

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKECHERS U.S.A., INC.,
Petitioner

v.

FAST IP, LLC,
Patent Owner

Case IPR2026-00342
U.S. Patent No. 11,633,006

PATENT OWNER'S PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	<i>Handsfree Labs Licensing LLC v. Skechers, U.S.A., Inc.</i> , Case No. 2-25-cv-00744-JRG (E.D. Tex.), Second Amended Complaint and Jury Demand, filed Dec. 19, 2025
2002	<i>Handsfree Labs Licensing LLC v. Skechers, U.S.A., Inc.</i> , Case No. 2-25-cv-00744-JRG (E.D. Tex.), Second Amended Docket Control Order, filed Dec. 23, 2025
2003	Conrad, J., “Kizik’s Hands-Free Tech Is Coming to New Balance,” <i>Inc.</i> , Mar. 26, 2026, accessed at https://www.inc.com/jennifer-conrad/kiziks-hands-free-tech-is-coming-to-new-balance/91319850 (last accessed July 14, 2026)
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2008	Daniels, M., “Inside Kizik’s Quest to Dominate the Hands-Free Shoe Space Through Intellectual Property,” <i>Modern Retail</i> , Apr. 18, 2025, accessed at https://www.modernretail.co/operations/inside-kiziks-quest-to-dominate-the-hands-free-shoe-space-through-intellectual-property/ (last accessed July 14, 2026)
2009	Welty, M., “The Designer Behind the Nike Benassi Slide Is Changing Slip-On Footwear,” <i>Complex</i> , Mar. 10, 2025, accessed at https://www.complex.com/sneakers/a/matt-welty/andreas-harlow-nike-kizik-interview (last accessed July 14, 2026)
2010	Docket Navigator Report showing Success Rate of Motions to Stay Pending <i>Inter Partes</i> Review before Judge Rodney Gilstrap, generated June 8, 2026
2011	Miller, C., “Transforming Giants: Inside 3G Capital’s Most Successful Acquisitions,” <i>CEOWORLD magazine</i> , Oct. 7, 2024, accessed at https://ceoworld.biz/2024/10/07/transforming-giants-inside-3g-capitals-most-successful-acquisitions/ (last accessed July 14, 2026)
2012	Examiner’s Search Strategy and Results in U.S. Patent Application No. 17/965,501, filed Jan. 30, 2023
2013	<i>Handsfree Labs Licensing LLC v. Skechers, U.S.A., Inc.</i> , Case No. 2-25-cv-00744-JRG (E.D. Tex), Skechers U.S.A., Inc.’s Preliminary Invalidity Contentions, filed Mar. 2, 2026
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2015	Ireland, S. (2026, March 11). Alex Behring and Daniel Schwartz on Why 3G Capital’s Model is Rewriting the Rules of Private Equity. Retrieved June 29, 2026, from https://ceoworld.biz/2026/03/11/alex-behring-and-daniel-schwartz-on-why-3g-capitals-model-is-rewriting-the-rules-of-private-equity/

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2018	“HandsFree Labs Receives Strategic Investment From Nike,” <i>PR Newswire</i> , Nov. 20, 2019, accessed at https://www.prnewswire.com/news-releases/handsfree-labs-receives-strategic-investment-from-nike-300962516.html (last accessed July 14, 2026)
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2020	Who Owns 3G Capital? Founders, Partners, and Structure. (2026, June 11.) Retrieved June 29, 2026, from https://legalclarity.org/who-owns-3g-capital-founders-partners-and-structure/
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2022	“The Ultimate Guide to Skechers Hands-Free Slip-ins®,” <i>SKECHERS</i> , accessed at https://www.skechers.com/stories/comfort-technology/what-is-skechers-hands-free-slip-ins.html (last accessed July 15, 2026)
2023	“Hands-Free Slip-ins® vs. Traditional Slip-Ons: What’s the Difference?,” <i>SKECHERS</i> , accessed at https://www.skechers.com/stories/comfort-technology/skechers-hands-free-slip-ins-vs-slip-ons.html (last accessed July 15, 2026)
2024	Declaration of Robert W. Erb

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2025	<i>Curriculum Vitae</i> of Robert W. Erb
2026	Ryder, S. “Step by Step. Shoe Design and Development,” CoDesign Collaborative, accessed at https://codesigncollaborative.org/step-by-step-shoe-design/ (last accessed July 30, 2026)
2027	“When Technology meets your shoes,” Kizik, accessed at https://kizik.com/pages/tech-demo (last accessed July 30, 2026)

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<i>Chevron Oronite Co. LLC v. Infineum USA L.P.</i> , IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018).....	37
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I. INTRODUCTION

The Board should deny institution of *inter partes* review of U.S. Patent No. 11,633,006 (“the ’006 patent”) on the merits. While slip-on shoes have been around for centuries, *see, e.g.*, Pet., 1-2, hands-free shoes and boots that are donned and doffed easily while at the same time fitting like a traditional shoe have not. Skechers even admits that there is a large gap between a traditional slip-on shoe and hands-free experience, stating that traditional slip-ons are defined by a “lack of traditional fasteners like laces or buckles” but still require “slight hand assistance” by “using a finger to hold the back of the shoe open”, require “wiggling your foot to get it settled correctly”, and can result in “sometimes crushing the heel counter” because the heel is “often flexible/collapsible.” *See* EX2023.

Even the recent easy entry sneaker trend has produced shoes plagued by myriad design problems rendering them (1) no more convenient than traditionally fastening shoes because they are difficult to slip on and off and/or still require the wearer to bend over and use their hands (e.g., to fasten Velcro®, zippers, or pull ties), and/or (2) of limited functionality because they slip off too easily and/or provide inadequate foot support for athletic use, and/or (3) uncomfortable because the dynamic elements that provide the slip-on functionality rub or pinch the wearer.

As Patent Owner's expert states, the Petition misleadingly suggests that because the words used to identify the different elements of the patented shoe (such as a sole, an upper, a foot opening, a stabilizer, and elastic elements) can be found in the prior art, the claimed combination is therefore obvious. EX2024, ¶50. But obviousness is not established by identifying individual claim elements in isolation. Rather, Patent Owner's expert explains that each element of the claimed shoe has a specific shape and configuration and each element interacts with the other elements as part of a carefully engineered whole to solve problems that had remained unsolved for many years. EX2024, ¶¶73-80.

The Petition also falsely states that Patent Owner Fast IP, LLC is a "non-practicing patent monetization entity." *Contra* Pet., 1. It is the IP holding affiliate of Kizik, a revolutionary shoe company that innovates, manufactures, and sells hands-free sneakers. *See* EX2027 ("Kizik uses HandsFree Labs® technology in every shoe"). Kizik has invented numerous patented shoe technologies directed to longstanding challenges in shoes, including embodiments that slip on quickly without needing to work the foot into position by maneuvering or shimmying the foot within the shoe during insertion, embodiments that do not slip off accidentally during high-performance activities like running, and embodiments that fit snugly and provide stability while also being easy to remove on demand. EX2024, ¶29. By reducing the physical effort required to put on and remove footwear, the

claimed technology is particularly beneficial for individuals with disabilities, mobility limitations, injuries, age-related impairments, or other conditions that make conventional footwear difficult to use.

As discussed by Patent Owner’s expert, the challenged patent reflects a carefully engineered design in which the precise structure, relative positioning, and interaction of every component are all carefully designed in an intentional construction to work together as a cohesive unit to provide a specific function, fit, and feel that is not possible for any individual component in isolation. *See generally* EX1001; *see also* EX2024 ¶¶34-35, 72-74. Indeed, claim 1 of the ’006 patent is nearly a page of text, historically called a “picture claim.” *Id.*; *see In re Float ‘N’ Grill LLC*, 72 F.4th 1347, 1349 (Fed. Cir. 2023). It recites, in detail, a very specific design that is found nowhere in the prior art. *See M. Eagles Tool Warehouse, Inc. v. Fisher Tooling Co.*, 439 F.3d 1335, 1341-42 (Fed. Cir. 2006) (a claim that “recites in detail nearly all of the features of the invention” is “often referred to as a ‘picture claim’”). The purpose of such claims is to distinguish a holistic invention from similar prior art in a crowded field.

Unable to identify the complete combination in any single prior-art reference, the Petition is forced to piece together five different references in six different variations of two different Grounds. EX2024, ¶50. Those references disclose materially different footwear designs and address different objectives, and

none of them—alone or in the Petition’s various alternative combinations—disclose Patent Owner’s intentional construction resulting in the specific combination recited by claim 1 as a whole. EX2024, ¶¶51-62. Accordingly, the Petition fails to show even a likelihood that claim 1 is invalid.

II. BACKGROUND

The challenged patent arises from pioneering innovations in hands-free footwear technology. The invention addresses a technically difficult footwear problem: how to allow a user to step into a shoe without using hands, bending down, or tying laces, while still providing the fit, structure, and retention expected from ordinary footwear. *See* EX1001, Abstract, 1:20-30, 1:47-62; EX2024, ¶¶35-37. Contrary to Petitioner’s accusations, Pet., 1, Utah-based Kizik Design, LLC (“Kizik”) and its U.S. owners and inventors spent considerable time and R&D money developing and commercializing hands-free technologies through hands-free footwear sold under its Kizik® brand; Patent Owner, Utah-based FAST IP, LLC, holds the patent assets commercialized by Kizik; and Utah-based HandsFree Labs Licensing, LLC controls the licensing of those patent assets. Each is wholly owned by U.S.-based HandsFree Labs, Inc. (“HFL”). EX2001, ¶¶3, 12-14; *see also* Paper 6 (Patent Owner’s Mandatory Notices).

Patent Owner’s corporate structure reflects a conventional operating company model for protecting and commercializing technologies. One affiliate

holds the patent assets, another manages licensing rights, and the product company practices the technologies in the market. Here, the HFL corporate family (“HFL family”) includes the inventors, the patent assets, the licensing function, and the well-known Kizik® brand. The HFL family continues inventing, patenting, and commercializing multiple hands-free footwear technologies. Today, Kizik has served millions of customers with distribution in over 40 countries, while the HFL family’s technologies are protected by more than 200 patents and patent applications worldwide. EX2001, ¶4. Thus, contrary to the Petition’s suggestion, Patent Owner is part of an American corporate family that practices its patents in the technologies and products it develops and sells.

The HFL family includes the innovators that first successfully commercialized hands-free footwear. Kizik launched in 2017 as the world’s original hands-free shoe brand, based on Utah-based founder Michael Pratt’s foundational work developing shoes that could be put on without bending over or tying laces. After years of experimentation, prototyping, and investment, Kizik released its first hands-free sneaker using a heel structure that compressed during foot entry and rebounded to secure the foot. EX2001, ¶3; EX2024, ¶ 32.

Independent industry coverage has consistently identified the HFL family as pioneers in the category, including coverage by Modern Retail, TechBuzz,

Complex, Forbes, Women’s Wear Daily, and Gear Patrol, to name just a few. *See, e.g.*, EX2004; EX2005; EX2006; EX2007; EX2008; EX2009.

The widespread industry recognition reflects the HFL family’s commercialization and licensing of its innovative technology. In 2019, Nike—the world’s largest footwear company, with a long history of innovation and more patents than any other footwear company—made a strategic investment in HFL and entered a licensing partnership, recognizing the HFL family as a pioneer in hands-free footwear technology. EX2001, ¶4. Since then, Kizik has continued to sell hands-free footwear under its own brand, while HFL has licensed its technology platform to established footwear companies. Industry coverage has reported on the HFL family’s award-winning status, expanding product lines, patent portfolio, and licensing relationships. EX2003; EX2006.

While many recognized the HFL family’s innovations through industry praise and licensing, Skechers took a different path—entering the category after the HFL family had already pioneered, patented, commercialized, and licensed the technology. Skechers launched its Hands Free Slip-ins and other hands-free products without requesting a license and simply incorporated the HFL family’s patented technologies into its own “Skecherized” versions. EX2001, ¶¶1, 5. Indeed, analysts have observed that Skechers has a “notorious reputation as one of the biggest knock-off brands in the world” and “built its entire business model

on stealing other brands' designs." EX2001, ¶2. The present dispute thus concerns a serial infringer that competes directly with a U.S.-based Patent Owner's groundbreaking technology.

III. OVERVIEW OF THE '006 PATENT AND COMPREHENSIVE EXAMINATION

The '006 patent is entitled "Rapid-Entry Footwear Having a Stabilizer and an Elastic Element." EX1001, 1. It was filed on October 13, 2022, as a continuation of application 16/942,335, which claims priority to provisional application 62/879,883, filed on July 29, 2019. The '006 patent discloses a rapid-entry shoe with a stabilizer to resist collapse of the rear portion of the shoe during use while still permitting hands-free entry. EX1001, Abstract; EX2024, ¶¶29, 38-39. Such a shoe can be put on without bending over to tie laces, making everyday tasks easier, faster, and more convenient. EX2001, ¶3; EX2024, ¶49. This technology is particularly beneficial for people with disabilities, mobility limitations, injuries, age-related impairments, or other conditions that make conventional footwear hard to use. EX2001, ¶3.

The Examiner performed a comprehensive examination of the '006 patent, which included two separate searches (searches that Skechers conveniently omits from its select "excerpted" prosecution history submitted with the Petition). Collectively, the search strategy and results total 222 pages and include over 3000 queries. EX2012. The Examiner further issued a double-patenting rejection and

Patent Owner responded by submitting a terminal disclaimer. EX1002, 8-15. After considering the search results and all references cited in Information Disclosure Statements, the Examiner concluded the claims were allowable and mailed a Notice of Allowance. EX1002, 5-7. Patent Owner paid the issue fee and the '006 patent issued.

The Petition identifies no material error in the Examiner's analysis. There is none. Instead, it invites the Board to revisit issues already considered during examination while disregarding the extensive review conducted through the Examiner's prior-art search and consideration. The Petition thus fails to present an argument on the merits worthy of the Board's limited resources.

IV. PERSON OF ORDINARY SKILL IN THE ART

For purposes of this Preliminary Response only, Patent Owner does not dispute Petitioner's definition of a person of ordinary skill in the art ("POSITA"). EX2024, ¶¶26-28. Patent Owner reserves the right to challenge Petitioner's proposed level of ordinary skill and to present a different definition should this decision be instituted.

V. THE PETITION FAILS ON THE MERITS.

The Board should deny institution on the merits because the Petition fails to provide proper translation certificate for its primary references, the Petition fails to show that all limitations of the challenged claim can be found in the prior art, the

Petition fails to articulate its grounds with particularity, and the Petition fails to establish a motivation to combine the references relied upon in its obviousness analysis. These failures are especially apparent in Grounds 1D, 1F, and 2B, which are presented only in cursory fashion and do not identify which references purportedly teach which limitations. *See* Pet., 68, 76, 92. This is not the particularized showing required by statute and is independently grounds for denial for failure to meet the statutory requirements. 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.104(b)(4). This problem is not merely one of presentation. As explained below, Petitioner's invalidity theories depend on internally inconsistent assumptions about what the references teach, why a skilled artisan would be motivated to combine those references, and how the resulting shoe would function.

A. Petitioner does not submit a proper translation certificate for its primary references

At the outset, each of Petitioner's asserted grounds is deficient because the primary references do not contain an affidavit in accordance with 37 C.F.R. § 42.63(b). Takahashi (EX1006) is a Japanese-language patent and the translation provided (EX1008) does not include a proper affidavit in accordance with 37 C.F.R. § 42.63(b). Kim (EX1020) is a Japanese-language patent and the translation provided (EX1022) does not include a proper affidavit in accordance with 37 C.F.R. § 42.63(b). Shin (EX1010) is a Korean-language patent and the translation provided (EX1015) does not include a proper affidavit in accordance with 37

C.F.R. § 42.63(b). Finally, Hongren (EX1016) is a Chinese-language reference and the translation provided (EX1018) does not include a proper affidavit in accordance with 37 C.F.R. § 42.63(b). Petitioner thus asks the Board to rely on English translations of foreign-language references without providing the sworn attestations that the Board’s rules expressly require. The Petition fails for this reason alone.

Rule 42.63(b) requires: “When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and *an affidavit attesting to the accuracy of the translation must be filed with the document.*” 37 C.F.R. § 42.63(b) (emphasis added). Under the Board’s rules, the term “affidavit” is defined to include an “affidavit or declaration under § 1.68 of this chapter.” 37 C.F.R. § 42.2. Rule 1.68 states:

Such declaration may be used in lieu of the oath otherwise required, *if, and only if*, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant’s own knowledge are true and that all statements made on information and belief are believed to be true.

37 C.F.R. § 1.68 (emphasis added).

The “Certification of Accuracy of Translation” provided with Takahashi is limited to the following statement:

I, Patti Miyano, hereby certify that the attached Japanese to English translation is, to the best of my knowledge, a true and accurate translation of “JP3212460U”. The translated text reflects the content, meaning and style of the original text and constitutes a true and accurate translation of the original document.

EX1008 (“Takahashi Certification”). This Certification is not an affidavit because it was not made under oath, and the Certification can qualify as a permitted declaration under Rule 1.68 only if the declarant is warned on the same document that willful false statements and the like are punishable by fine or imprisonment, or both. *See Ford Motor Co. v. Cruise Control Techs.*, IPR2014-00281, Paper 17, at 6 (P.T.A.B. July 2, 2014). No such warning is included in the Certification here.

The “Certification of Accuracy of Translation” provided with Kim is limited to the following statement:

I, Patti Miyano, hereby certify that the attached Japanese to English translation is, to the best of my knowledge, a true and accurate translation of “JP3153220U”. The translated text reflects the content, meaning and style of the original text and constitutes a true and accurate translation of the original document.

EX1006 (“Kim Certification”). This Certification is also not an affidavit because it was not made under oath, and the Certification can qualify as a permitted declaration under Rule 1.68 only if the declarant is warned on the same document that willful false statements and the like are punishable by fine or imprisonment, or both. No such warning is included in the Certification here.

The “Certification of Accuracy of Translation” provided with Shin is similarly limited to the following statement:

I, BEOMJIN KIM, hereby certify that the attached Korean to English translation is, to the best of my knowledge, a true and accurate translation of “Certified Copy of KR10-2019-0048102.” The translated text reflects the content, meaning and style of the original text and constitutes a true and accurate translation of the original document.

EX1015 (“Shin Certification”). As with the other references, this Certification is not an affidavit because it was not made under oath, and the Certification can qualify as a permitted declaration under Rule 1.68 only if the declarant is warned on the same document that willful false statements and the like are punishable by fine or imprisonment, or both. No such warning is included here.

Finally, the “Certification of Accuracy of Translation” provided with Hongren is limited to the following statement:

I, YAO Gang, hereby certify that the attached Chinese (Simplified) to English translation is, to the best of my knowledge, a true and accurate translation of CN109393642A. The translated text reflects the content, meaning and style of the original text and constitutes a true and accurate translation of the original document.

EX1018 (“Hongren Certification”). This Certification is not an affidavit because it was not made under oath, and the Certification can qualify as a permitted declaration under Rule 1.68 only if the declarant is warned on the same document that willful false statements and the like are punishable by fine or imprisonment, or both. No such warning is included in the Certification here.

Although in some early instances the Board has waived its rules and allowed correction of the translation certification, the Board should not do so here. The requirements of this rule have now been well-established, and denial of institution also is an appropriate result for failing to comply with the translation certification rules. *See Shenzhen Aurora Tech. Co., Ltd. v. Putco, Inc.*, IPR2020-00670, Paper 10, at 5-6 (P.T.A.B. Aug. 27, 2020) (denying institution for failure to comply with the Board’s rules regarding translation affidavit). Because all the asserted grounds rely on at least one of these references, the Petition should be denied.

B. The Petition fails to show a motivation to combine across all of its obviousness grounds.

In an IPR, “the burden of proving a proposition of unpatentability” is borne by (and remains at all times with) the petitioner. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016). To satisfy its burden, a petitioner must “articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness”—“mere conclusory statements” will not suffice. *Id.* at 1380. Indeed, “[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)).

“An obviousness determination requires finding that a [POSITA] would have been motivated to combine or modify the teachings in the prior art *and* would have had a reasonable expectation of success in doing so.” *Regents of the Univ. of Cal. v. Broad Inst., Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018); *Intelligent Bio-Sys.*, 821 F.3d at 1367-68; *see also, e.g., NJOY, LLC v. JUUL Labs, Inc.*, IPR2024-00536, Paper 17 (P.T.A.B. Aug. 12, 2024) (denying institution where petitioner did not show a reasonable expectation of success in combining the asserted references); *Honeywell Int’l Inc. v. DSM IP Assets B.V.*, IPR2024-00493, Paper 7 (P.T.A.B. Aug. 21, 2024) (same).

“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). The fact that the combination might have been successful does not mean that a POSITA would have been motivated to make the combination. *See id.* It is not sufficient “for obviousness that a variation of the prior art would predictably work, but requires consideration of whether, in light of factors such as ‘design incentives and other market forces,’ the hypothetical skilled artisan would recognize the potential benefits and pursue the variation.” *Id.* at 1075 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)).

The Petition ignores that each cited reference purports to be a complete and unique solution to specific problems that lack any holes or deficiencies needing to be filled, not a collection of interchangeable parts. *See* EX1007, ¶0037; EX1009, 4:10-5:37; EX1017, ¶¶0023-0025; EX1019, 2:8-35; EX1021, ¶¶0007-0008; EX2024, ¶¶65, 71. Each reference teaches a complete footwear design in which the disclosed components are intended to function together as part of an integrated whole to solve a unique problem. EX1021, ¶¶0029-0032; EX1007, ¶¶0071-0085; EX1019, 2:8-22 (Description of the Preferred Embodiment); EX1017, ¶¶0022-0025; EX1009, 4:10-6:8; EX2024, ¶31. They do not teach that individual components can be severed from their surrounding structures, transplanted into materially different footwear designs, and expected to perform and function in the same way.

To the contrary, a skilled artisan would understand that features such as a heel support, elastic sidewall, foam strip, and stabilizing structure derive their function from the surrounding structures and combination of structures of the shoe in which they appear. EX2024, ¶36. Their shapes, relative positions, and points of contact matter. EX2024, ¶66. In light of this, Petitioner fails to explain why a skilled artisan would extract individual features from the prior-art references and reassemble them into the specific configuration claimed in the '006 patent absent impermissible hindsight. Indeed, one of skill in the art would not take the heel

support of one shoe, for instance, and combine it with the resilient sidewall of a different shoe, because the shape of the heel support is designed to cooperate with every other part of *that* shoe; each surface and contour playing a specific role in the overall functionality of the whole. EX2024, ¶¶67.

Petitioner's motivation-to-combine analysis asserts that because the references disclose all of the individual footwear components, a skilled artisan would have rearranged them to reach the claim. The Petition does not provide any motivation to modify and combine the references, other than to say that it could be done. *See, e.g.*, Pet., 57-62, 65-68, 69-70, 74-76, 89-95. But footwear design is not an à-la-carte exercise in selecting isolated structures from unrelated shoes.

EX2024, ¶¶47, 71-72. In reality, the claimed configuration reflects a unique balance between resilient and rigid structures, support and flexibility, and ease of entry and secure retention. EX2024, ¶¶48, 73. The asserted prior-art references strike those balances differently, using different shapes, arrangements, and structural relationships. *See, e.g.*, EX1007, ¶¶0010, 0024, 0074-0077 (discussing how the heel curve retains the heel and the guide portion permits entry); EX2024, ¶¶51-62.

To the extent the prior-art teachings are combinable at all, the combination would not yield the same result as the claims without further modification attributable only to hindsight. EX2024, ¶78. Footwear designers simply do not start

with existing pieces of designs and then look to combine them. They start with a unique problem to solve and then design a complete unique solution looking forward. They do not work backwards from existing designs. EX2024, ¶¶30-35. Petitioner never supplies a non-hindsight reason why a skilled artisan would disturb the existing designs in the prior art, let alone why an artisan would modify them in the precise way required to arrive at claim 1 of the '006 patent. EX2024, ¶79. Petitioner's approach is therefore legally impermissible hindsight bias, and a factually erroneous treatment of the POSITA.

A proposed modification is not obvious where the prior art provides no reason to make the change. *See In re Gordon*, 733 F.2d 900, 902-03 (Fed. Cir. 1984). In *Gordon*, the Office argued that a prior-art gasoline strainer could be inverted so that both the inlet and outlet were located at the bottom. *Id.* at 902. The court rejected that theory, explaining that the relevant inquiry is “whether it would have been obvious ... to turn the prior art apparatus upside down,” not merely whether such a modification is possible. *Id.* The court emphasized that “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *Id.* at 902-03.

The Petition here suffers from the same deficiency. Although a combination of multiple prior art references may separately disclose elastic sides, a rigid heel

cup, and foam elements, they do not disclose or suggest the claimed unique combination in which those components are arranged and shaped to work together in the '006 patent. EX2024, ¶80. In the claimed design, those elements are not merely present; they are arranged in a specific manner that governs how the rear portion of the shoe deforms, rebounds, supports the foot, and resists collapse. EX2024, ¶81. Petitioner does not identify any prior-art teaching that would have led a skilled artisan to select those elements from among the different shoes, reposition them as claimed, and expect the resulting arrangement to preserve the functionality of the original designs. EX2024, ¶82. Simply taking the individual components from the prior art and assembling them as shown in the references, without the benefit of the claimed disclosure, would not produce the claimed arrangement. *See id.* Where, as here, the prior art does not suggest the claimed configuration, and the references do not depict the elements arranged and shaped as recited, the asserted modification does not support a finding of obviousness. EX2024, ¶¶65-66.

Similarly, an asserted combination is not obvious where it purports to incorporate a feature from one reference without accounting for accompanying structures necessary for its operation. *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1331-32 (Fed. Cir. 2019). Prior art must be considered “as a whole,” “not selectively.” *Id.* at 1332 (affirming that a piecemeal combination lacked

adequate support in the art). Although the prior art cited in the Petition identifies certain individual components, including elastic sides, a rigid heel cup, and foam elements, it depicts those features in arrangements that differ from the claimed configuration.

Petitioner's theory combines prior-art elements without accounting for the differences in shape and arrangement reflected in the claimed design and its supporting disclosure. An obviousness analysis must account for the *context* in which structural features are disclosed. *Henny Penny*, 938 F.3d at 1331-32. Here, the prior art provides no basis to depart from the shapes and arrangements shown in those references to arrive at the claimed configuration, and there is no indication that such a modification would be made absent the teachings of the disclosure. EX2024, ¶75. The claimed invention therefore is not the predictable result of combining known parts. Instead, the invention reflects a specific arrangement and shaping of those parts in a way that would not have been obvious to combine by looking at the prior art. EX2024, ¶76.

Indeed, Petitioner itself publicly describes the products accused in the co-pending litigation of practicing the '006 patent as a complete system, in which each physical part of the shoe is designed to work in cooperation with the other parts. *See, e.g.*, EX2022 (saying "Skechers Hands-Free Slip-ins® technology uses a specially molded heel panel and an exclusive Heel Pillow™ to allow you to step

into your shoes without bending down,” and describing the same system recited in claim 1 of the ’006 patent as “a revolutionary approach to footwear design”); EX2023 (distinguishing traditional slip-on footwear from shoes embodying the technology claimed in the ’006 patent); EX2024, ¶¶77. That description underscores the flaw in the Petition. The very technology Petitioner seeks to invalidate depends on cooperation among structures, yet the Petition treats those structures as freely interchangeable pieces.

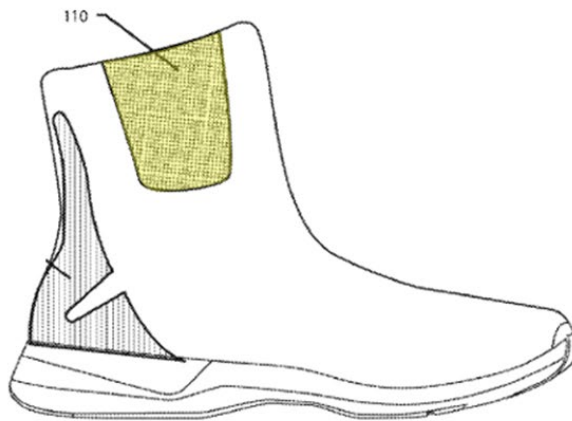
Finally, it is not a proper obviousness theory to selectively substitute individual components from different prior-art references where the substitution would alter the fundamental operation of the device. *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016); EX2024, ¶¶30, 74. That is especially true where the substitution of one element would require changes to the surrounding structures, especially when the prior art does not teach or suggest such a modification. *Id.*

The elements identified in the Petition are not interchangeable components, but features whose structure and function are linked to the surrounding design of the footwear. EX2024, ¶ 65. The claimed configuration depends on the interaction between the concave foam strip, the rigid heel cup, and the elastic side panels, including how those components conform to and support the foot. EX2024, ¶ 42. Substituting prior-art versions of these elements without accounting for their

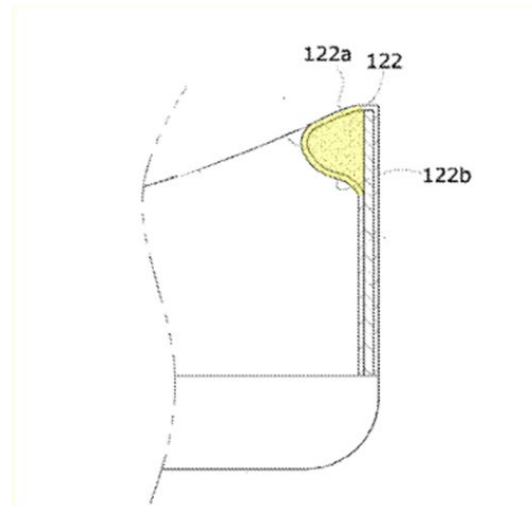
differing shapes and structural roles would alter how the shoe distributes load and maintains fit. EX2024, ¶¶43-45, 74.

The elastic element claimed is located in the side portions of the shoe, while the elastic portion of Shin is clearly in the heel portion. The placement of the elastic portion, in turn impacts the other structural components of the shoe, such as the stability of the heel, and its ability to counter the stretching of the elastic. EX2024, ¶46.

Elastic Element



006 Patent



Shin

The differences among the foam liners are even more pronounced. The structure named “foam liner” in the ’006 patent is a heel lock. It deforms to allow the heel to pass over while putting the shoe on and then returns to its shape to lock the heel in place during wear. EX2024, ¶¶42-45. The foam liner in Murray, by contrast, covers a large area of the inside of the shoe and provides comfort and stability, but not specifically a heel lock. Indeed, the lining in Murray covers the

front portion of the shoe as well, and that front liner cooperates with the side and rear portions to provide overall stability.

Foam Liner

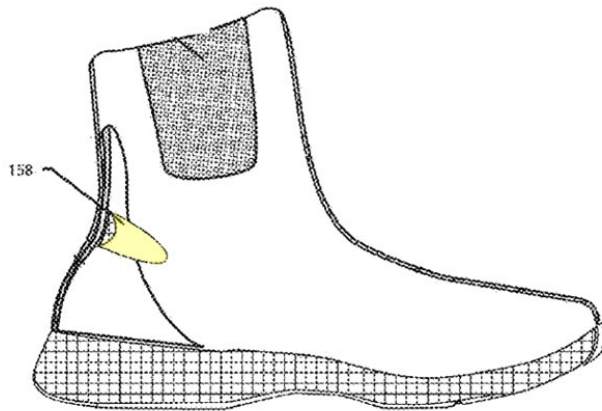


FIG. 1C

006 Patent

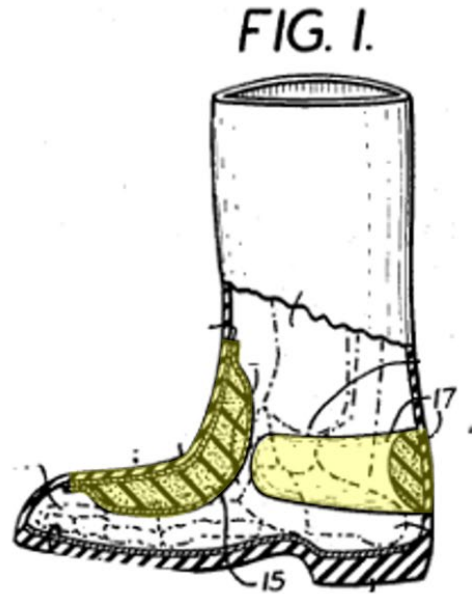
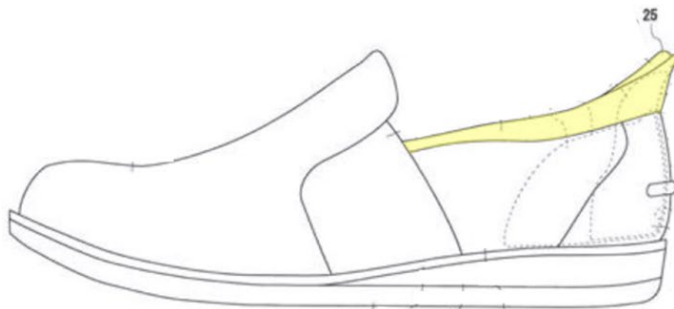
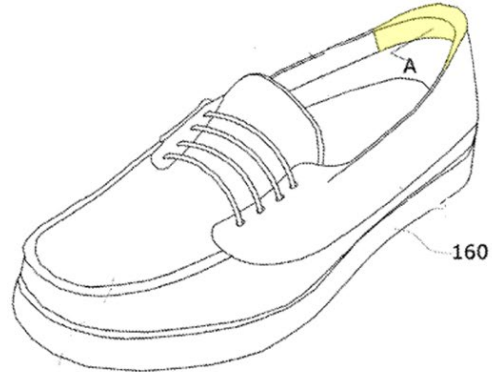


FIG. 1.

Murray



Takahashi



Shin

Takahashi and Shin are similarly different structures and functions. They do not provide heel-block foam liners at all. Rather, they provide simple linings to help mitigate the heel of the shoe rubbing against the wearer's Achilles tendon.

These linings are simply for comfort and do not provide the same function as a foam liner as claimed. These differences are not inconsequential.

As in *TriVascular*, Petitioner's proposed modification is not a simple substitution. It would require additional redesign of the surrounding structure to maintain functionality, yet the prior art does not teach or suggest such redesign. *Id.* Because the Petition identifies no evidence-based reason why a skilled artisan would make those redesign choices, let alone why the resulting shoe would work as intended, the asserted combinations of prior art do not establish a reasonable likelihood that the claim is obvious.

C. The Petition fails to articulate the grounds with particularity.

The Petition must establish, with particularity, the grounds and evidence that support invalidating the patented claims. 35 U.S.C. § 312(a)(3). Petitioner "must 'specify where each element of the claim is found in the [relied upon] prior art patents.'" *In-Depth Geophysical, Inc. v. ConocoPhillips Co.*, IPR2019-00850, Paper 56 at 27 (P.T.A.B. Sept. 3, 2020) (quoting 37 C.F.R. § 42.104(b)(4)). The Petition repeatedly fails to satisfy that basic requirement.

As shown below, every one of the grounds fails the particularity requirement in some respect.

Ground	Limitation	Cited Art	Particularity Failure
1A	1[c]	Takahashi	Petition does not identify what portions of Takahashi allegedly correspond to the claimed base portion and elevated portion of the stabilizer.
1A	1[f]	Takahashi	Petition relies interchangeably on guide portion 26 and guide core portion 33 without identifying which structure satisfies the limitation or tying the alleged stabilizer to the foot-guiding function.
1A	1[h]	Takahashi	Petition cites guide core portion 33 and the material properties of first portion 28 without connecting those disclosures to the claimed requirement that the stabilizer resist downward collapse.
1A	1[i]	Takahashi	Petition asserts that the liner on flared guide portion 26 forms the claimed U-shape oriented toward the sole portion, but provides no analysis explaining how the cited structure satisfies the limitation.
1B	1[c]	Takahashi + Shin	Petition does not identify in Shin which portions of the allegedly modified stabilizer correspond to the claimed base portion and elevated portion and does not make clear whether Shin replaces or is combined with Takahashi.
1B	1[d]	Takahashi + Shin	Petition does not explain whether limitation 1[d] is supposedly met by Takahashi, Shin, or some undefined combination of the two.
1B	1[e]	Takahashi + Shin	Petition does not explain whether limitation 1[e] is supposedly met by Takahashi, Shin, or some undefined combination of the two.
1B	1[f]	Takahashi + Shin	Petition does not explain whether limitation 1[f] is supposedly met by Takahashi, Shin, or some undefined combination of the two.
1B	1[i]	Takahashi + Shin	Petition does not explain whether limitation 1[i] is supposedly met by Takahashi, Shin, or some undefined combination of the two.

Ground	Limitation	Cited Art	Particularity Failure
1C	1[c]	Takahashi + Hongren	Petition does not identify which Takahashi elements or Hongren elements allegedly correspond to the stabilizer, base portion, or elevated portion, and does not clearly articulate the proposed modification.
1D	1[c]	Takahashi + Shin + Hongren	Petition does not explain which structure ultimately forms part of the asserted three-reference combination or how the resulting structure satisfies limitation 1[c].
1E	1[i]	Takahashi + Murray	Petition asserts that three Murray inserts are oriented concave toward the sole portion without analyzing the orientation of each insert or explaining how each satisfies the claim language.
1F	Claim 1 Generally	Takahashi + Hongren + Murray	Petition relies on generalized cross-references and does not identify the actual Takahashi-Hongren-Murray combination or explain how that combination satisfies claim 1.
2A	1[c]	Kim + Shin	Petition inconsistently relies on heel portion 4, heel guide portion 4a, and core material 9 without identifying the claimed stabilizer, base portion, or elevated portion.
2A	1[d]	Kim + Shin	Petition does not identify the claimed medial and lateral portions of the sole portion or how the cited U-shaped heel portion defines a closed cup.
2A	1[e]	Kim + Shin	Petition relies on the curvature of heel guide portion 4a without identifying any curvature extending from the claimed base portion toward the elevated portion.
2A	1[f]	Kim + Shin	Petition cites both heel portion 4 and heel guide portion 4a without explaining which structure allegedly satisfies the claimed limitation.
2A	1[i]	Kim + Shin	Petition incorporates Shin by reference but does not identify which structure from Kim or Shin constitutes the claimed foam liner or how the proposed combination teaches limitation 1[i].

Ground	Limitation	Cited Art	Particularity Failure
2B	1[c]	Kim + Hongren + Murray	Petition does not identify the resulting Kim-Hongren-Murray structure or which reference supplies which limitation, including the base portion.
	Claim 1 Generally	Kim + Hongren + Murray	Petition incorporates Takahashi-based sections into a Kim-based ground without identifying which teachings are supplied by Kim, Hongren, or Murray, or what resulting structure is proposed.

Each of these failures is discussed in further detail below.

1. Ground 1A – Takahashi fails to plead its obviousness theory with particularity

Regarding claim limitation 1[c], the Petition fails to articulate the grounds of obviousness with particularity because it never identifies what portions of Takahashi allegedly correspond to the claimed “base portion” and “elevated portion” of the stabilizer. The Petition appears to cite counter 27 as the stabilizer but does not explicitly define the base portion and elevated portion. Pet., 28-31.

For limitation 1[f], the Petition relies interchangeably on both “guide portion 26” and “guide core portion 33” without identifying which structure allegedly satisfies the limitation. Pet., 35-37. The Petition relies on the foot guiding properties of guide portion 26, which is part of the shoe, not the alleged stabilizer, and does not tie guide core portion 33 back to the foot guiding properties of guide portion 26. *Id.* This internal inconsistency and conflation of separate structures cannot teach a single limitation in the claims.

For limitation 1[h], the Petition again relies on disparate disclosures without explaining how they collectively satisfy the claim language. Petition cites guide core portion 33 and the material properties of first portion 28. Pet., 39-40. But Takahashi explains that the guide core portion 33 that maintains the shape of guide portion 26 is part of second portion 29. *See* EX1007, ¶0063. Takahashi further explains that the second counter 29 is soft compared to the first counter 28 and that the second counter 29 may be made of a shape memory resin so that guide portion 33 can return to its original shape if deformed by a person's foot. EX1007, ¶¶0067-0068. The Petition never connects these disclosures to the specific requirements of limitation 1[h]. If anything, they teach the inverse of the claim limitation.

For limitation 1[i], Petitioner asserts that the liner on flared guide portion 26 forms the claimed U-shape oriented towards the sole portion. Pet., 42-43. But the Petition provides no analysis explaining why the highlighted structure constitutes the claimed U-shape or how the cited disclosure satisfies that limitation. Once again, it was incumbent on Petitioner to provide both an interpretation of the claim limitation that supports its theory, and an interpretation of the prior-art teaching that satisfies that limitation as Petitioner interprets it. Petitioner has done neither. For at least these reasons, the Petition fails to articulate with particularity the grounds for a finding of obviousness.

2. Ground 1B - Takahashi in view of Shin fails to plead its obviousness theory with particularity and fails to articulate a coherent motivation to combine

The Petition relies on Shin in combination with Takahashi to attempt to cure deficiencies in its showing for limitation 1[c]. The Petition fails to articulate the grounds of obviousness as it never identifies in Shin which portions of the allegedly modified stabilizer correspond to the claimed “base portion” and “elevated portion” which Takahashi failed to disclose. Pet., 46-48. Additionally, the Petition never clearly articulates what modification it is actually proposing. It is unclear whether Petitioner contends that Takahashi’s alleged stabilizer would be replaced with Shin’s stabilizer, or whether Petitioner instead proposes combining features from both structures. For example, the motivation to combine section discusses “incorporating Shin’s heel support member and foam liner into Takahashi’s shoe.” Pet., 58. But elsewhere, the Petition discusses incorporating Shin’s foam liner into Takahashi’s heel counter. Pet., 59.

The Petition likewise never explains how the stabilizer allegedly taught by Shin teaches or suggests the remaining stabilizer-related limitations, including limitations 1[d], 1[e], 1[f], and 1[i]. Petitioner has thus failed to provide an interpretation of the claim limitation that supports its theory, and failed to provide an interpretation of the prior-art teaching that satisfies that limitation as Petitioner interprets it. Nor does Petitioner explain whether limitations 1[d], 1[e], 1[f], and

1[i] are supposedly met by Takahashi, Shin, or some undefined combination of the two. Such ambiguity falls well short of the particularized showing required by 35 U.S.C. § 312(a)(3). The combination of Takahashi and Shin therefore fails because the Petition does not identify with particularity what modified structure is being proposed, which reference allegedly supplies which limitations, or why a skilled artisan would be motivated to combine these prior-art references in the undefined manner.

3. Ground 1C - Takahashi in view of Hongren fails to plead its obviousness theory with particularity and fails to articulate a coherent motivation to combine

The Petition never identifies which elements of Takahashi and which portions of Hongren allegedly correspond to the stabilizer. Pet., 63-64. Nor does the Petition identify which structures in the prior art purportedly satisfy the claimed “base portion” and “elevated portion” of limitation 1[c]. Additionally, the Petition never clearly articulates the proposed modification.

At one point, Petitioner appears to propose incorporating Hongren’s heel cup into Takahashi’s shoe. Pet., 65. Elsewhere, Petitioner appears to rely on Hongren’s embedding portion as the relevant modification. Pet., 67-68; EX2024, ¶58. The Petition never explains whether these are alternative theories or part of a single proposed combination. Because the Petition does not clearly identify the resulting structure, it fails to explain how the modified shoe allegedly satisfies claim 1[c] or

the remaining stabilizer-related limitations with the particularity required by 35 U.S.C. § 312(a)(3). Combining these prior-art references therefore fails because the Petition never identifies a single coherent Takahashi-Hongren combination, much less explains with particularity which structures satisfy the stabilizer limitations or why a skilled artisan would have been motivated to make that undefined modification.

4. Ground 1D - Takahashi in view of Shin in further view of Hongren fails to plead its three-reference obviousness theory with particularity

The Petition again fails to identify which prior-art reference allegedly teaches or suggests each limitation of claim 1. That deficiency is particularly pronounced for limitation 1[c], where the Petition previously relied on both Shin and Hongren to supply the alleged stabilizer. The Petition never explains which structure ultimately forms part of the asserted three-reference combination. Pet., 68. Nor does the Petition clearly identify the resulting structure produced by combining Takahashi, Shin, and Hongren, or explain how the combined structure allegedly satisfies the claim limitations. Pet., 69-70. The Board should not be required to reconstruct Petitioner's obviousness theory from scattered references to multiple alternative modifications. This combination therefore fails because the Petition does not plead with particularity which three-reference structure is being proposed or how that structure allegedly satisfies limitation 1[c].

5. Ground 1E - Takahashi in view of Murray fails to plead its obviousness theory with particularity

The Petition claims that first insert 20, second insert 21, and third insert 22 are all oriented concave towards the sole portion. Pet., 72-73. But the Petition never explains how three inserts located in different portions of the shoe—and exhibiting different orientations—can each satisfy the same requirement that they be “oriented concave toward the sole portion.” EX1001, 12:5-6; EX2024, ¶¶59-60. The Petition simply asserts that conclusion without analyzing the orientation of each insert or explaining how each cited structure satisfies the claim language. This prior-art combination therefore fails because the Petition does not plead with particularity how the Murray inserts satisfy the requirement that the foam liner be oriented concave toward the sole portion.

6. Ground 1F - Takahashi in view of Hongren in further view of Murray fails to plead its three-reference theory with particularity

The Petition again fails to identify which reference allegedly teaches which limitation of claim 1. Rather than providing a limitation-by-limitation analysis, the Petition broadly cites to sections VIII, X, and XII of the Petition. Pet., 76. As a result, the Petition imports the failures of those sections and then compounds that failure. The Petition never clearly identifies the structure allegedly resulting from the combination of Takahashi, Hongren, and Murray, nor does it explain how that resulting structure satisfies the challenged claim. Such

generalized cross-references do not satisfy Petitioner's obligation to identify its challenge with particularity under 35 U.S.C. § 312(a)(3), because they do not even identify which portions of the earlier analysis form the basis for the ground. This prior-art combination therefore fails because the Petition never identifies the actual Takahashi-Hongren-Murray combination being advanced or explains how that combination allegedly satisfies claim 1.

7. Ground 2A - Kim in view of Shin fails to plead its obviousness theory with particularity and fails to articulate a coherent motivation to combine

The Petition never clearly identifies the structure that allegedly constitutes the claimed stabilizer, nor does it explain what portion of that structure purportedly satisfies the claimed "base portion" and "elevated portion" of the stabilizer. In regard to limitation 1[a], the Petition defines the rear portion of the upper portion as heel portion 4 and heel guide portion 4a (highlighted yellow portion). Pet., 79-80.

For limitation 1[c], the Petition relies on heel portion 4 and guide portion 4a as the alleged stabilizer. Pet., 81-82. The Petition also cites the core material 9. But the Petition never explains whether the alleged stabilizer consists of heel portion 4 and heel guide portion 4a, core material 9, or some combination of those structures. Nor does the Petition identify which structures purportedly correspond to the claimed "base portion" and "elevated portion" of the stabilizer. The Petition

further never explains how the cited structure satisfies the requirement of “a base portion at least partially within the sole portion.” Pet., 81-82.

For limitation 1[d], Petitioner again fails to identify the claimed medial and lateral portions of the sole portion. Nor does the Petition identify how the cited U-shaped portion of the heel defines a closed cup.

Claim limitation 1[e] specifies a curvature between the lateral and medial sides of the stabilizer that extend progressively less from the base portion to the elevated portion. The Petition relies only on the curvature of heel guide portion 4a. This is presumed to be the elevated portion and does not meet the limitations of the base portion from 1[c] or 1[d]. As a result, the Petition never identifies any structure corresponding to the claimed progression in curvature from “the base portion toward the elevated portion.” Pet., 84. The Petition likewise never explains what is meant by a “curvature that extends progressively less between the base portion and the elevated portion.” EX1001, 11:50-55; Pet., 34-35.

For limitation 1[f], the same deficiency persists. The Petition still never identifies the claimed portion of the stabilizer. Instead, the Petition cites both the heel portion and the heel portion guide without explaining which structure allegedly satisfies the limitation. Pet., 84-85.

For limitation 1[i], the Petition again never identifies what structure allegedly constitutes “a foam liner oriented concave toward the sole portion.”

Rather than providing analysis for this reference, the Petition simply incorporates by reference its discussion of Shin, Pet., 87 (citing Section IX), which concerns a different combination based on a different reference. Pet., 87. The Petition never identifies which structure from Kim allegedly teaches limitation 1[i], which structure from Shin is being incorporated, or how the proposed combination would teach or suggest limitation 1[i].

The motivation-to-combine analysis of Ground 2A further underscores the lack of a coherent theory. The Petition first proposes incorporating Shin's support member into Kim's shoe. But Shin's support member is not mentioned elsewhere in Ground 2A, which instead relies on Kim's heel portion 4 and guide portion 4a to allegedly teach or suggest a stabilizer. Pet., 89-90. The Petition never explains how these competing theories fit together, or what resulting structure is actually being proposed.

The Petition then states "Shin's elastic member could easily be incorporated into Kim's heel portion ... in the same configuration taught by Shin (e.g., attached to an inner surface of the heel portion and/or heel guide portion)." Pet., 90; EX2024, ¶67. But attaching the elastic member as taught by Shin to the heel portion or heel guide portion may alter the functioning of these elements by blocking the heel as it enters the shoe along the heel guide portion. EX2024, ¶68. This omission is significant because Kim and Shin appear to rely on fundamentally

different entry mechanisms. Kim teaches a heel guide portion 4a that directs a user's heel into the shoe from a rear of the heel structure, like a shoehorn. EX2024, ¶61. Shin teaches a user's heel entering the shoe from the front end of the heel and sliding into place through deformation of the elastic element. EX2024, ¶55. The Petition never explains why a skilled artisan would combine these different approaches or how the resulting structure would operate.

The Petition further states “Kim describes ‘a soft lining material covering the inside of the core material’ of its heel portion. ... Substituting Shin's foam liner for this soft lining would be straightforward and yield the same benefit of cushioning and secure fit.” Pet., 91; EX2024, ¶69. But the Petition never explains why a skilled artisan would consider combining Shin's “foam liner,” which has an elastic element that allows a user to insert their foot into a shoe without increasing the shoe opening, with Kim's lining material. These liners do not function in the same manner. The Petition only offers conclusory assertions that substitution would be “straightforward” without explaining why a skilled artisan would expect the two structures to serve the same role in the modified shoe. EX2024, ¶69. This prior-art combination therefore fails because the Petition does not plead with particularity what Kim-Shin structure is being proposed, which structures allegedly satisfy the stabilizer and foam-liner limitations, or why a skilled artisan would have

been motivated to combine Kim's shoehorn-style entry mechanism with Shin's materially different elastic-entry mechanism.

8. Ground 2B - Kim in view of Hongren in further view of Murray fails to plead its three-reference obviousness theory with particularity and fails to articulate a coherent motivation to combine

The Petition again fails to identify which reference allegedly teaches or suggests each limitation of claim 1. Rather than providing a limitation-by-limitation analysis, the Petition simply incorporates sections that are directed to combinations based on Takahashi, not Kim. Pet., 92 (citing Sections XI, IX, X). As a result, the Petition never clearly identifies which teachings are purportedly supplied by Kim, which are supplied by Hongren or Murray, and which limitations are allegedly satisfied by the proposed combination.

The Petition likewise never identifies the structure that would result from combining Kim, Hongren, and Murray. It is unclear if Hongren's entire heel counter is being incorporated into Kim's heel portion, or if only Hongren's embedding portions are added. For the former, the Petition does not explain how Hongren's heel counter meets any limitation other than a "base portion at least partially within the sole portion." For the latter, the Petition does not explain what elements of Hongren's heel counter would be incorporated into Kim's heel portion, or how this would be accomplished. For example, what portion of heel portion 4 would include the horizontal embedding portion? The Board should not be

required to speculate as to which combination Petitioner is actually advancing. As such, Petitioner has not met its obligation to identify its challenge with particularity under 35 U.S.C. § 312(a)(3). This prior-art combination therefore fails because the Petition does not identify the resulting Kim-Hongren-Murray structure, does not explain which reference supplies which limitation, and does not provide a coherent reason why a skilled artisan would make the undefined combination necessary to arrive at claim 1.

D. The Petition fails to show all limitations of the claim in the prior art.

Multiple Grounds of the Petition fail to identify all of the claim limitations in the prior art and therefore cannot show any likelihood of unpatentability. Because the Board may not institute on fewer than all grounds and all claims, the better use of the Board's resources here, where such a large majority of the Petition is fatally flawed, would be to deny institution. *See BioDelivery Scis. Int'l, Inc. v. Aquestive Therapeutics, Inc.*, IPR2015-00165, Paper 91 at 27-28 (P.T.A.B. Feb. 7, 2019) (denying institution where Petitioner had shown a reasonable likelihood of success on fewer than all asserted grounds); *cf. also Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (DI) at 11. (P.T.A.B. Nov. 7, 2018) (denying institution where Petitioner had shown reasonable likelihood of success on fewer than all challenged claims).

1. Ground 1A – Takahashi fails to disclose limitations 1[c], 1[h], 1[i], and 1[j]

Takahashi fails to teach or suggest the claimed requirement of “a stabilizer disposed at the rear portion and extending from within the sole portion, the stabilizer comprising a base portion at least partially within the sole portion,” as recited in claim limitation 1[c]. EX2024, ¶83. The Petition alleges that Takahashi’s heel counter 27 includes a lip that a POSITA would understand sits below the sole portion. Pet., 29-30. But the Petition identifies no disclosure in Takahashi describing such a lip as extending within the sole portion, and Takahashi’s specification does not appear to discuss the alleged structure at all. At most, Petitioner asks the Board to infer the presence of a structure that Takahashi never identifies. EX2024, ¶83.

Takahashi also fails to teach or suggest a stabilizer that is “configured to resist downward collapse” as required by limitation 1[h]. EX2024, ¶¶40-41. The Petition alleges that, since Takahashi’s first heel counter 28 is made of a relatively hard material, a POSITA would understand the heel element would resist downward collapse of the rear portion of the shoe. Pet., 42. However, the Petition conveniently fails to mention that Takahashi’s second heel counter 29 is softer than the first heel counter 28. Takahashi explains that even if guide core portion 33 is deformed by a person’s foot, it can return to its original shape, since the second heel counter 29 is made of a shape-memory resin. That disclosure does not teach a

stabilizer configured to resist downward collapse. EX2024, ¶84. The Petition never explains how a structure that Takahashi expressly describes as soft and deformable satisfies the claimed requirement that the stabilizer resist downward collapse of the rear portion of the shoe. Thus, Takahashi fails to teach or suggest limitation 1[h].

Takahashi further fails to teach or suggest the claim requirement that “the rapid entry shoe comprises a foam liner oriented concave toward the sole portion,” as recited in claim limitation 1[i]. EX2024, ¶85. The ’006 specification defines the foam liner “as a strip that is generally oriented concave toward the sole portion.” EX1001, 7:8-10; *see also* EX1001, FIG. 1C (element 158). In contrast, the alleged foam element identified by Petitioner in Takahashi is a cloth and sponge liner that extends along the sides and heel portion of the shoe. EX1007, ¶0054. The Petition never explains how that liner exhibits the claimed concave orientation toward the sole portion recited in limitation 1[i]. EX2024, ¶85.

Finally, Takahashi fails to teach or suggest claim limitation 1[j] requiring that the elastic element enables the forward portion of the rapid-entry shoe to flex and/or pivot forward relative to the sole portion. The Petition appears to rely on Takahashi’s side stretchable portions as allegedly satisfying this limitation. Pet., 43-44. But Takahashi does not disclose that those portions enable the forward portion of the shoe to flex or pivot forward relative to the sole portion. At most, Takahashi describes elastic or stretchable material that may deform locally to

facilitate foot entry. EX2024, ¶86. That is not the same as the claimed configuration, which requires the elastic element to enable movement of the forward portion of the shoe relative to the sole portion. The Petition merely points to the presence of elastic material and assumes that any elastic deformation satisfies limitation 1[j]. That is insufficient. The claim does not merely require an elastic element; it requires an elastic element configured to enable a particular movement of a particular portion of the shoe relative to the sole. Takahashi does not teach that functionality. EX2024, ¶86. Thus, Takahashi fails to teach or suggest limitation 1[j].

2. Ground 1B - Takahashi in view of Shin fails to disclose limitation 1[i]

Shin fails to cure Takahashi's deficiency to teach or suggest the claim that "the rapid entry shoe comprises a foam liner oriented concave toward the sole portion," as recited in claim limitation 1[i]. EX2024, ¶87. Shin teaches an "elastic member 122" that is compressed by a user's heel when the user dons the shoe. After the user's foot has entered the shoe, the elastic element returns to its original shape. EX2024, ¶56. But Petitioner never explains why a POSITA would have viewed Shin's elastic member as equivalent to the claimed foam liner. The two structures perform different functions and possess different material properties, yet the Petition treats them as interchangeable without analysis. Pet., 52.; EX2024, ¶¶70, 87. Nor does Petitioner explain how Shin's elastic element satisfies the

claimed orientation requirement. As depicted in Figure 2, Shin's elastic element appears generally parallel to the sole rather than concave toward it. *See* EX1009, FIG. 2.

3. Ground 1C - Takahashi in view of Hongren fails to disclose limitation 1[i]

As described above, Takahashi fails to teach or suggest "a foam liner oriented concave towards the sole portion," as recited in limitation 1[i]. Hongren does not cure that deficiency. EX2024, ¶ 88. The Petition never identifies any structure in Hongren that allegedly supplies the claimed foam liner or explains how Hongren provides the concave orientation toward the sole required by limitation 1[i]. EX2024, ¶¶70, 89.

4. Ground 1D – Takahashi in view of Shin in further view of Hongren fails to disclose limitations 1[i] and 1[j]

As described above, Takahashi fails to teach suggest "a foam liner oriented concave toward the sole portion," as recited in limitation 1[i]. Shin does not cure that deficiency. EX2024, ¶89. Although Shin discloses an elastic member having a generally concave shape, the Petition never explains how Shin's elastic member is oriented concave toward the sole portion as required by the claim. EX2024, ¶70. As depicted in Figure 2, Shin's elastic member appears generally parallel to the sole rather than concave toward it. *See* EX1009, FIG. 2. Hongren likewise does not supply the missing orientation requirement. The Petition does not identify any

structure in Hongren that allegedly provides a foam liner oriented concave toward the sole portion. Accordingly, the combination of Takahashi, Shin, and Hongren fails to teach or suggest limitation 1[i]. EX2024, ¶89.

The combination also fails to teach or suggest limitation 1[j], which requires that “the elastic element is configured to enable the forward portion of the rapid-entry shoe to flex and/or pivot forward relative to the sole portion.” EX2024, ¶90. As explained above, Takahashi does not disclose that its side stretchable portions enable the forward portion of the shoe to flex or pivot forward relative to the sole portion. Shin and Hongren do not cure that deficiency. The Petition does not identify any disclosure in either reference teaching or suggesting the claimed forward flexing and/or pivoting movement relative to the sole portion, nor does it explain how the proposed combination would achieve that functionality. EX2024, ¶¶70, 90. Thus, the combination of Takahashi, Shin, and Hongren fails to teach or suggest limitation 1[j].

5. Ground 1E - Takahashi in view of Murray fails to disclose limitations 1[c] and 1[d]

As described above, Takahashi fails to teach or suggest limitations 1[c] and 1[d]. Murray likewise does not remedy those deficiencies. The Petition never explains how Murray supplies the claimed stabilizer configuration, including a base portion at least partially within the sole portion and a closed cup portion extending between the lateral and medial sides of the sole. EX2024, ¶¶70, 91.

6. Ground 1F – Takahashi in view of Hongren in further view of Murray fails to disclose limitation 1[j]

As described above, Takahashi fails to teach or suggest limitation 1[j], which requires that “the elastic element is configured to enable the forward portion of the rapid-entry shoe to flex and/or pivot forward relative to the sole portion.” EX2024, ¶92. Neither Hongren nor Murray cures that deficiency. The Petition does not identify any disclosure in Hongren or Murray teaching the claimed functionality, nor does it explain how the proposed three-reference combination would enable the forward portion of the shoe to flex and/or pivot forward relative to the sole portion. EX2024, ¶¶70, 92. Accordingly, the combination of Takahashi, Hongren, and Murray fails to teach or suggest limitation 1[j].

7. Ground 2A - Kim in view of Shin fails to disclose limitations 1[i] and 1[j]

Kim in view of Shin fails to teach or suggest the requirement that “the rapid entry shoe comprises a foam liner oriented concave toward the sole portion,” as recited in claim limitation 1[i]. Kim only teaches a generic cloth liner. EX2024, ¶93. Shin teaches an “elastic member 122” that is compressed by a user’s heel when the user dons the shoe. After the user’s foot has entered the shoe, the elastic element returns to its original shape. The Petition again assumes that Shin’s elastic member may simply substitute for the claimed foam liner without explaining why a POSITA would have regarded the two structures as equivalent. Pet., 52; EX2024,

¶70. And the Petition never explains how Shin’s elastic member satisfies the separate requirement that the liner be oriented concave toward the sole portion. *See* EX1009, FIG. 2.

Kim in view of Shin also does not teach or suggest the limitation requiring that “the elastic element is configured to enable the forward portion of the rapid entry shoe to flex and/or pivot forward relative to the sole portion,” as recited in claim limitation 1[j]. EX2024, ¶94. The Petition cites stretchable portion 8 and stretchable portion 6 in reference to claim limitation 1[j]. Only stretchable portion 8 appears relevant to the forward portion of the rapid entry shoe to flex and/or pivot forward relative to the sole portion. Stretchable portion 8, however, does not extend from the topline to sole of the shoe, as required by claim limitation 1[b]. Thus, Kim does not teach or suggest this limitation. Shin does not cure the deficiency of Kim in teaching or suggesting this limitation. EX2024, ¶94.

8. Ground 2B - Kim in view of Hongren in further view of Murray fails to disclose limitation 1[j]

Hongren and Murray likewise do not cure Kim’s failure to teach claim limitation 1[j]. The Petition does not identify any disclosure in either reference supplying the missing functionality, nor does it explain how the proposed combination would satisfy the requirement that the elastic element enable the forward portion of the shoe to flex and/or pivot relative to the sole portion. EX2024, ¶¶70, 95.

VI. CONCLUSION

The Board should deny institution of this IPR because Petitioner fails to establish a motivation to combine the asserted references, multiple grounds fail to meet the statutory particularity requirement, and no ground successfully finds all claim limitations in the prior art.

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 10,072 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE** and all associated Exhibits were served in their entirety on July 30, 2026, upon the following parties via electronic mail:

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