

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKECHERS U.S.A., INC.,

Petitioner,

v.

NIKE, INC.,

Patent Owner.

Case IPR2025-00151

Patent No. 9,510,636

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBITS

Exhibit No.	Description
2001	File History of U.S. Patent No. 9,510,636
2002	Carly Fink, Nike: Sustainability and Innovation through Flyknit Technology, N.Y.U. STERN CTR. FOR SUSTAINABLE BUS. (August 2016), available at: https://www.stern.nyu.edu/sites/default/files/assets/documents/Nike_Carly_04.2017%20-%20Copy.pdf
2003	Skechers' Supplemental Preliminary Invalidity Contentions Pleading (May 17, 2024)
2004	Skechers' Supplemental Ex. 636-1 Skechers' '636 Patent Invalidity Claim Chart – Glidden (May 17, 2024)
2005	Skechers' Supplemental Ex. 636-5 Skechers' '636 Patent Invalidity Claim Chart – Clark (May 17, 2024)
2006	Skechers' Supplemental Ex. 636-2 Skechers' '636 Patent Invalidity Claim Chart – Dua-956 (May 17, 2024)
2007	Skechers' Supplemental Ex. 636-6 Skechers' '636 Patent Invalidity Claim Chart – Horii (May 17, 2024)
2008	Skechers' Supplemental Ex. 636-8 Skechers' '636 Patent Invalidity Claim Chart – Dua-592 (May 17, 2024)
2009	RESERVED
2010	U.S. Patent No. 2,147,197 (“Glidden”)
2011	U.S. Patent No. 2,440,393 (“Clark”)
2012	Email from L. Oxenford to M. Wilk, November 13, 2024
2013	Skechers' Supplemental Claim Construction Brief (September 30, 2024)
2014	Nike's Supplemental Claim Construction Brief (September 30, 2024)
2015	Skechers' Preliminary Invalidity Contentions Pleading (April 19, 2024)

2016	Nike's Supplemental Infringement Contentions for the '636 Patent (October 23, 2024)
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I. INTRODUCTION

Patent Owner Nike, Inc. (“Nike”) submits this Preliminary Response to the Petition of Skechers U.S.A., Inc. (“Skechers” or “Petitioner”) challenging the patentability of Claims 1-27 (the “Challenged Claims”) of U.S. Patent No. 9,510,636 (the “’636 Patent”; Ex. 1001).

The article of footwear encompassed by the claims of the ’636 Patent has been hailed as “the most groundbreaking sneaker innovation in over 40 years.” Ex.2002¹, 3. The ’636 Patent is generally directed to an article of footwear that incorporates a knitted component having an upper and an integral knit tongue, wherein the integral knit tongue is formed of unitary knit construction with the upper and extends through the throat area of the knitted component. The ’636 Patent has three independent claims (1, 13, 21) and twenty-four dependent claims. The claims generally recite an article of footwear comprising a knitted component defining the upper, an integral knit tongue formed with the upper, and a raised element extending a height above the exterior surface of the knitted component. *See generally* ’636 Patent.

¹ Carly Fink, Nike: Sustainability and Innovation through Flyknit Technology, N.Y.U. STERN CTR. FOR SUSTAINABLE BUS. (August 2016), available at: https://www.stern.nyu.edu/sites/default/files/assets/documents/Nike_Carly_04.2017%20-%20Copy.pdf.

The Board should deny institution for at least three independent reasons.

First, Petitioner’s key asserted references, Dua-956 (Ex.1029) and Dua-952 (Ex.1014), were considered by the ’636 Examiner during the prosecution of the ’636 Patent. All of Petitioner’s other secondary references are cumulative of other art that was considered during prosecution. These facts independently warrant discretionary denial under 35 U.S.C. §325(d).

Second, Petitioner’s strategic delay in filing the Petition prejudices Nike and wastes judicial resources by ensuring that the validity of the ’636 Patent will be litigated simultaneously in two separate fora—before the Board and in district court. Indeed, the parties have been litigating an infringement action in the United States District Court for the Central District of California for more than a year. Petitioner’s delay wastes party and Board resources and prejudices Patent Owner by forcing it to defend against serial challenges while simultaneously defending the validity of the ’636 Patent in two fora, leading to potentially inconsistent decisions on the same issues. These circumstances favor discretionary denial, which is further justified under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, *2-3 (P.T.A.B. Mar. 20, 2020) (precedential) (“Fintiv”).

Third, the Board should deny institution because Petitioner has failed to meet its threshold burden under 35 U.S.C. §§314(a) and 312(a)(3) to show that there is a reasonable likelihood that at least one of the challenged claims of the ’636 Patent is

unpatentable. Skechers has not established a reasonable likelihood that it will prevail for any claim in any ground raised in the Petition. Skechers relies on inaccurate claim constructions, the cobbling together several combinations of references without explaining any motivation to combine them, and impermissible hindsight bias to argue that the challenged claims are anticipated and obvious. Importantly, Skechers fails to disclose any reference or combination of references that disclose, teach, or suggest an article of footwear having a knitted upper and an integral knit tongue. This further favors denial of institution.

Skechers presents six grounds of invalidity. Four grounds—Grounds 1A, 1B, 1C, and 2A—challenge the independent claims. Ground 1A advances an anticipation theory based on U.S. Patent No. 7,774,956 (“Dua-956”; Ex.1029), which was cited in an IDS and considered by the Examiner during prosecution. Grounds 1B, 1C, and 1D address the shortcomings in Dua-956 by alleging obviousness based on Dua-956 alone or in view of secondary references (1) Japanese Application Publication No. H3-3203 (“Horii”; Ex.1017; Ex.1031), (2) U.S. Patent No. 7,552,547 (“Calderone”; Ex.1018), and/or (3) International Patent Publication No. WO 98/43509 (“McDonald”; Ex.1016). The remaining two grounds—Grounds 2A and 2B—advance obviousness theories based upon U.S. Patent Application No. 2005/0193592 (“Dua-592”; Ex.1014) in view of (1) Calderone, (2) McDonald,

and/or (3) Horii. Dua-592 was also cited in an IDS and considered by the Examiner during prosecution.

Skechers' Petition is precisely what Congress sought to prevent when it enacted 35 U.S.C. §325(d). *See In re Vivint, Inc.*, 14 F.4th 1342 at 1346 (Fed. Cir. 2021). The Patent Office already considered both primary prior art references presented in Skechers' Petition, and considered art that was substantially the same as the asserted secondary references. Simply put: nothing in Skechers' petition presents a new question of patentability. The Board should also deny institution because this procedure needlessly wastes the Board's resources in view of the ongoing parallel District Court litigation, where the parties have spent much time and effort engaging in substantial written and document discovery and fully briefing and arguing claim construction.

Lastly, the Board should deny institution because Skechers has not shown a reasonable likelihood of prevailing on any of its six grounds. Dua-956 does not anticipate independent claims 1, 13, and 21 (Ground 1A) because it does not disclose a "knitted component defining the upper" or "integral knit tongue" as recited in claims 1, 13, and 21. The additions of Horii, Calderone, and McDonald (Grounds 1B-1D) do not fill this void. Indeed, Skechers engages in impermissible hindsight bias and uses Nike's invention as a template for its own reconstruction. Petitioner's grounds based on Dua-592 (Grounds 2A and 2B) fare no better. These grounds

entirely lack a motivation to combine Dua-592 and Calderone to arrive at the claimed invention.

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

II. THE '636 PATENT

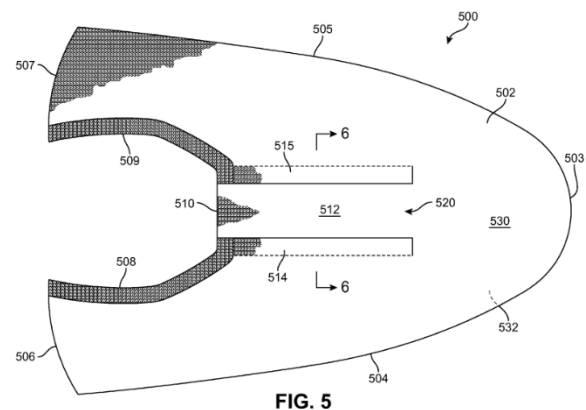
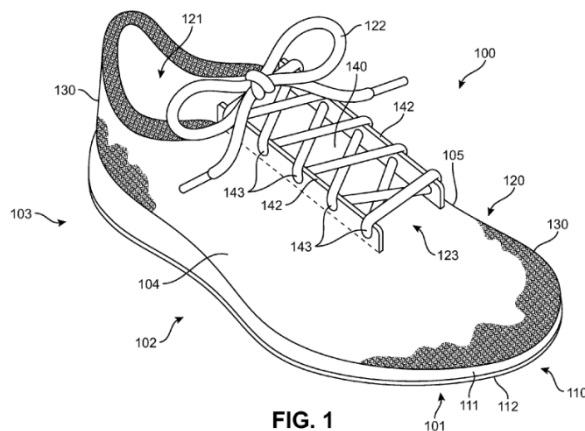
A. Overview of the '636 Patent

The '636 Patent lists Bhupesh Dua, Bruce Huffa, Adrian Meir, and Benjamin A. Shaffer as inventors. The '636 Patent claims priority back to U.S. Patent Application No. 13/400,511, filed February 20, 2012 (now U.S. Patent No. 8,448,474; “the '474 Patent”).

The '636 Patent relates to an article of footwear that incorporates a knitted component and an integral knit tongue. Specifically, the '636 Patent recites an article of footwear wherein a majority of the upper is formed from a knitted component. Ex.1001, 6:57-59. The knitted component extends through the forefoot region, midfoot region, and heel region, along both the lateral and medial side, over the forefoot region, and around a heel region. *Id.*, 6:59-62. Additionally, the knitted component forms portions of both an exterior surface and an opposite interior surface of the upper, which defines a void for receiving a foot. *Id.*, 6:62-65; *see also* Fig. 1. The integral knit tongue is formed of unitary knit construction with the upper and extends through the throat area of the upper between the lateral and medial sides.

Id., 6:35-38. The integral knit tongue incorporates raised elements providing lace apertures for a lacing system. *Id.*, 2:36-38.

The claimed article of footwear offers many advantages over conventional footwear. For example, “[b]y decreasing the number of material elements used in the upper, ... waste may be decreased while increasing the manufacturing efficiency and recyclability of the upper.” Ex.1001, 2:17-19, 7:13-46.



Figures 1 and 5 of the '636 Patent

Figure 1 (reproduced above) shows an example of an article of footwear with a knitted component and integral knit tongue. Figure 5 (reproduced above) shows an example of a knitted component with an integral knit tongue formed of unitary knit construction. Ex.1001, 7:58-66.

B. Relevant File History

The Patent Office has already considered both primary references now presented in Skechers' Petition. The Examiner considered Dua-956 and Dua-592 in an Information Disclosure Statement ("IDS"). *See* Petition at 123 (admitting Dua-956 and Dua-592 are cited on the face of the '636 Patent). And the Patent Office considered the art cumulative of Skechers' secondary references. *See* §IV.A.2, *infra*.

During original prosecution of the '636 Patent, the Examiner rejected then-pending claims 1-4, 8, 9, 13-16, 19, and 20 for (1) nonstatutory double patenting as being unpatentable over U.S. Patent No. 8,621,891 (claims 1-3, 13-15, 18-26), (2) anticipation by U.S. Patent Application Publication No. 2005/0115284 (claims 1, 3, 4, 8, 9, 13, 15, 16, 19, 20), and (3) anticipation by U.S. Patent No. 1,888,172. Ex.2001², 1795-1801. The Examiner objected to then-pending claims 5-7, 10-12, 17, 18, and 21-27 because they were dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *Id.*, 1800.

In response to the rejection, Nike amended independent Claim 1 to recite a knitted component comprising "at least one raised element extending a height above the exterior surface of the knitted component," and Claim 13 to recite a knitted

² File History of U.S. Patent No. 9,510,636.

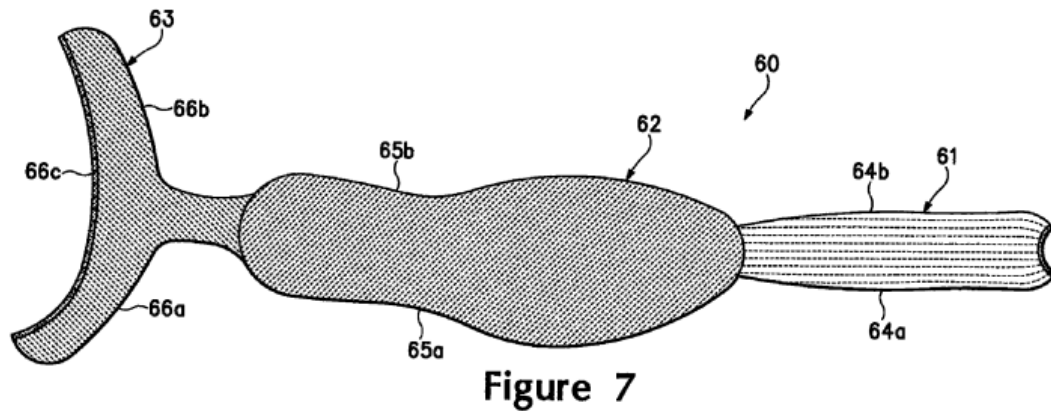
component with “at least one raised element having at least one lace aperture configured to receive a lace.” Ex.2001, 1843-1851. These amendments were added to include elements that were found in the objected-to but allowable Claims 5 and 6, respectively. *Id.*, 1849-1850. The Examiner subsequently allowed the claims without further action. *Id.*, 1856. Nike filed a Request for Continued Examination in order to submit an additional IDS. *Id.*, 1867-1881. The Examiner considered the IDS and issued another Notice of Allowance. *Id.*, 2299-2307. The ’636 Patent issued on November 16, 2016.

III. Alleged Prior Art References

A. Dua-956

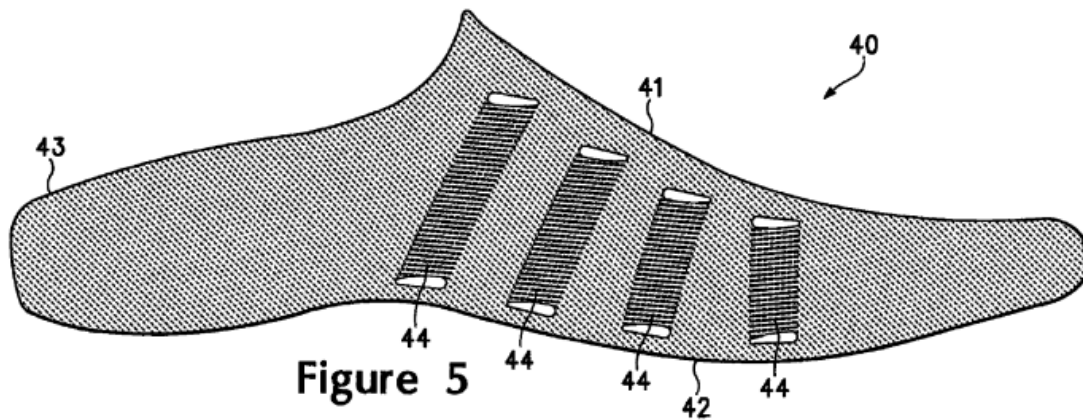
U.S. Patent No. 7,774,956 (“Dua-956”; Ex.1029) is titled “Article of Footwear Having a Flat Knit Upper Construction or Other Upper Construction” and issued on August 17, 2010. During prosecution of the ’636 Patent, the Examiner considered Dua-956 after Nike included it in an IDS. Ex.2001, 100, 1815.

Dua-956 is generally directed to articles of footwear with components of uppers that are “at least partially formed from a material produced through a flat knitting process.” Ex.1029, 4:7-10. Dua-956 discloses that “central textile element 60 forms portions of upper 30 extending under the foot, over forward portions of the foot, and around the heel of the foot.” *Id.* at 5:59-62. Central element 60 is shown in Figure 7, reproduced below:

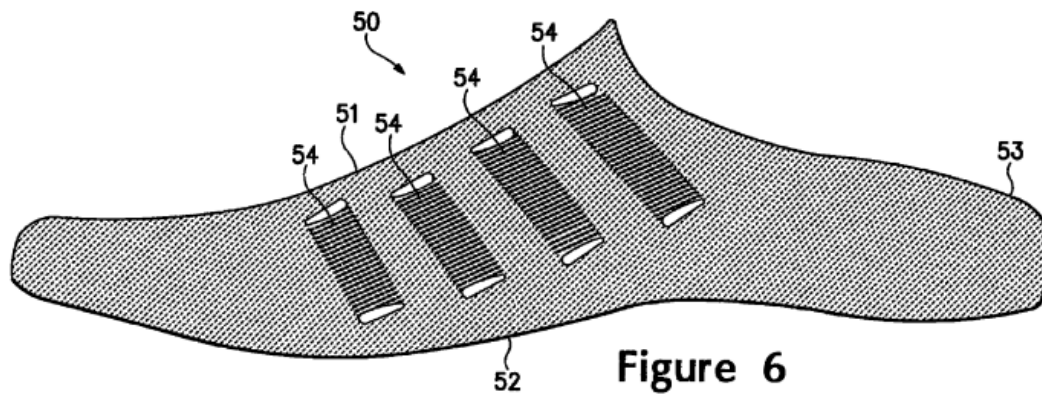


Ex.1029, Fig. 7.

Dua-956 is not directed to an upper of unitary knit construction with an integral knit tongue. The upper is “substantially assembled” by joining the edges of separately knitted textile elements 40, 50, and 60 together in the shape of the upper. Ex.1029, 5:65-67. Lateral textile element 40, medial textile element 50, and central textile element 60 are each separately knitted through a flat knitting process. *Id.*, 6:15-19, 6:31-33, 6:46-49. Lateral textile element 40 and medial textile element 50 are shown in Figures 5 and 6, respectively:



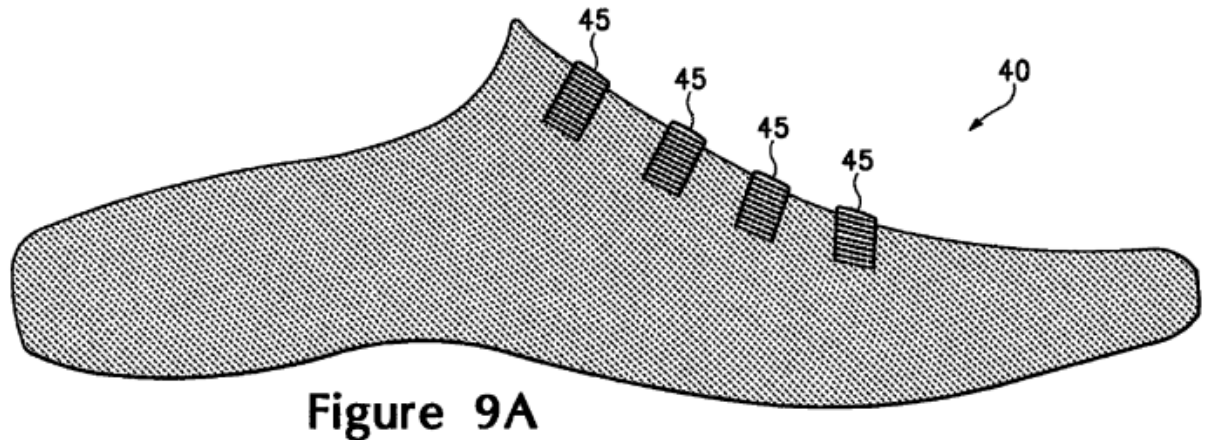
Ex.1029, Fig. 5.



Ex.1029, Fig. 6.

“[U]pper 30 is formed from three separate textile elements 40, 50, and 60 that are joined through stitching... .” Ex.1029, 11:1-2; *see also id.* at 8:44-65. The assembly process is generally depicted in Figures 8A-8E.

Dua-956 describes several additional embodiments of footwear. In one configuration, lace loops 45 are added to lateral textile element 40, as shown in Figure 9A (reproduced below):



Ex.1029, Fig. 9A; *see also id.*, 9:29-45. In another embodiment, pocket 46 replaces channels 44 and lace elements 33. *Id.* at 9:46-57. Pocket 46 is intended to store small items such as a key, identification, or change. *Id.*; *see generally* Fig. 9B.

In yet another embodiment, an upper 70 includes a central portion 71, a pair of side portions 72, and eight lace loops 73. Ex.1029, 9:58-61. Side portions 72 each include a side edge 74, a rear edge 75, and a central edge 76. *Id.*, 9:61-63. When assembled into an article of footwear, side central portion 71 extends over the foot and side portions 72 wrap under it. *Id.*, 9:63-65. Side portions 72 are relatively flat in configuration and are non-ribbed, while central portion 71 has a domed shape

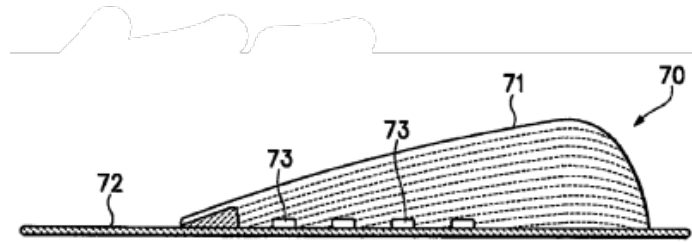


Figure 10C

Id., Fig. 10C.

In another embodiment, “[u]pper 30’ includes a foot-receiving portion 31’ and a pair of straps 32’ that extend outward from sides of foot-receiving portion 31’. Foot-receiving portion 31’ has the general configuration of a sock that is formed of unitary (i.e., one piece) construction by the flat knitting process.” Ex.1029, 10:31-35. This embodiment is depicted in Figure 11A, reproduced below:

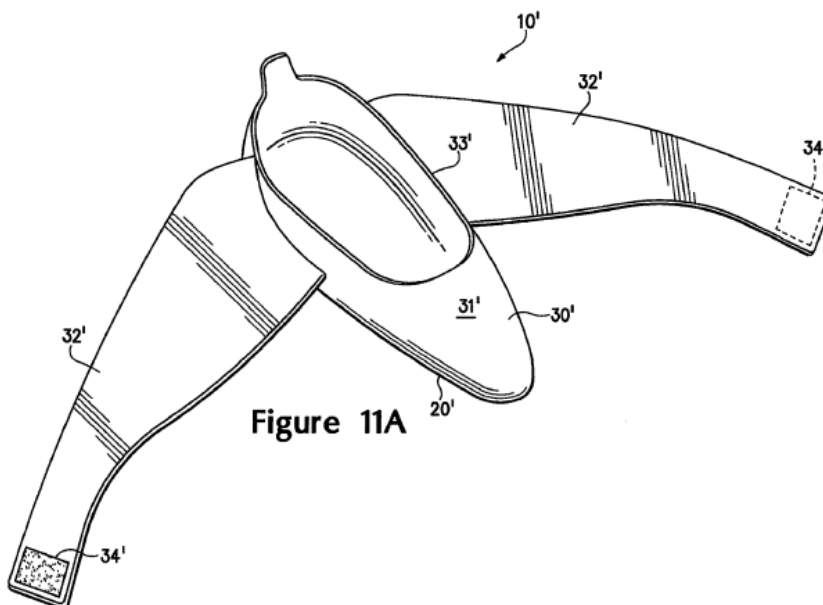


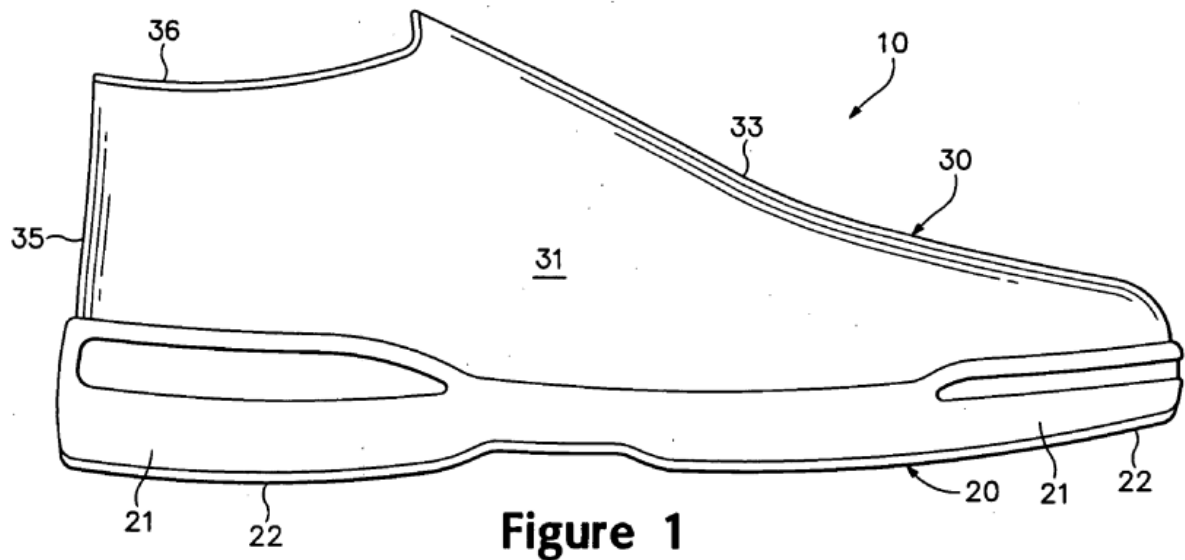
Figure 11A

Ex.1029, Fig. 11A. Dua-956 discloses two additional embodiments with straps. *Id.*, Figs. 12-13. The footwear structures in the embodiments depicted in Figures 11A through 13 are illustrated as ballet or yoga type footwear. *Id.*, 12:6-8.

B. Dua-592

U.S. Patent Application No. 2005/0193592 (“Dua-592”; Ex.1014) is titled “Article of Footwear Having a Textile Upper” and was published on September 8, 2005. During prosecution of the ’636 Patent, the Examiner considered Dua-592 after Nike included Dua-592 in an IDS. Ex.2001, 102, 1817.

Dua-592 describes an article of footwear incorporating a textile element formed with a knitting machine. Ex.1014, [0013]. It does not describe an article of footwear with an upper of unitary knit construction and an integral knit tongue. The article of footwear has an upper that incorporates the textile element. *Id.*, [0015]. Footwear 10 contains a sole structure 20 and an upper 30. *Id.*, [0033]. Upper 30 is at least partially formed by a textile element, which may or may not form substantially all of upper 30. *Id.* Upper 30 has a lateral region 31, an opposite medial region 32, an instep region 33, a lower region 34, and a heel region 35. *Id.*, [0035]. Upper 30 may also include laces or other elements associated with a conventional upper for footwear. *Id.*, [0037]. An embodiment of the article of footwear disclosed in Dua-592 is shown in Figure 1, which is reproduced below:



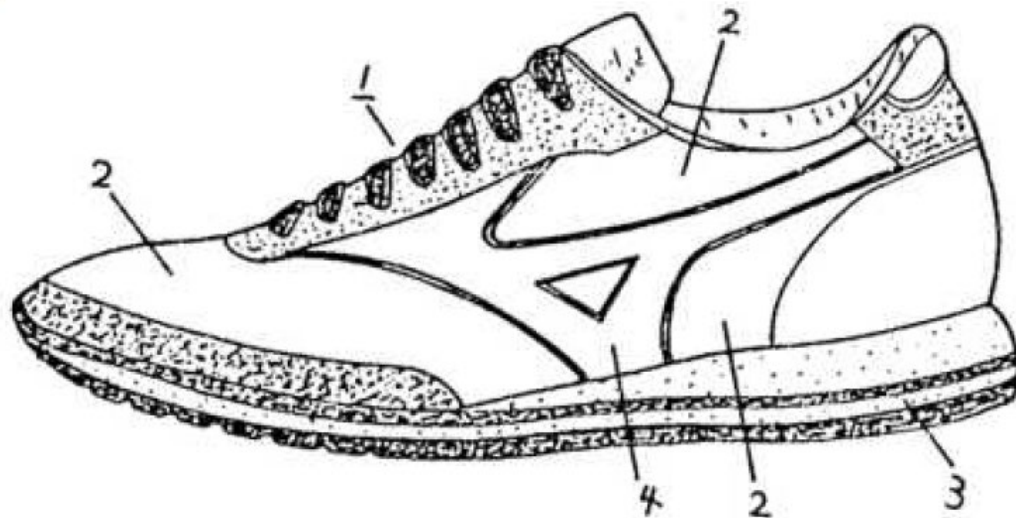
Ex.1014, Fig. 1.

C. Horii

Japanese Application Publication No. H3-3203 (“Horii”; Ex.1017; Ex.1031) is titled “Shoes” and published on January 14, 1991.

Horii is directed to a conventional article of footwear “with an upper made of an upper member that has good breathability, moderate hardness, and cushioning for the shoe....” Ex.1031, 25. “Upper member 2” of the upper is formed using a flat or circular knitting machine. *Id.*, 26. The embodiment described in Horii is disclosed in Figure 1, which is reproduced below:

Figure 1



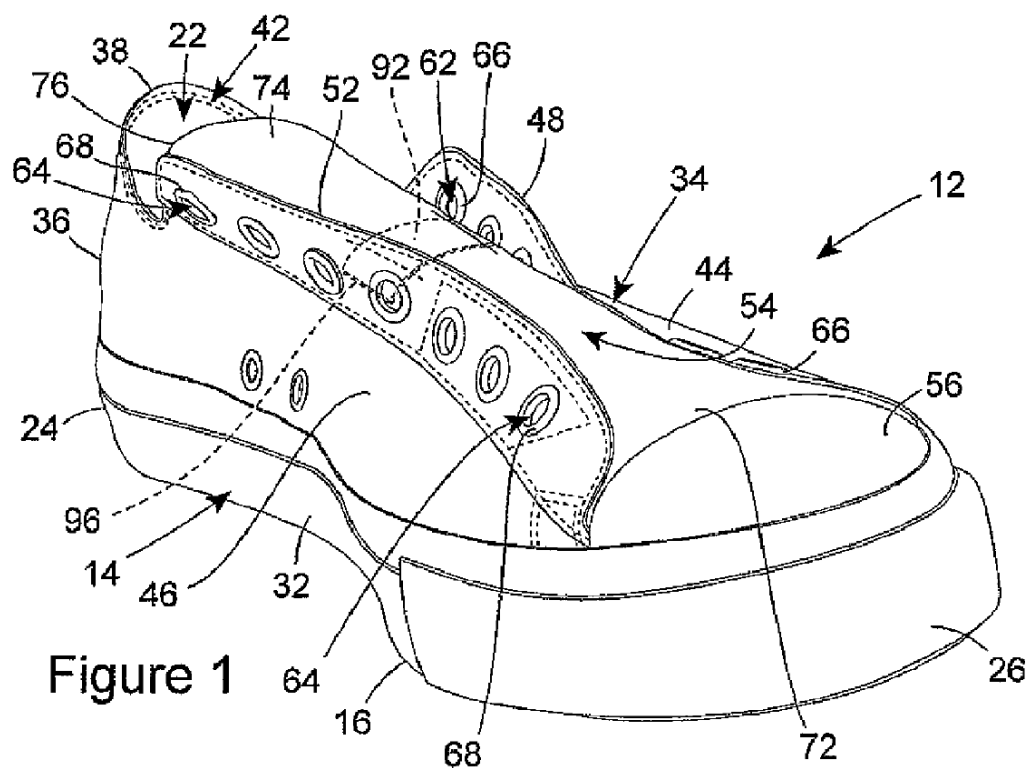
Ex.1031, Fig. 1.

D. Calderone

U.S. Patent No. 7,624,518 (“Calderone”; Ex.1018) is titled “Slip On Athleisure Shoe” and issued on December 1, 2009.

Calderone describes a conventional “oxford type, lace up athleisure shoe” that “enables the shoe to be slipped on the wearers foot and held securely on the foot without the need for lacing on the shoe,” “provid[ing] the shoe with the appearance of a lace up shoe that is worn without lacing.” Ex.1018, Abstract; *see also id.*, 1:15-20. The shoe described in Calderone “has the basic construction of an oxford lace up basketball shoe.” *Id.*, 2:19-21. The shoe upper 34 “is constructed of a flexible material, for example leather or fabric.” *Id.*, 2:45-46. The invention described in Calderone “overcomes the problem of wearing oxford lace up basketball shoes

without lacing,” where the “lacing openings or eyelet openings on the shoe are left open, with there being no lacing on the shoe.” *Id.*, 1:45-47. Instead of having laces, “[t]he shoe is modified with a band that is connected to the left side and the right side of the shoe upper and extends across the shoe forefoot opening.” *Id.*, 1:48-50. The embodiment described in Calderone is depicted in Figure 1, reproduced below:



Ex.1018, Fig. 1.

As shown, lacing openings 62 and 64 are provided on the upper left side 44 and the upper right side 46. *Id.*, 3:5-6. “[I]n the preferred embodiment of the invention, the lacing openings 62, 64 are provided by pluralities of eyelets or grommets 66, 68 on the upper left side 44 and the upper right side 46. The eyelets

66, 68 provide the desired lace up shoe appearance. The eyelet lacing openings 62, 68 are arranged in lines along the upper left side edge 48 and along the upper right side edge 52.” *Id.*, 3:12-18. “The novel features of the invention provide the lacing openings 62, 64 on the shoe 12, with there being no lacing positioned in the lacing openings.” *Id.*, 3:23-25.

E. McDonald

International Patent Publication No. WO 98/43509 (“McDonald”; Ex.1016) is titled “Engineered Textile” and was published on October 8, 1998.

McDonald describes a “lightweight, strong, durable engineered textile for use in a shoe upper and other applications....” Ex.1016, Abstract. According to McDonald, “[a]n engineered textile is a textile that is woven or computer stitched to serve a specific function in an item.” *Id.*, 4:32-34. McDonald discloses that [a] tongue 14 may be included, and be made of the material 1.” *Id.*, 10:14-16. Alternatively, McDonald discloses “eliminat[ing] a tongue” in its entirety. *Id.*, 10:16-19; *see also id.*, 12:7-11 (“The stretching characteristics of the textile permit a more even fit across the foot, and allow an upper design that eliminates the tongue normally associated with conventional shoes.”). McDonald further teaches that “the textile layer or layers forming upper 11 could be formed in sections and attached together by any number of other techniques such as sewing.” *Id.*, 13:9-12.

IV. DEFINITION OF A PERSON OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Nike applies Skechers' proposed level of skill in the art: a POSITA for the '636 Patent would have had at least a few years' experience in knit materials and knitting methods and machines that can be used to make footwear, or a bachelor's degree in textile-related sciences, engineering, or industrial product design, or equivalent work or academic experience, including in the footwear industry. Petition, 17-18. For individuals with a lower educational background, a person could still be of ordinary skill in the art provided that person's working experience compensates for any such lower educational level, or *vice versa*. *Id.*, 18. Nike reserves the right to further address Skechers' formulation of a POSITA if trial is instituted.

V. CLAIM CONSTRUCTION

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

For purposes of this IPR, Nike contends that no terms require construction. All terms and phrases in the '636 Patent claims have their ordinary and customary meanings, which are readily apparent, and no further construction is required.

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

The Board should exercise its discretion to deny institution of all Grounds under 35 U.S.C. §325(d) because Petitioner relies on the same or substantially the same art that was considered by the Examiner during prosecution of the '636 Patent, and fails to show that the Examiner made any error material to the patentability of the Challenged Claims.

The Board applies a two-part framework to analyze discretionary denial under §325(d): “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, 2020 WL 740292, *3–4 (P.T.A.B. Feb. 13, 2020) (precedential), citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential as to §III.C.5, first paragraph).

A. The Examiner Considered the Same or Substantially the Same Art During Prosecution (*Becton, Dickinson* Factors (a), (b), and (d))

As Petitioner admits, both of the primary references relied upon in its Grounds are cited on the face of the '636 Patent. Petition, 123. Petitioner's three remaining secondary references are substantially the same as other references considered by the Examiner during prosecution. These facts, which the Petition elides, satisfy step one of the *Advanced Bionics* framework.

1. Dua-956 and Dua-592 were squarely before the Examiner

Each of Petitioner's asserted grounds rely on either Dua-956 (Ground 1) or Dua-592 (Ground 2), either alone or in combination with other secondary references. But the Examiner considered both in their entirety during the prosecution of the '636 Patent.

Dua-956 appears on the face of the '636 Patent. Ex.1001, 2. Patent Owner cited it on an IDS on May 9, 2013, and the Examiner marked the reference "considered" on October 8, 2015. Ex.2001, 100, 1815. Likewise, Dua-592 also appears on the face of the '636 Patent, was cited in the same IDS as Dua-956, and was marked "considered" in the same transmission from the Examiner. Ex.1001, 2; Ex.2001, 102, 1817. "[P]reviously presented art includes art made of record ... such as on an [IDS]." *See, e.g., Biocon Pharma Ltd. v. Novartis Pharms. Corp.*, IPR2020-01263, 2021 WL 608300, at *4 (Feb. 16, 2021) (citing *Advanced Bionics*, 2020 WL 740292, at *3)15; *see also Philip Morris Prods., S.A. v. Rai Strategic Holdings, Inc.*,

IPR2020-00921, 2020 WL 6750120, at *5 (Nov. 16, 2020); *Mylan Pharms. Inc. v. Merck Sharp & Dohme Corp.*, IPR2020-00040, 2020 WL 2478503, at *6 (May 12, 2020). Thus, Dua-956 and Dua-592 were previously presented to and considered by the Office.

2. The Examiner considered art cumulative of the secondary references

Petitioner's secondary references are cumulative of art considered by the Examiner. While the Examiner did not consider Horii, McDonald, or Calderone during prosecution, these references "teach[] no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO." *Regeneron Pharms., Inc. v. Merus N.V.*, 864 F.3d 1343, 1350 (Fed. Cir. 2017) (quoting *Regents of the Univ. of Calif. v. Eli Lilly & Co.*, 119 F.3d 1559, 1575 (Fed. Cir. 1997)). Petitioner merely swaps-in these three similar references and points to features in the art already before the Examiner during the prosecution of the '636 Patent. *See Siemens Mobility, Inc. v. Metrom Rail, LLC*, 2024 WL 4827396, 2024 WL 4827396, *7 (P.T.A.B. Nov. 19, 2024) (denying institution under §325(d)).

In its district court invalidity claim charts, Petitioner asserts four references that were previously considered by the Patent Office: Glidden, Clark, Dua-956, and

Dua-592. Ex.2003³; *see also* Ex.2004⁴; Ex.2005⁵; Ex.2006⁶; Ex.2007⁷; Ex.2008⁸.

The Patent Office already considered Glidden, Clark, Dua-956, and Dua-592 after Nike included each reference in an IDS. Ex.2001, 96, 100, 102, 174, 1811, 1815, 1817, 1836. All four previously asserted references—like the references Petitioner now asserts in its Petition—are directed to conventional footwear. Ex. 2010⁹, 1:1–4

³ Skechers’ Supplemental Preliminary Invalidity Contentions Pleading (May 17, 2024).

⁴ Skechers’ Supplemental Ex. 636-1 Skechers’ ’636 Patent Invalidity Claim Chart – Glidden (May 17, 2024).

⁵ Skechers’ Supplemental Ex. 636-5 Skechers’ ’636 Patent Invalidity Claim Chart – Clark (May 17, 2024).

⁶ Skechers’ Supplemental Ex. 636-2 Skechers’ ’636 Patent Invalidity Claim Chart – Dua-956 (May 17, 2024).

⁷ Skechers’ Supplemental Ex. 636-6 Skechers’ ’636 Patent Invalidity Claim Chart – Horii (May 17, 2024).

⁸ Skechers’ Supplemental Ex. 636-8 Skechers’ ’636 Patent Invalidity Claim Chart – Dua-592 (May 17, 2024).

⁹ U.S. Patent No. 2,147,197 (“Glidden”).

("[invention] relates to articles of footwear and to methods of making the same"); Ex.2011¹⁰, 1:1–3 ("[invention] relates primarily to shoemaking and consists in a novel process of making textile material a last-fitting upper"); Ex.1029, 5:65-67 (directed to an upper of an article of footwear); Ex.1014 at [Abstract] (directed to "[a]n article of footwear and a method of manufacturing the article of footwear.").

Petitioner tacitly admits—through the claim-by-claim assertions in its district court invalidity contentions—that the teachings of the now-asserted Horii, McDonald, and Calderone references were previously considered by the Patent Office. As to Horii, Petitioner asserts in its district court invalidity contentions and here that it teaches "a knitted component defining the upper" as recited in Claim Element 1[a1] and "a partially integral portion and a free portion" as recited in Claims 7 and 18, just as Petitioner asserted in its invalidity contentions for the previously considered Glidden, Clark, Dua-956, and Dua-592 references. Petition, 67-69, 75-81, 118-123; Ex.2004, 9-14, 76-81, 95; Ex.2005, 4-7, 65-73, 99; Ex.2006, 3-7, 58-63, 82-83; Ex.2007, 5-9, 57-63, 86; Ex.2008, 5-8, 54-61, 81-82. As to McDonald, Petitioner also asserts that the reference teaches "a partially integral portion and a free portion" as recited in Claims 7 and 18, just as Petitioner asserted in its invalidity contentions for the previously considered Glidden, Clark, Dua-956,

¹⁰ U.S. Patent No. 2,440,393 ("Clark").

and Dua-592 references. Petition, 75-81, 118-123; Ex.2004, 76-81, 95; Ex.2005, 65-73, 99; Ex.2006, 58-63, 82-83; Ex.2008, 54-61, 81-82. And as to Calderone, Petitioner asserts that the reference teaches “at least one raised element extending a height above the exterior surface of the knitted component” as recited in Claim Element 1[c] and in Skechers’ proposed construction of Claim Element 1[b], just as Petitioner asserted in its invalidity contentions for the previously considered Glidden, Clark, Dua-956, and Dua-592. Petition, 71-75, 97-98; Ex.2004, 14-32; Ex.2005, 7-22; Ex.2006, 7-22; Ex.2008, 8-20.

The Horii, McDonald, and Calderone references are thus cumulative with art already considered by the Patent Office. As the Board explained in *Padagis Israel Pharmaceuticals*, asserted art is deemed cumulative when a petitioner “contends the same teachings are found” in previously considered art:

Turning to the other three references, we agree with Patent Owner that Anderson and Chim are cumulative of Kircik and Shalita. Petitioner relies on Anderson and Chim for their teaching that topical compositions containing 0.05% tazarotene are effective to treat acne. However, Petitioner contends the same teachings are found in Kircik and Shalita. Petitioner’s attempt to distinguish Anderson and Chim by urging they show “real-world clinical practice” and therefore “evidence that prior art use of 0.05% tazarotene for treating acne was not limited to experimental clinical studies,” such as those in Kircik and Shalita is unavailing. The challenged claims draw no such distinction, nor does Petitioner persuasively explain why a person of ordinary skill in the art (“POSITA”) would view Anderson’s and Chim’s teachings to be any more pertinent

than Kircik and Shalita's teachings as they relate to the motivation to combine and reasonable expectation of success allegations in the Petition.

Padagis Israel Pharmaceuticals, Ltd. v. Bausch Health Ireland Ltd., No. IPR2023-01114, 2024 WL 146121, at *5 (P.T.A.B. Jan. 12, 2024). The Board reached the same conclusion in *Sonos, Inc. v. Google, LLC*:

Accordingly, as Horn is applied in the Petition to the challenged claims in the same way as art previously presented to the Office, we determine that with regard to the Petition and the challenged claims that Horn is substantially the same as art previously presented to the Office.

Sonos, Inc. v. Google, LLC, IPR2021-00963, 2021 WL 5195655, at *4 (P.T.A.B. Nov. 9, 2021). A Petitioner cannot merely "swap in similar references" in an attempt to avoid discretionary denial under §325(d). *Siemens Mobility, Inc.*, 2024 WL 4827396 at *7 (denying institution under §325(d)).

In sum, Petitioner's asserted art is the same or substantially the same as the art that was presented to the Office during the prosecution of the '562 Patent. Step one of *Advanced Bionics* is met.

B. Petitioner Has Not Demonstrated that the Examiner Committed Material Error (*Becton, Dickinson* Factors (c), (e), and (f))

As *Advanced Bionics* step one has been satisfied, the burden shifts to Petitioner to show that the Office erred in a manner material to the patentability of

the challenged claims. 2020 WL 740292, *3. “An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Id.* at *3 n.9. But “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* at *3.

Petitioner has failed to make this showing. Indeed, Petitioner does not even allege that the Examiner committed any error; the word “error” does not appear anywhere in the Petition. Petition, 123. Petitioner cannot claim ignorance of this legal framework, as it devoted several pages to an argument of material error in its petition for *inter-partes* review of Nike’s U.S. Patent No. 7,401,420, filed on October 30, 2020. *Skechers U.S.A., Inc. v. Nike, Inc.*, IPR2021-00160, Paper 1 at 18-22 (P.T.A.B. Oct. 30, 2020). The Board has found that petitioner’s failure to allege material error is sufficient basis to determine that the petitioner did not carry its burden as to *Advanced Bionics* step two. *E.g., Balt USA, LLC v. MicroVention, Inc.*, IPR2019-01259, 2021 WL 219251, at *10, *12 (Jan. 21, 2021) (Petitioner’s own analysis of prior art without reference to Examiner’s analysis insufficient to show material error); *Sony Interactive Entm’t LLC v. Terminal Reality, Inc.*, IPR2020-00711, 2020 WL 6065188, at *5 (P.T.A.B. Oct. 13, 2020) (Petitioner’s argument that asserted references were not substantively evaluated or applied in a rejection

failed to sufficiently identify Examiner error); *NXP USA, Inc. v. Impinj, Inc.*, IPR2020-00519, 2020 WL 4805424, at *5 (P.T.A.B. Aug. 17, 2020) (no discussion of material error); *GlaxoSmithKline Consumer Healthcare Holdings (US) LLC v. Cipla Ltd.*, IPR2020-00369, 2020 WL 4390663, at *5 (P.T.A.B. Jul. 31, 2020). In *Sony Interactive*, the Board noted that “Sony [Petitioner] was provided the opportunity to provide explanation [of material error], but Sony was silent in this regard.... Accordingly, *Becton, Dickinson* Factor (e) favors exercising our discretion to deny institution.” *Id.*; see also *Universal Imaging Indus., LLC v. Lexmark Int’l, Inc.*, IPR2019-01387, 2020 WL 959375, at *5 (P.T.A.B. Feb. 27, 2020) (“Although Petitioner is correct that the Examiner did not reject any claims of the ’921 patent based on [the asserted reference], ***that is not the end of our analysis.***”) (emphasis added).

Even if Petitioner’s allusions to the prosecution record could be construed as an argument that the Examiner erred, those assertions are superficial at best. Petitioner hypothesizes that the Examiner might have overlooked the full scope of the teachings of its asserted art, nothing more. Petition, 123. Petitioner’s theory amounts to a disagreement with the Examiner over the state of the art, which is insufficient to show material error. See *Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021-00412, Paper 9, 36-39 (P.T.A.B. Jul. 21, 2021).

Second, as all references here are the same or substantially the same as the references that were before the Examiner, as detailed above (*see* Section VI.A, *supra*), Petitioner cannot meet its burden of demonstrating material error on the basis that the Examiner did not apply the asserted combinations of references in a rejection during the '636 Patent's prosecution. Express application simply is not required. *See ABS Global, Inc. v. Cytonome/ST, LLC*, IPR2021-00306, Paper 13, 13-14 (P.T.A.B. Jun. 7, 2021).

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

Sys. GMHB, IPR2021-01221, Paper 11, 21-24 (P.T.A.B. May 6, 2022) (denying petitioner’s request for reconsideration).

Similarly, here, the asserted references were before the Examiner or cumulative of references that were before the Examiner, and Petitioner fails to “point out sufficiently how the examiner erred in [his] evaluation of the asserted prior art.” *Nespresso*, 2022 WL 212376, *11. Having largely ignored the prosecution history of the ’636 Patent, and having failed to direct the Board to any specific (non-speculative) examiner error, Petitioner fails to meet its burden under *Advanced Bionics* step two.

Because Petitioner (1) relies on the same or substantially the same art considered by the Examiner during the prosecution of the ’636 Patent, and (2) fails to show that the Examiner materially erred, institution of the instant proceeding should be denied under §325(d).

VII. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. §314(A) AND *FINTIV*

Despite the fact that all of Petitioner’s asserted references are the same or substantially the same as references already considered by the ’636 Patent Examiner, Petitioner admitted to deliberately delaying its filing of the Petition for its own strategic benefit. *Fintiv* also warrants denial of institution under 35 U.S.C. §314(a)

because the validity of the '636 Patent is being litigated concurrently in district court in the Central District of California. *See generally Nike, Inc. v. Skechers U.S.A., Inc.*, 2:23-cv-09346-AB-PVC (C.D.Cal.).

That this Board and the district court are being asked to simultaneously adjudicate the validity of the '636 Patent is the direct consequence of Petitioner's admitted gamesmanship and strategic decision to delay the filing of the present Petition to take full strategic advantage of (1) Nike's recent trial with lululemon; (2) the fact that Nike will be doing "triple duty" by simultaneously pursuing litigations against Skechers, New Balance, and lululemon; and (3) Skechers' belief that the Board will institute at least Skechers' petitions challenging Nike's '484 and '749 Patents because those petitions are "similar" to the petitions filed by lululemon. Ex.2012¹¹. To institute review in these circumstances would (1) needlessly waste the resources of the Board, (2) result in inefficient and disorderly disposition of the parallel validity challenges to the '636 Patent, with the potential for conflicting decisions by the Board and the District Court on everything from claim construction to the final merits decision, and (3) reward Skechers' admitted gamesmanship.

¹¹ Email from L. Oxenford to M. Wilk, November 13, 2024.

A. Legal Standard for *Fintiv* Discretionary Denial

The Board weighs a set of nonexclusive factors, articulated in *Fintiv*, that balance considerations of system efficiency and fairness when a patent owner raises an argument for discretionary denial due to a parallel proceeding. *Fintiv*, 2020 WL 2126495, at *2. These factors are:

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

Id.

These factors relate to whether efficiency, fairness, and the merits support the Board's exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding. In evaluating the factors, the Board takes a holistic view of whether efficiency and the integrity of the system are best served by denying or instituting review. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 58 (quoting 35 U.S.C. §316(b)).

In addition, the Petitioner has not offered a *Sotera* stipulation. The Board should exercise its discretion and deny institution on the basis that “Petitioner has not submitted a *Sotera*-type stipulation that would make discretionary denial inappropriate.” *Zhuhai Cosmox Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, IPR2023-00587, Paper 12 at 15, 27 (P.T.A.B. Sept. 22, 2023) (discretionarily denying institution where Petitioner stipulated not to re-raise same grounds in district court as in IPR but where stipulation “does not extend to any ground ‘that could have been reasonably raised,’ pursuant to *Sotera*.”).

Petitioner has not offered a *Sotera* stipulation—or even a weaker commitment not to assert duplicative grounds in the District Court proceeding—and thus the sound logic recognized in *Zhuhai* applies here. The Board should accordingly find that Petitioner’s decision not to offer a *Sotera* stipulation neutralizes the effects of the pre-institution stay recently entered by the District Court, and under the circumstances merits denial under a holistic analysis of the *Fintiv* factors due to the duplication of the invalidity grounds asserted in the parallel District Court proceedings. *See Fintiv*, 2020 WL 2126495, at *3; *see also Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 (P.T.A.B. Jun. 1, 2021) (exercising discretion to deny institution after holistic analysis of *Fintiv* factors).

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

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

The first *Fintiv* factor addresses the likelihood of a stay if this proceeding is instituted. Patent Owner recognizes that a stay of District Court proceedings, when coupled with a *Sotera* stipulation, can make discretionary denial under *Fintiv* inappropriate. But here, Petitioner has not offered a *Sotera* stipulation, and there is no reason to conclude that the District Court's stay reflects any analysis regarding the merits of Petitioners' invalidity defense. As such, the Board should not weigh the pre-institution stay against using its discretion to deny institution because if the Board denies institution and the stay is lifted, the litigation can resume *status quo ante*.

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

"If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of exercising authority to deny institution under *NHK*." *Fintiv*, 2020 WL 2126495, at *4. In the parallel litigation, before the Court stayed the case, trial was set for February 9, 2026, more than four months before the expected Final Written Decision date of June 21, 2026. *Nike, Inc. v. Skechers U.S.A., Inc.*, 2:23-cv-09346-AB-PVC (C.D.Cal.), Dkt. 96 at 4. If the Board denies institution and the matter proceeds with an approximate delay of four

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

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

“The Board also has considered the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, 2020 WL 2126495, at *4. “[M]ore work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.* at 10. The Board considers the amount and type of work already completed in the parallel litigation “at the time of the institution decision.” *Id.*

Patent Owner and Petitioner have undertaken substantial activity in support of the district court proceedings since at least November 6, 2023, when Nike filed its complaint against Skechers for patent infringement. *Nike, Inc. v. Skechers U.S.A., Inc.*, Case No. 2:23-cv-09346-AB-PVC (C.D.Cal.), Dkt. No. 1. The parties have spent months briefing the district court on the claim construction issues in the parallel proceeding. The parties submitted opening, reply, and supplemental claim construction briefs, and a claim construction hearing was held on September 20, 2024. Ex.1006; Ex.1007; Ex.1008; Ex.1009; Ex.1010; Ex.1033; Ex.2013¹²; Ex.2014¹³.

Additionally, the parties have exchanged over one million pages of discovery, including information about their merits positions concerning the '636 Patent. Petitioner served preliminary and supplemental invalidity contentions in April and May, 2024, respectively, in the parallel proceeding, including detailed claim charts that address nearly the same exact prior art cited in the Petition. *See* Ex.2015¹⁴; Ex.2003. Nike served initial and supplemental infringement contentions in March

¹² Skechers' Supplemental Claim Construction Brief (September 30, 2024).

¹³ Nike's Supplemental Claim Construction Brief (September 30, 2024).

¹⁴ Skechers' Preliminary Invalidity Contentions Pleading (April 19, 2024).

and October, 2024, respectively. Ex.1011; Ex.2016¹⁵. At the time of the stay, non-email discovery was almost complete, and the parties were finalizing e-mail search terms. Thus, “the current investment in invalidity and construction contentions” weighs in favor of discretionary denial. *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ.*, IPR2020-00122, Paper 15 at 8-9 (P.T.A.B. May 15, 2020).

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

4. The validity of the ’636 Patent is central to both proceedings (*Fintiv* Factor Four)

The validity of the ’636 Patent is central to both this dispute and the parallel litigation. In the district court case, Patent Owner asserts that Petitioner infringes the ’636 Patent. *Nike, Inc. v. Skechers U.S.A., Inc.*, Case No. 2:23-cv-09346-AB-PVC (C.D.Cal.), Dkt. 1. In turn, Petitioner alleges that the claims of the ’636 Patent are invalid. *Id.*, Dkt. 34. It would be wasteful and inefficient to proceed here given the overlap between the issues and the potential for conflicting decisions. *See Keyme, LLC v. Hillman Grp.*, IPR2020-01485, 2021 WL 1236002, *5 (P.T.A.B. Mar. 31, 2021) (denying institution in light of parallel litigation because it would be

¹⁵ Nike’s Supplemental Infringement Contentions for the ’636 Patent (October 23, 2024).

inefficient to proceed in multiple fora and to avoid potential conflicting decisions due to the substantial overlap between claims). Factor four therefore weighs in favor of denying institution.

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

Petitioner and Patent Owner are the same parties in both the instant proceeding and the parallel litigation. Accordingly, “this [fifth] factor favors the exercise of discretionary denial.” *Keyme, LLC v. Hillman Grp.*, IPR2020-01485, 2021 WL 1236002, *6 (P.T.A.B. Mar. 31, 2021).

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

There are no additional factors that warrant institution. To the contrary, the other relevant circumstances here—including the Examiner’s previous consideration of the same or substantially the same art advanced by Petitioner (warranting §325(d) discretionary denial) and Petitioner’s strategic decision to delay filing the instant petition challenging the validity of the ’636 Patent at a time when it knew that “Nike [would] be doing ‘triple duty’ by simultaneously pursuing litigations against Skechers, New Balance, and lululemon.” Ex.2012; *Fintiv*, 2020 WL 2126495, at *7 (noting that other relevant circumstances include “considerations implicated by 35 U.S.C. §325(d)” and their effect on the “efficiency and integrity of the patent system”).

Petitioner could have filed a petition for IPR of the '636 Patent in May 2024, after it served its supplemental invalidity contentions that included many of the invalidity bases that it now raises in the instant petition. Yet, Skechers waited an additional six months to file it at a time when it was aware that Nike's resources would be stretched thin. The Board should not encourage or endorse these tactics. Institution under these circumstances would waste judicial resources and reward gamesmanship.

The *Fintiv* factors weigh in favor of denial. The Board should therefore exercise its discretion to deny institution under *Fintiv* and §314(a).

VIII. PETITIONER HAS NOT ESTABLISHED A REASONABLE LIKELIHOOD OF PREVAILING FOR ANY CHALLENGED CLAIM

Petitioner bears the burden on institution of “demonstrating a reasonable likelihood that it will prevail in showing the unpatentability of at least one claim.” *SMIC, Ams. v. Innovative Foundry Techs., LLC*, IPR2020-00837, Paper 13 at 13–14 (P.T.A.B. Oct. 9, 2020) (citing 35 U.S.C. §§314(a) and 312(a)(3)). In making this showing, Skechers' Petition must identify “the evidence that supports the grounds for the challenge to each claim.” *Id.* Skechers has not met that burden here.

First, Skechers alleges that claims 1-6, 8-17, and 19-27 of the '636 Patent are invalid as anticipated under 35 U.S.C. §102. Skechers' anticipation-based Ground

1A fails because the allegedly anticipating reference, Dua-956, does not disclose “a portion of the knitted component defining the upper” or “an integral knit tongue.” Anticipation requires “that a single prior art reference discloses each and every element of a claimed invention.” *Silicon Graphics, Inc. v. ATI Techs., Inc.*, 607 F.3d 784 at 796 (Fed. Cir. 2010). A reference must not only explicitly or inherently disclose every claimed element, but those elements must also be arranged within that reference as they are in the claim. *See Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359 at 1369–71 (Fed. Cir. 2008). Disclosures from multiple, distinct embodiments of a prior art reference cannot be combined to anticipate the challenged claim. *See id.* at 1371. And “differences between the prior art reference and a claimed invention, however slight, invoke the question of obviousness, not anticipation.” *Id.* Because Skechers does not demonstrate that the allegedly anticipating reference discloses all elements of claims 1-6, 8-17, and 19-27 of the ’636 Patent, it has not met its burden with respect to Ground 1A.

Second, Skechers alleges invalidity under 35 U.S.C. §103(a) of all claims of the ’636 Patent, *i.e.*, that the differences between the claims of the ’636 Patent and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made” to the POSITA. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). Skechers’ obviousness-based grounds (Grounds 1B-1D, 2A, and 2B) fail because the secondary references do not cure the defects in Dua-956

and Dua-592. In other words, none of Skechers' Ground 1 obviousness arguments (Grounds 1B-1D) teach or suggest, *inter alia*, "a knitted component defining the upper" or "an integral knit tongue." Likewise, neither of Skechers' Ground 2 obviousness challenges (Grounds 2A and 2B) teach or suggest, *inter alia*, "an integral knit tongue." To prevail, Skechers must "place themselves in the minds of those of ordinary skill in the relevant art ***at the time the invention was made***, to determine whether that which is now plainly at hand would have been obvious at such earlier time." *Millennium Pharms., Inc. v. Sandoz Inc.*, 862 F.3d 1356, 1367 (Fed. Cir. 2017) (emphasis added). Skechers must articulate specific reasoning and cannot rely on conclusory statements or attorney argument. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362–63 (Fed. Cir. 2016); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1342 (Fed. Cir. 2020) (affirming nonobviousness where petitioner's challenge was "based on attorney argument rather than evidence in the record"). Skechers' obviousness-based grounds suffer defeat because they do not teach or suggest all elements of the challenged claims.

Additionally, Skechers fails to demonstrate that the POSITA would be motivated to combine the asserted references to reach the invention claimed in the '636 Patent. Skechers must prove that a POSITA would have been motivated to modify or combine teachings from different references. *KSR*, 550 U.S. at 418; *see also In re Stepan Co.*, 868 F.3d 1342, 1345–46 (Fed. Cir. 2017). A patent "composed

of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* It is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* In addition to motivation to combine, Skechers must show a reasonable expectation of success in making a prior art combination. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). Because Skechers fails to articulate a reason to combine the proposed references in its obviousness-based Grounds, they cannot succeed.

Therefore, for the reasons articulated herein, Skechers has not shown a reasonable likelihood of success for any challenged claim under any ground of unpatentability. Accordingly, the Board should thus deny institution.

A. Ground 1A: Petitioner Fails to Show A Reasonable Likelihood That Dua-956 Anticipates Claims 1-6, 8-17, and 19-27

Petitioner argues that Embodiment #1 of Dua-956 anticipates Claims 1-6, 8-17, and 19-27 of the ’636 Patent. Skechers fails to show a reasonable likelihood that Embodiment #1 of Dua-956 anticipates any challenged claim in Ground 1.

1. Dua-956 does not disclose a “knitted component defining the upper” or an “integral knit tongue” as recited in independent claims 1, 13, and 21

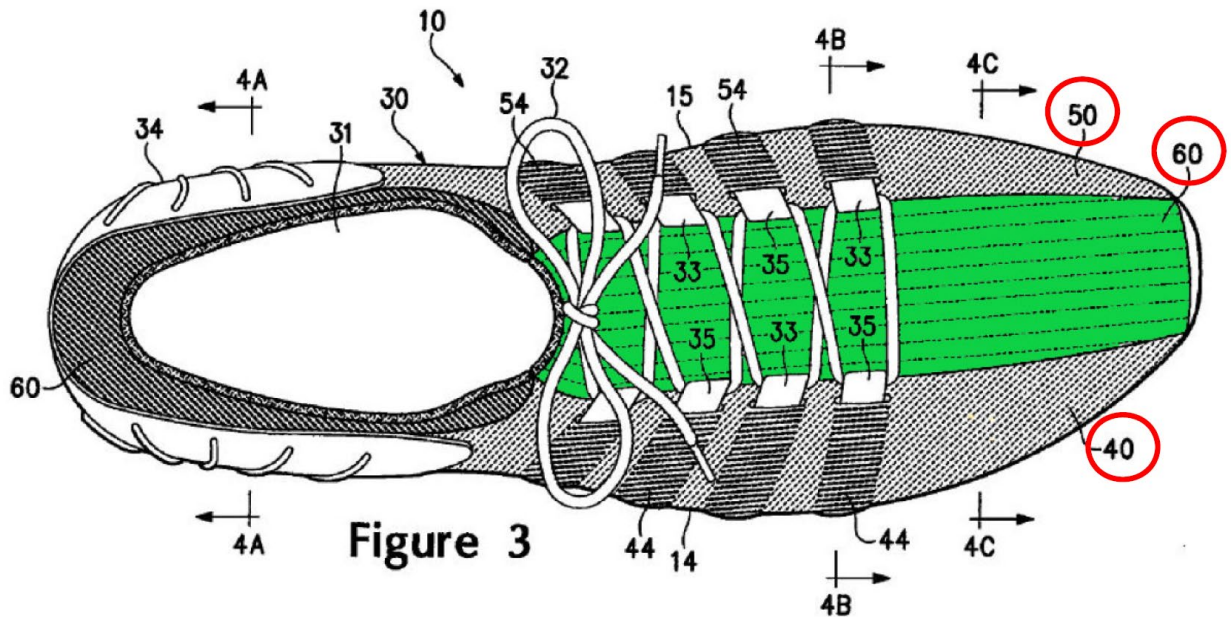
Dua-956 does not disclose a “knitted component defining the upper” or an “integral knit tongue” as recited in independent claims 1 and 13.

a) Dua-956 does not disclose a “knitted component defining the upper” as recited in Elements 1[a1] and 13[a]

Petitioner incorrectly argues that Dua-956 discloses the “knitted component defining the upper” element because “the majority *of the parts* of the upper are formed by the central element 60.” Petition, 27-28 (emphasis added). Skechers’ contention is based upon simply counting the components of the upper, not the actual surface area of the upper. *Id.*, 30.

Skechers’ argument regarding Elements 1[a1] and 13[a] comes from its flawed reading of the ’636 Patent. As described, the ’636 Patent explains that “a majority of upper 120 is formed from a knitted component 130....” Ex.1001, 6:57–63. Nowhere does the ’636 Patent state that the majority *of components* of the upper must be knitted. Rather, a majority *of the upper* must be knitted. Ex.1001, 6:57–63. Skechers’ defective interpretation would encompass embodiments in which a majority of components are knitted, but that majority of components does not make up the *majority of the upper*. This is contrary to the express disclosure in the specification of the ’636 Patent.

Indeed, Skechers’ argument is belied by Dua-956’s Figure 3. Skechers’ annotations underscore that central textile element 60 does not make up the majority of upper 30. Petition, 21. Skechers’ annotated Figure 3 is reproduced below:



Petition, 21. As shown, Dua-956 does not disclose a “knitted component defining the upper” because the majority of the upper disclosed in Dua-956 is not formed by central textile element 60.

Additionally, Skechers asserts that its expert “confirmed that the figures depict the central textile element 60 as comprising the majority of the area of the upper 30.” Petition, 30 (citing Ex.1002, ¶¶110-114). Skechers’ expert in turn relies on an analysis of the two-dimensional drawings in order to estimate the surface area of the three-dimensional knit upper. Ex.1002, ¶¶110-114 (citing Ex.1036, 10).

Skechers’ reliance on the two-dimensional rendering of the footwear embodied by Dua-956 as shown in Figures 1-3 is improper. The Federal Circuit expressly rejected this type of argument in *Hockerson-Halberstadt, Inc. v. Avia Grp. Int’l, Inc.*, 222 F.3d 951 (Fed. Cir. 2000). There, appellant HHI argued that the

“groove” claimed in the patent-at-issue is wider than the claimed “fins.” *Id.* at 956. For support, HHI noted that “the specification contains figures depicting a groove that is wider than the fins.” *Id.* But the Federal Circuit found HHI’s reliance on the figures “unavailing.” *Id.* The court explained that HHI’s argument “hinges on an inference drawn from certain figures about the quantitative relationship between the respective widths of the groove and fins.” *Id.* But the specification, the court observed, was “devoid of any indication that the proportions of the groove and finds are drawn to scale.” *Id.* And thus HHI “may not” rely on those drawings to show the particular sizes of the groove and finds:

Under our precedent, however, it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue. “Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.”

Id. (citing *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977); *In re Olson*, 212 F.2d 590, 592 (CCPA 1954)). Similarly, here the specification of Dua-956 is “devoid of any indication” of the actual proportions of the components that make up upper 30. Therefore, Dr. Adanur’s analysis of Figures 1-3 is of no value to Skechers’ argument that central textile element 60 comprises the majority the surface area of upper 30. For at least these reasons, Skechers fails to demonstrate that central textile element

60 is “a portion of the knitted component defining the upper” as recited in Element 1[a1].

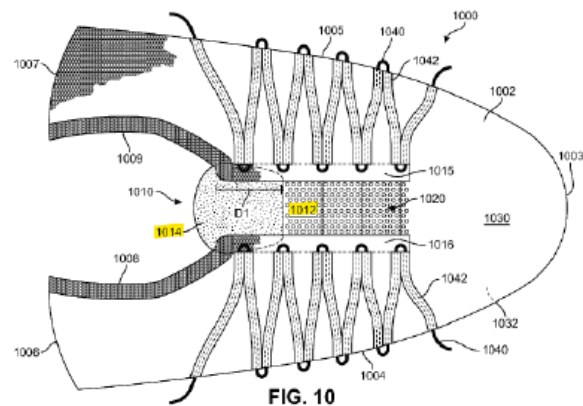
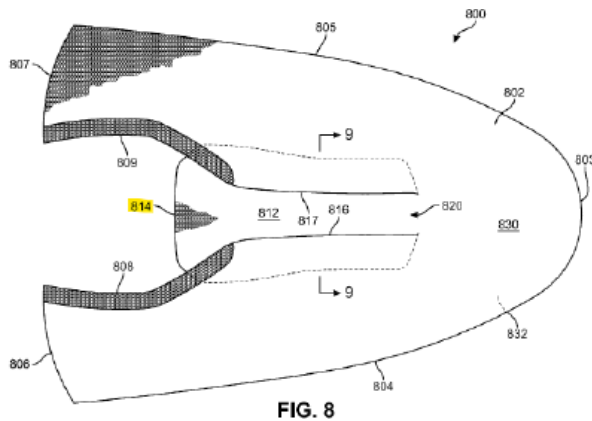
For at least these reasons, Dua-956 fails to disclose Elements 1[a1] and 13[a].

b) Dua-956 does not disclose “an integral knit tongue” as recited in Elements 1[b], 1[d], 13[b], 13[d], 21[a], and 21[c]

Nor does Dua-956 disclose “an integral knit tongue” as recited in Elements 1[b], 1[d], 13[b], 13[d], 21[a], and 21[c].

Skechers’ argument rests on a mischaracterization of Nike’s litigation position regarding the meaning of the term “tongue.” Petition, 33. Skechers asserts that Nike’s “understanding of ‘integral knit tongue’ refers generally to knitted material within the throat area. *Id.* Not so. In its supplemental claim construction briefing in the parallel litigation, Nike explained that “integral knit tongue,” as used in the ’636 Patent, “is ‘integrally knitted’ with the upper, but still has distinctive features of a conventional tongue.” Ex.2014, 1. In conventional articles of footwear, the tongue is a separate component stitched into the upper. The ’636 Patent provides various non-limiting examples of an “integral knit tongue.” For example, the integral knit tongue may have “a top end 814 that extends into the portion of second knitted component 800 that is associated with the ankle opening,” as shown in Figure 8 (below left). Ex.1001, 11:49-52, Fig. 8. Or, as shown in Figure 10 (below right), the integral knit tongue may have a “partially integral portion 1012 and a free portion

1014,” where the free portion provides an enlarged ankle opening to assist a wearer with foot insertion. *Id.* at 13:24-36, 14:4-20, Fig. 10. In these examples, the integral knit tongue is identifiable by its upper boundary which extends beyond the adjacent periphery of the ankle opening.



As another example, the integral knit tongue may be made of different yarn from the surrounding upper. *Id.* at 17:6-27. In this example, the integral knit tongue may be visually and structurally distinct from the surrounding upper. Or the integral knit tongue may have raised elements that may or may not incorporate lace apertures. *Id.* at 10:1-31.

It is readily apparent that Dua-956 does not disclose “an integral knit tongue” as recited in in Elements 1[b], 1[d], 13[b], 13[d], 21[a], and 21[c]. Skechers identifies forward portion 61 of central textile element 60 as an “integral knit tongue,” but forward portion 61 lacks the features of a conventional tongue. Petition, 33. Indeed, Dua-956 does not even describe the forward portion 61 of central textile element 60 as a “tongue,” and, in fact, the only time that Dua-956 mentions one is when

describing conventional footwear. Ex.1029, 1:32-34 (“the upper may include a tongue that extends under the lacing system....”).

For these reasons, Dua-956 does not disclose an “an integral knit tongue” because forward portion 61 of central textile element 60 does not have any distinctive features of a conventional tongue. For at least this reason, Dua-956 fails to disclose Elements 1[b], 1[d], 13[b], 13[d], 21[a], and 21[c].

2. Dua-956 does not disclose “an upper and an integral knit tongue formed of unitary knit construction with the upper” as recited in independent claim 21

Likewise, Dua-956 fails to anticipate independent claim 21. Element 21[a] of the '636 Patent recites “an upper and an integral knit tongue formed of unitary knit construction with the upper.” The '636 Patent expressly teaches that:

a knitted component (e.g., first knitted component 500, or other knitted components described herein) is defined as being formed of “unitary knit construction” when formed as a one-piece element through a knitting process. That is, the knitting process substantially forms the various features and structures of first knitted component 500 without the need for significant additional manufacturing steps or processes.

Ex.1001, 7:67-8:7.

Dua-956 does not teach an upper and an integral knit tongue formed of unitary knit construction with the upper. Dua-956 explicitly states that “upper 30 is substantially assembled by joining edges of textile elements 40, 50, and 60 to impart a general shape of the void.” Ex.1029, 5:65-67. Each of lateral textile element 40,

medial textile element 50, and central textile element 60 are individually knitted through a flat knitting process. *Id.*, 6:15-19, 6:31-33, 6:46-49. “[U]pper 30 is formed from three separate textile elements 40, 50, and 60 that are joined through stitching...” *Id.*, 11:1-2; *see also id.* at 8:44-65. The assembly process is generally depicted in Figures 8A-8E. In other words, setting aside that Dua-956 does not disclose an integral knit tongue (*see* §VIII.A.1.b, *supra*), the entire upper of Dua-956’s Embodiment #1 is not of unitary knit construction, as required by the claims of the ’636 Patent, but rather is formed by stitching together several different components into one.

For these reasons, Dua-956 does not disclose “an upper and an integral knit tongue formed of unitary knit construction with the upper” as recited in independent claim 21.

3. Dua-956 fails to anticipate claims 2-6, 8-12, 14-17, 19, 20, and 22-27

For the reasons discussed above, because Dua-956 does not anticipate independent claims 1, 13, and 21, it does not anticipate dependent claims 2-6, 8-12, 14-17, 19, 20, and 22-27.

B. Ground 1B: Petitioner Fails to Show A Reasonable Likelihood That Dua-956 Alone or in Combination with Horii Renders Obvious Claims 1-6, 8-17, and 19-27

Realizing the fatal flaws in Dua-956, Petitioner next argues that it would have been obvious to either (1) construct Embodiment #1 using Dua-956's Embodiments #2 and #3 or (2) modify Dua-956 with Horii. Petition, 62-70. Both arguments fail.

First, Skechers' additions from Dua-956 and Horii only address Element 1[a1] ("the knitted component defining the upper"). Petition, 62, 67. In other words, Skechers' Ground 1B still does not disclose "an integral knit tongue," and cannot be successful for that reason alone. Second, Skechers fails to articulate a motivation to combine Dua-956's Embodiment #1 with either of (1) Dua-956's Embodiments #2 and #3 or (2) Horii to arrive at "the knitted component defining the upper." Ground 1B fails for this reason as well.

1. Dua-956 alone or in view of Horii does not disclose "an integral knit tongue"

Petitioner's argument fails because Ground 1B does not teach or suggest an "integral knit tongue." Petitioner expressly states that the additions of Dua-956 Embodiments #2 and #3 and Horii are to address "the knitted component defining the upper" element recited in Claim 1[a1] that is missing from Dua-956's Embodiment #1. Petition, 62, 67 ("If Dua-956 alone is deemed not to expressly disclose 'the knitted component defining the upper' of Element 1[a1]..."; "It would also have been obvious to combine Dua-956 and Horii in order to construct Dua-

956's upper 30 (Embodiment #1) as a single, unitary knit component based on Horii [*sic*] teachings.”). As discussed in section §VIII.A.1.b, *supra*, Dua-956 does not disclose “an integral knit tongue,” as recited by independent claims 1, 8, and 21. None of Skechers' proposed modifications or combinations obviate this pitfall. Thus, Skechers fails to establish a reasonable likelihood that Dua-956 alone or in view of Horii renders claims 1-6, 8-17, and 19-27 obvious.

2. Petitioner fails to demonstrate that a POSITA would be motivated to modify Dua-956's Embodiment #1 in view of Embodiments #2 and #3

Moving on, Petitioner admits that textile elements 40, 50, and 60 of Embodiment #1 are knitted individually before they are joined by stitching to form upper 30. Petition, 62. Nevertheless, Skechers asserts that it would have been obvious to form the first embodiment of Dua-956's upper 30 as a single, unitarily knitted component based in part on the second and third embodiments in Dua-956. *Id.*, 62-67. Skechers' argument fails.

First, the POSITA would not be motivated to combine Embodiment #1 of Dua-956 with Embodiment #2 to form a unitarily knitted upper because there is no disclosure that Embodiment #2 is of unitary knit construction. Petition, 62-64. Dua-956 states that its footwear 10 describes an article of footwear that is “at least *partially* formed from a flat knit material structure.” Ex.1029, 4:7-10, 9:29-31 (emphasis added). Dua-956 is intentional when describing certain embodiments as

“formed of unitary (i.e., one piece) construction by the flat knitting process.” Indeed, Dua-956 expressly discloses that Figures 9B, 11A, 11B, 12, and 13 depict footwear that is formed of unitary, one-piece construction. Ex.1029, 9:53-57, 10:33-35, 11:1-4, 11:18-22, 11:62-65. This disclosure is glaringly absent from the text describing Embodiment #2 (Figures 10A-C). *Id.*, 9:58-10:6. Thus, Petitioner has not identified a reason to modify Dua-956’s Embodiment #1 with Embodiment #2, as neither teach or suggest “the knitted component defining the upper.”

Second, Petitioner does not identify a motivation to combine Embodiment #1 with Embodiment #3. Embodiment #1 is directed towards “walking, running, or other ambulatory activities,” (Ex.1029, 5:10-14) while Embodiment #3 is directed towards “ballet or yoga type footwear....” *Id.*, 13:6-11. Nowhere does Petitioner explain why one seeking to modify Embodiment #1, a running shoe, would turn to Embodiment #3, a yoga or ballet shoe. Skechers’ boilerplate motivation to combine fails, as it “involves nothing other than an assertion that because two ... systems were disclosed in a prior art reference and were therefore ‘known,’ that satisfies the motivation to combine analysis. That is an error as a matter of law. It does not suffice to simply be known. A reason for combining must exist.” *Virtek Vision Int’l v. Assembly Guidance Sys. Inc.*, 97 F.4th 882, 888 (Fed. Cir. 2024).

For these reasons, Skechers has failed to show that the POSITA would be motivated to modify Embodiment #1 of Dua-956 with Embodiments #2 and #3.

3. Petitioner fails to demonstrate that a POSITA would be motivated to combine Dua-956 with Horii

Petitioner further alleges that it would have been obvious to combine Dua-956 with Horii (Ex.1017) in order to arrive at the upper recited in Element 1[a1] of the '636 Patent. Petition, 67-69.

Petitioner alleges that the POSITA would have been motivated to manufacture Dua-956's upper 30 using the multilayer, single fabric of Horii "because Horii's single-piece knit upper would have provided upper 30 with a seamless structure...." Petition, 68. Petitioner argues that a POSITA would have looked to Horii because it is directed to "sports shoes," and is similar to some embodiments disclosed in the '636 Patent. *Id.* This analysis is fraught with impermissible hindsight bias. "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996); *see also In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). "Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." *In re NTP, Inc.*, 654 F.3d 1279,

1299 (Fed. Cir. 2011); *see also Sanofi-Aventis U.S., LLC v. Dr. Reddy's Lab 'ys, Inc.*, 933 F.3d 1367, 1375 (Fed. Cir. 2019).

Here, Skechers works backwards and starts with the disclosure of the '636 Patent itself, finding a motivation to combine Dua-956 with Horii because Horii's disclosure is similar to that of the '636 Patent. Petition, 68-69 ("A POSITA would have particularly looked to Horii because it is directed to 'sports shoes,' similar to at least some embodiments of footwear 100 of the '636 Patent."). This is precisely the hindsight reconstruction that the Federal Circuit repeatedly warns against. Skechers uses the embodiment described in the '636 Patent (Ex.1001, 5:25-36, Fig. 3) as a starting point and works backwards to find a motivation to combine Horii with Dua-956.

Thus, Petitioner impermissibly works backwards from Nike's own inventive path, using improper hindsight. *See Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012) ("The inventor's own path itself never leads to obviousness; that is hindsight."). The Board should not follow Petitioner's lead and assess the validity of the Challenged Claims using this "illogical and inappropriate process." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996); *see also Insite Vision Inc. v. Sandoz, Inc.*, 783 F.3d 853, 859 (Fed. Cir. 2015) ("Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.").

4. Petitioner fails to establish a reasonable likelihood that Dua-956 alone or in view of Horii renders obvious Claims 1-6, 8-17, and 19-27

Because Skechers fails to demonstrate that the POSITA would be motivated to modify Dua-956 in view of (1) Dua-956's Embodiments #2 and #3 or (2) Horii, and because Skechers fails to demonstrate that either teach or suggest "an integral knit tongue," Skechers has failed to demonstrate a reasonable likelihood that the challenged claims are rendered obvious by Dua-956 alone or in view of Horii.

C. Ground 1C: Petitioner Fails to Show A Reasonable Likelihood That Claims 1-6, 8-17, and 19-27 Are Obvious under Grounds 1A-1B in Further View of Calderone

Again, realizing the failures in Dua-956, Skechers argues that a POSITA would have been motivated to further modify Dua-956 in further view of Calderone (Ex.1018) to satisfy the "integral knit tongue element" and "raised element" recited in the Challenged Claims. Petition, 70-75. As an initial matter, because Grounds 1A or 1B do not teach or suggest "a knitted component defining the upper," Skechers' Ground 1C argument cannot succeed. *See* Sections VIII.A and VIII.B, *supra*. Skechers does not look to Calderone to cure this deficiency.

Moving on, Skechers asserts that Calderone satisfies the "integral knit tongue" element (Element 1[b]) under Skechers' proposed construction and the "raised element" (Element 1[c]) of the '636 Patent. Petition, 70-75. Under this theory, Skechers posits, citing its claim construction briefing from the parallel litigation, that

the term “integral knit tongue” “corresponds to the throat area between overhanging portions of the upper or adjacent to one or more raised elements.” *Id.*, 70. In turn, Skechers proposes that “raised element” means “a flap or overhanging portion that extends outward away from the surface of the upper along the length of the side of the tongue.” *Id.*, 70-71. Even assuming that Skechers’ proposed constructions are correct, Skechers still fails to demonstrate a reasonable likelihood that Claims 1-6, 8-17, and 19-27 are obvious under Grounds 1A-1B in view of Calderone.

As discussed in §III.D, *supra*, Calderone describes “an oxford type, lace up athleisure shoe” that “enables the shoe to be slipped on the wearers foot and held securely on the foot without the need for lacing on the shoe,” “provid[ing] the shoe with the appearance of a lace up shoe that is worn without lacing.” Ex.1018, Abstract; *see also id.*, 1:15-20. Calderone “overcomes the problem of wearing oxford lace up basketball shoes without lacing,” where the “lacing openings or eyelet openings on the shoe are left open, with there being no lacing on the shoe.” *Id.*, 1:45-47. Instead of having laces, “[t]he shoe is modified with a band that is connected to the left side and the right side of the shoe upper and extends across he shoe forefoot opening.” *Id.*, 1:48-50. Petitioner and its expert conveniently omit from their papers that Calderone expressly discloses an article of footwear that is to be worn without laces. Petition, 72; Ex.1002, ¶¶94, 230.

Petitioner provides no explanation for why the POSITA would look to a laceless shoe to modify the design of Dua-956. Indeed, Dua-956 states that its laces are intended to “permit[] the wearer to modify dimensions of upper 30” and “to loosen upper 30 and facilitate removal of the foot from the void.” Ex.1029, 5:39-43. Indeed, Calderone teaches away from the invention of the ’636 Patent: “it should be understood that the novel concept of the invention could be employed on other types of lace up shoes that are desired to be worn without lacing and without altering the appearance of the lace up shoe.” Ex.1018, 2:25-28. In other words, Calderon is explicitly intended to be used without laces. The Petition is silent as to why the POSITA wishing to modify Dua-956 would look to a reference such as Calderone, which is specifically meant to be worn without laces. As an additional matter, Petitioner also does not explain why there is a need to modify Dua-956, which is already designed to accommodate laces, with the features of Calderone. Petition, 74.

Thus, Petitioner fails to show a reasonable likelihood that Dua-956 in further view of Calderone renders obvious Claims 1-6, 8-17, and 19-27.

D. Ground 1D: Petitioner Fails to Show A Reasonable Likelihood That Claims 7 and 18 Are Obvious Over Grounds 1A-1C In Further View Of McDonald And/Or Horii

For at least the reasons discussed above with respect to Grounds 1A-1C, Dua-956 alone or in view of Horii and Calderone does not disclose independent claims 1 and 13. The Dua-956-based grounds do not teach or suggest “a knitted component

defining the upper,” or “an integral knit tongue.” Further, Ground 1C does not teach “raised elements.” For at least the same reasons, Grounds 1A-1C in further view of McDonald and/or Horii does not teach or suggest dependent claims 7 and 18.

E. Ground 2A: Petitioner Fails to Show A Reasonable Likelihood That Dua-592 In View Calderone Renders Obvious Claims 1-6, 8-17, and 19-27

Petitioner next argues that Dua-592 (Ex.1014) in view of Calderone renders obvious Claims 1-6, 8-17, and 19-27 obvious. Petition, 81-117. Petitioner fails to show that this is the case.

1. Dua-592 does not disclose “an integral knit tongue”

Much like its argument in Ground 1A, Petitioner’s argument that Dua-592 discloses an “integral knit tongue” as recited in Elements 1[b], 1[d], 13[b], 13[d], 21[a], and 21[c] fails.

Petitioner argues that “instep region 33” or “third texture 48” of Dua-592 is an “integral knit tongue.” Petition, 94-95. But as discussed in §VIII.A.1.b, *supra*, Petitioner’s argument is based upon a mischaracterization of Nike’s proposed claim construction of “integral knit tongue,” as “knitted material within the throat area....” Petition, 92. But that argument is squarely contradicted by Nike’s actual claim construction argument, which as articulated above, requires the tongue to be integrally knitted with the upper but maintain the distinctive features of a conventional tongue. Ex.2014; §VIII.A.1.b, *supra*. Indeed, neither Petitioner nor its

expert point to any features of “instep region 33” or “third texture 48” that are characteristic of a tongue. Petition, 94-95; Ex.1002, ¶259.

For these reasons, Dua-592 does not disclose an “an integral knit tongue” because “instep region 33” or “third texture 48” do not have any distinctive features of a conventional tongue. For at least this reason, Dua-592 fails to disclose Elements 1[b], 1[d], 13[b], 13[d], 21[a], and 21[c].

2. Petitioner fails to demonstrate that a POSITA would be motivated to combine Dua-592 and Calderone

Petitioner further asserts that the POSITA would combine Dua-592 with Calderone to arrive at the “raised elements” in (1) Skechers’ proposed construction of “integral knit tongue” and (2) Element 1[c]. Petition, 85-98. Skechers’ Ground 2A fails for the same reasons that its Ground 1C fails. *See* §VIII.C, *supra*.

As discussed, Calderone is directed to a laceless shoe. §VIII.C, *supra*; *see also* Ex.1018, Abstract, 1:15-20, 1:45-50, 2:25-28. Indeed, it is band 92 of Calderone that secures the foot within the shoe without the need for lacing. Ex.1018, 3:41-4:9. While Dua-592 teaches that its upper “may also include laces,” (Ex.1014, [0037]), Petitioner does not explain why the POSITA would incorporate elements from a laceless shoe such as Calderone. Petition, 85-88. Thus, Petitioner fails to demonstrate a motivation to combine Dua-592 and Calderone.

For these reasons, Dua-592 in view of Calderone fails to teach Elements 1[b], 1[d], 13[b], 13[d], 21[a], and 21[c].

3. Dua-592 in view of Calderone fails to render obvious claims 2-6, 8-12, 14-17, 19, 20, and 22-27

For the reasons discussed above, because Dua-592 in view of Calderone does not render obvious independent claims 1, 13, and 21, it does not render obvious dependent claims 2-6, 8-12, 14-17, 19, 20, and 22-27.

F. Ground 2B: Petitioner Fails to Show A Reasonable Likelihood That Claims 7 and 18 Are Obvious Over Ground 2A In Further View Of McDonald And/Or Horii

For at least the reasons discussed above with respect to Ground 2A, Dua-952 in view of Calderone does not disclose the “integral knit tongue” and “raised elements” elements of independent claims 1, 13, and 21. For at least the same reasons, Ground 2A in further view of McDonald and/or Horii does not teach or suggest dependent claims 7 and 18.

IX. CONCLUSION

For the reasons set forth above, Nike respectfully requests that the Board deny institution of the Petition for all Challenged Claims of the ‘636 Patent.

Dated: March 21, 2025

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CERTIFICATE OF WORD COUNT

Under the provisions of 37 C.F.R. §42.24(d), the undersigned hereby certifies that the Microsoft Office word count including all footnotes for the foregoing Patent Owner's Preliminary Response, excluding the table of contents, table of authorities, certificate of word count, appendix and certificate of service, totals 12,184 words, which is less than the 14,000 words allowed under 37 C.F.R. §42.24(b)(1).

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CERTIFICATE OF SERVICE

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

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