

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PUMA NORTH AMERICA, INC.,

Petitioner,

v.

NIKE, INC.,

Patent Owner.

U.S. Patent No. 9,314,065

Issue Date: April 19, 2016

Title: ARTICLE OF FOOTWEAR WITH BASE PLATE
HAVING STRUCTURE AND STUDS

Case Number: IPR2019-01042

**PETITIONER'S BRIEF RESPONDING TO PATENT OWNER'S
ARGUMENTS REGARDING 35 U.S.C. § 314(a) AND 35 U.S.C. § 325(d)**

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LIST OF EXHIBITS

Number	Description of the Exhibit
1001	U.S. Patent No. 9,314,065 (the “’065 Patent”)
1002	U.S. Patent Application No. 13/524,044 (the “’044 Application”)
1003	The ’065 Patent File History
1004	U.S. Patent No. 5,461,801 (“Anderton”)
1005	U.S. Patent Pub. No. 2009/0293315 (“Auger”)
1006	Declaration by Darren J. Stefanyshyn, Ph.D, P.Eng
1007	Curriculum vitae of Darren J. Stefanyshyn, Ph.D, P.Eng
1008	Benno M. Nigg, Biomechanics of Running Shoes (1986)
1009	Results of Docket Navigator’s Time to Milestones Search for Hon. Leo T. Sorokin, U.S. District Court Judge for the District of Massachusetts
1010	Defendant PUMA North America, Inc.’s Motion to Stay Pending <i>Inter Partes</i> Review and Memorandum of Reasons in Support, filed as Dkt. Nos. 84–85 in NIKE, Inc. v. PUMA North America, Inc., Case No. 1:18-cv-10876 (D. Mass. May 16, 2019)
1011	NIKE, Inc.’s Opposition to PUMA North America, Inc.’s Motion to Stay Pending <i>Inter Partes</i> Review, filed as Dkt. No. 88 in NIKE, Inc. v. PUMA North America, Inc., Case No. 1:18-cv-10876 (D. Mass. May 30, 2019)

I. INSTITUTION SHOULD NOT BE DENIED UNDER § 314(A)

Institution should not be denied under 35 U.S.C. § 314(a) because the pending District Court litigation is not at a late stage, there is no scheduled trial date, and a decision by this Board will greatly simplify the issues to be tried. Document production by both sides is ongoing; fact witness depositions have not begun; the fact discovery deadline is April 10, 2020; expert reports are not due until May 8, 2020 and expert discovery does not end until July 8, 2020.¹ The *Markman* hearing is scheduled for October 17, 2019, so the Board will likely decide whether to institute before the Court renders its claim constructions. Even if those constructions are rendered sooner, denial of institution is not required. *See Semiconductor Components Indus., LLC v. Power Integrations, Inc.*, IPR2018-01811, Paper 11 at 14, 36 (PTAB May 13, 2019) (adopting district court's claim constructions issued after filing of petition). Dispositive motions will not be fully briefed until August 20, 2020 and a ruling is unlikely prior to this Board's final written decision which would be rendered by November 2020.

Despite Patent Owner's ("PO") speculation that trial will take place in October 2020 (Paper 6 at 38, 40), *no trial date has yet been set.* (Exs. 2004, 2013).

The average time between filing of the complaint and jury trial in a patent

¹ The parties have not yet disclosed testifying experts or exchanged expert reports.

PO's statements regarding Dr. Stefanyshyn are pure speculation. Paper 6 at 39.

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