

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKECHERS U.S.A., INC.,

Petitioner,

v.

NIKE, INC.,

Patent Owner.

Case IPR2025-00143

Patent No. 9,986,781

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBITS

Exhibit No.	Description
2001	Declaration of Christopher M. Pastore
2002	Email from L. Oxenford to M. Wilk, November 13, 2024

I. INTRODUCTION

Patent Owner Nike, Inc. (“Nike”) submits this Preliminary Response to the Petition of Skechers U.S.A., Inc. (“Skechers”), challenging the patentability of Claims 1-20 (the “Challenged Claims”) of U.S. Patent No. 9,986,781 (the “’781 Patent”). The Board should deny institution for three independent reasons: (1) both asserted grounds involve the same or substantially the same prior art and arguments previously considered by the Patent Office in prosecution, (2) Skechers’ strategic delay in filing the Petition prejudices Nike and would waste judicial resources in view of parallel proceedings, and (3) Skechers has not established a reasonable likelihood that it will prevail for any claim in either ground.

The ’781 Patent relates to footwear, with an upper that includes a flat knit textile element with flat knit edges and longitudinal ribs, and a sole structure. Skechers advances two grounds, which largely overlap and fail for similar reasons. Ground 1 is based on a combination of European Patent Application 1,338,690 (“Cusinato”) in view of U.S. Patent No. 1,841,518 (“Bellak”) and/or U.S. Patent No. 6,910,288 (the “Dua ’288 Patent”), and if necessary, the book *Knitting Technology* (“Spencer”). Ground 2 is based on a combination of U.S. Patent No. 2,400,692 (“Herbert”) in view of U.S. Design Patent No. D461,591 (“Hlavacs”), and two of the same references from the first ground—Cusinato and Spencer.

First, the Patent Office has already considered most of these references. For Ground 1, the examiner relied upon both Bellak and the Dua '288 Patent in rejections, and considered Spencer. For Ground 2, the examiner already considered the primary reference Herbert, and Spencer. Critically, the only two new references—Cusinato and Hlavacs—are entirely cumulative. Skechers uses Cusinato for the same stocking/sock teachings (not footwear teachings), and Hlavacs for the same narrow teaching (a sole for a shoe), as, respectively, Bellak and the Dua '288 Patent—both of which the examiner used to reject all claims during prosecution. Everything in the Petition has already been considered by the Office, and the Board should therefore deny institution under 35 U.S.C. § 325(d).

Second, the validity of the '781 Patent is also being litigated in parallel district court proceedings that have been ongoing for more than a year. Skechers' delay in filing the Petition has already wasted party resources, and institution would both waste Board resources, and prejudice Nike by forcing it to defend challenges in two fora, while leading to potentially inconsistent decisions on the same issues. Thus, discretionary denial under *Fintiv* is also warranted.

Finally, the Board should also deny institution because Skechers failed to show that either ground discloses (or renders obvious) a critical element required

in all Challenged Claims: an “*upper* for an article of *footwear*.”¹ As Skechers acknowledges, each of the primary references in both grounds discloses teachings related to socks, stockings, or slippers—not footwear (*i.e.* shoes). *See* Paper 1, at 53 (Ground 1: relying on Cusinato, which discloses “stockings,” and Bellak, which discloses a “slipper”); 93-94 (Ground 2: relying on Herbert, which discloses a “slipper,” and again, Cusinato’s “stocking”).² For this reason, Skechers adds a shoe reference to each ground. *Id.*, at 53 (Ground 1: adding the Dua ’288 Patent for “a shoe”); 94 (Ground 2: adding Hlavacs for a figure depicting a shoe “sole”).

However, the Petition does not demonstrate even a *prima facie* rationale to support why a POSITA *would* have been motivated to combine sock references with entirely distinct shoe teachings. For Ground 1, Skechers’ expert Dr. Adanur

¹ Ex. 1001, Claim 1 (12:8-9) (all emphases added, unless noted otherwise). The other independent Claim 12 recites “[a]n article of footwear comprising: an upper,” which includes the same “footwear” and “upper” requirements. *Id.*, 12:49-50.

² Skechers misrepresents Herbert and Cusinato, in an attempt to obscure their lack of footwear or “sole” teachings. For Herbert, Skechers includes a one-word quote “sole,” to make it seem as if Herbert discloses footwear. Paper 1, at 93 (citing Ex. 1016, 2:17). Herbert does not—the quoted excerpt actually uses “sole” to refer to the location of the “slipper” fabric along “the bottom” of the foot (*i.e.*, the sole of the wearer’s foot), not a sole structure of a shoe. Ex. 1016, 2:9-21. And for Cusinato, Skechers includes a one-word quote “boot,” to make it seem as if Cusinato discloses footwear. Paper 1, at 94 (citing Ex. 1014, [0010]). Again, Cusinato does not—the quoted excerpt actually refers to a stocking with a “boot-like shape,” not a boot. Ex. 1014, [0010]. These misrepresentations highlight the deficiencies of both grounds, and why institution should be denied.

offers only one opinion: that a POSITA allegedly would “add a sole” to Cusinato’s stocking or Bellak’s slipper, because “a sole structure would provide, for example, cushioning, support, and traction.” Paper 1, at 53 (citing Ex. 1002, at ¶170). But that’s a conclusory tautology, not a rationale—stockings and slippers have unique properties and purposes, as do shoes, and opining that a POSITA would transform a sock into a shoe, in order to obtain benefits *that a shoe already has*, is not an obviousness rationale. And for Ground 2, the Petition is even more deficient, as Dr. Adanur only offers the conclusory opinion that “it would be obvious to add a discrete sole to Herbert’s ‘slipper’ or Cusinato’s ‘boot-like’ form,” with no further explanation. Paper 1, at 94 (citing Ex. 1002, at ¶286). That comes nowhere close to satisfying Skechers’ burden for institution of trial.

While these deficiencies alone warrant denial of institution, the Petition has more. The Petition also (1) fails to show that either ground discloses or renders obvious “a plurality of ribs integrally knitted into the flat knit textile element,” and for Ground 2 both (2) fails to show disclosure of “a flat knit textile element having: (1) flat knit edges free of surrounding textile structure,” and (3) fails to articulate a sufficient motivation to combine, including because the combination mixes fundamentally incompatible circular and flat knit teachings.

Nike respectfully requests that the Board decline to institute review.

II. BACKGROUND

A. The '781 Patent

The '781 Patent has a priority date of March 3, 2004, and is directed to “an article of footwear” with “a configuration that is suitable for athletic activities, particularly running,” which includes “an upper for an article of footwear, the upper incorporating a textile element formed with a knitting machine.” Ex. 1001, p.2, 3:43-45, 4:46-61. The “elements of footwear” include “a sole structure and an upper,” and the “sole structure” “provides a durable, wear-resistant component that imparts cushioning as footwear impacts the ground.” *Id.*, 4:62-5:6.

Claim 1 of the '781 Patent is representative. It claims an “upper for an article of footwear,” which includes an upper comprising a “flat knit textile element” with “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 “rib” elements that are “integrally knitted into the flat knit textile element.” *Id.* at Claim 1; *see also id.* at 12 (reciting an “article of footwear”). The '781 Patent depicts an example of a “flat knit” “textile element,” knit to the “general shape” of an upper (or a portion of an upper), with “flat knit edges” that do not have surrounding textile structure, in Figure 10:

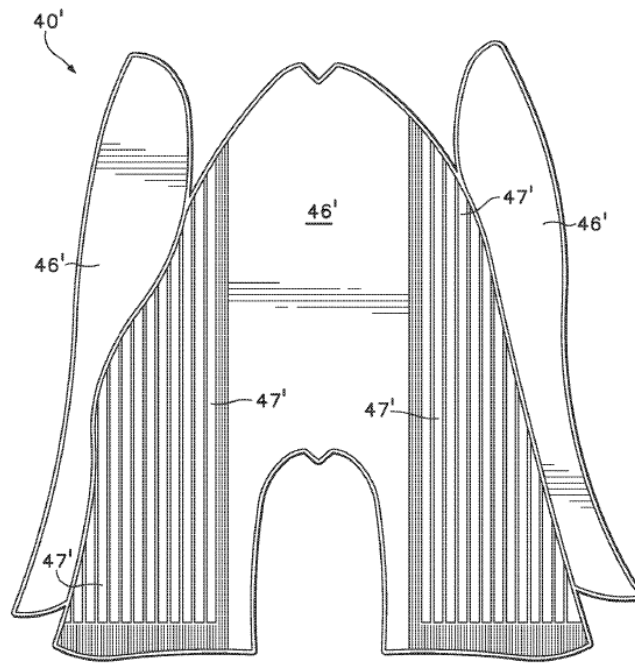


Figure 10

The example “textile element” depicted in Figure 10 also includes “a plurality of longitudinal ribs,” depicted as elements “47,” which are distinguishable from other portions of the “textile element,” for example, by having a different texture than the “generally smooth” regions “46.” *Id.*, 9:34-46.

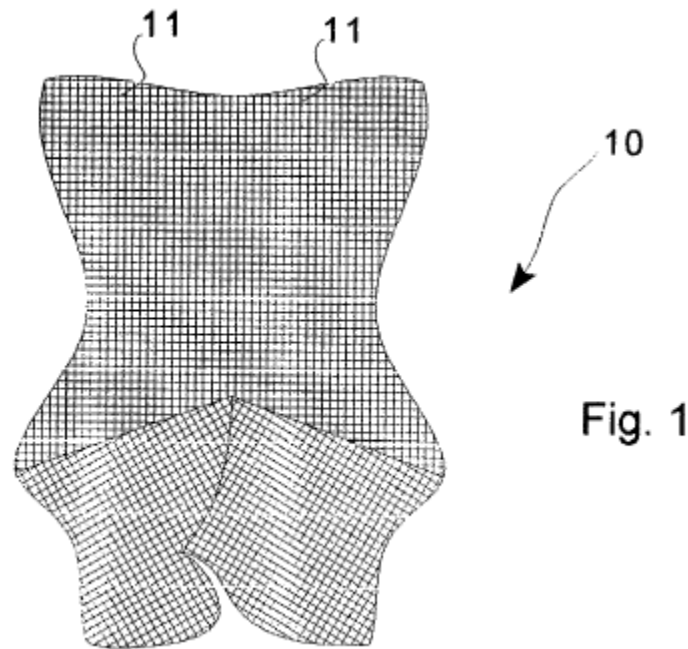
The '781 Patent distinguishes “flat knitting” and “circular knitting” as distinct types (*id.*, 10:35-36), and distinguishes knitting machines that “form a flat textile structure” (*id.*, 11:41-63), from “circular knitting machine[s]” that form a “cylindrical textile structure. *Id.*, 7:51-62. The '781 Patent also distinguishes the claimed “flat knit” “footwear” and “upper,” from “sock knitting” performed by “circular knitting.” *Id.*, 7:30-32. The '781 Patent also discloses that by producing a “textile element” like the flat knit element in Figure 10 as “a single, unitary

element of material,” manufacturing “efficiency is increased” in comparison to a process requiring “numerous joined elements.” *Id.*, 11:31-40.

B. Alleged Prior Art References

1. Cusinato

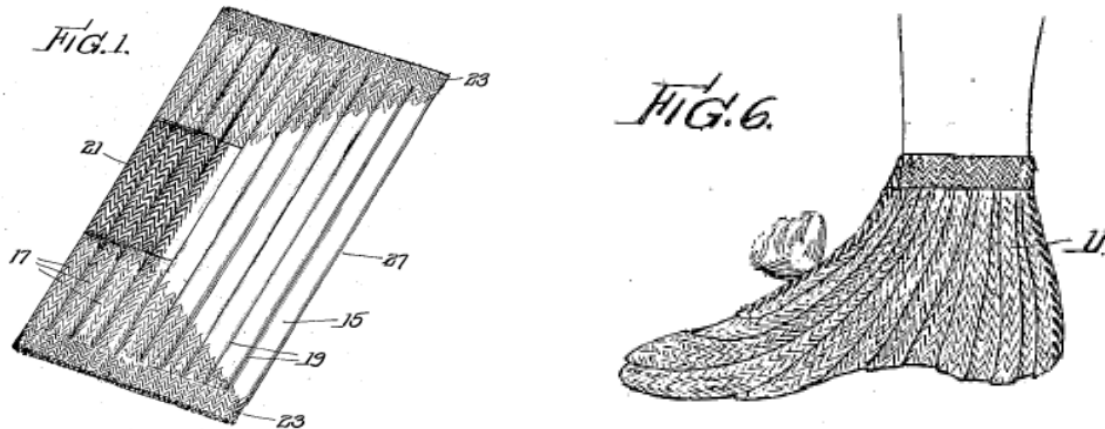
Cusinato is a European Patent Application (EP 1,338,690 A1) directed to a “[p]rocess for making a knitted fabric.” Ex. 1014, at 1. In relevant part, Cusinato discloses a “fabric which has the necessary geometrical characteristics so that, once it has been folded, it directly forms [a] stocking.” *Id.*, [0013]. Cusinato describes a “process for making” such a stocking, which produces a “one-piece fabric which has suitably shaped side edges” that “form two waves,” such that the stocking “is directly obtained by wrapping the fabric in a boot-like manner and carrying out a simple sewing in order to join the two side edges.” *Id.*, [0014]-[0015]. The stocking is thus “form-fitting to the foot or the leg of a person.” *Id.*, [0018]. An example of the resulting fabric that can be folded into a stocking shape is shown in Figure 1:



2. Bellak

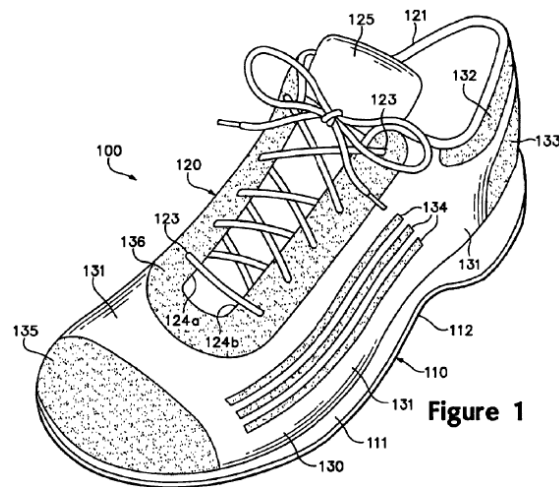
Bellak is a U.S. patent (No. 1,841,518) that issued in 1932, titled “Knitted Article And Method Of Making Same.” Ex. 1015, at 1. Bellak’s “object is to make a rectangular bag-like knitted article for use as a slipper,” but the article may also be used as a “hand cover,” such as a “glove or the like.” *Id.*, 1:8-25. Bellak’s slipper is made entirely out of “an extremely expansible, accordeon pleated fabric” of “the so-called ribbed type comprising a plurality of projecting bands and intermediate hollows.” *Id.*, 1:67-75. The slipper is made from “a rectangular strip” of fabric (Fig. 1), which is “made straight,” as in, the process does not “vary the width of the strip.” *Id.*, 1:80-88. To create the slipper, the “strip” is “fold[ed]” and the “edges are then sewed or otherwise secured together” “to form a

substantially rectangular bag, the neck of which is sufficiently expansible to permit the insertion of the wearer's foot." *Id.*, 2:15-27, Figs. 1, 6.

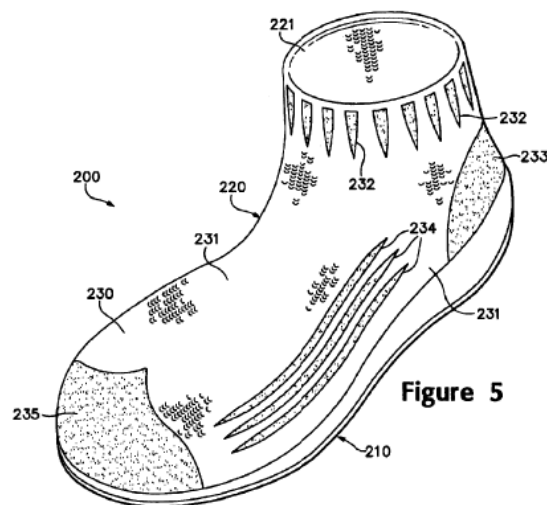


3. Dua '288 Patent

The Dua '288 Patent is a U.S. patent (No. 6,910,288), which issued in 2005 to one of the named inventors of the '781 Patent. The Dua '288 Patent discloses “an upper for an article of footwear that includes a textile having fusible filaments or fibers,” where areas of the “upper are heated such that the fusible filaments or fibers fuse with other filaments or fibers to form fused areas.” Ex. 1017, at Abstract. The Dua '288 Patent discloses a shoe with a “[f]used area 134” of “elongate strips” that “limits horizontal stretch on the lateral side of footwear 100,” “but permits lateral stretch of unfused areas 131 in the vertical direction.” *Id.*, 5:64-6:10. This “footwear 100” has the “configuration of conventional articles of athletic footwear,” as shown in Figure 1 (*id.*, 8:58-60):



The reference also discloses “footwear 200” with a “textile upper.” *Id.*, 8:65-67, Fig. 5. The “textile upper” also includes “a plurality of fused areas 232-235,” and may be made “on a circular knitting machine.” *Id.*, 9:16-25, 10:16-49. The Dua ’288 Patent does not disclose flat knitting, or flat knit textile elements.



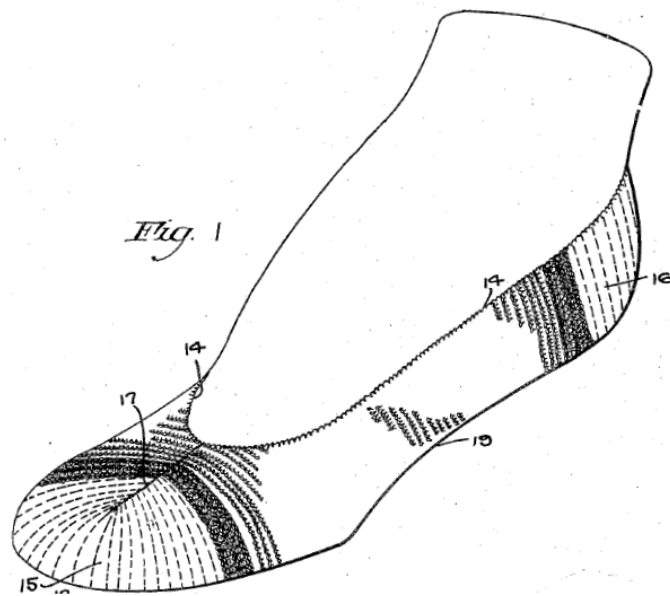
4. Spencer

Spencer is a 400-page textbook titled *Knitting Technology: A Comprehensive Handbook And Practical Guide*, by David J. Spencer, published in

2001. Spencer generally discusses the “fundamental principles of weft and warp knitting,” in “reference” format, including for “complete garments” and “hosiery” (*i.e.*, socks). Ex. 1050, at Preface. Spencer does not discuss footwear (*i.e.*, shoes).

5. Herbert

Herbert is a U.S. patent (No. 2,400,692) that issued in 1946, titled “Foot Covering.” Ex. 1016, at Title. Herbert discloses a “slipper type of knitted foot covering adapted to be worn inside a low cut ladies’ shoe or slipper”—*i.e.*, a sock. *Id.*, 1:4-6 (left col.). Herbert’s slipper/sock is formed from a “tubular section of true rib seamless fabric,” which is “fabricated of circular knit seamless fabric.” *Id.*, 1:15-18 (left col.), 1:5-15 (right col.). Herbert claims “circular knit” is the “preferred embodiment,” because that “method of making the finished product is simpler and less expensive.” *Id.*, 1:5-15 (right col.). The slipper is “shaped” from the fabric by “cutting” and “seam[ing]” “together the cut edges.” *Id.*, 2:9-21 (left col.). Fig. 1 shows the finished “slipper” on “the foot of a wearer”:

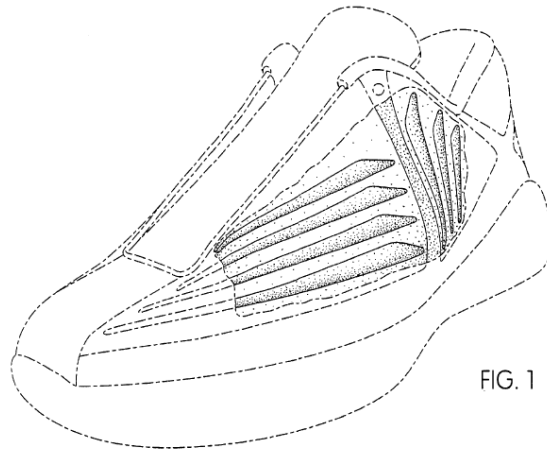


While the slipper is made entirely from “rib knitted fabric” (*id.*, 1:9 (left col.)), Herbert describes that the central section may be formed using “true rib” stitching, while the heel and toe sections may be formed using “tuck stitch rib sections.” *Id.*, 2:39-50 (right col.). The purpose of these different rib sections is to “reduce[] somewhat the elasticity” in the heel and toe, so that the slipper/sock “more snugly fit[s] about the toe and heel of the wearer.” *Id.*, 2:4-14 (right col.). Herbert states that the slipper could be made using “cut and sewn flat rib knitted fabric,” but no details of such method are disclosed. *Id.*, 1:5-15 (right col.).

6. Hlavacs

Hlavacs is a U.S. design patent (No. D461,951) that issued in 2002, and claims a “design for a portion of a shoe upper” with various “stripes” in different

orientations, as depicted in Figure 1. Ex. 1018, at 1, 3. Because it is a design patent, Hlavacs does not include a specification or any technical disclosure.



C. Relevant File History

The Patent Office extensively considered the patentability of the claims during prosecution, and considered most of the references in the asserted grounds. In fact, the Patent Office rejected all of the claims under two of the references that Skechers recycles in the Petition—the Dua '288 Patent and Bellak.

First, the examiner rejected all the claims under the Dua '288 Patent, in part because she believed that it discloses “a plurality of ribs” that “extend longitudinally on the medial and lateral sides with varying lengths.” Ex. 1013-1, 84 (citing “DUA 6910288”). But the examiner withdrew that rejection after the applicant explained that the Dua '288 Patent’s “fused rib structure” is known in the art to be distinct from “integrally knitted ribs,” as claimed. *Id.*, 91.

Next, the examiner rejected all the claims as obvious under Bellak, in combination with Holden (U.S. Patent No. 1,902,780), which discloses a knitted lining that fits inside a rubber boot. Ex. 1013-15, 7838-7842. The examiner believed Bellak disclosed “a flat knit textile element . . . substantially as claimed.” *Id.*, 7840 (citing “Bellak (1841518)”). In response, the applicant made amendments to the two independent claims (and two dependent claims), which clarified the location(s) of the rib elements that are “integrally knitted into the flat knit textile element.” *Id.*, 7849-7858 (amendments on pp. 7850, 7852). The examiner withdrew the rejection, and allowed the claims. *Id.*, 7866.

The examiner also confirmed that she considered Herbert—which Skechers recycles as the primary reference in the second ground—and Spencer—which Skechers recycles in both grounds. *Id.*, 7876-7879 (row 33, for Herbert); Ex. 1013-14, 7351-7358 (row 2, for Spencer).

III. LEVEL OF ORDINARY SKILL IN THE ART

For purposes of this preliminary response, Nike applies Skechers’ proposed level of ordinary skill in the art, but under the ordinary and customary meaning of “footwear” (not Skechers’ incorrect construction). That is, as of the earliest claimed priority date (March 3, 2004), “someone with at least a few years of experience in knit materials and knitting methods and machines that can be used in making footwear, or a bachelor’s degree in textile-related sciences, engineering,

or industrial product design, or equivalent academic or work experience, including in the footwear industry.” Paper 1, at 36. Skechers’ definition includes that more experience can compensate for less education, and vice versa. *Id.* Nike reserves the right to further address Skechers’ proposed level, if trial is instituted.

IV. CLAIM CONSTRUCTION

Claims in *inter partes* review proceedings “shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b). Under this standard, claims “are generally given their ordinary and customary meaning,” as understood by a POSITA. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005).

The parties currently dispute the construction of three terms: (i) “article of footwear”; (ii) “a flat knit textile element having: (1) flat knit edges . . .”; and (iii) “wherein one or more ribs extends longitudinally . . . toward the heel region.” Paper 1, at 36-40; Ex. 1006, at 5-7. For purposes of this preliminary response, Nike addresses only the first term, “article of footwear.” If trial is instituted, Nike will address the proper constructions of the other disputed terms at that time.

A. “article of footwear”

The ordinary and customary meaning of “article of footwear,” as recited in all claims of the ’781 Patent, does not include hosiery, stockings, or socks. Ex.

2001, ¶¶29-38. This is the only meaning supported by the intrinsic record, including the specification, which exclusively describes an “article of footwear” as including two primary elements: “an upper and a sole structure.” Ex. 1001, 1:39-40, 4:62-63. In contrast, hosiery, stockings, and socks do not have sole structures. Every figure of the ’781 Patent confirms this ordinary and customary meaning, as the figures depict shoes, or textile elements that are designed to be incorporated into shoes. *Id.*, Figs. 1–14. This meaning is further confirmed by the surrounding language of the claims. Independent Claims 1 and 12 recite an “upper” that is “for an article of footwear,” or an “article of footwear comprising” an “upper.” *Id.*, 12:8–9, 12:49-50. In addition, the term “upper” itself derives its meaning as a component of “footwear.” *E.g., id.*, 3:43-44 (“The present invention is an upper for an article of footwear.”). Indeed, “upper” is essentially read out of the claims and rendered nonsensical under Skechers’ proposal, which if substituted into the claim language would make it read an “upper for [a sock].” Skechers’ proposal cannot be correct, as long-standing Federal Circuit precedent holds that the construction of a term cannot read out claim language or render it meaningless. *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”); *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 951 (Fed. Cir. 2006) (rejecting construction of term in limiting preamble where the effect “would

be to read limitations” “out of the claim,” particularly because it “it would be contrary to the specification” descriptions of that term).

Furthermore, Dr. Pastore explains that a POSITA reading the ’781 Patent would understand “article of footwear” “to include both an upper and a sole structure, and to exclude hose, hosiery, stockings, socks, and the like.” Ex. 2001, ¶32. Dr. Pastore also explains that a POSITA understands the meaning of “upper” from “the context of being one of the primary elements of a shoe,” citing the ’781 Patent, which explains that the “upper and the sole structure operate cooperatively.” *Id.*, ¶33 (citing Ex. 1001, 1:51-52). According to Dr. Pastore, this is one reason why “uppers generally have” certain features that “hose, hosiery, stockings, socks, and the like do not have.” Ex. 2001, ¶34. For example, Dr. Pastore explains that an “upper” for “footwear” typically has features for “securing and placing the foot in a position inside the shoe upper, in relation to the sole structure, so that activities benefiting from the use of shoes may be performed,” such as “walking and running.” *Id.* On the other hand, because “hose, hosiery, stockings, socks, and the like do not have a sole structure,” they also do not have such features for working in conjunction with a sole structure. *Id.* Thus, Dr. Pastore opines that articles such as hosiery, stockings, and socks are not “articles of footwear,” as that term is used in the ’781 Patent. *Id.*, ¶¶29-38.

Skechers cites no intrinsic support for its construction,³ and instead relies on extrinsic evidence including a dictionary and an unrelated patent from the 1950s that is one of hundreds of references cited in prosecution. There is no reason even to consider that extrinsic evidence, including because there is no ambiguity in the plain claim language, as informed by the specification. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996); *see also* Ex. 2001, ¶36.

Furthermore, Skechers does not rely on any expert opinion to support its construction. Skechers cites Dr. Adanur's declaration, but only for the proposition that the grounds allegedly would disclose the "article of footwear" limitations under either party's construction (which Nike disputes, as detailed in the discussion of the grounds below). Paper 1, at 38, citing Ex. 1002, ¶¶97-98. Dr. Adanur does not provide any reason why a POSITA would supposedly ignore the ordinary meaning of "article of footwear" provided by the '781 Patent, and substitute a different meaning from Skechers' extrinsic evidence. Instead, Dr. Adanur merely states that the "opinions" in his declaration "reflect [Skechers'] construction of the term." Ex. 1002, ¶¶97-98. Nowhere does Dr. Adanur provide

³ Skechers' only citations to the '781 Patent include the Abstract, and dependent Claim 20, which separately recites a "sole" element. Paper 1, at 37. But these citations do not change the ordinary and customary meaning of "article of footwear," and instead reflect conventional patent claiming, where a patentee is free to place elements *of an invention* in dependent claims.

any analysis or opinions to support Skechers' construction. Thus, Dr. Adanur did not offer any claim construction opinions for the Board to consider. *See also* Ex. 2001, ¶37.

Finally, the Board previously considered and adopted the same ordinary and customary meaning of “article of footwear,” in IPR proceedings for a related patent.⁴ Specifically, in IPR2024-00778, involving U.S. Patent No 8,266,749 (the “’749 Patent”), Nike proposed that “the ordinary and customary meaning of the term ‘article of footwear,’ as recited in the ’749 patent, does not include hosiery, stockings, or socks.” *See* IPR2024-00778, Paper 6, at 11-12. And like Skechers’ proposal here, the petitioner in the ’749 Patent IPR proposed the term should encompass “a knitted stocking.” *See* IPR2024-00778, Paper 10, at 14. The Board agreed with Nike and rejected the petitioner’s construction, finding there was no reason why “a person of ordinary skill in the art would understand stockings to include a sole structure and an upper so as to be considered ‘an article of footwear.’” *Id.* The same is true here, and for the sake of consistency in interpreting the same term from the same patent family, the Board should apply its decision from the ’749 Patent to the “article of footwear” term in the ’781 Patent.

⁴ Ex. 1001, p.2, listing patent 8,266,749 under “Related U.S. Application Data.”

B. “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”

This term should have its ordinary and customary meaning, which based on the plain text, requires a “flat knit textile element” with “flat knit *edges*.” *See, e.g.*, Ex. 1007, at 9-10; Ex. 1009, 8-10. Skechers, however, seeks to improperly re-write the limitation so that it “has *only* flat knit edges.” Paper 1, at 38. While Skechers’ proposal is not supported, Nike believes that its arguments in this preliminary response do not implicate this dispute.

C. “wherein one or more ribs extends longitudinally . . . toward the heel region”

This term should have its ordinary and customary meaning, which based on the plain text, does not exclude “ribs” that may be oriented “in a diagonal or vertical orientation,” while extending “longitudinally . . . toward the heel region.” *See, e.g.*, Ex. 1007, 12-13; Ex. 1009, 14-15. Skechers argues that there is prosecution disclaimer supporting its construction (Paper 1, at 38-40), which Nike disputes. In any case, Nike believes that its arguments in this preliminary response do not implicate this dispute.

D. “ribs” / “ribs integrally knitted”

The parties agreed to constructions for “ribs” and “ribs integrally knit” in the district court litigation. Paper 1, at 40-41; Ex. 1005, 2. “Ribs” is agreed to mean

“ribs integrally knitted,” and “ribs integrally knitted” is agreed to mean “a structure made of face wales and back wales wherein lengthwise ridges are formed on both sides of the fabric by pulling stitches first to the face and next to the back of the fabric in adjacent stitches or groups of stitches.” *Id.* However, as discussed below, Skechers did not properly apply these constructions to the asserted references.

V. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 325(d)

The Board should exercise its discretion to deny institution under 35 U.S.C. §325(d), because Skechers relies on the same or substantially the same art and arguments that were considered by the Office during prosecution, and failed to show that the Office made any error material to the patentability of the Challenged Claims. The similarities between Skechers’ asserted references and the prior art previously before the Office are striking. Ground 1 relies extensively on Bellak—a reference the examiner used to reject all of the claims during prosecution—and Ground 2 relies extensively on the very similar Herbert, which was also considered by the examiner. Both grounds also rely on Spencer, which also was considered by the examiner. The only new material reference is Cusinato—but Skechers relies on Cusinato for “stocking”/sock teachings that are substantially the same as the “slipper”/sock teachings of both Bellak *and* Herbert. Thus, both grounds have already been considered and/or are entirely cumulative.

A. The Section 325(d) Standard

The Board applies a two-part framework for assessing discretionary denial under 35 U.S.C. § 325(d). First, the Board considers “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6, at 8 (P.T.A.B. Feb. 13, 2020) (precedential). Second, the Board assesses “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of [the] challenged claims.” *Id.* In applying the *Advanced Bionics* framework, the Board considers the non-exclusive *Becton, Dickinson* factors:

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

f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Advanced Bionics, LLC, IPR2019-01469, Paper 6, at 9, citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at 17–18 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). The Board considers factors (a), (b), and (d) during the first step, and factors (c), (e), and (f) during the second step. *Advanced Bionics*, IPR2019-01469, Paper 6, at 9-10.

B. *Advanced Bionics* Step 1: The same art, and substantially the same art, was previously before the Office during prosecution

For Ground 1, three of the four asserted references were already considered during prosecution—Bellak, the Dua '288 Patent, and Spencer. *See supra* § II.C. Skechers adds Cusinato, which is merely cumulative of at least Bellak and Herbert. For Ground 2, two of the four asserted references were already considered—Herbert and Spencer. *Id.* Skechers again adds the cumulative Cusinato reference, and uses Hlavacs, which is merely cumulative of at least the Dua '288 Patent.

Becton, Dickinson factor (a) assesses “the similarities and material differences between the asserted art and the prior art involved during examination,” factor (b) assesses “the cumulative nature of the asserted art and the prior art evaluated during examination,” and factor (d) assesses “the extent of the overlap between the arguments made during examination and the manner in which

Petitioner relies on the prior art or Patent Owner distinguishes the prior art.”

IPR2017-01586, Paper 8, at 17–18.

1. Limitations [pre] and [a1] of the independent claims

Bellak is central to Ground 1, Herbert is central to Ground 2, and the new Cusinato reference—used in both grounds—is entirely cumulative of both.

For Ground 1, Skechers recycles Bellak for allegedly disclosing limitations 1[pre] (“an upper for an article of footwear, the upper comprising” and 1[a1] “a flat knit textile element having: (1) flat knit edges . . . ,” just as the examiner previously found in a rejection that was overcome by Nike.⁵ *See* Paper 1, at 53 (for 1[pre]) and 57-58 (for 1[a1]). Similarly, for Ground 2 Skechers recycles Herbert for allegedly disclosing the same two limitations—1[pre] and 1[a1]. *See* Paper 1, at 93 (for 1[pre]) and 95 (for 1[a1]). While Herbert was not used by the examiner in a rejection, it was considered, and Skechers relies on it here for the same teachings as Bellak. Specifically, Skechers asserts that Herbert’s “slipper” discloses the “article of footwear” limitation, just as Bellak’s “slipper” allegedly does. *Compare* Paper 1, at 93 *with id.* at 53. Next, Skechers argues that Herbert’s reference to a “flat rib knitted

⁵ For the Claim 12 limitations, Skechers incorporates its arguments for the corresponding limitations of Claim 1. Paper 1, at 85 (Ground 1), 109 (Ground 2). To reduce repetition, Nike does the same here, with the arguments asserted for Claim 1 applying equally to the corresponding limitations in Claim 12.

fabric” discloses the “flat knit textile element,” just as Bellak’s “rectangular flat strip” of “fabric” allegedly does. *Compare* Paper 1, at 95 *with id.* at 57-58.

Skechers also relies on Cusinato—the only new material reference—for allegedly disclosing the same two limitations: 1[pre] (“an upper for an article of footwear, the upper comprising” and 1[a1] “a flat knit textile element having: (1) flat knit edges”:

- Ground 1: *see* Paper 1, at 53 (for 1[pre]) and 54-57 (for 1[a1]);
- Ground 2: *see* Paper 1, at 94 (for 1[pre]) and 95 (for 1[a1]).

Specifically, for Ground 1 Skechers argues that Cusinato’s “stocking” discloses the “article of footwear” limitation, just as Bellak’s “slipper” allegedly does. Paper 1, at 53 (discussing both back-to-back). Next, Skechers argues that Cusinato’s references to “flat parts,” “the use of any machine,” and the possibility “to obtain shaped fabrics,” discloses the “flat knit textile element,” just as Bellak’s “rectangular flat strip” of “fabric” allegedly does. *Compare* Paper 1, at 54-55 *with id.* at 57-58. Skechers thus relies on disclosures in Cusinato that are entirely cumulative of those relied on in Bellak, which was already considered.

Skechers identifies the same disclosures for its use of Cusinato in Ground 2. Specifically, Skechers again argues that Cusinato’s “stocking” discloses the “article of footwear” limitation, just as Bellak’s “slipper” allegedly does. *Compare* Paper 1, at 94 *with id.* at 53. And Skechers again argues that Cusinato discloses a “flat knit

fabric element (and manufacturing method therefor),” which again is no different than its reliance on Bellak’s “rectangular flat strip” of “fabric.” *Compare* Paper 1, at 95 (and 54-55) *with id.* at 57-58. Thus, again for Ground 2, Skechers relies on disclosures in Cusinato that are entirely cumulative of those relied on in Bellak.

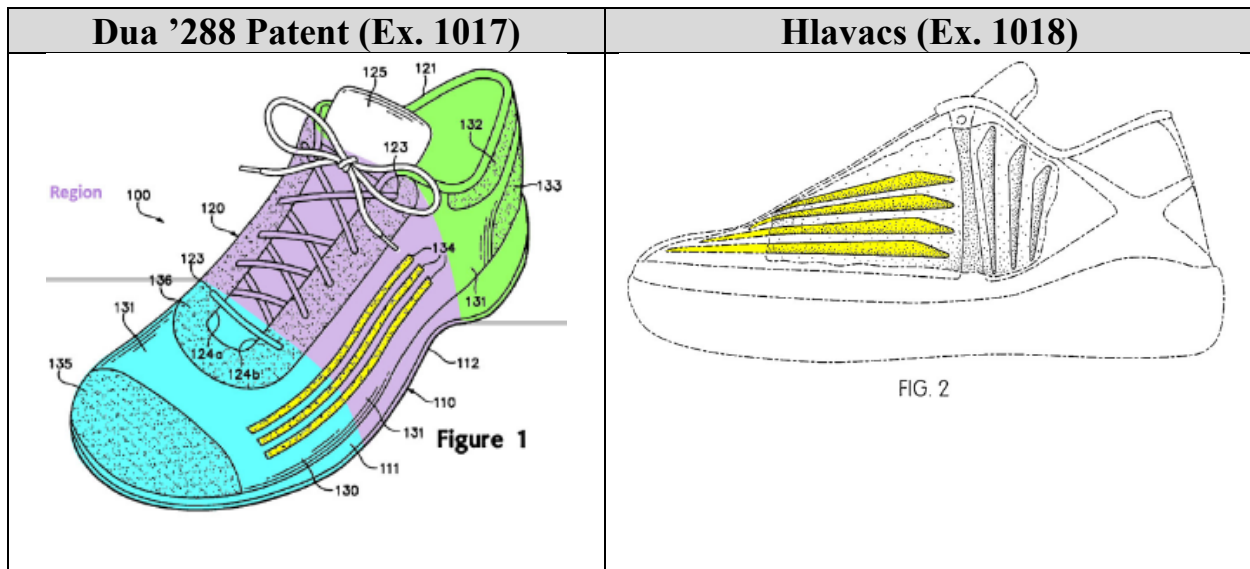
Finally, for factor (d), the petition has complete overlap with the arguments made during examination. Skechers does not attempt to use Bellak or Herbert in a manner different than how the examiner considered them during prosecution, nor does Skechers identify any new argument for Cusinato. Instead, Skechers simply asserts that Bellak, Herbert, and Cusinato disclose limitations 1[pre] and 1[a1] in precisely the same manner that was already considered by the Office.

2. Limitations [a2] and [b] of the independent claims

For the “rib” limitations 1[a2] and 1[b], Skechers relies on Bellak, Spencer, and the Dua ’288 Patent (for Ground 1), and Herbert, Spencer, and Hlavacs (for Ground 2). Paper 1, at 61-71 (Ground 1), and 96-100 (Ground 2). But as explained above, the Office already considered Bellak, Spencer, Herbert, and the Dua ’288 Patent during prosecution. *See supra* § II.C. Hlavacs is the only new reference, but Skechers cites it for teachings that are cumulative of the Dua ’288 Patent. For factor (d), Skechers does not attempt to use these references in a manner different than how the examiner considered them during prosecution, nor does Skechers identify any new arguments for Hlavacs.

For Ground 1, Skechers recycles the Dua '288 Patent for the same alleged disclosure that it acknowledges was already used by the examiner, by pointing to “what the Examiner described as ‘a plurality of ribs’” (limitation 1[a2]), and the “longitudinal appearance of the ribs/stripes” (limitation 1[b]). Paper 1, at 62, 69. But that incorrect understanding of the Dua '288 Patent was later withdrawn by the examiner, when she agreed that the “fused” structure does not disclose the claimed “ribs.” Ex. 1013-1, 91. In other words, Skechers makes the same argument in its Petition that was already rejected by the Office. For Ground 1, Skechers also relies on Bellak (Paper 1, at 63, 69), which again, was already considered by the Office. For Ground 2, Skechers relies on Hlavacs for the “aesthetic appearance of the ribs/stripes” for limitation 1[b], which must “extend longitudinally” and extend “from the forefoot region toward the heel region.” Paper 1, at 97-100. But as shown below using its own annotations for the yellow-highlighted elements, Skechers uses Hlavacs for the same teachings and arguments it uses for the Dua '288 Patent, which was already considered.⁶ Compare Paper 1, at 69-70 (citing Ex. 1017) *with id.* at 97-98 (citing Ex. 1018).

⁶ Nike does not agree that either the Dua '288 Patent or Hlavacs discloses or renders obvious any of the “rib” limitations.



Skechers' re-use of the Dua '288 Patent (as well as Bellak, Spencer, Herbert), and the entirely cumulative Hlavacs, thus has already been considered by the Office.

C. Advanced Bionics Step 2: Skechers did not demonstrate that the Office erred

Once step one has been satisfied, the burden shifts to Petitioner to show that the Office erred in a manner material to the patentability of the Challenged Claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, 2020 WL 740292, *3 (P.T.A.B. Feb. 13, 2020) (precedential). “An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Id.* at *3 n.9. But “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* at *3.

Here, Skechers failed to make any argument or evidentiary showing related to *Becton, Dickinson* factors (c), (e), and (f). Indeed, Skechers does not argue there was any error, and neither the word “error” nor “err” appears in the Petition.

Skechers’ failure to allege material error is a sufficient basis to determine that it did not carry its burden as to *Advanced Bionics* step two. *E.g.*, *Balt USA, LLC v. MicroVention, Inc.*, IPR2019-01259, 2021 WL 219251, at *10, *12 (P.T.A.B. Jan. 21, 2021); *Sony Interactive Ent. LLC v. Terminal Reality, Inc.*, IPR2020-00711, 2020 WL 6065188, at *5 (P.T.A.B. Oct. 13, 2020); *NXP USA, Inc. v. Impinj, Inc.*, IPR2020-00519, 2020 WL 4805424, at *5 (P.T.A.B. Aug. 17, 2020).

Specifically, for factor (c), Skechers acknowledges that the examiner extensively evaluated Bellak and the Dua ’288 Patent, using both in rejections of all claims, and acknowledges that the examiner also considered Herbert. Paper 1, at 31-33. However, Skechers failed to acknowledge that the examiner also considered Spencer, incorrectly stating that “[n]one of . . . Spencer [was] before the Examiner.” *Id.* at 33. Spencer was, in fact, considered during prosecution. *See* Ex. 1013-14, 7354 (row 2, and the notation “All References Considered”).

In any case, for factors (e) and (f), while Skechers does not assert that the Office made any **errors** (and thus failed to meet its burden), Nike provides responses to the three arguments Skechers included in the Petition, which are also insufficient under step two. First, Skechers asserts that the examiner did not

consider that “ribs . . . are among the simplest” elements in “knitted textiles” (Paper 1, at 16), an argument for which the Petition relies on Spencer. *E.g., id.* at 26. But the Office *did* consider Spencer (which Skechers failed to mention), and Skechers’ use of that reference in the Petition is akin to arguing that the examiner failed to consider what was “common knowledge” in the art, which cannot constitute a material error in any case. *Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021-00412, Paper 9, at 36-39 (P.T.A.B. July 21, 2021).

Second, Skechers argues the Office “did not have the opportunity to consider expert testimony.” Paper 1, at 17. But that also does not constitute an Office error, particularly here, where Skechers’ “observation” did not identify any misapprehension in the Examiner’s understanding “of the prior art previously presented to the Office,” rendering this argument “ineffective to show that the Examiner materially erred.” *See, e.g., Nespresso USA, Inc. v. K-Fee Sys. GmbH*, IPR2021-01222, 2022 WL 212376, at *11 (P.T.A.B. Jan. 18, 2022); *see also Nespresso USA, Inc. v. K-Fee Sys. GMHB*, IPR2021-01221, Paper 11, at 21-24 (P.T.A.B. May 6, 2022) (denying petitioner’s request for reconsideration). Further, as demonstrated below Dr. Adanur’s opinions regarding a POSITA’s alleged motivation to combine the teachings already considered by the office (or cumulative teachings) are entirely conclusory, and thus do not demonstrate any Office error. *See infra*, §§ VII.A.2-3, VII.B.2, 4-5; *Adt LLC v. Vivint, Inc.*, No.

IPR2022-00612, 2022 WL 3588570, at *11 (P.T.A.B. Aug. 22, 2022) (denying institution under 325(d), crediting Patent Owner’s argument that “conclusory” expert opinions do “not represent anything new” to change the Office’s decision).

Finally, Skechers argues that the Office did not previously consider Cusinato or Hlavacs. Paper 1, at 33. But that also does not constitute an Office error, and in any case, as discussed above Skechers relies on Cusinato and Hlavacs for teachings that are entirely cumulative of (at least) Bellak and the Dua ’288 Patent, which were extensively considered during prosecution.

Skechers failed to identify any Office error. And the three arguments Skechers advanced do not collectively constitute error, because in assessing Section 325(d), the Board takes a “holistic view of the totality of the information presented,” and “appl[ies] the principle that, ‘[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments’ by the examiner, then ‘it cannot be said that the Office erred in a manner material to patentability.’”

Nespresso, 2022 WL 212376, at *11 (citing *Advanced Bionics*, IPR2019-01469, Paper 6, at 9). Here, Skechers (1) failed to mention that the Office already considered Spencer, (2) did not show how the Office misunderstood the multiple references considered in any manner that would have changed based on conclusory expert testimony, and (3) only asserts new references that are entirely cumulative.

Thus, Skechers did not meet its burden under *Advanced Bionics* step two, and the Board should deny institution under Section 325(d).

VI. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

Despite the fact that Skechers' asserted references are the same or substantially the same as those considered during prosecution, Skechers admitted to delaying its filing of the Petition for its own strategic benefit. Thus, *Fintiv* also warrants denial of institution, because the validity of the '781 Patent is being litigated concurrently in district court in the Central District of California. *See Nike, Inc. v. Skechers U.S.A., Inc.*, 2:23-cv-09346 (C.D. Cal.).

That this Board and the District Court are being asked to simultaneously adjudicate the validity of the '781 Patent is the direct consequence of Skechers' admitted gamesmanship and strategic decision to delay the filing of the Petition to take strategic advantage of (1) Nike's recent trial with lululemon; (2) the fact that Nike will be doing "triple duty" by simultaneously pursuing litigation against Skechers, New Balance, and lululemon; and (3) Skechers' belief that the Board will institute at least Skechers' petitions challenging the related '484 and '749 Patents, because those petitions are "similar" to petitions filed by lululemon. *Ex. 2002*. To institute review in these circumstances would needlessly waste the resources of the Board, result in inefficient and disorderly disposition of the parallel validity challenges to the '781 Patent, with the potential for conflicting

decisions by the Board and the District Court on everything from claim construction to the final merits decision, and improperly reward Skechers' admitted gamesmanship.

A. Legal Standard for *Fintiv* Discretionary Denial

The Board considers six nonexclusive *Fintiv* factors to evaluate system efficiency and fairness when a patent owner argues for discretionary denial due to a parallel proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, at *2 (P.T.A.B. March 20, 2020). These factors are:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board's exercise of discretion, including the merits.

Id.

These factors relate to whether efficiency, fairness, and the merits warrant denial of institution in view of the parallel proceeding. "[I]n evaluating the factors,

the Board takes a holistic view of whether efficiency and the integrity of the system are best served by denying or instituting review.” *Id.* at *3.

In addition, Skechers has not offered a *Sotera* stipulation, which strongly weighs in favor of denying institution here. *Zhuhai Cosmx Battery Co., Ltd. v. Ningde Ampere Tech. Ltd.*, IPR2023-00587, Paper 12, at 15, 27 (P.T.A.B. Sept. 22, 2023) (denying institution where Petitioner stipulated not to re-raise same grounds in district court as in IPR but where stipulation “does not extend to any ground ‘that could have been reasonably raised,’ pursuant to *Sotera*.”). Because Skechers has not offered a *Sotera* stipulation—or even a weaker commitment not to assert duplicative grounds in the district court proceeding—*Zhuhai* applies here.

Accordingly, the Board should find that Skechers’ decision not to offer a *Sotera* stipulation neutralizes the effects of the pre-institution stay recently entered by the District Court, and find that a holistic analysis of the *Fintiv* factors warrants denial of institution due to the duplication of invalidity grounds in the parallel proceedings. *See Fintiv*, 2020 WL 2126495, at *3; *see also Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 (P.T.A.B. June 1, 2021) (denying institution in view of holistic analysis of *Fintiv* factors).

B. The Present Facts Warrant Discretionary Denial Under *Fintiv*

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted (Factor One)

The first *Fintiv* factor addresses the issue of a stay of the parallel proceedings. Here, while the District Court has stayed the parallel litigation (*Nike, Inc.*, 2:23-cv-09346, Dkt. 97 (C.D. Cal. Feb. 4, 2025)), Skechers has not offered a *Sotera* stipulation, and there is no reason to conclude that the District Court's stay reflects any analysis regarding the merits of Skechers' invalidity defenses. As such, the Board should not weigh the pre-institution stay against using its discretion to deny institution, because if the Board denies institution and the stay is lifted, the litigation can resume *status quo ante*.

2. The trial date is before the deadline for a Final Written Decision (Factor Two)

"If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of exercising authority to deny institution under *NHK*." *Fintiv*, 2020 WL 2126495, at *4. In the parallel litigation, before the Court stayed the case, trial was set for February 9, 2026, more than four months before the expected Final Written Decision date of June 21, 2026. *Nike, Inc.*, No. 2:23-cv-09346 (C.D. Cal.), Dkt. 96 at 4. If the Board denies institution and the matter proceeds with an approximate delay of four months from the previous schedule, the District Court action will head to trial on or about June

2026. Moreover, the District Court can hear not only Skechers' invalidity defenses, which will likely include challenges under 35 U.S.C. § 112, but can resolve infringement and damages as well. As such, especially in light of Skechers' failure to offer a *Sotera* stipulation, it is more efficient to allow this matter to proceed in front of the District Court. The Board has found that a trial date the same month as the due date for a Final Written Decision weighs against institution. *See 10x Genomics, Inc. v. President and Fellows of Harvard Coll.*, IPR2023-01299, 2024 WL 993828, at *7 (P.T.A.B. Mar. 7, 2024). Thus, factor two weighs against institution.

3. The Parties have invested in the parallel proceeding (Factor Three)

“The Board also has considered the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, 2020 WL 2126495, at *4. “[M]ore work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.* The Board considers the amount and type of work already completed in the parallel litigation “at the time of the institution decision.” *Id.*

Nike and Skechers have undertaken substantial activity in the district court proceedings since at least November 6, 2023, when Nike filed its complaint. *Nike, Inc.*, No. 2:23-cv-09346 (C.D. Cal.), Dkt. 1. The parties have already spent months briefing the district court on claim construction issues. The parties submitted opening, reply, and supplemental claim construction briefs, and a claim construction hearing was held on September 20, 2024. Ex. 1005; Ex. 1006; Ex. 1007; Ex. 1008; Ex. 1009; Ex. 1010; *see also Nike, Inc.*, No. 2:23-cv-09346 (C.D. Cal.), Dkt. 83 and 84 (supplemental claim construction briefing).

Additionally, the parties have exchanged thousands of pages of discovery, including for merits arguments concerning the '781 Patent. Skechers served preliminary and supplemental invalidity contentions in April and May 2024, respectively, including detailed claim charts that address nearly the same prior art cited in the Petition. *E.g., Nike, Inc.*, 2:23-cv-09346 (C.D. Cal.), Dkt. 48-1 at 1-2 (setting 2024 deadlines for preliminary and amended contentions). Nike served initial and supplemental infringement contentions in March and October 2024, respectively. *Id.*; Ex. 1011. At the time of the stay, non-email discovery was almost complete, and the parties were finalizing e-mail search terms. As the Board has found, “the current investment in invalidity and construction contentions” weighs in favor of discretionary denial. *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ.*, IPR2020-00122, Paper 15, at 8–9 (P.T.A.B. May 15, 2020). Thus, the

parties' significant investment in the parallel proceeding, since at least November 2023, favors denying institution.

4. The validity of the '781 Patent is central to both proceedings (Factor Four)

The validity of the '781 Patent is central to both this proceeding, and the parallel litigation. In district court, Nike asserts that Skechers infringes the '781 patent. *Nike, Inc.*, No. 2:23-cv-09346 (C.D. Cal.), Dkt. 1 at 18-20. In turn, Skechers alleges that the claims of the '781 patent are invalid. *Id.*, Dkt. 34 at 15. It would be wasteful and inefficient to proceed here given the overlap between the issues and the potential for conflicting decisions. *See Keyme, LLC v. Hillman Grp.*, IPR2020-01485, 2021 WL 1236002, at *5 (P.T.A.B. Mar. 31, 2021) (denying institution in light of parallel litigation because it would be inefficient to proceed in multiple fora, and to avoid potential conflicting decisions due to the substantial overlap between claims). Factor four therefore weighs in favor of denying institution.

5. Patent Owner and Petitioner are the same parties in both proceedings (Factor Five)

Skechers and Nike are the same parties in this proceeding, and the parallel litigation. Accordingly, "this [fifth] factor favors the exercise of discretionary denial." *Keyme, LLC*, 2021 WL 1236002, at *6.

6. Other circumstances warrant that the Board exercise its discretion to deny institution (Factor Six)

There are no additional factors that warrant institution. To the contrary, the other relevant circumstances here—including the Office’s previous consideration of substantially all of the same art advanced by Skechers (warranting § 325(d) discretionary denial), and Skechers’ strategic decision to delay filing this Petition until a time when it knew that “Nike [would] be doing ‘triple duty’ by simultaneously pursuing litigation against Skechers, New Balance, and lululemon.” Ex. 2002; *Fintiv*, 2020 WL 2126495, at *7 (noting that other relevant circumstances include “considerations implicated by 35 U.S.C. § 325(d)” and their effect on the “efficiency and integrity of the patent system”).

Skechers could have filed this Petition in May 2024, after it served its supplemental invalidity contentions in district court that included many of the same art and arguments. Yet, Skechers delayed an additional six months to file at a time when it was aware that Nike’s resources would be stretched thin. The Board should discourage these tactics and gamesmanship, and prevent wasting judicial resources, by denying institution.

Fintiv weighs in favor of denial, and the Board should deny institution.

VII. THE BOARD SHOULD ALSO DENY INSTITUTION BECAUSE SKECHERS HAS NOT ESTABLISHED A REASONABLE LIKELIHOOD OF PREVAILING FOR ANY CHALLENGED CLAIM

Skechers bears the burden to demonstrate “there is a reasonable likelihood” it “would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *SMIC, Ams. v. Innovative Foundry Techs., LLC*, IPR2020-00837, 2020 WL 5991664, at *5 (Oct. 9, 2020) (denying institution where petition “fails to identify sufficient evidence”). Skechers has not met its burden here.

Both grounds are based on unpatentability under 35 U.S.C. § 103, *i.e.*, that the differences between the claims of the ’781 Patent 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 POSITA. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). Skechers must articulate specific reasoning and cannot rely on conclusory statements or attorney argument. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362–63 (Fed. Cir. 2016); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1342 (Fed. Cir. 2020) (affirming non-obviousness where petition relied on “attorney argument rather than evidence in the record”).

Skechers also must articulate rationales to support why a POSITA would have been motivated to modify or combine teachings from the references. *KSR*, 550 U.S. at 418; *see also In re Stepan Co.*, 868 F.3d 1342, 1345–46 (Fed. Cir. 2017). In addition, Skechers must show that a POSITA would have had a

reasonable expectation of success in making the combination. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016).

Here, Skechers has not shown a reasonable likelihood of success for any challenged claim, under either ground. Accordingly, institution should be denied.

A. Ground 1: The Petition Fails To Show A Reasonable Likelihood Of Success That The Combination of Cusinato, Bellak, Dua, And Spencer Renders Obvious Any Challenged Claim

Skechers fails to show that multiple limitations in both independent claims are disclosed, and fails to articulate even a *prima facie* motivation to combine.

1. Neither Cusinato nor Bellak discloses an “upper for an article of footwear” (Claim 1[pre]) or an “article of footwear comprising: an upper” (Claim 12[pre])

Neither Cusinato nor Bellak discloses an “upper for an article of footwear,” or an “article of footwear comprising an upper,” which are required in all Challenged Claims, under the ordinary and customary meaning of “article of footwear.” As an initial matter, the preambles of Claims 1 and 12 are limiting, at least because they provide antecedent basis for the element “the *upper*,” which appears later in the body of both claims. *See, e.g., SIMO Holdings, Inc. v. Hong Kong uCloudlink Network Tech. Ltd.*, 983 F.3d 1367, 1375–76 (Fed. Cir. 2021) (“We have repeatedly held a preamble limiting when it serves as antecedent basis for a term appearing in the body of a claim.”). Notably, Skechers does not dispute

that the preambles are limiting, and alleges that the preambles are disclosed by the references in both grounds. Paper 1, at 53 (Ground 1), 93-94 (Ground 2).

Skechers alleges that Cusinato's "stocking" and Bellak's "slipper" are each "an upper for an article of footwear," under Skechers' incorrect construction, which re-defines "footwear" to include "slippers, or hose (e.g. socks)." *Id.* But a POSITA reading Claims 1 and 12 in light of the '781 Patent specification in 2004 would not have understood either "stockings" or "slippers" to constitute "articles of footwear." *See supra* § IV.A; Ex. 2001, ¶¶29-38. As Dr. Pastore explains, Cusinato's "stocking" and Bellak's "slipper" are not "footwear" because they lack a sole structure. Ex. 2001, ¶¶63-65. Skechers acknowledges this deficiency, because it also argues that a POSITA would have combined Cusinato or Bellak with the "shoe" from the Dua '288 Patent, to "add a sole." Paper 1, at 53. But Cusinato's "stocking" and Bellak's "slipper" are also not "uppers," because they have distinct sock features and are incapable of being incorporated or transformed into shoes by adding a sole. Ex. 2001, ¶¶33-34, 63-65. As Dr. Pastore opines, a POSITA cannot simply attach a sock to a sole to produce a shoe—an upper for a shoe requires features that stocking and slippers do not have. *Id.*, ¶70. The insufficiencies of Skechers' combination arguments are discussed below.

Because both Cusinato and Bellak fail to disclose the preamble of independent Claims 1 and 12, Ground 1 fails for all Challenged Claims.

2. The Petition does not articulate a sufficient motivation for combining Cusinato or Bellak with the Dua '288 Patent to reach Claims 1[pre] and 12[pre]

Skechers' alternative argument also fails, because the Petition does not articulate even a *prima facie* rationale to support why a POSITA allegedly would have been motivated to combine Cusinato's "stocking" or Bellak's "slipper," with the "shoe" of the Dua '288 Patent, to meet the preambles of Claims 1 and 12.

First, the Petition itself is silent on any motivation—Skechers only cites to Dr. Adanur's declaration. Paper 1, at 53 (citing Ex. 1002, ¶¶164-70). But Dr. Adanur provides only a single motivation that is insufficient to support institution. Specifically, Dr. Adanur opines that it allegedly "would be obvious to add a sole to Cusinato's flat knit textile element," "or to Bellak's 'slipper,' because adding a sole structure would provide, for example, cushioning, support, and traction." Ex. 1002, ¶169 (citing Ex. 1017, 4:17-37). That is the extent of his opinion, and for support, he only cites the Dua '288 Patent, which discusses how components of that patent's "[s]ole structure" (the "insole," "midsole," and "outsole") have properties that can enhance "comfort," "absorb[] energy associated with running," and "enhance the traction"—*for shoes*. Ex. 1017, 4:17-37.

In other words, Dr. Adanur's opinion is limited to quoting potential benefits of a sole, as described in a shoe reference that already has a sole. That cannot constitute a motivation to combine—the notion that soles may provide benefits *for*

shoes does not explain why a POSITA in possession of *non-shoe* references would seek out shoe teachings. Indeed, Dr. Adanur does not cite anything from Cusinato or Bellak to explain what would lead a POSITA to shoe teachings in the first place, let alone articulate a single reason why a POSITA would supposedly be motivated to modify a “stocking” or “slipper” to transform them into shoes. Dr. Adanur’s opinion is therefore “insufficient for obviousness” as a matter of law, because he failed to articulate “why a POSITA would modify the teachings of the references to arrive at the claimed invention.” *William Wesley Carnes, Sr., Inc. v. Seaboard Int’l Inc.*, IPR2019-00133, Paper 10, at 18 (P.T.A.B. May 8, 2019); *see also In re Nuvasive Inc.*, 842 F.3d 1376, 1384-85 (Fed. Cir. 2016) (reversing obviousness, because while the petitioner only offered “conclusory statements,” and the Board “failed to articulate a *reason why* the PHOSITA would have been motivated to” make the combination) (emphasis original). And, as Dr. Pastore explains, “a POSITA would not have any reason to attempt to transform a sock, stocking, or slipper into a shoe.” Ex. 2001, ¶69; *see also id.*, ¶¶66-71. Moreover, Bellak in particular teaches away from such combination (and shows why a POSITA would not have had a reasonable expectation of success in combining stocking or slipper references with shoe sole teachings), because Bellak’s “slipper” article is “adapted to form a *hand* or foot covering, such as a slipper, *glove* or the like.” Ex. 1015, 1:18-25. A sole structure cannot be added to a glove. Ex. 2001, ¶69.

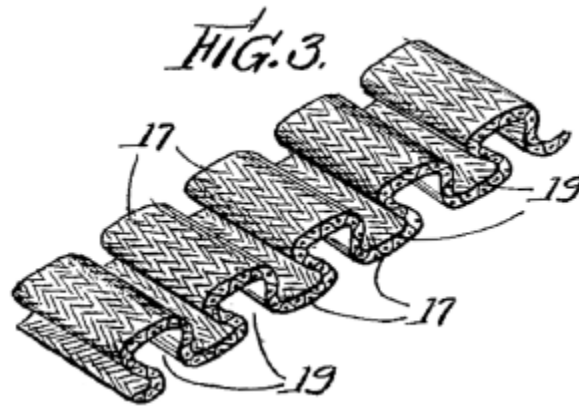
Furthermore, it is well-settled that conclusory expert “testimony is entitled to little or no weight.” *One World Techs., Inc. v. Chevron (HK) Ltd.*, PGR2020-00059, 2020 WL 7222691, at *16 (P.T.A.B. Dec. 7, 2020). Here, Dr. Adanur’s opinion is conclusory, and amounts to opining that because shoes also existed at the time of application, a POSITA automatically would have been motivated to add a “sole” to non-shoe art to obtain the benefits of shoes. That is also insufficient to demonstrate a motivation to combine. *William Wesley Carnes*, IPR2019-00133, Paper 10, at 17–18 (denying institution, in part because a “conclusory statement” is not “sufficient to support a motivation to modify the prior art teachings” under *KSR*); *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024) (reversing the Board’s obviousness ruling because the mere fact that an approach “existed in the prior art does not provide a reason that a skilled artisan would have substituted” for it).

Finally, Dr. Adanur did not provide any opinion to support a reasonable expectation of success, as he merely asserts without support that Cusinato’s “stocking” and Bellak’s “slipper” could be converted into shoes simply by “add[ing] a sole.” Ex. 1002, ¶169. But as Dr. Pastore explains, stockings, slippers, and socks are garments, which lack the unique features of shoe uppers that allow them to be attached to soles. Ex. 2001, ¶¶69-71. Skechers’ failure to address a reasonable expectation of success also warrants denial of institution.

3. The combination of Cusinato, Bellak, Dua, and/or Spencer does not disclose “a plurality of ribs integrally knitted into the flat knit textile element” (Claims 1[a2] and 12[a2])

The asserted combination also does not disclose an “a plurality of ribs integrally knitted into the flat knit textile element,” which is required in all Challenged Claims, under the parties’ agreed construction of “ribs integrally knitted.” *See supra* § IV.D; Ex. 2001, ¶¶72-81. The parties’ construction requires, *inter alia*, a plurality of “structure[s]” constituting “lengthwise ridges,” which must be “integrally knitted into the flat knit textile element.” *Id.*

But for this limitation, Skechers primarily relies on Bellak (Paper 1, at 61), which only discloses a piece of “fabric” that is entirely constructed of the “so-called ribbed type,” with “projecting bands 17 and intermediate hollows 19.” Ex. 1015, 1:71-75. Skechers does not show that Bellak’s “ribbed” fabric includes “structure[s]” constituting “lengthwise ridges” that are “integrally knitted into” a larger element of “flat knit textile.” Ex. 2001, ¶¶74-76. Instead, Bellak’s fabric is uniformly constructed of so-called alternating “bands” and “hollows”:



Next, Skechers seemingly acknowledges this deficiency in Bellak, because it also relies on Spencer. Paper 1, at 61-62. But here, Skechers makes no showing that Spencer discloses the claimed “ribs.” Instead, Skechers points to a basic teaching that the “simplest rib fabric is 1 x 1 rib,” which has “a vertical cord appearance” and “wales” (*id.*, citing Ex. 1050, 60, 67-68), and an entirely different chapter of Spencer describing “[c]ardigan stitches . . . used in the body sections of heavy-weight stich-shaped sweaters.” *Id.*, citing Ex. 1050, 218. Skechers makes no showing how these disparate teachings about basic knitting, and the knitting of sweaters, could disclose “a plurality of ribs integrally knitted into the flat knit textile element” under the parties’ agreed construction. Neither does Dr. Adanur, who simply asserts that “Spencer explains [] integrally knit ribs,” while citing to the same few pages of Spencer that discuss generic ribbed fabric and sweaters—not anything like the claim limitation. Ex. 1002, ¶197; Ex. 2001, ¶¶77-79.

Finally, Skechers also seemingly acknowledges the deficiencies in Spencer, because in a last attempt it also relies on the Dua '288 Patent. Paper 1, at 62-63. But this argument may be immediately dismissed. Skechers admits that the Dua '288 Patent does **not** disclose the claimed “ribs integrally knitted into the flat knit textile element,” and instead discloses “fused yarn ribs,” as the examiner agreed during prosecution after the applicant explained the known (and distinct) meaning in the art of “fused” elements. *Id.* at 63; Ex. 1013-1, 91. Skechers argues that a POSITA would look to Spencer to somehow “modify” the Dua '288 Patent’s “fused yarn ribs,” and transform them into the claimed “ribs integrally knitted,” but this argument fails and is not supported because, as explained above, Spencer also does not disclose this limitation. Paper 1, at 63; Ex. 2001, ¶80.

Finally, Dr. Adanur’s single-paragraph opinion does not provide sufficient support. Dr. Adanur merely opines that “one would turn to Spencer’s teachings of how to create integrally knit ribs (rather than Dua’s fused yarn ribs), as described above, which could be incorporated into Cusinato’s upper.” Ex. 1002, ¶199. But the only reason Dr. Adanur provides for this series of modifications to Cusinato is that “the ribs disclosed in Bellak, Dua, and Spencer can all be used for both aesthetic and/or functional purposes.” *Id.* Even if true, that is not enough, because merely asserting that an approach “existed in the prior art does not provide a reason that a skilled artisan would have substituted” for it. *Virtek Vision Int’l*

ULC, 97 F.4th at 887 (reversing the Board’s obviousness ruling). And in any case, Dr. Adanur’s opinion is conclusory, as it does not explain *why* a POSITA would turn to Spencer when “fused yarn ribs” are known in the art to be a distinct approach, or explain *how* Spencer would be used to modify the Dua ’288 Patent, which then must be further modified with Cusinato. *One World Techs.*, 2020 WL 7222691, at *16 (conclusory “testimony is entitled to little or no weight”).

Accordingly, Bellak, Spencer, and the Dua ’288 Patent fail to disclose this limitation, which is another independent reason that Ground 1 fails.

B. Ground 2: The Petition Fails To Show A Reasonable Likelihood Of Success That The Combination of Herbert, Cusinato, Hlavacs, And Spencer Renders Obvious Any Challenged Claim

Skechers fails to show that multiple limitations in both independent claims are disclosed, and fails to articulate even a *prima facie* motivation to combine.

1. Neither Herbert nor Cusinato discloses an “upper for an article of footwear” (Claim 1[pre]) or an “article of footwear comprising: an upper” (Claim 12[pre])

Neither Herbert nor Cusinato discloses an “upper for an article of footwear,” or an “article of footwear comprising an upper,” which are required in all Challenged Claims, under the ordinary and customary meaning of “article of footwear.”

First, Skechers repeats its allegation from Ground 1 that Cusinato’s “stocking” is “an upper for an article of footwear,” under Skechers’ incorrect

construction (Paper 1, at 94). This fails for the same reasons discussed above. *See supra*, § VII.A.1.; *see also* Ex. 2001, ¶¶62-65, 85-88.

Second, Skechers alleges that Herbert’s “slipper” is “an upper for an article of footwear,” again under Skechers’ incorrect construction. Paper 1, at 93-94.

This allegation fails for largely the same reasons as with the other references. A POSITA reading Claims 1 and 12 in light of the ’781 Patent specification in 2004 would not have understood a “slipper” to constitute an “article of footwear.” *See supra* § IV.A; *see also* Ex. 2001, ¶¶29-38. And as Dr. Pastore explains, Herbert’s “slipper” cannot be “footwear” because it lacks a sole, and it also cannot be an “upper,” because it is a distinct sock-like garment that is incapable of being incorporated into an “article of footwear.” Ex. 2001, ¶¶33-34, 86-87. Moreover, (and as discussed above, *see supra*, at fn.2), Skechers’ misleading one-word quote from Herbert cannot be credited as disclosing this limitation. Paper 1, at 93 (quoting “sole”). Herbert uses “sole” only to refer to the location of its “slipper” fabric along “the bottom” of the foot (*i.e.*, the sole of the wearer’s foot), not a sole structure of a shoe. Ex. 1016, 2:9-21 (left col.). Herbert makes this clear as it also describes its “slipper” as being “adapted to be worn *inside a low cut ladies’ shoe.*” *Id.*, 1:4-7 (left col.); Ex. 2001, ¶86. Thus, Herbert’s slipper does not, and could not, disclose the sole structure of a shoe.

Finally, as with Ground 1, Skechers acknowledges these deficiencies, as it alternatively argues that a POSITA would have combined Herbert or Cusinato with a different “shoe” reference—Hlavacs—in order to “add a discrete sole.” Paper 1, at 94. The insufficiency of that argument is discussed below.

Because both Herbert and Cusinato fail to disclose the preamble of independent Claims 1 and 12, Ground 2 fails for all Challenged Claims.

2. A sufficient motivation is not articulated for combining Hlavacs with Herbert or Cusinato to reach Claims 1[pre] and 12[pre]

Skechers’ alternative argument also fails because the Petition does not articulate even a *prima facie* rationale to support why a POSITA allegedly would have been motivated to combine Herbert’s “slipper,” or Cusinato’s “stocking,” with the “shoe” figure of Hlavacs, to meet the preambles of Claims 1 and 12.

While the Petition does not articulate a sufficient motivation for the analogous Ground 1 combination (*see supra*, § VII.A.2), for Ground 2 the deficiency is total—neither the Petition nor Dr. Adanur alleges *any* obviousness rationale for a motivation to combine.

But first, the combination is also deficient with respect to its disclosures, because Hlavacs is a design patent, which does not include a specification or any technical disclosure. Skechers relies only on one figure that “depicts a sole in dotted lines,” with no further details (Paper 1, at 94, citing Ex. 1018, Fig 2):

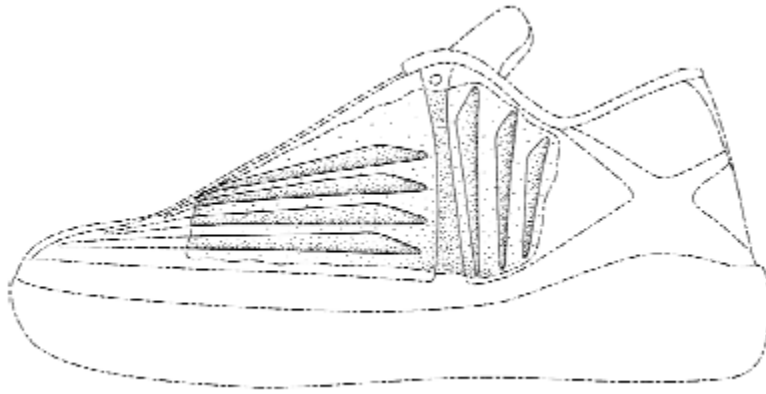


FIG. 2

Skechers does not even attempt to explain how a POSITA could combine Herbert or Cusinato with a figure in Hlavacs to produce a shoe, or demonstrate a reasonable expectation of success in doing so. Ex. 2001, ¶93. Critically, Skechers does not use Hlavacs for the design of its sole, but instead asserts that a POSITA would “add” Hlavacs’s sole to Herbert and Cusinato. But Hlavacs does not disclose any teachings regarding soles, including how they are constructed or joined with an upper to produce a shoe. This combination fails for that reason alone.

Second, turning to the lack of a motivation to combine—the Petition itself is silent, and Skechers only cites to Dr. Adanur’s declaration. Paper 1, at 94 (citing Ex. 1002, ¶¶286-88). But Dr. Adanur does not articulate any motivation to combine—he only offers the conclusory statement that “it would be obvious to add a discrete sole to Herbert’s ‘slipper’ or Cusinato’s ‘boot-like’ form,” with no analysis or explanation. Ex. 1002, ¶286. Dr. Adanur’s conclusory opinion is

insufficient and cannot be credited. *William Wesley*, IPR2019-00133, Paper 10 at 17–18 (denying institution, because a “conclusory statement” is insufficient under *KSR*); *One World Techs.*, 2020 WL 7222691, at *16 (conclusory expert “testimony is entitled to little or no weight”). And, as Dr. Pastore explains, a POSITA would not have been motivated to combine these references. Ex. 2001, ¶¶89-94.

Accordingly, Ground 2 fails for all Challenged Claims for the independent reason that the Petition fails to articulate *any* alleged motivation to combine.

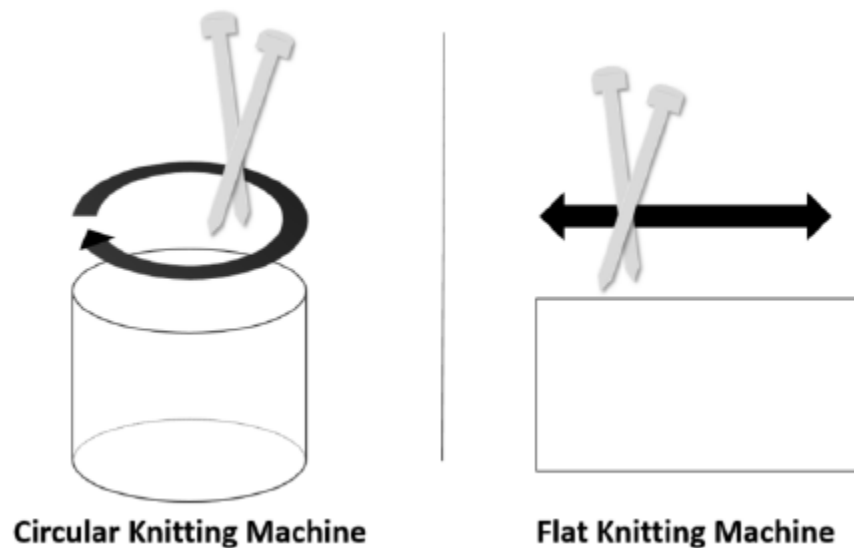
3. Herbert does not disclose “a flat knit textile element having: (1) flat knit edges free of surrounding textile structure . . .” (Claims 1[a1] and 12[a1])

Skechers relies on “Herbert in view of Cusinato” for this limitation.⁷ Paper 1, at 94-95. But Herbert does not disclose it, and as discussed below, the Petition does not articulate a sufficient motivation for combining Herbert and Cusinato.

First, Herbert does not disclose “a flat knit textile element having: (1) flat knit edges free of surrounding textile structure . . .” under either party’s construction. *See supra* § IV.B; Ex. 2001, ¶39. That is because, regardless of how many edges must be “free of surrounding textile structure,” Herbert does not disclose a “*flat knit* textile” element with *any* “flat knit edges.” Ex. 2001, ¶¶95-

⁷ Skechers also mentions Spencer for this limitation, but not for disclosing the limitation itself, and instead only for allegedly teaching how to manufacture generic “flat rib knitted fabric” or “flat knit [(selvedged)] edges.” Paper 1, at 95.

100. Herbert discloses that its “slipper” is made from a “**tube** of knitted fabric,” which is “fabricated of **circular knit** seamless fabric.” Ex. 1016, 1:48-55 (left col.), 1:10-15 (right col.). And Dr. Adanur readily acknowledges that flat and circular knitting are entirely distinct and use different machines: “Circular knitting produces textiles in a continuous tube, while flat knitting produces textiles in sheets.” Ex. 1002, ¶51 (including Dr. Adanur’s illustration):



Dr. Pastore agrees that flat knitting and circular knitting are distinct. Ex. 2001, ¶¶96-97. In an attempt to address this deficiency, Skechers quotes one sentence of Herbert, stating that “cut and sewn flat rib knitted fabric **may** be employed.” Paper 1, at 95, citing Ex. 1016, 1:8-9 (right col.). But this is insufficient for two reasons. First, Herbert does not disclose **any** details regarding how its “slipper” could be manufactured using “cut and sewn flat rib knitted fabric”—this single phrase is

Herbert's total disclosure regarding "flat" knitting. Accordingly a POSITA would not understand Herbert to disclose this limitation. Ex. 2001, ¶¶98-99.

But second, setting aside the lack of details, Herbert references a different *type* of flat knitting that is distinct from the "flat knit edges free of surrounding textile structure" required in this limitation. There is no dispute that a flat knit edge is "*not formed by cutting* from a flat knit textile element." Paper 1, at 38 (quoting Skechers' construction, with emphases added). Yet the only mention of flat knitting in Herbert is for material that must be "*cut* and sewn." Ex. 1016, 1:8-9 (right col.). And as Dr. Pastore explains, flat knitting items that must be cut out of a larger piece of fabric is distinct from flat knitting "to shape," which produces flat knit edges that do not require cutting. Ex. 2001, ¶¶96-97.

Herbert does not disclose that its "cut and sewn flat rib knitted fabric" has *any* edges that do not require cutting, and therefore Herbert cannot disclose this limitation's "flat knit edges free of surrounding textile structure." Dr. Adanur does not address Herbert's deficiency, and instead relies on combining Herbert with Cusinato (which is addressed in the next section, below). Ex. 1002, ¶289.

4. A sufficient motivation is not articulated for combining Herbert with Cusinato to reach Claims 1[a1] and 12[a1]

Skechers' alternative argument—"Herbert in view of Cusinato"—also fails, because a POSITA would not have been motivated to combine the references.

Paper 1, at 94-95. In fact, the circular knit teachings of Herbert are fundamentally incompatible with the flat knit teachings of Cusinato, and Herbert explicitly teaches away from combining with flat knit teachings. Ex. 2001, ¶¶101-107.

Skechers offers one alleged motivation to combine: “A POSITA in possession of Herbert would have been motivated to combine it with Cusinato . . . to take advantage of the benefits of Cusinato’s flat knitting, which eliminated waste and simplified manufacturing (by eliminating cutting).” Paper 1, at 91. But this alleged motivation reveals that Skechers fundamentally misread Herbert. Herbert’s “preferred embodiment” utilizes “circular knit seamless fabric,” which requires “cutting” before the “cut edges” can be joined to form the slipper. Ex. 1016, 1:10-15 (right col.), 2:9-21 (left col.). And Herbert’s single mention of flat knitting is “*cut* and sewn flat rib knitted fabric,” which also requires *cutting*. *Id.*, 1:5-10 (right col.); Ex. 2001, ¶104. In other words, Herbert exclusively discloses processes that require cutting.

Further, Herbert explicitly discloses that its “preferred” “circular knit” process is beneficial, because “making the finished product is simpler and less expensive.” Ex. 1016, 1:10-15 (right col.). In other words, Herbert directs a POSITA to circular knitting for those benefits—not to flat knitting. Ex. 2001, ¶105. But Skechers’ alleged motivation is premised on the notion that a POSITA reading Herbert would be motivated to look to Cusinato’s “flat knit” teachings,

“which could be employed to reduce waste and simplify manufacturing by eliminating cutting steps,” according to Dr. Adanur. Paper 1, at 91, citing Ex. 1002, ¶158. This alleged motivation is not supported because Herbert actually teaches a POSITA away from flat knitting. Thus, Skechers failed to identify a reason that a POSITA would have looked to the flat knit teachings in Cusinato, let alone a reasonable expectation of success in making such combination.⁸

“Fundamental differences between the references are central to [the] motivation to combine inquiry.” *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1358-59 (Fed. Cir. 2020) (affirming Board’s finding of non-obviousness for lack of a motivation to combine, in part because petitioner’s expert failed to address that one reference “teaches pre-seaming” while the other “involves seaming the textile element after it has been cut from the textile structure”). And merely arguing that a POSITA could have combined references is “insufficient” for trial to be instituted on an obviousness ground, because the petition must articulate “why a POSITA would modify the teachings of the references.” *William Wesley Carnes*,

⁸ The Petition also makes the boilerplate assertion that the combination “would have been obvious to try with reasonable expectations of success,” citing Dr. Adanur, who repeats the same boilerplate: “employing the flat knit technology disclosed in Cusinato to create Herbert’s ribbed slipper . . . would have been obvious to try, with a reasonable expectation of success.” Paper 1, at 92, citing Ex. 1002, ¶159. But no details are provided for these conclusory statements, nor any explanation how circular knit teachings could be combined with flat knit teachings.

IPR2019-00133, Paper 10, at 18; *see also In re Nuvasive*, 842 F.3d at 1384-85 (reversing obviousness, because petitioner’s “arguments amount to nothing more than conclusory statements”).

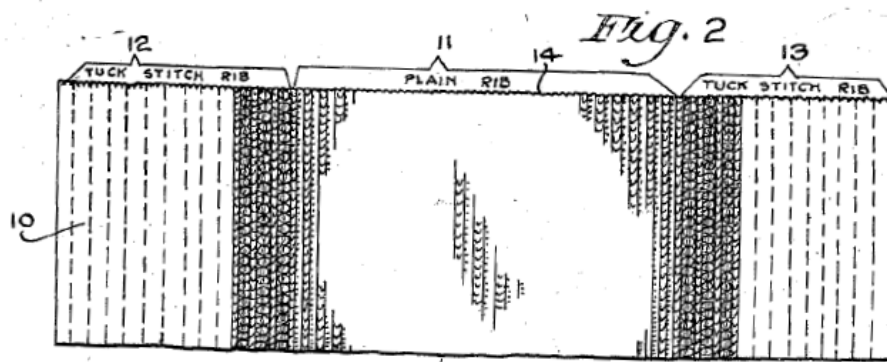
Here, Skechers failed to address the fundamental difference between the references—Herbert exclusively discloses knitting processes that require cutting, while Cusinato touts alleged benefits of knitting without cutting. Furthermore, Skechers ignored that Herbert expressly teaches away from flat knitting because it teaches that circular knitting provides a “simpler and less expensive” process.

Accordingly, Ground 2 fails for all Challenged Claims for the independent reason that the Petition fails to articulate a sufficient motivation to combine for this limitation.

5. Neither Herbert nor Spencer discloses “a plurality of ribs integrally knitted into the flat knit textile element” (Claims 1[a2] and 12[a2])

For largely the same reasons discussed for this limitation in Ground 1 (*see supra* § VII.A.3), and an additional reason, the asserted combination in Ground 2 also does not disclose “a plurality of ribs integrally knitted into the flat knit textile element,” under the parties’ agreed construction of “ribs integrally knitted.” *See supra* § IV.D; *see also* Ex. 2001, ¶¶41, 108-112. The parties’ construction requires, *inter alia*, a plurality of “structure[s]” constituting “lengthwise ridges,” which must be “integrally knitted into the flat knit textile element.” *Id.*

For Ground 2, Skechers primarily relies on Herbert (Paper 1, at 96-97), which like Bellak, only discloses a “slipper” that is entirely constructed of “rib knitted fabric.” Ex. 1016, 1:9 (left col.). Moreover, Herbert discloses that its “preferred embodiment” is “fabricated of circular knit seamless fabric,” with all of its figures depicting “a tubular section of seamless knitted fabric.” *Id.*, 1:11-13 (right col.), 1:35-36 (left col.), Figs. 1-7. And Herbert further discloses that its “slipper” is constructed of “rib rather than plain fabric,” and that the “rib” fabric is used throughout even if variations are incorporated into the “heel” and “toe,” with plain “rib stitch” used for the middle of the slipper, and “tuck stitch rib” used for the heel and toe. *Id.*, 1:16-29 (right col.). This is depicted in Figure 2, which shows “rib” fabric throughout the entire slipper (sections 11, 12, 13):



Accordingly, Skechers does not show that Herbert’s “ribbed” fabric includes “structure[s]” constituting “lengthwise ridges” that are “integrally knitted into” a larger element of “flat knit textile.” The first reason is that Herbert’s teachings and depicted examples all show “circular knit” fabric. Ex. 2001, ¶110.

The second reason is that, like for Bellak above, Herbert's entire fabric is ribbed, and therefore it does not contain distinct "structures" that are "integrally knitted into" a larger textile element. *Id.* Skechers briefly suggests that Spencer could also be added to this combination (Paper 1, at 97), but that argument fails for the same reasons discussed with respect to Spencer's use for this limitation in Ground 1. *See supra*, § VII.A.3; *see also* Ex. 2001, ¶111.

Accordingly, Herbert (and Spencer) fail to disclose this limitation, which is another independent reason that Ground 2 fails.

VIII. CONCLUSION

For the reasons set forth above, Nike respectfully requests that the Board deny institution of the Petition for all Challenged Claims of the '781 Patent.

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/s/ Michael J. Harris

Michael J. Harris (Reg. No. 62,957)

Aaron P. Bowling (Reg. No. 67,311)

Arnold & Porter Kaye Scholer LLP

70 West Madison Street, Suite 4200

Chicago, IL 60602-4231

Tel: (312) 583-2300

Fax: (312) 583-2360

Email: michael.harris@arnoldporter.com

aaron.bowling@arnoldporter.com

Michael J. Sebba (Reg. No. 75,595)

Arnold & Porter Kaye Scholer LLP

777 South Figueroa St - 44th Floor

Los Angeles, CA 90017-5844

Tel: (213) 243-4000

Fax: (213) 243-4199
Email: michael.sebba@arnoldporter.com

Jonathan Swisher (*pro hac* forthcoming)
Arnold & Porter Kaye Scholer LLP
3 Embarcadero Center, 10th Floor
San Francisco, CA 94111-4024
Tel: (415) 471-3100
Fax: (415) 471-3400
Email: jonathan.swisher@arnoldporter.com

Attorneys for Patent Owner Nike, Inc.

CERTIFICATE OF WORD COUNT

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the Microsoft Office word count including all footnotes for the foregoing Patent Owner's Preliminary Response, excluding the table of contents, table of authorities, certificate of word count, appendix and certificate of service, totals 12,938 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

Dated: March 21, 2025

/s/ Michael J. Harris
Michael J. Harris (Reg. No. 62,957)
Arnold & Porter Kaye Scholer LLP
70 West Madison Street, Suite 4200
Chicago, IL 60602-4231
Tel: (312) 583-2300
Fax: (312) 583-2360
Email: michael.harris@arnoldporter.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies service on the Petitioner, pursuant to 37 C.F.R. § 42.6(e) and by agreement of counsel, by electronic (e-mail) delivery of a true copy of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE**, which was served on March 21, 2025 to the following Counsel for Petitioner via e-mail:

Samuel K. Lu (Reg. No. 40,707)
Keith Orso (Reg. No. 52,084)
Connor He-Schaefer
IRELL & MANELLA LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90067-4276
slu@irell.com
korso@irell.com
che-schaefer@irell.com
SkechersNikeIPRs@irell.com

Jonathan M. Lindsay (Reg. No. 45,810)
Jie Gao (Reg. No. 73,835)
IRELL & MANELLA LLP
840 Newport Center Dr., Suite 400
Newport Beach, CA 92660-6324
jlindsay@irell.com
jgao@irell.com

Michael M. Rosen
IRELL & MANELLA LLP
750 17th Street NW, Suite 850
Washington, DC 20006
mrosen@irell.com

/s/ Timothy Haugh
Timothy Haugh