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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

NIKE, INC., Plaintiff, vs. SKECHERS U.S.A., INC., Defendant.	Case No. 2:23-cv-09346-AB-PVC **SKECHERS U.S.A., INC.'S SUPPLEMENTAL PRELIMINARY INVALIDITY CONTENTIONS**

Skechers U.S.A. v. Nike, Inc.
IPR2025-00150
Patent No. 9,060,562
Ex. 2003

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I. INTRODUCTION

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

- U.S. Patent No. 8,266,749 (the "'749 Patent") — Claims 1-8, 11-18, 21 (the "'749 Asserted Claims")
- U.S. Patent No. 9,060,562 (the "'562 Patent") — Claims 1-23 (the "'562 Asserted Claims")
- U.S. Patent No. 9,510,636 (the "'636 Patent") — Claims 1-27 (the "'636 Asserted Claims")
- U.S. Patent No. 9,730,484 (the "'484 Patent") — Claims 1, 5-9, 11-17 (the "'484 Asserted Claims")
- U.S. Patent No. 9,918,511 (the "'511 Patent") — Claims 1-20 (the "'511 Asserted Claims")
- U.S. Patent No. 9,986,781 (the "'781 Patent") — Claims 1-20 (the "'781 Asserted Claims")

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

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

use the acronym "POSITA" to refer to a person having ordinary skill in the art to which the claimed inventions pertain.

II. PRIORITY DATE OF THE ASSERTED PATENTS AND CLAIMS

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

- The '749 Patent claims entitlement to a priority date of March 3, 2004.
- The '562 Patent claims entitlement to a priority date of February 20, 2012.
- The '636 Patent claims entitlement to a priority date of February 20, 2012.
- The '484 Patent claims entitlement to a priority date of November 10, 2006.
- The '511 Patent claims entitlement to a priority date of March 3, 2004.
- The '781 Patent claims entitlement to a priority date of March 3, 2004.

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

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

III. '749 PATENT

A. Prior Art References[2]

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

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

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

1. Prior Art Patents and Publications[3]

Prior Art	Date of Issue or Publication
US 1,538,263	2/2004
US 1,597,934	8/1926
US 1,803,554	5/1931
US 1,888,172	11/1932
US 1,902,780	3/1933
US 1,965,969	7/1934
US 2,161,472	6/1939
US 2,467,237	4/1949
US 2,675,631	4/1954

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

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

Prior Art	Date of Issue or Publication
US 4,211,806	7/1980
US 4,255,949	3/1981
US 4,276,671	7/1981
US 4,317,292	3/1982
US 4,373,361	2/1983
US 4,430,811	2/1984
US 4,447,967	5/1984
US 4,494,266	1/1985
US 4,527,403	7/1985
US 4,531,525	7/1985
US 4,607,439	8/1986
US 4,663,946	5/1987
US 4,722,202	2/1988
US 4,785,558	11/1988
US 4,813,158	3/1989
US 4,852,272	8/1989
US 5,095,720	3/1992
US 5,099,588	3/1992
US 5,125,116	6/1992
US 5,253,434	10/1993
US 5,323,627	6/1994
US 5,345,638	9/1994
US 5,353,524	10/1994
US 5,385,036	1/1995
US 5,461.884	10/1995
US 5,511,323	4/1996
US 5,526,584	6/1996
US 5,566,396	10/1996

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

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

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

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

Prior Art	Date of Issue or Publication
University Press)	
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
Stoll Sirix 100 / 200 Manual Part 1 and Part 2	No later than 3/3/2003

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

2. Prior Art Products

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

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

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

Prior Art Product	Date of Public Use
Steve Blevins, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Robert Szanto for Simply Knitting Mills, Inc., publicly known, used, and/or on sale within United States	No later than 3/3/2003
"Hard Rope" Shoe by Simone Memel	No later than 1995

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

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

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

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

or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications and their general scientific knowledge. Skechers may rely upon uncited portions of the prior art references and on other publications and expert testimony to provide context, and as aids to understanding and interpreting the portions that are cited. Skechers may also rely on the prior art of record for any permissible purpose, including prior art discussed in the '749 Patent specification itself, including to show that the '749 Patent is anticipated or obvious, show the state of the art, show motivation to combine a reference with one or more other references, and to show the proper scope of the claims. Skechers may also rely on uncited portions of the prior art references, other disclosed publications, and the testimony of experts to establish that a POSITA would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

1. Anticipation

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

2. Obviousness

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

35 U.S.C. § 103.

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

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

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

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

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

Each of these combinations was obvious to try for a POSITA. In the field of the '749 Patent, there was a design need or market pressure to solve a problem and

there were a finite number of identified, predictable solutions. A POSITA had good reason to pursue the known options within his or her technical grasp including combinations of the disclosures in the accompanying claim charts. Each of these combinations is also the combination of familiar elements according to known methods and yields predictable results. In the field of the '749 Patent, a great deal of prior research and product designs were available and design incentives and other market forces would prompt variations of it. Further reasons to combine the references identified in the accompanying claim charts include the nature of the problem being solved, the express, implied, and inherent teachings of the prior art, and the knowledge of a POSITA that such combinations would have yielded predictable results, and that such combinations would have represented known alternatives to a POSITA. For each combination, there is a teaching, suggestion, and motivation to combine both in the references to be combined themselves, as well as in the art generally that was known to a POSITA. In any event, each limitation of the '749 Patent is, and would have been at the time of the alleged invention, a simple design choice representing a predictable variation within the skill of a POSITA. Moreover, each limitation of the '749 Patent was well known in the art, including well-known to POSITAs.

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

No showing of a specific motivation to combine prior art is required to combine the references disclosed for any asserted patent in this document and in the attached charts, as each combination of art would have yielded expected results and at most would simply represent a known alternative to one of skill in the art. *See*

B/E Aerospace, Inc. v. C&D Zodiac, Inc., 962 F.3d 1373, 1379 (Fed. Cir. 2020) ("[W]e affirm the Board's conclusion that the challenged claims would have been obvious because modifying the Admitted Prior Art/Betts combination to include a second recess was nothing more than the predictable application of known technology."); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1344 (Fed. Cir. 2017); *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415 (2007) (rejecting the "rigid" application of the teaching, suggestion, or motivation to combine test, and instead applying an "expansive and flexible" approach). Indeed, the Supreme Court held that a POSITA is "a person of ordinary creativity, not an automaton" and "in many cases a POSITA will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR*, 550 U.S. at 420-21. Nevertheless, in addition to the information contained in the obviousness sections of this document and elsewhere in these contentions, Skechers hereby identify motivations and reasons to combine.

One or more combinations of the prior art references identified above would have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) ("It is simply a matter of common sense that the sleeve used in Down, in a towing attachment quite similar to a hitch receiver/tow bar arrangement, could be combined with a barbell-shaped hitch pin lock in order to address the known problem of different aperture sizes in standard hitch receivers and the shelf-space problem experienced by retailers."); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008) ("The asserted claims simply substitute a resistive electrical switch for the mechanical pressure switch employed by the Gopher Zapper," which "is a textbook case of when the asserted claims involve a combination of familiar

elements according to known methods that does no more than yield predictable results." (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed. Cir. 2004) (affirming the district court's finding of "a motivation to combine because the two references address precisely the same problem of underpinning existing structural foundations" even though the record "does not feature an express written teaching in the art to make this combination"); *see also Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869 F.3d at 1344.

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

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

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

predictable solutions that had a reasonable expectation of success; and (9) known work in various technological fields that could be applied to the same or different technological fields based on design incentives or other market forces. *See* above for legal background regarding obviousness combinations and M.P.E.P. § 2143.

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

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

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

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

D. Invalidity Under 35 U.S.C. § 112

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

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

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

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

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

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

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

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

The grounds identified below both individually and collectively render the

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

a. Lack of Enablement And Written Description

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

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

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

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

b. Indefiniteness

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

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

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

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

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

IV. '562 PATENT

A. Prior Art References[5]

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

1. Prior Art Patents and Publications[6]

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

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

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

Prior Art	Date of Issue or Publication
US 50,369	10/1865
US 601,192	3/1898
US 1,215,198	2/1917
US 1,597,934	8/1926
US 1,839,274	1/1932
US 1,888,172	11/1932
US 1,902,780	3/1933
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US 2,001,293	5/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,314,098	3/1943
US 2,330,199	9/1943
US 2,343,390	3/1944
US 2,400,692	5/1946
US 2,440,393	4/1948
US 2,569,764	10/1951
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US 3,694,940	10/1972
US 3,704,474	12/1972
US 3,766,566	10/1973
US 3,778,856	12/1973
US 3,583,081	6/1974
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Prior Art	Date of Issue or Publication
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US 6,981,393	1/2006
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US 7,051,460	5/2006
US 7,056,402	6/2006
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Dorin Ionesi, et al., Three-Dimensional Knitted Fabric with Technical Destination, Bulletinul Institutului Politehnic Din Iaşi	2010
Technology/Machinery, Santoni Seamless Innovations for Sports and Active Markets, www.innovationintextiles.com/technology-machinery-equipment/santoni-seamless-innovations-for-sports-and-active-markets	2/2011
Knitting industry, Flat Knitting: Adidas Unveils Adizero Primknit Running Shoe, www.knittingindustry.com/flat-knitting/adidas-unveils-adizero-primeknit-running-shoe	7/2012
Knitting Project – "Converse" Baby Booties!!!, amandaleaps.blogspot.com/2012/01/knitting-project-converse-baby-booties.html	1/2012
Fibres/Yarns/Fabrics, Nike Flyknit – A Seamlessly Knitted Running Shoe!, www.innovationintextiles.com/nike-flyknit-a-seamlessly-knitted-running-shoe	2/2012
Mohammad Imrul Khorshed, Studies on the Quality Control Procedure of Cutting Department in Footwear Industry (BS Dissertation), The University of Dhaka	2007
Brandon Richard, Bargain Buys: 20 Sneaker Steals Found in Vintage Eastbay Catalogs, www.complex/com/sneakers/a/brandon-richard/vintage-eastbay-sneaker-prices	9/2015
Caroline Cox, Vintage Shoes (Carlton Books)	2008

Prior Art	Date of Issue or Publication
1989 Reebok AXT SXT CXT Cross-Training Shoes Vintage Print Ad, www.ebay.com/itm/362604032836	1989
Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
J. H. Thornton, Textbook of Footwear Manufacture	2009

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

2. Prior Art Products

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

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

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

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

Prior Art Product	Date of Public Use
used, and/or on sale within the United States	2001
Nike Summer Runner, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas 2000 Sydney Olympics Collection, publicly known, used, and/or on sale within the United States	No later than 2001
Nike Presto Chanjo shoe, publicly known, used, and/or on sale within the United States	No later than 2001
"Hard Rope" Shoe by Simone Memel	No later than 1995

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

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

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

Although Skechers has identified at least one citation per limitation for each reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. Rather, in an effort to focus the issues, Skechers has generally cited representative portions of identified references, even where a

reference may contain additional support for a particular claim element. In addition, POSITAs generally read a prior art reference as a whole and in the context of other publications and literature. Thus, to understand and interpret any specific statement or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications and their general scientific knowledge. Skechers may rely upon uncited portions of the prior art references and on other publications and expert testimony to provide context, and as aids to understanding and interpreting the portions that are cited. Skechers may also rely on the prior art of record for any permissible purpose, including prior art discussed in the '562 Patent specification itself, including to show that the '562 Patent is anticipated or obvious, show the state of the art, show motivation to combine a reference with one or more other references, and to show the proper scope of the claims. Skechers may also rely on uncited portions of the prior art references, other disclosed publications, and the testimony of experts to establish that a POSITA would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

1. Anticipation

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

2. Obviousness

To the extent any limitation is deemed not to be exactly met by an item of prior art, any purported differences are such that the claimed subject matter as a

whole would have been obvious to a POSITA at the time of the alleged invention, based on the state of the art and knowledge of those skilled in the art. The item of prior art would, therefore, render the relevant claims invalid for obviousness under 35 U.S.C. § 103.

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

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

Motivations to combine the above items of prior art are present in the references themselves, general knowledge of a POSITA, the prior art as a whole, or the nature of the problems allegedly addressed by the '562 Patent. Combining the references identified in the accompanying claim charts would have been obvious, as the references identify and address the same technical issues and suggest very

similar solutions to those issues. Skechers reserves the right to amend or supplement these invalidity contentions to identify additional reasons that combining the references would be obvious to a POSITA.

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

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

Each of these combinations was obvious to try for a POSITA. In the field of

the ’562 Patent, there was a design need or market pressure to solve a problem and there were a finite number of identified, predictable solutions. A POSITA had good reason to pursue the known options within his or her technical grasp including combinations of the disclosures in the accompanying claim charts. Each of these combinations is also the combination of familiar elements according to known methods and yields predictable results. In the field of the ’562 Patent, a great deal of prior research and product designs were available and design incentives and other market forces would prompt variations of it. Further reasons to combine the references identified in the accompanying claim charts include the nature of the problem being solved, the express, implied, and inherent teachings of the prior art, and the knowledge of a POSITA that such combinations would have yielded predictable results, and that such combinations would have represented known alternatives to a POSITA. For each combination, there is a teaching, suggestion, and motivation to combine both in the references to be combined themselves, as well as in the art generally that was known to a POSITA. In any event, each limitation of the ’562 Patent is, and would have been at the time of the alleged invention, a simple design choice representing a predictable variation within the skill of a POSITA. Moreover, each limitation of the ’562 Patent was well known in the art, including well-known to POSITAs.

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

No showing of a specific motivation to combine prior art is required to combine the references disclosed for any asserted patent in this document and in the attached charts, as each combination of art would have yielded expected results and

at most would simply represent a known alternative to one of skill in the art. *See B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020) ("[W]e affirm the Board's conclusion that the challenged claims would have been obvious because modifying the Admitted Prior Art/Betts combination to include a second recess was nothing more than the predictable application of known technology."); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1344 (Fed. Cir. 2017); *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415 (2007) (rejecting the "rigid" application of the teaching, suggestion, or motivation to combine test, and instead applying an "expansive and flexible" approach). Indeed, the Supreme Court held that a POSITA is "a person of ordinary creativity, not an automaton" and "in many cases a POSITA will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR*, 550 U.S. at 420-21. Nevertheless, in addition to the information contained in the obviousness sections of this document and elsewhere in these contentions, Skechers hereby identify motivations and reasons to combine.

One or more combinations of the prior art references identified above would have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) ("It is simply a matter of common sense that the sleeve used in Down, in a towing attachment quite similar to a hitch receiver/tow bar arrangement, could be combined with a barbell-shaped hitch pin lock in order to address the known problem of different aperture sizes in standard hitch receivers and the shelf-space problem experienced by retailers."); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008) ("The asserted claims simply substitute a resistive electrical switch for the mechanical pressure switch employed by the Gopher Zapper," which "is a

textbook case of when the asserted claims involve a combination of familiar elements according to known methods that does no more than yield predictable results." (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed. Cir. 2004) (affirming the district court's finding of "a motivation to combine because the two references address precisely the same problem of underpinning existing structural foundations" even though the record "does not feature an express written teaching in the art to make this combination"); *see also Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869 F.3d at 1344

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

Wyers v. Master Lock Co., 616 F.3d at 1242.

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

The motivation to combine the teachings of the prior art references disclosed herein is also found in the references themselves and in: (1) the nature of the problem being solved; (2) the express, implied and inherent teachings of the prior art; (3) the knowledge of POSITAs; (4) the predictable results obtained in combining the different elements of the prior art; (5) the predictable results obtained in simple substitution of one known element for another; (6) the use of a known technique to improve similar devices, methods, or products in the same way; (7) the predictable results obtained in applying a known technique to a known device,

method, or product ready for improvement; (8) the finite number of identified predictable solutions that had a reasonable expectation of success; and (9) known work in various technological fields that could be applied to the same or different technological fields based on design incentives or other market forces. *See* above for legal background regarding obviousness combinations and M.P.E.P. § 2143.

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

Skechers submits the following charts identifying specific locations in each alleged item of prior art where each limitation of each asserted claim is found as attached Exhibits 562-1 through 562-10. The contents of Exhibits 562-1 through 562-10, in combination with the foregoing patents, publications, and products, anticipate and/or render obvious the '562 Asserted Claims under 35 U.S.C. § 102, either expressly or inherently, and under § 103, in each case, as understood by a POSITA.

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

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

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '562 Patent)
562-10	Okamoto – European Patent App. Pub. No. 2149629

D. Invalidity Under 35 U.S.C. § 112

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

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

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

Section 112 further includes an enablement requirement: "The specification shall contain a written description . . . of the manner and process of making and using [the invention] in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same[.]" Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure "must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,

687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of the claim or does not enable the full scope of the claim, there is no enablement. *AK Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687 F.3d at 1383-84.

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

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

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

The grounds identified below both individually and collectively render the '562 Asserted Claims invalid under the statutory requirements of § 112. By identifying certain claim language below, Skechers does not imply that such language is entitled to any patentable weight when comparing the claim as a whole to the prior art. Skechers' identifications are made based on Skechers' present understanding of the Asserted Claims and Nike's apparent interpretation of these claims as reflected in its Apparent Infringement Contentions, and Skechers reserves the right to amend these identifications, including in response to claim constructions and claim interpretations that would render claim limitations not enabled, lacking in written description, or indefinite.

a. Lack of Enablement And Written Description

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

- "knitting an integral knit tongue that is of unitary knit construction with the upper with the knitting machine, the integral knit tongue extending through a throat area of the knitted component" (Claim 1)
- "knitting an integral knit tongue that is of unitary knit construction with the upper with at least one of the first feeder and the second feeder of the knitting machine, the integral knit tongue extending through a throat area of the knitted component" (Claim 8)
- "the integral knit tongue is joined by knitting with the knitting machine to: (1) a forward portion of the throat area, and (2) at least along a portion of both of a lateral side and a medial side of the throat area of the knitted component extending through a portion of a length of the throat area in a

longitudinal direction from the forward portion to an ankle opening of the upper." (Claims 1, 8, 16)

- "forming a course with the knitting machine that joins the integral knit tongue to the upper" (Claim 4)
- "knitting the partially integral portion with the knitting machine of unitary knit construction with the upper at the forward portion of the throat area and at least along the portion of both of the lateral side and the medial side of the throat area of the knitted component extending through the portion of the length of the throat area in the longitudinal direction" (Claim 5)
- "knitting the free portion with the knitting machines of unitary knit construction with the partially integral portion at a rearward portion of the integral knit tongue and remaining portions of the knitted component" (Claim 5)
- "the first portion of the upper including at least the rearward portion of the integral knit tongue" (Claim 6)
- "the first portion of the upper moving with respect to the free portion during knitting of the first portion of the upper" (Claim 7)
- "the step of knitting the second portion further comprises moving the free portion and the upper together during knitting of the second portion of the upper" (Claim 7)
- "knitting the exterior surface of the first portion of the upper with the second feeder" (Claim 10)
- "the first portion of the upper is one of a medial side and a lateral side of the knitted component" (Claim 11)

These claim terms/phrases as apparently construed and/or interpreted by Nike violate the written description and/or enablement requirements of 35 U.S.C. § 112. Each asserted claim of the '562 Patent is invalid as not containing a written description of the invention, and of the manner and process of making and using it,

in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the alleged invention. Moreover, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear lack written description because the specification of the '562 Patent demonstrates that the patentee neither conceived of nor demonstrated possession of all that Nike now contends the claims cover. In addition, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear are invalid because the specification fails to provide sufficient disclosure to enable any POSITA to which it pertains, or with which it is most nearly connected, to implement the invention without undue experimentation.

b. Indefiniteness

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

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

- "throat area" (Claims 1, 5, 8, 13, 14, 16, 20, 21)
- "forward portion of the throat area" (Claims 1, 5, 8, 13, 16, 20)
- "integral knit tongue" (Claims 1, 3, 4, 6-10, 12-17, 19-21)
- "knitting the partially integral portion with the knitting machine of unitary knit construction with the upper at the forward portion of the throat area and at least along the portion of both of the lateral side and the medial side

of the throat area of the knitted component extending through the portion of the length of the throat area in the longitudinal direction" (Claim 5)

- "knitting the free portion with the knitting machines of unitary knit construction with the partially integral portion at a rearward portion of the integral knit tongue and remaining portions of the knitted component" (Claim 5)
- "the first portion of the upper including at least the rearward portion of the integral knit tongue" (Claim 6)
- "knitting the exterior surface of the first portion of the upper with the second feeder" (Claim 10)

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

E. Invalidity Under the Doctrine of Double Patenting

The '562 patent is also invalid for obvious-type double patenting. "[T]he obviousness-type double patenting doctrine prohibits an inventor from extending his right to exclude through claims in a later-expiring patent that are not patentably distinct from the claims of the inventor's earlier-expiring patent[.]" *Gilead Scis., Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1210 (Fed. Cir. 2014). Both the '562 and '626 Patents issued from continuations-in-part of U.S. Patent App. No. 13/400,511 (the "'511 Application"), now Patent No. 8,448, 474 (the "'474 Patent"), and are subject to patent term extensions of 141 days and 703 days, respectively. Therefore,

the ’474, ’562, and ’636 Patents respectively have the expiration dates of February 20, 2032, July 10, 2032, and January 23, 2034. Moreover, U.S. Patent Nos. 8,621,891 (the “’891 Patent”), 9,032,763 (the “’763 Patent”), 9,420,844 (the “’844 Patent”) all issued from a continuation or continuation-in-part application of the ’511 Application, and also have an expiration date of February 20, 2032. Because the ’562 Patent is a later-expiring patent than the ’474, ’891, 763, and 844 Patents, and its claims are obvious variations of those of the ’474, ’891, 763, and 844 Patents, the ’562 Asserted Claims are invalid and/or unenforceable for this additional reason. *See, e.g.*, *In re Cellect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023).

V. ’636 PATENT

A. Prior Art References[8]

Skechers identifies the following prior art presently known to Skechers to anticipate the ’636 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g), either expressly or inherently as understood by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers generally identifies and incorporates by reference herein all prior art and invalidity arguments previously asserted against the ’636 Patent, whether during the original prosecution of the ’636 Patent, before the Patent Trial and Appeals Board, or during any of the litigations filed by Nike involving the ’636 Patent, including, for example, the adidas Litigation or the New Balance Litigation. In addition, discovery is outgoing, and Skechers has served document requests and interrogatories for which responses are outstanding that Skechers expects to reveal additional prior art. Furthermore, Skechers is generally aware of information pertaining to prior art from other proceedings that is currently unavailable to

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

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

1. Prior Art Patents and Publications[9]

Prior Art	Date of Issue or Publication
US RE18,804	4/1933
US 601,192	3/1898
US 1,215,198	2/1917
US 1,597,934	8/1926
US 1,839,274	1/1932
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US 2,569,764	10/1951
US 2,586,045	2/1952
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[9] Skechers incorporates by reference all prior art references cited in the patents and publications listed herein and/or their file histories.

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Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth-Verlag GmnH 2002)	2002
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J. Power, *9.6 Weft Knitwear in Fashion Applications,* in Advances in Apparel Production (Catherine Fairhurst, ed. 2008)	2008
Hong, H., et al. *The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine,* India Journal of Fibre and Textile Research, 1994, 19: 189-189	9/1994
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Nishiwaki, *T Requirement Properties and Materials Used in Sport Shoes, Sen-I Gakkaishi,* 2009, 65(5): P150-P153	2009
Choi, Wonseok and Powell, Nancy B., *Three Dimensional Seamless Garment Knitting on V-Bed Flat Knitting Machines,* Journal of Textile and Apparel, Technology and Management, Vo. 4, Issue 3, Spring 2005	2005
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Charles B Hatfield, DESIGNING, CUTTING, AND GRADING BOOT AND SHOE PATTERNS AND COMPLETE MANUAL FOR THE STITCHING ROOM BY AN EXPERT OF THIRTY YEARS (1899)	1899
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Tuxedo Slipper Book Volume 3, Tuxedo Yarn Company	NA
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Jenny Underwood, The Design of 3D Shape	11/2009

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Dorin Ionesi, et al., Three-Dimensional Knitted Fabric with Technical Destination, Bulletinul Institutului Politehnic Din Iaşi	2010
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Knitting Project – "Converse" Baby Booties!!!, amandaleaps.blogspot.com/2012/01/knitting-project-converse-baby-booties.html	1/2012
Fibres/Yarns/Fabrics, Nike Flyknit – A Seamlessly Knitted Running Shoe!, www.innovationintextiles.com/nike-flyknit-a-seamlessly-knitted-running-shoe	2/2012
Mohammad Imrul Khorshed, Studies on the Quality Control Procedure of Cutting Department in Footwear Industry (BS Dissertation), The University of Dhaka	2007
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Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
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June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania, https://www.thedeffest.com/vintage-ads	1980s
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History	2019

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Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
J. H. Thornton, Textbook of Footwear Manufacture	2009

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

2. Prior Art Products

Skechers also contends that the asserted claims of the '636 Patent are invalid based on public knowledge and uses and/or offers for sale or sales of products that are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the United States by other inventors who had not abandoned, suppressed, or concealed them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious under 35 U.S.C. § 103 the asserted claims.

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

Prior Art Product	Date of Public Use
Nike Huarache shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Nike Sock Dart shoe, publicly known, used, and/or on sale within the United States	No later than 5/2004
"Acorn Footwear-Slipper Sock," from Northland Maine, publicly known, used, and/or on sale within the United States	No later than 12/18/2001

Prior Art Product	Date of Public Use
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
Nike "Air Flow" shoe (SK# 258), publicly known, used, and/or on sale within the United States	No later than 1/1990
Reebok "Shaq Trainer" shoe, publicly known, used, and/or on sale within the United States	No later than 1995
Reebok "City Jam" shoe (SK# 506), publicly known, used, and/or on sale within the United States	No later than 1993
"Nova Cushion" shoe (SK# 01290), publicly known, used, and/or on sale within the United States	No later than 2006
Nike "Shox Laser" shoe, publicly known, used, and/or on sale within the United States	No later than 7/2005
Nike "2:40" shoe, publicly known, used, and/or on sale within the United States	No later than 2005
Reebok "Summer Runner" shoe, publicly known, used, and/or on sale within the United States	No later than 2005
Reebok "Whiplash" shoe, publicly known, used, and/or on sale within the United States	No later than 2005
Nike Air Presto shoes, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Nike Sock Racer shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Das Wrestling shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Equipment Wrestling shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Barefoot shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011

Prior Art Product	Date of Public Use
adidas Primeknit shoe, publicly known, used, and/or on sale within the United States	No later than 7/26/2012
Nike FlyKnit shoe, publicly known, used, and/or on sale within the United States	No later than 2/21/2012
Nike Flyknit Trainer+, publicly known, used, and/or on sale within the United States	No later than 2/21/2012
New Balance Minimus Life shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
Tuxedo shoe, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas Adizero Infiknit Olympics, publicly known, used, and/or on sale within the United States	No later than 2/28/2013
adidas Hydroglide 2000, publicly known, used, and/or on sale within the United States	No later than 2001
Nike Summer Runner, publicly known, used, and/or on sale within the United States	No later than 2/20/2011
adidas 2000 Sydney Olympics Collection, publicly known, used, and/or on sale within the United States	No later than 2001
Nike Presto Chanjo shoe, publicly known, used, and/or on sale within the United States	No later than 2001
"Hard Rope" Shoe by Simone Memel	No later than 1995

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

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

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

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

1. Anticipation

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

2. Obviousness

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

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

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

Motivations to combine the above items of prior art are present in the references themselves, general knowledge of a POSITA, the prior art as a whole, or the nature of the problems allegedly addressed by the '636 Patent. Combining the references identified in the accompanying claim charts would have been obvious, as the references identify and address the same technical issues and suggest very similar solutions to those issues. Skechers reserves the right to amend or supplement these invalidity contentions to identify additional reasons that combining the references would be obvious to a POSITA.

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

The obviousness combinations set forth in these contentions reflect Skechers' present understanding of the potential scope of the claims that Nike appears to be advocating and should not be seen as Skechers' acquiescence to Nike's interpretation of the patent claims. Skechers reserves the right to amend or supplement these contentions regarding anticipation or obviousness of the asserted claims based on further information from Nike, the Court, other courts or decision-makers in parallel proceedings, or any other source including any changes Nike makes to its Apparent Infringement Contentions, information discovered during

discovery, arguments made and positions taken by Nike, or a claim construction ruling by the Court. Skechers reserves the right to amend or supplement these contentions to assert different support for each asserted limitation, to cite different portions of each reference in support of any invalidity theory, to assert different combinations, or to identify different references, as necessary. Nike has not identified what elements or combinations it alleges were not known to a POSITA. Therefore, for any claim limitation that Nike alleges is not disclosed in a particular prior art reference, Skechers reserves the right to assert that any such limitation is either inherent in the disclosed reference or obvious to a POSITA at the time in light of the same, or that the limitation is disclosed in another of the references disclosed above and, in combination, would have rendered the asserted claim obvious.

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

simple design choice representing a predictable variation within the skill of a POSITA. Moreover, each limitation of the '636 Patent was well known in the art, including well-known to POSITAs.

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

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

One or more combinations of the prior art references identified above would

have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) ("It is simply a matter of common sense that the sleeve used in Down, in a towing attachment quite similar to a hitch receiver/tow bar arrangement, could be combined with a barbell-shaped hitch pin lock in order to address the known problem of different aperture sizes in standard hitch receivers and the shelf-space problem experienced by retailers."); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008) ("The asserted claims simply substitute a resistive electrical switch for the mechanical pressure switch employed by the Gopher Zapper," which "is a textbook case of when the asserted claims involve a combination of familiar elements according to known methods that does no more than yield predictable results." (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed. Cir. 2004) (affirming the district court's finding of "a motivation to combine because the two references address precisely the same problem of underpinning existing structural foundations" even though the record "does not feature an express written teaching in the art to make this combination"); *see also Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869 F.3d at 1344.

In addition, it would have been obvious to try combining the prior art references identified above because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367 (Fed. Cir. 2016) ("The ordinary artisan would then be left with two design choices: he could place the thickness sensor either above the presence sensor in the feed, so

that the paper contacts the thickness sensor before the presence sensor, or below so that the paper contacts it after. Each of these two design choices is an obvious combination of prior-art elements." (citing *KSR Int'l Co.*, 550 U.S. at 421)); *Bayer Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) ("While a skilled artisan may have preferred a delayed-release formulation over the claimed immediate-release formulation, 'that the prior art as a whole suggests the desirability of a particular combination need not be supported by a finding that the prior art suggests that the combination claimed ... is the preferred, or most desirable, combination.'" (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004)); *KSR*, 550 U.S. at 419-20. Further, the combinations of the prior art references identified above and in the claim charts would have been obvious because the combinations represent known potential options with a reasonable expectation of success. *See Wyers v. Master Lock Co.*, 616 F.3d at 1242.

Additional evidence that there would have been a motivation to combine the prior art references identified above includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the '636 Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged inventions; and the background knowledge that would have been possessed by a POSITA. *See KSR*, 550 U.S. at 401 ("When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill."); *Arctic Cat Inc. v. Bombardier Recreational Prod.*

Inc., 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir. 2016); *Norgren Inc. v. Int'l Trade Comm'n*, 699 F.3d 1317, 1322-23 (Fed. Cir. 2012).

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

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

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

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '636 Patent)
636-1	Glidden – U.S. Patent No. 2,147,197[10]
636-2	Dua '956 – U.S. Patent No. 7,774,956
636-3	Joha – U.S. Patent No. RE 18,804
636-4	Bell – U.S. Patent App. Pub. No. 2010/0077634
636-5	Clark – U.S. Patent No. 2,440,393
636-6	Horii - Japanese Patent App. Pub. No. H3-3203
636-7	Li – Chinese Patent App. Pub. No. 2187379Y
636-8	Dua '592 – U.S. Patent App. Pub. No. 2005/0193592
636-9	Glidden, Dua '956, Joha, Bell, Clark, Horii, Li, and Dua '592

D. Invalidity Under 35 U.S.C. § 112

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

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

The definiteness requirement requires that the claim must set forth what the applicant regards as the invention, and do so with sufficient particularity and definiteness. *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.

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

2002). Where it would be apparent to one of skill in the art, based on the patent specification, that the "invention" set forth in a claim is not what the patent applicant regarded as the invention, the claim is invalid. *Id.*

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

Section 112 further includes a written description requirement: "The specification shall contain a written description of the invention[.]" Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). "To satisfy the written description requirement, a patent applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *ICU Medical Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009) (internal quotation marks and citations omitted); *see also Synthes USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (Fed. Cir. 2013). "The test [for written description support] requires an objective inquiry into the four corners of the specification from the perspective of a POSITA. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and

show that the inventor actually invented the invention claimed." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

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

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

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

a. Lack of Enablement And Written Description

Based on Skechers' present understanding of the Asserted Claims and Nike's apparent interpretation of these claims as reflected in its Apparent Infringement Contentions, the '636 Asserted Claims fail to satisfy the requirements of § 112 because the specification and original patent application fail to provide an enabling

disclosure of and written description support for at least the following limitations:

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

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

b. Indefiniteness

Based on Skechers' present understanding of the '636 Asserted Claims and

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

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

- "raised element" (Claims 1-20, 27)
- "throat area" (Claims 1, 5, 7, 11-13, 18, 21, 23, 24)
- "forward portion of the throat area" (Claims 1, 7, 13, 18, 21)
- "integral knit tongue" (Claims 1-4, 7, 8, 10, 13-16, 18, 19, 21, 22, 25, 26)
- "knit structure" (Claims 3, 15)
- "the portion of the lateral side and the medial side" (Claim 7)
- "an integral knit tongue with the upper" (Claim 13)

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

E. Invalidity Under the Doctrine of Double Patenting

The '636 patent is also invalid for obvious-type double patenting. "[T]he obviousness-type double patenting doctrine prohibits an inventor from extending his right to exclude through claims in a later-expiring patent that are not patentably

distinct from the claims of the inventor's earlier-expiring patent[.]" *Gilead Scis., Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1210 (Fed. Cir. 2014). Both the '562 and '626 Patents issued from continuations-in-part of U.S. Patent App. No. 13/400,511, now Patent No. 8,448, 474 (the "'474 Patent"), and are subject to patent term extensions of 141 days and 703 days, respectively. Therefore, the '474, '562, and '636 Patents respectively have the expiration dates of February 20, 2032, July 10, 2032, and January 23, 2034. Moreover, U.S. Patent Nos. 8,621,891 (the "'891 Patent"), 9,032,763 (the "'763 Patent"), 9,420,844 (the "'844 Patent") all issued from a continuation or continuation-in-part application of the '511 Application, and also have an expiration date of February 20, 2032. Because the '636 Patent is a later-expiring patent than the '474, '562, 891, 763, and 844 Patents, and its claims are obvious variations of those of the '474, '562, 891, 763, and 844 Patents, the '636 Asserted Claims are invalid and/or unenforceable for this additional reason. *See, e.g.*, *In re Cellect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023).

VI. '484 PATENT

A. Prior Art References[11]

Skechers identifies the following prior art presently known to Skechers to anticipate the '484 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g) or AIA 35 U.S.C. § 102, either expressly or inherently as understood by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers generally identifies and incorporates by reference herein all prior art and invalidity arguments previously asserted against the '484 Patent, whether during the original prosecution of the '484 Patent, before the Patent Trial and Appeals Board, or during any of the litigations filed by Nike involving the '484

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

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

1. Prior Art Patents and Publications[12]

Prior Art	Date of Issue or Publication
US 601,192	3/1898
US 924,605	6/1909
US, 1,215,198	2/1917
US 1,597,934	8/1926
US 1,729,816	10/1929
US 1,888,172	11/1932
US 1,902,780	3/1933
US 1,910,251	5/1933
US 2,001,293	5/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,314,098	3/1943
US 2,330,199	9/1943
US 2,376,399	10/1943
US 2,343,390	3/1944
US 2,400,692	5/1946

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

Prior Art	Date of Issue or Publication
US 2,412,087	12/1946
US 2,440,393	4/1948
US 2,569,764	10/1951
US 2,586,045	2/1952
US 2,608,078	8/1952
US 2,641,004	6/1953
US 2,675,631	4/1954
US 2,707,381	5/1955
US 2,714,813	8/1955
US 2,770,055	11/1956
US 2,904,980	9/1959
US 2,994,322	8/1961
US 3,114,213	12/1963
US 3,128,567	4/1964
US 3,284,827	11/1966
US 3,291,085	8/1964
US 3,402,323	9/1968
US 3,416,174	12/1968
US 3,583,081	6/1971
US 3,603,006	9/1971
US 3,641,603	2/1972
US 3,694,940	10/1972
US 3,704,474	12/1972
US 3,766,566	10/1973
US 3,778,856	12/1973
US 3,952,427	4/1976
US 3,972,086	8/1976
US 4,027,402	6/1977

Prior Art	Date of Issue or Publication
US 4,031,586	6/1977
US 4,211,806	7/1980
US 4,232,458	11/1980
US 4,255,949	3/1981
US 4,258,480	3/1981
US 4,317,292	3/1982
US 4,342,159	8/1982
US 4,373,361	2/1983
US 4,430,811	2/1984
US 4,447,967	5/1984
US 4,465,448	8/1984
US 4,607,439	8/1986
US 4,646,727	3/1987
US 4,737,396	4/1988
US 4,750,339	6/1988
US 4,756,098	7/1988
US 4,785,558	11/1988
US 4,813,158	3/1989
US 4,878,504	11/1989
US 4,967,494	11/1990
US 4,998,722	3/1991
US 5,031,423	7/1991
US 5,067,260	11/1991
US 5,095,720	3/1992
US 5,117,567	6/1992
US 5,152,025	10/1992
US 5,192,601	3/1993
US 5,257,969	11/1993

Prior Art	Date of Issue or Publication
US D346,686	5/1994
US 5,345,638	9/1994
US 5,353,524	10/1994
US 5,371,957	12/1994
US 5,377,430	1/1995
US 5,461,884	10/1995
US 5,511,323	4/1996
US 5,572,860	11/1996
US 5,575,090	11/1996
US 5,623,840	4/1997
US 5,729,918	3/1998
US 5,735,145	4/1998
US 5,746,013	5/1998
US 5,765,296	6/1998
US 5,778,564	7/1998
US 5,884,419	3/1999
US 5,996,189	12/1999
US 6,029,376	2/2000
US 6,032,387	3/2000
US 6,052,921	4/2000
US 6,088,936	7/2000
US 6,151,802	11/2000
US 6,170,175	1/2001
US 6,227,010	5/2001
US 6,308,438	10/2001
US 6,333,105	12/2001
US 6,367,168	4/2002
US 6,389,715	5/2002

Prior Art	Date of Issue or Publication
US 6,401,364	6/2002
US 6,558,784	5/2003
US 6,588,237	7/2003
US 6,631,569	10/2003
US 6,644,070	11/2003
US 6,763,610	7/2004
US 6,754,983	6/2004
US 6,910,288	6/2005
US 6,922,917	8/2005
US 6,931,762	8/2005
US 6,986,269	1/2006
US D517,297	3/2006
US 7,016,867	3/2006
US 7,051,460	5/2006
US 7,056,402	6/2006
US 7,107,235	9/2006
US 7,168,184	1/2007
US 7,347,011	3/2008
US 7,441,348	10/2008
US 7,543,397	6/2009
US 7,568,298	8/2009
US 7,637,032	12/2009
US 7,682,219	3/2010
US 7,774,956	8/2010
US 7,861,438	1/2011
US 8,215,132	7/2012
US 8,225,530	7/2012
US 8,448,474	5/2013

Prior Art	Date of Issue or Publication
US 8,490,299	7/2013
US 8,544,191	10/2013
US 8,650,916	2/2014
US 8,887,411	11/2014
US 2002/0078599	6/2002
US 2002/0148258	10/2002
US 2003/0037462	2/2003
US 2003/0126762	7/2003
US 2003/0191427	10/2003
US 2004/0118018	6/2004
US 2004/0181972	9/2004
US 2004/0226191	11/2004
US 2005/0016023	1/2005
US 2005/0075027	4/2005
US 2005/0115284	6/2005
US 2005/0193592	9/2005
US 2005/0273988	12/2005
US 2005/0284000	12/2005
US 2006/0010931	1/2006
US 2006/0048413	3/2006
US 2006/0059715	3/2006
US 2006/0130359	6/2006
US 2006/0162187	7/2006
US 2007/0022627	2/2007
US 2007/0180730	8/2007
US 2007/0245595	10/2007
US 2007/0294920	12/2007
US 2008/0017294	1/2008

Prior Art	Date of Issue or Publication
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Isidore Zamosky, Shoe Modifications in Lower-Extremity Orthotics, Journal of Rehabilitation Research and Development; Washington, Vol. 50, Iss. 6, pp. 54-95	2013
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Caroline Cox, Vintage Shoes (Carlton Books)	2008
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Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
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Flat Knitting Footwear – STOLL, Technical Textiles with Flat Knitting Machines	3/1997
Wonseok Choi, et al., Three Dimensional Seamless Garment Knitting on V-Bed Flat Knitting Machineses, Journal Textile and Apparel, Technology and Management, 2005, 4(3)	2005

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

2. Prior Art Products

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

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

Prior Art Product	Date of Public Use
Stoll Flat Knitting Machinery in operation within the United States	No later than 11/6/2005
Santoni Circular Knitting Machinery in operation within the United States	No later than 11/6/2005
Nike Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 11/6/2005
Nike Air Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 11/6/2005
Nike Aquasock, publicly known, used, and/or on sale within the United States	No later than 11/6/2005
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
adidas engineered warp footwear, publicly known, used, and/or on sale within the United States. Including: white and blue adidas 2000 Olympic Wrestling shoe, Olympic Rowing Shoe, adidas black and white Olympic sprinting shoes, adidas Olympic Boxing shoes, adidas Olympic marathon orange and white shoe, 2003 adistar RD shoe, adidas white and blue shoe 2003 a3 shoe, adidas YY Tenet Flower shoe, and adidas Climacool shoe	No later than 11/6/2005
Pan Am Slipper publicly known, used, and/or on sale within the United States	No later than 11/6/2005
Capezio Shoe, publicly known, used, and/or on sale within the United States	No later than 11/6/2005
Karl Mayer Warp Knitting Machinery in operation within the United States	No later than 11/6/2005

Prior Art Product	Date of Public Use
Steve Blevins, publicly known, used, and/or on sale within the United States	No later than 11/6/2005
Robert Szanto for Simply Knitting Mills, Inc., publicly known, used, and/or on sale within United States	No later than 11/6/2005
"Hard Rope" Shoe by Simone Memel	No later than 1995

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

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

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

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

or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications and their general scientific knowledge. Skechers may rely upon uncited portions of the prior art references and on other publications and expert testimony to provide context, and as aids to understanding and interpreting the portions that are cited. Skechers may also rely on the prior art of record for any permissible purpose, including prior art discussed in the '484 Patent specification itself, including to show that the '484 Patent is anticipated or obvious, show the state of the art, show motivation to combine a reference with one or more other references, and to show the proper scope of the claims. Skechers may also rely on uncited portions of the prior art references, other disclosed publications, and the testimony of experts to establish that a POSITA would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

1. Anticipation

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

2. Obviousness

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

35 U.S.C. § 103.

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

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

Motivations to combine the above items of prior art are present in the references themselves, general knowledge of a POSITA, the prior art as a whole, or the nature of the problems allegedly addressed by the ’484 Patent. Combining the references identified in the accompanying claim charts would have been obvious, as the references identify and address the same technical issues and suggest very similar solutions to those issues. Skechers reserves the right to amend or supplement these invalidity contentions to identify additional reasons that combining the references would be obvious to a POSITA.

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

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

Each of these combinations was obvious to try for a POSITA. In the field of the '484 Patent, there was a design need or market pressure to solve a problem and there were a finite number of identified, predictable solutions. A POSITA had good reason to pursue the known options within his or her technical grasp including

combinations of the disclosures in the accompanying claim charts. Each of these combinations is also the combination of familiar elements according to known methods and yields predictable results. In the field of the '484 Patent, a great deal of prior research and product designs were available and design incentives and other market forces would prompt variations of it. Further reasons to combine the references identified in the accompanying claim charts include the nature of the problem being solved, the express, implied, and inherent teachings of the prior art, and the knowledge of a POSITA that such combinations would have yielded predictable results, and that such combinations would have represented known alternatives to a POSITA. For each combination, there is a teaching, suggestion, and motivation to combine both in the references to be combined themselves, as well as in the art generally that was known to a POSITA. In any event, each limitation of the '484 Patent is, and would have been at the time of the alleged invention, a simple design choice representing a predictable variation within the skill of a POSITA. Moreover, each limitation of the '484 Patent was well known in the art, including well-known to POSITAs.

Additional prior art references rendering the asserted claims obvious, alone or in combination with other references, including identification of combinations showing obviousness, are identified in the accompanying claim charts, which include exemplary citations for the '484 Asserted Claims showing specifically where in each reference or combinations of references each asserted claim is found, and an explanation of why the prior art renders the asserted claim obvious.

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

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

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

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

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

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

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

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

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

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

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

Exhibit No.	Exhibit (claim chart explaining bases for invalidity of '484 Patent)
484-1	Dua '592 – U.S. Publication No. 2005/0193592
484-2	Yamamoto – Japanese Publication No. JP 3118168U
484-3	Glidden – U.S. Patent No. 2,147,197
484-4	Li – Chinese Publication No. CN 2187379Y
484-5	Cusinato – European Patent No. EP 1338690
484-6	Clark – U.S. Patent No. 2,440,393
484-7	Horii – Japanese Publication No. H3-3203; Morimoto – Japanese Publication No. 2001-164444; Zuckerman – U.S. Patent No. 2,047,724
484-8	Doughty – U.S. Patent No. 2,675,631
484-9	Dua '592, Yamamoto, Glidden, Li, Cusinato, Clark, Horii, Morimoto, Zuckerman, and Doughty

D. Invalidity Under 35 U.S.C. § 112

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

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

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

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

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

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

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

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

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

The grounds identified below both individually and collectively render the '484 Asserted Claims invalid under the statutory requirements of § 112. By identifying certain claim language below, Skechers does not imply that such language is entitled to any patentable weight when comparing the claim as a whole to the prior art. Skechers' identifications are made based on Skechers' present understanding of the Asserted Claims and Nike's apparent interpretation of these

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

a. Lack of Enablement And Written Description

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

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

These claim terms/phrases as apparently construed and/or interpreted by Nike violate the written description and/or enablement requirements of 35 U.S.C. § 112. Each asserted claim of the '484 Patent is invalid as not containing a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the alleged invention. Moreover, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear lack written description because the specification of the '484 Patent demonstrates that the patentee neither conceived of nor demonstrated possession of all that Nike now contends the claims cover. In addition, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear are invalid because

the specification fails to provide sufficient disclosure to enable any POSITA to which it pertains, or with which it is most nearly connected, to implement the invention without undue experimentation.

b. Indefiniteness

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

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

- "first area" (Claims 7, 12-14)
- "second area" (Claims 7, 12-14)
- "first layer" (Claims 1, 2, 4, 10, 11)
- "second layer" (Claims 2, 4, 10)
- "domed, three-dimensional structure" (Claims 1, 10, 11)
- "overlapped loop" (Claim 10)

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

VII. '511 PATENT

A. Prior Art References[13]

Skechers identifies the following prior art presently known to Skechers to anticipate the '511 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g) or AIA 35 U.S.C. § 102, either expressly or inherently as understood by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers generally identifies and incorporates by reference herein all prior art and invalidity arguments previously asserted against the '511 Patent, whether during the original prosecution of the '511 Patent, before the Patent Trial and Appeals Board, or during any of the litigations filed by Nike involving the '511 Patent, including, for example, the adidas Litigation, the adidas ITC Investigation, or the New Balance Litigation. In addition, discovery is outgoing, and Skechers has served document requests and interrogatories for which responses are outstanding that Skechers expects to reveal additional prior art. Furthermore, Skechers is generally aware of information pertaining to prior art from other proceedings that is currently unavailable to Skechers, including because such information may be subject to a protective order. Once Skechers receives relevant information, it will timely supplement its invalidity contentions, as appropriate.

1. Prior Art Patents and Publications[14]

Prior Art	Date of Issue or Publication
US 601,192	3/1898
US 761,520	5/1904
US 1,215,198	2/1917

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

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

Prior Art	Date of Issue or Publication
US 1,597,934	8/1926
US 1,803,554	5/1931
US 1,841,518	l/1932
US 1,888,172	11/1932
US 1,902,780	3/1933
US RE18,804	4/1933
US 1,910,251	5/1933
US 1,956,969	5/1934
US 2,001,293	5/1935
US 2,024,180	12/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,150,730	3/1939
US 2,161,472	6/1939
US 2,178,941	11/1939
US 2,314,098	3/1943
US 2,330,199	9/1943
US 2,343,390	3/1944
US 2,400,692	5/1946
US 2,440,393	4/1949
US 2,467,237	4/1949
US 2,569,764	10/1951
US 2,586,045	2/1952
US 2,598,217	5/1952
US 2,603,891	7/1952
US 2,608,078	8/1952
US 2,641,004	6/1953
US 2,675,631	4/1954

Prior Art	Date of Issue or Publication
US 2,714,813	8/1955
US 2,770,055	11/1956
US 2,848,885	8/1953
US 2,966,785	1/1961
US 2,994,372	8/1961
US 3,114,213	12/1963
US 3,298,204	1/1967
US 3,372,415	3/1968
US 3,497,971	3/1970
US 3,583,081	6/1971
US 3,635,051	1/1972
US 3,694,940	10/1972
US 3,703,820	11/1972
US 3,704,474	12/1972
US 3,766,566	10/1973
US 3,769,723	11/1973
US 3,778,856	12/1973
US 3,835,555	9/1974
US 3,851,315	11/1974
US 3,863,272	2/1975
US 3,882,697	5/1975
US 3,937,039	2/1976
US 3,952,427	4/1976
US 3,972,086	8/1976
US 3,985,003	10/1976
US 4,027,402	6/1977
US 4,031,586	6/1977
US 4,038,840	8/1977

Prior Art	Date of Issue or Publication
US 4,057,981	11/1977
US 4,150,498	4/1979
US 4,151,662	5/1979
US 4,172,293	10/1979
US 4,183,156	1/1980
US 4,211,806	7/1980
US 4,219,945	9/1980
US 4,232,458	11/1980
US 4,255,949	3/1981
US 4,258,480	3/1981
US 4,317,292	3/1982
US 4,354,318	10/1982
US 4,373,361	2/1983
US 4,430,811	2/1984
US 4,438,574	3/1984
US 4,447,967	5/1984
US 4,465,448	8/1984
US 4,494,266	1/1985
US 4,527,403	7/1985
US 4,531,525	7/1985
US 4,607,439	8/1986
US 4,624,115	11/1986
US 4,737,396	4/1988
US 4;750,339	6/1988
US 4,756,098	7/1988
US 4,785,558	11/1988
US 4,813,158	3/1989
US 5,031,423	7/1991

Prior Art	Date of Issue or Publication
US 5,081,854	1/1992
US 5,095,720	3/1992
US 5,099,588	3/1992
US 5,117,567	6/1992
US 5,152,025	10/1992
US 5,192,601	3/1993
US 5,253,434	10/1993
US 5,343,639	9/1994
US 5,345,638	9/1994
US 5,353,523	10/1994
US 5,353,524	10/1994
US 5,371,957	12/1994
US 5,385,036	1/1995
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US 5,511,323	4/1996
US 5,526,584	6/1996
US 5,557,527	9/1996
US 5,566,396	10/1996
US 5,572,860	11/1996
US 5,575,090	11/1996
US 5,604,997	2/1997
US 5,623,840	4/1997
US 5,709,107	1/1998
US 5,711,168	1/1998
US 5,729,918	3/1998
US 5,735,145	4/1998
US 5,746,013	5/1998
US 5,765,296	6/1998

Prior Art	Date of Issue or Publication
US 5,884,419	3/1999
US 5,955,172	9/1999
US 5,996,189	12/1999
US 6,029,376	2/2000
US 6,032,387	3/2000
US 6,052,921	4/2000
US 6,088,936	7/2000
US 6,151.802	11/2000
US 6,170,175	1/2001
US 6,108,943	8/2000
US 6,250,115	6/2001
US 6,308,438	10/2001
US 6,330,814	12/2001
US 6,333,105	12/2001
US 6,401,364	6/2002
US 6,477,865	11/2002
US 6,482,492	11/2002
US 6,505,422	1/2003
US 6,558,784	5/2003
US 6,588,237	7/2003
US 6,708,530	3/2004
US 6,754,983	6/2004
US 6,779,369	8/2004
US 6,845,284	1/2005
US 6,910,288	6/2005
US 6,922,917	8/2005
US 6,931,762	8/2005
US 6,984,596	1/2006

Prior Art	Date of Issue or Publication
US 6,986,269	1/2006
US D517,297	3/2006
US 7,051,460	5/2006
US 7,056,402	6/2006
US 7,155,846	1/2007
US 7,204,042	4/2007
US 7,347,011	3/2008
US 7,350,321	4/2008
US 7,441,348	10/2008
US 7,543,397	6/2009
US 7,568,298	8/2009
US 7,682,219	3/2010
US 7,707,747	5/2010
US 7,814,598	10/2010
US 8,042,288	10/2011
US 8,069,692	12/2011
US 8,266,749	9/2012
US 8,490,299	7/2013
US 8,745,895	6/2014
US 9,084,449	7/2015
US 2001/0055684	12/2001
US 2002/0078599	6/2002
US 2002/0148258	10/2002
US 2003/0069807	4/2003
US 2003/0126762	7/2003
US 2003/0191427	10/2003
US 2004/0083625	5/2004
US 2004/0087230	5/2004

Prior Art	Date of Issue or Publication
US 2004/0118018	6/2004
US 2004/0181972	9/2004
US 2004/0216332	11/2004
US 2005/0115284	6/2005
US 2005/0188564	9/2005
US 2005/0193592	9/2005
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US 2007/0180730	8/2007
US 2007/0294920	12/2007
US 2008/0017294	1/2008
US 2008/007810	4/2008
US 2008/0110048	5/2008
US 2008/0110049	5/2008
US 2008/0189830	8/2008
US 2008/0313939	12/2008
US 2009/0068908	3/2009
US 2010/0051132	3/2010
US 2010/0154256	6/2010
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Prior Art	Date of Issue or Publication
US 2010/0199520	8/2010
US 2010/0287790	11/2010
US 2011/0030244	2/2011
US 2011/0078921	4/2011
US 2012/0159813	6/2012
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US 2014/0150294	6/2014
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US 2016/0088893	3/2016
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US 2016/0208421	7/2016
CN 1067566A	1/1993
CN 2187379Y	1/1995
DE 870963	3/1953
DE 1084173	6/1960
DE 19738433	4/1998
DE 19728848	1/1999
DE 29700546 U1	5/1997
EP 0448714	10/1991
EP 0728860	8/1996
EP 0758693	2/1997
EP 0279950	8/1998
EP 0898002	2/1999
EP 1233091	8/2002
EP 1338690	6/2005
EP 1437057	7/2004
EP 1467008 A2	10/2004

Prior Art	Date of Issue or Publication
EP 1563752	8/2005
EP 1602762	12/2005
EP 1972706	9/2008
FR 2171172	9/1973
GB 538865	8/1941
GB 2018837	10/1979
GB 1603487	11/1981
JP S49-39620	10/1974
JP H1-178708	12/1989
JP H3-3203	1/1991
JP H06-113905	4/1994
JP H08-109553	4/1996
JP H11-302943	11/1999
JP 3118168U	1/2006
JP 2006000258	1/2006
KR 880001710	4/1988
KR 900006205	8/1990
KR 200365032Y	10/2004
KR 200200056Y	10/2000
KR 200261749Y1	1/2002
KR 19990004904U	2/1999
KR 200251085	11/2001
KR 200309026Y1	3/2003
KR 19980068775U	12/1998
NL 7304678	10/1974
WO 90/03744	4/1990
WO 98/20758	5/1998
WO 00/32861	6/2000

Prior Art	Date of Issue or Publication
WO 02/31247	4/2002
Burall, P., CoID Design Awards, Design	6/1969
Circular Machines, International Standard, ISO 8117, Second Edition	2/2003
David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (3rd ed., Woodhead Publishing Ltd. 2001)	2001
Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth-Verlag GmnH 2002)	2002
Koester, A.W., Analyzing the Color, Design and Texture of Fabric, Oregon State University Extension Service, 1993	1993
Knitted Fabrics: Manufacture and Processing	1976
Bharat J. Gajjar, Warp Knit Fabrics Technologies	2007
J. Watel, The Milanese Machine: Little Progress Made in the Development of the Milanese Fabric	12/1921
Billy Hunter, Nike Flyknit: Quantum Leap for Flat Knitting	7/2012
Billy Hunter, Nike Flyknit: Ready, Steady, Go!	7/2012
R. Shishoo, Textiles in sport (Woodhead Publishing Ltd. 2005)	2005
Manuals for Stoll Flat Knitting Machinery	No later than 3/3/2003
Hong, H., et al., *The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine*, India Journal of Fibre and Textile Research, 1994, 19: 189-194	9/1994
Susanna E. Lewis et al., A Machine Knitter's Guide to Creating Fabrics	1986

Prior Art	Date of Issue or Publication
Georga Tay, Fundamentals of Weft Knitted Fabrics	1996
Brandon Richard, Bargain Buys: 20 Sneaker Steals Found in Vintage Eastbay Catalogs, www.complex/com/sneakers/a/brandon-richard/vintage-eastbay-sneaker-prices	9/2015
Caroline Cox, Vintage Shoes (Carlton Books)	2008
1989 Reebok AXT SXT CXT Cross-Training Shoes Vintage Print Ad, www.ebay.com/itm/362604032836	1989
Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories Series (Dr. Aileen Ribeiro)	1986
Rei Co-op 1980s Vintage Second Wind Running Shoes and Nike Oceania,	1980s

Prior Art	Date of Issue or Publication
https://www.thedeffest.com/vintage-ads	
Sears the Winner II 1979 Sneakers, https://www.thedeffest.com/vintage-ads/tag/sears+the+winner	1979
Thomas Turner, The Sports Shoe: A History from Field to Fashion (Bloomsbury Publishing Plc)	2019
Eunice Wilson, A History of Shoe Fashion (Pitman Publishing: London)	1974
Desert Boots and Slippers, www.knitlist.com/97gift/desertboots.htm	2001
Stoll Sirix 100 / 200 Manual Part 1 and Part 2	NA

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

2. Prior Art Products

Skechers also contends that the asserted claims of the ’511 Patent are invalid based on public knowledge and uses and/or offers for sale or sales of products that are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the United States by other inventors who had not abandoned, suppressed, or concealed them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious under 35 U.S.C. § 103 the asserted claims.

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

Prior Art Product	Date of Public Use
Stoll Flat Knitting Machinery in operation	No later than

Prior Art Product	Date of Public Use
within the United States	3/3/2003
Santoni Circular Knitting Machinery in operation within the United States	No later than 3/3/2003
Nike Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Air Presto Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Nike Aquasock, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Arcopedico Shoes, publicly known, used, and/or on sale within the United States	No later than 12/18/2001
adidas engineered warp footwear, publicly known, used, and/or on sale within the United States. Including: white and blue adidas 2000 Olympic Wrestling shoe, Olympic Rowing Shoe, adidas black and white Olympic sprinting shoes, adidas Olympic Boxing shoes, adidas Olympic marathon orange and white shoe, 2003 adistar RD shoe, adidas white and blue shoe 2003 a3 shoe, adidas YY Tenet Flower shoe, and adidas Climacool shoe	No later than 3/3/2003
Pan Am Slipper publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Capezio Shoe, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Karl Mayer Warp Knitting Machinery in operation within the United States	No later than 3/3/2003
Steve Blevins, publicly known, used, and/or on sale within the United States	No later than 3/3/2003
Robert Szanto for Simply Knitting Mills, Inc., publicly known, used, and/or on sale within United States	No later than 3/3/2003
"Hard Rope" Shoe by Simone Memel	No later than 1995

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

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

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

Although Skechers has identified at least one citation per limitation for each reference, each and every disclosure of the same limitation in the same reference is not necessarily identified. Rather, in an effort to focus the issues, Skechers has generally cited representative portions of identified references, even where a reference may contain additional support for a particular claim element. In addition, POSITAs generally read a prior art reference as a whole and in the context of other publications and literature. Thus, to understand and interpret any specific statement or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications and their general scientific knowledge. Skechers may rely upon uncited portions of the prior art references and on other publications and expert testimony to provide context, and as aids to understanding and interpreting the portions that are cited. Skechers may also rely on the prior art of record for any permissible purpose, including prior art discussed in the '511 Patent specification itself, including to show that the '511 Patent is anticipated or obvious, show the state of the art, show motivation to

combine a reference with one or more other references, and to show the proper scope of the claims. Skechers may also rely on uncited portions of the prior art references, other disclosed publications, and the testimony of experts to establish that a POSITA would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

1. Anticipation

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

2. Obviousness

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

In addition, the references identified above render one or more asserted claims of the ’511 Patent obvious when the references are read in combination with each other by a POSITA. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined to render obvious (and therefore invalid) each of Nike’s asserted claims. Skechers may rely upon a subset of the above identified references or all of the references identified above for purposes of obviousness depending on

the Court's claim construction, positions taken by Nike during this litigation, and further investigation and discovery. Skechers may rely on combinations with any reference in the attached claim charts and any of the other references disclosed herein with respect to the '511 Patent, including combinations with any of the patents, publications or products identified herein as prior art to the '511 Patent.

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

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

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

The obviousness combinations set forth in these contentions reflect Skechers' present understanding of the potential scope of the claims that Nike appears to be advocating and should not be seen as Skechers' acquiescence to Nike's

interpretation of the patent claims. Skechers reserves the right to amend or supplement these contentions regarding anticipation or obviousness of the asserted claims based on further information from Nike, the Court, other courts or decision-makers in parallel proceedings, or any other source including any changes Nike makes to its Apparent Infringement Contentions, information discovered during discovery, arguments made and positions taken by Nike, or a claim construction ruling by the Court. Skechers reserves the right to amend or supplement these contentions to assert different support for each asserted limitation, to cite different portions of each reference in support of any invalidity theory, to assert different combinations, or to identify different references, as necessary. Nike has not identified what elements or combinations it alleges were not known to a POSITA. Therefore, for any claim limitation that Nike alleges is not disclosed in a particular prior art reference, Skechers reserves the right to assert that any such limitation is either inherent in the disclosed reference or obvious to a POSITA at the time in light of the same, or that the limitation is disclosed in another of the references disclosed above and, in combination, would have rendered the asserted claim obvious.

Each of these combinations was obvious to try for a POSITA. In the field of the '511 Patent, there was a design need or market pressure to solve a problem and there were a finite number of identified, predictable solutions. A POSITA had good reason to pursue the known options within his or her technical grasp including combinations of the disclosures in the accompanying claim charts. Each of these combinations is also the combination of familiar elements according to known methods and yields predictable results. In the field of the '511 Patent, a great deal of prior research and product designs were available and design incentives and other market forces would prompt variations of it. Further reasons to combine the references identified in the accompanying claim charts include the nature of the problem being solved, the express, implied, and inherent teachings of the prior art, and the knowledge of a POSITA that such combinations would have yielded

predictable results, and that such combinations would have represented known alternatives to a POSITA. For each combination, there is a teaching, suggestion, and motivation to combine both in the references to be combined themselves, as well as in the art generally that was known to a POSITA. In any event, each limitation of the '511 Patent is, and would have been at the time of the alleged invention, a simple design choice representing a predictable variation within the skill of a POSITA. Moreover, each limitation of the '511 Patent was well known in the art, including well-known to POSITAs.

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

No showing of a specific motivation to combine prior art is required to combine the references disclosed for any asserted patent in this document and in the attached charts, as each combination of art would have yielded expected results and at most would simply represent a known alternative to one of skill in the art. *See B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020) ("[W]e affirm the Board's conclusion that the challenged claims would have been obvious because modifying the Admitted Prior Art/Betts combination to include a second recess was nothing more than the predictable application of known technology."); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1344 (Fed. Cir. 2017); *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415 (2007) (rejecting the "rigid" application of the teaching, suggestion, or motivation to combine test, and instead applying an "expansive and flexible" approach). Indeed, the Supreme Court held that a POSITA is "a person of ordinary creativity, not an automaton" and "in many cases a POSITA will be able to fit the teachings of

multiple patents together like pieces of a puzzle." *KSR*, 550 U.S. at 420-21. Nevertheless, in addition to the information contained in the obviousness sections of this document and elsewhere in these contentions, Skechers hereby identify motivations and reasons to combine.

One or more combinations of the prior art references identified above would have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) ("It is simply a matter of common sense that the sleeve used in Down, in a towing attachment quite similar to a hitch receiver/tow bar arrangement, could be combined with a barbell-shaped hitch pin lock in order to address the known problem of different aperture sizes in standard hitch receivers and the shelf-space problem experienced by retailers."); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008) ("The asserted claims simply substitute a resistive electrical switch for the mechanical pressure switch employed by the Gopher Zapper," which "is a textbook case of when the asserted claims involve a combination of familiar elements according to known methods that does no more than yield predictable results." (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed. Cir. 2004) (affirming the district court's finding of "a motivation to combine because the two references address precisely the same problem of underpinning existing structural foundations" even though the record "does not feature an express written teaching in the art to make this combination"); *see also Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869 F.3d at 1344.

In addition, it would have been obvious to try combining the prior art references identified above because there were only a finite number of predictable

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

Additional evidence that there would have been a motivation to combine the prior art references identified above includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the '511 Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged inventions; and the background knowledge that would have been possessed by a POSITA. *See KSR*, 550 U.S. at 401 ("When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a

predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill."); *Arctic Cat Inc. v. Bombardier Recreational Prod. Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir. 2016); *Norgren Inc. v. Int'l Trade Comm'n*, 699 F.3d 1317, 1322-23 (Fed. Cir. 2012).

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

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

Skechers submits the following charts identifying specific locations in each alleged item of prior art where each limitation of each asserted claim is found as attached Exhibits 511-1 through 511-9. The contents of Exhibits 511-1 through 511-9, in combination with the foregoing patents, publications, and products, anticipate

and/or render obvious the '511 Asserted Claims under 35 U.S.C. § 102, either expressly or inherently, and under § 103, in each case, as understood by a POSITA.

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

D. Invalidity Under 35 U.S.C. § 112

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

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

The definiteness requirement requires that the claim must set forth what the applicant regards as the invention, and do so with sufficient particularity and definiteness. *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002). Where it would be apparent to one of skill in the art, based on the patent

specification, that the "invention" set forth in a claim is not what the patent applicant regarded as the invention, the claim is invalid. *Id.*

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

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

Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

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

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

The grounds identified below both individually and collectively render the '511 Asserted Claims invalid under the statutory requirements of § 112. By identifying certain claim language below, Skechers does not imply that such language is entitled to any patentable weight when comparing the claim as a whole to the prior art. Skechers' identifications are made based on Skechers' present understanding of the Asserted Claims and Nike's apparent interpretation of these claims as reflected in its Apparent Infringement Contentions, and Skechers reserves the right to amend these identifications, including in response to claim constructions and claim interpretations that would render claim limitations not enabled, lacking in written description, or indefinite.

a. Lack of Enablement And Written Description

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

- "a flat knit textile element comprising [] 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, 15)
- "a flat knit textile element comprising [] a first knit strip having a first property and a second knit strip having a second property that is different from the first property" (Claims 1, 15)
- "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" (Claims 1, 15)
- "one or both of the first knit strip and the second knit strip comprises a plurality of knit strips" (Claims 2
- "the first and second knit strips alternate with one another along one or more of the lateral side and the medial side of the upper" (Claim 3)
- "the flat knit textile element comprises at least two first knit strips and at least two second knit strips" (Claim 4)
- "the first knit strip and the second knit strip extend along the lateral side of the upper from an instep region of the upper to an area proximate to a lower region of the upper" (Claim 5)
- "the first knit strip and the second knit strip extend along the medial side of the upper from an instep region of the upper to an area proximate to a lower region of the upper" (Claim 6)
- "the first property comprises a first knit construction and the second property comprises a second knit construction" (Claim 7)
- "the first property of the first knit strip comprises a smooth texture, and the second property of the second knit strip comprises a rough texture" (Claim 8)
- "the first property of the first knit strip comprises a higher degree of stretch than the second property of the second knit strip" (Claim 10)

- "the second property of the second knit strip comprises a higher degree of stretch than the first property of the first knit strip" (Claim 11)
- "the first property comprises a first yarn type and the second property comprises a second yarn type" (Claim 12)
- "the first yarn type of the first knit strip comprises at least one of a higher biodegradability, moisture absorption, insulation, durability, and/or hydrophobicity than the second yarn type of the second knit strip" (Claim 13)
- "the first yarn type of the first knit strip comprises at least one of a higher strength, support, stiffness, recovery, fit and/or form than the second yarn type of the second knit strip" (Claim 14)
- "the first property comprises one or more of a first knit construction and a first yam type and wherein the second property comprises one or more of a first knit construction and a second yam type" (Claim 16)
- "the flat knit textile element comprises a plurality of first knit strips extending along the lateral side and the medial side of the upper and a plurality of second knit strips extending along the lateral side and the medial side of the upper" (Claim 17)
- "the first knit strip is parallel to the second knit strip" (Claim 18)
- "the first knit strip and the second knit strip extend along the lateral side of the upper from an instep region of the upper to an area proximate to the sole structure" (Claim 19)
- "the first knit strip and the second knit strip extend along the medial side of the upper from an instep region of the upper to an area proximate to the sole structure" (Claim 20)

These claim terms/phrases as apparently construed and/or interpreted by Nike violate the written description and/or enablement requirements of 35 U.S.C. § 112. Each asserted claim of the '511 Patent is invalid as not containing a written

description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the alleged invention. Moreover, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear lack written description because the specification of the '511 Patent demonstrates that the patentee neither conceived of nor demonstrated possession of all that Nike now contends the claims cover. In addition, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear are invalid because the specification fails to provide sufficient disclosure to enable any POSITA to which it pertains, or with which it is most nearly connected, to implement the invention without undue experimentation.

b. Indefiniteness

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

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

- "knit strip" (Claims 1-20)

Based on Skechers present understanding of Nike's Apparent Infringement Contentions, at least one or more of these claim terms/phrases are indefinite because they are inconsistent with and broader than the alleged invention disclosed in the specification and given Nike's apparent constructions of the claims, any POSITA at

the time of the invention would not understand what is claimed, even when the claims are read in light of the specification. To the extent that Nike ultimately asserts any terms in a manner that makes clear the scope of such terms would not be reasonably certain to a POSITA, Skechers reserves the right to seek a ruling that any such term is indefinite.

VIII. '781 PATENT

A. Prior Art References[15]

Skechers identifies the following prior art presently known to Skechers to anticipate the '781 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b), (e), and/or (g) or AIA 35 U.S.C. § 102, either expressly or inherently as understood by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers generally identifies and incorporates by reference herein all prior art and invalidity arguments previously asserted against the '781 Patent, whether during the original prosecution of the '781 Patent, before the Patent Trial and Appeals Board, or during any of the litigations filed by Nike involving the '781 Patent. In addition, discovery is outgoing, and Skechers has served document requests and interrogatories for which responses are outstanding that Skechers expects to reveal additional prior art. Furthermore, Skechers is generally aware of information pertaining to prior art from other proceedings that is currently unavailable to Skechers, including because such information may be subject to a protective order. Once Skechers receives relevant information, it will timely supplement its invalidity contentions, as appropriate.

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

1. Prior Art Patents and Publications[16]

Prior Art	Date of Issue or Publication
US 601,192	3/1898
US 761,520	5/1904
US 1,215,198	2/1917
US 1,597,934	8/1926
US 1,803,554	5/1931
US 1,841,518	l/1932
US 1,888,172	11/1932
US 1,902,780	3/1933
US RE18,804	4/1933
US 1,910,251	5/1933
US 1,956,969	5/1934
US 2,001,293	5/1935
US 2,047,724	7/1936
US 2,147,197	2/1939
US 2,150,730	3/1939
US 2,161,472	6/1939
US 2,178,941	11/1939
US 2,314,098	3/1943
US 2,330,199	9/1943
US 2,343,390	3/1944
US 2,400,692	5/1946
US 2,440,393	4/1949
US 2,467,237	4/1949
US 2,569,764	10/1951
US 2,586,045	2/1952

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

Prior Art	Date of Issue or Publication
US 2,598,217	5/1952
US 2,603,891	7/1952
US 2,608,078	8/1952
US 2,641,004	6/1953
US 2,675,631	4/1954
US 2,714,813	8/1955
US 2,770,055	11/1956
US 2,994,372	8/1961
US 3,114,213	12/1963
US 3,372,415	3/1968
US 3,497,971	3/1970
US 3,583,081	6/1971
US 3,694,940	10/1972
US 3,703,820	11/1972
US 3,704,474	12/1972
US 3,766,566	10/1973
US 3,769,723	11/1973
US 3,778,856	12/1973
US 3,835,555	9/1974
US 3,851,315	11/1974
US 3,863,272	2/1975
US 3,882,697	5/1975
US 3,937,039	2/1976
US 3,952,427	4/1976
US 3,972,086	8/1976
US 3,985,003	10/1976
US 4,027,402	6/1977
US 4,031,586	6/1977

Prior Art	Date of Issue or Publication
US 4,038,840	8/1977
US 4,057,981	11/1977
US 4,150,498	4/1979
US 4,151,662	5/1979
US 4,172,293	10/1979
US 4,183,156	1/1980
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US 4,430,811	2/1984
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US 4,447,967	5/1984
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US 4,494,266	1/1985
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US 4,624,115	11/1986
US 4,737,396	4/1988
US 4;750,339	6/1988
US 4,756,098	7/1988
US 4,785,558	11/1988
US 4,813,158	3/1989

Prior Art	Date of Issue or Publication
US 5,031,423	7/1991
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US 6,984,596	1/2006

Prior Art	Date of Issue or Publication
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US D517,297	3/2006
US 7,051,460	5/2006
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Circular Machines, International Standard, ISO 8117, Second Edition	2/2003
David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (3rd ed., Woodhead Publishing Ltd. 2001)	2001
Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth-Verlag GmnH 2002)	2002
Man-Made Fiber and Textile Dictionary	1981
Knitted Fabrics: Manufacture and Processing	1976
Bharat J. Gajjar, Warp Knit Fabrics Technologies	2007
J. Watel, The Milanese Machine: Little Progress Made in the Development of the Milanese Fabric	12/1921
Billy Hunter, Nike Flyknit: Quantum Leap for Flat Knitting	7/2012
Billy Hunter, Nike Flyknit: Ready, Steady, Go!	7/2012
R. Shishoo, Textiles in sport (Woodhead Publishing Ltd. 2005)	2005
Textile Machinery-Knitting Machines-Nominal Diameters of Circular Machines, International Standard, ISO 8117, Second Edition	2/2003
Manuals for Stoll Flat Knitting Machinery	No later than 3/3/2003
Hong, H., et al., *The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine*, India Journal of	9/1994

Prior Art	Date of Issue or Publication
Fibre and Textile Research, 1994, 19: 189-194	
Susanna E. Lewis et al., A Machine Knitter's Guide to Creating Fabrics	1986
Georga Tay, Fundamentals of Weft Knitted Fabrics	1996
Brandon Richard, Bargain Buys: 20 Sneaker Steals Found in Vintage Eastbay Catalogs, www.complex/com/sneakers/a/brandon-richard/vintage-eastbay-sneaker-prices	9/2015
Caroline Cox, Vintage Shoes (Carlton Books)	2008
1989 Reebok AXT SXT CXT Cross-Training Shoes Vintage Print Ad, www.ebay.com/itm/362604032836	1989
Nike Sneaker History, https://us.fatbuddhastore.com/nike-sneaker-history-i195	NA
Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
Louise Mitchell, Stepping Out: Three Centuries of Shoes (Powerhouse Publishing)	2008
Edna Nahshon, Jews and Shoes (Berg)	2008
Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
1989 Sears Style Catalog, https://christmas.musetechnical.com/ShowCatalogPage/1989-Sears-Style-Catalog/0183	1989
1990 Sears Style Catalog Volume 2, https://christmas.musetechnical.com/ShowCatalogPage/1990-Sears-Style-Catalog-Volume-2/0126	1990
June Swann, Shoes, The Costume Accessories	1986

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

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

2. Prior Art Products

Skechers also contends that the asserted claims of the ’781 Patent are invalid based on public knowledge and uses and/or offers for sale or sales of products that are prior art under 35 U.S.C. § 102(a) and/or (b); and/or prior inventions made in the United States by other inventors who had not abandoned, suppressed, or concealed them under pre-AIA 35 U.S.C. § 102(g); and/or that anticipate or render obvious under 35 U.S.C. § 103 the asserted claims.

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

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

Prior Art Product	Date of Public Use
	1995

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

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

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

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

rely on the prior art of record for any permissible purpose, including prior art discussed in the '562 Patent specification itself, including to show that the '781 Patent is anticipated or obvious, show the state of the art, show motivation to combine a reference with one or more other references, and to show the proper scope of the claims. Skechers may also rely on uncited portions of the prior art references, other disclosed publications, and the testimony of experts to establish that a POSITA would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

1. Anticipation

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

2. Obviousness

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

In addition, the references identified above render one or more asserted claims of the '781 Patent obvious when the references are read in combination with each other by a POSITA. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed

above may be combined to render obvious (and therefore invalid) each of Nike's asserted claims. Skechers may rely upon a subset of the above identified references or all of the references identified above for purposes of obviousness depending on the Court's claim construction, positions taken by Nike during this litigation, and further investigation and discovery. Skechers may rely on combinations with any reference in the attached claim charts and any of the other references disclosed herein with respect to the '781 Patent, including combinations with any of the patents, publications or products identified herein as prior art to the '781 Patent.

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

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

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

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

Each of these combinations was obvious to try for a POSITA. In the field of the '781 Patent, there was a design need or market pressure to solve a problem and there were a finite number of identified, predictable solutions. A POSITA had good reason to pursue the known options within his or her technical grasp including combinations of the disclosures in the accompanying claim charts. Each of these combinations is also the combination of familiar elements according to known methods and yields predictable results. In the field of the '781 Patent, a great deal of prior research and product designs were available and design incentives and other market forces would prompt variations of it. Further reasons to combine the

references identified in the accompanying claim charts include the nature of the problem being solved, the express, implied, and inherent teachings of the prior art, and the knowledge of a POSITA that such combinations would have yielded predictable results, and that such combinations would have represented known alternatives to a POSITA. For each combination, there is a teaching, suggestion, and motivation to combine both in the references to be combined themselves, as well as in the art generally that was known to a POSITA. In any event, each limitation of the '781 Patent is, and would have been at the time of the alleged invention, a simple design choice representing a predictable variation within the skill of a POSITA. Moreover, each limitation of the '781 Patent was well known in the art, including well-known to POSITAs.

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

No showing of a specific motivation to combine prior art is required to combine the references disclosed for any asserted patent in this document and in the attached charts, as each combination of art would have yielded expected results and at most would simply represent a known alternative to one of skill in the art. *See B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020) ("[W]e affirm the Board's conclusion that the challenged claims would have been obvious because modifying the Admitted Prior Art/Betts combination to include a second recess was nothing more than the predictable application of known technology."); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1344 (Fed. Cir. 2017); *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415 (2007) (rejecting the "rigid" application of the teaching, suggestion, or motivation to

combine test, and instead applying an "expansive and flexible" approach). Indeed, the Supreme Court held that a POSITA is "a person of ordinary creativity, not an automaton" and "in many cases a POSITA will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR*, 550 U.S. at 420-21. Nevertheless, in addition to the information contained in the obviousness sections of this document and elsewhere in these contentions, Skechers hereby identify motivations and reasons to combine.

One or more combinations of the prior art references identified above would have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241 (Fed. Cir. 2010) ("It is simply a matter of common sense that the sleeve used in Down, in a towing attachment quite similar to a hitch receiver/tow bar arrangement, could be combined with a barbell-shaped hitch pin lock in order to address the known problem of different aperture sizes in standard hitch receivers and the shelf-space problem experienced by retailers."); *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008) ("The asserted claims simply substitute a resistive electrical switch for the mechanical pressure switch employed by the Gopher Zapper," which "is a textbook case of when the asserted claims involve a combination of familiar elements according to known methods that does no more than yield predictable results." (citation omitted)); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276 (Fed. Cir. 2004) (affirming the district court's finding of "a motivation to combine because the two references address precisely the same problem of underpinning existing structural foundations" even though the record "does not feature an express written teaching in the art to make this combination"); *see also Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1350 (Fed. Cir. 2009); *Intercontinental Great Brands*, 869

F.3d at 1344.

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

Additional evidence that there would have been a motivation to combine the prior art references identified above includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the '781 Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged inventions; and the background knowledge that would have been possessed by a

POSITA. *See KSR*, 550 U.S. at 401 ("When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill."); *Arctic Cat Inc. v. Bombardier Recreational Prod. Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir. 2016); *Norgren Inc. v. Int'l Trade Comm'n*, 699 F.3d 1317, 1322-23 (Fed. Cir. 2012).

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

C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims

Skechers submits the following charts identifying specific locations in each

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

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

D. Invalidity Under 35 U.S.C. § 112

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

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

S. Ct. 2120, 2124 (2014).

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

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

Section 112 further includes a written description requirement: "The specification shall contain a written description of the invention[.]" Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35 U.S.C. § 112(a). "To satisfy the written description requirement, a patent applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *ICU Medical Inc. v. Alaris Medical Systems, Inc., 558 F.3d 1368, 1377 (Fed. Cir. 2009) (internal quotation marks and citations omitted); see also Synthes*

USA, LLC v. Spinal Kinetics, Inc., 734 F.3d 1332, 1340 (Fed. Cir. 2013). "The test [for written description support] requires an objective inquiry into the four corners of the specification from the perspective of a POSITA. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

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

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

The grounds identified below both individually and collectively render the '781 Asserted Claims invalid under the statutory requirements of § 112. By identifying certain claim language below, Skechers does not imply that such language is entitled to any patentable weight when comparing the claim as a whole to the prior art. Skechers' identifications are made based on Skechers' present understanding of the Asserted Claims and Nike's apparent interpretation of these claims as reflected in its Apparent Infringement Contentions, and Skechers reserves the right to amend these identifications, including in response to claim constructions and claim interpretations that would render claim limitations not enabled, lacking in written description, or indefinite.

a. Lack of Enablement And Written Description

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

- "a flat knit textile element having [] 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, 12)
- "the one or more ribs extending longitudinally comprises ribs spaced apart from an area adjacent an instep region of the upper to an area adjacent a lower region of the upper" (Claim 4)
- "the ribs are spaced apart at a uniform distance from the area adjacent the instep region to the area adjacent the lower region" (Claim 6)
- "the one or more ribs are adjacent one or more regions having a smooth texture" (Claim 7)
- "the one or more ribs comprise a plurality of ribs, at least one rib terminating in the heel region and at least one rib terminating in the midfoot region" (Claim 8)
- "the one or more ribs extending along the lateral side mirror the one or more ribs extending longitudinally along the medial side" (Claim 10)
- "the one or more ribs comprise ribs of varying lengths" (Claim 11)
- "the one or more ribs on the lateral side and the one or more ribs on the medial side extend from the forefoot region toward the heel region and terminate in one of the midfoot region or the heel region" (Claim 12)
- "the one or more ribs on the lateral side and the one or more ribs on the medial side each comprise ribs spaced apart from an area adjacent an instep region of the upper to an area adjacent a lower region of the upper"

(Claim 15)

- "the ribs are spaced apart at a uniform distance" (Claim 16)
- "the one or more ribs on the lateral side and the one or more ribs on the medial side are adjacent one or more regions having a smooth texture" (Claim 17)
- "at least the one or more ribs on the lateral side comprise a plurality of ribs, at least one rib terminating in the heel region and at least one rib terminating in the midfoot region" (Claim 18)
- "the one or more ribs on the lateral side and the one or more ribs on the medial side comprise ribs of varying lengths" (Claim 19)

These claim terms/phrases as apparently construed and/or interpreted by Nike violate the written description and/or enablement requirements of 35 U.S.C. § 112. Each asserted claim of the '781 Patent is invalid as not containing a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the alleged invention. Moreover, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear lack written description because the specification of the '562 Patent demonstrates that the patentee neither conceived of nor demonstrated possession of all that Nike now contends the claims cover. In addition, based on Skechers' present understanding of Nike's Apparent Infringement Contentions, each of the asserted claims in which these claim terms/phrases appear are invalid because the specification fails to provide sufficient disclosure to enable any POSITA to which it pertains, or with which it is most nearly connected, to implement the invention without undue experimentation.

b. Indefiniteness

Based on Skechers' present understanding of the '781 Asserted Claims and

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

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

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

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

IX. DOCUMENT PRODUCTION ACCOMPANYING PRELIMINARY INVALIDITY CONTENTIONS

Skechers is producing documents , including prior art in its possession referenced above, as well as well specifications and schematics sufficient to show elements of the accused products, including the following:

BegBates	EndBates
SKECHERS-9346-00000001	SKECHERS-9346-00041426
SKECHERS-9346-00041427	SKECHERS-9346-00043438
SKECHERS-9346-00043439	SKECHERS-9346-00051606

SKECHERS-9346-00054529	SKECHERS-9346-00054603
SKECHERS-9346-00055781	SKECHERS-9346-00055788
SKECHERS-9346-00055790	SKECHERS-9346-00059128
SKECHERS-9346-00059129	SKECHERS-9346-00059141
SKECHERS-9346-00059142	SKECHERS-9346-00059397
SKECHERS-9346-00059398	SKECHERS-9346-00059430
SKECHERS-9346-00059431	SKECHERS-9346-00059454

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

X. OTHER RESERVATIONS AND EXPLANATIONS

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

For prior art patents and prior art publications identified in these Preliminary Invalidity Contentions, Skechers reserves the right to rely on the public use, offer for sale, sale, and/or actual products embodying the features described therein uncovered during discovery. Skechers also reserves the right to rely on any related patents and patent applications, foreign patent counterparts and foreign patent applications of U.S. patents identified in these Preliminary Invalidity Contentions, and U.S. counterparts of foreign patents and foreign patent applications identified in

these Preliminary Invalidity Contentions.

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

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

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

Skechers may rely on Nike's or any inventor's admissions concerning the scope of prior art relevant to the Asserted Patents; the patent prosecution histories for the Asserted Patents (including any history arising from any IPR proceedings); any deposition testimony of the named inventors on the Asserted Patents; and the papers filed and any evidence submitted by Nike in connection with this litigation or

any IPR proceedings. For example, Skechers reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 101 or pre-AIA 35 U.S.C. § 102(f) and/or in the event that Skechers obtains evidence that the named inventors did not invent (either alone or in conjunction with others) the subject matter claimed in the Asserted Patents. Should Skechers obtain such evidence, they will provide the name(s) of the person(s) from whom and the circumstances under which the claimed invention or any part of it was derived. Similarly, Skechers reserves the right to right to assert that the Asserted Claims are invalid under pre-AIA 35 U.S.C. § 102(d) or § 102(e) in the event that Skechers obtains evidence establishing that one or more of the claimed inventions in the Asserted Claims was patented, caused to patented, or subject to an inventor certificate meeting the provisions of § 102(d) or was described in a patent or patent application meeting the provisions of § 102(e).

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

Additionally, because third-party discovery has not yet begun, Skechers reserves the right to present additional items of prior art under 35 U.S.C. § 102 and/or § 103, located during the course of such discovery or further investigation, and to assert invalidity under pre-AIA 35 U.S.C. §§ 102(c), (d), or (f), to the extent

that such discovery or investigation yields information forming the basis for such invalidity. For example, Skechers may issue subpoenas to, and receive information from, third parties believed to have knowledge, documentation, and/or corroborating evidence concerning some of the prior art listed below and/or additional prior art. These third parties include, without limitation, the authors, inventors, vendors, or assignees of the references listed in these disclosures.

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

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

Skechers further incorporates in these Preliminary Invalidity Contentions, in full, the invalidity contentions, accompanying charts, cited prior art, and supporting declarations and testimony asserted by adidas, lululemon, Puma, and New Balance in the following actions: the adidas Litigation, the adidas ITC Investigation, the Puma Litigation, the lululemon Litigation (including, *e.g.*, NIKE-SKX_0656342-_0657108), and the New Balance Litigation. Skechers also incorporates, in full, the petitions, prior art identified in the petitions, accompanying charts, and supporting declarations and testimony from the *inter partes* reviews filed by adidas, lululemon, and New Balance with respect to the '749 and '484 Patents (*e.g.*, IPR2016-00922, IPR2023-01460, IPR2024-00460, and IPR2024-00778), as well as the *inter partes* reviews to be filed by Skechers and New Balance with respect to all of the Asserted Patents.

Dated: May 17, 2024 Respectfully submitted,

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PROOF OF SERVICE

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

On May 17, 2024, I served the foregoing document described as SKECHERS U.S.A., INC.'S SUPPLEMENTAL PRELIMINARY INVALIDITY CONTENTIONS on each interested party, as follows:

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

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

Executed on May 17, 2024, at Los Angeles, California.

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

Jim I. Manzano (JManzano@irell.com)	*/s/ Jim Manzano*
(Type or print name)	(Signature)