses that the inner tube 12 may be formed as a lining, while the outer tube 12 may be formed as a normal decorative fabric. (Ex. 1003, ¶142.) It would have been obvious to the POSA at least as of March 3, 2004, that modifying Nishida's upper to incorporate the circular-knitted textile element of Reed would result in an upper with an interior surface formed by the inner tube 12 portion of Reed's circular-knitted textile. (Ex. 1003, ¶142.)

xii. Independent Claim 14

Independent claim 14 is similar to the combination of claims 1 and 8, wherein elements [14A], [14B], and [14E] are substantially identical to elements [1A], [1B], and [1E], respectively, and element [14D] is identical to claim 8.

CLAIM	GROUND 1
[14A] An article of footwear comprising:	***See* Section VII.A.6.i, claim 1A.**
[14B] an upper incorporating a circular-knitted textile element,	***See* Section VII.A.6.i, claim 1B.**

One difference is that [14C] recites a "circular-knitted textile element having a first area and a second area with a unitary construction, the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the circular-knitted textile element, wherein the varying properties are aesthetic or structural." This limitation is substantially similar to "a plurality of knit

constructions" in [1B], particularly in view of the Board's previous BRI construction of "a first area and a second area with a unitary construction" to "require a textile element having a unitary construction *and* having a first area and a second area." (Ex. 1003, ¶91-93, 96-97, 99-106, 109-117, 122, 136-138.)

CLAIM	GROUND 1
[14C] the circular-knitted textile element having a first area and a second area with a unitary construction, the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the circular-knitted textile element, wherein the varying properties are aesthetic or structural,	***See* Section VII.A.6.i, claim 1B.**
[14D] wherein the upper includes an exterior layer, an intermediate layer, and an interior layer, and the circular-knitted textile element forms at least a portion of the interior layer; and	***See* Section VII.A.6.i, claim 8.**
[14E] a sole structure secured to the upper.	***See* Section VII.A.6.i, claim 1E.**

xiii. Dependent Claims 15, 16, 24, 25

Claim 15 recites that "the first stitch configuration provides a substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smoother texture." Claim 16 adds that "the second stitch configuration forms a rib structure in the second area." Claim 24 similarly recites that "the knit constructions produce varying properties in the circular-knitted textile element including a varying elasticity of the circular-knitted textile element." Claim 25 similarly recites that "the knit constructions produce varying properties in the circular-knitted textile element including a varying air permeability of

the circular-knitted textile element."

As discussed in Section VII.A.6.i above with respect to element [1B], Nishida and Reed describe a "textile element having a plurality of knit constructions." (Ex. 1003, ¶109-117.) More specifically, Nishida goes on to describe that these varying properties may include a varying elasticity, air permeability, absorptivity, softness, extensibility, wear resistance, and appearance. (Ex. 1009, 3:43-49; 5:63-6:2; 6:1-31; Ex. 1003, ¶112-113.) Nishida also states that "[l]ayout 2 is divided into different individual parts or areas, which differ from one another, such as by being of another material style and/or by being of different fibers or yarns . . . ." (Ex. 1009, 3:15-25; Ex. 1003, ¶113.)

The chart below shows how Nishida discloses the features of claims 15, 16, 24, and 25, and thus renders claims 15, 16, 24, and 25 obvious. (Ex. 1003, ¶110-113.)

A POSA at least as of March 3, 2004, would have understood Nishida's disclosure regarding a varying softness and the use of fibers or yarns with different textures (i.e., wool and silk) to divide layout 2 into different individual parts or areas to mean that the knit configuration in one area may have a smoother texture than a knit configuration in second area (claim 15). (Ex. 1003, ¶113.) Furthermore, a POSA at least as of March 3, 2004 would have understood Nishida's disclosure regarding a varying extensibility to mean that the knit configuration in the rougher area may have a rib structure (claim 16). (Ex. 1003, ¶113.)

CLAIM	GROUND 1
[15] The article of footwear recited in claim 14, wherein the first stitch configuration provides a substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smoother texture.	***See* Section VII.A.6.i, claim 1B.** "Since, generally, toe area 14 is designed to be relatively deformably ***soft*** or ***elastic***, and optionally, also ***permeable to air***, the web of material 1, in toe area 14, according to the present invention, is correspondingly designed by suitable selection of the weave pattern, ***knit pattern*** and/or the material used, such as, for example, Silk or plastic. The type of production can, additionally, ***insure that the toe area 14 has a good air exchange capability. For example, this can be achieved by a net-like woven or knitted structure."*** **Nishida**, 3:43-52 (emphasis added). "[T]he layouts of the shoe upper and sole parts are ***produced by modifying the overall construction of the web of material*** in the locations of the layouts relative to that in portions thereof where the layouts of the shoe upper and the sole parts are not provided, ***using*** one of a ***different*** weaving and ***knitting type*** for the layouts of the shoe upper than is used for producing the sole parts, said weaving and knitting types being matched to differing requirements for materials of the shoe upper and sole part of a shoe in relation to properties thereof including at least one of the properties of absorptivity, ***air permeability***, ***softness***, ***extensibility***, wear resistance and appearance." **Nishida**, 6:1-31(emphasis added); *see also* 5:63-6:2.

xiv. Dependent Claims 17, 23

Claim 17 recites that "at least one of the first stitch configuration and the second stitch configuration forms an aperture in the circular-knitted textile element." Claim 23 similarly recites that "at least one of the knit constructions forms an aperture in the circular-knitted textile element." The chart below shows how Nishida and Reed disclose the feature of claims 17 and 23, and thus render claims 17 and 23 obvious. (Ex. 1003, ¶150-153.) The '288 patent describes apertures in one of three ways. (Ex. 1003, ¶150.) With respect to the first type of "ankle opening" aperture, Nishida

discloses that the u-shaped area in the layout 2 forms an ankle opening 36 when formed into the shoe upper. (Ex. 1009, FIGS. 1-5.; Ex. 1003, ¶151.)

With respect to the second type of "air-permeability" apertures, Nishida discloses that the "type of production can, additionally, insure that the toe area 14 has a good air exchange capability. For example, this can be achieved by a ***net-like woven or knitted structure***." (Ex. 1009, 3:49-52 (emphasis added); *see also* 3:43-52; 3:66-4:5; 6:25-31; Ex. 1003, ¶152.)

With respect to the third type of "lace hole" apertures, Nishida describes lacing strips that may be layered over the net-like structure to reinforce that structure and holes formed in the lacing strips may be aligned with the existing holes in the net-like structure. (Ex. 1009, 4:1-5.; Ex. 1003, ¶153.)

CLAIM	GROUND 1
[17] The article of footwear recited in claim 14, wherein at least one of the first stitch configuration and the second stitch configuration forms an aperture in the circular-knitted textile element.	Nishida discloses that the u-shaped area in the layout 2 forms an ankle opening 36 when formed into the shoe upper. *See* **Nishida**, FIGS. 1-5. "Since, generally, toe area 14 is designed to be relatively deformably soft or elastic, and optionally, also permeable to air, the web of material 1, in toe area 14, according to the present invention, is correspondingly designed by suitable selection of the weave pattern, knit pattern and/or the material used, such as, for example, Silk or plastic. The type of production can, additionally, insure that the toe area 14 has a good air exchange capability. **For example, this can be achieved by a net-like woven or knitted structure**." **Nishida**, 3:43-52 (emphasis added); *see also* 3:66-4:5; 6:25-31. Nishida also describes lacing strips that may be layered over the net-like structure to reinforce that structure and holes formed in the lacing strips may be aligned with the existing holes in the net-

CLAIM	GROUND 1
	like structure. **Nishida**, 4:1-5.

xv. Independent Claim 21

Independent claim 21 is substantially similar to the combination of claims 1, 3, and 4, wherein elements [21A], [21B], [21C], and [21E] are substantially identical to elements [1A], [1B], [1D], and [1E], and element [14D] is the same as claims 3, 4, and 5. (Ex. 1003, ¶91-93, 96-97, 99-104, 109-117, 118-120, 122.)

CLAIM	GROUND 1
[21A] An article of footwear comprising:	***See* Section VII.A.6.i, claim 1A.**
[21B] an upper incorporating a circular-knitted textile element having a plurality of knit constructions, and	***See* Section VII.A.6.i, claim 1B.**
[21C] further having edges that are joined together to form seams and define at least one portion of a void for receiving a foot,	***See* Section VII.A.6.i, claim 1D.**
[21D] the seams including a first seam and a second seam, the first seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper, and the second seam extending vertically in the heel area; and	***See* Sections VII.A.6.iii, claim 3, VII.A.6.iv, claim 4, and VII.A.6.v, claim 5.**
[21E] a sole structure secured to the upper.	***See* Section VII.A.6.i, claim 1E.**

xvi. Dependent Claim 28

Dependent claim 28 recites that "the circular-knitted textile element forms an interior surface of the upper, and at least one additional textile element form an exterior surface of the footwear." As discussed in Section VII.A.6.vii above, the (1) conventional three-layered upper described in the '288 patent, Nishida, and Reed and (2) Shiomura and Shepherd, respectively, describe these features of claim 28, and thus render claim 28 obvious. (Ex. 1003, ¶143-145.)

xvii. Independent Claim 29

Independent claim 29 is substantially similar to claim 1, wherein elements [29A], [29B], [29D], [29F], and [29G] are identical to elements [1A], [1B], [1C], [1D], and [1E], respectively.

CLAIM	GROUND 1
[29A] An article of footwear comprising:	***See* Section VII.A.6.i, claim 1A.**
[29B] an upper incorporating a circular-knitted textile element having a plurality of knit constructions,	***See* Section VII.A.6.i, claim 1B.**

One difference is that [29C] recites that "the circular-knitted textile element is formed with a knitting machine." However, as described in Section VII.A.6.i above, Nishida and Reed both describe the use of knitting machines to form the textile elements extensively. (Ex. 1003, ¶93, 96-97, 99-104.)

CLAIM	GROUND 1
[29C] wherein the circular-knitted textile element is formed with a knitting machine,	***See* Section VII.A.6.i, claim 1B.**
[29D] the circular-knitted element being removed from a circular-knitted textile structure	***See* Section VII.A.6.i, claim 1C.**

In addition, [29E] recites an "outline of the circular-knitted textile element."

CLAIM	GROUND 1
[29E] that includes an outline of the circular-knitted textile element	"[I]n the production of a web of material, both ***the patterns or partial patterns in the form of layouts of the shoe upper*** and the patterns or partial patterns in the form of a sole part, ***are produced by*** a fabric printing process (which is generally well known in the textile industry) on the web of material and/or by ***a textile production process inside the web of material***. . . ." **Nishida**, 1:50-56 (emphasis added); *see also* Abstract; 1:10-18; 1:40-47; 1:50-2:47; 4:13-18; 4:47-60;

CLAIM	GROUND 1
	5:63-6:2; FIGS. 1-2. "The garments 16, 18 and 20 are ***outlined*** by a plurality of interconnecting knitted stitches 22 and 24." **Reed**, 3:8-9 (emphasis added). "The outline seam 24 is formed from two sets of X's and O's which are offset in the wale axes by four wales. The degree of wale offset ***to form the desired outline*** is a matter of design and thus not critical." **Reed**, 4:42-45 (emphasis added); *see also* 5:67-6:3 (emphasis added).
[29F] having longitudinal edges that are joined together to define at least a portion of a void for receiving a foot; and	***See* Section VII.A.6.i, claim 1D.**
[29G] a sole structure secured to the upper.	***See* Section VII.A.6.i, claim 1E.**

xviii. Dependent Claim 30

As described in Section VII.A.6.xvii above, claim 29 is rendered obvious by Nishida and Reed. Claim 30 adds a product-by-process limitation that should not receive patentable weight. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe,* 777 F.2d 695, 698 (Fed. Cir. 1985) (citations omitted); MPEP § 2113. The chart below shows how Reed discloses the feature of claim 30, and thus renders claim 30 obvious. (Ex. 1003, ¶98.)

Reed identifies "[a]n example of a ***circular knitting machine*** which will produce knitted structure 10 is Model 9RJ36 made by Wildt, Mellor, Bromley, Ltd. of Leicester, England." (Ex. 1006, 3:58-60.) As Mr. Holden explains, Reed uses his

knitting machine and technique to make a plurality of "skirts 16, 18, and 20" "[a]round the circumference of the knitted structure 10." (Ex. 1006, 3:5-7; Ex. 1003, ¶98.) That fact alone would inform a POSA at least as of March 3, 2004, that the circumference of the circular knitted tube must be at least large enough to accommodate the width of three skirts, and would certainly require a circumference larger than 22 inches. (Ex. 1003, ¶98.) The POSA would also have understood that a circular knitting machine having a circumference of at least 22 inches (i.e., a nominal diameter of at least 7 inches) is a wide-tube circular knitting machine. (Ex. 1003, ¶98.)

Hence, the POSA would thus have recognized that wide-tube circular knitting machines were used to make Reed's garments and would understand that the Model 9RJ36 was one such example. (Ex. 1003, ¶98.) Indeed, the POSA at least as of March 3, 2004, would have been aware of the 9RJ36, and would have known that it had a diameter of 30 inches, as evidenced by Burall (Ex. 1011). (Ex. 1003, ¶98.)

CLAIM	GROUND 1
[30] The article of footwear recited in claim 29, wherein the circular-knitted textile element has a structure formed by a wide-tube circular knitting machine.	"An example of a ***circular knitting machine*** which will produce knitted structure 10 is Model 9RJ36 made by Wildt, Mellor, Bromley, Ltd. of Leicester, England." **Reed**, 3:58-60 (emphasis added); *see also* Abstract; 1:58-64. "Around the circumference of the knitted structure 10 are illustrated three garments which, for example, may be skirts 16, 18, 20." **Reed**, 3:5-7; FIGS. 1-2.

xix. Independent Claim 36

Independent claim 36 is substantially similar to claims 1, 4, and [29E], wherein elements [36A], [36B], [36D], and [36H] are substantially similar to elements [1A], [1B], [1C], and [1E], respectively, [36E] is substantially similar to [29E]; and [36G] is substantially similar to claim 4.

CLAIM	GROUND 1
[36A] An article of footwear comprising:	***See* Section VII.A.6.i, claim 1A.**
[36B] an upper incorporating a knitted textile element,	***See* Section VII.A.6.i, claim 1B.**

One difference is that [36C] recites that "the knitted textile element is formed unitarily with a knitted textile structure." However, as described in Section VII.A.6.i above, Nishida and Reed both describe forming textile elements unitarily with a knitted textile structure. (Ex. 1003, ¶99-104.)

CLAIM	GROUND 1
[36C] wherein the knitted textile element is formed unitarily with a knitted textile structure,	***See* Section VII.A.6.i, claim 1B.**
[36D] the knitted textile element being removed from the knitted textile structure	***See* Section VII.A.6.i, claim 1C.**
[36E] that includes an outline of the knitted textile element to form edges,	***See* Section VII.A.6.xvii, claim 29E.**

In addition, [36F] recites a "circular-knitted textile element having a first area and a second area with a unitary construction, the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the circular-knitted textile element, wherein the varying properties are

aesthetic or structural." This limitation is substantially similar to "a plurality of knit constructions" in [1B], particularly in view of the Board's previous BRI construction of "a first area and a second area with a unitary construction" to "require a textile element having a unitary construction *and* having a first area and a second area."

CLAIM	GROUND 1
[36F] the knitted textile element having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction, the first area having a first set of properties, and the second area having a second set of properties that is different from the first set of properties to impart varying characteristics to the textile element,	***See* Section VII.A.6.i, claim 1B.**
[36G] and further having the edges joined together to form a seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper; and	***See* Section VII.A.6.iv, claim 4.**
[36H] a sole structure secured to the upper.	***See* Section VII.A.6.i, claim 1E.**

xx. Dependent Claim 37

As discussed in Section VII.A.6.i above with respect to [1B], Nishida and Reed describe that "the first set of properties and the second set of properties are at least one of a stitch configuration and a yarn type." (Ex. 1003, ¶109-117.)

B. Ground 2: Obviousness of Claims 1-38 in View of Nishida, Castello, Fujiwara, Shiomura, and Shepherd.

1. Nishida (Ex. 1009)

See Section VII.A.1 above. (Ex. 1003, ¶171, 174, 180-181, 187, 208.)

2. Castello (Ex. 1007)

Castello (Ex. 1007) issued on August 2, 1977, before the March 3, 2004 earliest possible priority date claimed by the '288 patent. Castello thus is prior art under 35

U.S.C. § 102(b). Castello was not cited during prosecution of the '288 patent and explicitly describes features of claims 1-38 of the '288 patent. Castello explains that with the advent of single needle selection that is controlled with programmable patterns, a variety of features can be combined on a single circular machine and knit simultaneously. (Castello (Ex. 1007), 1:39-53; 2:12-21; 3:35-44.) (Ex. 1003, ¶66, 176.) Castello describes using a circular-knitting machine to knit one or more textile elements unitarily with a surrounding textile structure, the textile elements located in different portions of the textile structure; removing the textile element(s) from the textile structure; and incorporating the textile element(s) into shirts worn by men, women, and children. (Ex. 1007, Abstract; 1:35-2:21; 2:42-52; 3:34-5:44; 6:35-58; 7:1-9; 7:23-25; 8:17-19; FIGS. 1, 2A, 2-5; Ex. 1003, ¶172, 176, 183-184, 188.)

3. Fujiwara (Ex. 1008)

Fujiwara (Ex. 1008) issued on December 18, 2001, before the March 3, 2004 earliest possible priority date claimed by the '288 patent. Fujiwara thus is prior art under 35 U.S.C. § 102(b). Fujiwara was not cited during prosecution of the '288 patent and explicitly describes features of claims 1-38 of the '288 patent

Fujiwara likewise describes using a circular-knitting machine to knit one or more textile elements unitarily with a surrounding textile structure, the textile elements located in different portions of the textile structure; removing the textile element(s) from the textile structure; and incorporating the textile element(s) into garments worn by men, women, and children. (Ex. 1008, 1:58-3:18; 3:45-48; 3:59-5:11;

5:42-6:62; 7:21-37; FIGS. 1, 4, 6, 7; Ex. 1003, ¶173, 177, 185-186, 189.)

4. Shiomura (Ex. 1013)

See Section VII.A.3 above. (Ex. 1003, ¶218-219.)

5. Shepherd (Ex. 1014)

Shepherd is described in Section VII.A.4 above. (Ex. 1003, ¶220-221.)

6. The Combination of Nishida, Castello, Fujiwara, Shiomura, and Shepherd

Nishida's explicit statements that a method of producing knitted textiles for shoe uppers can be performed with any "conventional textile process . . . " such as "weaving and/or knitting and/or embroidering" (Ex. 1009, 3:6-9) and that "the use of program-controlled, particularly computer-controlled, production devices is advantageous, so that style, color, design, size or the like can be varied at will" (Ex. 1009, 4:12-18) would have suggested to a POSA at least as of March 3, 2004 that Nishida's method of making shoes with uppers formed of textile fabrics could be performed with any knitting machine having computerized or programmable single needle selection capabilities. (Ex. 1003, ¶245.)

With this understanding, the POSA would have been motivated to form articles of footwear as described in Nishida using Castello's program-controlled circular knitting machinery and resulting textile element, as well as Fujiwara's circular knitting machinery with "computer controlled pattern control mechanism" and resulting textile element, as such a design choice would have been predictable and well known to a POSA. (Ex. 1003, ¶246.)

The POSA would have found Nishida's process of producing textile elements to be analogous art to Castello's and Fujiwara's processes, as all three processes are directed to methods of simultaneously forming textile elements within a surrounding textile structure using programmable and/or computerized single needle selection technology, removing the textile elements, and incorporating the textile elements into a wearable item. (Ex. 1003, ¶247.)

Additionally, Nishida, Castello, and Fujiwara are all directed to reducing costs associated with producing textile elements using the latest advances in knitting technology of the time of each reference. (Ex. 1003, ¶248-250.) Castello's method provides that "[t]he present invention resides in a novel method of fabricating knitted collars on circular knitting machines which results in a far greater production capability at resulting cost savings over that presently possible on flat machines." (Ex. 1003, ¶248.) Fujiwara also identifies that "sewing is a bottleneck from the view point of increase in an production efficiency as well as of decrease in a production cost" such that "there has heretofore been a strong requirement as to a development in a garment making by which any sewing is not necessary." (Ex. 1003, ¶249.) Nishida likewise states that a "process is used by which such shoe uppers can be produced in a timesaving and efficient manner" with "only a small number of individual parts that have to be produced separately and applied to the upper later" over conventional methods that generate expensive cutting waste. (Ex. 1003, ¶250.) The POSA would have found that Castello, Nishida, and Fujiwara are directed to solving a similar

problem: expensive and time consuming production of textile components. (Ex. 1003, ¶250.)

The POSA would also have been motivated to look to Shiomura and Shepherd for suggestions regarding knitted textile structures that meet the performance characteristics for athletic shoes. (Ex. 1013, 1:6-9; 1:38-41; Ex. 1003, ¶251.) Shiomura describes providing an athletic shoe upper with a combination of suitable elasticity with high air permeability. (Ex. 1013, 1:6-9; 1:38-41; Ex. 1003, ¶251.) Shepherd describes how to make this multilayered knitted spacer fabric using computer-controlled circular knitting machinery. (Ex. 1014, 4:53-7:47; Ex. 1003, ¶251.)

In view of the substantial similarities and overlap between Nishida, Castello, Fujiwara, Shiomura, and Shepherd, a POSA would certainly have been motivated to modify Nishida's method to include the additional features described by Castello, Fujiwara, Shiomura, and Shepherd to produce a textile element for use in a shoe upper, as well as to produce a shoe incorporating such a textile element, as this is nothing more than combining "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-22 (2007); MPEP § 2143 (A, C); Ex. 1003, ¶252-253.) This is particularly the case where "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 421.

7. Claim-by-Claim Analysis

i. Independent Claim 1

The chart below shows how Nishida, Castello, and Fujiwara disclose all of the limitations of claim 1, and thus render claim 1 obvious. (Ex. 1003, ¶171-174, 176-177, 180-189, 193-203, 204-205, 208.)

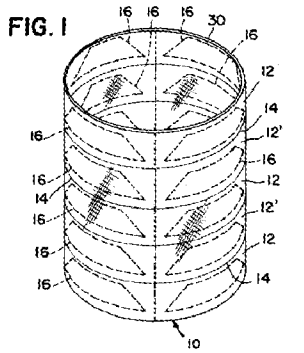
CLAIM	GROUND 2
[1A] An article of footwear comprising:	***See* Section VII.A.6.i, claim 1A regarding Nishida.** "The present invention resides in a novel method of fabricating knitted collars on circular knitting machines . . . ." **Castello**, 1:39-40; *see also* Abstract; 1:35-2:4; 3:34-4:10; 4:22-5:44; 6:35-58; 7:1-5; FIGS. 1, 2A, 2-5. "FIG. 1 illustrates schematically a formation of a circular knitted fabric as a first embodiment of the present invention, from which fabric a garment such as a sweater is obtained without necessitating any subsequent sewing process." **Fujiwara,** 3:45-48; *see also* 1:58-3:18; 3:59-4:65.

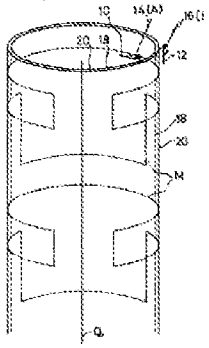
With respect to the [1B] limitation, as discussed in Section VII.A.6.i above, Nishida describes the features of [1B]. (Ex. 1003, ¶194-197.)

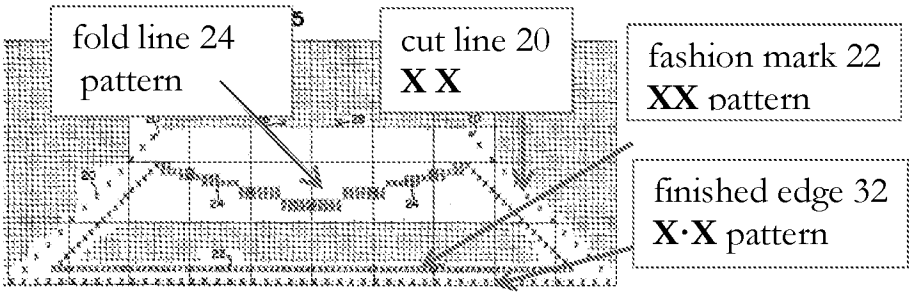
Castello additionally describes that "[a]s illustrated in the graph 18 (FIG. 5), the collars 16 may be knitted with "an integral knitted fold crease 24, knitted sewing guide marks 26, 28, mock fashion marks 22 and any desired Jacquard color designs (not illustrated) . . . . ***The fashion marks 22 may be knitted in conventional manner spaced apart in any desired stitch pattern, such as by Jacquard patterns***." (Ex. 1007, 4:23-32; *see also* 3:51-58; 4:32-33; 5:35-44; FIG. 5; Ex. 1003, ¶198-199.) Castello also points out that "the top and bottom edges 30, 32 of each layer 12, 12' are finished . . . ." (Ex. 1007, 4:4-10; *see also* 1:43-49; 1:54-68; 2:12-21; 2:42-52; 3:34-58; 4:34-5:7;

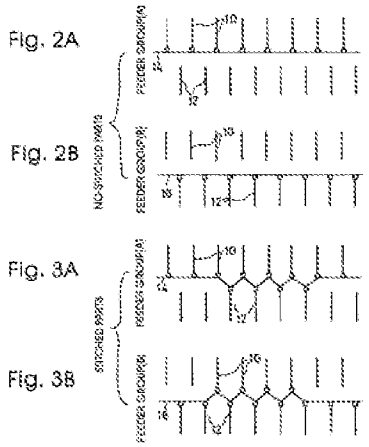
5:13-17; FIG. 5; Ex. 1003, ¶200-201.) These different stitch configurations around the collar 16 are illustrated in guide 18 (FIG. 5). (Ex. 1007, FIG. 5; Ex. 1003, ¶202.)

Fujiwara describes that the outline M of the garment is formed with interknitted stitches (as shown in FIGS. 3A and 3B), and that these interknitted stitches may be a jacquard, birds eye, eyelet, ***circular rib***, or interlock stitch configuration, whereas the non-interknitted portions of each layers 18, 20 comprises a ***plain stitch configuration***. (Ex. 1008, 5:42-56; 5:57-6:7; 7:21-24; Ex. 1003, ¶203.)

CLAIM	GROUND 2
[1B] an upper incorporating a circular-knitted textile element having a plurality of knit constructions,	**Circular-knitted textile element:** ***See* Section VII.A.6.i, claim 1B regarding Nishida.** "In utilizing the method of the present invention, circular machines having either Jacquard cards, or pattern wheels or drums or any other known suitable mechanical means of needle selection can be used. For purposes of illustration, a Jacquard type machine with cards, such as a TJI or Links and Links machine will be described." **Castello**, 1:43-49. "After a suitable sketch has been prepared on the graph paper showing the desired collar shape, design, color, mock fashion marks, etc., knitting machine cards (or some equivalent system) are then punched or otherwise prepared in conventional manner and set up on the machine to thereby automatically control the machine stitches to knit the tubular cloth 10 with the layers 12, 12', the separating threads 14 and the collar construction 16 knitted therein." **Castello**, 3:59-67; *see also* 3:34-45; 3:68-4:55; 5:18-44; FIG. 1 (reproduced at right); FIG. 2.  "In other words, it is desirable that the circular knitting machine is the one that, at each thread feeding position, is provided with a computer controlled pattern control mechanism. Namely, for

CLAIM	GROUND 2
	practicing the present invention, it is desirable that the circular knitting machine is of a so-called double knitting type by which an independent needle selection control is obtained at each thread feeder not only for the cylinder needles but also for the dial needles. Such a type of a circular knitting machine is, for example, available from Fukuhara Industrial Trading Co., Ltd., Osaka, Japan under the trade name of V-LEC4D." **Fujiwara**, 4:12-21. "According to the present invention, the circular knitted fabric is constructed by an inner and outer layers, which are separate with each other and which are knitted by the dial and cylinder needles, respectively. The inner and outer layers are, along an outline of an article or a garment, connected with each other by using a stitching construction using both of the dial and cylinder needles." **Fujiwara**, 2:31-37; *see also* 1:58-3:18; 4:66-5:7; FIGS. 1, 4 (reproduced below); FIGS. 6, 7.  **<u>Plurality of Knit Constructions:</u>** ***See* Section VII.A.6.i, claim 1B regarding Nishida.** "[A]s seen in FIG. 5, a graph 18 is first laid out in accordance with practices well known to those skilled in the art to show features such as peripheral knitted cutting guide lines 20, knitted fashion marks 22, knitted neck fold lines 24 and knitted guide marks 26, 28. The guide marks 26, 28 serve as guides to aid sewing machine operators when the collar is being affixed to the remainder of the garment." **Castello**, 3:51-58; FIG. 5 (reproduced below). "[A] collar construction 16 can be produced on a single circular knitting machine having an integral knitted fold crease 24, knitted sewing guide marks 26, 28, mock fashion marks 22 and any desired Jacquard color designs (not illustrated) . . . . ***The fashion marks 22 may be knitted in conventional manner spaced apart in any desired stitch pattern, such as by Jacquard patterns***. The fashion marks 22 may be knit continuously about the periphery of the collar." **Castello**, 4:23-33 (emphasis added); FIG. 5. "[M]ore or fewer fashion marks 22 can be provided, ***more or fewer collar***

CLAIM	GROUND 2
	fold marks 24 (knitted as reversed jersey) can be knit, ***more or fewer stripes, various colors, patterns (not illustrated)*** can be programmed into the circular knitting machine." **Castello**, 5:35-44 (emphasis added); FIG. 5. "[T]he top and bottom edges 30, 32 of each layer 12, 12' are finished, knitted edges which remain after separation of the layers by pulling the draw threads 14 and can serve as the top and bottom edges respectively, 30', 32' of each individual collar 16 without further sewing or other operations." **Castello**, 4:4-10; FIG. 5. "[C]ircular neck fold line 24 of jersey stitches . . . create[s] a collar that lays naturally on the back of the neck without 'hiking' up or down to thereby enhance the beauty and utility of the collar. The fold 24 remains permanent even after washing or dry cleaning inasmuch as it is knitted directly into the fabric and thus reduces pressing costs in the finished garment." **Castello**, 4:53-63; *see also* 1:43-49; 1:54-68; 2:12-21; 2:42-52; 3:34-58; 4:34-5:7; 5:13-17.  "FIGS. 2A and 2B illustrate, in a course direction, schematically, knitting diagrams at yarn feeders in groups A and B, respectively at the non-stitched part of the fabric. At the yarn feeder in the group A in FIG. 2A, . . . the ***fabric is of basically a plain stitch***, wherein the cylinder needle 12 does not take part in knitting operation. Similarly, at the yarn feeder in the group B in FIG. 2B, . . .***the fabric is, also, of basically a plain stitch*** (tenjiku), wherein the cylinder needle 10 does not take part in knitting operation. Thus***, a separate structure is obtained between the inner and outer layers 18 and 20***." **Fujiwara,** 5:42-56 (emphasis added) FIGS. 2A, 2B (reproduced below). "FIGS. 3A and 3B illustrate schematically in a course direction knitting diagrams at yarn feeders in groups A and B, respectively at the stitched part of the fabric. At the yarn feeder in the group A, . .

CLAIM	GROUND 2
	. ***the integrated fabric is of a so-called rib stitch*** in a rib stitch arrangement between the dial and cylinder needles 10 and 12. However, in a jacquard arrangement (not shown) of the dial and cylinder needles 10 and 12, ***it is possible that another desired stitching, such as birds eye, eyelet, circular rib or interlock may be employed***. **Fujiwara**, 5:57-6:1 (emphasis added); FIGS. 3A, 3B (reproduced at right); *see also* 6:2-7; 6:43-62. 
[1C] the circular-knitted textile element being removed from a circular-knitted textile structure, and	***See* Section VII.A.6.i, claim 1C regarding Nishida.** "After the tubular cloth 10 has been knit by the machine (not shown), the draw threads 14 are pulled to separate the cloth into a plurality of individual layers 12, 12'. The layers are then cut along the knitted cut guide lines 20 to produce a plurality of individual collars 16, each having cut sides 38, 40." **Castello**, 3:67-4:4; *see also* 4:38-45; 4:67-5:17. "As a result, when the fabric is cut outwardly along the outline while the stitched parts are at least partially left, a garment can be obtained, which has a front and back bodies, which are connected along the outline M." **Fujiwara**, 5:7-11; *see also* 1:58-3:18; 6:12-42; 7:21-37.
[1D] further having longitudinal edges that are joined together to define at least a portion of a void for receiving a foot; and	***See* Section VII.A.6.i, claim 1D regarding Nishida.**
[1E] a sole structure	***See* Section VII.A.6.i, claim 1E.**

CLAIM	GROUND 2
secured to the upper.	

ii. Dependent Claim 2

See Section 0 above. (Ex. 1003, ¶209.)

iii. Dependent Claims 3 and 31

See Section VII.A.6.iii above. (Ex. 1003, ¶204-205.)

iv. Dependent Claims 4 and 32

See Section VII.A.6.iv above. (Ex. 1003, ¶206.)

v. Dependent Claim 5

See Section VII.A.6.v above. (Ex. 1003, ¶206.)

vi. Dependent Claims 6, 22, and 33

See Section VII.A.6.vi above. (Ex. 1003, ¶207.)

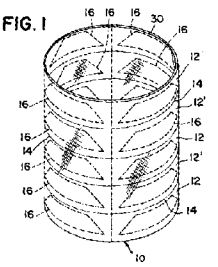
vii. Dependent Claims 7, 18, 26, 34, and 38

Dependent claims 7, 18, 26, 34, and 38 recite that the textile element "is ***one of*** an exterior layer, an intermediate layer, and an interior layer of the upper." The chart below shows how Nishida, Castello, Fujiwara, Shiomura, and Shepherd disclose the features of claims 7, 18, 26, 34, and 38, and thus render claims 7, 18, 26, 34, and 38 obvious. (Ex. 1003, ¶212-221.)

As discussed in Section VII.A.6.vii above, the '288 patent explains that the only difference between the well-known prior art multi-layered construction described in the Background Art of the '288 patent and the claimed invention is the use of the textile element as the inner layer. (Ex. 1003, ¶212-214.) It would have been obvious to the POSA at least as of March 3, 2004, to replace the interior (or the exterior) fabric

layer of a conventional multi-layered upper with a circular-knitted textile, such as the one collectively described in Nishida and Castello. (Ex. 1003, ¶215.)

As discussed in Section VII.A.6.vii above, Shiomura and Shepherd collectively describe a multilayered upper with spacer fabric comprising multiple circular-knit layers, in which an inner circular-knit fabric layer 5 forms an interior surface of the upper. (Ex. 1003, ¶216-221.)

CLAIM	GROUND 2
[7] The article of footwear recited in claim 1, wherein the circular-knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	**Conventional Multilayered Upper With Interior Circular-Knitted Textile Layer Substituted in Place of Interior Fabric Layer** "***Areas 20, 21 and 22*** **. . . *can be woven or knitted in two or more layers*** or can be especially thick or additionally embroidered." **Nishida**, 3:59-4:1 (emphasis added); *see also* Abstract; 1:40-2:5; 2:11-2:25; 2:40-54; 3:6-26; 3:43-4:9; 4:11-18; 4:47-55; 5:27-40; 5:45-6:2.) Castello describes that the collars are knitted as single layers so that the same layer forms the interior and exterior surface. *See* **Castello**, FIG. 1 (reproduced at right).  **Multilayered Upper With Spacer Fabric Comprising Multiple Circular-Knit Layers** ***See* Section VII.A.6.vii, claim 7 regarding Shiomura and Shepherd.**

viii. Dependent Claim 8

Dependent claim 8 recites that "the upper includes an exterior layer, an intermediate layer, and an interior layer, and the circular-knitted textile element forms at least a portion of the interior layer." As discussed in Section VII.B.7.vii above, the

combinations of (1) the conventional three-layered upper described in the '288 patent, Nishida, and Castello, and (2) Shiomura and Shepherd, respectively, describe these features of claim 8, and thus render claim 8 obvious. (Ex. 1003, ¶222-225.)

ix. Dependent Claims 9, 19, and 27

See Section VII.A.6.ix above regarding Nishida. (Ex. 1003, ¶234.)

As discussed in Section VII.B.7.i above, Castello additionally describes that the collars are knitted as single layers so that the same layer forms the interior and exterior surface when combined with Nishida's upper. (*See* Castello, FIG. 1 (showing that the collars are visible in the layer from both the outside and inside views); Ex. 1003, ¶235.) It would have been obvious to the POSA at least as of March 3, 2004, that modifying Nishida's upper to incorporate the circular-knitted textile element of Castello would result in an upper having at least a portion of an interior surface and at least a portion of an exterior surface formed by Castello's circular-knitted textile. (Ex. 1003, ¶236.)

x. Dependent Claims 10, 11, 12

See Section VII.A.6.x above. (Ex. 1003, ¶237.)

xi. Dependent Claims 13, 20, and 35

Dependent claims 13, 20, and 35 recite that "the circular-knitted textile element forms an interior surface of the upper." As discussed in Section VII.B.7.vii above, the combinations of (1) the conventional three-layered upper described in the '288 patent, Nishida, and Castello and (2) Shiomura and Shepherd, respectively, describe these

features of claims 13, 20, and 35, and thus render claims 13, 20, and 35 obvious. (Ex. 1003, ¶226-228.)

As discussed in Section VII.B.7.ix above, Castello describes that the collars are knitted as single layers so that the same layer forms the interior and exterior surface. (*See* Castello, FIG. 1; Ex. 1003, ¶229.)

It would have been obvious to the POSA at least as of March 3, 2004, that modifying Nishida's upper to incorporate the circular-knitted textile element of Castello would result in an upper having an interior surface formed by Castello's circular-knitted textile. (Ex. 1003, ¶230.)

xii. Independent Claim 14

As discussed in Section VII.A.6.xii above, independent claim 14 is similar to the combination of claims 1 and 8. The chart below shows how Nishida, Castello, Fujiwara, Shiomura, and Shepherd disclose the features of claim 14, and thus render claim 14 obvious. (Ex. 1003, ¶171-174, 176-177, 180-189, 193-203, 208, 222-225.)

CLAIM	GROUND 2
[14A] An article of footwear comprising:	***See* Section VII.B.7.i, claim 1A.**
[14B] an upper incorporating a circular-knitted textile element,	***See* Section VII.B.7.i, claim 1B.**
[14C] the circular-knitted textile element having a first area and a second area with a unitary construction, the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the circular-knitted textile element, wherein the varying	***See* Section VII.B.7.i, claim 1B.**

CLAIM	GROUND 2
properties are aesthetic or structural,	
[14D] wherein the upper includes an exterior layer, an intermediate layer, and an interior layer, and the circular-knitted textile element forms at least a portion of the interior layer; and	***See* Section VII.B.7.viii, claim 8.**
[14E] a sole structure secured to the upper.	***See* Section VII.B.7.i, claim 1E.**

xiii. Dependent Claims 15, 16, 24, 25

Claim 15 recites that "the first stitch configuration provides a substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smoother texture." Claim 16 adds that "the second stitch configuration forms a rib structure in the second area." Claim 24 similarly recites that "the knit constructions produce varying properties in the circular-knitted textile element including a varying elasticity of the circular-knitted textile element." Claim 25 similarly recites that "the knit constructions produce varying properties in the circular-knitted textile element including a varying air permeability of the circular-knitted textile element."

As discussed in Section VII.B.7.i above with respect to claim 1[B], Nishida, Castello, and Fujiwara describe a "textile element having a plurality of knit constructions." (Ex. 1003, ¶193-203.) As discussed in Section VII.A.6.xiii above, Nishida describes the features of claims 15, 16, 24, and 25. (Ex. 1003, ¶193-197.)

Fujiwara likewise describes that the outline M of the garment is formed with interknitted stitches (as shown in FIGS. 3A and 3B), and that these interknitted

stitches may be a jacquard, birds eye, eyelet, ***circular rib***, or interlock stitch configuration, whereas the non-interknitted portions of each layers 18, 20 comprises a ***plain stitch configuration***. (Ex. 1008, 5:42-56; 5:57-6:7; 7:21-24; Ex. 1003, ¶203.) In other words, the non-interknitted portions have a substantially smooth texture, and the interknitted portions have a rougher texture (claim 15) and/or a rib structure (claim 16). (Ex. 1003, ¶203.)

CLAIM	GROUND 2
[15] The article of footwear recited in claim 14, wherein the first stitch configuration provides a substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smoother texture.	***See* Section VII.A.6.xiii above, claim 15.** "FIGS. 2A and 2B illustrate, in a course direction, schematically, knitting diagrams at yarn feeders in groups A and B, respectively at the non-stitched part of the fabric. At the yarn feeder in the group A in FIG. 2A, . . . the ***fabric is of basically a plain stitch***, wherein the cylinder needle 12 does not take part in knitting operation. Similarly, at the yarn feeder in the group B in FIG. 2B, . . .***the fabric is, also, of basically a plain stitch*** (tenjiku), wherein the cylinder needle 10 does not take part in knitting operation. Thus, a separate structure is obtained between the inner and outer layers 18 and 20." **Fujiwara,** 5:42-56 (emphasis added) FIGS. 2A, 2B (reproduced below). "FIGS. 3A and 3B illustrate schematically in a course direction knitting diagrams at yarn feeders in groups A and B, respectively at the stitched part of the fabric. At the yarn feeder in the group A, . . . the ***integrated fabric*** is of a so-called rib stitch in a rib stitch arrangement between the dial and cylinder needles 10 and 12. However, in a jacquard arrangement (not shown) of the dial and cylinder needles 10 and 12, ***it is possible that another desired stitching, such as*** birds eye, eyelet, ***circular rib*** or interlock ***may be employed***." **Fujiwara**, 5:57-6:1 (emphasis added); FIGS. 3A, 3B (reproduced below); see also 6:2-7; 6:43-62; 7:21-24.

xiv. Dependent Claims 17, 23

Claim 17 recites that "at least one of the first stitch configuration and the

second stitch configuration forms an aperture in the circular-knitted textile element." Claim 23 similarly recites that "at least one of the knit constructions forms an aperture in the circular-knitted textile element." As discussed in Section VII.A.6.xiv above, Nishida discloses forming "apertures" in the textile element according to each use of the term in the '288 patent. (Ex. 1003, ¶238-241.)

Furthermore, Fujiwara describes forming apertures by omitting stitches at specific locations, such as is described by the '598 patent as the mechanism for forming the "air permeability" and the "lace hole" apertures. (Ex. 1003, ¶242-244.) For example, Fujiwara suggests that the interknitted stitches that form the outline M of the textile element may be formed with a birds eye or eyelet stitching. (Ex. 1003, ¶244.)

As Mr. Holden explains, a POSA at least as of March 3, 2004, would have understood that a birds eye stitch configuration includes float stitches, which leave yarn floating freely on the reverse side of the held loop, thereby resulting in an aperture formed by omitting stitches in each location where a float stitch is applied. The configuration of a birds eye stitch is explained in Spencer. (Ex. 1003, ¶243-244.)

CLAIM	GROUND 2
[17] The article of footwear recited in claim 14, wherein at least one of the first stitch configuration and the second	***See* Section VII.A.6.xiv, claim 17 regarding Nishida.** "FIGS. 3A and 3B illustrate schematically in a course direction knitting diagrams at yarn feeders in groups A and B, respectively at the stitched part of the fabric. At the yarn feeder in the group A, the yarn 14 is subjected to a knitting by both of the dial and cylinder needles 10 and 12, so that the inner and outer layers 18 and 20 are integrated. In the example shown in FIG. 3A, the

CLAIM	GROUND 2
stitch configuration forms an aperture in the circular-knitted textile element.	***integrated fabric*** is of a so-called rib stitch in a rib stitch arrangement between the dial and cylinder needles 10 and 12. However, in a jacquard arrangement (not shown) of the dial and cylinder needles 10 and 12, ***it is possible that another desired stitching, such as birds eye, eyelet,*** circular rib or interlock ***may be employed***. In the similar way, at the yarn feeder in the group B in FIG. 3B, the yarn 16 is subjected to a knitting by both of the dial and cylinder needles 10 and 12, so that the inner and outer layers 18 and 20 are integrated. Similarly***, any of stitching such as bird's eye, eyelet***, circular rib or interlock ***may also be employed***." **Fujiwara**, 5:57-6:7 (emphasis added); FIGS. 3A, 3B (reproduced below); see also 6:43-62; 7:21-24.

xv. Independent Claim 21

As discussed in Section VII.A.6.xv above, independent claim 21 is substantially similar to the combination of claims 1, 3, 4, and 5. The chart below shows how Nishida, Castello, and Fujiwara disclose the features of claim 21, and thus render claim 21 obvious. (Ex. 1003, ¶171-174, 176-177, 180-186, 193-203, 204-206, 208.)

CLAIM	GROUND 2
[21A] An article of footwear comprising:	***See*** **Section VII.B.7.xiv, claim 1A.**
[21B] an upper incorporating a circular-knitted textile element having a plurality of knit constructions, and	***See*** **Section VII.B.7.xiv, claim 1B.**
[21C] further having edges that are joined together to form seams and define at least one portion of a void for receiving a foot,	***See*** **Section VII.B.7.xiv, claim 1D.**
[21D] the seams including a first seam and a second seam, the first seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper, and the second seam extending vertically in the heel area; and	***See*** **Sections VII.B.7.iii, claim 3, VII.B.7.iv, claim 4, and VII.B.7.v, claim 5.**
[21E] a sole structure secured to the upper.	***See*** **Section VII.B.7.xiv, claim**

CLAIM	GROUND 2
	1E.

xvi. Dependent Claim 28

As discussed in Section VII.B.7.vii above, the combinations of (1) the conventional three-layered upper described in the '288 patent, Nishida, and Castello, and (2) Shiomura and Shepherd, respectively, describe these features of claim 28, and thus render claim 28 obvious. (Ex. 1003, ¶231-233.)

xvii. Independent Claim 29

As discussed in Section VII.A.6.xvii above, independent claim 29 is substantially similar to claim 1. The chart below shows how Nishida, Castello, and Fujiwara disclose the features of claim 29, and thus render claim 29 obvious. (Ex. 1003, ¶171-174, 176-177, 180-205, 208.)

Specifically, Nishida, Castello, and Fujiwara describe knitting an outline of the knitted textile element in the textile structure, in which the outline has the shape and proportion of the knitted textile element. (Ex. 1003, ¶190-192.)

CLAIM	GROUND 2
[29A] An article of footwear comprising:	***See* Section VII.B.7.i, claim 1A.**
[29B] an upper incorporating a circular-knitted textile element having a plurality of knit constructions,	***See* Section VII.B.7.i, claim 1B.**
[29C] wherein the circular-knitted textile element is	***See* Section VII.B.7.i, claim 1B.**

CLAIM	GROUND 2
formed with a knitting machine,	
[29D] the circular-knitted element being removed from a circular-knitted textile structure	***See* Section VII.B.7.i, claim 1C.**
[29E] that includes an outline of the circular-knitted textile element	***See* Section VII.A.6.xvii, claim 29E regarding Nishida.** "The method of the present invention also eliminates the need for patterns for use when cutting inasmuch as knitting cutting guide lines 20 are knit directly into the tubular knitted cloth 10 during the knitting operation. The only cutting required is along the sides 38, 40 of the collar which have the cutting guide lines 20 already knit directly in the fabric. Mock fashion marks 22 can be knit along the sides 38, 40 and the bottom edge 32' of the collar in any desired design or pattern by employing conventional knitting procedures. The bottom edge 32' of the collar need not be additionally sewn inasmuch as this is a knitted finished edge which remains after pulling the draw thread 14 and so requires no additional operations." **Castello**, 4:38-52; *see also* 1:68; 2:45-50; 3:50-58; 4:2-4; 4:11-12; 4:22-33; 4:67-5:17; 5:35-44; FIG. 5. "In FIG. 1, a closed phantom line M indicates, in a very schematic manner, an outline of a sweater as a garment wherein one of the inner and outer layers 18 and 20 becomes one side (front body) of the sweater while the other of the inner and outer layers 18 and 20 becomes the other side (back body) of the sweater. Along the outline M of a necessary width, the inner and outer tubular layers 18 and 20 are connected or stitched with each other, so that the both of the layers 18 and 20 are integrated." **Fujiwara**, 4:66-5:7; *see also* 2:34-37; 3:62-4:5; 5:20-41; 6:12-22; 7:21-32; FIGS. 1, 4, 6, 7.
[29F] having longitudinal edges that are joined together to define at least a portion of a	***See* Section VII.B.7.i, claim 1D.**

CLAIM	GROUND 2
void for receiving a foot; and	
[29G] a sole structure secured to the upper.	***See* Section VII.B.7.i, claim 1E.**

xviii. Dependent Claim 30

See Section VII.A.6.xviii above regarding the product-by-process aspect of claim 30. Furthermore, the chart below shows how Castello discloses the feature of claim 30, and thus render claim 30 obvious. (Ex. 1003, ¶178-179.)

Castello states "[r]eferring again to FIG. 5, I show a sketch which may be employed in conjunction with an ***eight-cut*** L.H. circular machine having 64 levers per automat. Assuming twelve automats, the machine could be programmed to knit three collar constructions 16 per layer 12. In the illustration shown, ***768 needles*** would be employed less approximately 10 needles on each side of the gate on automats one and twelve." (Ex. 1007, 5:18-25 (emphasis added); *see also* Abstract; 1:35-53; 1:47-64; 3:34-39; 4:23-38; Ex. 1003, ¶178.)

As Mr. Holden explains, the POSA at least as of March 3, 2004, would have understood how to calculate the diameter of the L.H. circular knitting machine based on the explicit information provided by Castello. (Ex. 1003, ¶179.) Hence, the POSA would have understood from Castello's description that the L.H. circular knitting machine has eight needles per inch (according to the meaning of eight-cut) and 768 needles total around the circumference, thus resulting in a total circumference of 96 inches (calculated by dividing the total needles by the needles per inch). (Ex. 1003,

¶179.) Since diameter is equal to the circumference divided by π, the nominal diameter is equal to 30.55 inches. (Ex. 1003, ¶179.) The POSA would also have understood that a circular knitting machine having a nominal diameter of 30.55 inches is a wide-tube circular knitting machine. (Ex. 1003, ¶179.) Therefore, the POSA would thus have recognized that wide-tube circular knitting machines were used to make Castello's collars and would understand that the L.H. circular knitting machine was one such example. (Ex. 1003, ¶179.)

CLAIM	GROUND 2
[30] The article of footwear recited in claim 29, wherein the circular-knitted textile element has a structure formed by a wide-tube circular knitting machine.	"Referring again to FIG. 5, I show a sketch which may be employed in conjunction with an ***eight-cut*** L.H. circular machine having 64 levers per automat. Assuming twelve automats, the machine could be programmed to knit three collar constructions 16 per layer 12. In the illustration shown, ***768 needles*** would be employed less approximately 10 needles on each side of the gate on automats one and twelve." **Castello**, 5:18-25 (emphasis added); *see also* Abstract; 1:35-53; 1:47-64; 3:34-39; 4:23-38.

xix. Independent Claim 36

As discussed in Section VII.A.6.xix above, independent claim 36 is substantially similar to claims 1, 4, and [29E]. The chart below shows how Nishida, Castello, and Fujiwara disclose the features of claim 36, and render claim 36 obvious. (Ex. 1003, ¶171-174, 176-177, 180-189, 190-205, 208.)

CLAIM	GROUND 2
[36A] An article of footwear comprising:	***See* Section VII.B.7.i, claim 1A.**
[36B] an upper incorporating a knitted textile element,	***See* Section**

CLAIM	GROUND 2
	VII.B.7.i, claim 1B.
[36C] wherein the knitted textile element is formed unitarily with a knitted textile structure,	***See* Section VII.B.7.i, claim 1B.**
[36D] the knitted textile element being removed from the knitted textile structure	***See* Section VII.B.7.i, claim 1C.**
[36E] that includes an outline of the knitted textile element to form edges,	***See* Section VII.B.7.xvii, claim 29E.**
[36F] the knitted textile element having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction, the first area having a first set of properties, and the second area having a second set of properties that is different from the first set of properties to impart varying characteristics to the textile element,	***See* Section VII.B.7.i, claim 1B.**
[36G] and further having the edges joined together to form a seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper; and	***See* Section VII.B.7.iv, claim 4.**
[36H] a sole structure secured to the upper.	***See* Section VII.B.7.i, claim 1E.**

xx. Dependent Claim 37

As discussed in Section VII.B.7.i above with respect to claim 1B, Nishida, Castello, and Fujiwara describe that "the first set of properties and the second set of properties are at least one of a stitch configuration and a yarn type." (Ex. 1003, ¶193-203.)

VIII. EVEN IF CONSIDERED, SECONDARY CONSIDERATIONS FAIL TO OVERCOME THE EVIDENCE OF OBVIOUSNESS.

The Board has repeatedly held that, at the institution phase, evidence of secondary considerations presented by the Patent Owner should be addressed in a trial where the parties may develop, and the Board may consider, a full record. *See, e.g., 10X Genomics Inc. v. Univ. of Chicago*, IPR2015–01162, Paper No. 14 at 22 (PTAB Nov.

16, 2015); *Petroleum Geo-Servs Inc. v. WesternGeco LLC*, IPR2014-01477, Paper No. 18 at 32 (PTAB Mar. 17, 2015); *Crocs Inc. v. Pollivalks Inc.*, IPR2014-00424, Paper No. 8 at 16, 2014 WL 4181938, at *9 (PTAB Aug. 20, 2014) ("We reiterate ... that such secondary considerations are better considered in the context of a trial when the ultimate determination of obviousness is made."). That is the appropriate course here given that "the inventions represent[ ] no more than 'the predictable use of prior art elements according to their established functions,'" and, thus, any "secondary considerations are inadequate to establish nonobviousness as a matter of law." *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010) (quoting *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007)).

Petitioner nonetheless preliminarily addresses alleged secondary considerations that Patent Owner may argue, but reserves the right to respond to any arguments asserted by the Patent Owner in this proceeding. Specifically, in connection with a prior review of the related '011 patent, Patent Owner argued that a proposed amended claim 47 satisfied a long felt need for reducing waste because it claimed a textile element with "flat knit edges" that were not cut or removed from surrounding textile structure. *See Nike, Inc. v. adidas AG*, CA No. 14-1719, slip op. at 19 & 32-33 (Fed. Cir. Feb. 11, 2016).

"For objective [evidence of secondary considerations] to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention." *Wyers*, 616 F.3d at 1246 (quoting *In re GPAC Inc.*, 57

F.3d 1573, 1580 (Fed.Cir.1995)) (internal quotation marks omitted). Unlike in the proposed amended claim in the '011 patent, there is no claim to a textile element with "flat knit edges" or other claim elements that could, even conceivably, connect the challenged claims to any purported long felt need for reducing cutting waste in the '288 patent. That is a critical difference because "[w]here the offered secondary consideration actually results from something other than what is both claimed and novel in the claim, there is no nexus to the merits of the claimed invention." *In re Huai-Hung Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). No such evidence of nexus exists and, to the contrary, the claims here demonstrates that cutting waste will be generated. For example, the majority of the '288 patent claims expressly recite that "the knitted textile element being removed from a knitted textile structure." Thus, to form a shoe upper, will require removing the element from the surrounding structure, thus creating waste and, likewise, describing a feature already present in Nishida. In short, the claims here demonstrate an absence of cost and material savings, rather than satisfaction of any purported long felt need.

IX. THE PROPOSED REJECTIONS RAISE NEW ISSUES IN WHICH PETITIONER WILL LIKELY PREVAIL.

Patent Owner may urge, incorrectly, that the Board should exercise its discretion under 35 U.S.C. 325(d) to deny institution one or more grounds. Indeed, that was the ground Patent Owner articulated in opposing the petition filed concerning the related '011 patent, during prosecution of which Nishida was cited by

the examiner. *adidas AG v. Nike, Inc.*, IPR2013-00067, Paper No. 12, 2013 WL 8595550, at *9 (PTAB May 17, 2013). The Board appropriately rejected that argument, finding Petitioner had "present[ed] different arguments and new supporting evidence that were not before the Examiner." *See id.*, Paper No. 18. Ultimately, the original claims 1-46 challenged in the petition were canceled. *Nike, Inc. v. adidas AG*, 2016 WL 537609, *2 (Fed. Cir. Feb. 11, 2016).

As to both Grounds, the examiner did not consider Reed, Castello, or Fujiwara at all, much less the obviousness of combining Nishida with Reed and/or with Castello and Fujiwara, or the rationales and evidence adidas provides the Board. Likewise, as described, Reed's, Castello's, and Fujiwara's disclosure of multiple other elements would have rendered the claims obvious in view of Nishida's teaching of forming textile elements for articles of footwear.

In view of the foregoing, it is respectfully submitted that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of claims 1-38 challenged in this petition. Accordingly, the Board is requested to grant this petition and to initiate an *inter partes* review, find claims 1-38 unpatentable and cancel these claims, rendering them null, void and otherwise unenforceable.

Respectfully submitted,

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Exhibit 2001

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.8(e) and 42.105(b), the undersigned certifies that on April 19, 2016, a complete and entire copy of this Petition for *Inter Partes* Review was served via USPS Priority Express Mail, costs prepaid, to the Patent Owner by serving the correspondence address of record as follows:

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As a courtesy, the undersigned certifies that on April 19, 2016, a complete and entire copy of this Petition for *Inter Partes* Review was served via USPS Priority Express Mail, costs prepaid, upon the following:

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By: /s/ Mitchell G. Stockwell
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Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, INC.
Patent Owner

Case IPR2017-00263
U.S. Patent No. 8,042,288

PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107

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Exhibit 2001	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2016-00920, Paper 1 (PTAB Apr. 19, 2016)
Exhibit 2002	Decision Denying *Inter Partes* Review, IPR2016-00920, Paper 6 (PTAB Oct. 20, 2016)
Exhibit 2003	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2017-00264, Paper 1 (PTAB Nov. 14, 2016)

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Pursuant to 37 C.F.R. § 42.107, Patent Owner NIKE, Inc. ("NIKE") submits the following Preliminary Response to Petitioner adidas AG's ("adidas'") Petition for *Inter Partes* Review of claims 8 and 14-20 of U.S. Patent No. 8,042,288.

I. INTRODUCTION

adidas' Petition should be rejected for three reasons. First, the Petition is a quintessential "second bite at the apple." The Board, in IPR2016-00920 ("the '920 IPR"), considered and denied *inter partes* review of the ***same*** claims, challenged by the ***same*** party, on the ***same*** grounds, and in view of the ***same*** prior art references. (Ex. 2001.) As a result, the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d).

Second, the Petition does not comply with 37 C.F.R. § 42.8(b)(2) and 35 U.S.C. § 312(a)(4) because adidas fails to identify in its mandatory notices all "related matters"—including the most closely related matter, the '920 IPR—which alone is grounds for denial of the Petition.

Third, the Petition should be rejected under 35 U.S.C. § 312(a)(3) because it suffers from the same deficiencies that led the Board to deny institution in the '920 IPR. adidas fails to identify with particularity the grounds and evidence that form the underlying basis of its patentability challenge. The uncertainties and vagaries in the Petition prevent the Board from conducting an informed evaluation of the

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asserted grounds and deprive NIKE of an appropriate basis to formulate a response.

II. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE THE PETITION IS AN IMPROPER "SECOND BITE AT THE APPLE"

A. Procedural Background

On April 19, 2016, adidas initiated the '920 IPR by filing a petition seeking *inter partes* review of claims 1–38 of the '288 patent. (Ex. 2001.) adidas asserted two grounds of obviousness under 35 U.S.C. § 103(a) as to all 38 claims, relying on a total of six prior art references: Nishida, Reed, Shiomura, Shepherd, Castello, and Fujiwara. (*Id.* at 7.)

On October 20, 2016, the Board rejected adidas' petition under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5,7.) Specifically, adidas failed to describe which claimed features existed in each prior art reference, and the Board was "left to guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as part of the proposed ground." (*Id.* at 6, 7.) The Board therefore declined to institute trial on either ground because the "noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the

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ground by the panel . . . [and] also deprive Nike of an appropriate basis for it to formulate a response to the Petition." (*Id.* at 5,7.)

Less than one month after the Board rejected adidas' petition in the '920 IPR, adidas filed two new petitions that together challenged, for a second time, claims 1–38 of the '288 patent. The instant petition challenges claims 8 and 14–20 (IPR2017-00263), and the other petition challenges claims 1–7, 9–13, and 21–38 (IPR2017-00264) (Ex. 2003). The Petition in the present proceeding seeks cancellation on a single ground that is entirely duplicative of the grounds raised and denied in the '920 IPR. (Pet. at 6; Ex. 2001 at 7.)

Illustration 1: Comparison of Asserted Grounds in adidas' Petitions

adidas' Petition in the '920 IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	1–38	Nishida, Reed, Shiomura, and Shepherd
2	103(a)	1–38	Nishida, Castello, Fujiwara, Shiomura, and Shepherd
adidas' Petition in this IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	8 and 14-20	Reed, Nishida, and Shiomura

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As compared to adidas' petition in the '920 IPR, the instant Petition does not identify any new prior art, challenge any new claims, or raise any new grounds or arguments.[1] (*Id.*)

B. The Board Routinely Rejects "Second Bite" Petitions Under 35 U.S.C. § 325(d)

Section 325(d) of Title 35 authorizes the Board to reject petitions for *inter partes* review that seek to reargue previously rejected positions:

> In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d). Recognizing "the importance of quiet title to patent owners to ensure continued investments resources," Congress gave the Patent Office this broad authority in order to prevent post-grant proceedings form being "used as

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[1] adidas' current and prior petitions both challenge claims 14 and 17 as obvious in view of Reed and Nishida (Pet. at 15, 29; Ex. 2001 at 13, 22, 25–26, 28); both petitions assert that the additional limitations of dependent claims 15, 16, and 19 are obvious in view of Nishida (Pet. at 27, 33; Ex. 2001 at 27, 22–24); both petitions assert that claim 18 is obvious in view of the combination of Reed, Nishida, and Shiomura (Pet. at 31; Ex. 2001 at 20; *see also* Ex. 2002 at 6 ("Shiomura and Shepherd are applied in parallel with one another apparently to account for the same additional claim features"); and both petitions assert that the additional limitations of claim 20 are rendered obvious by Reed (Pet. at 34; Ex. 2001 at 25). In each instance, adidas relies upon nearly identical portions of each prior art reference. (*Compare* Pet. at 15, 27, 29, 31, 33–34 *with* Ex. 2001 at 13, 20, 22–28.)

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tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent." H.R. Rep. No. 112-98, pt. 1, at 48 (2011). In addition, allowing parties to reargue previously-rejected petitions "would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation." *Id.*; *see also 10x Genomics, Inc.*, IPR2015-01157, 2015 WL 7304561 (PTAB Nov. 16, 2015) ("§ 325(d) reflects the fact that a petitioner is not entitled to unlimited challenges against a patent. Rather, our discretion under § 325(d) is guided by a balancing of the interests of the parties, the public, and the Board.... It is more efficient for the parties and the Board to address a matter once rather than twice.") (internal citations and quotations omitted).

In accordance with Congress' intent, the Board frequently rejects petitions under 35 U.S.C. § 325(d) where a petitioner asserts grounds, prior art, or arguments that are substantially similar to those previously presented to the Office. *E.g., HTC Corp. v. NFC Tech.*, IPR2015-00384, 2015 WL 4149068, at *7 (PTAB July 6, 2015) ("To the extent that the present Petition asserts grounds of the earlier Petition . . . institution on such grounds now would not ensure 'the just, speedy, and inexpensive resolution of every proceeding.'"). *Unilever v. Procter & Gamble Co.*, IPR2014-00628, 2014 WL 3588116, at *6 (PTAB Oct. 20, 2014) ("we are persuaded that our resources are better spent addressing matters other than

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Unilever's second attempt to raise a plurality of duplicative grounds against the same patent claims"). The Board is especially likely to reject "second bite" petitions filed by the same party, where the petitioner "simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so." *Samsung Elecs. v. Rembrandt Wireless Techs.*, IPR2015-00114, 2015 WL 410653, at *4 (PTAB Jan. 28, 2015); *see also Netapp Inc. v. Crossroad Sys.*, IPR2015-00777, 2015 WL 5244971, at *4 (PTAB Sept. 3, 2015) (same).

Importantly, the earlier and subsequently-filed petitions need not be identical to warrant rejection under 35 U.S.C. § 325(d). *Lower Drug Prices for Consumers, LLC v. Forest Labs Holdings, Ltd.*, IPR2016-00379, 2016 WL 6958131 (PTAB Oct. 19, 2016) ("§ 325(d) only requires that the arguments be substantially the same, and not identical."). For example, even where a petitioner asserts entirely different prior art references, but mounts substantially the same arguments, the Board denies *inter partes* review. *Unilever*, IPR2014-00628, 2014 WL 5388116, at *6 (denying *inter partes* review under § 325(d) because, although petitioner's first petition asserted anticipation by Bowser and Reid, its subsequent petition nonetheless raised "substantially the same arguments" in asserting anticipation by Cothran and Uchiyama); *see also Praxair Distrib., Inc. v. INO Therapeutics LLC*, IPR2016-00781, 2016 WL 5105519 (PTAB Aug. 25, 2016) (denying petition under § 325(d) because "Petitioner now advances the same or substantially the

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same arguments it presented in [the prior IPR] . . . Although Petitioner now relies on [two different references], its underlying argument—that the prior art taught or suggested the exclusion of neonates with LVD from iNO treatment—is essentially the same as that raised in [the prior IPR], and …it should have been aware of the [newly-cited] references when it filed the earlier Petition.").

Similarly, the Board denies *inter partes* review where a subsequent petition asserts the same prior art references against different claims or claim elements of the previously challenged patent. *E.g., Schrader-Bridgeport Int'l v. Wasica Finance GMBH & Blueare Finance AG*, IPR2015-00272, 2015 WL 3543108, at *3 (PTAB June 1, 2015) (denying *inter partes* review under § 325(d) where patent owner asserted the same references against different claim elements as compared to the earlier petition); *Apple, Inc. v. Aylus Networks, Inc.*, IPR2014-01566, 2015 WL 1870711, at *4 (PTAB Apr. 23, 2015) (denying *inter partes* review under § 325(d) where petitioner challenged an 11-claim subset of the 33 claims previously challenged on the same ground and with the same prior art).

The Board also denies *inter partes* review where it determines that the subsequent petition was intended only to correct defects identified by the Board in an earlier petition. *E.g., ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00454, 2013 WL 12126100 (PTAB Sept. 25, 2013) ("[a] decision to institute review on some claims should not act as an entry ticket, and a how-to

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guide, for the same Petitioner . . . to challenge those claims which it unsuccessfully challenged in the first petition."). For example, the Board explained in *Netapp*, 2015 WL 5244971, at *4:

> "[T]he Petition in this proceeding was filed less than a month after our [decision in the prior proceeding]. The Petition makes clear that this case has been guided by, and has received the benefit of, seeing the decision addressing nearly identical grounds in the prior proceeding . . . Absent a good reason, a subsequently filed petition is not typically granted."

Id.

In particular, the Board has rejected numerous petitions that attempt to correct obviousness-related deficiencies identified by the Board in a prior petition, such as a petitioner's failure to adequately explain how one of ordinary skill would combine the cited references to render the claimed subject matter obvious. *E.g.*, *Samsung*, 2015 WL 410653. In *Samsung*, the Board explained:

> On its face, it is more efficient for the parties and the Board to address a matter once rather than twice. The sole difference between what Petitioner presents in this proceeding and what Petitioner presented in [the prior proceeding] is that the Petitioner now provides further reasoning in support of the same combination of prior art. Therefore, the "same prior art" was "previously presented" to the Board, with respect to the same claims.
>
> Petitioner is requesting, essentially, a second chance to challenge the claims. We, however, are not persuaded that a second chance would help "secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). Permitting second chances in cases like this one

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> ties up the Board's limited resources; we must be mindful not only of this proceeding, but of "every proceeding."
>
> In this proceeding, however, we are not apprised of a reason that merits a second chance. Petitioner simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so.

Id. at *4 (internal citations omitted). *See also Zimmer Holdings, Inc. v. Bonutti Skeletal Innovations LLC*, IPR2014-01080, 2014 WL 5677247, at *4 (PTAB Oct. 31, 2014) (same). Similarly, the Board in *Butamax Adv. Biofuels LLC, v. Gevo Inc.*, IPR2014-00581, 2014 WL 5299385, at *6 (PTAB Oct. 14, 2014), rejected a petition under § 325(d) where petitioner attempted to correct an obviousness-related deficiency, explaining:

> [W]e observe that the obviousness grounds asserted in the present Petition are intended to 'squarely address the alleged deficiencies identified by the Board' in our Decision in the [prior petition]. In other words, the four obviousness grounds are second bites at the apple, which use our prior discussion as a roadmap to remedy Butamax's prior, deficient challenge. Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act. . . . We, therefore, exercise our discretion under § 325(d) to deny institution of *inter partes* review on the four obviousness challenges.

Id.

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C. 35 U.S.C. § 325(d) Compels Denial of the Petition

The Petition is an improper "second bite at the apple." adidas does not assert any new prior art, challenge any new claims, raise any new grounds, or mount any new arguments. (Pet. at 6; Ex. 2001 at 7.) Instead, adidas' Petition challenges, for a second time, claims 8, and 14–20 of the '288 patent as obvious in view of Nishida, Reed, and Shimura. (*Id.*) As a result, the Petition should be denied under 35. U.S.C. § 325(d). *HTC Corp.*, 2015 WL 4149068, at *7 ("Here, Petitioner applies the same references by the same arguments against claim 13 in the present Petition that it applied against claim 13 in the earlier Petition. On that basis alone, we may exercise our discretion and decline to institute *inter partes* review under 35 U.S.C. § 325(d)"); *Square, Inc., v. Think Computer Corp.*, CBM2015-00067, 2015 WL 9898995, at *3 (PTAB July 2, 2015) (denying review under § 325(d) because "allowing almost identical challenges to the same claims, of the same patent, on the same statutory basis, by the same Petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act.").

adidas does not allege that its second challenge raises arguments that are meaningfully different from those asserted in the earlier petition. *Cont'l Auto. Sys., Inc. v. Wasica Finance GMBH & Bluearc Finance, AG*, IPR2014-01454, 2015 WL 674133, at *3 (PTAB Feb. 13, 2015) (rejecting second petition under §

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325(d) where petitioner "offer[ed] no persuasive explanation as to how the arguments regarding claim 4 presented in this proceeding differ from those presented in [the earlier proceeding] in a meaningful way."). Nor does adidas offer—as it would be required to do—any "persuasive explanation as to why these [allegedly new arguments] could not have been presented in [its earlier petition]." *Id.*

Instead, the Petition merely attempts to remedy the defects identified by the Board in the earlier petition, *i.e.*, adidas' failure to "identify with particularity the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) Similar to the petitioner in *Samsung*, the "sole difference" between what adidas presents in this Petition and what adidas presented in the '920 IPR is that the adidas "now provides further reasoning in support of the same combination of prior art." 2015 WL 410653 at *4. In other words, adidas "simply presents arguments now that it could have made in [the '920 IPR], had it merely chosen to do so." *Id.* adidas should not be granted a second chance to present the same arguments to the Board, because "[a]bsent a good reason,"—which adidas has not provided—"a subsequently filed petition that only corrects defects identified by a Board decision in a prior petition is not typically granted." *Netapp*, 2015 WL 5244971, at *4; *Butamax*, 2014 WL 5299385, at *6.

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Accordingly, the Board should exercise its discretion to reject the Petition under 35 U.S.C. § 325(d).

III. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(4) FOR FAILURE TO IDENTIFY ALL RELATED MATTERS

A petition for *inter partes* review "may only be considered if," among other things, "the petition provides such other information as the Director may require by regulation." 35 U.S.C. § 312(a)(4). The Director requires petitioners to include within the petition certain mandatory notices. 37 C.F.R. § 42.8(a)(1). Mandatory notices, in turn, must "[i]dentify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding." 37 C.F.R. § 42.8(b)(2). Judicial matters include "actions involving the patent in federal court," while "administrative matters" include "every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party's involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

Pursuant to 37 C.F.R. § 42.8(b)(2), adidas identifies three related patents and patent applications: U.S. Patent Nos. 7,814,598 ("'598 patent"), a parent of the '288 patent; U.S. Patent Nos. 7,347,011 ("'011 patent"), a grandparent of the '288 patent; and U.S. Patent No. 8,266,749 ("'749 patent"), a continuation of the '288

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patent. adidas also identifies one federal action, *NIKE, Inc. v. adidas AG*, No. 14-1719 (Fed. Cir.), and three *inter partes* review proceedings: IPR2013-00067, involving the '011 patent; IPR2016-00921, involving the '598 patent; and IPR2016-00922, involving the '749 patent. (Pet. at 1–2.)

adidas did not identify, however, the two proceedings initiated by adidas involving the '288 patent: the '920 IPR, in which the Board denied institution of claims 1–38 of the '288 patent (Exs. 2001, 2002); and IPR2017-00264, the simultaneously filed companion to this petition in which adidas challenges claims 1–7, 9–13, and 21–38 of the '288 patent (Ex. 2003). In fact, adidas never once mentions either proceeding in its Petition. Nor has adidas filed an updated notice of related matters, or otherwise notified the Board of its improper omission.

adidas failure to comply with 37 C.F.R. § 42.8(b)(2), and thus 35 U.S.C. § 312(a)(4), warrants denial of the Petition. *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00358, 2015 WL 9899010, at *4 (PTAB July 2, 2015) (denying petition on other grounds, but noting that "[t]he Petition's failure to comply with 37 C.F.R. § 42.8(b)(2), and thus also 35 U.S.C. § 312(a)(4), could be ground for denial of the Petition.") (citing *Reflectix, Inc. v. Promethian Insulation Tech. LLC*, IPR2015-00039, 2015 WL 1927414, at *9 (PTAB Apr. 24, 2015) (denying institution because petition did not comply with parallel requirement, under 35 U.S.C. § 312(a)(2), to identify all real parties-in-interest).)

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IV. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(3) FOR FAILURE TO IDENTIFY GROUNDS AND EVIDENCE WITH PARTICULARITY

As noted above, the Board rejected adidas' petition in the '920 IPR under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) The Board identified two examples of adidas' failure to provide adequate particularity, both of which remain uncorrected in adidas' instant Petition. As a result, the Board should similarly reject the instant Petition under 35 U.S.C. § 312(a)(3).

The first deficiency identified by the Board relates to adidas' challenge of claim 1 (and thus its challenge of claim 14)[2], where adidas' "claim chart . . . spans four pages and constitutes bulk citation to large portions of both Nishida and Reed." (Ex. 2002 at 5.) adidas approach, the Board concluded, "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*Id.*)

adidas' Petition in the instant proceeding suffers from the same deficiency. Except for one instance in which adidas shortens a citation by four lines (Ex. 2001

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[2] adidas' petition in the '920 IPR challenged claim 14 by referring to its challenge of claim 1 for elements 14A, 14B, 14C, and 14E, and to its challenge of claim 8 for element 14D. (Ex. 2001 at 25–26.)

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at 15 ("3:43–48" changed to "3:47–48"), every "bulk citation" in adidas' earlier challenge of claim 1 appears, unabridged, in adidas' instant Petition. (*Compare* Ex. 2001 at 13–18 *with* Pet at. 16–17, 20–21, 27, and 35–37.) In fact, adidas in many cases expands its citations or includes additional citations. (*E.g.*, *Compare* Ex. 2001 at 13 [Element 1A], *with* Pet. at 16 [Element 14A] (adding citation to 1:33–35, 1:39–47 and FIGS 1–3).) As a result, the Petition in the instant proceeding "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*See* Ex. 2002 at 5.)

Second, the Board in the '920 IPR observed that adidas' petition failed to identify which claim limitations were absent from each prior art reference, and the extent to which adidas relied upon other references in support its obviousness challenge for those limitations. (Ex. 2002 at 6 ("The Petition does not provide adequate explanation as to what features adidas contends are absent from Nishida that it also must rely on content of Reed to meet the challenged claims" and "no explanation emerges as to how or why Shimura's and Shepherd's teachings are germane to claim 1") (*citing Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (obvious analysis must describe (1) the scope and content of the prior art and (2) any differences between the claimed subject matter and the prior art.).)

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adidas' Petition in the instant proceeding suffers from the same deficiency. adidas' new "explanation" is comprised essentially of quotations copied from its claim charts and reproduced, redundantly, in the immediately preceding body of the petition. (*Compare* Ex. 2001 at 13–18 *with* Pet. at 15–27.) In addition, rather than explaining which claim elements are absent in each reference, adidas offers, in total, four sentences ambiguously suggesting that certain references may or may not "explicitly" disclose certain features. (Pet. at 16 ("[t]o the extent that Reed does not explicitly state that these features are present . . ."), 19 (same), 35 (same); Pet. at 14 ("While Shiomura does not explicitly reference using a circular knitting machine . . .").) As a result, the Petition in the instant proceeding, as in the '920 IPR, requires the Board and NIKE to "guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as a part of the proposed ground." (Ex. 2002 at 6.)

In sum, adidas fails to correct the deficiencies that led the Board to reject adidas' petition in the '920 IPR. Here too, "the noted uncertainties and vagaries arising from [the Petition] do not lend themselves to informed evaluation of the ground by the panel . . . [and] deprive Nike of an appropriate basis for it to formulate a response to the Petition." As a result, the Board should reject the Petition under 35 U.S.C. § 312(a)(3).

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V. CONCLUSION

As set forth above, NIKE respectfully requests that the Board deny institution of IPR2017-00263.

Date: March 9, 2017

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), NIKE hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this preliminary response, that the number of words in this paper is 3,859. Pursuant to 37 C.F.R. §42.24(d), this word count excludes the table of contents, table of authorities, certificate of service, and appendix of exhibits.

Dated: March 9, 2017

/s/ Christopher J. Renk
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on March 9, 2017, by Express Mail and email directed to the attorneys of record for Petitioner as follows:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, INC.
Patent Owner

Case IPR2017-00263
U.S. Patent No. 8,042,288

PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107

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TABLE OF EXHIBITS

Exhibit No.	Description
Exhibit 2001	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2016-00920, Paper 1 (PTAB Apr. 19, 2016)
Exhibit 2002	Decision Denying *Inter Partes* Review, IPR2016-00920, Paper 6 (PTAB Oct. 20, 2016)
Exhibit 2003	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2017-00264, Paper 1 (PTAB Nov. 14, 2016)

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Pursuant to 37 C.F.R. § 42.107, Patent Owner NIKE, Inc. ("NIKE") submits the following Preliminary Response to Petitioner adidas AG's ("adidas'") Petition for *Inter Partes* Review of claims 8 and 14-20 of U.S. Patent No. 8,042,288.

I. INTRODUCTION

adidas' Petition should be rejected for three reasons. First, the Petition is a quintessential "second bite at the apple." The Board, in IPR2016-00920 ("the '920 IPR"), considered and denied *inter partes* review of the ***same*** claims, challenged by the ***same*** party, on the ***same*** grounds, and in view of the ***same*** prior art references. (Ex. 2001.) As a result, the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d).

Second, the Petition does not comply with 37 C.F.R. § 42.8(b)(2) and 35 U.S.C. § 312(a)(4) because adidas fails to identify in its mandatory notices all "related matters"—including the most closely related matter, the '920 IPR—which alone is grounds for denial of the Petition.

Third, the Petition should be rejected under 35 U.S.C. § 312(a)(3) because it suffers from the same deficiencies that led the Board to deny institution in the '920 IPR. adidas fails to identify with particularity the grounds and evidence that form the underlying basis of its patentability challenge. The uncertainties and vagaries in the Petition prevent the Board from conducting an informed evaluation of the

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asserted grounds and deprive NIKE of an appropriate basis to formulate a response.

II. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE THE PETITION IS AN IMPROPER "SECOND BITE AT THE APPLE"

A. Procedural Background

On April 19, 2016, adidas initiated the '920 IPR by filing a petition seeking *inter partes* review of claims 1–38 of the '288 patent. (Ex. 2001.) adidas asserted two grounds of obviousness under 35 U.S.C. § 103(a) as to all 38 claims, relying on a total of six prior art references: Nishida, Reed, Shiomura, Shepherd, Castello, and Fujiwara. (*Id.* at 7.)

On October 20, 2016, the Board rejected adidas' petition under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5,7.) Specifically, adidas failed to describe which claimed features existed in each prior art reference, and the Board was "left to guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as part of the proposed ground." (*Id.* at 6, 7.) The Board therefore declined to institute trial on either ground because the "noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the

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ground by the panel . . . [and] also deprive Nike of an appropriate basis for it to formulate a response to the Petition." (*Id.* at 5,7.)

Less than one month after the Board rejected adidas' petition in the '920 IPR, adidas filed two new petitions that together challenged, for a second time, claims 1–38 of the '288 patent. The instant petition challenges claims 8 and 14–20 (IPR2017-00263), and the other petition challenges claims 1–7, 9–13, and 21–38 (IPR2017-00264) (Ex. 2003). The Petition in the present proceeding seeks cancellation on a single ground that is entirely duplicative of the grounds raised and denied in the '920 IPR. (Pet. at 6; Ex. 2001 at 7.)

Illustration 1: Comparison of Asserted Grounds in adidas' Petitions

adidas' Petition in the '920 IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	1–38	Nishida, Reed, Shiomura, and Shepherd
2	103(a)	1–38	Nishida, Castello, Fujiwara, Shiomura, and Shepherd
adidas' Petition in this IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	8 and 14-20	Reed, Nishida, and Shiomura

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As compared to adidas' petition in the '920 IPR, the instant Petition does not identify any new prior art, challenge any new claims, or raise any new grounds or arguments.[1] (*Id.*)

B. The Board Routinely Rejects "Second Bite" Petitions Under 35 U.S.C. § 325(d)

Section 325(d) of Title 35 authorizes the Board to reject petitions for *inter partes* review that seek to reargue previously rejected positions:

> In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d). Recognizing "the importance of quiet title to patent owners to ensure continued investments resources," Congress gave the Patent Office this broad authority in order to prevent post-grant proceedings form being "used as

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[1] adidas' current and prior petitions both challenge claims 14 and 17 as obvious in view of Reed and Nishida (Pet. at 15, 29; Ex. 2001 at 13, 22, 25–26, 28); both petitions assert that the additional limitations of dependent claims 15, 16, and 19 are obvious in view of Nishida (Pet. at 27, 33; Ex. 2001 at 27, 22–24); both petitions assert that claim 18 is obvious in view of the combination of Reed, Nishida, and Shiomura (Pet. at 31; Ex. 2001 at 20; *see also* Ex. 2002 at 6 ("Shiomura and Shepherd are applied in parallel with one another apparently to account for the same additional claim features"); and both petitions assert that the additional limitations of claim 20 are rendered obvious by Reed (Pet. at 34; Ex. 2001 at 25). In each instance, adidas relies upon nearly identical portions of each prior art reference. (*Compare* Pet. at 15, 27, 29, 31, 33–34 *with* Ex. 2001 at 13, 20, 22–28.)

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tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent." H.R. Rep. No. 112-98, pt. 1, at 48 (2011). In addition, allowing parties to reargue previously-rejected petitions "would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation." *Id.*; *see also 10x Genomics, Inc.*, IPR2015-01157, 2015 WL 7304561 (PTAB Nov. 16, 2015) ("§ 325(d) reflects the fact that a petitioner is not entitled to unlimited challenges against a patent. Rather, our discretion under § 325(d) is guided by a balancing of the interests of the parties, the public, and the Board.... It is more efficient for the parties and the Board to address a matter once rather than twice.") (internal citations and quotations omitted).

In accordance with Congress' intent, the Board frequently rejects petitions under 35 U.S.C. § 325(d) where a petitioner asserts grounds, prior art, or arguments that are substantially similar to those previously presented to the Office. *E.g., HTC Corp. v. NFC Tech.*, IPR2015-00384, 2015 WL 4149068, at *7 (PTAB July 6, 2015) ("To the extent that the present Petition asserts grounds of the earlier Petition . . . institution on such grounds now would not ensure 'the just, speedy, and inexpensive resolution of every proceeding.'"). *Unilever v. Procter & Gamble Co.*, IPR2014-00628, 2014 WL 3588116, at *6 (PTAB Oct. 20, 2014) ("we are persuaded that our resources are better spent addressing matters other than

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Unilever's second attempt to raise a plurality of duplicative grounds against the same patent claims"). The Board is especially likely to reject "second bite" petitions filed by the same party, where the petitioner "simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so." *Samsung Elecs. v. Rembrandt Wireless Techs.*, IPR2015-00114, 2015 WL 410653, at *4 (PTAB Jan. 28, 2015); *see also Netapp Inc. v. Crossroad Sys.*, IPR2015-00777, 2015 WL 5244971, at *4 (PTAB Sept. 3, 2015) (same).

Importantly, the earlier and subsequently-filed petitions need not be identical to warrant rejection under 35 U.S.C. § 325(d). *Lower Drug Prices for Consumers, LLC v. Forest Labs Holdings, Ltd.*, IPR2016-00379, 2016 WL 6958131 (PTAB Oct. 19, 2016) ("§ 325(d) only requires that the arguments be substantially the same, and not identical."). For example, even where a petitioner asserts entirely different prior art references, but mounts substantially the same arguments, the Board denies *inter partes* review. *Unilever*, IPR2014-00628, 2014 WL 5388116, at *6 (denying *inter partes* review under § 325(d) because, although petitioner's first petition asserted anticipation by Bowser and Reid, its subsequent petition nonetheless raised "substantially the same arguments" in asserting anticipation by Cothran and Uchiyama); *see also Praxair Distrib., Inc. v. INO Therapeutics LLC*, IPR2016-00781, 2016 WL 5105519 (PTAB Aug. 25, 2016) (denying petition under § 325(d) because "Petitioner now advances the same or substantially the

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same arguments it presented in [the prior IPR] . . . Although Petitioner now relies on [two different references], its underlying argument—that the prior art taught or suggested the exclusion of neonates with LVD from iNO treatment—is essentially the same as that raised in [the prior IPR], and …it should have been aware of the [newly-cited] references when it filed the earlier Petition.").

Similarly, the Board denies *inter partes* review where a subsequent petition asserts the same prior art references against different claims or claim elements of the previously challenged patent. *E.g., Schrader-Bridgeport Int'l v. Wasica Finance GMBH & Blueare Finance AG*, IPR2015-00272, 2015 WL 3543108, at *3 (PTAB June 1, 2015) (denying *inter partes* review under § 325(d) where patent owner asserted the same references against different claim elements as compared to the earlier petition); *Apple, Inc. v. Aylus Networks, Inc.*, IPR2014-01566, 2015 WL 1870711, at *4 (PTAB Apr. 23, 2015) (denying *inter partes* review under § 325(d) where petitioner challenged an 11-claim subset of the 33 claims previously challenged on the same ground and with the same prior art).

The Board also denies *inter partes* review where it determines that the subsequent petition was intended only to correct defects identified by the Board in an earlier petition. *E.g., ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00454, 2013 WL 12126100 (PTAB Sept. 25, 2013) ("[a] decision to institute review on some claims should not act as an entry ticket, and a how-to

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guide, for the same Petitioner . . . to challenge those claims which it unsuccessfully challenged in the first petition."). For example, the Board explained in *Netapp*, 2015 WL 5244971, at *4:

> "[T]he Petition in this proceeding was filed less than a month after our [decision in the prior proceeding]. The Petition makes clear that this case has been guided by, and has received the benefit of, seeing the decision addressing nearly identical grounds in the prior proceeding . . . Absent a good reason, a subsequently filed petition is not typically granted."

Id.

In particular, the Board has rejected numerous petitions that attempt to correct obviousness-related deficiencies identified by the Board in a prior petition, such as a petitioner's failure to adequately explain how one of ordinary skill would combine the cited references to render the claimed subject matter obvious. *E.g.*, *Samsung*, 2015 WL 410653. In *Samsung*, the Board explained:

> On its face, it is more efficient for the parties and the Board to address a matter once rather than twice. The sole difference between what Petitioner presents in this proceeding and what Petitioner presented in [the prior proceeding] is that the Petitioner now provides further reasoning in support of the same combination of prior art. Therefore, the "same prior art" was "previously presented" to the Board, with respect to the same claims.
>
> Petitioner is requesting, essentially, a second chance to challenge the claims. We, however, are not persuaded that a second chance would help "secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). Permitting second chances in cases like this one

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> ties up the Board's limited resources; we must be mindful not only of this proceeding, but of "every proceeding."
>
> In this proceeding, however, we are not apprised of a reason that merits a second chance. Petitioner simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so.

Id. at *4 (internal citations omitted). *See also Zimmer Holdings, Inc. v. Bonutti Skeletal Innovations LLC*, IPR2014-01080, 2014 WL 5677247, at *4 (PTAB Oct. 31, 2014) (same). Similarly, the Board in *Butamax Adv. Biofuels LLC, v. Gevo Inc.*, IPR2014-00581, 2014 WL 5299385, at *6 (PTAB Oct. 14, 2014), rejected a petition under § 325(d) where petitioner attempted to correct an obviousness-related deficiency, explaining:

> [W]e observe that the obviousness grounds asserted in the present Petition are intended to 'squarely address the alleged deficiencies identified by the Board' in our Decision in the [prior petition]. In other words, the four obviousness grounds are second bites at the apple, which use our prior discussion as a roadmap to remedy Butamax's prior, deficient challenge. Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act. . . . We, therefore, exercise our discretion under § 325(d) to deny institution of *inter partes* review on the four obviousness challenges.

Id.

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C. 35 U.S.C. § 325(d) Compels Denial of the Petition

The Petition is an improper "second bite at the apple." adidas does not assert any new prior art, challenge any new claims, raise any new grounds, or mount any new arguments. (Pet. at 6; Ex. 2001 at 7.) Instead, adidas' Petition challenges, for a second time, claims 8, and 14–20 of the '288 patent as obvious in view of Nishida, Reed, and Shimura. (*Id.*) As a result, the Petition should be denied under 35. U.S.C. § 325(d). *HTC Corp.*, 2015 WL 4149068, at *7 ("Here, Petitioner applies the same references by the same arguments against claim 13 in the present Petition that it applied against claim 13 in the earlier Petition. On that basis alone, we may exercise our discretion and decline to institute *inter partes* review under 35 U.S.C. § 325(d)"); *Square, Inc., v. Think Computer Corp.*, CBM2015-00067, 2015 WL 9898995, at *3 (PTAB July 2, 2015) (denying review under § 325(d) because "allowing almost identical challenges to the same claims, of the same patent, on the same statutory basis, by the same Petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act.").

adidas does not allege that its second challenge raises arguments that are meaningfully different from those asserted in the earlier petition. *Cont'l Auto. Sys., Inc. v. Wasica Finance GMBH & Bluearc Finance, AG*, IPR2014-01454, 2015 WL 674133, at *3 (PTAB Feb. 13, 2015) (rejecting second petition under §

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325(d) where petitioner "offer[ed] no persuasive explanation as to how the arguments regarding claim 4 presented in this proceeding differ from those presented in [the earlier proceeding] in a meaningful way."). Nor does adidas offer—as it would be required to do—any "persuasive explanation as to why these [allegedly new arguments] could not have been presented in [its earlier petition]." *Id.*

Instead, the Petition merely attempts to remedy the defects identified by the Board in the earlier petition, *i.e.*, adidas' failure to "identify with particularity the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) Similar to the petitioner in *Samsung*, the "sole difference" between what adidas presents in this Petition and what adidas presented in the '920 IPR is that the adidas "now provides further reasoning in support of the same combination of prior art." 2015 WL 410653 at *4. In other words, adidas "simply presents arguments now that it could have made in [the '920 IPR], had it merely chosen to do so." *Id.* adidas should not be granted a second chance to present the same arguments to the Board, because "[a]bsent a good reason,"—which adidas has not provided—"a subsequently filed petition that only corrects defects identified by a Board decision in a prior petition is not typically granted." *Netapp*, 2015 WL 5244971, at *4; *Butamax*, 2014 WL 5299385, at *6.

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Accordingly, the Board should exercise its discretion to reject the Petition under 35 U.S.C. § 325(d).

III. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(4) FOR FAILURE TO IDENTIFY ALL RELATED MATTERS

A petition for *inter partes* review "may only be considered if," among other things, "the petition provides such other information as the Director may require by regulation." 35 U.S.C. § 312(a)(4). The Director requires petitioners to include within the petition certain mandatory notices. 37 C.F.R. § 42.8(a)(1). Mandatory notices, in turn, must "[i]dentify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding." 37 C.F.R. § 42.8(b)(2). Judicial matters include "actions involving the patent in federal court," while "administrative matters" include "every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party's involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

Pursuant to 37 C.F.R. § 42.8(b)(2), adidas identifies three related patents and patent applications: U.S. Patent Nos. 7,814,598 ("'598 patent"), a parent of the '288 patent; U.S. Patent Nos. 7,347,011 ("'011 patent"), a grandparent of the '288 patent; and U.S. Patent No. 8,266,749 ("'749 patent"), a continuation of the '288

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patent. adidas also identifies one federal action, *NIKE, Inc. v. adidas AG*, No. 14-1719 (Fed. Cir.), and three *inter partes* review proceedings: IPR2013-00067, involving the '011 patent; IPR2016-00921, involving the '598 patent; and IPR2016-00922, involving the '749 patent. (Pet. at 1–2.)

adidas did not identify, however, the two proceedings initiated by adidas involving the '288 patent: the '920 IPR, in which the Board denied institution of claims 1–38 of the '288 patent (Exs. 2001, 2002); and IPR2017-00264, the simultaneously filed companion to this petition in which adidas challenges claims 1–7, 9–13, and 21–38 of the '288 patent (Ex. 2003). In fact, adidas never once mentions either proceeding in its Petition. Nor has adidas filed an updated notice of related matters, or otherwise notified the Board of its improper omission.

adidas failure to comply with 37 C.F.R. § 42.8(b)(2), and thus 35 U.S.C. § 312(a)(4), warrants denial of the Petition. *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00358, 2015 WL 9899010, at *4 (PTAB July 2, 2015) (denying petition on other grounds, but noting that "[t]he Petition's failure to comply with 37 C.F.R. § 42.8(b)(2), and thus also 35 U.S.C. § 312(a)(4), could be ground for denial of the Petition.") (citing *Reflectix, Inc. v. Promethian Insulation Tech. LLC*, IPR2015-00039, 2015 WL 1927414, at *9 (PTAB Apr. 24, 2015) (denying institution because petition did not comply with parallel requirement, under 35 U.S.C. § 312(a)(2), to identify all real parties-in-interest).)

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IV. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(3) FOR FAILURE TO IDENTIFY GROUNDS AND EVIDENCE WITH PARTICULARITY

As noted above, the Board rejected adidas' petition in the '920 IPR under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) The Board identified two examples of adidas' failure to provide adequate particularity, both of which remain uncorrected in adidas' instant Petition. As a result, the Board should similarly reject the instant Petition under 35 U.S.C. § 312(a)(3).

The first deficiency identified by the Board relates to adidas' challenge of claim 1 (and thus its challenge of claim 14)[2], where adidas' "claim chart . . . spans four pages and constitutes bulk citation to large portions of both Nishida and Reed." (Ex. 2002 at 5.) adidas approach, the Board concluded, "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*Id.*)

adidas' Petition in the instant proceeding suffers from the same deficiency. Except for one instance in which adidas shortens a citation by four lines (Ex. 2001

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[2] adidas' petition in the '920 IPR challenged claim 14 by referring to its challenge of claim 1 for elements 14A, 14B, 14C, and 14E, and to its challenge of claim 8 for element 14D. (Ex. 2001 at 25–26.)

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at 15 ("3:43–48" changed to "3:47–48"), every "bulk citation" in adidas' earlier challenge of claim 1 appears, unabridged, in adidas' instant Petition. (*Compare* Ex. 2001 at 13–18 *with* Pet at. 16–17, 20–21, 27, and 35–37.) In fact, adidas in many cases expands its citations or includes additional citations. (*E.g.*, *Compare* Ex. 2001 at 13 [Element 1A], *with* Pet. at 16 [Element 14A] (adding citation to 1:33–35, 1:39–47 and FIGS 1–3).) As a result, the Petition in the instant proceeding "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*See* Ex. 2002 at 5.)

Second, the Board in the '920 IPR observed that adidas' petition failed to identify which claim limitations were absent from each prior art reference, and the extent to which adidas relied upon other references in support its obviousness challenge for those limitations. (Ex. 2002 at 6 ("The Petition does not provide adequate explanation as to what features adidas contends are absent from Nishida that it also must rely on content of Reed to meet the challenged claims" and "no explanation emerges as to how or why Shimura's and Shepherd's teachings are germane to claim 1") (*citing Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (obvious analysis must describe (1) the scope and content of the prior art and (2) any differences between the claimed subject matter and the prior art.).)

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adidas' Petition in the instant proceeding suffers from the same deficiency. adidas' new "explanation" is comprised essentially of quotations copied from its claim charts and reproduced, redundantly, in the immediately preceding body of the petition. (*Compare* Ex. 2001 at 13–18 *with* Pet. at 15–27.) In addition, rather than explaining which claim elements are absent in each reference, adidas offers, in total, four sentences ambiguously suggesting that certain references may or may not "explicitly" disclose certain features. (Pet. at 16 ("[t]o the extent that Reed does not explicitly state that these features are present . . ."), 19 (same), 35 (same); Pet. at 14 ("While Shiomura does not explicitly reference using a circular knitting machine . . .").) As a result, the Petition in the instant proceeding, as in the '920 IPR, requires the Board and NIKE to "guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as a part of the proposed ground." (Ex. 2002 at 6.)

In sum, adidas fails to correct the deficiencies that led the Board to reject adidas' petition in the '920 IPR. Here too, "the noted uncertainties and vagaries arising from [the Petition] do not lend themselves to informed evaluation of the ground by the panel . . . [and] deprive Nike of an appropriate basis for it to formulate a response to the Petition." As a result, the Board should reject the Petition under 35 U.S.C. § 312(a)(3).

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V. CONCLUSION

As set forth above, NIKE respectfully requests that the Board deny institution of IPR2017-00263.

Date: March 9, 2017

Respectfully submitted,

/s/ Christopher J. Renk

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), NIKE hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this preliminary response, that the number of words in this paper is 3,859. Pursuant to 37 C.F.R. §42.24(d), this word count excludes the table of contents, table of authorities, certificate of service, and appendix of exhibits.

Dated: March 9, 2017

/s/ Christopher J. Renk
Christopher J. Renk
Banner & Witcoff, Ltd.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on March 9, 2017, by Express Mail and email directed to the attorneys of record for Petitioner as follows:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, INC.
Patent Owner

Case IPR2017-00263
U.S. Patent No. 8,042,288

PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107

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Exhibit No.	Description
Exhibit 2001	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2016-00920, Paper 1 (PTAB Apr. 19, 2016)
Exhibit 2002	Decision Denying *Inter Partes* Review, IPR2016-00920, Paper 6 (PTAB Oct. 20, 2016)
Exhibit 2003	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2017-00264, Paper 1 (PTAB Nov. 14, 2016)

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Pursuant to 37 C.F.R. § 42.107, Patent Owner NIKE, Inc. ("NIKE") submits the following Preliminary Response to Petitioner adidas AG's ("adidas'") Petition for *Inter Partes* Review of claims 8 and 14-20 of U.S. Patent No. 8,042,288.

I. INTRODUCTION

adidas' Petition should be rejected for three reasons. First, the Petition is a quintessential "second bite at the apple." The Board, in IPR2016-00920 ("the '920 IPR"), considered and denied *inter partes* review of the ***same*** claims, challenged by the ***same*** party, on the ***same*** grounds, and in view of the ***same*** prior art references. (Ex. 2001.) As a result, the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d).

Second, the Petition does not comply with 37 C.F.R. § 42.8(b)(2) and 35 U.S.C. § 312(a)(4) because adidas fails to identify in its mandatory notices all "related matters"—including the most closely related matter, the '920 IPR—which alone is grounds for denial of the Petition.

Third, the Petition should be rejected under 35 U.S.C. § 312(a)(3) because it suffers from the same deficiencies that led the Board to deny institution in the '920 IPR. adidas fails to identify with particularity the grounds and evidence that form the underlying basis of its patentability challenge. The uncertainties and vagaries in the Petition prevent the Board from conducting an informed evaluation of the

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asserted grounds and deprive NIKE of an appropriate basis to formulate a response.

II. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE THE PETITION IS AN IMPROPER "SECOND BITE AT THE APPLE"

A. Procedural Background

On April 19, 2016, adidas initiated the '920 IPR by filing a petition seeking *inter partes* review of claims 1–38 of the '288 patent. (Ex. 2001.) adidas asserted two grounds of obviousness under 35 U.S.C. § 103(a) as to all 38 claims, relying on a total of six prior art references: Nishida, Reed, Shiomura, Shepherd, Castello, and Fujiwara. (*Id.* at 7.)

On October 20, 2016, the Board rejected adidas' petition under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5,7.) Specifically, adidas failed to describe which claimed features existed in each prior art reference, and the Board was "left to guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as part of the proposed ground." (*Id.* at 6, 7.) The Board therefore declined to institute trial on either ground because the "noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the

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ground by the panel . . . [and] also deprive Nike of an appropriate basis for it to formulate a response to the Petition." (*Id.* at 5,7.)

Less than one month after the Board rejected adidas' petition in the '920 IPR, adidas filed two new petitions that together challenged, for a second time, claims 1–38 of the '288 patent. The instant petition challenges claims 8 and 14–20 (IPR2017-00263), and the other petition challenges claims 1–7, 9–13, and 21–38 (IPR2017-00264) (Ex. 2003). The Petition in the present proceeding seeks cancellation on a single ground that is entirely duplicative of the grounds raised and denied in the '920 IPR. (Pet. at 6; Ex. 2001 at 7.)

Illustration 1: Comparison of Asserted Grounds in adidas' Petitions

adidas' Petition in the '920 IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	1–38	Nishida, Reed, Shiomura, and Shepherd
2	103(a)	1–38	Nishida, Castello, Fujiwara, Shiomura, and Shepherd
adidas' Petition in this IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	8 and 14-20	Reed, Nishida, and Shiomura

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As compared to adidas' petition in the '920 IPR, the instant Petition does not identify any new prior art, challenge any new claims, or raise any new grounds or arguments.[1] (*Id.*)

B. The Board Routinely Rejects "Second Bite" Petitions Under 35 U.S.C. § 325(d)

Section 325(d) of Title 35 authorizes the Board to reject petitions for *inter partes* review that seek to reargue previously rejected positions:

> In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d). Recognizing "the importance of quiet title to patent owners to ensure continued investments resources," Congress gave the Patent Office this broad authority in order to prevent post-grant proceedings form being "used as

---

[1] adidas' current and prior petitions both challenge claims 14 and 17 as obvious in view of Reed and Nishida (Pet. at 15, 29; Ex. 2001 at 13, 22, 25–26, 28); both petitions assert that the additional limitations of dependent claims 15, 16, and 19 are obvious in view of Nishida (Pet. at 27, 33; Ex. 2001 at 27, 22–24); both petitions assert that claim 18 is obvious in view of the combination of Reed, Nishida, and Shiomura (Pet. at 31; Ex. 2001 at 20; *see also* Ex. 2002 at 6 ("Shiomura and Shepherd are applied in parallel with one another apparently to account for the same additional claim features"); and both petitions assert that the additional limitations of claim 20 are rendered obvious by Reed (Pet. at 34; Ex. 2001 at 25). In each instance, adidas relies upon nearly identical portions of each prior art reference. (*Compare* Pet. at 15, 27, 29, 31, 33–34 *with* Ex. 2001 at 13, 20, 22–28.)

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tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent." H.R. Rep. No. 112-98, pt. 1, at 48 (2011). In addition, allowing parties to reargue previously-rejected petitions "would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation." *Id.*; *see also 10x Genomics, Inc.*, IPR2015-01157, 2015 WL 7304561 (PTAB Nov. 16, 2015) ("§ 325(d) reflects the fact that a petitioner is not entitled to unlimited challenges against a patent. Rather, our discretion under § 325(d) is guided by a balancing of the interests of the parties, the public, and the Board.... It is more efficient for the parties and the Board to address a matter once rather than twice.") (internal citations and quotations omitted).

In accordance with Congress' intent, the Board frequently rejects petitions under 35 U.S.C. § 325(d) where a petitioner asserts grounds, prior art, or arguments that are substantially similar to those previously presented to the Office. *E.g., HTC Corp. v. NFC Tech.*, IPR2015-00384, 2015 WL 4149068, at *7 (PTAB July 6, 2015) ("To the extent that the present Petition asserts grounds of the earlier Petition . . . institution on such grounds now would not ensure 'the just, speedy, and inexpensive resolution of every proceeding.'"). *Unilever v. Procter & Gamble Co.*, IPR2014-00628, 2014 WL 3588116, at *6 (PTAB Oct. 20, 2014) ("we are persuaded that our resources are better spent addressing matters other than

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Unilever's second attempt to raise a plurality of duplicative grounds against the same patent claims"). The Board is especially likely to reject "second bite" petitions filed by the same party, where the petitioner "simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so." *Samsung Elecs. v. Rembrandt Wireless Techs.*, IPR2015-00114, 2015 WL 410653, at *4 (PTAB Jan. 28, 2015); *see also Netapp Inc. v. Crossroad Sys.*, IPR2015-00777, 2015 WL 5244971, at *4 (PTAB Sept. 3, 2015) (same).

Importantly, the earlier and subsequently-filed petitions need not be identical to warrant rejection under 35 U.S.C. § 325(d). *Lower Drug Prices for Consumers, LLC v. Forest Labs Holdings, Ltd.*, IPR2016-00379, 2016 WL 6958131 (PTAB Oct. 19, 2016) ("§ 325(d) only requires that the arguments be substantially the same, and not identical."). For example, even where a petitioner asserts entirely different prior art references, but mounts substantially the same arguments, the Board denies *inter partes* review. *Unilever*, IPR2014-00628, 2014 WL 5388116, at *6 (denying *inter partes* review under § 325(d) because, although petitioner's first petition asserted anticipation by Bowser and Reid, its subsequent petition nonetheless raised "substantially the same arguments" in asserting anticipation by Cothran and Uchiyama); *see also Praxair Distrib., Inc. v. INO Therapeutics LLC*, IPR2016-00781, 2016 WL 5105519 (PTAB Aug. 25, 2016) (denying petition under § 325(d) because "Petitioner now advances the same or substantially the

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same arguments it presented in [the prior IPR] . . . Although Petitioner now relies on [two different references], its underlying argument—that the prior art taught or suggested the exclusion of neonates with LVD from iNO treatment—is essentially the same as that raised in [the prior IPR], and …it should have been aware of the [newly-cited] references when it filed the earlier Petition.").

Similarly, the Board denies *inter partes* review where a subsequent petition asserts the same prior art references against different claims or claim elements of the previously challenged patent. *E.g., Schrader-Bridgeport Int'l v. Wasica Finance GMBH & Blueare Finance AG*, IPR2015-00272, 2015 WL 3543108, at *3 (PTAB June 1, 2015) (denying *inter partes* review under § 325(d) where patent owner asserted the same references against different claim elements as compared to the earlier petition); *Apple, Inc. v. Aylus Networks, Inc.*, IPR2014-01566, 2015 WL 1870711, at *4 (PTAB Apr. 23, 2015) (denying *inter partes* review under § 325(d) where petitioner challenged an 11-claim subset of the 33 claims previously challenged on the same ground and with the same prior art).

The Board also denies *inter partes* review where it determines that the subsequent petition was intended only to correct defects identified by the Board in an earlier petition. *E.g., ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00454, 2013 WL 12126100 (PTAB Sept. 25, 2013) ("[a] decision to institute review on some claims should not act as an entry ticket, and a how-to

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guide, for the same Petitioner . . . to challenge those claims which it unsuccessfully challenged in the first petition."). For example, the Board explained in *Netapp*, 2015 WL 5244971, at *4:

> "[T]he Petition in this proceeding was filed less than a month after our [decision in the prior proceeding]. The Petition makes clear that this case has been guided by, and has received the benefit of, seeing the decision addressing nearly identical grounds in the prior proceeding . . . Absent a good reason, a subsequently filed petition is not typically granted."

Id.

In particular, the Board has rejected numerous petitions that attempt to correct obviousness-related deficiencies identified by the Board in a prior petition, such as a petitioner's failure to adequately explain how one of ordinary skill would combine the cited references to render the claimed subject matter obvious. *E.g.*, *Samsung*, 2015 WL 410653. In *Samsung*, the Board explained:

> On its face, it is more efficient for the parties and the Board to address a matter once rather than twice. The sole difference between what Petitioner presents in this proceeding and what Petitioner presented in [the prior proceeding] is that the Petitioner now provides further reasoning in support of the same combination of prior art. Therefore, the "same prior art" was "previously presented" to the Board, with respect to the same claims.
>
> Petitioner is requesting, essentially, a second chance to challenge the claims. We, however, are not persuaded that a second chance would help "secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). Permitting second chances in cases like this one

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> ties up the Board's limited resources; we must be mindful not only of this proceeding, but of "every proceeding."
>
> In this proceeding, however, we are not apprised of a reason that merits a second chance. Petitioner simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so.

Id. at *4 (internal citations omitted). *See also Zimmer Holdings, Inc. v. Bonutti Skeletal Innovations LLC*, IPR2014-01080, 2014 WL 5677247, at *4 (PTAB Oct. 31, 2014) (same). Similarly, the Board in *Butamax Adv. Biofuels LLC, v. Gevo Inc.*, IPR2014-00581, 2014 WL 5299385, at *6 (PTAB Oct. 14, 2014), rejected a petition under § 325(d) where petitioner attempted to correct an obviousness-related deficiency, explaining:

> [W]e observe that the obviousness grounds asserted in the present Petition are intended to 'squarely address the alleged deficiencies identified by the Board' in our Decision in the [prior petition]. In other words, the four obviousness grounds are second bites at the apple, which use our prior discussion as a roadmap to remedy Butamax's prior, deficient challenge. Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act. . . . We, therefore, exercise our discretion under § 325(d) to deny institution of *inter partes* review on the four obviousness challenges.

Id.

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C. 35 U.S.C. § 325(d) Compels Denial of the Petition

The Petition is an improper "second bite at the apple." adidas does not assert any new prior art, challenge any new claims, raise any new grounds, or mount any new arguments. (Pet. at 6; Ex. 2001 at 7.) Instead, adidas' Petition challenges, for a second time, claims 8, and 14–20 of the '288 patent as obvious in view of Nishida, Reed, and Shimura. (*Id.*) As a result, the Petition should be denied under 35. U.S.C. § 325(d). *HTC Corp.*, 2015 WL 4149068, at *7 ("Here, Petitioner applies the same references by the same arguments against claim 13 in the present Petition that it applied against claim 13 in the earlier Petition. On that basis alone, we may exercise our discretion and decline to institute *inter partes* review under 35 U.S.C. § 325(d)"); *Square, Inc., v. Think Computer Corp.*, CBM2015-00067, 2015 WL 9898995, at *3 (PTAB July 2, 2015) (denying review under § 325(d) because "allowing almost identical challenges to the same claims, of the same patent, on the same statutory basis, by the same Petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act.").

adidas does not allege that its second challenge raises arguments that are meaningfully different from those asserted in the earlier petition. *Cont'l Auto. Sys., Inc. v. Wasica Finance GMBH & Bluearc Finance, AG*, IPR2014-01454, 2015 WL 674133, at *3 (PTAB Feb. 13, 2015) (rejecting second petition under §

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325(d) where petitioner "offer[ed] no persuasive explanation as to how the arguments regarding claim 4 presented in this proceeding differ from those presented in [the earlier proceeding] in a meaningful way."). Nor does adidas offer—as it would be required to do—any "persuasive explanation as to why these [allegedly new arguments] could not have been presented in [its earlier petition]." *Id.*

Instead, the Petition merely attempts to remedy the defects identified by the Board in the earlier petition, *i.e.*, adidas' failure to "identify with particularity the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) Similar to the petitioner in *Samsung*, the "sole difference" between what adidas presents in this Petition and what adidas presented in the '920 IPR is that the adidas "now provides further reasoning in support of the same combination of prior art." 2015 WL 410653 at *4. In other words, adidas "simply presents arguments now that it could have made in [the '920 IPR], had it merely chosen to do so." *Id.* adidas should not be granted a second chance to present the same arguments to the Board, because "[a]bsent a good reason,"—which adidas has not provided—"a subsequently filed petition that only corrects defects identified by a Board decision in a prior petition is not typically granted." *Netapp*, 2015 WL 5244971, at *4; *Butamax*, 2014 WL 5299385, at *6.

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Accordingly, the Board should exercise its discretion to reject the Petition under 35 U.S.C. § 325(d).

III. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(4) FOR FAILURE TO IDENTIFY ALL RELATED MATTERS

A petition for *inter partes* review "may only be considered if," among other things, "the petition provides such other information as the Director may require by regulation." 35 U.S.C. § 312(a)(4). The Director requires petitioners to include within the petition certain mandatory notices. 37 C.F.R. § 42.8(a)(1). Mandatory notices, in turn, must "[i]dentify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding." 37 C.F.R. § 42.8(b)(2). Judicial matters include "actions involving the patent in federal court," while "administrative matters" include "every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party's involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

Pursuant to 37 C.F.R. § 42.8(b)(2), adidas identifies three related patents and patent applications: U.S. Patent Nos. 7,814,598 ("'598 patent"), a parent of the '288 patent; U.S. Patent Nos. 7,347,011 ("'011 patent"), a grandparent of the '288 patent; and U.S. Patent No. 8,266,749 ("'749 patent"), a continuation of the '288

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patent. adidas also identifies one federal action, *NIKE, Inc. v. adidas AG*, No. 14-1719 (Fed. Cir.), and three *inter partes* review proceedings: IPR2013-00067, involving the '011 patent; IPR2016-00921, involving the '598 patent; and IPR2016-00922, involving the '749 patent. (Pet. at 1–2.)

adidas did not identify, however, the two proceedings initiated by adidas involving the '288 patent: the '920 IPR, in which the Board denied institution of claims 1–38 of the '288 patent (Exs. 2001, 2002); and IPR2017-00264, the simultaneously filed companion to this petition in which adidas challenges claims 1–7, 9–13, and 21–38 of the '288 patent (Ex. 2003). In fact, adidas never once mentions either proceeding in its Petition. Nor has adidas filed an updated notice of related matters, or otherwise notified the Board of its improper omission.

adidas failure to comply with 37 C.F.R. § 42.8(b)(2), and thus 35 U.S.C. § 312(a)(4), warrants denial of the Petition. *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00358, 2015 WL 9899010, at *4 (PTAB July 2, 2015) (denying petition on other grounds, but noting that "[t]he Petition's failure to comply with 37 C.F.R. § 42.8(b)(2), and thus also 35 U.S.C. § 312(a)(4), could be ground for denial of the Petition.") (citing *Reflectix, Inc. v. Promethian Insulation Tech. LLC*, IPR2015-00039, 2015 WL 1927414, at *9 (PTAB Apr. 24, 2015) (denying institution because petition did not comply with parallel requirement, under 35 U.S.C. § 312(a)(2), to identify all real parties-in-interest).)

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IV. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(3) FOR FAILURE TO IDENTIFY GROUNDS AND EVIDENCE WITH PARTICULARITY

As noted above, the Board rejected adidas' petition in the '920 IPR under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) The Board identified two examples of adidas' failure to provide adequate particularity, both of which remain uncorrected in adidas' instant Petition. As a result, the Board should similarly reject the instant Petition under 35 U.S.C. § 312(a)(3).

The first deficiency identified by the Board relates to adidas' challenge of claim 1 (and thus its challenge of claim 14)[2], where adidas' "claim chart . . . spans four pages and constitutes bulk citation to large portions of both Nishida and Reed." (Ex. 2002 at 5.) adidas approach, the Board concluded, "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*Id.*)

adidas' Petition in the instant proceeding suffers from the same deficiency. Except for one instance in which adidas shortens a citation by four lines (Ex. 2001

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[2] adidas' petition in the '920 IPR challenged claim 14 by referring to its challenge of claim 1 for elements 14A, 14B, 14C, and 14E, and to its challenge of claim 8 for element 14D. (Ex. 2001 at 25–26.)

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at 15 ("3:43–48" changed to "3:47–48"), every "bulk citation" in adidas' earlier challenge of claim 1 appears, unabridged, in adidas' instant Petition. (*Compare* Ex. 2001 at 13–18 *with* Pet at. 16–17, 20–21, 27, and 35–37.) In fact, adidas in many cases expands its citations or includes additional citations. (*E.g.*, *Compare* Ex. 2001 at 13 [Element 1A], *with* Pet. at 16 [Element 14A] (adding citation to 1:33–35, 1:39–47 and FIGS 1–3).) As a result, the Petition in the instant proceeding "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*See* Ex. 2002 at 5.)

Second, the Board in the '920 IPR observed that adidas' petition failed to identify which claim limitations were absent from each prior art reference, and the extent to which adidas relied upon other references in support its obviousness challenge for those limitations. (Ex. 2002 at 6 ("The Petition does not provide adequate explanation as to what features adidas contends are absent from Nishida that it also must rely on content of Reed to meet the challenged claims" and "no explanation emerges as to how or why Shimura's and Shepherd's teachings are germane to claim 1") (*citing Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (obvious analysis must describe (1) the scope and content of the prior art and (2) any differences between the claimed subject matter and the prior art.).)

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adidas' Petition in the instant proceeding suffers from the same deficiency. adidas' new "explanation" is comprised essentially of quotations copied from its claim charts and reproduced, redundantly, in the immediately preceding body of the petition. (*Compare* Ex. 2001 at 13–18 *with* Pet. at 15–27.) In addition, rather than explaining which claim elements are absent in each reference, adidas offers, in total, four sentences ambiguously suggesting that certain references may or may not "explicitly" disclose certain features. (Pet. at 16 ("[t]o the extent that Reed does not explicitly state that these features are present . . ."), 19 (same), 35 (same); Pet. at 14 ("While Shiomura does not explicitly reference using a circular knitting machine . . .").) As a result, the Petition in the instant proceeding, as in the '920 IPR, requires the Board and NIKE to "guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as a part of the proposed ground." (Ex. 2002 at 6.)

In sum, adidas fails to correct the deficiencies that led the Board to reject adidas' petition in the '920 IPR. Here too, "the noted uncertainties and vagaries arising from [the Petition] do not lend themselves to informed evaluation of the ground by the panel . . . [and] deprive Nike of an appropriate basis for it to formulate a response to the Petition." As a result, the Board should reject the Petition under 35 U.S.C. § 312(a)(3).

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V. CONCLUSION

As set forth above, NIKE respectfully requests that the Board deny institution of IPR2017-00263.

Date: March 9, 2017

Respectfully submitted,

/s/ Christopher J. Renk

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), NIKE hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this preliminary response, that the number of words in this paper is 3,859. Pursuant to 37 C.F.R. §42.24(d), this word count excludes the table of contents, table of authorities, certificate of service, and appendix of exhibits.

Dated: March 9, 2017

/s/ Christopher J. Renk
Christopher J. Renk
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on March 9, 2017, by Express Mail and email directed to the attorneys of record for Petitioner as follows:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner,

v.

NIKE, INC.
Patent Owner

Case IPR2017-00264
U.S. Patent No. 8,042,288

PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 37 C.F.R. § 42.107

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Exhibit No.	Description
Exhibit 2001	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2016-00920, Paper 1 (PTAB Apr. 19, 2016)
Exhibit 2002	Decision Denying *Inter Partes* Review, IPR2016-00920, Paper 6 (PTAB Oct. 20, 2016)
Exhibit 2003	adidas' Petition for *Inter Partes* Review of U.S. Patent 8,042,288, IPR2017-00263, Paper 1 (PTAB Nov. 14, 2016)

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Pursuant to 37 C.F.R. § 42.107, Patent Owner NIKE, Inc. ("NIKE") submits the following Preliminary Response to Petitioner adidas AG's ("adidas'") Petition for *Inter Partes* Review of claims 1–7, 9–13, 21–38 of U.S. Patent No. 8,042,288.

I. INTRODUCTION

adidas' Petition should be rejected for three reasons. First, the Petition is a quintessential "second bite at the apple." The Board, in IPR2016-00920 ("the '920 IPR"), considered and denied *inter partes* review of the ***same*** claims, challenged by the ***same*** party, raising the ***same*** arguments, and in view of the ***same*** prior art references. (Ex. 2001.) As a result, the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d).

Second, the Petition does not comply with 37 C.F.R. § 42.8(b)(2) and 35 U.S.C. § 312(a)(4) because adidas fails to identify in its mandatory notices all "related matters"—including the most closely related matter, the '920 IPR—which alone is grounds for denial of the Petition.

Third, the Petition should be rejected under 35 U.S.C. § 312(a)(3) because it suffers from the same deficiencies that led the Board to deny institution in the '920 IPR. adidas fails to identify with particularity the grounds and evidence that form the underlying basis of its patentability challenge. The uncertainties and vagaries in the Petition prevent the Board from conducting an informed evaluation of the

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asserted grounds and deprive NIKE of an appropriate basis to formulate a response.

II. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 325(d) BECAUSE THE PETITION IS AN IMPROPER "SECOND BITE AT THE APPLE"

A. Procedural Background

On April 19, 2016, adidas initiated the '920 IPR by filing a petition seeking *inter partes* review of claims 1–38 of the '288 patent. (Ex. 2001.) adidas asserted two grounds of obviousness under 35 U.S.C. § 103(a) as to all 38 claims, relying on a total of six prior art references: Nishida, Reed, Shiomura, Shepherd, Castello, and Fujiwara. (*Id.* at 7.)

On October 20, 2016, the Board rejected adidas' petition under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5,7.) Specifically, adidas failed to describe which claimed features existed in each prior art reference, and the Board was "left to guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as part of the proposed ground." (*Id.* at 6, 7.) The Board therefore declined to institute trial on either ground because the "noted uncertainties and vagaries arising from the Petition do not lend themselves to informed evaluation of the

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ground by the panel . . . [and] also deprive Nike of an appropriate basis for it to formulate a response to the Petition." (*Id.* at 5,7.)

Less than one month after the Board rejected adidas' petition in the '920 IPR, adidas filed two new petitions that together challenged, for a second time, claims 1–38 of the '288 patent. The instant petition challenges claims 1–7, 9–13, and 21–38 (IPR2017-00264), and the other petition challenges claims 8 and 14–20 (IPR2017-00263) (Ex. 2003). The Petition in the present proceeding seeks cancellation on two grounds that are entirely duplicative of the grounds raised and denied in the '920 IPR. (Pet. at 7; Ex. 2001 at 7.)

Illustration 1: Comparison of Asserted Grounds in adidas' Petitions

adidas' Petition in the '920 IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	1–38	Nishida, Reed, Shiomura, and Shepherd
2	103(a)	1–38	Nishida, Castello, Fujiwara, Shiomura, and Shepherd
adidas' Petition in this IPR			
Ground	**35 U.S.C.**	**Claims**	**References**
1	103(a)	1–7, 9–13, 21–38	Reed and Nishida
2	102(b)	36–38	Nishida

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The Petition's patentability challenge in Ground 1 is identical to its assertions in the '920 IPR.[1] While Ground 2 of the instant Petition may appear, on its face, distinct from those in the '920 IPR: adidas' less than two-page analysis of Ground 2 is comprised entirely of cross-references to its analysis of Ground 1, and is therefore nothing more than a repackaged presentation of the identical arguments previously raised by adidas.[2] Thus, as compared to adidas' petition in the '920

---

[1] Comparing Ground 1 of the instant Petition to adidas' assertions in the '920 IPR: both petitions challenge claims 1, 7, 9, 13, 21, 23, 26–29, and 34–38 as obvious in view of Reed and Nishida (Pet. at 13, 25–27, 29–31, 34, 36, 39, 44; Ex. 2001 at 13, 20–21, 23, 24, 28, 30–32, 34–35); both petitions argue that the additional limitations of dependent claims 2–6, 10–12, 22, 24–25, and 31–33 are rendered obvious by Nishida (Pet. at 22–25, 28, 33, Ex. 2001 at 18–20, 24, 27); and both petitions argue that the additional limitations of dependent claim 30 are rendered obvious by Reed (Pet. at 38, Ex. 2001 at 32). In each instance, adidas relies upon nearly identical portions of each prior art reference. (*Compare* Pet. at 13, 22–31, 33–34, 36, 38–39, 44, *with* Ex. 2001 at 13, 18–21, 23, 24, 27–28, 30–32, 34–35.)

[2] The Petition's analysis of Ground 2, which pertains to claims 36–38, is comprised exclusively of cross-references to the Petition's analysis of claims 36–38 under Ground 1. (Pet. at 44–46 (**Claim 36**: "As a result, Section VII.A.4.xvii above describes how Nishida discloses all of the features of claim 36, and thus anticipates claim 36" and "*See* Section VII.A.4.xvii, claim [36-A-H] regarding Nishida"; **Claim 37**: "As discussed in Section VII.A.4.xviii above and VII.A.4.xvii above, Nishida discloses the feature of claim 37, and thus anticipates claim 37"; **Claim 38**: "As discussed in Section VII.A.4.vii above, Nishida discloses the feature of claim 38, and thus anticipates claim 38."). As noted in footnote 1, the Petition's analysis of Claims 36–38 under Ground 1 relies upon precisely the same portions of Reed and Nishida that adidas relied upon when challenging those claims as obvious in the '920 IPR (*Compare* Pet. at 13–22, 37, 39–44, *with* Ex. 2001 at 13–19, 31–32, 34–35).

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IPR, the instant Petition does not identify any new prior art, challenge any new claims, or raise any new arguments. (*Id.*)

B. The Board Routinely Rejects "Second Bite" Petitions Under 35 U.S.C. § 325(d)

Section 325(d) of Title 35 authorizes the Board to reject petitions for *inter partes* review that seek to reargue previously rejected positions:

> In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d). Recognizing "the importance of quiet title to patent owners to ensure continued investments resources," Congress gave the Patent Office this broad authority in order to prevent post-grant proceedings form being "used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent." H.R. Rep. No. 112-98, pt. 1, at 48 (2011). In addition, allowing parties to reargue previously-rejected petitions "would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation." *Id.*; *see also 10x Genomics, Inc.*, IPR2015-01157, 2015 WL 7304561 (PTAB Nov. 16, 2015) ("§ 325(d) reflects the fact that a petitioner is not entitled to unlimited challenges against a patent. Rather, our discretion under § 325(d) is guided by a balancing of the interests of the parties, the public, and the Board.... It is more efficient for the parties and the Board to

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address a matter once rather than twice.") (internal citations and quotations omitted).

In accordance with Congress' intent, the Board frequently rejects petitions under 35 U.S.C. § 325(d) where a petitioner asserts grounds, prior art, or arguments that are substantially similar to those previously presented to the Office. *E.g., HTC Corp. v. NFC Tech.*, IPR2015-00384, 2015 WL 4149068, at *7 (PTAB July 6, 2015) ("To the extent that the present Petition asserts grounds of the earlier Petition . . . institution on such grounds now would not ensure 'the just, speedy, and inexpensive resolution of every proceeding.'"). *Unilever v. Procter & Gamble Co.*, IPR2014-00628, 2014 WL 3588116, at *6 (PTAB Oct. 20, 2014) ("we are persuaded that our resources are better spent addressing matters other than Unilever's second attempt to raise a plurality of duplicative grounds against the same patent claims"). The Board is especially likely to reject "second bite" petitions filed by the same party, where the petitioner "simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so." *Samsung Elecs. v. Rembrandt Wireless Techs.*, IPR2015-00114, 2015 WL 410653, at *4 (PTAB Jan. 28, 2015); *see also Netapp Inc. v. Crossroad Sys.*, IPR2015-00777, 2015 WL 5244971, at *4 (PTAB Sept. 3, 2015) (same).

Importantly, the earlier and subsequently-filed petitions need not be identical to warrant rejection under 35 U.S.C. § 325(d). *Lower Drug Prices for Consumers,*

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LLC v. Forest Labs Holdings, Ltd., IPR2016-00379, 2016 WL 6958131 (PTAB Oct. 19, 2016) ("§ 325(d) only requires that the arguments be substantially the same, and not identical."). For example, even where a petitioner asserts entirely different prior art references, but mounts substantially the same arguments, the Board denies *inter partes* review. *Unilever*, 2014 WL 5388116, at *6 (denying *inter partes* review under § 325(d) because, although petitioner's first petition asserted anticipation by Bowser and Reid, its subsequent petition nonetheless raised "substantially the same arguments" in asserting anticipation by Cothran and Uchiyama); *see also Praxair Distrib., Inc. v. INO Therapeutics LLC*, IPR2016-00781, 2016 WL 5105519 (PTAB Aug. 25, 2016) (denying petition under § 325(d) because "Petitioner now advances the same or substantially the same arguments it presented in [the prior IPR] . . . Although Petitioner now relies on [two different references], its underlying argument—that the prior art taught or suggested the exclusion of neonates with LVD from iNO treatment—is essentially the same as that raised in [the prior IPR], and …it should have been aware of the [newly-cited] references when it filed the earlier Petition.").

Similarly, the Board denies *inter partes* review where a subsequent petition asserts the same prior art references against different claims or claim elements of the previously challenged patent. *E.g., Schrader-Bridgeport Int'l v. Wasica Finance GMBH & Blueare Finance AG*, IPR2015-00272, 2015 WL 3543108, at *3

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(PTAB June 1, 2015) (denying *inter partes* review under 35 U.S.C. § 325(d) where patent owner asserted the same references against different claim elements as compared to the earlier petition); *Apple, Inc. v. Aylus Networks, Inc.*, IPR2014-01566, 2015 WL 1870711, at *4 (PTAB Apr. 23, 2015) (denying *inter partes* review under § 325(d) where petitioner challenged an 11-claim subset of the 33 claims previously challenged on the same ground and with the same prior art).

The Board also denies *inter partes* review where it determines that the subsequent petition was intended only to correct defects identified by the Board in an earlier petition. *E.g., ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00454, 2013 WL 12126100 (PTAB Sept. 25, 2013) ("A decision to institute review on some claims should not act as an entry ticket, and a how-to guide, for the same Petitioner . . . to challenge those claims which it unsuccessfully challenged in the first petition."). For example, the Board explained in *Netapp*, 2015 WL 5244971, at *4:

> "[T]he Petition in this proceeding was filed less than a month after our [decision in the prior proceeding]. The Petition makes clear that this case has been guided by, and has received the benefit of, seeing the decision addressing nearly identical grounds in the prior proceeding . . . Absent a good reason, a subsequently filed petition is not typically granted."

Id.

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In particular, the Board has rejected numerous petitions that attempt to correct obviousness-related deficiencies identified by the Board in a prior petition, such as a petitioner's failure to adequately explain how one of ordinary skill would combine the cited references to render the claimed subject matter obvious. *E.g.*, *Samsung*, 2015 WL 410653. In *Samsung*, the Board explained:

> On its face, it is more efficient for the parties and the Board to address a matter once rather than twice. The sole difference between what Petitioner presents in this proceeding and what Petitioner presented in [the prior proceeding] is that the Petitioner now provides further reasoning in support of the same combination of prior art. Therefore, the "same prior art" was "previously presented" to the Board, with respect to the same claims.
>
> Petitioner is requesting, essentially, a second chance to challenge the claims. We, however, are not persuaded that a second chance would help "secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). Permitting second chances in cases like this one ties up the Board's limited resources; we must be mindful not only of this proceeding, but of "every proceeding."
>
> In this proceeding, however, we are not apprised of a reason that merits a second chance. Petitioner simply presents arguments now that it could have made in [the prior proceeding], had it merely chosen to do so.

Id. at *4 (internal citations omitted). *See also Zimmer Holdings, Inc. v. Bonutti Skeletal Innovations LLC*, IPR2014-01080, 2014 WL 5677247, at *4 (Oct. 31, 2014) (same). Similarly, the Board in *Butamax Adv. Biofuels LLC, v. Gevo Inc.*, IPR2014-00581, 2014 WL 5299385, at *6 (PTAB Oct. 14, 2014), rejected a

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petition under § 325(d) where petitioner attempted to correct an obviousness-related deficiency, explaining:

> [W]e observe that the obviousness grounds asserted in the present Petition are intended to 'squarely address the alleged deficiencies identified by the Board' in our Decision in the [prior petition]. In other words, the four obviousness grounds are second bites at the apple, which use our prior discussion as a roadmap to remedy Butamax's prior, deficient challenge. Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act. . . . We, therefore, exercise our discretion under § 325(d) to deny institution of *inter partes* review on the four obviousness challenges.

Id.

C. 35 U.S.C. § 325(d) Compels Denial of the Petition

The Petition is an improper "second bite at the apple." adidas does not assert any new prior art, challenge any new claims, or mount any new arguments. (Pet. at 7; Ex. 2001 at 7.) Instead, adidas' Petition challenges, for a second time, claims 1–7, 9–13, and 21–38 of the '288 patent as obvious in view of Reed and Nishida; and then attempts to dress-up those arguments (exclusively through cross-reference) as a second "ground" of anticipation for claims 36–38. (*Id*; *see* footnotes 1–2 above.) As a result, because the Petition is comprised exclusively of the same arguments, challenging the same claims, and relying on the same prior art references, the Petition should be denied under 35. U.S.C. § 325(d). *HTC Corp.*,

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2015 WL 4149068, at *7 ("Here, Petitioner applies the same references by the same arguments against claim 13 in the present Petition that it applied against claim 13 in the earlier Petition. On that basis alone, we may exercise our discretion and decline to institute *inter partes* review under 35 U.S.C. § 325(d)"); *Butamax*, 2014 WL 5299385, at *6 ("Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress's intent in enacting the [AIA].")

adidas does not allege that its second challenge raises arguments that are meaningfully different from those asserted in its earlier petition. *Cont'l Auto. Sys., Inc. v. Wasica Finance GMBH & Bluearc Finance, AG*, IPR2014-01454, 2015 WL 674133, at *3 (PTAB Feb. 13, 2015) (rejecting second petition under § 325(d) where petitioner "offer[ed] no persuasive explanation as to how the arguments regarding claim 4 presented in this proceeding differ from those presented in [the earlier proceeding] in a meaningful way."). Nor does adidas offer—as it would be required to do—any "persuasive explanation as to why these [allegedly new arguments] could not have been presented in [its earlier petition]." *Id.*

Instead, the Petition merely attempts to remedy the defects identified by the Board in the earlier petition, *i.e.*, adidas' failure to "identify with particularity the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) Similar to the petitioner in *Samsung*, the "sole

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difference" between what adidas presents in this Petition and what adidas presented in the '920 IPR is that the adidas "now provides further reasoning in support of the same combination of prior art." 2015 WL 410653 at *4. In other words, adidas "simply presents arguments now that it could have made in [the '920 IPR], had it merely chosen to do so." *Id.* adidas should not be granted a second chance to present the same arguments to the Board, because "[a]bsent a good reason,"—which adidas has not provided—"a subsequently filed petition that only corrects defects identified by a Board decision in a prior petition is not typically granted." *Netapp*, 2015 WL 5244971, at *4; *Butamax*, 2014 WL 5299385, at *6. Accordingly, the Board should exercise its discretion to reject the Petition under 35 U.S.C. § 325(d).

III. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(4) FOR FAILURE TO IDENTIFY ALL RELATED MATTERS

A petition for *inter partes* review "may only be considered if," among other things, "the petition provides such other information as the Director may require by regulation." 35 U.S.C. § 312(a)(4). The Director requires petitioners to include within the petition certain mandatory notices. 37 C.F.R. § 42.8(a)(1). Mandatory notices, in turn, must "[i]dentify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding." 37 C.F.R. § 42.8(b)(2). Judicial matters include "actions involving the patent in federal court,"

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while "administrative matters" include "every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party's involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

Pursuant to 37 C.F.R. § 42.8(b)(2), adidas identifies three related patents and patent applications: U.S. Patent Nos. 7,814,598 ("'598 patent"), a parent of the '288 patent; U.S. Patent Nos. 7,347,011 ("'011 patent"), a grandparent of the '288 patent; and U.S. Patent No. 8,266,749 ("'749 patent"), a continuation of the '288 patent. adidas also identifies one federal action, *NIKE, Inc. v. adidas AG*, No. 14-1719 (Fed. Cir.), and three *inter partes* review proceedings: IPR2013-00067, involving the '011 patent; IPR2016-00921, involving the '598 patent; and IPR2016-00922, involving the '749 patent. (Pet. at 1–2.)

adidas did not identify, however, the two proceedings initiated by adidas involving the '288 patent: the '920 IPR, in which the Board denied institution of claims 1–38 of the '288 patent (Exs. 2001, 2002); and IPR2017-00263, the simultaneously filed companion to this petition in which adidas challenges claims 8 and 14–20 of the '288 patent (Ex. 2003). In fact, adidas never once mentions either proceeding in its Petition. Nor has adidas filed an updated notice of related matters, or otherwise notified the Board of its improper omission.

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adidas failure to comply with 37 C.F.R. § 42.8(b)(2), and thus 35 U.S.C. § 312(a)(4), warrants denial of the Petition. *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00358, 2015 WL 9899010, at *4 (PTAB July 2, 2015) (denying petition on other grounds, but noting that "[t]he Petition's failure to comply with 37 C.F.R. § 42.8(b)(2), and thus also 35 U.S.C. § 312(a)(4), could be ground for denial of the Petition.") (citing *Reflectix, Inc. v. Promethian Insulation Tech. LLC*, IPR2015-00039, 2015 WL 1927414, at *9 (PTAB Apr. 24, 2015) (denying institution because petition did not comply with parallel requirement, under 35 U.S.C. § 312(a)(2), to identify all real parties-in-interest).)

IV. INSTITUTION OF REVIEW SHOULD BE DENIED UNDER 35 U.S.C. § 312(a)(3) FOR FAILURE TO IDENTIFY GROUNDS AND EVIDENCE WITH PARTICULARITY

As noted above, the Board rejected adidas' petition in the '920 IPR under 35 U.S.C. § 312(a)(3) because the petition "fail[ed] to identify 'with particularity' the grounds and evidence that form the underlying basis for adidas' patentability challenge." (Ex. 2002 at 5.) The Board identified two examples of adidas' failure to provide adequate particularity, both of which remain uncorrected in adidas' instant Petition. As a result, the Board should similarly reject the instant Petition under 35 U.S.C. § 312(a)(3).

The first deficiency identified by the Board relates to adidas' challenge of claim 1, where adidas' "claim chart . . . spans four pages and constitutes bulk

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citation to large portions of both Nishida and Reed." (Ex. 2002 at 5.) adidas approach, the Board concluded, "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*Id.*)

adidas' Petition in the instant proceeding suffers from the same deficiency. Except for one instance in which adidas shortens a citation by four lines (Ex. 2001 at 15 ("3:43–48" changed to "3:47–48"), every "bulk citation" in adidas' earlier challenge of claim 1 appears, unabridged, in adidas' instant Petition. (*Compare* Ex. 2001 at 13–18 *with* Pet at. 13–22.) In fact, adidas in many cases expands its citations or includes additional citations. (*E.g.*, *Compare* Ex. 2001 at 13 [Element 1A], *with* Pet. at 14 [Element 1A] (adding citation to 1:33–35, 1:39–47 and FIGS 1–3).) As a result, the Petition in the instant proceeding "does not provide meaningful 'particularity' sufficient for the panel to ascertain where, specifically, adidas identifies the limitations of the claim in the prior art." (*See* Ex. 2002 at 5.)

Second, the Board in the '920 IPR observed that adidas' petition failed to identify which claim limitations were absent from each prior art reference, and the extent to which adidas relied upon other references in support its obviousness challenge for those limitations. (Ex. 2002 at 6 ("The Petition does not provide adequate explanation as to what features adidas contends are absent from Nishida that it also must rely on content of Reed to meet the challenged claims" and "no

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explanation emerges as to how or why Shimura's and Shepherd's teachings are germane to claim 1") (*citing Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (obvious analysis must describe (1) the scope and content of the prior art and (2) any differences between the claimed subject matter and the prior art.).)

adidas' Petition in the instant proceeding suffers from the same deficiency. adidas' new "explanation" is comprised essentially of quotations copied from its claim charts and reproduced, redundantly, in the immediately preceding body of the petition. (*Compare* Ex. 2001 at 13–18 *with* Pet. at 13–22.) In addition, rather than explaining which claim elements are absent in each reference, adidas offers, in total, four sentences ambiguously suggesting that certain references may or may not "explicitly" disclose certain features. (Pet. at 14 ("[t]o the extent that Reed does not explicitly state . . ."), 16 (same), 20 (same), 37 (same), 40 (same) Pet. at 14 ("While Shiomura does not explicitly reference using a circular knitting machine . . .").) As a result, the Petition in the instant proceeding, as in the '920 IPR, requires the Board and NIKE to "guess as to what limitations adidas seeks to supply from the teachings of each of the references that it cites as a part of the proposed ground." (Ex. 2002 at 6.)

In sum, adidas fails to correct the deficiencies that led the Board to reject adidas' petition in the '920 IPR. Here too, "the noted uncertainties and vagaries arising from [the Petition] do not lend themselves to informed evaluation of the

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ground by the panel . . . [and] deprive Nike of an appropriate basis for it to formulate a response to the Petition." As a result, the Board should reject the Petition under 35 U.S.C. § 312(a)(3).

V. CONCLUSION

As set forth above, NIKE respectfully requests that the Board deny institution of IPR2017-00264.

Date: March 9, 2017

Respectfully submitted,

/s/ Christopher J. Renk

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), NIKE hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this preliminary response, that the number of words in this paper is 4,061. Pursuant to 37 C.F.R. §42.24(d), this word count excludes the table of contents, table of authorities, certificate of service, and appendix of exhibits.

Dated: March 9, 2017

/s/ Christopher J. Renk
Christopher J. Renk
Banner & Witcoff, Ltd.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on March 9, 2017, by Express Mail and email directed to the attorneys of record for Petitioner as follows:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner

v.

Nike, Inc.
Patent Owner

Case IPR2017-00264
Patent No. 8,042,288

PETITIONER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. §42.8, Petitioner, adidas AG, hereby submits the following Updated Mandatory Notices information:

II. MANDATORY NOTICES

A. Real Party in Interest under 37 C.F.R. § 42.8(b)(1)

There is no change to the identity of real party in interest provided in the Petition. In that filing, Petitioner identified the real party in interest as follows:

Petitioner, adidas AG, the ultimate parent of adidas International B.V., adidas North America, Inc., adidas America, Inc., and adidas International, Inc., is the real party-in-interest for the instant petition.

B. Related Matters under 37 C.F.R. § 42.8(b)(2)

In accordance with 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related proceedings that may affect, or be affected by, a decision in the proceeding:

Petition for *inter partes* review of claims 1-38 of the '288 patent (IPR2016-00920), for which the Board denied institution.[1]

Petition to *inter partes* review of claims 8 and 14-20 of the '288 patent (IPR2017-00263), filed simultaneously with the instant Petition.

There is no change to the identity of the other related matters provided in the Petition. In that filing, Petitioner identified the related matters as follows:

[1] The citation to IPR2016-00920 appears on page 48 (and is discussed at pages 48-51) of the Petition, and this updated notice adds an additional citation to IPR2016-00920 in the "Related Matters" section of the Petition.

The '288 patent is a continuation application of U.S. Patent No. 7,814,598, which is a divisional application of U.S. Patent No. 7,347,011 ("the '011 patent"). U.S. Patent No. 8,266,749 is a continuation application of the '288 patent.

The Board instituted *inter partes* review of claims 1-46 of the '011 patent (IPR2013-00067), and Nike requested cancellation of claims 1-46 and proposed substitute claims 47-50. The Board granted the motion to cancel, but denied the motion as to the substitute claims. Nike appealed the Board's decision to the Federal Circuit (Case No. 2014-1719). The Federal Circuit issued a decision on February 11, 2016, which affirmed-in-part, vacated-in-part, and remanded the case to the Board for further proceedings on secondary consideration and patentability of dependent claim 49.

The Board instituted *inter partes* review of claims 1-13 of the '598 patent (IPR2016-00921), and instituted *inter partes* review of claims 1-9, 11-19, and 21 of the '749 patent (IPR2016-00922).

D. Designation of Lead Counsel and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)

There is no change to the designation of lead and backup counsel provided in the Petition. In that filing, Petitioner designated lead counsel and substitute back-up counsel as follows:

Lead Counsel	Back-Up Counsel
Mitchell G. Stockwell Reg. No. 39,389 mstockwell@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 815 6214	Vaibhav P. Kadaba Reg. No. 45,865 wkadaba@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 532 6959 Tiffany L. Williams Reg. No. 59,549 tiwilliams@kilpatricktownsend.com Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, NE, Suite 2800 Atlanta, Georgia 30309 (404) 815 6608

Petitioner continues to respectfully request that service be provided at the email addresses listed above.

Respectfully submitted,

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8** has been served on March 28, 2017, by Express Mail and email directed to the attorneys of record for Patent Owner as follows:

Christopher J. Renk
Michael J. Jarris
BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago, Illinois 60606
crenk@bannerwitcoff.com,
mharris@bannerwitcoff.com, and
bwlitdocket@bannerwitcoff.com

Dated: March 28, 2017

By: /s/ Mitchell G. Stockwell
Mitchell G. Stockwell
Registration No. 39,389
Lead Counsel for Petitioner

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: July 14, 2017 Name: Christopher J. Gerardot (Reg. No. 73,644) Signature: /Christopher J. Gerardot/

BANNER WITCOFF

FIFTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15/358,723
Filing Date	November 22, 2016
First Named Inventor	Bhupesh Dua et al.
Art Unit	3765
Confirmation Number	4188
Examiner Name	Carter, Cameron A.
Attorney Docket No.	15571-1169/08-1313US77CON

In accordance with the duty of disclosure, Applicant(s) hereby cites the following references:

OTHER ART – NON PATENT LITERATURE DOCUMENTS

EXAMINER INITIAL	Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	
	G1	Petitioner Adidas AG's Request for Rehearing Under 37 C.F.R. § 42.71 On The Decision Not to Institute Inter Partes Review for Inter Partes Review IPR2017-00263, dated July 7, 2017, 17 pages.
	G2	Petitioner Adidas AG's Request for Rehearing Under 37 C.F.R. § 42.71 On The Decision Not to Institute Inter Partes Review for Inter Partes Review IPR2017-00264, dated July 7, 2017, 17 pages.
	G3	Petitioner's Demonstratives for Inter Partes Review IPR2016-00921, dated July 10, 2017 and for Inter Partes Review IPR2016-00922, 84 pages.
	G4	Patent Owner NIKE's Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00921, dated July 11, 2017, 3 pages.
	G5	Petitioner's Updated Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00921, dated July 11, 2017, 4 pages.
	G6	Patent Owner NIKE Inc.'s Demonstratives for Inter Partes Review IPR2016-00921, dated July 11, 2017 and for Inter Partes Review IPR2016-00922, 27 pages.
	G7	Patent Owner NIKE's Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00922, dated July 11, 2017, 3 pages.
	G8	Petitioner's Updated Exhibit List (As of July 11, 2017) for Inter Partes Review IPR2016-00922, dated July 11, 2017, 4 pages.

1. PRIORITY INFORMATION:

☐ This application claims priority under 35 USC §120 to the following United States patent application(s): _____. In accordance with 37 CFR §1.98(d), copies of the references cited herein which were submitted to, or cited by, the office, in compliance with 37 CFR §1.98(a)-(c) in the earlier application are not provided herewith. The Examiner is directed to those references cited in all Information Disclosure Statements filed in the priority United States patent application(s) cited above in addition to the references cited herein.

2. CERTIFICATIONS: (CHECK ALL THAT APPLY)

A. Certifications For 37 CFR §1.97(c) or 37 CFR §1.97(d):

☐ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(1) that each item of information in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

Examiner Signature		Date Considered	

Skechers EX1013-p. 628
Skechers v Nike

☒ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(2) that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this Statement was known to any individual designated in 37 CFR §1.56(c), more than three months prior to the filing of this Information Disclosure Statement.

B. For Patent Term Adjustment Purposes:

☒ For purposes of 37 CFR §1.704(d)(i) or 37 CFR §1.704(d)(ii), Applicant hereby certifies that each item of information contained in this Information Disclosure Statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office or is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and that this communication was not received by any individual designated in 37 CFR §1.56(c) more than thirty days prior to the filing of this Information Disclosure Statement.

3. FEE INFORMATION: (CHECK IF FEE REQUIRED)

☐ Applicant has calculated a processing fee in the amount of _____ to be due under 37 CFR §1.17(p) in connection with the filing of this Information Disclosure Statement. Applicant authorizes charging the fee to Deposit Account _____.

☒ The Director is hereby authorized to charge any fee deficiency associated with the filing of this Information Disclosure Statement to Deposit Account 23-1925.

Pursuant to the undersigned attorney's obligation and duties under 37 CFR §§ 1.56 and 1.98(a)(3) and (c), either English language abstracts, partial translations, or full translations are included for patent documents which are not in English for the express purpose of providing a concise explanation of the references to the Patent and Trademark Office with the opportunity to evaluate the same. Applicant respectfully requests the Examiner's consideration of the above reference(s) and entry thereof into the record of this application.

By submitting this Statement, Applicant is attempting to fully comply with the duty of candor and good faith mandated by 37 CFR §1.56. As such, this Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 CFR §1.56(a).

Respectfully submitted,

July 14, 2017
Date

/Christopher J. Gerardot/
Christopher J. Gerardot (Reg. No. 73,644)

Examiner Signature		Date Considered	

Electronic Acknowledgement Receipt

EFS ID:	29781198
Application Number:	15358723
International Application Number:	
Confirmation Number:	4188
Title of Invention:	Article of Footwear Having A Textile Upper
First Named Inventor/Applicant Name:	Bhupesh Dua
Customer Number:	133691
Filer:	Christopher J. Gerardot/Michael Lopez
Filer Authorized By:	Christopher J. Gerardot
Attorney Docket Number:	15571-1169/08-1313US77CON
Receipt Date:	14-JUL-2017
Filing Date:	22-NOV-2016
Time Stamp:	17:44:20
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		15571-1169IDSPTO.pdf	177424 bd2e3f028a934fbc56bc410d07605f56e7d7faca	yes	3

	Multipart Description/PDF files in .zip description					
	Document Description		Start		End	
	Miscellaneous Incoming Letter		1		1	
	Information Disclosure Statement (IDS) Form (SB08)		2		3	
Warnings:						
Information:						
2	Non Patent Literature	AdidasRequestforRehearingIPR201700263.pdf	9062449 9dfee5687c78d5b78db962ebe1de987d7954d6ed	no	17	
Warnings:						
Information:						
3	Non Patent Literature	AdidasRequestforRehearingIPR201700264.pdf	9065468 d75ffe9d2d0d207a2cdd455c798bd88fc58eddf7	no	17	
Warnings:						
Information:						
4	Non Patent Literature	PetitionersDemonstrativesIPR201600921and00922a.pdf	12040481 ae7803f8f080690b736cd758b0a1d23ad1757960	no	84	
Warnings:						
Information:						
5	Non Patent Literature	NikeExhibitListIPR201600921.pdf	466350 2505a666437aec166bdc34150d471316b62f7373	no	3	
Warnings:						
Information:						
6	Non Patent Literature	PetitionersUpdatedExhibitListIPR201600921.pdf	1037011 67818c6103e3d88555b6a49687252f4a98aa60ce	no	4	
Warnings:						
Information:						
7	Non Patent Literature	NikeDemonstrativesIPR201600921and00922.pdf	19081625 71f9351e9e47d48249f01023a4a1d4279c3b717e	no	27	
Warnings:						

Information:					
8	Non Patent Literature	NikeExhibitListIPR201600922.pdf	467179 b0631cdc1c86aa628bca05d05356ce7a013a2057	no	3
Warnings:					
Information:					
9	Non Patent Literature	PetitionersUpdatedExhibitListIPR201600922.pdf	943791 fd14d9d0945347e938362a609b8507a330625188	no	4
Warnings:					
Information:					
			Total Files Size (in bytes):	52341778	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: July 14, 2017 Name: Christopher J. Gerardot (Reg. No. 73,644) Signature: /Christopher J. Gerardot/

BRINKS GILSON & LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Bhupesh Dua et al.		
Appln. No.:	15/358,723	Examiner:	Carter, Cameron A.
Filed:	November 22, 2016	Art Unit:	3765
For:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	Conf. No.:	4188
Attorney Docket No.:	15571-1169/08-1313US77CON		

TRANSMITTAL

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

☒ Transmittal Letter; Sixth Supplemental Information Disclosure Statement and References G1-G8.

Fee calculation:

☒ No additional fee is required.

☐ Per 37 CFR §1.27, ☐ Applicant is small entity ☐ Applicant is micro entity.

☐ An extension fee in an amount of $_____ for a _____-month extension of time under 37 CFR § 1.136(a).

☐ A petition or processing fee in an amount of $_____ under 37 CFR § 1.1_____(_____).

☐ An additional filing fee has been calculated as shown below:

					Fee		Small Entity Fee		Micro Entity Fee	
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus			x $ 80 =	$	x $ 40 =	$	x $20 =	$
Independent		Minus			x $420 =	$	x $210 =	$	x $105 =	$
First Presentation of Multiple Dep. Claim					+ $780 =	$	+ $390 =	$	+ $195 =	$
					Total	$	Total	$	Total	$

Fee payment:

☐ Please charge Deposit Account No. 23-1925 in the amount of $_____ for _____.

☐ Payment by credit card in the amount of $_____ (Form PTO-2038 is attached).
WARNING: Information on this form may become public. **Credit card information should not be included on this form.**

☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

July 14, 2017
Date

/Christopher J. Gerardot/
Christopher J. Gerardot (Reg. No. 73,644)

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: June 22, 2017 Name: Christopher J. Gerardot, Reg. No. 73,644 Signature: /Christopher J. Gerardot/

BRINKS GILSON & LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Bhupesh DUA et al.	
Appln. No.:	15/358,723	Examiner: Carter, Cameron A.
Filed:	November 22, 2016	Art Unit: 3765
For:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	Conf. No.: 4188
Attorney Docket No.: 15571-1169/08-1313US77CON		

INTERVIEW SUMMARY AND RESPONSE TO NON-FINAL OFFICE ACTION

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Non-Final Office Action dated April 5, 2017, Applicant electronically submits this timely response and interview summary for the Examiner interview conducted on April 19, 2017.

A **Listing of the Claims** begins on page 2 of this paper.

Interview Summary and Remarks begin on page 6 of this paper.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: June 22, 2017 Name: Christopher J. Gerardot, Reg. No. 73,644 Signature: /Christopher J. Gerardot/

BRINKS GILSON LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Bhupesh DUA et al.	
Appln. No.:	15/358,723	Examiner: Carter, Cameron A.
Filed:	November 22, 2016	Art Unit: 3765
For:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	Conf. No.: 4188
Attorney Docket No.:	15571-1169/08-1313US77CON	

TRANSMITTAL

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Attached are:

☒ Transmittal; Interview Summary and Response to Non-Final Office Action.

Fee calculation:

☒ No additional fee is required.

☐ Per 37 CFR §1.27, ☐ Applicant is small entity ☐ Applicant is micro entity.

☐ An extension fee in an amount of $_____ for a _____-month extension of time under 37 CFR § 1.136(a).

☐ A petition or processing fee in an amount of $_____ under 37 CFR § 1.17(_____).

☐ An additional filing fee has been calculated as shown below:

					Fee		Small Entity Fee		Micro Entity Fee	
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus			x $ 80 =	$	x $ 40 =	$	x $20 =	$
Independent		Minus			x $420 =	$	x $210 =	$	x $105 =	$
First Presentation of Multiple Dep. Claim					+ $780 =	$	+ $390 =	$	+ $195 =	$
					Total	$	Total	$	Total	$

Fee payment:

☐ Please charge Deposit Account No. 23-1925 in the amount of $_____ for _____.

☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

June 22, 2017
Date

/Christopher J. Gerardot/
Christopher J. Gerardot (Reg. No. 73,644)

Electronic Acknowledgement Receipt

EFS ID:	29573957
Application Number:	15358723
International Application Number:	
Confirmation Number:	4188
Title of Invention:	Article of Footwear Having A Textile Upper
First Named Inventor/Applicant Name:	Bhupesh Dua
Customer Number:	133691
Filer:	Christopher J. Gerardot/Jesus Rodriguez
Filer Authorized By:	Christopher J. Gerardot
Attorney Docket Number:	15571-1169/08-1313US77CON
Receipt Date:	22-JUN-2017
Filing Date:	22-NOV-2016
Time Stamp:	11:40:31
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		155711169Rsp.pdf	69220 d4c78035fee697b8f2a703b29cb97a714178a9fb	yes	9

	Multipart Description/PDF files in .zip description		
	Document Description	**Start**	**End**
	Applicant Arguments/Remarks Made in an Amendment	6	9
	Claims	2	5
	Amendment/Req. Reconsideration-After Non-Final Reject	1	1

Warnings:					
Information:					
2	Miscellaneous Incoming Letter	155711169tl.pdf	50266 ae7b4bffb5e5b5d3a12529a14e0dac01dd4034aa	no	1
Warnings:					
Information:					
		Total Files Size (in bytes):	119486		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Remarks

Claims 21-40 are pending. Reconsideration of this application is respectfully requested in view of the following remarks.

I. Interview Summary

Applicant thanks Examiner Cameron Carter and Supervisory Examiner Clinton Ostrup for interviewing this case on April 19, 2017 with Danielle Gillen (Reg. No. 68,197), Applicant's attorney representative. During the interview, the 35 U.S.C. § 103 rejections based on U.S. Patent No. 5,345,638 to Nishida ("Nishida") in view of U.S. Patent No. 6,931,762 to Dua ("Dua") were discussed. Ms. Gillen asserted that Nishida at least fails to disclose "flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed," as recited in part by independent claims 21 and 31, and also identified for the Examiners the U.S. Court of Appeals for the Federal Circuit's decision in the parent application for this application concerning a similar limitation. While no agreement was reached, Applicant asserts its argument herein for the Examiners' consideration.

II. Claim Objections

Claim 21 stands objected to regarding an extra space between "second" and "knit." Claim 21 is amended obviating the objection, and no new matter has been added.

III. Double Patenting Rejections

Claims 21-40 stand rejected based on nonstatutory double patenting as being allegedly unpatentable over claims 1-46 of U.S. Patent No. 7,347,011 and claims 1-21 of U.S. Patent No. 8,266,749. Applicant respectfully requests that such double patent rejections are held in abeyance until the Examiner has indicated that one or more of the pending claims include allowable subject matter.

IV. 35 U.S.C. § 103 Claim Rejections

Claims 21-40 stand rejected under pre-AIA 35 U.S.C. § 103(a) as allegedly obvious over Nishida in view of Dua.

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Independent claims 21 and 31 each recite in part "flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed." In the Non-Final Office Action, the Examiner relies on Nishida for such a disclosure. (*See* April 5, 2017 Non-Final Office Action, 4, 8.)

This application claims priority to U.S. Patent Application No. 10/791,289, now U.S. Patent No. 7,347,011, which is the subject of *inter partes* review IPR2013-00067. In IPR2013-00067, the Patent Trial and Appeal Board's Final Written Decision was appealed to the U.S. Court of Appeals for the Federal Circuit. On appeal, the Federal Circuit found the following:

> Each of Nike's proposed substitute claims is directed to a 'flat knit textile element . . . having flat knit edges free of surrounding textile structure.' . . . The [Patent Trial and Appeal] Board . . . determined that the broadest reasonable construction of the term 'flat knit edges' is 'an edge of a flat knit textile element, which is itself flat knit, e.g. which is not formed by cutting from a flat knit textile element.' . . . We agree with the Board's construction. . . . This claim language demonstrates that the scope of this claim is limited to a flat-knit textile element where the flat knit edges have not been removed, or cut, from a surrounding textile structure. An interpretation that included a flat-knit textile element that has been cut from a larger textile web would contradict the express claim language."

NIKE, Inc. v. Adidas AG, No. 2014-1719, slip op. at 32-33 (Fed. Cir. Feb. 11, 2016); *see also Adidas AG v. NIKE, Inc.*, IPR2013-00067, Paper 60 at 18-19 (PTAB Apr. 28, 2014). The Federal Circuit also found that "[t]he process disclosed in Nishida . . . requires that the portion of the pattern corresponding to the shoe upper be cut from the surrounding textile web." *NIKE, Inc.*, No. 2014-1719, slip op. at 14. For at least this reason, Nishida fails to teach, suggest or disclose independent claims 21 and 31, and Dua does not cure the deficiencies of Nishida.

Moreover, the Examiner acknowledges that Nishida does not disclose "a first knit strip having a first knit construction and a second knit strip having a second knit construction that is different from the first knit construction; wherein the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper," as recited in part by independent claim 21, and relies on Dua for such a disclosure. (Apr. 5, 2017 Non-Final Office Action, 4-5.) The Examiner also acknowledges that Nishida does not disclose "a first knit strip formed

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from yarns of a first yarn type and a second knit strip formed from yarns of a second yarn type that is different from the first yarn type; wherein the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper; wherein one or both of the first knit strip and the second knit strip comprises a plurality of strips; and wherein the first and second knit strips alternate with one another along one or more of the lateral side and the medial side of the upper," as recited in part by independent claim 31, and relies on Dua for such a disclosure. (*Id.*, 8-9.)

Dua does not qualify as prior art pursuant to pre-AIA 35 U.S.C. § 103(c)(1). Pre-AIA 35 U.S.C. § 103(c)(1) states the following:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As identified above, the present application claims priority to U.S. Patent Application No. 10/791,289 ("the '289 application"), which was filed on March 3, 2004. Dua issued on August 23, 2005 and does not have a prior publication date. Dua therefore does not qualify as prior art under pre-AIA 35 U.S.C. §§ 102(a) or 102(b) and qualifies as prior art only under at least pre-AIA 35 U.S.C. § 102(e)(2). Dua also constitutes subject matter developed by another person because the inventive entity of the '289 application is different than the inventive entity of Dua. *See* MPEP 2136.04. Also, at least as of the filing date of the '289 application, Dua and the '289 application were both owned and/or subject to an obligation of assignment to NIKE, Inc. *See* Reel/Frame No. 014902 / 0758 & Reel/Frame No. 013832 / 0270. Therefore, pursuant to pre-AIA 35 U.S.C. § 103(c)(1), Dua is disqualified as prior art.

Therefore, claim 21, and claims 22-30 that depend therefrom, and claim 31, and claims 32-40 that depend therefrom, are allowable, and Applicant respectfully requests reconsideration and withdrawal of the § 103 rejections of claims 21-40Conclusion

In view of the foregoing remarks, Applicant respectfully submits that the rejections have been overcome and the pending claims are believed to be patentable. Accordingly, Applicant respectfully requests that the Examiner grant allowance of this

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Skechers v Nike

application. The Examiner is invited to contact the undersigned attorney for the Applicant via telephone if such communication would expedite this application.

Respectfully submitted,

Dated: June 22, 2017

/Christopher J. Gerardot/
Danielle C. Gillen (Reg. No. 68,197)
Christopher J. Gerardot (Reg. No. 73,644)
Attorneys for Applicant

BRINKS GILSON & LIONE
PO BOX 10395
CHICAGO, IL 60610
(312) 321-4200

Skechers EX1013-p. 641
Skechers v Nike

Listing of the Claims

A complete listing of the claims proper claim identifiers is set forth below.

1-20. (Cancelled)

21. (Currently Amended) An upper for an article of footwear, the upper comprising:

a flat knit textile element comprising (1) flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed and (2) a first knit strip having a first knit construction and a second knit strip having a second knit construction that is different from the first knit construction;

wherein the first knit strip and the second -knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper.

22. (Previously Presented) The upper of clam 21, wherein one or both of the first knit strip and the second knit strip comprises a plurality of knit strips.

23. (Previously Presented) The upper of claim 22, wherein the first and second knit strips alternate with one another along one or more of the lateral side and the medial side of the upper.

24. (Previously Presented) The upper of claim 22, wherein the flat knit textile element comprises at least two of the first knit strip and at least two of the second knit strip.

25. (Previously Presented) The upper of claim 21, wherein the first knit strip and the second knit strip extend along the lateral side of the upper from an instep region of the upper to an area proximate to a lower region of the upper.

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26. (Previously Presented) The upper of claim 21, wherein the first knit strip and the second knit strip extend along the medial side of the upper from an instep region of the upper to an area proximate to a lower region of the upper.

27. (Previously Presented) The upper of claim 21, wherein the first knit construction of the first knit strip comprises a smooth texture, and the second knit construction of the second knit strip comprises a rough texture.

28. (Previously Presented) The upper of claim 21, wherein the flat knit textile element further comprises a plurality of apertures in an instep region of the upper.

29. (Previously Presented) The upper of claim 21, wherein the first knit construction of the first knit strip comprises a higher degree of stretch than the second knit construction of the second knit strip.

30. (Previously Presented) The upper of claim 21, wherein the second knit construction of the second knit strip comprises a higher degree of stretch than the first knit construction of the first knit strip.

31. (Previously Presented) An upper for an article of footwear, the upper comprising:

a flat knit textile element comprising (1) flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed and (2) a first knit strip formed from yarns of a first yarn type and a second knit strip formed from yarns of a second yarn type that is different from the first yarn type;

wherein the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper;

wherein one or both of the first knit strip and the second knit strip comprises a plurality of strips; and

wherein the first and second knit strips alternate with one another along one or more of the lateral side and the medial side of the upper.

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Skechers v Nike

32. (Previously Presented) The upper of claim 31, wherein the flat knit textile element comprises at least two of the first knit strip and at least two of the second knit strip.

33. (Previously Presented) The upper of claim 31, wherein the first knit strip and the second knit strip extend along the lateral side of the upper from an instep region of the upper to an area proximate to a lower region of the upper.

34. (Previously Presented) The upper of claim 31, wherein the first knit strip and the second knit strip extend along the medial side of the upper from an instep region of the upper to an area proximate to a lower region of the upper.

35. (Previously Presented) The upper of claim 31, wherein the first yarn type of the first knit strip comprises a smooth texture, and the second yarn type of the second knit strip comprises a rough texture.

36. (Previously Presented) The upper of claim 31, wherein the flat knit textile element further comprises a plurality of apertures in an instep region of the upper.

37. (Previously Presented) The upper of claim 31, wherein the first yarn type of the first knit strip comprises a higher degree of stretch than the second yarn type of the second knit strip.

38. (Previously Presented) The upper of claim 31, wherein the second yarn type of the second knit strip comprises a higher degree of stretch than the first yarn type of the first knit strip.

39. (Previously Presented) The upper of claim 31, wherein the first yarn type of the first knit strip comprises at least one of a higher biodegradability, moisture absorption, insulation, durability, and/or hydrophobicity than the second yarn type of the second knit strip.

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40. (Previously Presented) The upper of claim 31, wherein the first yarn type of the first knit strip comprises at least one of a higher strength, support, stiffness, recovery, fit and/or form than the second yarn type of the second knit strip.

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Skechers v Nike

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: June 19, 2017 Name: Christopher J. Gerardot (Reg. No. 73,644) Signature: /Christopher J. Gerardot/

BANNER WITCOFF

FIFTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15/358,723
Filing Date	November 22, 2016
First Named Inventor	Bhupesh Dua et al.
Art Unit	3765
Confirmation Number	4188
Examiner Name	Carter, Cameron A.
Attorney Docket No.	15571-1169/08-1313US77CON

In accordance with the duty of disclosure, Applicant(s) hereby cites the following references:

OTHER ART – NON PATENT LITERATURE DOCUMENTS

EXAMINER INITIAL		Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
	F1	Decision Denying Institution of Inter Partes Review Under 37 C.F.R. § 42.108 for Inter Partes Review IPR2017-00263 dated June 7, 2017, 11 pages.
	F2	Decision Denying Institution of Inter Partes Review Under 37 C.F.R. § 42.108 for Inter Partes Review IPR2017-00264 dated June 7, 2017, 12 pages.
	F3	Patent Owner Nike Inc.'s Request for Oral Argument for Inter Partes Review IPR2016-00921 dated June 12, 2017, 4 pages.
	F4	Petitioner's Request for Oral Argument for Inter Partes Review IPR2016-00921 dated June 12, 2017, 4 pages.
	F5	Patent Owner Nike Inc.'s Request for Oral Argument for Inter Partes Review IPR2016-00922 dated June 12, 2017, 4 pages.
	F6	Petitioner's Request for Oral Argument for Inter Partes Review IPR2016-00922 dated June 12, 2017, 4 pages.
	F7	ORDER Oral Hearing Under 37 C.F.R. § 42.70 for Inter Partes Review IPR2016-00921 and for Inter Partes Review IPR2016-00922 dated June 14, 2017, 6 pages.

1. PRIORITY INFORMATION:

☐ This application claims priority under 35 USC §120 to the following United States patent application(s): _____. In accordance with 37 CFR §1.98(d), copies of the references cited herein which were submitted to, or cited by, the office, in compliance with 37 CFR §1.98(a)-(c) in the earlier application are not provided herewith. The Examiner is directed to those references cited in all Information Disclosure Statements filed in the priority United States patent application(s) cited above in addition to the references cited herein.

2. CERTIFICATIONS: (CHECK ALL THAT APPLY)

A. Certifications For 37 CFR §1.97(c) or 37 CFR §1.97(d):

☐ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(1) that each item of information in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

☒ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(2) that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of

Examiner Signature		Date Considered	

information contained in this Statement was known to any individual designated in 37 CFR §1.56(c), more than three months prior to the filing of this Information Disclosure Statement.

B. For Patent Term Adjustment Purposes:

☒ For purposes of 37 CFR §1.704(d)(i) or 37 CFR §1.704(d)(ii), Applicant hereby certifies that each item of information contained in this Information Disclosure Statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office or is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and that this communication was not received by any individual designated in 37 CFR §1.56(c) more than thirty days prior to the filing of this Information Disclosure Statement.

3. FEE INFORMATION: (CHECK IF FEE REQUIRED)

☐ Applicant has calculated a processing fee in the amount of _____ to be due under 37 CFR §1.17(p) in connection with the filing of this Information Disclosure Statement. Applicant authorizes charging the fee to Deposit Account _____.

☒ The Director is hereby authorized to charge any fee deficiency associated with the filing of this Information Disclosure Statement to Deposit Account 23-1925.

Pursuant to the undersigned attorney's obligation and duties under 37 CFR §§ 1.56 and 1.98(a)(3) and (c), either English language abstracts, partial translations, or full translations are included for patent documents which are not in English for the express purpose of providing a concise explanation of the references to the Patent and Trademark Office with the opportunity to evaluate the same. Applicant respectfully requests the Examiner's consideration of the above reference(s) and entry thereof into the record of this application.

By submitting this Statement, Applicant is attempting to fully comply with the duty of candor and good faith mandated by 37 CFR §1.56. As such, this Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 CFR §1.56(a).

Respectfully submitted,

June 19, 2017
Date

/Christopher J. Gerardot/
Christopher J. Gerardot (Reg. No. 73,644)

Examiner Signature		Date Considered	

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: June 19, 2017 Name: Christopher J. Gerardot (Reg. No. 73,644) Signature: /Christopher J. Gerardot/

BRINKS GILSON & LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Bhupesh Dua et al.		
Appln. No.:	15/358,723	Examiner:	Carter, Cameron A.
Filed:	November 22, 2016	Art Unit:	3765
For:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	Conf. No.:	4188
Attorney Docket No.:	15571-1169/08-1313US77CON		

TRANSMITTAL

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

☒ Transmittal Letter; Fifth Supplemental Information Disclosure Statement and References F1-F7.

Fee calculation:

☒ No additional fee is required.

☐ Per 37 CFR §1.27, ☐ Applicant is small entity ☐ Applicant is micro entity.

☐ An extension fee in an amount of $_____ for a _____-month extension of time under 37 CFR § 1.136(a).

☐ A petition or processing fee in an amount of $_____ under 37 CFR § 1.1_____(_____).

☐ An additional filing fee has been calculated as shown below:

					Fee		Small Entity Fee		Micro Entity Fee	
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus			x $ 80 =	$	x $ 40 =	$	x $20 =	$
Independent		Minus			x $420 =	$	x $210 =	$	x $105 =	$
First Presentation of Multiple Dep. Claim					+ $780 =	$	+ $390 =	$	+ $195 =	$
					Total	$	Total	$	Total	$

Fee payment:

☐ Please charge Deposit Account No. 23-1925 in the amount of $_____ for _____.

☐ Payment by credit card in the amount of $_____ (Form PTO-2038 is attached).
WARNING: Information on this form may become public. **Credit card information should not be included on this form.**

☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

June 19, 2017
Date

/Christopher J. Gerardot/
Christopher J. Gerardot (Reg. No. 73,644)

Electronic Acknowledgement Receipt

EFS ID:	29504148
Application Number:	15358723
International Application Number:	
Confirmation Number:	4188
Title of Invention:	Article of Footwear Having A Textile Upper
First Named Inventor/Applicant Name:	Bhupesh Dua
Customer Number:	133691
Filer:	Christopher J. Gerardot/Michael Lopez
Filer Authorized By:	Christopher J. Gerardot
Attorney Docket Number:	15571-1169/08-1313US77CON
Receipt Date:	19-JUN-2017
Filing Date:	22-NOV-2016
Time Stamp:	16:38:08
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Non Patent Literature	DecisionDenyingInstitutionIPR201700263.pdf	5775302 62b743e1f5d86791e9b80ee7291dff0033c07aea	no	11

Warnings:

Information:					
2	Non Patent Literature	DecisionDenyingInstitutionIPR201700264.pdf	5837935 416e3f9086fe3bb58a8004541de43945a3d072c5	no	12
Warnings:					
Information:					
3	Non Patent Literature	OwnerRequestOralArgumentIPR201600921.pdf	1317440 8b29f3fcda07836ef7b7eb65a4afc129a2ba74db	no	4
Warnings:					
Information:					
4	Non Patent Literature	PetitionerRequestOralArgumentIPR201600921.pdf	1250476 0a23cb7236b07717a425133dad27a31b8abde20e	no	4
Warnings:					
Information:					
5	Non Patent Literature	OwnerRequestOralArgumentIPR201600922.pdf	1282116 87f0ef8076f29cc767eda2b46e929a14dce19807	no	4
Warnings:					
Information:					
6	Non Patent Literature	PetitionerRequestOralArgumentIPR201600922.pdf	1270730 9648f8f93966ba9911b45fd89e89631e14555353	no	4
Warnings:					
Information:					
7	Non Patent Literature	OrderOralHearingIPR201600921and922.pdf	2522637 dccebd8e1d82c61f730c3b7b906259d61375aa9d	no	6
Warnings:					
Information:					
8		15571-1169IDSPTO.pdf	177200 035e2dc9ec41e273f79d88ad4fd91939ea3fbe12	yes	3
	Multipart Description/PDF files in .zip description				
	Document Description		**Start**	**End**	

	Information Disclosure Statement (IDS) Form (SB08)	2	3
	Miscellaneous Incoming Letter	1	1
Warnings:			
Information:			
	Total Files Size (in bytes):	19433836	

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: June 1, 2017 Name: Christopher J. Gerardot (Reg. No. 73,644) Signature: /Christopher J. Gerardot/

FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	15/358,723
	Filing Date	November 22, 2016
	First Named Inventor	Bhupesh Dua et al.
	Art Unit	3765
	Confirmation Number	4188
	Examiner Name	Carter, Cameron A.
	Attorney Docket No.	15571-1169/08-1313US77CON

In accordance with the duty of disclosure, Applicant(s) hereby cites the following references:

OTHER ART – NON PATENT LITERATURE DOCUMENTS

EXAMINER INITIAL	Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	
	E1	Petitioner Adidas AG's Notice of Supplemental Evidence in Response to Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(B)(1) for Inter Partes Review IPR2016-00921 dated May 12, 2017, 4 pages.
	E2	Petitioner's Exhibit List (as of May 12, 2017) for Inter Partes Review IPR2016-00921, dated May 12, 2017, 4 pages.
	E3	Declaration of Tiffany L. Williams, and submitted to the US Patent and Trademark Office on May 12, 2017 as Exhibit 1015 to the Petitioner Adidas AG's Notice of Supplemental Evidence in Response to Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(B)(1) for Inter Partes Review IPR2016-00921 dated May 12, 2017 and for Inter Partes Review IPR2016-00922.
	E4	Petitioner Adidas AG's Notice of Supplemental Evidence in Response to Patent Owner's Objections to Evidence Under 37 C.F.R. § 42.64(B)(1) for Inter Partes Review IPR2016-00922 dated May 12, 2017, 4 pages
	E5	Petitioner's Exhibit List (as of May 12, 2017) for Inter Partes Review IPR2016-00922, dated May 12, 2017, 4 pages.

1. PRIORITY INFORMATION:

☐ This application claims priority under 35 USC §120 to the following United States patent application(s): _____. In accordance with 37 CFR §1.98(d), copies of the references cited herein which were submitted to, or cited by, the office, in compliance with 37 CFR §1.98(a)-(c) in the earlier application are not provided herewith. The Examiner is directed to those references cited in all Information Disclosure Statements filed in the priority United States patent application(s) cited above in addition to the references cited herein.

2. CERTIFICATIONS: (CHECK ALL THAT APPLY)

A. Certifications For 37 CFR §1.97(c) or 37 CFR §1.97(d):

☐ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(1) that each item of information in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

☒ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(2) that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of

Examiner Signature		Date Considered	

information contained in this Statement was known to any individual designated in 37 CFR §1.56(c), more than three months prior to the filing of this Information Disclosure Statement.

B. For Patent Term Adjustment Purposes:

☒ For purposes of 37 CFR §1.704(d)(i) or 37 CFR §1.704(d)(ii), Applicant hereby certifies that each item of information contained in this Information Disclosure Statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office or is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and that this communication was not received by any individual designated in 37 CFR §1.56(c) more than thirty days prior to the filing of this Information Disclosure Statement.

3. FEE INFORMATION: (CHECK IF FEE REQUIRED)

☐ Applicant has calculated a processing fee in the amount of _____ to be due under 37 CFR §1.17(p) in connection with the filing of this Information Disclosure Statement. Applicant authorizes charging the fee to Deposit Account _____.

☒ The Director is hereby authorized to charge any fee deficiency associated with the filing of this Information Disclosure Statement to Deposit Account 23-1925.

Pursuant to the undersigned attorney's obligation and duties under 37 CFR §§ 1.56 and 1.98(a)(3) and (c), either English language abstracts, partial translations, or full translations are included for patent documents which are not in English for the express purpose of providing a concise explanation of the references to the Patent and Trademark Office with the opportunity to evaluate the same. Applicant respectfully requests the Examiner's consideration of the above reference(s) and entry thereof into the record of this application.

By submitting this Statement, Applicant is attempting to fully comply with the duty of candor and good faith mandated by 37 CFR §1.56. As such, this Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 CFR §1.56(a).

Respectfully submitted,

June 1, 2017
Date

/Christopher J. Gerardot/
Christopher J. Gerardot (Reg. No. 73,644)

Examiner Signature		Date Considered	

Electronic Acknowledgement Receipt

EFS ID:	29364776
Application Number:	15358723
International Application Number:	
Confirmation Number:	4188
Title of Invention:	Article of Footwear Having A Textile Upper
First Named Inventor/Applicant Name:	Bhupesh Dua
Customer Number:	133691
Filer:	Christopher J. Gerardot/Michael Lopez
Filer Authorized By:	Christopher J. Gerardot
Attorney Docket Number:	15571-1169/08-1313US77CON
Receipt Date:	01-JUN-2017
Filing Date:	22-NOV-2016
Time Stamp:	14:21:47
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		15571-1169IDSPTO.pdf	177639 e9391c58d37ad2857234a00e55501ed0ea240025	yes	3

	Multipart Description/PDF files in .zip description		
	Document Description	**Start**	**End**
	Miscellaneous Incoming Letter	1	1
	Information Disclosure Statement (IDS) Form (SB08)	2	3

Warnings:					
Information:					
2	Non Patent Literature	NoticeofSuppEvidenceIPR2016 00921.pdf	1283653 354e68cffd718b2017541221abfcfebfb1895 34d	no	4
Warnings:					
Information:					
3	Non Patent Literature	PetitionerExhibitListIPR201600 921.pdf	1092751 063a94a10848549f02377d7b2d324be54ce 7888c	no	4
Warnings:					
Information:					
4	Non Patent Literature	WilliamsDeclaration.pdf	661501 1b464c7f530ecad69f978790a2a174a7f05ff 7b3	no	2
Warnings:					
Information:					
5	Non Patent Literature	NoticeofSuppEvidenceIPR2016 00922.pdf	1284272 acd81d0b01e5f70646e6ca0d1d3d339c0bf 82f20	no	4
Warnings:					
Information:					
6	Non Patent Literature	PetitionerExhibitListIPR201600 922.pdf	1037886 a05df17ea84528d02bdb0506749f5490887 5fddf	no	4
Warnings:					
Information:					
		Total Files Size (in bytes):	5537702		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: June 1, 2017 Name: Christopher J. Gerardot (Reg. No. 73,644) Signature: /Christopher J. Gerardot/

BRINKS GILSON & LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Bhupesh Dua et al.		
Appln. No.:	15/358,723	Examiner:	Carter, Cameron A.
Filed:	November 22, 2016	Art Unit:	3765
For:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	Conf. No.:	4188
Attorney Docket No.:	15571-1169/08-1313US77CON		

TRANSMITTAL

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

☒ Transmittal Letter; Fourth Supplemental Information Disclosure Statement and References E1-E5.

Fee calculation:

☒ No additional fee is required.

☐ Per 37 CFR §1.27, ☐ Applicant is small entity ☐ Applicant is micro entity.

☐ An extension fee in an amount of $_____ for a _____-month extension of time under 37 CFR § 1.136(a).

☐ A petition or processing fee in an amount of $_____ under 37 CFR § 1.1_____(_____).

☐ An additional filing fee has been calculated as shown below:

					Fee		Small Entity Fee		Micro Entity Fee	
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus			x $ 80 =	$	x $ 40 =	$	x $20 =	$
Independent		Minus			x $420 =	$	x $210 =	$	x $105 =	$
First Presentation of Multiple Dep. Claim					+ $780 =	$	+ $390 =	$	+ $195 =	$
					Total	$	Total	$	Total	$

Fee payment:

☐ Please charge Deposit Account No. 23-1925 in the amount of $_____ for _____.

☐ Payment by credit card in the amount of $_____ (Form PTO-2038 is attached).
WARNING: Information on this form may become public. **Credit card information should not be included on this form.**

☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

June 1, 2017
Date

/Christopher J. Gerardot/
Christopher J. Gerardot (Reg. No. 73,644)

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: May 9, 2017 Name: Danielle C. Gillen (Reg. No. 68,197) Signature: /Danielle C. Gillen

THIRD SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15/358,723
Filing Date	November 22, 2016
First Named Inventor	Bhupesh Dua et al.
Art Unit	3765
Confirmation Number	4188
Examiner Name	Carter, Cameron A.
Attorney Docket No.	15571-1169/08-1313US77CON

In accordance with the duty of disclosure, Applicant(s) hereby cites the following references:

OTHER ART – NON PATENT LITERATURE DOCUMENTS

EXAMINER INITIAL		Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
	D1	Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00921 dated April 21, 2017, 32 pages.
	D2	Petitioner's Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8 for Inter Partes Review IPR2016-00921, dated April 21, 2017, 5 pages.
	D3	Koester, A.W., "Analyzing the Color, Design and Texture of Fabric", *Oregon State University Extension* Service, 1993, 8 pages, and submitted to the US Patent and Trademark Office on April 21, 2017 as Exhibit 1013 to the Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00921 dated April 21, 2017 and for Inter Partes Review IPR2016-00922.
	D4	"Definition of 'Impart'", *Merriam-Webster*, printed on April 10, 2017 from the internet: https://www.merriam-webster.com/dictionary/impart, 11 pages, and submitted to the US Patent and Trademark Office on April 21, 2017 as Exhibit 1014 to the Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00921 dated April 21, 2017 and for Inter Partes Review IPR2016-00922.
	D5	Patent Owner's Objections to Admissibility of Evidence Served With Petitioner's Reply to Patent Owner's Response Pursuant to 37 C.F.R. § 42.64(b) for Inter Partes Review IPR2016-00921 dated April 28, 2017, 4 pages.
	D6	Petitioner's Reply to Patent Owner's Response for Inter Partes Review IPR2016-00922 dated April 21, 2017, 34 pages.
	D7	Petitioner's Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8 for Inter Partes Review IPR2016-00922, dated April 21, 2017, 5 pages.
	D8	Patent Owner's Objections to Admissibility of Evidence Served With Petitioner's Reply to Patent Owner's Response Pursuant to 37 C.F.R. § 42.64(b) for Inter Partes Review IPR2016-00922 dated April 28, 2017, 4 pages..

1. PRIORITY INFORMATION:

☐ This application claims priority under 35 USC §120 to the following United States patent application(s): _____. In accordance with 37 CFR §1.98(d), copies of the references cited herein which were submitted to, or cited by, the office, in compliance with 37 CFR §1.98(a)-(c) in the earlier application are not provided herewith. The Examiner is directed to those references cited in all Information Disclosure Statements filed in the priority United States patent application(s) cited above in addition to the references cited herein.

Examiner Signature		Date Considered	

2. CERTIFICATIONS: (CHECK ALL THAT APPLY)

A. Certifications For 37 CFR §1.97(c) or 37 CFR §1.97(d):

☐ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(1) that each item of information in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

☒ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(2) that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this Statement was known to any individual designated in 37 CFR §1.56(c), more than three months prior to the filing of this Information Disclosure Statement.

B. For Patent Term Adjustment Purposes:

☒ For purposes of 37 CFR §1.704(d)(i) or 37 CFR §1.704(d)(ii), Applicant hereby certifies that each item of information contained in this Information Disclosure Statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office or is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and that this communication was not received by any individual designated in 37 CFR §1.56(c) more than thirty days prior to the filing of this Information Disclosure Statement.

3. FEE INFORMATION: (CHECK IF FEE REQUIRED)

☐ Applicant has calculated a processing fee in the amount of _____ to be due under 37 CFR §1.17(p) in connection with the filing of this Information Disclosure Statement. Applicant authorizes charging the fee to Deposit Account _____.

☒ The Director is hereby authorized to charge any fee deficiency associated with the filing of this Information Disclosure Statement to Deposit Account 23-1925.

Pursuant to the undersigned attorney's obligation and duties under 37 CFR §§ 1.56 and 1.98(a)(3) and (c), either English language abstracts, partial translations, or full translations are included for patent documents which are not in English for the express purpose of providing a concise explanation of the references to the Patent and Trademark Office with the opportunity to evaluate the same. Applicant respectfully requests the Examiner's consideration of the above reference(s) and entry thereof into the record of this application.

By submitting this Statement, Applicant is attempting to fully comply with the duty of candor and good faith mandated by 37 CFR §1.56. As such, this Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 CFR §1.56(a).

Respectfully submitted,

May 9, 2017 /Danielle C. Gillen/
Date Danielle C. Gillen (Reg. No. 68,197)

Examiner Signature		Date Considered	

Electronic Acknowledgement Receipt

EFS ID:	29151751
Application Number:	15358723
International Application Number:	
Confirmation Number:	4188
Title of Invention:	Article of Footwear Having A Textile Upper
First Named Inventor/Applicant Name:	Bhupesh Dua
Customer Number:	133691
Filer:	Danielle Cendrowski Gillen/Michael Lopez
Filer Authorized By:	Danielle Cendrowski Gillen
Attorney Docket Number:	15571-1169/08-1313US77CON
Receipt Date:	09-MAY-2017
Filing Date:	22-NOV-2016
Time Stamp:	11:43:10
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		15571-1169IDSPTO.pdf	181657 e9d7d93e9cf44218caca19e2f1790cf128695836	yes	3

	Multipart Description/PDF files in .zip description			
	Document Description		Start	End
	Miscellaneous Incoming Letter		1	1
	Information Disclosure Statement (IDS) Form (SB08)		2	3
Warnings:				
Information:				
2	Non Patent Literature	PetitionersReplyIPR201600921.pdf	361467 4edda4a07389ae4884fcf4f09cee6bc03abb60d2	no	32
Warnings:				
Information:				
3	Non Patent Literature	PetitionersUpdatedMandatoryNoticeIPR201600921.pdf	134408 75aaea4b4cdab7e9d4079607ee7487b99e5852fc	no	5
Warnings:				
Information:				
4	Non Patent Literature	KoesterArticle.pdf	5277817 69aca5926b000147f8b22adf34380c906226aab5	no	8
Warnings:				
Information:				
5	Non Patent Literature	ImpartMerriamWebster.pdf	666500 669050fdc9a0f85e8a305d75255ac104d9d5642b	no	11
Warnings:				
Information:				
6	Non Patent Literature	PatentOwnersObjectionsIPR201600921.pdf	613024 810e3bacab834343786458719ae728fa41e985cc	no	4
Warnings:				
Information:				
7	Non Patent Literature	PetitionersReplyIPR201600922.pdf	388895 3ce82134b9190e6bd7bfa0d78e952099413f550d	no	34
Warnings:				

Information:					
8	Non Patent Literature	PetitionersUpdatedMandatoryNoticeIPR201600922.pdf	154900 04d29aa7c7b31e50b8e2a3b8028bf6422a7bce66	no	5
Warnings:					
Information:					
9	Non Patent Literature	PatentOwnersObjectionsIPR201600922.pdf	613777 24aac19b00726699fa2e62b1e89887a23d771db9	no	4
Warnings:					
Information:					
			Total Files Size (in bytes):	8392445	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

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Date: May 9, 2017 Name: Danielle C. Gillen (Reg. No. 68,197) Signature: /Danielle C. Gillen/

BRINKS GILSON LIONE

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Independent		Minus			x $420 =	$	x $210 =	$	x $105 =	$
First Presentation of Multiple Dep. Claim					+ $780 =	$	+ $390 =	$	+ $195 =	$
					Total	$	Total	$	Total	$

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Respectfully submitted,

May 9, 2017
Date

/Danielle C. Gillen/
Danielle C. Gillen (Reg. No. 68,197)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/358,723	11/22/2016	Bhupesh Dua	15571-1169/08-1313US77CON	4188

133691 7590 05/02/2017

NIKE, Inc./BGL
P.O. Box 10395
Chicago, IL 60610

EXAMINER
CARTER, CAMERON A

ART UNIT	PAPER NUMBER
3765	

MAIL DATE	DELIVERY MODE
05/02/2017	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Applicant-Initiated Interview Summary	Application No.	Applicant(s)		
	15/358,723	DUA ET AL.		
	Examiner	Art Unit	AIA (First Inventor to File) Status	Page
	Cameron A. Carter	3765	No	1 of 2

All participants (applicant, applicant's representative, PTO personnel):

1. Cameron A. Carter (Examiner); Telephonic
2. Clinton T. Ostrup (SPE); Telephonic
3. Danielle Gillen (Attorney of Record); Telephonic

Date of Interview: 19 April 2017

Claim(s) discussed: 21 and 31

Identification of prior art discussed: Nishida (5,345,638) and Dua (6,931,762)

Brief Description of main topic of discussion: Applicant initiated interview in order to discuss the combination of Nishida and Dua as well as a limitation previously decided on by PTAB in a prior application.

Issues Discussed:

Item(s) under 35 U.S.C. 103:
Applicant requested clarification on how Examiner was reading Dua on a first knit strip and a second knit strip different from the first knit strip as well as how there is an alternating first and second knit strip and at least two first and second knit strips. Examiner indicated that Dua taught a medial first knit strip and a lateral first knit strip with the second knit strip placed in the ankle section between the two first knit strips across the instep and vamp alternating between a first and second knit strip.

Claim Interpretation and/or scope:
Applicant indicated that PTAB in a prior application decided that Nishida did not read on a claim limitation presented in the instant application. Examiner indicated that each application is examined and decided upon on its own merits.

Attachment(s): Agenda

/Cameron A. Carter/ Examiner, Art Unit 3765	/CLINTON T. OSTRUP/ Supervisory Patent Examiner, Art Unit 3765

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable time limit of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

Applicant is reminded that a complete written statement as to the substance of the interview must be made of record in the application file. It is the applicant's responsibility to provide the written statement, unless the interview was initiated by the Examiner and the Examiner has indicated that a written summary will be provided. See MPEP 713.04

Please further see:

MPEP 713.04
Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews, paragraph (b)
37 CFR § 1.2 Business to be transacted in writing

Skechers EX1013-p. 666
Skechers v Nike

TO:Auto-reply fax to 13123214299 COMPANY:

Auto-Reply Facsimile Transmission

TO: Fax Sender at 13123214299

Fax Information
Date Received: 4/14/2017 4:29 PM [Eastern Daylight Time]
Total Pages: 2 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received Cover Page =======>

04/14/2017 03:29 13123214299 BRINKS GILSON LIONE PAGE 01/02

FACSIMILE COVER SHEET

BRINKS GILSON & LIONE
NOTABLE IP LAW

Date: April 14, 2017

To: Cameron A. Carter
Company: United States Patent & Trademark Office
Fax No: (571) 273-8300

From: Danielle C. Gillen
Tel. No: (312) 840-3252
Email: dgillen@brinksgilson.com

Our Ref. No: 15571-1169
Your Ref. No: 15/358,723

No. of Pages (including this page): 2

Confirmation Copy to Follow: ☐ Yes, Via ☐ No

ANY PROBLEMS RECEIVING THIS FAX, CALL 312-321-4200 AND ASK FOR: Christine Pisarski

THIS MESSAGE IS INTENDED ONLY FOR THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED. IT MAY CONTAIN PRIVILEGED, CONFIDENTIAL, ATTORNEY WORK PRODUCT, OR TRADE SECRET INFORMATION WHICH IS EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAWS. IF YOU ARE NOT THE INTENDED RECIPIENT, OR AN EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE (AND ALL COPIES) TO US BY MAIL AT THE ADDRESS NOTED BELOW. WE WILL REIMBURSE YOU FOR POSTAGE.

COVER MESSAGE:

Dear Examiner Carter:

Enclosed is an applicant initiated interview request. Please kindly confirm receipt of this fax.

Regards,

Danielle C. Gillen

NBC Tower – Suite 3600 | 455 N. Cityfront Plaza Drive | Chicago, IL 60611-5599 | Telephone 312.321.4200 | Fax 312.321.4299 | brinksgilson.com

Carter, Cameron

From: Gillen, Danielle C. <dgillen@brinksgilson.com>
Sent: Wednesday, April 19, 2017 9:57 AM
To: Carter, Cameron
Cc: Pisarski, Christine
Subject: US Patent App. No. 15/358,723 (Attorney Dkt. No. 15571-1169/08-1313US77CON)
Attachments: 2017-04-14 (15571-1169) Applicant Interview Request Form.pdf; 2017-04-14 (15571-1169) Fax Cover Sheet for Applicant Interview Request Form.pdf; 2017-04-14 (15571-1169) USPTO Confirmation of Fax.pdf

Dear Examiner Carter:

Please find attached the applicant initiated interview request form and fax cover sheet for the above identified US patent application. Also attached is the confirmation of the fax from the USPTO that we received on April 14, 2017. I look forward to speaking with you soon.

Regards,

Danielle

Danielle C. Gillen
Intellectual Property Attorney
312.840.3252 ¦ Direct
dgillen@brinksgilson.com
www.brinksgilson.com

BRINKS GILSON & LIONE
NBC Tower - Suite 3600 ¦ 455 N. Cityfront Plaza Drive ¦ Chicago, IL 60611

Please Note: This message is intended for the individual or entity named above and may constitute a privileged and confidential communication. If you are not the intended recipient, please do not read, copy, use, or disclose this message. Please notify the sender by replying to this message, and then delete the message from your system. Thank you.

Doc Code: M865 or FAI.REQ.INTV

PTOL-413A (08-10)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: 15/358,723 First Named Applicant: Bhupesh Dua
Examiner: Cameron A. Carter Art Unit: 3765 Status of Application: Pending

Tentative Participants:
(1) Danielle C. Gillen (2) Cameron A. Carter
(3) _____ (4) _____

Proposed Date of Interview: April 19, 2017 **Proposed Time:** 10 AM (Eastern) 9 AM (Central)

Type of Interview Requested:
(1) [✓] Telephonic (2) [ ] Personal (3) [ ] Video Conference

Exhibit To Be Shown or Demonstrated: [ ] YES [✓] NO
If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) Rej.	21-40	Nishida, Dua	[ ]	[ ]	[ ]
(2)			[ ]	[ ]	[ ]
(3)			[ ]	[ ]	[ ]
(4)			[ ]	[ ]	[ ]

[ ] Continuation Sheet Attached [ ] Proposed Amendment or Arguments Attached
Brief Description of Arguments to be Presented: 35 USC § 103 rejections of claims 21-40 based on U.S. Patent No. 5,345,638 (Nishida) in view of U.S. Patent No. 6,931,762 (Dua).
An interview was conducted on the above-identified application on _____

NOTE: This form should be completed and filed by applicant in advance of the interview (see MPEP § 713.01). If this form is signed by a registered practitioner not of record, the Office will accept this as an indication that he or she is authorized to conduct an interview on behalf of the principal (37 CFR 1.32(a)(3)) pursuant to 37 CFR 1.34. This is not a power of attorney to any above named practitioner. See the Instruction Sheet for this form, which is incorporated by reference. By signing this form, applicant or practitioner is certifying that he or she has read the Instruction Sheet. After the interview is conducted, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible. This application will not be delayed from issue because of applicant's failure to submit a written record of this interview.

/Danielle C. Gillen/
Applicant/Applicant's Representative Signature

Examiner/SPE Signature

Danielle C. Gillen
Typed/Printed Name of Applicant or Representative

68,197
Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

FACSIMILE COVER SHEET

Date: April 14, 2017

To: Cameron A. Carter
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From: Danielle C. Gillen
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No. of Pages (including this page): 2

Confirmation Copy to Follow: ☐ Yes, Via ☐ No

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: 15/358,723 First Named Applicant: Bhupesh Dua
Examiner: Cameron A. Carter Art Unit: 3765 Status of Application: Pending

Tentative Participants:
(1) Danielle C. Gillen (2) Cameron A. Carter
(3) _____ (4) _____

Proposed Date of Interview: April 19, 2017 **Proposed Time:** 10 AM (Eastern) / 9 AM (Central)

Type of Interview Requested:
(1) [✓] Telephonic (2) [ ] Personal (3) [ ] Video Conference

Exhibit To Be Shown or Demonstrated: [ ] YES [✓] NO
If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) Rej.	21-40	Nishida, Dua	[ ]	[ ]	[ ]
(2)			[ ]	[ ]	[ ]
(3)			[ ]	[ ]	[ ]
(4)			[ ]	[ ]	[ ]

[ ] Continuation Sheet Attached [ ] Proposed Amendment or Arguments Attached

Brief Description of Arguments to be Presented: 35 USC § 103 rejections of claims 21-40 based on U.S. Patent No. 5,345,638 (Nishida) in view of U.S. Patent No. 6,931,762 (Dua).

An interview was conducted on the above-identified application on _____

NOTE: This form should be completed and filed by applicant in advance of the interview (see MPEP § 713.01). If this form is signed by a registered practitioner not of record, the Office will accept this as an indication that he or she is authorized to conduct an interview on behalf of the principal (37 CFR 1.32(a)(3)) pursuant to 37 CFR 1.34. This is not a power of attorney to any above named practitioner. See the Instruction Sheet for this form, which is incorporated by reference. By signing this form, applicant or practitioner is certifying that he or she has read the Instruction Sheet. After the interview is conducted, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible. This application will not be delayed from issue because of applicant's failure to submit a written record of this interview.

/Danielle C. Gillen/
Applicant/Applicant's Representative Signature

Examiner/SPE Signature

Danielle C. Gillen
Typed/Printed Name of Applicant or Representative

68,197
Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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APR 14 2017

FACSIMILE COVER SHEET

Date: April 14, 2017

To: Cameron A. Carter
Company: United States Patent & Trademark Office
Fax No: (571) 273-8300

From: Danielle C. Gillen
Tel. No: (312) 840-3252
Email: dgillen@brinksgilson.com

Our Ref. No: 15571-1169
Your Ref. No: 15/358,723

No. of Pages (including this page): 2

Confirmation Copy to Follow: ☐ Yes, Via ☐ No

ANY PROBLEMS RECEIVING THIS FAX, CALL 312-321-4200 AND ASK FOR: Christine Pisarski

THIS MESSAGE IS INTENDED ONLY FOR THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED. IT MAY CONTAIN PRIVILEGED, CONFIDENTIAL, ATTORNEY WORK PRODUCT, OR TRADE SECRET INFORMATION WHICH IS EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAWS. IF YOU ARE NOT THE INTENDED RECIPIENT, OR AN EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE (AND ALL COPIES) TO US BY MAIL AT THE ADDRESS NOTED BELOW. WE WILL REIMBURSE YOU FOR POSTAGE.

COVER MESSAGE:

Dear Examiner Carter:

Enclosed is an applicant initiated interview request. Please kindly confirm receipt of this fax.

Regards,

Danielle C. Gillen

PAGE 1/2 * RCVD AT 4/14/2017 4:29:52 PM [Eastern Daylight Time] * SVR:W-PTOFAX-001/27 * DNIS:2738300 * CSID:13123214299 * DURATION (mm-ss):00-34

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: April 6, 2017 Name: Danielle C. Gillen (Reg. No. 68,197) Signature: /Danielle C. Gillen

SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	15/358,723
Filing Date	November 22, 2016
First Named Inventor	Bhupesh Dua et al.
Art Unit	3765
Confirmation Number	4188
Examiner Name	Carter, Cameron A.
Attorney Docket No.	15571-1169/08-1313US77CON

In accordance with the duty of disclosure, Applicant(s) hereby cites the following references:

OTHER ART – NON PATENT LITERATURE DOCUMENTS

EXAMINER INITIAL	Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	
	C1	Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00263 dated March 9, 2017, 24 pages.
	C2	Petition for Inter-Partes Review Under 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 et seq. (IPR2016-00920), filed April 19, 2016, 67 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2001 to the Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00263 and for Inter Partes Review IPR2017-00264.
	C3	Trial Instituted Document in IPR2016-00920 dated October 20, 2016, 8 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2002 to the Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00263 and for Inter Partes Review IPR2017-00264.
	C4	Petition for Inter-Partes Review Under 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 et seq. (IPR2017-00264), filed November 14, 2016, 59 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2003 to the Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00263.
	C5	Patent Owner Corrected Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00263 dated March 27, 2017, 24 pages.
	C6	Patent Owner Updated Mandatory Notice Under 37 C.F.R. § 42.8 for Inter Partes Review IPR2017-00263 dated March 28, 2017, 5 pages.
	C7	Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00264 dated March 9, 2017, 24 pages.
	C8	Petition for Inter-Partes Review Under 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 et seq. (IPR2017-00263), filed November 14, 2016, 50 pages, and submitted to the US Patent and Trademark Office on March 9, 2017 as Exhibit 2003 to the Patent Owner Preliminary Response Under 37 C.F.R. § 42.107 dated March 9, 2017 for Inter Partes Review IPR2017-00264.
	C9	Patent Owner Corrected Preliminary Response Under 37 C.F.R. § 42.107 for Inter Partes Review IPR2017-00264 dated March 27, 2017, 24 pages.
	C10	Patent Owner Updated Mandatory Notice Under 37 C.F.R. § 42.8 for Inter Partes Review IPR2017-00264 dated March 28, 2017, 5 pages.

Examiner Signature		Date Considered	

1. PRIORITY INFORMATION:

☐ This application claims priority under 35 USC §120 to the following United States patent application(s): _____. In accordance with 37 CFR §1.98(d), copies of the references cited herein which were submitted to, or cited by, the office, in compliance with 37 CFR §1.98(a)-(c) in the earlier application are not provided herewith. The Examiner is directed to those references cited in all Information Disclosure Statements filed in the priority United States patent application(s) cited above in addition to the references cited herein.

2. CERTIFICATIONS: (CHECK ALL THAT APPLY)

A. Certifications For 37 CFR §1.97(c) or 37 CFR §1.97(d):

☐ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(1) that each item of information in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

☒ Applicant hereby certifies pursuant to 37 CFR §1.97(e)(2) that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this Statement was known to any individual designated in 37 CFR §1.56(c), more than three months prior to the filing of this Information Disclosure Statement.

B. For Patent Term Adjustment Purposes:

☒ For purposes of 37 CFR §1.704(d)(i) or 37 CFR §1.704(d)(ii), Applicant hereby certifies that each item of information contained in this Information Disclosure Statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office or is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and that this communication was not received by any individual designated in 37 CFR §1.56(c) more than thirty days prior to the filing of this Information Disclosure Statement.

3. FEE INFORMATION: (CHECK IF FEE REQUIRED)

☐ Applicant has calculated a processing fee in the amount of _____ to be due under 37 CFR §1.17(p) in connection with the filing of this Information Disclosure Statement. Applicant authorizes charging the fee to Deposit Account _____.

☒ The Director is hereby authorized to charge any fee deficiency associated with the filing of this Information Disclosure Statement to Deposit Account 23-1925.

Pursuant to the undersigned attorney's obligation and duties under 37 CFR §§ 1.56 and 1.98(a)(3) and (c), either English language abstracts, partial translations, or full translations are included for patent documents which are not in English for the express purpose of providing a concise explanation of the references to the Patent and Trademark Office with the opportunity to evaluate the same. Applicant respectfully requests the Examiner's consideration of the above reference(s) and entry thereof into the record of this application.

By submitting this Statement, Applicant is attempting to fully comply with the duty of candor and good faith mandated by 37 CFR §1.56. As such, this Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 CFR §1.56(a).

Respectfully submitted,

April 6, 2017 /Danielle C. Gillen/
Date Danielle C. Gillen (Reg. No. 68,197)

Examiner Signature		Date Considered	

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: April 6, 2017 Name: Danielle C. Gillen (Reg. No. 68,197) Signature: /Danielle C. Gillen/

BRINKS GILSON LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Bhupesh Dua et al.		
Appln. No.:	15/358,723	Examiner:	Carter, Cameron A.
Filed:	November 22, 2016	Art Unit:	3765
For:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	Conf. No.:	4188
Attorney Docket No.:	15571-1169/08-1313US77CON		

TRANSMITTAL

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

☒ Transmittal Letter; Second Supplemental Information Disclosure Statement and References C1-C10.

Fee calculation:

☒ No additional fee is required.

☐ Per 37 CFR §1.27, ☐ Applicant is small entity ☐ Applicant is micro entity.

☐ An extension fee in an amount of $_____ for a _____-month extension of time under 37 CFR § 1.136(a).

☐ A petition or processing fee in an amount of $_____ under 37 CFR § 1.1_____(_____).

☐ An additional filing fee has been calculated as shown below:

					Fee		Small Entity Fee		Micro Entity Fee	
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus			x $ 80 =	$	x $ 40 =	$	x $20 =	$
Independent		Minus			x $420 =	$	x $210 =	$	x $105 =	$
First Presentation of Multiple Dep. Claim					+ $780 =	$	+ $390 =	$	+ $195 =	$
					Total	$	Total	$	Total	$

Fee payment:

☐ Please charge Deposit Account No. 23-1925 in the amount of $_____ for _____.

☐ Payment by credit card in the amount of $_____ (Form PTO-2038 is attached).
WARNING: Information on this form may become public. **Credit card information should not be included on this form.**

☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

April 6, 2017
Date

/Danielle C. Gillen/
Danielle C. Gillen (Reg. No. 68,197)

Electronic Acknowledgement Receipt

EFS ID:	28848492
Application Number:	15358723
International Application Number:	
Confirmation Number:	4188
Title of Invention:	Article of Footwear Having A Textile Upper
First Named Inventor/Applicant Name:	Bhupesh Dua
Customer Number:	133691
Filer:	Danielle Cendrowski Gillen/Michael Lopez
Filer Authorized By:	Danielle Cendrowski Gillen
Attorney Docket Number:	15571-1169/08-1313US77CON
Receipt Date:	06-APR-2017
Filing Date:	22-NOV-2016
Time Stamp:	11:28:11
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		15571-1169IDSPTO.pdf	177492 8dccd63acbafce56c297da1704403c23114d8787	yes	3

	Multipart Description/PDF files in .zip description		
	Document Description	**Start**	**End**
	Information Disclosure Statement (IDS) Form (SB08)	2	3
	Miscellaneous Incoming Letter	1	1

Warnings:					
Information:					
2	Non Patent Literature	PatentOwnerPrelimResponseIPR201700263.pdf	6362612 bd1f4e99aa73fae793447a2726b2f777e4bebb9e	no	24
Warnings:					
Information:					
3	Non Patent Literature	Exhibit2001.pdf	555726 f46c0d929f1986062ee2d654bffa0f2820ba1f29	no	68
Warnings:					
Information:					
4	Non Patent Literature	Exhibit2002a.pdf	232576 34199c127301d849f94198e53a5eae53c7713c84	no	9
Warnings:					
Information:					
5	Non Patent Literature	Exhibit2003IPR201700263.pdf	498743 f603bbb5f44e217933a722213a94df7489324180	no	60
Warnings:					
Information:					
6	Non Patent Literature	CorrectedPatentOwnerResponseIPR201700263.pdf	6032409 b71bd128534ae5bfa3c04688772323c6adb6261c	no	24
Warnings:					
Information:					
7	Non Patent Literature	UpdatedMandtoryNoticeIPR201700263.pdf	117742 fef5496ae28aec8b2669c0dd93f0f5775db665db	no	5
Warnings:					

Information:					
8	Non Patent Literature	PatentOwnerPrelimResponseIPR201700264.pdf	6589666 70a3b349416967185a25407d6ea2c6b1ddf70dd2	no	24
Warnings:					
Information:					
9	Non Patent Literature	Exhibit2003IPR201700264a.pdf	1917720 7c2dda9b3bfeab78cd9d8ab02d8fbfa4f1121223	no	51
Warnings:					
Information:					
10	Non Patent Literature	CorrectedPatentOwnerResponseIPR201700264.pdf	6270309 0e8fa1715da2468306fd96124063f78128921f83	no	24
Warnings:					
Information:					
11	Non Patent Literature	UpdatedMandtoryNoticeIPR201700264.pdf	117743 fefef9a9609398c5b34fcbf967a4f5c02bb4d54c	no	5
Warnings:					
Information:					
		Total Files Size (in bytes):	28872738		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/358,723	11/22/2016	Bhupesh Dua	15571-1169/08-1313US77CON	4188

133691 7590 04/05/2017

NIKE, Inc./BGL
P.O. Box 10395
Chicago, IL 60610

EXAMINER
CARTER, CAMERON A

ART UNIT	PAPER NUMBER
3765	

MAIL DATE	DELIVERY MODE
04/05/2017	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 15/358,723	Applicant(s) DUA ET AL.	
	Examiner Cameron A. Carter	Art Unit 3765	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/22/2016*.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5)☒ Claim(s) *21-40* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *21-40* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☒ The drawing(s) filed on *11/22/2016* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

4) ☐ Other: _____.

DETAILED ACTION

The present application is being examined under the pre-AIA first to invent provisions.

Election/Restrictions

Applicant's election without traverse of Embodiment IV (Figure 11) in the reply filed on January 19, 2017 is acknowledged.

This Office Action is in response to Applicant's amendment filed January 19, 2017 in which claims 1-20 are canceled, and thus claims 21-40 are presented for examination.

Claim Objections

Claim 21 is objected to because of the following informalities: On line 8 of claim 21 it appears as though there is an extra space between "second" and "knit". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van*

Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(l)(1) - 706.02(l)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Claims 21-40 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 7,347,011 as well as claims 1-21 of U.S. Patent No. 8,266,749. Although the claims at issue are not identical, they are not patentably distinct from each other because U.S. Patent No. 7,347,011 is directed to a weft-knitted textile element

with a plurality of knit constructions along a lateral side, medial side, and instep of the upper, the knit constructions having varying properties.

U.S. Patent No. 8,266,749 is directed to a method of manufacturing footwear with a knitted textile element having varying stitch types and yarns.

Claim Rejections - 35 USC § 103

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-40 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Nishida (5,345,638) in view of Dua (6,931,762).

Regarding claim 21, Nishida discloses a flat knit textile element (1) comprising flat knit edges free of surrounding textile structure (5 and 6 of Figure 2) such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed (Figure 2).

Nishida does not teach a first knit strip having a first knit construction and a second knit strip having a second knit construction that is different from the first knit construction, or that the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper.

Dua teaches a knit upper formed of a plurality of sections.

Dua teaches a first knit strip (31 of Dua) having a first knit construction and a second knit strip (34 of Dua) having a second knit construction that is different from the first knit construction (Column 4, lines 1-16 of Dua); wherein the first knit strip and the second knit strip

are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper (Figure 1 of Dua).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have created the upper of Nishida out of the separate knitted sections as taught by Dua in order to give different parts of the upper varying physical and mechanical properties for greater stretch at the ankle, or greater support in the heel, or greater protection at the toe portion of the article of footwear.

Regarding claim 22, the combined upper of Nishida and Dua disclose the limitations of claim 21 above, including that one or both of the first knit strip (31 of Dua) and the second knit strip (34 of Dua) comprises a plurality of knit strips (Figure 1 of Dua). It is noted that the second knit strip of Dua has a medial strip and a lateral strip, creating a plurality of knit strips.

Regarding claim 23, the combined upper of Nishida and Dua disclose the limitations of claim 22 above, including that the first and second knit strips (31 and 34 of Dua) alternate with one another along one or more of the lateral side and the medial side of the upper (30 of Dua). It is noted that the second knit strip alternates along both the medial and lateral sides of the upper around the ankle portion at the first knit strip.

Regarding claim 24, the combined upper of Nishida and Dua disclose the limitations of claim 22 above, including that the flat knit textile element (1 of Nishida) comprises at least two of the first knit strip (31; Figure 1 of Dua) and at least two of the second knit strip (34; Figure 1 of Dua).

Regarding claim 25, the combined upper of Nishida and Dua disclose the limitations of claim 21 above, including that the first knit strip (31 of Dua) and the second knit strip (34 of

Dua) extend along the lateral side of the upper (30 of Dua) from an instep region (33 of Dua) of the upper to an area proximate to a lower region of the upper (Figure 1 of Dua).

Regarding claim 26, the combined upper of Nishida and Dua disclose the limitations of claim 21 above, including that the first knit strip (31 of Dua) and the second knit strip (34 of Dua) extend along the medial side of the upper (30 of Dua) from an instep region (33 of Dua) of the upper to an area proximate to a lower region of the upper (Figure 1 of Dua).

Regarding claim 27, the combined upper of Nishida and Dua teach the limitations of claim 21 above, except that the first knit construction of the first knit strip comprises a smooth texture, and the second knit construction of the second knit strip comprises a rough texture.

Dua does teach the use of many different kinds of fibers, both natural and synthetic in order to impart a variety of mechanical and physical properties to different sections of the knitted upper (Column 4, lines 57-Column 5, lines 1-30). It is well known that silk has a soft touch, or hand to it, and that wool has a rougher touch, or hand because of the crimped fibers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a smoother fiber for the first knit strip of the combined upper of Nishida and Dua and a rougher fiber for the second knit strip of the combined upper of Nishida and Dua to have provided a variety of different physical and mechanical properties to the article of footwear as taught by Column 4, lines 57-Column 5, lines 1-30 of Dua, since it has been held that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP 2144.07.

Regarding claim 28, the combined upper of Nishida and Dua disclose the limitations of claim 21 above, including that the flat knit textile element (1 of Nishida) further comprises a plurality of apertures (38 of Dua) in an instep region (33 of Dua) of the upper (30 of Dua).

Regarding claim 29, the combined upper of Nishida and Dua disclose the limitations of claim 21 above, including that the first knit construction of the first knit strip (31 of Dua) comprises a higher degree of stretch than the second knit construction of the second knit strip (34 of Dua; Column 4, lines 17-39 and Column 5, lines 45-58 of Dua).

Regarding claim 30, the combined upper of Nishida and Dua teach the limitations of claim 21 above, except that the second knit construction of the second knit strip comprises a higher degree of stretch than the first knit construction of the first knit strip.

Column 4, lines 17-39 of Dua teaches that other elastic fibers other than Lycra or elastane can be used. Column 5, lines 26-28 of Dua also teach that any section of the article of footwear can be constructed out of any material to impart a variety of physical properties. Column 5, lines 56-58 of Dua further teach that the degree of stretch can be adjusted.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the combined second knit strip of Nishida and Dua to have a higher degree of stretch than the combined second knit strip of Nishida and Dua in order to provide a variety of different physical and mechanical properties to the article of footwear as taught by Column 4, lines 17-39, Column 5, lines 26-28, and Column 5, lines 56-58 of Dua, since it has been held that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v.*

Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP 2144.07.

Regarding claim 31, Nishida discloses a flat knit textile element (1) comprising flat knit edges free of surrounding textile structure (5 and 6 of Figure 2) such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed (Figure 2).

Nishida does not teach a first knit strip having a first yarn type and a second knit strip having a second yarn type that is different from the first yarn type, or that the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper, or that one or both of the first and second knit strip comprises a plurality of strips, or that the first and second knit strips alternate with one another along one or more of the lateral side and the medial side of the upper.

Dua teaches a knit upper formed of a plurality of sections.

Dua teaches a first knit strip (31 of Dua) having a first yarn type and a second knit strip (34 of Dua) having a second yarn type that is different from the first yarn type (Column 4, lines 1-16 of Dua); wherein the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper (Figure 1 of Dua); wherein one or both of the first knit strip (31 of Dua) and the second knit strip (34 of Dua) comprises a plurality of knit strips (Figure 1 of Dua); and wherein the first and second knit strips (31 and 34 of Dua) alternate with one another along one or more of the lateral side and the medial side of the upper (30 of Dua). It is noted that the second knit strip alternates along both the medial and lateral sides of the upper around the ankle portion at the first knit strip. It is also

noted that the second knit strip of Dua has a medial strip and a lateral strip, creating a plurality of knit strips.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have created the upper of Nishida out of the separate knitted sections as taught by Dua in order to give different parts of the upper varying physical and mechanical properties for greater stretch at the ankle, or greater support in the heel, or greater protection at the toe portion of the article of footwear.

Regarding claim 32, the combined upper of Nishida and Dua disclose the limitations of claim 31 above, including that the flat knit textile element (1 of Nishida) comprises at least two of the first knit strip (31; Figure 1 of Dua) and at least two of the second knit strip (34; Figure 1 of Dua).

Regarding claim 33, the combined upper of Nishida and Dua disclose the limitations of claim 23 above, including that the first knit strip (31 of Dua) and the second knit strip (34 of Dua) extend along the lateral side of the upper (30 of Dua) from an instep region (33 of Dua) of the upper to an area proximate to a lower region of the upper (Figure 1 of Dua).

Regarding claim 34, the combined upper of Nishida and Dua disclose the limitations of claim 31 above, including that the first knit strip (31 of Dua) and the second knit strip (34 of Dua) extend along the medial side of the upper (30 of Dua) from an instep region (33 of Dua) of the upper to an area proximate to a lower region of the upper (Figure 1 of Dua).

Regarding claim 35, the combined upper of Nishida and Dua teach the limitations of claim 31 above, except that the first yarn type of the first knit strip comprises a smooth texture, and the second yarn type of the second knit strip comprises a rough texture.

Dua does teach the use of many different kinds of fibers, both natural and synthetic in order to impart a variety of mechanical and physical properties to different sections of the knitted upper (Column 4, lines 57-Column 5, lines 1-30). It is well known that silk has a soft touch, or hand to it, and that wool has a rougher touch, or hand because of the crimped fibers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a smoother fiber for the first knit strip of the combined upper of Nishida and Dua and a rougher fiber for the second knit strip of the combined upper of Nishida and Dua to have provided a variety of different physical and mechanical properties to the article of footwear as taught by Column 4, lines 57-Column 5, lines 1-30 of Dua, since it has been held that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP 2144.07.

Regarding claim 36, the combined upper of Nishida and Dua disclose the limitations of claim 31 above, including that the flat knit textile element (1 of Nishida) further comprises a plurality of apertures (38 of Dua) in an instep region (33 of Dua) of the upper (30 of Dua).

Regarding claim 37, the combined upper of Nishida and Dua disclose the limitations of claim 31 above, including that the first yarn type of the first knit strip (31 of Dua) comprises a higher degree of stretch than the second yarn type of the second knit strip (34 of Dua; Column 4, lines 17-39 and Column 5, lines 45-58 of Dua).

Regarding claim 38, the combined upper of Nishida and Dua teach the limitations of claim 31 above, except that the second yarn type of the second knit strip comprises a higher degree of stretch than the first yarn type of the first knit strip.

Column 4, lines 17-39 of Dua teaches that other elastic fibers other than Lycra or elastane can be used. Column 5, lines 26-28 of Dua also teach that any section of the article of footwear can be constructed out of any material to impart a variety of physical properties. Column 5, lines 56-58 of Dua further teach that the degree of stretch can be adjusted.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the combined second knit strip of Nishida and Dua to have a higher degree of stretch than the combined second knit strip of Nishida and Dua in order to provide a variety of different physical and mechanical properties to the article of footwear as taught by Column 4, lines 17-39, Column 5, lines 26-28, and Column 5, lines 56-58 of Dua, since it has been held that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP 2144.07.

Regarding claim 39, the combined upper of Nishida and Dua teach the limitations of claim 31 above, except that the first yarn type of the first knit strip comprises at least one of a higher biodegradability, moisture absorption, insulation, durability, or hydrophobicity than the second yarn type of the second knit strip.

Column 5, lines 26-28 of Dua also teach that any section of the article of footwear can be constructed out of any material to impart a variety of physical properties. Column 5, lines 15 and 16 of Dua further teach that cotton provides biodegradability.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the combined first knit strip of Nishida and Dua to have a higher degree of biodegradability than the combined second knit strip of Nishida and Dua in order to provide a variety of different physical and mechanical properties to the article of footwear as taught by Column 5, lines 15 and 16 and Column 5, lines 26-28, of Dua, since it has been held that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP 2144.07.

Regarding claim 40, the combined upper of Nishida and Dua disclose the limitations of claim 31 above, including that the first yarn type of the first knit strip (31 of Dua) comprises at least one of a higher recovery (Column 5, lines 16-18 of Dua) than the second yarn type of the second knit strip (34 of Dua).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron A. Carter whose telephone number is (571)272-3290. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Clinton T. Ostrup can be reached on 571-272-5559. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Cameron A. Carter/
Examiner, Art Unit 3765

/CLINTON T. OSTRUP/
Supervisory Patent Examiner, Art Unit 3765

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Bhupesh Dua et al.		
Appln. No.:	15/358,723	Examiner:	Carter, Cameron A.
Filed:	November 22, 2016	Art Unit:	3765
For:	ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER	Conf. No.:	4188
Attorney Docket No.:	15571-1169/08-1313US77CON		

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

In accordance with the duty of disclosure, Applicant(s) hereby cites the following references:

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EXAMINER INITIAL		Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
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