

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 IPR2026-00343
U.S. Patent No. 11,871,811

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	5
III.	OVERVIEW OF THE '811 PATENT AND EXAMINATION	8
IV.	THE PETITION FAILS ON THE MERITS	9
A.	Petitioner does not submit a proper translation certificate for its primary reference, Kim.	10
B.	Petitioner fails to meet its burden of showing a reasonable likelihood of success for all asserted grounds.	12
1.	Ground 1: Petitioner Fails To Establish A Reasonable Likelihood That Kim Anticipates Claims 1-4, 7-10, and 12.	13
a.	Petitioner has not shown that Kim discloses “a stabilizer defining a unitary structure extending from the sole portion toward a rear portion of the foot opening,” as recited in claims 1 and 10.	14
b.	Petitioner has not shown that Kim discloses “the elastic element configured to facilitate at least one of flexion and pivoting of the forward portion of the upper relative to the sole portion,” as recited in claim 10.	21
c.	Petitioner has not shown that Kim discloses the relative angles limitation recited in claim 10.	24
d.	Petitioner fails to show the dependent claims are anticipated by Kim.	29
2.	Grounds 2 and 3: Petitioner Fails To Show That Claims 8 and 9 Would Have Been Obvious in View of Kim and Hoying or that Claims 2, 5, 6, and 11 Would Have Been Obvious in View of Kim and Koo.	30
a.	The Petition fails to show a motivation to combine for either of its obviousness grounds.	30
b.	The Petition fails to articulate either obviousness ground with particularity.	36

V.	IF THE BOARD FINDS THAT PETITIONER FAILS TO MEET ITS BURDEN FOR LESS THAN ALL OF THE CHALLENGED CLAIMS AND/OR PROPOSED GROUNDS, THE BOARD SHOULD DENY INSTITUTION TO CONSERVE RESOURCES.....	38
VI.	CONCLUSION.....	40

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	<i>HandsFree Labs Licensing, LLC et al. 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 et al. v. Skechers U.S.A. Inc.</i> , Case No. 2:25-cv-007744-JRG (E.D. Tex.), Second Amended Docket Control Order, filed Dec. 23, 2025
2003	Conrad, J. (2026, March 26). Kizik's Hands-Free Tech is Coming to New Balance. Retrieved June 29, 2026, from https://www.inc.com/jennifer-conrad/kiziks-hands-free-tech-is-coming-to-new-balance/91319850
2004	England, A. (2022, January 2). Kizik by HandsFree Labs: "The Future of Footwear." Retrieved June 29, 2026, from https://www.techbuzznews.com/kizik-by-handsfree-labs-the-future-of-footwear-/
2005	Helms, H. (2026, April 22). The Most Convenient Running Shoe Innovation in Years Isn't From Nike or Adidas. Retrieved June 29, 2026, from https://www.gearpatrol.com/footwear/kizik-freedom-run/
2006	Newcomb, T. (2024, November 14). Kizik Growing Hands-Free Outdoor-Focused Footwear Lineup. Retrieved June 29, 2026, from https://www.forbes.com/sites/timnewcomb/2024/11/14/kizik-growing-hands-free-outdoor-focused-footwear-lineup/
2007	Pastore, A. (2024, January 9). Kizik's Bradley Johnson Discusses Enabling Discovery for Innovation Hungry Consumers. Retrieved June 29, 2026, from https://wwd.com/business-news/business-features/kizik-bradley-johnson-discovery-innovation-hungry-consumers-1236114333/

Exhibit No.	Description
2008	Daniels, M. (2025, April 18). Inside Kizik’s quest to dominate the hands-free shoe space through intellectual property. Retrieved June 29, 2026, from https://www.modernretail.co/operations/inside-kiziks-quest-to-dominate-the-hands-free-shoe-space-through-intellectual-property/
2009	Welty, M. (2025, March 10). The Designer Behind the Nike Benassi Slide is Changing Slip-on Footwear. Retrieved June 29, 2026, from https://www.complex.com/sneakers/a/matt-welty/andreas-harlow-nike-kizik-interview
2010	Success Rate of Motions to Stay Pending <i>Inter Partes</i> Review before Judge Rodney Gilstrap, Docket Navigator Report, generated June 8, 2026
2011	Miller, C. (2024, October 7). Transforming Giants: Inside 3G Capital’s Most Successful Acquisitions. Retrieved June 29, 2026, from https://ceoworld.biz/2024/10/07/transforming-giants-inside-3g-capitals-most-successful-acquisitions/
2012	Examiner’s Search Strategy and Results in U.S. Patent Application No. 18/371,413, filed Dec. 4, 2023
2013	<i>HandsFree Labs Licensing, LLC, et al. 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
2014	3G Completes Acquisition of Skechers (2025, September 12). Retrieved May 28, 2026, from https://about.skechers.com/press-release/3g-capital-completes-acquisition-of-skechers
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/

Exhibit No.	Description
2016	Burba, A. (2024, October 21). How Kizik Found Its Footing. Retrieved June 29, 2026, from https://www.inc.com/annabel-burba/how-kizik-found-its-footing/90990715
2017	Beyond Private Equity: 3G Capital’s Business-Building Partnership Model. (2026, April 20). Retrieved June 19, 2026, from https://thebossmagazine.com/post/beyond-private-equity-3g-capitals-business-building-partnership-model/
2018	HandsFree Lab Receives Strategic Investment from Nike. (2019, November 20). Retrieved June 29, 2026, from https://www.prnewswire.com/news-releases/handsfree-labs-receives-strategic-investment-from-nike-300962516.html
2019	<i>HandsFree Labs Licensing, LLC, et al. v. Skechers U.S.A., Inc.</i> , Case No. 2:25-cv-00744-JRG (E.D. Tex.), Exhibit 811-C, Invalidity Combinations Chart for U.S. Patent No. 11,871,811
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/
2021	Skechers Agrees to be Acquired by 3G Capital, United States Securities and Exchange Commission Archive. Retrieved June 30, 2026, from https://www.sec.gov/Archives/edgar/data/1065837/000119312525112159/d943603dex991.htm
2022	Powered by Handsfree Labs, the world leader in hands-free technology. Retrieved July 22, 2026, from https://kizik.com/pages/innovation
2023	Carmichael, E. (2019, February 21). TWH explains: What is a heel counter and Why you need to know. Retrieved July 22, 2026, from https://the-well-heeled.com/twh-explains-what-is-a-heel-counter-and-why-you-need-to-know/

Exhibit No.	Description
2024	Heel Counter. Retrieved July 22, 2026, from https://shoemaking.wiki/Heel_Counter
2025	Counter Stiffener Attaching in Footwear Upper Manufacturing – Stitching Process Series. Retrieved July 22, 2026, from https://thefootwearedge.com/counter-stiffener-attaching-028/
2026	“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)
2027	“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)
2028	Declaration of Robert Erb
2029	<i>Curriculum Vitae</i> of Robert Erb
2030	Ryder, S. “Step by Step. Design and Development,” CoDesign Collaborative, accessed at https://codesigncollaborative.org/step-by-step-shoe-design/ (last accessed July 30, 2026)

TABLE OF AUTHORITIES

Cases

<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	31
<i>Chevron Oronite Co. v. Infineum USA L.P.</i> , IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018)	38
<i>Connell v. Sears, Roebuck Co.</i> , 722 F.2d 1542 (Fed. Cir. 1983)	13
<i>Cont'l Can Co. USA v. Monsanto Co.</i> , 948 F.2d 1264 (Fed. Cir. 1991)	20, 28
<i>Deeper, UAB. v. Vexilar, Inc.</i> , IPR2018-01310, Paper 7 (P.T.A.B. Jan. 24, 2019)	40
<i>Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015)	12
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (May 19, 2025)	37
<i>Ford Motor Co. v. Cruise Control Techs.</i> , IPR2014-00281, Paper 17 (P.T.A.B. July 2, 2014)	12
<i>Harmonic v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	13, 38
<i>Hockerson-Halberstadt, Inc. v. Avia Grp. Int'l, Inc.</i> , 222 F.3d 951 (Fed. Cir. 2000)	27
<i>Honeywell Int'l Inc. v. DSM IP Assets, B.V.</i> , IPR2024-00493, Paper 7 (P.T.A.B. Aug. 21, 2024)	31
<i>Icon Health & Fitness, Inc. v. Strava, Inc.</i> , 849 F.3d 1034 (Fed. Cir. 2017)	23, 28
<i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984)	33, 35
<i>In re Magnum Oil Tools Int'l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	9, 13, 37
<i>In re Mraz</i> , 455 F.2d 1069 (C.C.P.A. 1972)	27
<i>In re Turlay</i> , 304 F.2d 893 (C.C.P.A. 1962)	17
<i>In-Depth Geophysical, Inc. v. ConocoPhillips Co.</i> , IPR2019-00850, Paper 56 (P.T.A.B. Sept. 3, 2020)	36
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	10, 30

<i>Krippelz v. Ford Motor Co.</i> , 667 F.3d 1261 (Fed. Cir. 2012)	27
<i>KSR Int’l v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	31
<i>Net MoneyIn, Inc. v. VeriSign, Inc.</i> , 545 F.3d 1359 (Fed. Cir. 2008)	passim
<i>Netflix, Inc. v. DivX, LLC</i> , 84 F.4th 1371 (Fed. Cir. 2023)	18
<i>NJOY, LLC v. JUUL Labs, Inc.</i> , IPR2024-00536, Paper 17 (P.T.A.B. Aug. 12, 2024).....	30
<i>Par Pharm. Inc. v. TWI Pharms., Inc.</i> , 773 F.3d 1186 (Fed. Cir. 2014)	20, 28
<i>Regents of the Univ. of Cal. v. Broad Inst., Inc.</i> , 903 F.3d 1286 (Fed. Cir. 2018)	30
<i>SAS Inst., Inc. v. Iancu</i> , 584 U.S. 357 (2018).....	14, 38
<i>Shenzhen Aurora Tech. Co., Ltd. v. Putco, Inc.</i> , IPR2020-00670, Paper 10 (P.T.A.B. Aug. 27, 2020).....	12
<i>Therasense, Inc. v. Becton, Dickinson & Co.</i> , 593 F.3d 1325 (Fed. Cir. 2010)	13
<i>Verdegaal Bros. v. Union Oil Co. of California</i> , 814 F.2d 628 (Fed. Cir. 1987).....	13, 29
<i>W.L. Gore & Assocs., Inc. v. Garlock, Inc.</i> , 721 F.2d 1540 (Fed. Cir. 1983)	17
Statutes	
35 U.S.C. § 102	8, 13
35 U.S.C. § 112	8
35 U.S.C. § 312(a)(3).....	10, 36
35 U.S.C. § 314(a)	9, 38, 39
35 U.S.C. § 316(b)	39, 40
35 U.S.C. § 316(e)	9
Regulations	
37 C.F.R. § 1.68	11
37 C.F.R. § 42.1(b)	39, 40
37 C.F.R. § 42.104(b)(4).....	36
37 C.F.R. § 42.2	11
37 C.F.R. § 42.63(b)	10, 11

I. INTRODUCTION

The Board should deny institution of *inter partes* review of U.S. Patent No. 11,871,811 (“the ’811 patent”) on the merits. While slip-on shoes have been around for centuries, *see, e.g.*, Pet.¹, 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.” EX2027.

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

¹ Petitioner filed a Motion to Correct Petition (Paper 9) to correct references to claim language and numbering, as reflected in the August 27, 2024, Certificate of Correction (EX1027). This Preliminary Response references the corrected claim numbering, and provides citations to the Corrected Petition submitted as Attachment A to Petitioner’s Motion.

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.

The Petition falsely states that Patent Owner Fast IP, LLC is a “non-practicing patent monetization entity.” *Contra* Pet., 1. But it is the IP holding affiliate of Kizik, a revolutionary shoe company that innovates, manufactures, and sells hands-free sneakers. *See* EX2022 (“With over 200 patents, Handsfree Labs engineers and designers are at the forefront of footwear technology, seamlessly integrating proprietary hands-free tech into every Kizik style for unmatched convenience & innovation.”). Kizik has invented numerous 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. 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.

Turning to the asserted grounds, at the outset, all grounds fail because Petitioner does not submit a proper translation certificate for its primary reference, Kim. On the substantive merits, Petitioner asserts that the majority of the claims are anticipated by Kim. But Petitioner has not met its burden to show that Kim “not only disclose[s] all elements of the claim within the four corners of the document, but ... also disclose[s] those elements arranged as in the claim.” *Net MoneyIn, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (internal quotations omitted). That a claim may have been *obvious* in view of a single prior art reference, which Petitioner does not contend here (and which Patent Owner does not concede), is insufficient to show that claim is *anticipated* by that reference. In particular, Petitioner has not shown that Kim discloses a key feature included in both independent claims 1 and 10: a stabilizer defining a unitary structure extending from the sole portion toward a rear portion of the foot opening. Further still, Petitioner has not shown that Kim discloses that the claimed “plurality of elastic elements” functions as recited in independent claim 10.

Petitioner also asserts that a handful of dependent claims would have been obvious over combinations of Kim with Hoying or Koo. But again, Petitioner’s contentions fail. First, 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, that the claimed combinations are therefore obvious. But obviousness is not established by identifying individual claim elements in isolation. 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. As discussed by Patent Owner's expert, the specific 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* EX2028, ¶¶38-42; *see generally* EX1001. The Petition does not sufficiently explain why the prior art suggests implementing Hoying's or Koo's features into Kim in such a way to arrive at the claimed invention.

Compounding this issue, the Petition fails to articulate either obviousness ground with particularity. Instead, Petitioner presents alternative theories without any explanation as to which it relies upon. Worse yet, in at least some instances, Petitioner's proposed combinations remove aspects of Kim relied upon for teaching elements of the independent claims without any explanation as to how the combination then meets those claim elements.

Accordingly, the Petition fails to show a reasonable likelihood that the challenged claims are unpatentable.

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, 1:25-34, 1:52-67; EX2028, ¶¶29-37. 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 are 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. 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.*, EX2004-2009.

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 late, years 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 “it 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 '811 PATENT AND EXAMINATION

The '811 patent is entitled "Rapid-Entry Footwear Having a Stabilizer and an Elastic Element." It was filed on September 21, 2023, as a continuation of application 17/965,516, filed on October 13, 2022, which is a continuation of application 16/942,335, filed on July 29, 2020, and which claims priority to provisional application 62/879,883, filed on July 29, 2019. The '811 patent discloses a rapid-entry shoe with a stabilizer to resist a rear portion of the shoe from collapsing downward. EX1001, Abstract; EX2028, ¶38. Such a shoe can be put on without bending over to tie laces, making everyday tasks easier, faster, and more convenient. EX2001, ¶3. This technology is particularly useful 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 '811 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 863 pages and include over 250 extensive queries. EX2012. The Examiner further issued an Office Action with multiple rejections, alleging: 35 U.S.C. § 112 written description and indefiniteness rejections, a § 102 anticipation rejection, and a double patenting rejection. EX1002, 15-21. Without acquiescing to the propriety of the rejections,

Patent Owner responded by submitting an amendment to cancel claims rejected under §§ 112 and 102, and to incorporate novel and nonobvious features of dependent claim 17 into independent claim 15 (issued claim 10) to expedite prosecution. EX1002, 4-10. Patent Owner further submitted a terminal disclaimer. EX1002, 10. 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, 1-3. Patent Owner paid the issue fee and the '811 patent issued.

The Petition identifies no material error in the Examiner's analysis. 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. THE PETITION FAILS ON THE MERITS

In an IPR, “the burden of proving a proposition of unpatentability” is borne by (and remains at all times with) the petitioner. 35 U.S.C. §§ 314(a), 316(e); *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)).

Here, the Petitioner falls far short of its burden of demonstrating that there is a reasonable likelihood that at least one claim of the 12 challenged claims of the ’811 patent is unpatentable. First, all of Petitioner’s asserted grounds rely on a foreign language reference, Kim, for which a proper translation affidavit was not provided. Second, Petitioner’s anticipation ground falls short of disclosing all elements of the claims. Third, Petitioner’s obviousness grounds fail to show a motivation to combine and are not articulated with particularity.

A. Petitioner does not submit a proper translation certificate for its primary reference, Kim.

At the outset, each of Petitioner’s asserted grounds is deficient because the primary reference Kim (EX1004) is a Japanese-language patent and the translation provided (EX1005) does not include a proper affidavit in accordance with 37 C.F.R. § 42.63(b).² The Petition fails for this reason alone.

² Petitioner’s translation certification for Higuchi—relied upon as evidence that particular features were well-known in the art, Pet., 34—is likewise deficient. *See* EX1015-EX1017.

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 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 (“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.

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 Kim is relied upon as the basis of all asserted grounds, the Petition should be denied.

B. Petitioner fails to meet its burden of showing a reasonable likelihood of success for all asserted grounds.

Even if the Board considers Kim, the Petition still fails. Petitioner bears the burden of proving unpatentability of the challenged claims; this burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015); *see also Harmonic Inc. v.*

Avid Tech., Inc., 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“[T]he petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”). Petitioner has not met its burden here, and all asserted grounds fail. *In re Magnum Oil*, 829 F.3d at 1375.

1. Ground 1: Petitioner Fails To Establish A Reasonable Likelihood That Kim Anticipates Claims 1-4, 7-10, and 12.

Petitioner contends that claims 1-4, 7-10, and 12 are anticipated by Kim. Pet., 14-47. It is black letter law that “the hallmark of anticipation is prior invention.” *Net MoneyIn*, 545 F.3d at 1369. For a reference to anticipate under 35 U.S.C. § 102, it “must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Id.* (quoting *Connell v. Sears, Roebuck Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)); *see also Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”); *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 1332 (Fed. Cir. 2010) (“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.”).

Thus, in order to show Kim anticipates any challenged claim, Petitioner must show that it discloses each and every element of the claim “arranged or combined in the same way as recited in the claim.” *Net MoneyIn*, 545 F.3d at 1371.

As discussed in detail below, Petitioner's allegations regarding multiple claims terms are wholly insufficient. Petitioner therefore has not met its burden to prove anticipation of any of the challenged claims.³

a. Petitioner has not shown that Kim discloses “a stabilizer defining a unitary structure extending from the sole portion toward a rear portion of the foot opening,” as recited in claims 1 and 10.

Independent claims 1 and 10 each recite “a stabilizer defining a unitary structure extending from the sole portion toward a rear portion of the foot opening.” EX1001, 11:46-48 (element 1[c]), 12:25-27 (element 10[c]). Petitioner has not met its burden to show that Kim discloses this limitation. *See* EX2028, ¶¶39, 61-67.

Kim describes a shoe, including “a sole portion 2,” “an instep portion 3,” “a heel portion 4,” and “a heel guide portion 4a integrally projecting from the upper end of the heel portion 4.” EX1005, ¶22. Kim explains that, during donning, the user “pushes the heel of the foot into the heel portion 4 while sliding it along the heel guide portion 4a.” EX1005, ¶29. In Kim, the heel portion 4 and heel guide

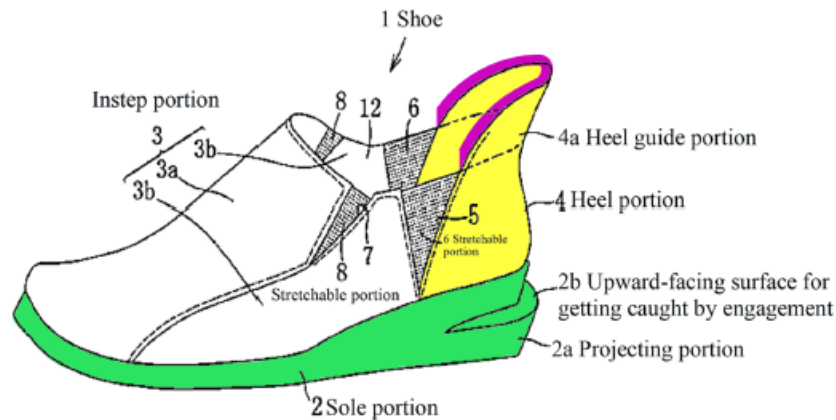
³ Petitioner does not contend that any of claims 1-4, 7-10, and 12 would have been obvious in view of Kim alone. “[T]he petitioner’s contentions, not the Director’s discretion, define the scope of the litigation all the way from institution through to conclusion.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 367 (2018).

portion 4a include “a hard core material 9,” “a soft skin material 10 covering the outside of the core material 9,” and “a soft lining material 11 covering the inside of the core material 9.” EX1005, ¶27. According to Kim, this construction provides “sufficient strength” so that “the heel portion 4 and the heel guide portion 4a can be prevented from losing their shape.” EX1005, ¶31; *see also* EX2028, ¶¶44-49.

Petitioner points to Kim’s “4 Heel portion,” including “4a Heel guide portion,” as allegedly disclosing the claimed “stabilizer” of element 1[c].⁴ Pet., 19-21. Petitioner further relies on Kim’s “hard core material” as providing “sufficient strength” so that “the heel portion and the heel guide portion can be prevented from losing their shape.” Pet., 20. Petitioner provides an annotated version of Figure 1 (reproduced below), asserting *without further explanation* that Kim’s “‘4 Heel portion’ (yellow) extends from [Kim’s] ‘2 Sole portion’ (green) toward a rear of the foot opening (pink).” Pet., 21.

⁴ Petitioner’s arguments for element 10[c] merely point back to the discussion for element 1[c]. *See* Pet., 40.

[FIG. 1]



EX1005, FIG. 1 (as annotated by Petitioner, at Pet., 21).

Petitioner’s conclusory statements are insufficient to show anticipation. EX2028, ¶61. In Kim, core material 9 (within heel portion 4) acts as a typical conventional heel counter, which was well known in the art. *See, e.g.*, EX2023 (“The heel counter is one of the most important features in a shoe...”); EX2028, ¶62. Traditionally, a heel counter may be pasted or sewn into place between the shoe’s upper and any lining. *See* EX2024; EX2025 (“The attaching process [for a counter] involves cutting, heating, positioning, and fixing the stiffener between upper and lining layers.”); EX2028, ¶62.

Petitioner does not adequately identify where Kim discloses “a stabilizer defining a unitary structure extending from the sole portion toward a rear portion of the foot opening,” as recited in claims 1 and 10. First, Petitioner does not clearly explain whether the alleged “unitary structure” is Kim’s heel portion 4, heel guide portion 4a, hard core material 9, some combination of those components, or the

full layered heel structure that also includes skin material 10 and lining material

11. *See* Pet., 19-21. Second, Petitioner does not explain how any identified structure is “extending from the sole portion” as claimed. *See id.* Instead, Petitioner makes unsupported assertions that Kim discloses such features.

“Statements in a prior application relied on to prove anticipation must be so clear and explicit that those skilled in the art will have no difficulty in ascertaining their meaning.” *In re Turlay*, 304 F.2d 893, 899 (C.C.P.A. 1962) (anticipation cannot be predicated on an ambiguous reference.); *see also W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983) (rejecting both anticipation and obviousness challenges due to prior art reference that was “unacceptably vague”).

But Kim’s written disclosure does not clearly or explicitly teach the claimed “unitary structure” or that it is “extending from the sole portion” as claimed. Instead, Kim is silent as to these claimed features.

Assuming Petitioner relies on Kim’s hard core material 9 as the “unitary structure,”⁵ Kim’s Figure 2 shows only a cross-section of the heel guide portion

⁵ If Petitioner relies also on Kim’s lining material 11 and skin material 10 then there is no disclosed “unitary structure” because Kim does not explain how, or even if, these layers are connected together. In any event, it is Petitioner’s burden to

without any indication of the specific location of that cross-section. Kim does not explicitly state that this hard core material 9 extends from the sole portion 2, as recited in claim 1. As described in the '811 patent, on the other hand, the claimed “stabilizer” and sole are in contact in order to function properly as a stabilizer. *See* EX1001, 6:36-40, 9:25-28; EX2028, ¶¶39, 63. Kim, however, simply indicates that hard core material 9 is sandwiched between a skin material 10 and a lining 11. EX1005, ¶27; EX2028, ¶63. In contrast, although Kim explicitly discloses, for example, that “heel guide portion 4a integrally project[s] from the upper end of the heel portion 4,” EX1005, ¶22, there is no corresponding disclosure that hard core material 9 is connected in any way to or in contact with the sole portion 2. EX2028, ¶63. Further, the presence of Kim’s forward *and* rearward stretchable portions 6 and 8 at least suggests to a POSITA⁶ that Kim’s heel portion 4 is

explain its grounds with particularity, so any ambiguity in Petitioner’s contentions should be resolved in Patent Owner’s favor. *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377 (Fed. Cir. 2023) (“[T]he Board should ... not have to decode a petition to locate additional arguments beyond the ones clearly made.”).

⁶ For purposes of this POPR, Patent Owner applies Petitioner’s definition of a POSITA. *See* Pet., 8. The precise definition of a POSITA does not materially affect the analysis required for deciding institution. EX2028, ¶¶26-28; Pet., 8.

configured to move rearward upon foot insertion. *See* EX1005, ¶29 (describing that the opening of the shoe expands when the foot slides along the heel guide portion); EX2028, ¶64. Such rearward motion would not be possible if core material 9 were to “extend[] from” the sole portion. EX2028, ¶64. Kim’s silence on this issue is fatal to Petitioner’s anticipation ground. *Net MoneyIn*, 545 F.3d at 1371.

Petitioner’s annotated Figure 1 also does not provide this missing disclosure. Petitioner annotates the “4 Heel portion” yellow and the “2 Sole portion” green, then asserts that the yellow portion extends from the green portion toward the rear of the foot opening. Pet., 21. But Petitioner does not point to any text in Kim explaining that the hard core material is extending from the sole portion. Pet., 19-21. At most, Petitioner identifies visual proximity between Kim’s entire heel portion and the sole portion. Figure 1 shows only skin material 10 that covers the outside of core material 9. EX1005, ¶27. This is insufficient for anticipation of the claimed “stabilizer defining a unitary structure extending from the sole portion.”

Nor does Kim’s Figure 2 supply the missing disclosure. Figure 2 is “a cross sectional view of a heel guide portion,” but Kim does not identify at what portion of the heel guide that cross-section is taken. EX1005, ¶20. Indeed, Figure 2 itself suggests it is *not* taken at the bottom end of heel portion 4 adjacent to the sole portion, because it is labeled as “4a” which is the heel guide portion located at the upper end of heel portion 4. EX2028, ¶65. Figure 2 does not show that hard core

material 9 extends from the sole portion, and it does not show a unitary stabilizer extending from the sole portion toward a rear portion of the foot opening. EX2028, ¶65. A cross-sectional view of the heel guide portion does not establish the required relationship between the alleged stabilizer and the sole portion.

For these reasons, a POSITA would not have understood Kim to disclose that Kim's hard core material 9 "extends from" the sole portion 2. EX2028, ¶¶61-67. Without an express disclosure of a stabilizer extending from the sole portion, it is not enough to anticipate claim 1 that Kim *could* be configured in this way, but rather the claimed configuration "necessarily must be present." *See Par Pharm. Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1195-96 (Fed. Cir. 2014); *Cont'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). That is not the case here, nor does Petitioner even allege that this feature is inherently disclosed in Kim. Instead, Kim describes that core material 9 may be, *inter alia*, "a counter material or the like," EX1005, ¶27, and it was known in the art that heel counters can have different designs and may not (and most often do not), extend from the sole of the shoe. *See, e.g.*, EX2024; EX2028, ¶66. Thus, it is just as likely that only Kim's soft lining material 11 and/or skin material 10 are connected to the sole portion and that hard core material 9 begins at some point there above. EX2028, ¶66.

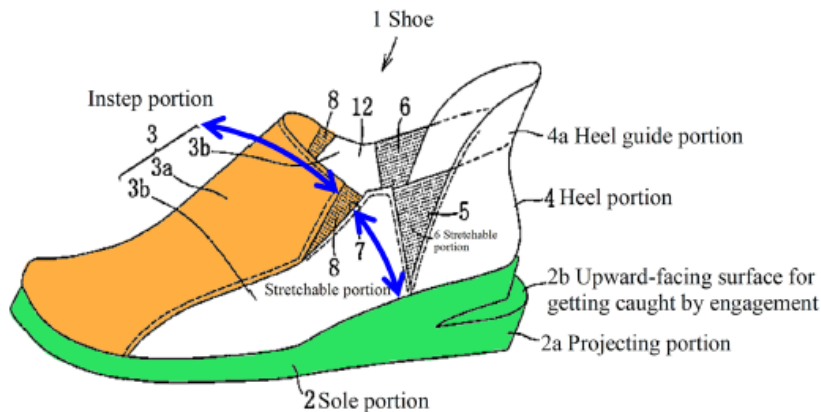
Accordingly, for at least this reason, Petitioner has not met its burden to show that claims 1 and 10 are anticipated by Kim and therefore has not established a reasonable likelihood of success on this asserted ground.

- b. Petitioner has not shown that Kim discloses “the elastic element configured to facilitate at least one of flexion and pivoting of the forward portion of the upper relative to the sole portion,” as recited in claim 10.**

Independent claim 10 further recites “a plurality of elastic elements positioned along at least a portion of the upper, the elastic element configured to facilitate at least one of flexion and pivoting of the forward portion of the upper relative to the sole portion.” EX1001, 12:28-31 (element 10[d]). Petitioner also has not met its burden to show that Kim discloses this limitation. *See* EX2028, ¶¶40, 68-72.

Petitioner provides an annotated version of Kim’s Figure 1 (reproduced below) to explain its position.

[FIG. 1]



EX1005, FIG. 1 (as annotated by Petitioner at Pet., 42).

Petitioner relies on Kim’s stretchable portions 6 and 8 as allegedly disclosing the claimed “plurality of elastic elements.” Pet., 40-42. Pointing to Kim’s disclosure that “the shoe opening 12 expands when the two pairs of stretchable portions 6, 8 stretches,” Petitioner adds blue arrows to Kim’s Figure 1 and asserts that Kim’s stretchable portions “facilitate flexion and/or pivoting of the forward portion of the upper (orange) relative to the sole portion (green), in the manner indicated above with annotated blue arrows.” Pet., 41-42; EX1005 ¶25; EX2028, ¶69.

Petitioner’s conclusory assertion and unsupported annotations are insufficient to support a finding of anticipation. *Net MoneyIn*, 545 F.3d at 1371. Petitioner does not explain why Kim’s elastic elements would necessarily result in movement as shown by Petitioner’s annotated arrows. Indeed, Kim discloses only that stretchable portions 6 and 8 “stretch[]” so that shoe opening 12 “expands.”

EX1005 ¶¶25, 29. But Kim is entirely silent as to *how and in what direction(s)* the shoe opening expands when a user dons the shoe. EX2028, ¶70. And, as the hard core material 9 of the heel portion 4 does not extend from the sole portion (see above, Section IV.B.1.a), stretchable portion 6 can allow the heel portion 4/heel guide portion 4a to move rearward. *See* EX1005, ¶29 (describing that the opening of the shoe expands when the foot slides along the heel guide portion); EX2028, ¶70. Indeed, Petitioner does not identify any explicit disclosure in Kim that the forward portion of the upper flexes or pivots relative to the sole portion, as required by the claim language. Pet., 40-42. Nor does Petitioner identify anywhere in Kim that discloses the stretchable portions 6 or 8 are configured to facilitate that movement. *Id.*

The blue arrows are Petitioner's annotations, not disclosures in Kim, and are unsupported by expert testimony. Pet., 42; *see* EX1003, ¶¶20, 24 (cited paragraphs do not contain the relevant annotations or a discussion thereof); EX2028, ¶71. And Petitioner's annotated arrows cannot provide disclosure of a missing claim element. *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017) ("Attorney argument is not evidence."). As noted, the Petition identifies no text in Kim stating that the forward portion moves, flexes, or pivots relative to the sole portion. Pet., 40-42. Additionally, Petitioner does not explain why expansion of shoe opening 12 necessarily requires flexion or pivoting of the forward portion

relative to the sole portion. *Id.* It does not, and Petitioner’s annotation is based solely on assumptions, not Kim’s disclosure. EX2028, ¶¶70-71.

Claim 10 requires more than an elastic element that simply expands a shoe opening, as taught by Kim. Instead, claim 10 includes specific recitation of a plurality of elastic elements “configured to facilitate at least one of flexion and pivoting of the forward portion of the upper relative to the sole portion.” EX1001, claim 10. Petitioner’s reliance on Kim’s disclosure that shoe opening 12 “expands” is insufficient because it does not address the requirement that the elastic elements facilitate flexion and/or pivoting of the forward portion relative to the sole portion.

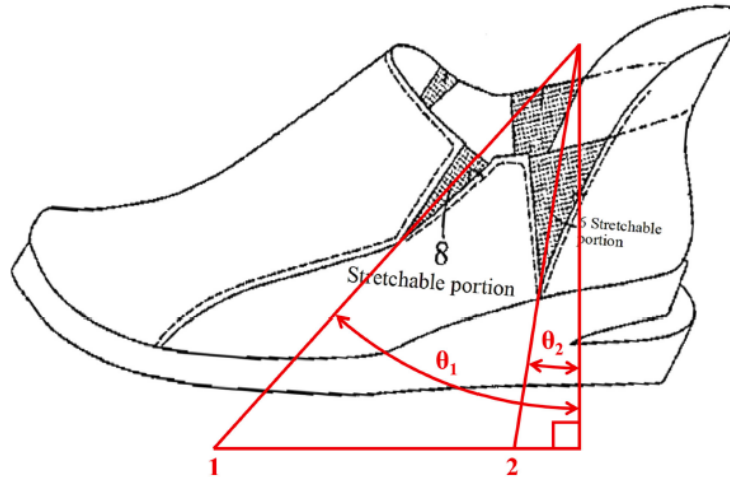
Petitioner has not identified *any* disclosure in Kim showing that those stretchable portions are configured to facilitate flexion or pivoting of the forward portion of the upper relative to the sole portion. EX2028, ¶¶68-72; *Net MoneyIn*, 545 F.3d at 1369, 1371. Accordingly, for this additional reason, Petitioner has not met its burden to show that claim 10 is anticipated by Kim and therefore has not established a reasonable likelihood of success on this asserted ground.

c. Petitioner has not shown that Kim discloses the relative angles limitation recited in claim 10.

Independent claim 10 further recites “the plurality of elastic elements includes a first elastic element defining a first longitudinal axis and a second elastic element defining a second longitudinal axis, wherein the first longitudinal axis defines a first angle relative to a vertical axis and the second longitudinal axis

defines a second angle relative to the vertical axis, wherein the first angle and the second angle are different.” EX1001, 12:32-39 (element 10[e], “relative angles” limitation). Petitioner also has not met its burden to show that Kim discloses this limitation. *See* EX2028, ¶¶73-76.

For element 10[e], Petitioner points to one of Kim’s stretchable portions 8 as the claimed “first elastic element” and one of Kim’s stretchable portions 6 as the claimed “second elastic element.” Pet., 45-46. Petitioner then presents an annotated version of Kim’s Figure 1 (reproduced below) with red diagonal lines drawn through those stretchable portions. *Id.* Petitioner labels the lines as the claimed “first [and second] longitudinal ax[e]s,” adds a vertical reference line, and asserts that the resulting angles are different. *Id.* According to Petitioner, the angle associated with its alleged first longitudinal axis is “substantially larger” than the angle associated with its alleged second longitudinal axis. *Id.* But every part of that angular comparison comes from Petitioner’s annotations to the figure, not from any express disclosure in Kim. EX2028, ¶¶74-75.



EX1005, FIG. 1 (as modified and annotated by Petitioner at Pet., 45).

Kim describes stretchable portions 6 and 8 as filling “substantially triangular” notch portions located in different regions of the upper. EX1005, ¶25. Kim discloses the respective locations of stretchable portions 6 and 8 as being at the “boundary between the instep portion 3 and the heel portion 4” and at the “boundary portions between the upper surface side member 3a and the lateral surface side members 3b,” and also notes that “stretchable portions 8 are formed smaller than the stretchable portions 6.” EX1005, Abstract, ¶25. Notably, Kim does *not* include any disclosure regarding the relative placement angles of the stretchable portions. EX2028, ¶75. Further, Kim does not describe any of its figures, including Figures 1 or 3, as being scale drawings from which angular relationships may be measured. *See* EX1005, ¶¶20-25, 33.

Prior-art drawings may only be relied on for what the drawings themselves clearly disclose or would reasonably convey to a POSITA. *See In re Mraz*, 455

F.2d 1069, 1072 (C.C.P.A. 1972) (“Patent drawings are not working drawings.

However, we did not mean that things patent drawings show clearly are to be *disregarded.*”) (emphasis original); *Krippelz v. Ford Motor Co.*, 667 F.3d 1261, 1269 (Fed. Cir. 2012) (relying on figures where “a person of ordinary skill, reviewing these figures, would understand them” to disclose the claimed relationship). The MPEP similarly explains that “[d]rawings and pictures can anticipate claims if they clearly show the structure which is claimed,” but where a reference does not disclose that the drawings are to scale and is silent as to dimensions, “arguments based on measurement of the drawing features are of little value.” MPEP § 2125 (I), (II). The Federal Circuit articulated the same principle in *Hockerson-Halberstadt*, holding that “patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue,” and that “[a]bsent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.” *Hockerson-Halberstadt, Inc. v. Avia Grp. Int’l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000).

Here, as in *Hockerson-Halberstadt*, Kim’s specification is silent as to the elements of the relative angles limitation. Indeed, Petitioner does not identify any explicit discussion in Kim regarding any longitudinal axis, a vertical axis, or a relative angular relationship between the stretchable portions. EX2028, ¶75.

Instead, Petitioner supplies those features through attorney annotations added to Kim's Figure 1. *Icon Health*, 849 F.3d at 1043 ("Attorney argument is not evidence."); *see generally* EX1003 (no expert testimony regarding this claim element). And Petitioner does not allege that the stretchable portions 6 and 8 *necessarily* result in the claimed configuration based on Kim's disclosure. *Par Pharm. Inc.*, 773 F.3d at 1195-96; *Cont'l Can Co.*, 948 F.2d at 1268.

The Petition relies on the relative angles created by their own annotations, asserting that one resulting angle is "substantially larger" than the other. Pet., 46. But the asserted difference depends entirely on the placement and orientation of lines Petitioner itself added to the figure. Petitioner cites no disclosure in Kim identifying those lines and no testimony explaining why a skilled artisan would select them. Kim does not identify the diagonal lines, does not identify the vertical line, and does not identify or describe θ_1 or θ_2 . *See* Pet., 45 (annotated figure).

Kim's Figure 3 and the related discussion do not remedy the deficiency. Petitioner relies on both Figures 1 and 3 individually as disclosing claim 10, but Kim describes Figure 3 only as an embodiment in which the shape of projecting portion 2a differs from Example 1. EX1005, ¶33. Petitioner provides no separate explanation of how Figure 3 discloses the claimed longitudinal axes or angular relationship beyond the discussion of Figure 1. *See* Pet., 39, 45-46.

Petitioner has not shown that Kim discloses the relative angles limitation of claim 10. EX2028, ¶¶73-76. Accordingly, for this additional reason, Petitioner has not met its burden to show that claim 10 is anticipated by Kim and therefore has not established a reasonable likelihood of success on this asserted ground.

d. Petitioner fails to show the dependent claims are anticipated by Kim.

Petitioner also fails to establish a reasonable likelihood that one or more of dependent claims 2-4 and 7-9, which depend from claim 1, and 12 which depends from claim 10, are anticipated by Kim. Each of claims 2-4, 7-9, and 12 is narrower in scope than the independent claim from which it depends, but each dependent claim also incorporates all of the elements of its respective independent claim. Because Kim fails to teach all of the elements of the independent claims, it necessarily fails to teach all of the elements of the dependent claims, and therefore the dependent claims are also not anticipated by Kim. *Verdegaal Bros.*, 814 F.2d at 631. Because Petitioner fails to meet its burden of proving anticipation with respect to independent claims 1 and 10, it likewise fails to meet its burden for dependent claims 2-4, 7-9, and 12.

2. Grounds 2 and 3: Petitioner Fails To Show That Claims 8 and 9 Would Have Been Obvious in View of Kim and Hoying or that Claims 2, 5, 6, and 11 Would Have Been Obvious in View of Kim and Koo.

Petitioner contends that dependent claims 8 and 9 would have been obvious over Kim in view of Hoying. Pet., 47-66. Petitioner further contends that dependent claims 2, 5, 6, and 11 would have been obvious over Kim in view of Koo. Pet., 67-87. At the outset, it should be noted that Petitioner does not contend that either Ground 2 or 3 remedies the deficiencies identified above with respect to Ground 1 for the independent claims. Thus, Grounds 2 and 3 fail for that reason alone. Further, Petitioner has not shown sufficient motivation to combine the asserted references nor articulated the obviousness grounds with sufficient particularity as required by the Board's rules.

a. The Petition fails to show a motivation to combine for either of its obviousness grounds.

“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) (emphasis original). 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 v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)).

The Petition ignores that each cited reference in the obviousness combinations 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* EX2028, ¶¶77; EX1005, ¶¶7-8; EX1007, 38:10-31; EX1008, 9:64-10:18, 10:46-11:17. Each reference teaches a complete footwear design in which the disclosed components are intended to function together as part of an integrated whole. EX2028, ¶¶44-58, 77; EX1005, ¶¶29-32; EX1007, 38:10-46:32; EX1008, 9:64-10:18, 10:46-11:17. 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 stabilizer and the claimed plurality of elastic elements are intentionally constructed to function in a particular manner and derive their function from the surrounding structures and combination of structures of the shoe in which they appear. Their shapes, relative positions, and points of contact matter. EX2028, ¶78. 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 '811 patent absent impermissible hindsight. Indeed, one of skill in the art would not simply take the elastic web or laces of one shoe, for instance, and combine it with (or somehow replace) the stretchable portions of a different shoe, because the elastic web or laces are intentionally constructed and designed to cooperate with every other part of *that* shoe; each part plays a specific role in the overall functionality of the whole. EX2028, ¶¶58, 78; *see also id.*, ¶¶38-42 (describing how the claims recite a complete system with each element acting in cooperation with others).

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. *See, e.g., Pet.*, 62-66, 79-87. But

footwear design is not an à-la-carte exercise in selecting isolated structures from unrelated shoes. EX2028, ¶¶79-81; *see also id.*, ¶¶30-35 (describing footwear development process). In reality, the claimed configuration reflects a unique balance between resilient and rigid structures, support and flexibility, ease of entry and secure retention. The asserted prior-art references strike those balances differently, using different shapes, arrangements, and structural relationships. *See, e.g.*, EX2028, ¶82; EX1005, ¶¶29-32; EX1008, 9:64-10:18, 10:46-11:17.

To the extent the prior-art teachings are combinable at all, the proposed combinations would not yield the same result as the claims without further modification attributable only to hindsight. EX2028, ¶83. Footwear designers simply do not start with existing pieces of designs and then look to combine them. EX2028, ¶¶81, 83. They start with a unique problem to solve and then design a complete unique solution looking forward. *Id.* They do not work backwards from existing designs. *Id.* 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 the claim of the '811 patent. EX2028, ¶83.

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 using 2-way or 4-way stretch materials for shoe uppers, or using elastic web, laces, or straps, they do not disclose or suggest implementing these elements into Kim’s disclosure such that those components are arranged as in the ’811 patent. EX2028, ¶¶58, 78, 84-86. In the claimed design, the “plurality of elastic elements” are not merely present; they are intentionally constructed, arranged and configured in a specific manner that governs how the shoe functions. EX2028, ¶85. Petitioner does not identify any prior-art teaching that would have led a skilled artisan to select the particular elements from among the different shoes, position them as claimed, and expect the resulting arrangement to preserve the functionality of the original designs. EX2028, ¶86. Indeed, both Hoying and Koo disclose configurations completely different from that of Kim, which uses the elastic elements 6, 8 at the side portion

for expansion of the foot opening. Hoying has a configuration with elastic elements at the forward portion, and Koo has a configuration with a split forward portion with a tongue that is tied by laces or elastic straps. *see* EX1007, FIG. 10A; EX1008, FIGs. 19, 22; EX2028, ¶¶52, 54-57, 86. 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 necessarily produce the claimed arrangement. *See In re Gordon*, 733 F.2d at 902-03; EX2028, ¶86.

Indeed, Petitioner itself publicly describes the products accused in the co-pending litigation of practicing the '811 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.*, EX2026 (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 systems recited in the claims of the '811 patent as “a revolutionary approach to footwear design”); EX2027 (distinguishing traditional slip-on footwear from shoes embodying the technology claimed in the '811 patent). 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. EX2028, ¶87; *see also id.*, ¶¶38-42 (describing how the claims recite a complete system with each element acting in cooperation with

others). For at least this reason, Petitioner has not shown that the asserted combinations of prior art establish a reasonable likelihood that the challenged claims would have been obvious.

b. The Petition fails to articulate either obviousness ground 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 fails to satisfy that basic requirement.

For example, Ground 2 purports to rely on Kim in view of Hoying but is presented as one jumbled section in which Petitioner also asserts “any of the other example references ... could be substituted for Hoying.” *See* Pet., 51. To compound the lack of clarity, the four identified “example” references (Lyden, Toronjo, Marvin, and Smith) are not identified in Petition’s “Grounds for Challenge.” Pet., 10.

And for Ground 3, Petitioner’s combination is equally unclear. Petitioner contends “a POSITA would have found it obvious to modify either of Kim’s first two examples (Figures 1 or 3) by *replacing or supplementing* Kim’s ‘8 Stretchable portion[s]’ with Koo’s ‘elastic web 267’ or ‘elastic laces 337.’” Pet., 70 (emphasis

added). These result in quite different combinations. *See, e.g.*, EX2028, ¶¶78-79.

The Petition further ignores that the independent claims also include limitations directed to details about the configuration and functions of the claimed “plurality of elastic elements.” EX2028, ¶¶40, 85. The Petition makes no attempt to reconcile how the Kim-Koo combination meets the limitations of claims 1 and 10 (which are still present in the respective dependent claims). In other words, the Petition explicitly relies on Kim’s stretchable portions as disclosing the specifics of the claimed “plurality of elastic elements” in the independent claims but provides no explanation how the Kim-Koo combination teaches these features, particularly if Kim’s stretchable portions are replaced. EX2028, ¶¶82, 84.

It is not the Board’s job to sift through the evidence to find suitable prior art combinations. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 6 n.2 (P.T.A.B. May 19, 2025) (precedential as to § A) (“Petitioner’s suggestion that the Board should have scoured the Petition to cobble together an argument ... improperly shifts Petitioner’s burden ... onto the Board.”). That burden lies with Petitioner and Petitioner has not met that burden here. *In re Magnum Oil*, 829 F.3d at 1375.

V. IF THE BOARD FINDS THAT PETITIONER FAILS TO MEET ITS BURDEN FOR LESS THAN ALL OF THE CHALLENGED CLAIMS AND/OR PROPOSED GROUNDS, THE BOARD SHOULD DENY INSTITUTION TO CONSERVE RESOURCES.

Petitioner has failed to meet its burden as to all claims and all grounds, as discussed above. However, should the Board disagree and determine that Petitioner met its burden for some claims, but failed to meet its burden for other claims, the Board should still deny institution here to conserve the Board's valuable resources. *See Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (P.T.A.B. Nov. 7, 2018) (informative); *see also* Interim Director Discretionary Process,⁷ §I.F.

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless ... the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” But even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims, institution of review remains discretionary. *SAS Inst. Inc.*, 584 U.S. at 358 (“[Section] 314(a) invests the Director with discretion on the question whether to institute review ...” (emphasis omitted)); *Harmonic Inc.*, 815 F.3d at 1367 (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). The

⁷ <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>

governing statute also provides that, when determining whether to exercise its discretion, the Board should consider the effect of any regulations on “the efficient administration of the Office [and] the ability of the Office to timely complete proceedings.” 35 U.S.C. § 316(b). Additionally, Rule 42.1(b) provides that the Board should also take into account the requirement to construe the rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). The Trial Practice Guide also explains that the Board may consider the number of claims and grounds that meet and do not meet the reasonable likelihood standard when deciding whether to institute *inter partes* review under 35 U.S.C. § 314(a). PTAB Trial Practice Guide,⁸ §II.D.3 (“[T]he panel will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied.”).

Here, should the Board determine that Petitioner failed to meet its burden of establishing unpatentability for some but fewer than all of the challenged claims of the ’811 patent as discussed in Section IV, the Petition should still be denied in order to conserve the Board’s valuable time and resources. *See* Interim Director Discretionary Process, §I.F; *Deeper, UAB. v. Vexilar, Inc.*, IPR2018-01310, Paper

⁸ <https://www.uspto.gov/patents/ptab/trial-practice-guide>

7 at 43 (P.T.A.B. Jan. 24, 2019) (informative) (finding that because Petitioner only demonstrated a reasonable likelihood of prevailing with respect to a subset of the 23 challenged claims, “instituting a trial with respect to all twenty-three claims ... would not be an efficient use of the Board’s time and resources.”); 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

VI. CONCLUSION

The Petition fails to show a reasonable likelihood that any of the challenged claims is unpatentable as anticipated or obvious in view of the cited art and, therefore, the Board should deny institution.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg, Registration No. 43,447
Melissa Haapala, Registration No. 47,622
Kristina C. Kelly, Registration No. 58,164
Jennifer Meyer Chagnon, Registration No. 55,440
Attorneys for Patent Owner Fast IP, LLC

Date: July 30, 2026

1101 K Street, NW,
10th Floor
Washington, DC 20005
(202) 371-2600

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 8,804 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg
Registration No. 43,447
Attorney for Patent Owner FAST IP, LLC

Date: July 30, 2026

1101 K Street, NW
10th Floor
Washington, DC 20005
(202) 371-2600

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

I certify that the above-captioned **PATENT OWNER PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107(a)** and associated Exhibits 2022-2030 were served in their entirety on July 30, 2026, upon the following parties via electronic mail:

Samuel K. Lu (Lead Counsel)
Benjamin Hattenbach (Back-up Counsel)
Ian Washburn (Back-up Counsel)
Christopher Abernethy (Back-up Counsel)
Kamran Vakili (Back-up Counsel)
Aron Berger (Back-up Counsel)
IRELL & MANELLA LLP
SkechersHFLIPRs@irell.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg
Registration No. 43,447
Attorney for Patent Owner FAST IP, LLC

Date: July 30, 2026

1101 K Street, NW
10th Floor
Washington, DC 20005
(202) 371-2600