

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNDER ARMOUR, INC.,
Petitioner,

v.

ATHALONZ, LLC,
Patent Owner.

IPR2024-00636
Patent 10,674,786 B2

Before WILLIAM V. SAINDON, HYUN J. JUNG, and
CARL M. DEFranco, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Under Armour, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–8 (“the challenged claims”) of U.S. Patent No. 10,674,786 B2 (Ex. 1001, “the ’786 patent”). Athalonz, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314(b) and 37 C.F.R. § 42.4(a). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons provided below, we determine that Petitioner has satisfied the threshold requirement set forth in 35 U.S.C. § 314(a). Because Petitioner has demonstrated a reasonable likelihood that at least one claim of the ’786 patent is unpatentable, we institute an *inter partes* review. 37 C.F.R. § 42.108(a).

Our findings of fact, conclusions of law, and reasoning discussed below are based on the evidentiary record developed thus far, and made for the sole purpose of determining whether the Petition meets the threshold for initiating review. This decision to institute trial is not a final decision as to the patentability of any challenged claim or the construction of any claim limitation.

B. Real Parties in Interest

The parties both assert that they are the sole real parties in interest. Pet. ix; Paper 4, 1 (Patent Owner's Mandatory Notice).

C. Related Matters

The parties both identify *Athalonz, LLC v. Under Armour*, Case No. 2:23-cv-00193 (E.D. Tex.) as a related matter. Pet. ix; Prelim. Resp. 18; Paper 4, 1.

Patent Owner also identifies several of its patents challenged by Petitioner in: IPR2024-00637 (U.S. Pat. No. 11,013,291); IPR2024-00638 (U.S. Pat. No. 11,064,760); IPR2024-00639 (U.S. Pat. No. 11,375,768); and IPR2024-00640 (U.S. Pat. No. 11,510,456). Prelim. Resp. 18.

D. Prior Art and Asserted Grounds

Petitioner's grounds rely on the following prior art references:

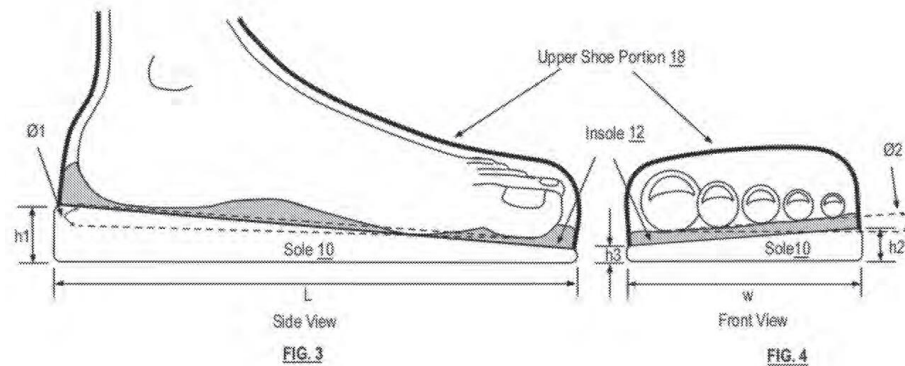
Name	Reference	Exhibit No.
Rubin	US Pat. 3,789,523, iss. Feb. 5, 1974	1007
Dufour	US Pat. 4,754,561, iss. July 5, 1988	1006
Kim	US Pub. 2004/0040181 A1, pub. Mar. 4, 2004	1005

Petitioner asserts that the challenged claims would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–8	103	Kim
1–3, 5, 6, 8	103	Dufour
1–3, 5, 6, 8	103	Rubin
2, 4, 7	103	Dufour, Kim
2, 4, 7	103	Rubin, Kim

E. Overview of the '786 Patent

The '786 patent is directed to a shoe or insole that positions a big toe lower than an outer toe, both of which are lower than the heel. Ex. 1001, code (57). Figures 3 and 4, reproduced below, are illustrative:



Figures 3 and 4 depict a left foot atop sole 10 where, due to the slope of the sole, the heel is at height h_1 , the little toe is at height h_2 , and the big toe is at height h_3 , where $h_3 < h_2 < h_1$. *Id.* at 8:60–9:8.

F. Challenged Claims

Claims 1–8 are challenged. Claims 1 and 5 are independent. Claims 1 and 5 are reproduced below.

1. An apparatus comprises:
 - a heel platform section that has a uniform height from an outer edge to an inner edge of the apparatus at the rear edge of the apparatus, wherein the uniform height establishes a reference slope from the outer edge to the inner edge, the reference slope substantially parallel to a bottom surface of the apparatus;
 - a mid-foot section juxtaposed to the heel platform section; and
 - a toe section juxtaposed to the mid-foot section, wherein the mid-foot section and the toe section form an angled support

platform that has a first slope along the inner edge of the apparatus from a front edge of the apparatus to the heel platform section, a second slope along the front edge of the apparatus from the inner edge to the outer edge of the apparatus, and a third slope along the outer edge of the apparatus from the front edge of the apparatus to the heel platform section, the first slope, second slope, and the third slope each greater than the reference slope, wherein the toe section is lower than the heel platform section as a result of the first, second, and third slopes.

5. A shoe comprises:

an upper shoe section; and

a sole coupled to the upper shoe section, wherein the sole includes:

a specific bottom; and

an athletic positioning sole section having:

a heel platform section that has a uniform height from an outer edge to an inner edge of the athletic positioning sole section at a rear edge of the athletic positioning sole section, wherein the uniform height establishes a reference slope from the outer edge to the inner edge, the reference slope substantially parallel to a bottom surface of the sole;

a mid-foot section; and

a toe section, wherein the mid-foot section and the toe section form an angled support platform that has a first slope along the inner edge of the athletic positioning sole section from a front edge of the athletic positioning sole section to the heel platform section, a second slope along the front edge of the athletic positioning sole section from the inner edge to the outer edge of the athletic positioning sole section, and a third slope along the outer edge of the athletic positioning sole section from the front edge of the athletic positioning sole section to the heel platform section, the

first slope, second slope, and the third slope each greater than the reference slope.

II. DISCRETIONARY ANALYSIS

Patent Owner asserts that we should deny institution under *Fintiv* based on the related district court matters identified above. Prelim. Resp. 22–34; see *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 11–12 (PTAB Mar. 20, 2020) (precedential) (holding that PTAB has discretion to deny institution in certain circumstances where there are parallel district court proceedings). Our analysis under *Fintiv* is guided by the USPTO Director’s Memorandum issued on June 21, 2022, titled “Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation” (“Director’s Memo”). Pursuant to the Director’s Memo, we “will not discretionarily deny institution . . . where a petitioner presents a [*Sotera*] stipulation.” Director’s Memo at 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)). Because Petitioner has offered a stipulation like in *Sotera*, i.e., to “not pursue in the associated litigation . . . the grounds raised in the Petition for IPR or any other grounds that could have reasonably been raised before the PTAB in this proceeding” (Paper 7), we do not discretionarily deny institution under *Fintiv*.

III. MERITS ANALYSIS

A. Legal Standards Used in the Merits Analysis

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C.

§ 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious . . . to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective evidence of non-obviousness, i.e., secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner asserts that:

A person of ordinary skill in the art would have (1) at least a B.S. or equivalent degree related to industrial or product design and at least two years’ experience designing or developing athletic shoes; or (2) at least five years designing or developing athletic shoes.

Pet. 15 (citing Ex. 1002 ¶ 31). Patent Owner does not contest. Prelim. Resp. 17. Reviewing the ’786 patent and the cited prior art, we determine that Petitioner’s proposed level of skill is reasonable and adopt it for purposes of this Decision.

C. Claim Construction

Under 37 C.F.R. § 42.100(b), we apply the claim construction standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). That is, “the words of a claim ‘are generally given their ordinary and customary meaning’ . . . that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1312–13.

Petitioner does not set forth any particular claim construction at this time. That said, Petitioner draws our attention to the way Patent Owner has allegedly characterized some of the limitations in the claims of the ’786 patent. Pet. 12–14. We acknowledge Petitioner’s position that Patent Owner has asserted, e.g., that a “uniform height” can be met by a curved surface. *Id.* (citing Ex. 1009, Ex. C, pp. 17, 41 (excerpt from Patent Owner’s Infringement Contentions)). However, at this time, we do not construe these terms because they are not at issue. *Realtime, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Patent Owner proposes that the term “athletic positioning” in independent claim 5 should be construed to mean “a heel section higher than the toe section and the outside edge of the toe section higher than the inside edge of the toe section.” Prelim. Resp. 20–22. However, independent claim 5 already appears to give the term “athletic positioning” this meaning, where it describes the various slopes. In particular, the claim recites that the toe section forms an angled support platform that has a first slope along the

inner edge of the sole and a third slope along the outer edge of the sole, each of which extend from the toe to the heel. Accordingly, Patent Owner's proposed construction appears unnecessary in view of the claim. In sum, we do not explicitly construe any limitations at this time.

*D. Asserted Obviousness Over Kim
(Claims 1–8)*

Petitioner asserts that claims 1–8 would have been obvious in view of Kim. Pet. 15–30. The parties' arguments are focused on the various slope limitations of independent claims 1 and 5. In particular, the limitations in claims 1 and 5 are directed to an apparatus (e.g., shoe) having an angled support platform with a first slope along the *inner* edge from the heel to the front, a second slope along the *front* edge from the inner edge to the outer edge, and a third slope along the *outer* edge from the heel to the front. Together, these slopes form a big toe section lower than an outer (little) toe section, which are both lower than the heel section. See Ex. 1001, Figs. 3, 4 (reproduced *supra*). We begin with an overview of Kim, and then turn to the parties' disputes.

1. Kim

Kim is directed to a pair of golf shoes having an outsole with the lower surface inclined between its outer and inner edges. Ex. 1005 ¶ 2. Kim states that the inclination assists a golfer in concentrating their weight balance on the inner edges of their feet during the swing motion, which Kim states allows the golfer to maintain a more stable position. *Id.* ¶ 12. In order to provide that inclination during the swing but allow a golfer to walk stably on hard ground, the slope across the front edge of the shoe in Kim is

complemented by the length of the spikes. Figure 3b depicts a cross-section of the sole of the golf shoe according to Kim's invention:

FIG. 3b

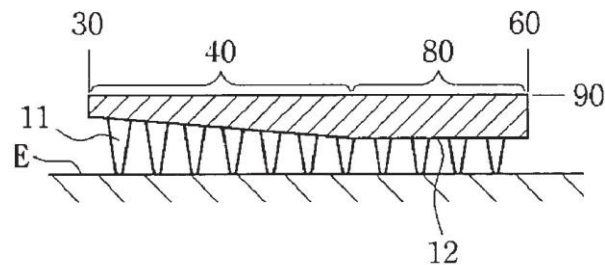


Figure 3b depicts a cross-section of an outsole of a golf shoe. The height of spikes 11 at inner edge 30 of the sole is shown larger than that of spikes 11 at outer edge 60 of the sole, while the thickness of the sole is thinner at inner edge 30 than outer edge 60. Accordingly, the combination of the sole's slope and the spikes' lengths makes it so the golfer can walk around normally on hard surfaces on the tips of the spikes, but adopt a more balanced position when swinging a golf club once those spikes sink into the softer grass. Figures 5a and 5b of Kim show these positions:

FIG. 5a

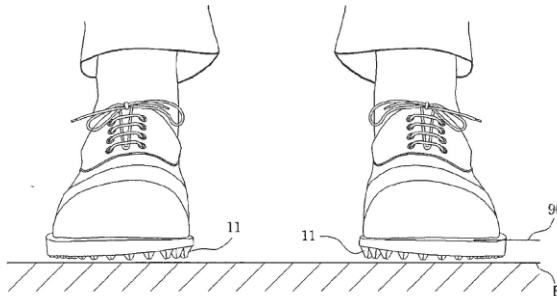


FIG. 5b

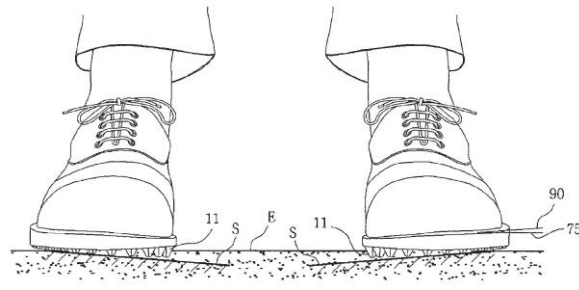


Figure 5a (left) illustrates the feet of a golfer in a pair of golf shoes standing on hard ground. *Id.* ¶ 38. The lengths of the spikes on the ground ensure that the golfer's feet are parallel with the ground (despite the sloped sole). *Id.* Figure 5b (right) illustrates the feet of a golfer in a pair of golf shoes standing on a green with their feet sloped inward. *Id.* ¶ 36. Figure 5b depicts the spikes sunk into the ground (line S) up to the sole, such that the golfer has their feet sloped inwardly. This position provides more grip for the golfer. *Id.*

2. Analysis

Patent Owner argues that Kim does not disclose the slopes required in independent claim 1. Prelim. Resp. 34–37. Patent Owner focuses its analysis on Figure 5a, however, which depicts the golfer standing on a hard surface. Patent Owner passes over the disclosure in Kim's Figure 5b, which appears to depict the claimed big toe-to-little toe slope when the golfer is attempting a swing. *Hewlett-Packard Co. v. Mustek Systems, Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003) (“Just as ‘an accused product that sometimes, but not always, embodies a claimed method nonetheless infringes,’ *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 622–623 (Fed. Cir. 1995), a prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention.”). Thus, we are persuaded that Kim sufficiently discloses the claimed slopes in the configuration shown in Figure 5b.

Patent Owner's argument for independent claim 5 recognizes the disclosure in Kim's Figure 5b, but argues that the entire foot of the golfer would be inclined, including the heel. Prelim Resp. 37–41. It is not clear to us, on this record, what Patent Owner is basing its argument on. We find no

disclosure in Kim suggesting that the heel is inclined. To the contrary, the record suggests a person of ordinary skill in the art would presume a flat heel absent disclosure to the contrary. Specifically, Petitioner's declaration states that "having a heel platform of uniform height throughout is standard shoe design" (Ex. 1002 ¶ 47) and, as Kim makes clear, "[e]xcept for the outsole 10 including the inclined lower surface 12, the golf shoe 100 of the present invention is substantially the same as conventional golf shoes" (Ex. 1005 ¶ 27). Thus, we are not persuaded, on this record, that the heel in Kim is inclined in the same manner as the sole.

Reviewing the Petition and Preliminary Response, we determine that Petitioner has established a reasonable likelihood of success in showing that claims 1 and 5 would have been obvious in view of Kim.

3. *Remaining Grounds*

Petitioner also asserts that various challenged claims are unpatentable as obvious in view of Dufour (Pet. 30–41), Rubin (*id.* at 41–52), Dufour and Kim (*id.* at 52–56), and Rubin and Kim (*id.* at 56–58). Dufour and Rubin also disclose golf shoes, and are very similar to Kim. *See generally* Exs. 1006, 1007. In order to provide some guidance to the parties, we will address Patent Owner's arguments unique to the remaining grounds.

Regarding the Dufour ground, Patent Owner argues that Petitioner is mixing and matching embodiments to show the claim limitations. Prelim. Resp. 43–45. Patent Owner is referencing the fact that Petitioner cites to Figures 9 and 10, as well as Figures 11 and 12, in its analysis. *See, e.g.*, Pet. 34–35. Dufour does state that Figures 11 and 12 are "another embodiment" compared to Figures 9 and 10. Ex. 1006, 3:26–29. That said, all of these embodiments are highly similar, and to the extent Petitioner presents Figure

9 or 10 to more clearly illustrate a feature, it appears to be a feature that is also illustrated in Figure 11 or 12. For example, the side-to-side slope depicted in Figures 9 and 10 is also depicted in Figure 12. *Compare id.*, Fig. 9 *with id.*, Fig. 12. Thus, we are not persuaded that Petitioner's choice to cite to the various figures here makes any meaningful difference.

Patent Owner also argues that Dufour discloses the heel to be at the same height as the toe area. Prelim. Resp. 42–43. Patent Owner does not persuasively explain its position. In contrast, Petitioner's showings with respect to Figure 11 of Dufour appear to satisfy the first and third slope limitations requiring the heel to be taller than the toe area. *See* Pet. 34–35. In particular, the heel area visually appears to be taller than the toe area in Figures 11 and 12. This visual inspection is supported by Petitioner's declarant, who states that it is generally expected that a heel area is taller than a toe area in a shoe. Ex. 1002 ¶ 63. Thus, we are not persuaded that the toe area in Dufour is the same height as the heel area.

Patent Owner's arguments with respect to Rubin repeat prior arguments made with respect to Kim and Dufour. *See* Prelim. Resp. 47–54. Patent Owner's arguments with respect to the combinations of Dufour and Kim, and Rubin and Kim, rely on its earlier arguments. *Id.* at 54–55.

IV. CONCLUSION

For the reasons given above, we determine that Petitioner has established a reasonable likelihood of success in showing that claims 1 and 5 of the '786 patent would have been obvious in view of Kim. Accordingly, we institute *inter partes* review on all challenged claims and grounds. 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will

authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review of claims 1–8 of the ’786 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), the *inter partes* review of the ’786 patent commences on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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