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Re: *HandsFree Labs Licensing, LLC, et al. v. Skechers U.S.A., Inc.*, No. 2:25-cv-00744-JRG (E.D. Tex.): IPR2026-00342, U.S. Patent No. 11,633,006

Counsel:

Skechers U.S.A., Inc. ("Skechers") has filed a petition seeking *inter partes* review of claim 1 of U.S. Patent No. 11,633,006 (the '006 Patent). The Patent Trial and Appeal Board ("PTAB") has assigned that proceeding AIA Review No. IPR2026-00342. Please take notice that Skechers hereby stipulates as follows:

If the PTAB institutes the IPR and institution is not vacated, reversed or otherwise withdrawn, then Skechers will not pursue in Civil Action No. 2:25-cv-00744-JRG (E.D. Tex.), or in any related U.S. district court litigation, as a § 102 or § 103 ground of invalidity against the '006 Patent claim challenged in the IPR, any of the following: (i) the grounds raised in the IPR; (ii) any ground that reasonably could have been raised in the IPR; (iii) any ground asserting a combination of product prior art (i.e., art that is not a patent or printed publication) with any reference asserted as part of a ground raised in the IPR, except as set forth below; or (iv) any ground asserting product prior art corresponding to any reference asserted as part of a ground raised in the IPR.

Notwithstanding subpart (iii) above, Skechers reserves the right to assert in litigation grounds based on its own product prior art (i.e., Skechers shoes) alone or in combination with CN109393642A ("Hongren"). Among other things, Skechers' own prior art shoes, alone or in combination with Hongren's heel counter, comprise all features that Plaintiffs have accused of infringing the '006 Patent. Skechers would thus be unduly prejudiced if it were to forego these grounds in litigation, as it could not have asserted them in the IPR (even with printed publications about Skechers' shoes) because that would require arguing inconsistent positions

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as to non-infringement in the litigation and invalidity in the IPR, contrary PTAB authority.¹ This is so because Skechers contends its accused shoes do not infringe the '006 Patent, and its prior art shoes include many of the same features that Skechers contends do not infringe. As arguments in the alternative are permissible in district court, Skechers reserves the right to argue in litigation that, under Plaintiffs' overbroad infringement theories, Skechers' prior art shoes alone or in combination with Hongren would render claim 1 of the '006 Patent invalid.

Sincerely,



Christopher Abernethy

¹ See, e.g., *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential) ("The Board's claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums.... That is not the case here, however, as petitioners continue to propose different claim constructions in the two forums. Allowing petitioners to continue this practice does not further the Office's goal of 'providing greater predictability and certainty in the patent system.'") (citing 83 Fed. Reg. 51,340, 51,342-43 (Oct. 11, 2018)).