

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 IPR2025-00144

Patent No. 9,918,511

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBITS

Exhibit No.	Description
2001	Declaration of Dr. 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. 9,918,511 (the “’511 patent”; Ex. 1001). The Board should deny institution for two independent reasons: (1) Skechers’ two grounds in its Petition involve the same or substantially the same prior art and arguments the Patent Office previously considered during the original prosecution of the ’511 Patent, and (2) Skechers failed to establish a reasonable likelihood that it will prevail in showing the unpatentability of any Challenged Claim.

The ’511 patent relates to an article of footwear having a textile upper and a sole structure. The ’511 patent has two independent claims (1, 15) and eighteen dependent claims. The claims are generally directed to an article of footwear with an 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, at least one flat knit edge being a curved flat knit edge, and (2) a first knit strip having a first property and a second knit strip having a second property that is different from the first property.” *E.g.*, Ex. 1001, 12:9–14:16; *see also* Figs. 2–7; 5:30–6:53.

Skechers presents two grounds of alleged unpatentability. Both grounds advance an obviousness theory. Ground 1 alleges obviousness of the Challenged Claims based on European Patent Application EP 1,338,690 A1 (“Cusinato”; Ex. 1014) in view of U.S. Patent No. 2,440,393 (“Clark;” Ex. 1015) and, if necessary, *Knitting Technology, A Comprehensive Handbook And Practical Guide* (Third Edition) by David J. Spencer (“Spencer;” Ex. 1050). Ground 2 alleges obviousness of the Challenged Claims based on U.S. Patent No. 2,400,692 (“Herbert”; Ex. 1016) in view of Cusinato and U.S. Patent No. 2,147,197 (“Glidden,” Ex. 1017), and, if necessary, Spencer.

The Patent Office has already considered four of the prior art references Skechers presented in its Petition—Spencer, Clark, Herbert, and Glidden. The fifth reference, Cusinato, is cumulative of other prior art the Examiner considered during prosecution. The Board should thus deny institution. *See* 35 U.S.C. § 325(d).

Further, Skechers’ strategic delay in filing its Petition prejudices Nike and wastes judicial resources by ensuring that the validity of the ’511 patent will be litigated simultaneously in two separate fora—before the Board and in district court, where the parties have been litigating for more than a year. Skechers’ delay wastes party and Board resources and prejudices Nike by forcing it to defend against serial challenges while simultaneously defending the validity of the ’511 patent in two

fora, leading to potentially inconsistent decisions on the same issues. These circumstances favor discretionary denial, which is further justified under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495 (PTAB Mar. 20, 2020) (precedential).

The Board should also deny institution because Skechers has not shown a reasonable likelihood of prevailing on any Challenged Claim across its two grounds. Skechers failed to show that either ground discloses or renders obvious at least one critical element required in all Challenged Claims: an “*upper* for an article of *footwear*.” See Ex 1001, 12:9 (emphasis added)¹. As Skechers acknowledges, each of the primary references in the two grounds discloses teachings related to socks, stockings, or slippers—not footwear (*i.e.* shoes). See Petition, 51 (Ground 1: relying on Cusinato, which discloses “stockings”); 94–95 (Ground 2: relying on Herbert, which discloses a “slipper,” and again Cusinato, which discloses a “stocking”).² For

¹ The other challenged independent claim, Claim 15, recites “An article of footwear comprising: an upper,” which includes the same “footwear” requirement. See Ex. 1001, 13:1–2.

² Skechers misrepresents Herbert and Cusinato in an attempt to obscure their lack of “sole” or footwear teachings. For Herbert, Skechers includes a one-word quote “sole,” to make it seem as if Herbert discloses footwear. Petition, 94 (citing Ex. 1016, 1:48, 3:17). Herbert does not disclose footwear—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, at 2:9–21. And for Cusinato, Skechers includes a one-word quote “boot,” to make it seem as if Cusinato discloses footwear. Petition, 95 (citing Ex. 1014, [0010]). Again,

this reason, Skechers also adds a shoe reference to the combination in each ground. *Id.*, 51 (Ground 1: relying on the Clark for an “upper”); 94 (Ground 2: relying on Glidden, for “articles of footwear”). 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 only offers the conclusory opinion that “a POSITA would consider it obvious to add a sole to Cusinato’s ‘boot-like’ form.” Petition, 51 (citing Ex. 1002, ¶¶157–160). Similarly for Ground 2, the Petition is equally deficient, as Dr. Adanur offers the conclusory opinion that “a POSITA would also consider it obvious to add a more rugged sole to the ‘slipper’ in Herbert or the ‘bootlike’ form in Cusinato,” with no further explanation. Petition, 95 (citing Ex. 1002, ¶¶268–269).

Because of this deficiency, for Ground 1, the Petition fails to show that the combination discloses “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

Cusinato does not disclose footwear—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.

which the textile element must be removed, at least one flat knit edge being a curved flat knit edge” and “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.” Skechers also fails to articulate a sufficient motivation to combine for either of these, which again is required for all claims.

For Ground 2, the Petition also fails to show that the combination discloses “a flat knit textile element having: (1) flat knit edges free of surrounding textile structure . . .,” and fails to articulate a sufficient motivation to combine, which again is required for all claims.

For these reasons and those discussed below, Nike respectfully requests that the Board decline to institute review.

II. BACKGROUND

A. Overview of the ’511 patent

The ’511 patent has a priority date of March 3, 2004. Ex. 1001, p.2. It is directed to “an upper for an article of footwear, the upper incorporating a textile element formed with a knitting machine” that was new and non-obvious in 2004. *See e.g., id.*, 3:44–46. All 20 claims of the ’511 patent recite textile elements that are flat knit. *Id.*, 12:10–14:16. Claim 1 is representative and it recites: “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, at least one flat knit edge being a curved flat knit edge, and (2) a first knit strip having a first property and a second knit strip having a second property that is different from the first property; 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.” *Id.*, 12:9–22.

B. Relevant File History

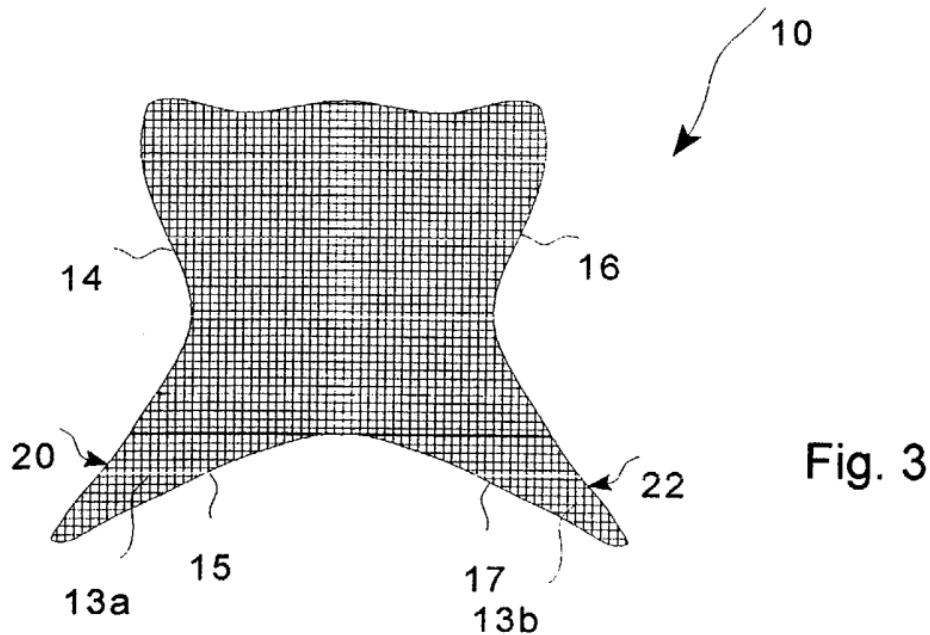
The Patent Office has already considered four of the prior art references Skechers relies on in its Petition. The Examiner considered (1) Spencer, asserted in both Grounds, (2) Clark, asserted in Ground 1, and (3) Herbert and Glidden, both asserted in Ground 2. *See* Ex. 1013, 758, 787, 788, 790 [11/03/2017 IDS, Non-Patent Literature Documents Item No. 2 (Spencer); U.S. Patents Item Nos. 3 (Glidden); 17 (Clark); and 33 (Herbert)].

III. ALLEGED PRIOR ART REFERENCES

A. Cusinato

Cusinato is directed to a process for making a knitted fabric and using it to produce a “stocking.” Ex. 1014, [0013]. Cusinato discloses that its “aim is to obtain a fabric in one piece” in order to make a “stocking,” such that once the fabric “has been folded, it directly forms the stocking.” *Id.* Cusinato discloses a section of

knitted fabric in which a left wave and right wave form a “V” shape. *Id.*, [0014]. The shape is formed by reducing the number of stitches in each row. *Id.*



B. Clark

Clark is directed to a “process of making fabric shoe uppers.” Ex. 1015, 1:1, 5:9. Specifically, Clark discloses a method of distributing strands of thermoplastic yarns throughout a knitted fabric, and then “shrinking these strands in the fabric upon [a] last” using heat treatment. *Id.*, 1:18–25. In this way, the “shape of the last is accurately reproduced and permanently retained.” *Id.* Clark’s knitted fabric is either “knitted as a strip in a flat bed knitting machine and formed into a continuous band by having its ends joined, or it may be knitted as a seamless band in a circular knitting machine.” *Id.*, 2:12–17.

The Examiner considered Clark during prosecution of the '511 patent. Ex. 1013, 788 [11/03/2017 IDS, U.S. Patents Item No. 17 (Clark)].

C. Spencer

Spencer is a 400-page textbook titled *Knitting Technology, A Comprehensive Handbook And Practical Guide*, authored by David J. Spencer and published in 2001. Spencer generally discusses the “fundamental principles of weft and warp knitting,” in “reference” format. Ex. 1050, Preface. Spencer discusses the history of knitting, and general knitting concepts, including for knitting garments such as socks and sweaters, and the associated manufacturing processes for making those garments. *See id.*, 104, 222. Spencer does not discuss footwear (i.e., shoes).

The Examiner considered Spencer during prosecution of the '511 patent. Ex. 1013, 758 [11/03/2017 IDS, Non-Patent Literature Documents Item No. 2 (Spencer)].

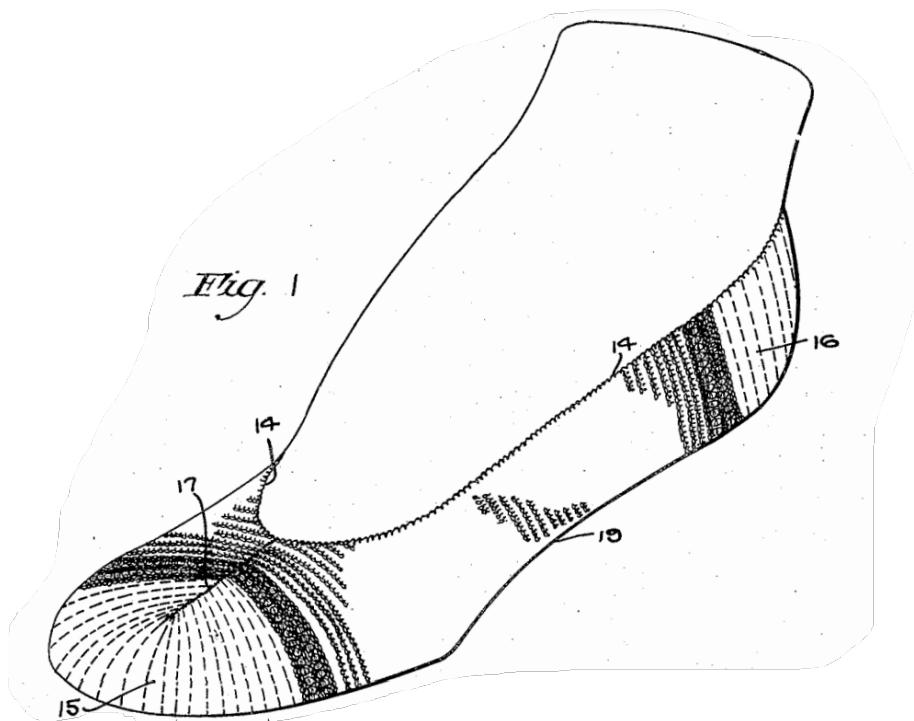
D. Herbert

Herbert is directed to “the slipper type of knitted foot covering adapted to be worn inside a low cut ladies’ shoe or slipper.” Ex. 1016, 1:3–6. Herbert discloses a “slipper type foot covering of such height as to be completely concealed from view when worn within an outer pump or other such low-cut shoe.” *Id.*, 2:2:25–29. The fabric is preferably a seamless tube, though “cut and sewn flat rib knitted fabric”

may also be used. *Id.*, 1:8–9. The purpose of the ribbed fabric is to provide stretch and elasticity. *Id.*, 6–13.

Herbert explains that the “slipper” is produced from the circular knit fabric via “cutting” and “seam[ing]” steps. *Id.*, 2:9–21 (left column). Herbert mentions that it could be possible to produce the “slipper” from “cut and sewn flat rib knitted fabric,” which also requires cutting steps. *Id.*, 1:5–11 (right column).

Herbert’s “slipper foot covering in place on the foot of a wearer” is embodied in Figure 1 below.



The Examiner considered Herbert during prosecution of the '511 patent. Ex. 1013, 790 [11/03/2017 IDS, U.S. Patents Item No. 33 (Herbert)].

E. Glidden

Glidden is directed to “articles of footwear” and is “especially useful in the manufacture of shoes having textile uppers.” Ex. 1017, 1:1–4. The invention “contemplates the construction of an article of footwear in which an upper of extensible and elastic textile material, such, for example, as knitted material, and of such extent as to form the complete upper including the insole, is fabricated without substantial waste to the desired shape to accommodate the foot without uncomfortable wringles.” *Id.*, 2:3–10. The Examiner considered Glidden during prosecution of the ’511 patent. Ex. 1013, 787 [11/03/2017 IDS, U.S. Patents Item No. 3 (Glidden)].

IV. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Nike applies Skechers’ proposed level of skill in the art: a POSITA for the ’511 patent would be 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. Petition, 30; Ex. 1002, ¶78. Such a POSITA would have at least a general understanding of general construction processes and materials used in the manufacturing process of fabric-based articles. *Id.* For individuals with a lower educational level, a person could still be of ordinary

skill in the art provided that person's working experience compensates for any such lower educational level, or vice versa. *Id.* Nike reserves the right to further address Skechers' formulation of a POSITA if trial is instituted.

V. CLAIM CONSTRUCTION

Claims challenged 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 person of ordinary skill. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (citation omitted).

The parties dispute the construction of three claim terms: (i) "article of footwear"; (ii) "a flat knit textile element having: (1) flat knit edges..."; and (iii) "strips." Petition, 31–36. 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 remaining two disputed terms at that time.

A. "article of footwear"

The ordinary and customary meaning of the term "article of footwear," as recited in all claims of the '511 patent, does not include hosiery, stockings, or socks. Ex. 2001 (Pastore Declaration), ¶¶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, 1:40–41, 3:65–66. Hosiery, stockings, and socks do not have sole structures. Every figure of the ’511 patent confirms this ordinary and customary meaning. *See id.*, Figs. 1–14. The figures depict knitted textile elements which are designed to be, or are, incorporated into a shoe.

This meaning is further confirmed by the surrounding language of the claims. Independent Claims 1 and 15 recite an “upper” that is “for an article of footwear,” or an “article footwear comprising” an “upper.” *Id.*, 12:9, 13:1–2. Furthermore, the term “upper” derives its meaning as a component of “footwear” (*e.g.*, *id.*, 3:44–45 (“The present invention is an upper for an article of footwear”), and “upper” would be read out of the claims and rendered nonsensical under Skecher’s proposed construction, because there is no intrinsic support for the concept of an “upper for [a sock].” Ex. 2001, ¶32–34. Thus, articles such as hosiery, stockings, or socks are not “articles of footwear” as that term is used in the ’511 patent.

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

³ Skechers’ only reference to the ’511 patent is the Abstract. Petition, 31. But this reference does not change the ordinary and customary meaning of “article of footwear,” and instead reflects conventional patent claiming, where a patentee is free to describe different embodiments *of an invention*.

that is one of hundreds of references cited during prosecution. Because there is no ambiguity in the meaning of this term as provided by the claims and specification, there is no reason even to consider such evidence. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996).

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 meet the "article of footwear" limitations under either party's construction (which Nike disputes). Petition, 32, citing Ex. 1002, ¶92. In that paragraph Dr. Adanur does not provide **any** reason why a POSITA would supposedly ignore the ordinary meaning of "article of footwear" provided by the '511 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." *Id.* Nowhere does Dr. Adanur provide **any** analysis or opinions to **support** Skechers' construction. Thus, Dr. Adanur did not offer any claim construction opinions for the Board to consider.

Finally, the Board previously considered and adopted the same ordinary and customary meaning of "article of footwear" in *inter partes* review proceedings for a related patent.⁴ Specifically, in IPR2024-00778, which involved U.S. Patent No

⁴ See Ex. 1001, p.2, listing the '749 patent under "Related U.S. Application Data."

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, 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 (Institution Decision), 14. But the Board properly rejected that argument, finding there was no explanation 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 ’511 patent.

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, 9–10; Ex. 1009, 8–10. Skechers, however, seeks to improperly rewrite the limitation so that it “has only flat knit edges.” Petition, 32. While Skechers’ proposal is not supported, Nike believes that its arguments in this preliminary response do not implicate this dispute.

C. “strips”

Construction of this term is not necessary for resolution of this proceeding. Further, Nike is according this term the same meaning in both this proceeding and the district court litigation.

Nike does not contend that any other terms require construction at this time. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). All other terms and phrases in the ’511 patent claims have their ordinary and customary meanings, which are readily apparent, and no further construction is required.

VI. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(d)

The Board should exercise its discretion to deny institution of the two Grounds under 35 U.S.C. §325(d) because Skechers relies on the same or substantially the same art that was considered by the Examiner during prosecution of the ’511 patent, and Skechers failed to show that the Examiner made any error material to the patentability of the Challenged Claims.

The Board applies a two-part framework to analyze discretionary denial under § 325(d): “(1) whether the same or substantially the same art previously was

presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, 2020 WL 740292, at *3–4 (PTAB Feb. 13, 2020) (precedential), citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to §III.C.5, first paragraph).

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, 2020 WL 740292, at *4 n.10, citing *Becton, Dickinson*, IPR2017-01586, Paper 8, 17–18. The Board considers *Becton, Dickinson* factors (a), (b), and (d) during the first step of the *Advanced Bionics* framework, and factors (c), (e), and (f) during the second step of the framework. *Advanced Bionics, LLC*, 2020 WL 740292, at *4.

A. *Advanced Bionics* step 1: The same art, or substantially the same art, was previously before the Office during prosecution

The Board should deny institution of Skechers' Petition because both Grounds involve the "same or substantially the same prior art or arguments previously presented to the Office." *See* 35 U.S.C. § 325(d). *Becton, Dickinson* factor (b) takes into account "the cumulative nature of the asserted art and the prior art evaluated during examination."

Ground 1 combines Cusinato with Clark and Spencer. Ground 2 adds Herbet and Glidden. All of those prior art references were cited and considered by the Patent Office during the original examination, except Cusinato. And Cusinato is merely cumulative of at least Herbet.⁵ Ex. 1013, 758, 787, 788, and 790 [11/03/2017

⁵ Contrary to Skechers' assertion that Herbet and Spencer were not before the Examiner. Petition, 28.

IDS, Non-Patent Literature Documents Item No. 2 (Spencer), U.S. Patents Item Nos. 3 (Glidden); 17 (Clark); and 33 (Herbert)].

More specifically, Cusinato and Herbert disclose a very similar item. Skechers explains that Cusinato “discloses that ‘*the stocking or footwear* 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.’” Ex. 1014, [0001] (emphasis Skechers). Skechers explains that Herbert ““relates to knitted *foot coverings* and more particularly to the *slipper* type.”” Petition, 86 (citing Ex. 1016, 1:4–5) (emphasis Skechers). Thus, Cusinato which Skechers now asserts for both Grounds, is cumulative of what was previously considered by the Examiner during the prosecution of the ’511 patent. Step one of *Advanced Bionics* is met.

B. *Advanced Bionics* step 2: Skechers does not demonstrate that the Office erred

As *Advanced Bionics* step one has been satisfied, the burden shifts to Skechers to show that the Examiner erred in a manner material to the patentability of the Challenged Claims. *Advanced Bionics LLC*, 2020 WL 740292, at *3. “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.

Skechers has failed to make this showing. Indeed, Skechers does not even allege that the Examiner committed any error; the word “error” does not appear anywhere in the Petition. Petition, 28–29. Skechers cannot claim ignorance of this legal framework, as it devoted several pages to an argument of material error in its petition for *inter partes* review of Nike’s U.S. Patent No. 7,401,420, filed on October 30, 2020. *Skechers U.S.A., Inc. v. Nike, Inc.*, IPR2021-00160, Paper 1, 18–22 (PTAB Oct. 30, 2020). The Board has found that petitioner’s failure to allege material error is sufficient basis to determine that the petitioner 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 (Jan. 21, 2021) (Petitioner’s own analysis of prior art without reference to Examiner’s analysis insufficient to show material error); *Sony Interactive Entm’t LLC v. Terminal Reality, Inc.*, IPR2020-00711, 2020 WL 6065188, at *5 (PTAB Oct. 13, 2020) (Petitioner’s argument that asserted references were not substantively evaluated or applied in a rejection failed to sufficiently identify Examiner error); *NXP USA, Inc. v. Impinj, Inc.*, IPR2020-00519, 2020 WL 4805424, at *5 (PTAB Aug. 17, 2020) (no discussion of material error); *GlaxoSmithKline Consumer Healthcare Holdings (US) LLC v. Cipla Ltd.*,

IPR2020-00369, 2020 WL 4390663, at *5 (PTAB Jul. 31, 2020). In *Sony Interactive*, the Board noted that “Sony [Petitioner] was provided the opportunity to provide explanation [of material error], but Sony was silent in this regard Accordingly, *Becton, Dickinson* Factor (e) favors exercising our discretion to deny institution.” *Sony*, 2020 WL 6065188, at *5; *see also Universal Imaging Indus., LLC v. Lexmark Int’l, Inc.*, IPR2019-01387, 2020 WL 959375, at *5 (PTAB Feb. 27, 2020) (“Although Petitioner is correct that the Examiner did not reject any claims of the ’921 patent based on [the asserted reference], ***that is not the end of our analysis.***”) (emphasis added).

Even if Skechers’ allusions to the prosecution record could be construed as an argument that the Examiner erred, those assertions are superficial at best. Skechers hypothesizes that the Examiner might have overlooked the full scope of the teachings of its asserted art, nothing more. Petition, 28–29. Skechers’ theory amounts to a disagreement with the Examiner over the state of the art, which is insufficient to show material error. *See Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021-00412, Paper 9, 36–39 (PTAB Jul. 21, 2021).

Second, as all references here are the same or substantially the same as the references that were before the Examiner, as detailed above (*see §VI.A, supra*), Skechers cannot meet its burden of demonstrating material error on the basis that the

Examiner did not apply the asserted combinations of references in a rejection during the '511 patent's prosecution. Express application simply is not required. *See ABS Global, Inc. v. Cytonome/ST, LLC*, IPR2021-00306, Paper 13, 13–14 (PTAB Jun. 7, 2021).

The salient facts here are akin to those at issue in *Nespresso USA, Inc. v. K-Fee System GmbH*, IPR2021-01222, 2022 WL 212376 (PTAB Jan. 18, 2022). There, “four of the six asserted references were considered by the examiner, and an additional one of the references [was] cumulative of a reference considered by the examiner.” *Id.* at *10. The petitioner argued that the examiner erred “by allowing the challenged claims to issue ‘without comment and without considering the art in this petition.’” *Id.* The Board rejected this assertion as insufficient to meet petitioner’s “burden of showing that the Office erred, for example, by ‘misapprehending or overlooking specific teachings of the relevant prior art whose teachings impact patentability of the challenged claims.’” *Id.* at *11. Further, the Board found petitioner’s bare observation that “‘the obviousness analysis’ in the Petition ‘is supported by expert testimony, which the Examiner did not have’” to be “ineffective” in showing material error. *Id.*; *see also Nespresso USA, Inc. v. K-Fee Sys. GmbH*, IPR2021-01221, Paper 11, 21–24 (PTAB May 6, 2022) (denying petitioner’s request for reconsideration).

Similarly, here, the asserted references were before the Examiner or cumulative of references that were before the Examiner, and Skechers fails to “point out sufficiently how the examiner erred in [his] evaluation of the asserted prior art.” *Nespresso*, 2022 WL 212376, at *11. Having largely ignored the prosecution history of the ’511 Patent, and having failed to direct the Board to any specific (non-speculative) examiner error, Skechers fails to meet its burden under *Advanced Bionics* step two.

Because Skechers (1) relies on the same or substantially the same art considered by the Examiner during the prosecution of the ’511 patent, and (2) fails to show that the Examiner materially erred, institution of the instant proceeding should be denied under § 325(d).

VII. 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 ’511 patent is being litigated concurrently in district court in the Central District of California. *See generally Nike, Inc. v. Skechers U.S.A., Inc.*, 2:23-cv-09346-AB-PVC (C.D. Cal.).

That this Board and the district court are being asked to simultaneously adjudicate the validity of the '511 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 9,730,484 and 8,266,749 patents, because those petitions are "similar" to petitions filed by lululemon. Ex. 2002 (Email from L. Oxenford to M. Wilk, Nov. 13, 2024). 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. *Fintiv*, 2020 WL 2126495, at *2. 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 support the Board's exercise of authority to deny institution in view of an earlier trial date in 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.*

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 Amperex Tech. Ltd.*, IPR2023-00587, Paper 12 at 15, 27 (PTAB 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 (PTAB Jun. 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 (*Fintiv* 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 (*Fintiv* 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.*, 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 defense, which most certainly will involve IPR-ineligible 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 (PTAB Mar. 7, 2024). Thus, factor two weighs against institution.

3. The Parties have invested in the parallel proceeding (*Fintiv* 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 support of the district court proceedings since at least November 6, 2023, when Nike filed its complaint against Skechers for patent infringement. *Nike, Inc.*, No. 2:23-cv-09346 (C.D. Cal.), Dkt. 1. The parties have spent months briefing the district court on the claim construction issues in the parallel proceeding. 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; Ex. 1033; *see also Nike, Inc.*, 2:23-cv-09346 (C.D. Cal.), Dkts. 83 and 84 (supplemental claim construction briefing).

Additionally, the parties have exchanged thousands of pages of discovery, including information about their merits positions concerning the '511 patent. Skechers served preliminary and supplemental invalidity contentions in April and May, 2024, respectively, in the parallel proceeding, including detailed claim charts that address the nearly the same exact 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. Thus, “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 (PTAB May 15, 2020). The parties’ significant investment in the parallel proceeding, since at least November 2023, favors denying institution.

**4. The validity of the '511 patent is central to both proceedings
(*Fintiv* Factor Four)**

The validity of the '511 patent is central to both this dispute and the parallel litigation. In the district court case, Nike asserts that Skechers infringes the '511 patent. *Nike, Inc.*, No. 2:23-cv-09346 (C.D. Cal.), Dkt. 1. In turn, Skechers alleges that the claims of the '511 patent are invalid. *Id.*, Dkt. 34. 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 (PTAB 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 (*Fintiv* Factor Five)

Skechers and Nike are the same parties in both the instant 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 (*Fintiv* Factor Six)

There are no additional factors that warrant institution. To the contrary, the other relevant circumstances here—including the Examiner’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 the instant petition challenging the validity of the ’511 patent at a time when it knew that “Nike [would] be doing ‘triple duty’ by simultaneously pursuing litigations against Skechers, New Balance, and lululemon.” Ex. 2002; *Fintiv*, IPR2020-00019, 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 a petition for IPR of the ’511 patent in May 2024, after it served its supplemental invalidity contentions that included many of the invalidity bases that it now raises in the instant petition. Yet, Skechers waited an additional six months to file it at a time when it was aware that Nike’s resources would be stretched thin. The Board should not encourage or endorse these tactics. Institution under these circumstances would waste judicial resources and reward gamesmanship.

The *Fintiv* factors weigh in favor of denial. Therefore, the Board should exercise its discretion to deny institution under *Fintiv*.

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

Skechers bears the burden on institution of “demonstrating a reasonable likelihood that it will prevail in showing the unpatentability of at least one claim.” *SMIC, Ams. v. Innovative Foundry Techs., LLC*, IPR2020-00837, Paper 13, 13–14 (PTAB Oct. 9, 2020) (citing 35 U.S.C. §§ 314(a) and 312(a)(3)). In making this

showing, Skechers' Petition must identify "the evidence that supports the grounds for the challenge to each claim." *Id.* Skechers has not met that burden here.

In both grounds, Skechers alleges unpatentability under 35 U.S.C. § 103(a), i.e., that the differences between the claims of the '511 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 the POSITA. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). To prevail, Skechers must "place themselves in the minds of those of ordinary skill in the relevant art ***at the time the invention was made***, to determine whether that which is now plainly at hand would have been obvious at such earlier time." *Millennium Pharms., Inc. v. Sandoz Inc.*, 862 F.3d 1356, 1367 (Fed. Cir. 2017) (emphasis added). 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 nonobviousness where petitioner's challenge was "based on attorney argument rather than evidence in the record"). Skechers also must prove that a POSITA would have been motivated to modify or combine teachings from different references. *KSR*, 550 U.S. at 418; *see also In re Stepan Co.*, 868 F.3d 1342, 1345–46 (Fed. Cir. 2017). "[I]t is important to identify a reason that would have prompted a person of ordinary skill in the relevant

field to combine the elements in the way the claimed new invention does.” *Id.* In addition to motivation to combine, Skechers must show a reasonable expectation of success in making a prior art combination. *See 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 any ground of unpatentability. The Board should thus deny institution.

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

The Petition fails to show that multiple limitations required in both independent Claims 1 and 15 are disclosed by the Ground 1 combination and fails to articulate a *prima facie* motivation to combine.

1. Cusinato does not disclose “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, at least one flat knit edge being a curved flat knit edge” (Claim 1[pre] & [a1]) and “An article of footwear comprising: an 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, at least one flat knit edge being a curved flat knit edge” (Claim 15[pre] & [a1])

Cusinato does not disclose an “upper for an article of footwear” or an “article of footwear comprising: an upper,” as recited in the preamble of independent Claims 1 and 15, respectively, and which are required in all Challenged Claims including 1[a1] and 15[a1]. The preamble of claims 1 and 15 is limiting because it provides antecedent basis for the limitation “upper” appearing later in the body of those claims. *See 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 the antecedent basis for a term appearing in the body of a claim.”). Notably, Skechers does not argue that the preambles are not limiting and instead alleges that they are met by the asserted references. Petition, 51.

Skechers alleges that Cusinato’s stocking is an upper for an article of footwear. *Id.* (citing Ex. 1002, ¶¶157–161). However, Cusinato does not disclose an “upper for an article of footwear.” Ex. 2001, ¶¶57, 59–61. Instead, Cusinato explains that its “stocking or footwear 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.*, ¶60. A POSITA reading Claims 1 and 15 in light of the ’511 patent specification in 2004 would not have understood Cusinato’s “stocking” to be “an upper for an article of footwear” because a POSITA would understand an article of footwear

requires an upper and a sole structure and Cusinato discloses a single textile element without a distinct upper and sole structure. *See supra* §V.A; Ex. 2001, ¶¶29–38. Skechers seemingly acknowledges these deficiencies, as it alternatively argues that a POSITA would have combined Cusinato with the “shoe” from Clark, in order to “add a sole.” Petition, 51. The insufficiency of that argument is discussed below.

Because Cusinato fails to disclose “upper for an article of footwear” or an “article of footwear comprising: an upper,” the preamble of independent Claims 1 and 15, Cusinato also fails to disclose “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, at least one flat knit edge being a curved flat knit edge” and “An article of footwear comprising: an 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, at least one flat knit edge being a curved flat knit edge” for Claims 1[pre] & [a1] and 15[pre] & [a1], respectively. Therefore, Ground 1 fails for all Challenged Claims.

2. A sufficient motivation is not articulated for combining Cusinato with Clark and Spencer to reach Claims 1[a1] and 15[a1]

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 Clark with Cusinato to reach Claims 1[pre] and 15[pre], and, therefore, reach Claims 1[a1] and 15[a1]. *See* Petition, 51–55. Skechers simply claims, without any explanation, that a “‘shoe bottom’ or sole is disclosed in Clark, and a POSITA would consider it obvious to add a sole to Cusinato’s ‘*boot-like*’ form” *Id.*, 51 (emphasis Skechers).

The Petition is silent with respect to any alleged motivation—Skechers does not argue any and only cites to the declaration of Dr. Adanur. Petition, 51 (citing Ex. 1002, ¶¶157–161). But Dr. Adanur’s declaration provides only a single motivation that has no connection to the asserted combinations or the cited references and is also insufficient as a matter of law. Specifically, Dr. Adanur’s only opinion is that it allegedly “would be obvious to add a sole to Cusinato’s ‘boot-like’ form to provide cushioning and protection.” Ex. 1002, ¶160 (citing Ex. 1015, 3:10). That is the sum total of Dr. Adanur’s opinion, and for evidentiary support, he only cites *one* line of Clark which simply discloses a “shoe bottom” and cites no evidentiary support for his assertion that combining them would “provide cushioning and protection.” Ex. 1002, ¶160.

Dr. Adanur's opinion is limited to quoting a "shoe bottom" disclosed in Clark that Skechers asserts could be combined with Cusinato. But Dr. Adanur does not explain even a single reason *why* a POSITA would supposedly modify a "stocking" to transform it into a shoe with a sole. And to be sure, stockings, slippers, and socks in general, have their own purposes that are distinct from the purposes of shoes. Ex. 2001, ¶65. Dr. Adanur does not cite or quote *anything* from Cusinato to support his opinion, let alone articulate any reason why something in Cusinato would supposedly lead a POSITA to a "shoe" teaching. And in any case, stockings, slippers, and socks cannot simply be transformed into shoes by "add[ing] a sole," as Dr. Adanur implies with no evidentiary support whatsoever. Ex. 1002, ¶160; Ex. 2001, ¶¶58, 62–67. In other words, Skechers and Dr. Adanur failed even to address a reasonable expectation of success in making the proposed combinations.

It is well-settled that obviousness grounds require "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at 418. Moreover, unsupported and 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 (PTAB Dec. 7, 2020).

Here, Dr. Adanur did not even pay lip service to these obviousness requirements, as he did not articulate any reason why a POSITA allegedly would

have taken the non-shoe garment disclosed in Cusinato, and combined or modified it with the “shoe bottom” of Clark in order to transform the garment into a shoe. Dr. Adanur does not provide any objective evidence or explain how or why a “stocking” could be joined with a shoe bottom in the first place. Instead, Dr. Adanur’s opinion seems to be that because shoes also existed at the time, a POSITA automatically would have added a “shoe bottom” to Cusinato’s “stocking.” That cannot supply a motivation to combine. *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).

Dr. Adanur’s single, conclusory opinion is insufficient to demonstrate a motivation to combine. *William Wesley Carnes, Sr., Inc. v. Seaboard Int’l Inc.*, IPR2019-00133, Paper 10, 17–18 (PTAB May 8, 2019) (denying institution, in part because a “conclusory statement . . . does not constitute an articulated reasoning with rationale underpinning sufficient to support a motivation to modify the prior art teachings” under *KSR*). Further, even to the extent that Dr. Adanur’s opinion were credited as explaining that a POSITA **could** have combined the references (which it does not), that would still be “insufficient for obviousness” as a matter of law, as the petition must articulate “why a POSITA **would** modify the teachings of the

references to arrive at the claimed invention.” *Id.*, 18 (emphasis added), citing *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017); *see also In re Nuvasive Inc.*, 842 F.3d 1376, 1384–85 (Fed. Cir. 2016) (reversing obviousness, because while the Board concluded a POSITA could have combined references, 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).

Further, the Petition also does not articulate even a *prima facie* rationale to support why a POSITA allegedly would have been motivated to combine Clark and Spencer with Cusinato to reach Claims 1[a1] and 15[a1]. *See* Petition, 55. Neither the petition nor Dr. Adanur alleges **any** obviousness rationale for a motivation to combine Spencer, which is not directed to manufacturing an article of footwear, or to incorporating knitted textiles into footwear, with Cusinato, a sock, and Clark, an upper for a shoe. Skechers simply claims that “it would have been obvious to a POSITA to use flat knitting, as expressly taught in Clark and Spencer, and a POSITA would reasonably have expected to do so successfully” and cites Dr. Adanur’s declaration. Petition, 55 (citing 1002, ¶¶176–177). But Dr. Adanur’s declaration is also silent, as he only offers the conclusory statement that “it would have been obvious to use flat knitting, which is expressly taught in both Clark and Spencer, and

a POSITA would have had a reasonable expectation of success in doing so.” Ex. 1002, ¶¶176. Dr. Adanur’s conclusory opinion is insufficient as a matter of law and also must not be credited. *William Wesley*, IPR2019-00133, Paper 10 at 17–18 (denying institution, in part 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”).

Ground 1 fails for all Challenged Claims for the independent reason that the Petition fails to articulate a sufficient motivation to combine Clark with Cusinato to reach the preamble of independent Claims 1 and 15, and a sufficient motivation to combine Clark and Spencer with Cusinato to reach Claims 1[a1] and 15[a1].

3. Cusinato does not disclose “An upper for an article of footwear, the upper comprising:” and therefore does not disclose “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” (Claim 1[b] and Claim 15[b])

For the same reasons discussed above, Cusinato fails to disclose the preamble of independent Claims 1 and 15. *See supra*, §VIII.A.1.; Ex. 2001, ¶¶57, 59–61. Because Cusinato fails to disclose the preamble of independent Claims 1 and 15, Cusinato also fails to disclose 1[b] and 15[b]. For this reason, Ground 1 fails for all Challenged Claims.

4. A sufficient motivation is not articulated for combining Cusinato with Clark to reach Claims 1[b] and 15[b]

Skechers' alternative argument to combine Cusinato with Clark also fails for the same reasons discussed above. *See supra*, §VIII.A.2; Ex. 2001, ¶¶58, 62–67. Accordingly, Ground 1 fails for all Challenged Claims for the independent reason that the Petition fails to articulate a sufficient motivation to combine for this limitation.

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

The Petition fails to show that multiple limitations required in both independent Claims 1 and 15 are disclosed by the Ground 2 combination and fails to articulate 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 15[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

(Petition, 95), which fails for the same reasons discussed above. *See supra*, §VIII.A.1; Ex. 2001, ¶¶57, 59–61.

Second, Skechers alleges that Herbert’s “slipper” is “an upper for an article of footwear,” again under Skechers’ incorrect construction. Petition, 94. This allegation fails for largely the same reasons as with Cusinato. A POSITA reading Claims 1 and 15 in light of the ’511 Patent specification in 2004 would not have understood a “slipper” to constitute an “article of footwear.” *See supra* §V.A; 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, ¶¶68, 70–73. Moreover, (and as discussed above, *see supra*, at fn.2), Skechers’ misleading one-word quote from Herbert cannot be credited as disclosing this limitation. Petition, 94 (quoting “sole”). Herbert plainly 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 column). Herbert makes this clear as it also describes its “slipper” as being “adapted to be worn *inside a low cut ladies’ shoe*.” *Id.*, at 1:4–7 (left column) (emphasis added); Ex. 2001, ¶71. Thus, Herbert’s slipper does not, and could not, have the sole structure of a shoe.

Finally, as with Ground 1, Skechers seemingly acknowledges these deficiencies, as it alternatively argues that a POSITA would have combined Herbert or Cusinato with a different “shoe” reference—Glidden—“to add a more rugged sole to the ‘slipper’ in Herbert or the ‘bootlike’ form in Cusinato.” Petition, 94. The insufficiency of that argument is discussed below.

Because both Herbert and Cusinato fail to disclose the preamble of independent Claims 1 and 15, Ground 2 fails for all Challenged Claims.

2. A sufficient motivation is not articulated for combining Glidden with Herbert or Cusinato to reach Claims 1[pre] and 15[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” of Glidden, to meet the preambles of Claims 1 and 15.

Like in Ground 1, the Petition is silent with respect to any alleged motivation—Skechers does not argue any and only cites to the declaration of Dr. Adanur. Petition, 95 (citing Ex. 1002, ¶¶268–269). And Dr. Adanur’s declaration provides only a single motivation that has no connection to the asserted combinations and is also insufficient as a matter of law. Specifically, Dr. Adanur’s only opinion is that it allegedly “would be obvious to add a sole to Herbert’s ‘slipper’

or Cusinato’s ‘boot-like’ form to provide cushioning and protection.” Ex. 1002, ¶269 (citing Ex. 1015, 3:10). That is the sum total of Dr. Adanur’s opinion, and for evidentiary support, he only cites *one* paragraph of Glidden which simply states that the invention “relates to articles of footwear and to methods of making the same, and is especially useful in the manufacture of shoes having textile uppers.” Ex. 1017, 1:1–4; *see* Ex. 2001, ¶¶69, 74–79. Further, Dr. Adanur cites no evidentiary support for his assertion that combining the references would “provide cushioning and protection.” *See* Ex. 1002, ¶269. Dr. Adanur’s conclusory opinion is insufficient as a matter of law and also must not be credited. *William Wesley*, IPR2019-00133, Paper 10 at 17–18 (denying institution, in part 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”).

Accordingly, Ground 2 fails for all challenged claims for the independent reason that the Petition fails to articulate any alleged motivation to combine.

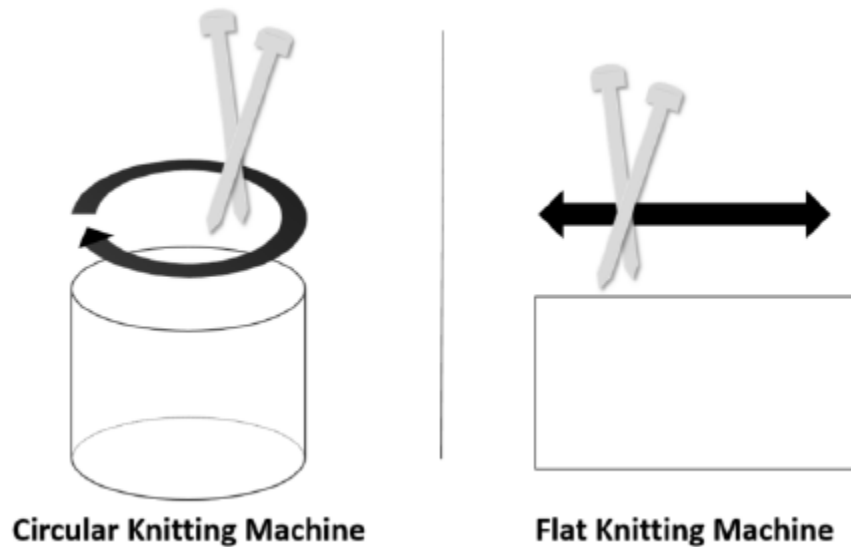
3. Herbert does not disclose “flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed” (Claims 1[a1] and 15[a1])

Skechers relies on “Herbert in view of Cusinato” for this limitation.⁶ Petition, 95–96. 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 “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” under either party’s construction. *See supra* §V.B; Ex. 2001, ¶¶80–85. That is because, regardless how many edges must be “free of surrounding textile structure” (the only aspect of the construction that is disputed), Herbert does not disclose a “*flat knit* textile” element with any “*flat knit edges*” in the first place. 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 column), 1:10–15 (right column) (emphasis added). 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

⁶ 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 knit “selvedge[d] edges.” Petition, 96.

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, ¶82. 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.” Petition, 95, citing Ex. 1016, 1:8–9 (right column) (emphasis added). 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 represents Herbert’s total disclosure regarding “flat” knitting. Accordingly, a POSITA would not understand Herbert to disclose this limitation. Ex. 2001, ¶¶80–85.

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. While the parties dispute how many of the edges must be “flat knit,” there is no dispute that a flat knit edge is “*not formed by cutting* from a flat knit textile element or by otherwise removing the textile element from a larger textile material.” Petition, 32 (quoting Skechers’ construction, emphasis 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 column) (emphasis added). 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, ¶82.

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). Petition, 95–96, citing Ex. 1002, ¶272.

Because Herbert fails to disclose 1[a1] of independent Claims 1 and 15, Ground 2 fails for all Challenged Claims.

4. A sufficient motivation is not articulated for combining Herbert with Cusinato to reach Claims 1[a1] and 15[a1]

Skechers' alternative argument—"Herbert in view of Cusinato"—also fails, because a POSITA would not have been motivated to combine the references. Petition, 95–96. 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.

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." Petition, 90. But this alleged motivation betrays a fundamental misreading of 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 column), 2:9–21 (left column). And Herbert's single mention of flat knitting is "*cut* an sewn flat rib knitting fabric," which also requires *cutting*. *Id.*, 1:5–10 (right column). Ex. 2001, ¶¶86–93. 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 column). Herbert directs a POSITA to circular knitting for those benefits—not flat knitting. Ex. 2001, ¶91. 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. Petition, 90, citing Ex. 1002, ¶147. 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.⁷

“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

⁷ The Petition states 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.” Petition, 91, citing 1002, ¶149. No details are provided nor any explanation how the circular knit teachings of Herbert could be combined with the flat knit teachings of Cusinato.

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*, IPR2019-00133, Paper 10, 18 (emphasis added); *see also Nuvasive*, 842 F.3d at 1384–85 (reversing the Board’s obviousness finding, because petitioner’s “arguments amount to nothing more than conclusory statements that a PHOSITA would have been motivated to combine the prior art references”).

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.

IX. CONCLUSION

For the reasons set forth above, Nike respectfully requests that the Board deny institution of the Petition for all Challenged Claims of the ‘511 patent.

Dated: March 21, 2025

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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 10,963 words, which is less than the 14,000 words allowed under 37 C.F.R. § 42.24(b)(1).

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CERTIFICATE OF SERVICE

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

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