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13 UNITED STATES DISTRICT COURT
14 CENTRAL DISTRICT OF CALIFORNIA
15

16 NIKE, INC.,	)	Case No. 2:23-cv-09346-AB-PVC
	)	
17	)	
18 Plaintiff,	)	
	)	SKECHERS U.S.A., INC.'S
19 vs.	)	SUPPLEMENTAL PRELIMINARY
	)	INVALIDITY CONTENTIONS
20 SKECHERS U.S.A., INC.,	)	
	)	
21 Defendant.	)	

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Skechers U.S.A. v. Nike, Inc. IPR2025-00151 Patent No. 9,510,636 Ex. 2003
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TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION.....	1
II. PRIORITY DATE OF THE ASSERTED PATENTS AND CLAIMS	2
III. '749 PATENT	2
A. Prior Art References.....	2
1. Prior Art Patents and Publications.....	3
2. Prior Art Products	10
B. Invalidity Under 35 U.S.C. §§ 102 and 103	12
1. Anticipation	13
2. Obviousness	13
C. Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims	20
D. Invalidity Under 35 U.S.C. § 112	21
1. Legal Background Regarding The Definiteness, Enablement, And Written Description Requirements	21
2. Invalidity Grounds Under 35 U.S.C. § 112	22
a. Lack of Enablement And Written Description.....	23
b. Indefiniteness.....	24
IV. '562 PATENT	25
A. Prior Art References.....	25
1. Prior Art Patents and Publications.....	25
2. Prior Art Products	37
B. Invalidity Under 35 U.S.C. §§ 102 and 103	39
1. Anticipation	40
2. Obviousness	40

	<u>Page</u>
1	
2	
3	C. Charts Identifying Disclosure in Prior Art Invalidating
4	Asserted Claims 47
5	D. Invalidity Under 35 U.S.C. § 112 48
6	1. Legal Background Regarding The Definiteness,
7	Enablement, And Written Description Requirements 48
8	2. Invalidity Grounds Under 35 U.S.C. § 112 50
9	a. Lack of Enablement And Written Description.....50
10	b. Indefiniteness.....51
11	E. Invalidity Under the Doctrine of Double Patenting.....52
12	V. '636 PATENT 53
13	A. Prior Art References.....53
14	1. Prior Art Patents and Publications.....54
15	2. Prior Art Products 67
16	B. Invalidity Under 35 U.S.C. §§ 102 and 103 70
17	1. Anticipation 71
18	2. Obviousness 71
19	C. Charts Identifying Disclosure in Prior Art Invalidating
20	Asserted Claims 77
21	D. Invalidity Under 35 U.S.C. § 112 78
22	1. Legal Background Regarding The Definiteness,
23	Enablement, And Written Description Requirements 78
24	2. Invalidity Grounds Under 35 U.S.C. § 112 80
25	a. Lack of Enablement And Written Description.....80
26	b. Indefiniteness.....82
27	E. Invalidity Under the Doctrine of Double Patenting.....82
28	VI. '484 PATENT 83

1
2
3
4
5
6
7
8
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11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Page

A.	Prior Art References.....	83
1.	Prior Art Patents and Publications.....	84
2.	Prior Art Products	95
B.	Invalidity Under 35 U.S.C. §§ 102 and 103	97
1.	Anticipation	98
2.	Obviousness	98
C.	Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims	105
D.	Invalidity Under 35 U.S.C. § 112	106
1.	Legal Background Regarding The Definiteness, Enablement, And Written Description Requirements	106
2.	Invalidity Grounds Under 35 U.S.C. § 112	107
a.	Lack of Enablement And Written Description.....	108
b.	Indefiniteness.....	109
VII.	'511 PATENT	110
A.	Prior Art References.....	110
1.	Prior Art Patents and Publications.....	111
2.	Prior Art Products	122
B.	Invalidity Under 35 U.S.C. §§ 102 and 103	124
1.	Anticipation	125
2.	Obviousness	125
C.	Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims	132
D.	Invalidity Under 35 U.S.C. § 112	132
1.	Legal Background Regarding The Definiteness, Enablement, And Written Description Requirements	132

1
2
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24
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27
28

2.	Invalidity Grounds Under 35 U.S.C. § 112	134
a.	Lack of Enablement And Written Description.....	135
b.	Indefiniteness.....	137
VIII.	'781 PATENT	138
A.	Prior Art References.....	138
1.	Prior Art Patents and Publications.....	139
2.	Prior Art Products	150
B.	Invalidity Under 35 U.S.C. §§ 102 and 103	152
1.	Anticipation	153
2.	Obviousness	153
C.	Charts Identifying Disclosure in Prior Art Invalidating Asserted Claims	160
D.	Invalidity Under 35 U.S.C. § 112	160
1.	Legal Background Regarding The Definiteness, Enablement, And Written Description Requirements	160
2.	Invalidity Grounds Under 35 U.S.C. § 112	162
a.	Lack of Enablement And Written Description.....	163
b.	Indefiniteness.....	165
IX.	DOCUMENT PRODUCTION ACCOMPANYING PRELIMINARY INVALIDITY CONTENTIONS	165
X.	OTHER RESERVATIONS AND EXPLANATIONS	166

1 **I. INTRODUCTION**

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

- 10 • U.S. Patent No. 8,266,749 (the “749 Patent”) — Claims 1-8, 11-18, 21
11 (the “749 Asserted Claims”)
- 12 • U.S. Patent No. 9,060,562 (the “562 Patent”) — Claims 1-23 (the “562
13 Asserted Claims”)
- 14 • U.S. Patent No. 9,510,636 (the “636 Patent”) — Claims 1-27 (the “636
15 Asserted Claims”)
- 16 • U.S. Patent No. 9,730,484 (the “484 Patent”) — Claims 1, 5-9, 11-17 (the
17 “484 Asserted Claims”)
- 18 • U.S. Patent No. 9,918,511 (the “511 Patent”) — Claims 1-20 (the “511
19 Asserted Claims”)
- 20 • U.S. Patent No. 9,986,781 (the “781 Patent”) — Claims 1-20 (the “781
21 Asserted Claims”)

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

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27 ¹ Skechers notes that Nike did not serve infringement contentions on the date
28 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.

1 use the acronym “POSITA” to refer to a person having ordinary skill in the art to
2 which the claimed inventions pertain.

3 **II. PRIORITY DATE OF THE ASSERTED PATENTS AND CLAIMS**

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

- 6 • The ’749 Patent claims entitlement to a priority date of March 3, 2004.
- 7 • The ’562 Patent claims entitlement to a priority date of February 20,
8 2012.
- 9 • The ’636 Patent claims entitlement to a priority date of February 20,
10 2012.
- 11 • The ’484 Patent claims entitlement to a priority date of November 10,
12 2006.
- 13 • The ’511 Patent claims entitlement to a priority date of March 3, 2004.
- 14 • The ’781 Patent claims entitlement to a priority date of March 3, 2004.

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

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

20 **III. ’749 PATENT**

21 **A. Prior Art References²**

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

26
27 ² To the extent one or more prior art patents, publications, or products are
28 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 Publications³

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.

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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

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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

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

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

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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

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

14 **1. Anticipation**

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

23 **2. Obviousness**

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

1 35 U.S.C. § 103.

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

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

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

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

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

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

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

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

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

1 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
2 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
3 obvious because modifying the Admitted Prior Art/Betts combination to include a
4 second recess was nothing more than the predictable application of known
5 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
6 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
7 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
8 combine test, and instead applying an “expansive and flexible” approach). Indeed,
9 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
10 automaton” and “in many cases a POSITA will be able to fit the teachings of
11 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
12 Nevertheless, in addition to the information contained in the obviousness sections of
13 this document and elsewhere in these contentions, Skechers hereby identify
14 motivations and reasons to combine.

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

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

9 In addition, it would have been obvious to try combining the prior art
10 references identified above because there were only a finite number of predictable
11 solutions and/or because known work in one field of endeavor prompted variations
12 based on predictable design incentives and/or market forces either in the same field
13 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
14 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
15 he could place the thickness sensor either above the presence sensor in the feed, so
16 that the paper contacts the thickness sensor before the presence sensor, or below so
17 that the paper contacts it after. Each of these two design choices is an obvious
18 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
19 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
20 skilled artisan may have preferred a delayed-release formulation over the claimed
21 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
22 of a particular combination need not be supported by a finding that the prior art
23 suggests that the combination claimed ... is the preferred, or most desirable,
24 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004)); *KSR*,
25 550 U.S. at 419-20. Further, the combinations of the prior art references identified
26 above and in the claim charts would have been obvious because the combinations
27 represent known potential options with a reasonable expectation of success. *See*
28 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

1 Additional evidence that there would have been a motivation to combine the
2 prior art references identified above includes the interrelated teachings of multiple
3 prior art references; the effects of demands known to the design community or
4 present in the marketplace; the existence of a known problem for which there was an
5 obvious solution encompassed by the '749 Asserted Claims; the existence of a
6 known need or problem in the field of the endeavor at the time of the alleged
7 inventions; and the background knowledge that would have been possessed by a
8 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
9 incentives and other market forces can prompt variations of it, either in the same
10 field or in another. If a person of ordinary skill in the art can implement a
11 predictable variation, and would see the benefit of doing so, § 103 likely bars its
12 patentability. Moreover, if a technique has been used to improve one device, and a
13 person of ordinary skill in the art would recognize that it would improve similar
14 devices in the same way, using the technique is obvious unless its actual application
15 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
16 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
17 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
18 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
19 2012).

20 The motivation to combine the teachings of the prior art references disclosed
21 herein is also found in the references themselves and in: (1) the nature of the
22 problem being solved; (2) the express, implied and inherent teachings of the prior
23 art; (3) the knowledge of POSITAs; (4) the predictable results obtained in
24 combining the different elements of the prior art; (5) the predictable results obtained
25 in simple substitution of one known element for another; (6) the use of a known
26 technique to improve similar devices, methods, or products in the same way; (7) the
27 predictable results obtained in applying a known technique to a known device,
28 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.

1 **D. Invalidity Under 35 U.S.C. § 112**

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

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

12 The definiteness requirement requires that the claim must set forth what the
13 applicant regards as the invention, and do so with sufficient particularity and
14 definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
15 2002). Where it would be apparent to one of skill in the art, based on the patent
16 specification, that the “invention” set forth in a claim is not what the patent
17 applicant regarded as the invention, the claim is invalid. *Id.*

18 Section 112 further includes an enablement requirement: “The specification
19 shall contain a written description . . . of the manner and process of making and
20 using [the invention] in such full, clear, concise and exact terms as to enable any
21 person skilled in the art to which it pertains, or with which it is most nearly
22 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
23 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
24 those skilled in the art how to make and use the full scope of the claimed invention
25 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
26 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
27 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
28 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of

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

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

17 The specification must describe the claimed invention in sufficient detail so
18 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
19 words in a specification or a claim, even an original claim, does not necessarily
20 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
21 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
22 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
23 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
24 description requirement ... is necessarily met as a matter of law because the claim
25 language appears *in ipso verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
26 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

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

28 The grounds identified below both individually and collectively render the

1 '749 Asserted Claims invalid under the statutory requirements of § 112. By
2 identifying certain claim language below, Skechers does not imply that such
3 language is entitled to any patentable weight when comparing the claim as a whole
4 to the prior art. Skechers' identifications are made based on Skechers' present
5 understanding of the Asserted Claims and Nike's apparent interpretation of these
6 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
7 the right to amend these identifications, including in response to claim constructions
8 and claim interpretations that would render claim limitations not enabled, lacking in
9 written description, or indefinite.

10 **a. Lack of Enablement And Written Description**

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

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

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

1 Apparent Infringement Contentions, each of the asserted claims in which these
2 claim terms/phrases appear lack written description because the specification of the
3 '749 Patent demonstrates that the patentee neither conceived of nor demonstrated
4 possession of all that Nike now contends the claims cover. In addition, based on
5 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
6 of the asserted claims in which these claim terms/phrases appear are invalid because
7 the specification fails to provide sufficient disclosure to enable any POSITA to
8 which it pertains, or with which it is most nearly connected, to implement the
9 invention without undue experimentation.

10 **b. Indefiniteness**

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

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

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

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

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

3 **IV. '562 PATENT**

4 **A. Prior Art References⁵**

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

21 **1. Prior Art Patents and Publications⁶**

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

25 ⁵ To the extent one or more prior art patents, publications, or products are
26 identified in the claim charts attached hereto but are not included in the tables and
27 lists below, those prior art patents, publications, or products should also be considered
28 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.

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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
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 2,343,390	3/1944
US 2,400,692	5/1946
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 2,725,567	12/1955
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
US 3,952,427	4/1976

1	Prior Art	Date of Issue or Publication
2	US 3,972,086	8/1976
3	US 4,027,402	6/1977
4	US 4,031,586	6/1977
5	US 4,211,806	7/1980
6	US 4,216,662	8/1980
7	US 4,255,949	3/1981
8	US 4,317,292	3/1982
9	US 4,373,361	2/1983
10	US 4,447,967	5/1984
11	US 4,465,448	8/1984
12	US 4,499,741	2/1985
13	US 4,505,134	3/1985
14	US 4,607,439	8/1986
15	US 4,737,396	4/1988
16	US 4,750,339	6/1988
17	US 4,756,098	7/1988
18	US 4,785,558	11/1988
19	US 4,813,158	3/1989
20	US 5,095,720	3/1992
21	US 5,152,025	10/1992
22	US 5,192,601	3/1993
23	US 5,284,031	2/1994
24	US 5,337,493	8/1994
25	US 5,345,638	9/1994
26	US 5,353,524	10/1994
27	US 5,379,615	1/1995
28	US 5,461,884	10/1995
	US 5,511,323	4/1996

1	Prior Art	Date of Issue or Publication
2	US 5,572,860	11/1996
3	US 5,575,090	11/1996
4	US 5,729,918	3/1998
5	US 5,735,145	4/1998
6	US 5,746,013	5/1998
7	US 5,784,806	7/1998
8	US 5,823,012	10/1998
9	US 6,029,376	2/2000
10	US 6,065,311	5/2000
11	US 6,192,716	2/2001
12	US 6,196,030	3/2001
13	US 6,216,494	4/2001
14	US 6,299,962	10/2001
15	US 6,308,438	10/2001
16	US 6,321,574	11/2001
17	US 6,333,105	12/2001
18	US 6,401,364	6/2002
19	US 6,449,879	9/2002
20	US 6,558,784	5/2003
21	US 6,588,237	7/2003
22	US 6,910,288	6/2005
23	US 6,931,762	8/2005
24	US 6,981,393	1/2006
25	US 6,986,269	1/2006
26	US 7,051,460	5/2006
27	US 7,056,402	6/2006
28	US 7,082,703	8/2006
	US 7,347,011	3/2008

1	Prior Art	Date of Issue or Publication
2	US 7,424,783	9/2008
3	US 7,441,348	10/2008
4	US 7,682,219	3/2010
5	US 7,752,775	7/2010
6	US 7,770,306	8/2010
7	US 7,774,956	8/2010
8	US 7,814,598	10/2010
9	US 8,132,340	3/2012
10	US 8,196,317	6/2012
11	US 8,215,033	7/2012
12	US 8,225,530	7/2012
13	US 8,266,749	9/2012
14	US 8,448,474	5/2013
15	US 8,490,299	7/2013
16	US 8,621,891	1/2014
17	US 8,650,916	2/2014
18	US 8,745,895	6/2014
19	US 8,800,172	8/2014
20	US 9,675,134	6/2017
21	US 2001/0055684	12/2001
22	US 2002/0078599	6/2002
23	US 2002/0148258	10/2002
24	US 2003/0126762	7/2003
25	US 2003/0191427	10/2003
26	US 2003/0200679	10/2003
27	US 2004/0118018	6/2004
28	US 2005/0115284	6/2005
	US 2005/0193592	9/2005

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Prior Art	Date of Issue or Publication
US 2005/0284000	12/2005
US 2005/0288615	12/2005
US 2007/0180730	8/2007
US 2007/0227040	10/2007
US 2007/0294920	12/2007
US 2008/0017294	1/2008
US 2008/0110048	5/2008
US 2008/0189830	8/2008
US 2008/0313939	12/2008
US 2009/0068908	3/2009
US 2010/0051132	3/2010
US 2010/0077634	4/2010
US 2010/0107346	5/2010
US 2010/0154256	6/2010
US 2010/0170651	7/2010
US 2010/0263236	10/2010
US 2010/0269369	10/2010
US 2011/0078921	4/2011
US 2011/0185592	8/2011
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Rachael S. Davis, <i>Reebok: The Brand that</i>	11-12/2007

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Duke London, The Many Sides of Puma Clydes, https://thehundreds.com/blogs/content/the-many-sides-of-puma-clydes	12/2019
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Nancy E. Rexford, Women's Shoes in America, 1795-1930 (The Kent State University Press)	2000
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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 '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

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

17 **1. Anticipation**

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

26 **2. Obviousness**

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

1 whole would have been obvious to a POSITA at the time of the alleged invention,
2 based on the state of the art and knowledge of those skilled in the art. The item of
3 prior art would, therefore, render the relevant claims invalid for obviousness under
4 35 U.S.C. § 103.

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

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

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

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

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

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

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

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

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

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

1 at most would simply represent a known alternative to one of skill in the art. *See*
2 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
3 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
4 obvious because modifying the Admitted Prior Art/Betts combination to include a
5 second recess was nothing more than the predictable application of known
6 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
7 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
8 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
9 combine test, and instead applying an “expansive and flexible” approach). Indeed,
10 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
11 automaton” and “in many cases a POSITA will be able to fit the teachings of
12 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
13 Nevertheless, in addition to the information contained in the obviousness sections of
14 this document and elsewhere in these contentions, Skechers hereby identify
15 motivations and reasons to combine.

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

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

10 In addition, it would have been obvious to try combining the prior art
11 references identified above because there were only a finite number of predictable
12 solutions and/or because known work in one field of endeavor prompted variations
13 based on predictable design incentives and/or market forces either in the same field
14 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
15 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
16 he could place the thickness sensor either above the presence sensor in the feed, so
17 that the paper contacts the thickness sensor before the presence sensor, or below so
18 that the paper contacts it after. Each of these two design choices is an obvious
19 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
20 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
21 skilled artisan may have preferred a delayed-release formulation over the claimed
22 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
23 of a particular combination need not be supported by a finding that the prior art
24 suggests that the combination claimed ... is the preferred, or most desirable,
25 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004))); *KSR*,
26 550 U.S. at 419-20. Further, the combinations of the prior art references identified
27 above and in the claim charts would have been obvious because the combinations
28 represent known potential options with a reasonable expectation of success. *See*

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

2 Additional evidence that there would have been a motivation to combine the
3 prior art references identified above includes the interrelated teachings of multiple
4 prior art references; the effects of demands known to the design community or
5 present in the marketplace; the existence of a known problem for which there was an
6 obvious solution encompassed by the '562 Asserted Claims; the existence of a
7 known need or problem in the field of the endeavor at the time of the alleged
8 inventions; and the background knowledge that would have been possessed by a
9 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
10 incentives and other market forces can prompt variations of it, either in the same
11 field or in another. If a person of ordinary skill in the art can implement a
12 predictable variation, and would see the benefit of doing so, § 103 likely bars its
13 patentability. Moreover, if a technique has been used to improve one device, and a
14 person of ordinary skill in the art would recognize that it would improve similar
15 devices in the same way, using the technique is obvious unless its actual application
16 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
17 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
18 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
19 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
20 2012).

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

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

6 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
7 **Claims**

8 Skechers submits the following charts identifying specific locations in each
9 alleged item of prior art where each limitation of each asserted claim is found as
10 attached Exhibits 562-1 through 562-10. The contents of Exhibits 562-1 through
11 562-10, in combination with the foregoing patents, publications, and products,
12 anticipate and/or render obvious the '562 Asserted Claims under 35 U.S.C. § 102,
13 either expressly or inherently, and under § 103, in each case, as understood by a
14 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

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27 ⁷ An identification of a prior art reference for purposes of identifying an exhibit
28 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.*,

1 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
2 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
3 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
4 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
5 F.3d at 1383-84.

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

19 The specification must describe the claimed invention in sufficient detail so
20 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
21 words in a specification or a claim, even an original claim, does not necessarily
22 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
23 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
24 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
25 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
26 description requirement ... is necessarily met as a matter of law because the claim
27 language appears *in ipsius verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
28 *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

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

- 3 • “forming a course with the knitting machine that joins the integral knit
4 tongue to the upper” (Claim 4)
- 5 • “knitting the partially integral portion with the knitting machine of unitary
6 knit construction with the upper at the forward portion of the throat area
7 and at least along the portion of both of the lateral side and the medial side
8 of the throat area of the knitted component extending through the portion
9 of the length of the throat area in the longitudinal direction” (Claim 5)
- 10 • “knitting the free portion with the knitting machines of unitary knit
11 construction with the partially integral portion at a rearward portion of the
12 integral knit tongue and remaining portions of the knitted component”
13 (Claim 5)
- 14 • “the first portion of the upper including at least the rearward portion of the
15 integral knit tongue” (Claim 6)
- 16 • “the first portion of the upper moving with respect to the free portion
17 during knitting of the first portion of the upper” (Claim 7)
- 18 • “the step of knitting the second portion further comprises moving the free
19 portion and the upper together during knitting of the second portion of the
20 upper” (Claim 7)
- 21 • “knitting the exterior surface of the first portion of the upper with the
22 second feeder” (Claim 10)
- 23 • “the first portion of the upper is one of a medial side and a lateral side of
24 the knitted component” (Claim 11)

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

1 in such full, clear, concise and exact terms as to enable any person skilled in the art
2 to which it pertains, or with which it is most nearly connected, to make and use the
3 alleged invention. Moreover, based on Skechers' present understanding of Nike's
4 Apparent Infringement Contentions, each of the asserted claims in which these
5 claim terms/phrases appear lack written description because the specification of the
6 '562 Patent demonstrates that the patentee neither conceived of nor demonstrated
7 possession of all that Nike now contends the claims cover. In addition, based on
8 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
9 of the asserted claims in which these claim terms/phrases appear are invalid because
10 the specification fails to provide sufficient disclosure to enable any POSITA to
11 which it pertains, or with which it is most nearly connected, to implement the
12 invention without undue experimentation.

13 **b. Indefiniteness**

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

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

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

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

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

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

20 **E. Invalidity Under the Doctrine of Double Patenting**

21 The ’562 patent is also invalid for obvious-type double patenting. “[T]he
22 obviousness-type double patenting doctrine prohibits an inventor from extending his
23 right to exclude through claims in a later-expiring patent that are not patentably
24 distinct from the claims of the inventor’s earlier-expiring patent[.]” *Gilead Scis.,*
25 *Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1210 (Fed. Cir. 2014). Both the ’562 and
26 ’626 Patents issued from continuations-in-part of U.S. Patent App. No. 13/400,511
27 (the “’511 Application”), now Patent No. 8,448, 474 (the “’474 Patent”), and are
28 subject to patent term extensions of 141 days and 703 days, respectively. Therefore,

1 the '474, '562, and '636 Patents respectively have the expiration dates of February
2 20, 2032, July 10, 2032, and January 23, 2034. Moreover, U.S. Patent Nos.
3 8,621,891 (the "'891 Patent"), 9,032,763 (the "'763 Patent"), 9,420,844 (the "'844
4 Patent") all issued from a continuation or continuation-in-part application of the
5 '511 Application, and also have an expiration date of February 20, 2032. Because
6 the '562 Patent is a later-expiring patent than the '474, '891, 763, and 844 Patents,
7 and its claims are obvious variations of those of the '474, '891, 763, and 844
8 Patents, the '562 Asserted Claims are invalid and/or unenforceable for this
9 additional reason. *See, e.g., In re Collect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023).

10 **V. '636 PATENT**

11 **A. Prior Art References⁸**

12 Skechers identifies the following prior art presently known to Skechers to
13 anticipate the '636 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
14 (e), and/or (g), either expressly or inherently as understood by a POSITA, and/or to
15 render obvious under 35 U.S.C. § 103, either alone or in combination. Skechers
16 generally identifies and incorporates by reference herein all prior art and invalidity
17 arguments previously asserted against the '636 Patent, whether during the original
18 prosecution of the '636 Patent, before the Patent Trial and Appeals Board, or during
19 any of the litigations filed by Nike involving the '636 Patent, including, for
20 example, the adidas Litigation or the New Balance Litigation. In addition,
21 discovery is ongoing, and Skechers has served document requests and
22 interrogatories for which responses are outstanding that Skechers expects to reveal
23 additional prior art. Furthermore, Skechers is generally aware of information
24 pertaining to prior art from other proceedings that is currently unavailable to
25

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

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

4 **1. Prior Art Patents and Publications⁹**

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
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 2,034,091	3/1936
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
US 2,586,045	2/1952
US 2,608,078	8/1952
US 2,641,004	6/1953

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28 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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US 3,694,940	10/1972
US 3,704,474	12/1972
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US 3,778,856	12/1973
US 3,952,427	4/1976
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US 4,031,586	6/1977
US 4,211,806	7/1980
US 4,232,458	11/1980
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US 4,258,480	3/1981
US 4,317,292	3/1982
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	Prior Art	Date of Issue or Publication
1	US 5,095,720	3/1992
2	US 5,117,567	6/1992
3	US 5,152,025	10/1992
4	US 5,192,601	3/1993
5	US 5,337,493	8/1994
6	US 5,345,638	9/1994
7	US 5,353,524	10/1994
8	US 5,371,957	12/1994
9	US 5,461,884	10/1995
10	US 5,511,323	4/1996
11	US 5,572,860	11/1996
12	US 5,575,090	11/1996
13	US 5,623,840	4/1997
14	US 5,729,918	3/1998
15	US 5,735,145	4/1998
16	US 5,746,013	5/1998
17	US 5,765,296	6/1998
18	US 5,784,806	7/1998
19	US 5,823,012	10/1998
20	US 5,884,419	3/1999
21	US 5,996,189	12/1999
22	US 6,029,376	2/2000
23	US 6,032,387	3/2000
24	US 6,052,921	4/2000
25	US 6,088,936	7/2000
26	US 6,151,802	11/2000
27	US 6,170,175	1/2001
28	US 6,308,438	10/2001

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3	US 6,401,364	6/2002
4	US 6,449,879	9/2002
5	US 6,558,784	5/2003
6	US 6,588,237	7/2003
7	US 6,754,983	6/2004
8	US 6,910,288	6/2005
9	US 6,922,917	8/2005
10	US 6,931,762	8/2005
11	US D517,297	3/2006
12	US 7,051,460	5/2006
13	US 7,056,402	6/2006
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16	US 7,543,397	6/2009
17	US 7,568,298	8/2009
18	US 7,624,518	12/2009
19	US 7,682,219	3/2010
20	US 7,752,775	7/2010
21	US 7,770,306	8/2010
22	US 7,774,956	8/2010
23	US 7,814,598	10/2010
24	US 8,132,340	3/2012
25	US 8,196,317	6/2012
26	US 8,215,033	7/2012
27	US 8,225,530	7/2012
28	US 8,266,749	9/2012

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2	US 8,490,299	7/2013
3	US 8,621,891	1/2014
4	US 8,650,916	2/2014
5	US 8,745,895	6/2014
6	US 8,800,172	8/2014
7	US 9,675,134	6/13/2017
8	US 2001/0055684	12/2001
9	US 2002/0078599	6/2002
10	US 2002/0148258	10/2002
11	US 2003/0126762	7/2003
12	US 2003/0191427	10/2003
13	US 2003/0200679	10/2003
14	US 2004/0118018	6/2004
15	US 2004/0181972	9/2004
16	US 2004/0237348	12/2004
17	US 2005/0115284	6/2005
18	US 2005/0193592	9/2005
19	US 2005/0273.988	12/2005
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Mackenzie Lobby, <i>New Barefoot and Minimalist Trail Footwear</i> , Trailspace (Mar. 16, 2011)	3/2011
Justin, <i>Review NB Minimus Life by New Balance</i> , birthdayshoes	2/2011
J. Power, <i>9.6 Weft Knitwear in Fashion Applications</i> , in <i>Advances in Apparel Production</i> (Catherine Fairhurst, ed. 2008)	2008
Hong, H., et al. <i>The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine</i> , India Journal of Fibre and Textile Research, 1994, 19: 189-189	9/1994
Abounaim, M. D., C. Cherif. <i>Flat-knitted</i>	10/2011

Prior Art	Date of Issue or Publication
<i>innovative three-dimensional spacer fabrics: a competitive solution for lightweight composite applications</i> , Textile Research Journal, 2012, 82(3): 288-298	
Nishiwaki, <i>T Requirement Properties and Materials Used in Sport Shoes</i> , <i>Sen-I Gakkaishi</i> , 2009, 65(5): P150-P153	2009
Choi, Wonseok and Powell, Nancy B., <i>Three Dimensional Seamless Garment Knitting on V-Bed Flat Knitting Machines</i> , Journal of Textile and Apparel, Technology and Management, Vo. 4, Issue 3, Spring 2005	2005
H.J. Patrick, MODERN PATTERN CUTTING AND DESIGN (1983)	1983
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
Sadhan Chandra Ray, FUNDAMENTALS AND ADVANCES IN KNITTING TECHNOLOGY (2012)	2012
RJ Miller, MANUAL OF SHOEMAKING (1976)	1976
Tuxedo Slipper Book Volume 3, Tuxedo Yarn Company	NA
Anthonia Akitunde, Nike Unveils Its Big New Paradigm: Shoes Knit Like Socks, Fast Company (2/22/2012)	2/2012
Rachael S. Davis, Reebok: The Brand that Fits, TextileWorld.com	11-12/2007
Innovations in Knitting, www.textileworld.com/textile-world/knitting-apparel/2009/09/innovations-in-knitting/	9/2009
Jenny Underwood, The Design of 3D Shape	11/2009

Prior Art	Date of Issue or Publication
Knitted Preforms (PhD Dissertation), School of Fashion and Textiles, Design and Social Context Portfolio, RMIT University	
F. Saifee, The Influence of Knitwear on Smart Wearables	2009
N. Gokarneshan & R. Alagirusamy, Weaving of 3D Fabrics: A Critical Appreciation of the Developments, Textile Progress, 41(1): 1-58	2009
Dorin Ionesi, et al., Three-Dimensional Knitted Fabric with Technical Destination, Bulletinul Institutului Politehnic Din Iași	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-	9/2015

Prior Art	Date of Issue or Publication
richard/vintage-eastbay-sneaker-prices	
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, 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

Prior Art	Date of Issue or Publication
from Field to Fashion (Bloomsbury Publishing Plc)	
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.

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

2 Nike asserts claims 1-27 of the '636 Patent. All of those claims are invalid
3 because they fail to meet one or more of the requirements for patentability. The
4 individual bases for invalidity are provided below and in the attached claim charts.
5 Each of the foregoing listed prior art documents, the underlying work, and/or the
6 underlying apparatus or method qualifies as prior art under one or more sections of
7 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

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

1 **1. Anticipation**

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

10 **2. Obviousness**

11 To the extent any limitation is deemed not to be exactly met by an item of
12 prior art, any purported differences are such that the claimed subject matter as a
13 whole would have been obvious to a POSITA at the time of the alleged invention,
14 based on the state of the art and knowledge of those skilled in the art. The item of
15 prior art would, therefore, render the relevant claims invalid for obviousness under
16 35 U.S.C. § 103.

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

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

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

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

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

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

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

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

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

10 No showing of a specific motivation to combine prior art is required to
11 combine the references disclosed for any asserted patent in this document and in the
12 attached charts, as each combination of art would have yielded expected results and
13 at most would simply represent a known alternative to one of skill in the art. *See*
14 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
15 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
16 obvious because modifying the Admitted Prior Art/Betts combination to include a
17 second recess was nothing more than the predictable application of known
18 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
19 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
20 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
21 combine test, and instead applying an “expansive and flexible” approach). Indeed,
22 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
23 automaton” and “in many cases a POSITA will be able to fit the teachings of
24 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
25 Nevertheless, in addition to the information contained in the obviousness sections of
26 this document and elsewhere in these contentions, Skechers hereby identify
27 motivations and reasons to combine.

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

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

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

1 that the paper contacts the thickness sensor before the presence sensor, or below so
2 that the paper contacts it after. Each of these two design choices is an obvious
3 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
4 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
5 skilled artisan may have preferred a delayed-release formulation over the claimed
6 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
7 of a particular combination need not be supported by a finding that the prior art
8 suggests that the combination claimed ... is the preferred, or most desirable,
9 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004))); *KSR*,
10 550 U.S. at 419-20. Further, the combinations of the prior art references identified
11 above and in the claim charts would have been obvious because the combinations
12 represent known potential options with a reasonable expectation of success. *See*
13 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

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

1 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
2 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
3 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
4 2012).

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

18 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
19 **Claims**

20 Skechers submits the following charts identifying specific locations in each
21 alleged item of prior art where each limitation of each asserted claim is found as
22 attached Exhibits 636-1 through 636-9. The contents of Exhibits 636-1 through 636-
23 9, in combination with the foregoing patents, publications, and products, anticipate
24 and/or render obvious the ’636 Asserted Claims under 35 U.S.C. § 102, either
25 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.

1 2002). Where it would be apparent to one of skill in the art, based on the patent
2 specification, that the “invention” set forth in a claim is not what the patent
3 applicant regarded as the invention, the claim is invalid. *Id.*

4 Section 112 further includes an enablement requirement: “The specification
5 shall contain a written description . . . of the manner and process of making and
6 using [the invention] in such full, clear, concise and exact terms as to enable any
7 person skilled in the art to which it pertains, or with which it is most nearly
8 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
9 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
10 those skilled in the art how to make and use the full scope of the claimed invention
11 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
12 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
13 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
14 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
15 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
16 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
17 F.3d at 1383.

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

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

3 The specification must describe the claimed invention in sufficient detail so
4 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
5 words in a specification or a claim, even an original claim, does not necessarily
6 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
7 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
8 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
9 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
10 description requirement ... is necessarily met as a matter of law because the claim
11 language appears *in ipso verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
12 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

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

14 The grounds identified below both individually and collectively render the
15 ’636 Asserted Claims invalid under the statutory requirements of § 112. By
16 identifying certain claim language below, Skechers does not imply that such
17 language is entitled to any patentable weight when comparing the claim as a whole
18 to the prior art. Skechers’ identifications are made based on Skechers’ present
19 understanding of the Asserted Claims and Nike’s apparent interpretation of these
20 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
21 the right to amend these identifications, including in response to claim constructions
22 and claim interpretations that would render claim limitations not enabled, lacking in
23 written description, or indefinite.

24 a. Lack of Enablement And Written Description

25 Based on Skechers’ present understanding of the Asserted Claims and Nike’s
26 apparent interpretation of these claims as reflected in its Apparent Infringement
27 Contentions, the ’636 Asserted Claims fail to satisfy the requirements of § 112
28 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

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

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

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

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

25 **E. Invalidity Under the Doctrine of Double Patenting**

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

1 distinct from the claims of the inventor's earlier-expiring patent[.]” *Gilead Scis.,*
2 *Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1210 (Fed. Cir. 2014). Both the ’562 and
3 ’626 Patents issued from continuations-in-part of U.S. Patent App. No. 13/400,511,
4 now Patent No. 8,448, 474 (the “’474 Patent”), and are subject to patent term
5 extensions of 141 days and 703 days, respectively. Therefore, the ’474, ’562, and
6 ’636 Patents respectively have the expiration dates of February 20, 2032, July 10,
7 2032, and January 23, 2034. Moreover, U.S. Patent Nos. 8,621,891 (the “’891
8 Patent”), 9,032,763 (the “’763 Patent”), 9,420,844 (the “’844 Patent”) all issued
9 from a continuation or continuation-in-part application of the ’511 Application, and
10 also have an expiration date of February 20, 2032. Because the ’636 Patent is a
11 later-expiring patent than the ’474, ’562, 891, 763, and 844 Patents, and its claims
12 are obvious variations of those of the ’474, ’562, 891, 763, and 844 Patents, the ’636
13 Asserted Claims are invalid and/or unenforceable for this additional reason. *See,*
14 *e.g., In re Collect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023).

15 **VI. ’484 PATENT**

16 **A. Prior Art References¹¹**

17 Skechers identifies the following prior art presently known to Skechers to
18 anticipate the ’484 Asserted Claims under at least pre-AIA 35 U.S.C. §§ 102(a), (b),
19 (e), and/or (g) or AIA 35 U.S.C. § 102, either expressly or inherently as understood
20 by a POSITA, and/or to render obvious under 35 U.S.C. § 103, either alone or in
21 combination. Skechers generally identifies and incorporates by reference herein all
22 prior art and invalidity arguments previously asserted against the ’484 Patent,
23 whether during the original prosecution of the ’484 Patent, before the Patent Trial
24 and Appeals Board, or during any of the litigations filed by Nike involving the ’484
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27 ¹¹ To the extent one or more prior art patents, publications, or products are
28 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.

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

9 **1. Prior Art Patents and Publications¹²**

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.

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Prior Art	Date of Issue or Publication
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Prior Art	Date of Issue or Publication
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US 5,031,423	7/1991
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Prior Art	Date of Issue or Publication
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Caroline Cox, Vintage Shoes (Carlton Books)	2008
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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
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Wonseok Choi, et al., Three Dimensional Seamless Garment Knitting on V-Bed Flat Knitting Machines, 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

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

14 **1. Anticipation**

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

23 **2. Obviousness**

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

1 35 U.S.C. § 103.

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

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

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

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

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

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

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

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

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

1 obvious because modifying the Admitted Prior Art/Betts combination to include a
2 second recess was nothing more than the predictable application of known
3 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
4 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
5 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
6 combine test, and instead applying an “expansive and flexible” approach). Indeed,
7 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
8 automaton” and “in many cases a POSITA will be able to fit the teachings of
9 multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420-21.
10 Nevertheless, in addition to the information contained in the obviousness sections of
11 this document and elsewhere in these contentions, Skechers hereby identify
12 motivations and reasons to combine.

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

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

7 In addition, it would have been obvious to try combining the prior art
8 references identified above because there were only a finite number of predictable
9 solutions and/or because known work in one field of endeavor prompted variations
10 based on predictable design incentives and/or market forces either in the same field
11 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
12 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
13 he could place the thickness sensor either above the presence sensor in the feed, so
14 that the paper contacts the thickness sensor before the presence sensor, or below so
15 that the paper contacts it after. Each of these two design choices is an obvious
16 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
17 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
18 skilled artisan may have preferred a delayed-release formulation over the claimed
19 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
20 of a particular combination need not be supported by a finding that the prior art
21 suggests that the combination claimed ... is the preferred, or most desirable,
22 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004))); *KSR*,
23 550 U.S. at 419-20. Further, the combinations of the prior art references identified
24 above and in the claim charts would have been obvious because the combinations
25 represent known potential options with a reasonable expectation of success. *See*
26 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

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

1 prior art references; the effects of demands known to the design community or
2 present in the marketplace; the existence of a known problem for which there was an
3 obvious solution encompassed by the '484 Asserted Claims; the existence of a
4 known need or problem in the field of the endeavor at the time of the alleged
5 inventions; and the background knowledge that would have been possessed by a
6 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
7 incentives and other market forces can prompt variations of it, either in the same
8 field or in another. If a person of ordinary skill in the art can implement a
9 predictable variation, and would see the benefit of doing so, § 103 likely bars its
10 patentability. Moreover, if a technique has been used to improve one device, and a
11 person of ordinary skill in the art would recognize that it would improve similar
12 devices in the same way, using the technique is obvious unless its actual application
13 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
14 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
15 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
16 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
17 2012).

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

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

3 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
4 **Claims**

5 Skechers submits the following charts identifying specific locations in each
6 alleged item of prior art where each limitation of each asserted claim is found as
7 attached Exhibits 484-1 through 484-9. The contents of Exhibits 484-1 through 484-
8 9, in combination with the foregoing patents, publications, and products, anticipate
9 and/or render obvious the '484 Asserted Claims under 35 U.S.C. § 102, either
10 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

23 **D. Invalidity Under 35 U.S.C. § 112**

24 **1. Legal Background Regarding The Definiteness, Enablement,**
25 **And Written Description Requirements**
26

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

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

7 The definiteness requirement requires that the claim must set forth what the
8 applicant regards as the invention, and do so with sufficient particularity and
9 definiteness. *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
10 2002). Where it would be apparent to one of skill in the art, based on the patent
11 specification, that the “invention” set forth in a claim is not what the patent
12 applicant regarded as the invention, the claim is invalid. *Id.*

13 Section 112 further includes an enablement requirement: “The specification
14 shall contain a written description . . . of the manner and process of making and
15 using [the invention] in such full, clear, concise and exact terms as to enable any
16 person skilled in the art to which it pertains, or with which it is most nearly
17 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
18 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
19 those skilled in the art how to make and use the full scope of the claimed invention
20 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
21 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
22 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
23 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
24 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
25 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
26 F.3d at 1383-84.

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

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

12 The specification must describe the claimed invention in sufficient detail so
13 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
14 words in a specification or a claim, even an original claim, does not necessarily
15 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
16 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
17 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
18 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
19 description requirement ... is necessarily met as a matter of law because the claim
20 language appears *in ipsius verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
21 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

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

23 The grounds identified below both individually and collectively render the
24 ’484 Asserted Claims invalid under the statutory requirements of § 112. By
25 identifying certain claim language below, Skechers does not imply that such
26 language is entitled to any patentable weight when comparing the claim as a whole
27 to the prior art. Skechers’ identifications are made based on Skechers’ present
28 understanding of the Asserted Claims and Nike’s apparent interpretation of these

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

5 **a. Lack of Enablement And Written Description**

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

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

16 These claim terms/phrases as apparently construed and/or interpreted by Nike
17 violate the written description and/or enablement requirements of 35 U.S.C. § 112.
18 Each asserted claim of the '484 Patent is invalid as not containing a written
19 description of the invention, and of the manner and process of making and using it,
20 in such full, clear, concise and exact terms as to enable any person skilled in the art
21 to which it pertains, or with which it is most nearly connected, to make and use the
22 alleged invention. Moreover, based on Skechers' present understanding of Nike's
23 Apparent Infringement Contentions, each of the asserted claims in which these
24 claim terms/phrases appear lack written description because the specification of the
25 '484 Patent demonstrates that the patentee neither conceived of nor demonstrated
26 possession of all that Nike now contends the claims cover. In addition, based on
27 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
28 of the asserted claims in which these claim terms/phrases appear are invalid because

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

4 **b. Indefiniteness**

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

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

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

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

1 **VII. '511 PATENT**

2 **A. Prior Art References¹³**

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

19 **1. Prior Art Patents and Publications¹⁴**

20

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

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22
23
24

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

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

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

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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
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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

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

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

8 Nike asserts claims 1-21 of the '511 Patent. All of those claims are invalid
9 because they fail to meet one or more of the requirements for patentability. The
10 individual bases for invalidity are provided below and in the attached claim charts.
11 Each of the foregoing listed prior art documents, the underlying work, and/or the
12 underlying apparatus or method qualifies as prior art under one or more sections of
13 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

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

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

6 **1. Anticipation**

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

15 **2. Obviousness**

16 To the extent any limitation is deemed not to be exactly met by an item of
17 prior art, any purported differences are such that the claimed subject matter as a
18 whole would have been obvious to a POSITA at the time of the alleged invention,
19 based on the state of the art and knowledge of those skilled in the art. The item of
20 prior art would, therefore, render the relevant claims invalid for obviousness under
21 35 U.S.C. § 103.

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

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

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

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

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

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

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

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

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

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

15 No showing of a specific motivation to combine prior art is required to
16 combine the references disclosed for any asserted patent in this document and in the
17 attached charts, as each combination of art would have yielded expected results and
18 at most would simply represent a known alternative to one of skill in the art. *See*
19 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
20 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
21 obvious because modifying the Admitted Prior Art/Betts combination to include a
22 second recess was nothing more than the predictable application of known
23 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
24 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
25 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to
26 combine test, and instead applying an “expansive and flexible” approach). Indeed,
27 the Supreme Court held that a POSITA is “a person of ordinary creativity, not an
28 automaton” and “in many cases a POSITA will be able to fit the teachings of

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

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

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

1 solutions and/or because known work in one field of endeavor prompted variations
2 based on predictable design incentives and/or market forces either in the same field
3 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
4 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
5 he could place the thickness sensor either above the presence sensor in the feed, so
6 that the paper contacts the thickness sensor before the presence sensor, or below so
7 that the paper contacts it after. Each of these two design choices is an obvious
8 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
9 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
10 skilled artisan may have preferred a delayed-release formulation over the claimed
11 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
12 of a particular combination need not be supported by a finding that the prior art
13 suggests that the combination claimed ... is the preferred, or most desirable,
14 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004)); *KSR*,
15 550 U.S. at 419-20. Further, the combinations of the prior art references identified
16 above and in the claim charts would have been obvious because the combinations
17 represent known potential options with a reasonable expectation of success. *See*
18 *Wyers v. Master Lock Co.*, 616 F.3d at 1242

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

1 predictable variation, and would see the benefit of doing so, § 103 likely bars its
2 patentability. Moreover, if a technique has been used to improve one device, and a
3 person of ordinary skill in the art would recognize that it would improve similar
4 devices in the same way, using the technique is obvious unless its actual application
5 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
6 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
7 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
8 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
9 2012).

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

23 C. Charts Identifying Disclosure in Prior Art Invalidating Asserted 24 Claims

25 Skechers submits the following charts identifying specific locations in each
26 alleged item of prior art where each limitation of each asserted claim is found as
27 attached Exhibits 511-1 through 511-9. The contents of Exhibits 511-1 through 511-
28 9, in combination with the foregoing patents, publications, and products, anticipate

1 and/or render obvious the '511 Asserted Claims under 35 U.S.C. § 102, either
2 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

15 **D. Invalidity Under 35 U.S.C. § 112**

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

18 Section 112 includes a definiteness requirement: "[T]he specification shall
19 conclude with one or more claims particularly pointing out and distinctly claiming
20 the subject matter which the applicant regards as his invention." Pre-AIA 35 U.S.C.
21 § 112, ¶ 2; AIA 35 U.S.C. § 112(b). "[A] patent is invalid for indefiniteness if its
22 claims, read in light of the patent's specification and prosecution history, fail to
23 inform, with reasonable certainty, those skilled in the art about the scope of the
24 invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

25 The definiteness requirement requires that the claim must set forth what the
26 applicant regards as the invention, and do so with sufficient particularity and
27 definiteness. *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
28 2002). Where it would be apparent to one of skill in the art, based on the patent

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

3 Section 112 further includes an enablement requirement: “The specification
4 shall contain a written description . . . of the manner and process of making and
5 using [the invention] in such full, clear, concise and exact terms as to enable any
6 person skilled in the art to which it pertains, or with which it is most nearly
7 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
8 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
9 those skilled in the art how to make and use the full scope of the claimed invention
10 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
11 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
12 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
13 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
14 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
15 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
16 F.3d at 1383-84.

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

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

2 The specification must describe the claimed invention in sufficient detail so
3 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
4 words in a specification or a claim, even an original claim, does not necessarily
5 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
6 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
7 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
8 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
9 description requirement ... is necessarily met as a matter of law because the claim
10 language appears *in ipsius verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
11 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

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

13 The grounds identified below both individually and collectively render the
14 ’511 Asserted Claims invalid under the statutory requirements of § 112. By
15 identifying certain claim language below, Skechers does not imply that such
16 language is entitled to any patentable weight when comparing the claim as a whole
17 to the prior art. Skechers’ identifications are made based on Skechers’ present
18 understanding of the Asserted Claims and Nike’s apparent interpretation of these
19 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
20 the right to amend these identifications, including in response to claim constructions
21 and claim interpretations that would render claim limitations not enabled, lacking in
22 written description, or indefinite.

23 **a. Lack of Enablement And Written Description**

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

- 1 • “a flat knit textile element comprising [] flat knit edges free of surrounding
- 2 textile structure such that the flat knit edges are not surrounded by textile
- 3 structure from which the textile element must be removed” (Claims 1, 15)
- 4 • “a flat knit textile element comprising [] a first knit strip having a first
- 5 property and a second knit strip having a second property that is different
- 6 from the first property” (Claims 1, 15)
- 7 • “the first knit strip and the second knit strip are positioned adjacent to each
- 8 other along one or more of a lateral side and a medial side of the upper”
- 9 (Claims 1, 15)
- 10 • “one or both of the first knit strip and the second knit strip comprises a
- 11 plurality of knit strips” (Claims 2
- 12 • “the first and second knit strips alternate with one another along one or
- 13 more of the lateral side and the medial side of the upper” (Claim 3)
- 14 • “the flat knit textile element comprises at least two first knit strips and at
- 15 least two second knit strips” (Claim 4)
- 16 • “the first knit strip and the second knit strip extend along the lateral side of
- 17 the upper from an instep region of the upper to an area proximate to a
- 18 lower region of the upper” (Claim 5)
- 19 • “the first knit strip and the second knit strip extend along the medial side
- 20 of the upper from an instep region of the upper to an area proximate to a
- 21 lower region of the upper” (Claim 6)
- 22 • “the first property comprises a first knit construction and the second
- 23 property comprises a second knit construction” (Claim 7)
- 24 • “the first property of the first knit strip comprises a smooth texture, and the
- 25 second property of the second knit strip comprises a rough texture” (Claim
- 26 8)
- 27 • “the first property of the first knit strip comprises a higher degree of
- 28 stretch than the second property of the second knit strip” (Claim 10)

- 1 • “the second property of the second knit strip comprises a higher degree of
- 2 stretch than the first property of the first knit strip” (Claim 11)
- 3 • “the first property comprises a first yarn type and the second property
- 4 comprises a second yarn type” (Claim 12)
- 5 • “the first yarn type of the first knit strip comprises at least one of a higher
- 6 biodegradability, moisture absorption, insulation, durability, and/or
- 7 hydrophobicity than the second yarn type of the second knit strip” (Claim
- 8 13)
- 9 • “the first yarn type of the first knit strip comprises at least one of a higher
- 10 strength, support, stiffness, recovery, fit and/or form than the second yarn
- 11 type of the second knit strip” (Claim 14)
- 12 • “the first property comprises one or more of a first knit construction and a
- 13 first yam type and wherein the second property comprises one or more of a
- 14 first knit construction and a second yam type” (Claim 16)
- 15 • “the flat knit textile element comprises a plurality of first knit strips
- 16 extending along the lateral side and the medial side of the upper and a
- 17 plurality of second knit strips extending along the lateral side and the
- 18 medial side of the upper” (Claim 17)
- 19 • “the first knit strip is parallel to the second knit strip” (Claim 18)
- 20 • “the first knit strip and the second knit strip extend along the lateral side of
- 21 the upper from an instep region of the upper to an area proximate to the
- 22 sole structure” (Claim 19)
- 23 • “the first knit strip and the second knit strip extend along the medial side
- 24 of the upper from an instep region of the upper to an area proximate to the
- 25 sole structure” (Claim 20)

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

1 description of the invention, and of the manner and process of making and using it,
2 in such full, clear, concise and exact terms as to enable any person skilled in the art
3 to which it pertains, or with which it is most nearly connected, to make and use the
4 alleged invention. Moreover, based on Skechers' present understanding of Nike's
5 Apparent Infringement Contentions, each of the asserted claims in which these
6 claim terms/phrases appear lack written description because the specification of the
7 '511 Patent demonstrates that the patentee neither conceived of nor demonstrated
8 possession of all that Nike now contends the claims cover. In addition, based on
9 Skechers' present understanding of Nike's Apparent Infringement Contentions, each
10 of the asserted claims in which these claim terms/phrases appear are invalid because
11 the specification fails to provide sufficient disclosure to enable any POSITA to
12 which it pertains, or with which it is most nearly connected, to implement the
13 invention without undue experimentation.

14 **b. Indefiniteness**

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

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

- 24
 - "knit strip" (Claims 1-20)

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

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

6 **VIII. '781 PATENT**

7 **A. Prior Art References¹⁵**

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

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27 ¹⁵ To the extent one or more prior art patents, publications, or products are
28 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 **1. Prior Art Patents and Publications¹⁶**

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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	1/1932
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

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28 ¹⁶ 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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Prior Art	Date of Issue or Publication
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Prior Art	Date of Issue or Publication
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US 4,211,806	7/1980
US 4,219,945	9/1980
US 4,232,458	11/1980
US 4,255,949	3/1981
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US 4,317,292	3/1982
US 4,354,318	10/1982
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Prior Art	Date of Issue or Publication
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5	US 6,029,376	2/2000
6	US 6,032,387	3/2000
7	US 6,052,921	4/2000
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12	US 6,250,115	6/2001
13	US 6,308,438	10/2001
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JP 2006000258	1/2006
KR 880001710	4/1988
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KR 200309026Y1	3/2003
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NL 7304678	10/1974
WO 90/03744	4/1990
WO 98/20758	5/1998
WO 00/32861	6/2000
WO 02/31247	4/2002
Koester, A. W., Analyzing the Color, Design	1993

Prior Art	Date of Issue or Publication
and Texture of Fabric, Oregon State University Extension Service	
Burall, P., "CoID Design Awards," Design Circular Machines, International Standard, ISO 8117, Second Edition	6/1969
David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (3rd ed., Woodhead Publishing Ltd. 2001)	2/2003
Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth-Verlag GmnH 2002)	2001
Man-Made Fiber and Textile Dictionary	2002
Knitted Fabrics: Manufacture and Processing	1981
Bharat J. Gajjar, Warp Knit Fabrics Technologies	1976
J. Watel, The Milanese Machine: Little Progress Made in the Development of the Milanese Fabric	2007
Billy Hunter, Nike Flyknit: Quantum Leap for Flat Knitting	12/1921
Billy Hunter, Nike Flyknit: Ready, Steady, Go!	7/2012
R. Shishoo, Textiles in sport (Woodhead Publishing Ltd. 2005)	7/2012
Textile Machinery-Knitting Machines-Nominal Diameters of Circular Machines, International Standard, ISO 8117, Second Edition	2005
Manuals for Stoll Flat Knitting Machinery	2/2003
Hong, H., et al., <i>The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine</i> , India Journal of	No later than 3/3/2003
	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:

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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

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

9 **1. Anticipation**

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

18 **2. Obviousness**

19 To the extent any limitation is deemed not to be exactly met by an item of
20 prior art, any purported differences are such that the claimed subject matter as a
21 whole would have been obvious to a POSITA at the time of the alleged invention,
22 based on the state of the art and knowledge of those skilled in the art. The item of
23 prior art would, therefore, render the relevant claims invalid for obviousness under
24 35 U.S.C. § 103.

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

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

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

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

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

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

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

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

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

18 No showing of a specific motivation to combine prior art is required to
19 combine the references disclosed for any asserted patent in this document and in the
20 attached charts, as each combination of art would have yielded expected results and
21 at most would simply represent a known alternative to one of skill in the art. *See*
22 *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1379 (Fed. Cir. 2020)
23 (“[W]e affirm the Board’s conclusion that the challenged claims would have been
24 obvious because modifying the Admitted Prior Art/Betts combination to include a
25 second recess was nothing more than the predictable application of known
26 technology.”); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d
27 1336, 1344 (Fed. Cir. 2017); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415
28 (2007) (rejecting the “rigid” application of the teaching, suggestion, or motivation to

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

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

1 F.3d at 1344.

2 In addition, it would have been obvious to try combining the prior art
3 references identified above because there were only a finite number of predictable
4 solutions and/or because known work in one field of endeavor prompted variations
5 based on predictable design incentives and/or market forces either in the same field
6 or a different one. *See ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367
7 (Fed. Cir. 2016) (“The ordinary artisan would then be left with two design choices:
8 he could place the thickness sensor either above the presence sensor in the feed, so
9 that the paper contacts the thickness sensor before the presence sensor, or below so
10 that the paper contacts it after. Each of these two design choices is an obvious
11 combination of prior-art elements.” (citing *KSR Int’l Co.*, 550 U.S. at 421)); *Bayer*
12 *Pharma AG v. Watson Labs., Inc.*, 874 F.3d 1316, 1329 (Fed. Cir. 2017) (“While a
13 skilled artisan may have preferred a delayed-release formulation over the claimed
14 immediate-release formulation, ‘that the prior art as a whole suggests the desirability
15 of a particular combination need not be supported by a finding that the prior art
16 suggests that the combination claimed ... is the preferred, or most desirable,
17 combination.’” (quoting *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004)); *KSR*,
18 550 U.S. at 419-20. Further, the combinations of the prior art references identified
19 above and in the claim charts would have been obvious because the combinations
20 represent known potential options with a reasonable expectation of success. *See*
21 *Wyers v. Master Lock Co.*, 616 F.3d at 1242.

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

1 POSITA. *See KSR*, 550 U.S. at 401 (“When a work is available in one field, design
2 incentives and other market forces can prompt variations of it, either in the same
3 field or in another. If a person of ordinary skill in the art can implement a
4 predictable variation, and would see the benefit of doing so, § 103 likely bars its
5 patentability. Moreover, if a technique has been used to improve one device, and a
6 person of ordinary skill in the art would recognize that it would improve similar
7 devices in the same way, using the technique is obvious unless its actual application
8 is beyond that person's skill.”); *Arctic Cat Inc. v. Bombardier Recreational Prod.*
9 *Inc.*, 876 F.3d 1350, 1359-61 (Fed. Cir. 2017); *Intercontinental Great Brands*, 869
10 F.3d at 1344; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1003 (Fed. Cir.
11 2016); *Norgren Inc. v. Int’l Trade Comm’n*, 699 F.3d 1317, 1322-23 (Fed. Cir.
12 2012).

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

26 **C. Charts Identifying Disclosure in Prior Art Invalidating Asserted**
27 **Claims**

28 Skechers submits the following charts identifying specific locations in each

1 alleged item of prior art where each limitation of each asserted claim is found as
2 attached Exhibits 781-1 through 781-9. The contents of Exhibits 781-1 through 781-
3 9, in combination with the foregoing patents, publications, and products, anticipate
4 and/or render obvious the '781 Asserted Claims under 35 U.S.C. § 102, either
5 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

18
19 **D. Invalidity Under 35 U.S.C. § 112**

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

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

1 S. Ct. 2120, 2124 (2014).

2 The definiteness requirement requires that the claim must set forth what the
3 applicant regards as the invention, and do so with sufficient particularity and
4 definiteness. *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir.
5 2002). Where it would be apparent to one of skill in the art, based on the patent
6 specification, that the “invention” set forth in a claim is not what the patent
7 applicant regarded as the invention, the claim is invalid. *Id.*

8 Section 112 further includes an enablement requirement: “The specification
9 shall contain a written description . . . of the manner and process of making and
10 using [the invention] in such full, clear, concise and exact terms as to enable any
11 person skilled in the art to which it pertains, or with which it is most nearly
12 connected, to make and use the same[.]” Pre-AIA 35 U.S.C. § 112, ¶ 1; AIA 35
13 U.S.C. § 112(a). To satisfy the enablement requirement, the disclosure “must teach
14 those skilled in the art how to make and use the full scope of the claimed invention
15 without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d
16 1361, 1366 (Fed. Cir. 1997); *MagSil Corp. v. Hitachi Glob. Storage Techs., Inc.*,
17 687 F.3d 1377, 1381 (Fed. Cir. 2012); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993,
18 999 (Fed. Cir. 2008). If a specification teaches away from a substantial portion of
19 the claim or does not enable the full scope of the claim, there is no enablement. *AK*
20 *Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003); *see also MagSil Corp.*, 687
21 F.3d at 1383-84.

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

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

7 The specification must describe the claimed invention in sufficient detail so
8 that a POSITA can recognize what is claimed. “The appearance of mere indistinct
9 words in a specification or a claim, even an original claim, does not necessarily
10 satisfy that requirement.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916,
11 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted); *see also Nuvo*
12 *Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.*, 923 F.3d 1368,
13 1380 (Fed. Cir. 2019) (“We have expressly rejected the ‘argument that the written
14 description requirement ... is necessarily met as a matter of law because the claim
15 language appears *in ipso verbis* in the specification.” (quoting *Enzo Biochem, Inc.*
16 *v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002))).

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

18 The grounds identified below both individually and collectively render the
19 ’781 Asserted Claims invalid under the statutory requirements of § 112. By
20 identifying certain claim language below, Skechers does not imply that such
21 language is entitled to any patentable weight when comparing the claim as a whole
22 to the prior art. Skechers’ identifications are made based on Skechers’ present
23 understanding of the Asserted Claims and Nike’s apparent interpretation of these
24 claims as reflected in its Apparent Infringement Contentions, and Skechers reserves
25 the right to amend these identifications, including in response to claim constructions
26 and claim interpretations that would render claim limitations not enabled, lacking in
27 written description, or indefinite.

1 **a. Lack of Enablement And Written Description**

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

- 7 • “a flat knit textile element having [] flat knit edges free of surrounding
8 textile structure such that the flat knit edges are not surrounded by textile
9 structure from which the textile element must be removed” (Claims 1, 12)
10 • “the one or more ribs extending longitudinally comprises ribs spaced apart
11 from an area adjacent an instep region of the upper to an area adjacent a
12 lower region of the upper” (Claim 4)
13 • “the ribs are spaced apart at a uniform distance from the area adjacent the
14 instep region to the area adjacent the lower region” (Claim 6)
15 • “the one or more ribs are adjacent one or more regions having a smooth
16 texture” (Claim 7)
17 • “the one or more ribs comprise a plurality of ribs, at least one rib
18 terminating in the heel region and at least one rib terminating in the
19 midfoot region” (Claim 8)
20 • “the one or more ribs extending along the lateral side mirror the one or
21 more ribs extending longitudinally along the medial side” (Claim 10)
22 • “the one or more ribs comprise ribs of varying lengths” (Claim 11)
23 • “the one or more ribs on the lateral side and the one or more ribs on the
24 medial side extend from the forefoot region toward the heel region and
25 terminate in one of the midfoot region or the heel region” (Claim 12)
26 • “the one or more ribs on the lateral side and the one or more ribs on the
27 medial side each comprise ribs spaced apart from an area adjacent an
28 instep region of the upper to an area adjacent a lower region of the upper”

1 (Claim 15)

- 2 • “the ribs are spaced apart at a uniform distance” (Claim 16)
- 3 • “the one or more ribs on the lateral side and the one or more ribs on the
- 4 medial side are adjacent one or more regions having a smooth texture”
- 5 (Claim 17)
- 6 • “at least the one or more ribs on the lateral side comprise a plurality of
- 7 ribs, at least one rib terminating in the heel region and at least one rib
- 8 terminating in the midfoot region” (Claim 18)
- 9 • “the one or more ribs on the lateral side and the one or more ribs on the
- 10 medial side comprise ribs of varying lengths” (Claim 19)

11 These claim terms/phrases as apparently construed and/or interpreted by Nike

12 violate the written description and/or enablement requirements of 35 U.S.C. § 112.

13 Each asserted claim of the '781 Patent is invalid as not containing a written

14 description of the invention, and of the manner and process of making and using it,

15 in such full, clear, concise and exact terms as to enable any person skilled in the art

16 to which it pertains, or with which it is most nearly connected, to make and use the

17 alleged invention. Moreover, based on Skechers' present understanding of Nike's

18 Apparent Infringement Contentions, each of the asserted claims in which these

19 claim terms/phrases appear lack written description because the specification of the

20 '562 Patent demonstrates that the patentee neither conceived of nor demonstrated

21 possession of all that Nike now contends the claims cover. In addition, based on

22 Skechers' present understanding of Nike's Apparent Infringement Contentions, each

23 of the asserted claims in which these claim terms/phrases appear are invalid because

24 the specification fails to provide sufficient disclosure to enable any POSITA to

25 which it pertains, or with which it is most nearly connected, to implement the

26 invention without undue experimentation.

27 **b. Indefiniteness**

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

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

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

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

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

21 **IX. DOCUMENT PRODUCTION ACCOMPANYING PRELIMINARY** 22 **INVALIDITY CONTENTIONS**

23 Skechers is producing documents , including prior art in its possession
24 referenced above, as well as well specifications and schematics sufficient to show
25 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

1 these Preliminary Invalidity Contentions.

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

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

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

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

1 any IPR proceedings. For example, Skechers reserves the right to assert that the
2 Asserted Claims are invalid under 35 U.S.C. § 101 or pre-AIA 35 U.S.C. § 102(f)
3 and/or in the event that Skechers obtains evidence that the named inventors did not
4 invent (either alone or in conjunction with others) the subject matter claimed in the
5 Asserted Patents. Should Skechers obtain such evidence, they will provide the
6 name(s) of the person(s) from whom and the circumstances under which the claimed
7 invention or any part of it was derived. Similarly, Skechers reserves the right to
8 right to assert that the Asserted Claims are invalid under pre-AIA 35 U.S.C.
9 § 102(d) or § 102(e) in the event that Skechers obtains evidence establishing that
10 one or more of the claimed inventions in the Asserted Claims was patented, caused
11 to patented, or subject to an inventor certificate meeting the provisions of § 102(d)
12 or was described in a patent or patent application meeting the provisions of § 102(e).

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

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

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

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

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

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

26
27 Dated: May 17, 2024

Respectfully submitted,

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1 **PROOF OF SERVICE**

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

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

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



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

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

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

18 Jim I. Manzano
19 (JManzano@irell.com)
20 (Type or print name)

21 /s/ Jim Manzano
22 (Signature)