

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PUMA NORTH AMERICA, INC.,
Petitioner,

v.

NIKE, Inc.
Patent Owner

Case IPR2019-1042
Patent No. 9,314,065

**PATENT OWNER'S SUR-REPLY ADDRESSING WHY THE BOARD
SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(a) AND 35
U.S.C. § 325(d) AND DENY INSTITUTION**

LIST OF EXHIBITS

Exhibit	Description
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)
2001	Declaration of Kim Blair, Ph.D.
2002	CV of Kim Blair, Ph.D.
2003	Joint Claim Construction Statement
2004	Amended Scheduling Order
2005	Second Amended Complaint

2006	Notice of Scheduling Conference
2007	June 27, 2019 Order Resetting Briefing Schedule
2008	Excerpts of District of Massachusetts Local Rules
2009	Excerpts of Puma’s Supplemental Preliminary Patent-Related Disclosures
2010	Dr. Stefanyshyn’s Declaration in Support of Claim Construction in District Court Litigation
2011	June 7, 2019 Order Denying Puma’s Motion to Stay
2012	Dictionary Definition of “Point”
2013	July 29, 2019 Order Resetting Claim Construction Hearing
2014	Supplemental Joint Claim Construction Statement
2015	Excerpts of Dr. Stefanyshyn’s Deposition Transcript, July 23, 2019
Newly Submitted Exhibit	
2016	Public Notice Amendments to Local Rules of the United States District Court for the District of Massachusetts, May 28, 2018

I. The Board Should Deny Institution Under 35 U.S.C. § 325(d)

The Board should deny institution under 35 U.S.C. § 325(d). Petitioner cannot dispute that it relies on the same combination of prior art (Anderton and Auger) considered and applied by the Examiner. (Paper 1, at 6-8; Ex. 1003, at 192-196, 438-442.) This fact alone justifies denying institution. *Pfizer, Inc. v. Genentech, Inc.*, IPR2018-00373, Paper 12, at 14-15 (PTAB Aug. 2, 2018); *AgaMatrix, Inc. v. Dexcom, Inc.*, IPR2018-01717, Paper 10 at 16 (PTAB Mar. 13, 2019) (denying institution under § 325(d) “because the same prior art previously was presented to the Office.”) Unable to contest that the first three *Becton-Dickson* factors weigh against it, Petitioner argues that it presents “different arguments and new evidence.” (Paper 8, at 3.) None of these points have merit.

First, Petitioner rehashes the central argument considered during prosecution—whether a POSITA would have been motivated to add Auger’s medial midfoot bar to Anderton’s base plate. (*Compare* Ex. 1003, at 195, 476-480 with Paper 6, at 32-37.) The Examiner initially found a POSITA would be so motivated because the combination would provide “increased support.” (Ex. 1003, at 195.) Petitioner argues the same reasons for combining the references which Patent Owner overcame, but uses different words such as increased strength, “improved stability,”

and “structural reinforcement.”¹ (Paper 6, at 25, 24, 37.) Thus, the arguments considered by the Examiner and in the Petition relating to why a POSITA would have been motivated to combine Auger and Anderton overlap significantly.

Next, Petitioner characterizes as “new evidence” the Declaration of Dr. Stefanyshyn and his explanation that “a POSITA would know *how* to vary” Anderton when adding Auger (Paper 8, at 5), but it is not “new evidence.” The declaration relies on the same structures in Auger and Anderton and the same rationale for *why* a POSITIA would combine the references, *e.g.*, to support/reinforce or provide increased stability/pronation control, that the Examiner relied on. (*See* Ex. 1003, at 195; Ex. 1006, at ¶¶ 37-38; *see also* Paper 6, at 28-31.) Moreover, the explanation does not provide new evidence as to *why* a POSITA would combine the references; it only addresses how a POSITA would do so, if a reason to combined existed, which the Examiner ultimately concluded there was not.

Petitioner also posits its argument in the Petition that the “spaced apart” limitations are “design choices” as a “new” argument warranting institution. (Paper

¹ Patent Owner overcame the rejection by arguing that “Anderton is configured to provide particular performance characteristics” including “improved comfort” and “that the modification would alter the fundamental operation of Anderton.” (Ex. 1003, at 478-80.)

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