

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNDER ARMOUR, INC.,
Petitioner,

v.

ATHALONZ, LLC,
Patent Owner.

IPR2024-00637
Patent 11,013,291 B2

Before WILLIMA V. SAINDON, HYUN J. JUNG, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

DEFRANCO, *Administrative Patent Judge*.

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

Athalonz, LLC is the owner of U.S. Patent No. 11,013,291 B2 (Ex. 1001, “the ’291 patent”). Under Armour, Inc. filed a petition for *inter partes* review of the ’291 patent, challenging claims 1–5. *See* Paper 1 (“Pet.”). In due course, Athalonz filed a preliminary response. *See* Paper 6 (“Prelim. Resp.”). And, per our authorization, Under Armour filed a *Sotera* stipulation. *See* Paper 7. Exercising our jurisdiction under 35 U.S.C. § 314(a), we institute *inter partes* review of the challenged claims.

I. BACKGROUND

A. Related Matters

The ’291 patent is the subject of a federal district court action: *Athalonz, LLC v. Under Armour, Inc.*, No. 2:23-cv-00193 (E.D. Tex.). *See* Paper 3. The district court action involves four other patents that are also the subject of petitions for *inter partes* review: IPR2024-00636 (US 10,674,786 B2); IPR2024-00638 (US 11,064,760 B2); IPR2024-00639 (US 11,375,768 B2); and IPR2024-00640 (US 11,510,456 B2). *See* Paper 6, at 17.

B. The ’291 Patent

The ’291 patent relates generally to “athletic positioning footwear.” Ex. 1001, 1:39–40. According to the ’291 patent, prior athletic positioning footwear included an upper, a sole, an insole, and cleats or spikes, and it was known that “the sole and/or padded insole provide[s] a relatively flat platform for the foot” and that “the heel portion of the shoe be higher than the toe portion of the shoe from a side perspective.” *Id.* at 1:56–2:7, Figs. 1–2. But, unlike prior athletic positioning footwear, the claimed invention purports to have a forefoot platform that is constructed to be more compressible near its inner edge than its outer edge. *Id.* at 27:39–46, 33:50–34:20, Figs. 93–94, 112–113.

C. Challenged Claims

Claim 1 is the only independent claim and reads as follows:

1. A shoe comprises:
 - an upper section;
 - a midsole coupled to the upper section;
 - an insole positioned proximal to the midsole and within the upper section; and
 - a bottom outsole coupled to the midsole, wherein a combination of the midsole, the insole, and the bottom outsole form an athletic positioning shape, wherein the athletic positioning shape has:
 - a first height at an inside edge and at an outside edge of the shoe along a heel section of the shoe,
 - a second height on the outside edge of the shoe at a toe section of the shoe,
 - a third height on the inside edge of the shoe at the toe section of the shoe, and
 - the first height being greater than the second height and the second height being greater than the third height, wherein a first slope is formed by the first height and the second height, wherein a second sloped^[1] is formed by the first height and the third height, and wherein a third slope is formed by the second height and the third height.

D. Asserted Challenges

Claims Challenged	35 U.S.C. §	Basis
1–5	103	Kim ²
1–5	103	Dufour, ³ Kim
1–5	103	Rubin, ⁴ Kim

¹ The parties agree that “a second sloped” should read as “a second slope.”
See, e.g., Pet. 21; Prelim. Resp. 32.

² US 2004/0040181 A1, published Mar. 4, 2004 (Ex. 1005, “Kim”).

³ US 4,754,561, issued July 5, 1988 (Ex. 1006, “Dufour”).

⁴ US 3,789,523, issued Feb. 5, 1974 (Ex. 1007, “Rubin”).

In further support of these challenges, Under Armour relies on the declaration of Grant Delgatty. *See* Ex. 1002. Athalonz chose not to submit a rebuttal declaration at this stage.

II. ANALYSIS

A. Discretionary Denial Under 35 U.S.C. § 314(a)

Athalonz requests that we discretionarily deny institution under 35 U.S.C. § 314(a) due to the advanced state of the parallel district court action. *See* Prelim. Resp. 20–32. Under Armour disputes that discretionary denial is warranted (Pet. 55), but nonetheless submits a *Sotera* stipulation (Paper 7) per our authorization. In light of Under Armour’s *Sotera* stipulation, we will not discretionarily deny institution under § 314(a). *See* Director Memorandum, *Interim Procedure for Discretionary Denials in AIA-Post Grant Proceedings With Parallel District Court Litigation*, U.S. PATENT AND TRADEMARK OFFICE (June 21, 2022), at 3, 7.

B. Level of Ordinary Skill in the Art

Under Armour proposes that one of ordinary skill in the art would have had:

(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’ experience designing or developing athletic shoes.

Pet. 11 (citing Ex. 1002 ¶ 31). Athalonz agrees. *See* Prelim. Resp. 16 (accepting Under Armour’s proposed definition “[f]or present purposes”). At this stage, we see no reason to depart from Under Armour’s proposed definition, as it appears reasonable and consistent with the asserted prior art and the ’291 patent.

C. Claim Construction

Aside from “ordinary and customary meaning,” Under Armour does not propose any particular claim construction at this time. *See* Pet. 10. Athalonz proposes that the term “athletic positioning” in claim 1 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. 17–20. We note, however, that claim 1 already appears to define the term by describing the various heights and slopes of the sole that provide “athletic positioning” of the foot. *See* Ex. 1001, 43:22–36 (“wherein the athletic positioning shape has . . .”). Thus, because Athalonz’s proposed construction appears unnecessary in view of the claim language, we need not explicitly construe this limitation any more than claim 1 already does.

D. Obviousness Over Kim

Under Armour challenges claims 1–5 as being obvious over Kim. *See* Pet. 11–26. In doing so, Under Armour explains how Kim satisfies each claim element and provides supporting testimony from its expert. *See id.* (citing Ex. 1002 ¶¶ 53–68).

Athalonz first argues that Kim fails to disclose the “three slopes” limitation of claim 1. Prelim. Resp. 32–37. As for that limitation, claim 1 recites a first slope formed by the first and second heights, a second slope formed by the first and third heights, and a third slope formed by the second and third heights. *See* Ex. 1001, Figs. 3–5. Together, these three slopes form a big toe section that is lower than a little toe section, with both being lower than the heel section of the shoe’s sole. *See id.* In arguing that Kim fails to disclose the three slopes as claimed, Athalonz focuses on Kim’s Figures 3b and 5a. Prelim. Resp. 33–34. Those figures, however, depict a golfer standing “on a hard ground such as a paved road.” Ex. 1005 ¶ 38; *see*

also id. ¶ 23. Athalonz overlooks the disclosure in Kim’s Figure 5b, which depicts the claimed big toe-to-little toe slope when the golfer is standing “on a green” in the “address position” of the golfer’s swing. Ex. 1005 ¶¶ 24, 35–36. That is, although the golfer’s stance on the hard surface in Kim’s Figure 5a may not satisfy the claimed three slopes, the golfer’s stance on the softer grass surface in Kim’s Figure 5b most certainly does. *See 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 three slopes recited by claim 1.

Athalonz also argues that Kim fails to disclose the “athletic positioning” limitation of claim 1. *See* Prelim. Resp. 37–41. In doing so, Athalonz acknowledges Kim’s disclosure in Figure 5b, but argues that the entire foot of the golfer would be inclined, “including the heel.” *See id.* at 41. It is not clear to us, on this record, what Athalonz is basing its argument on. Nowhere do we discern where Kim discloses, or otherwise suggests, that the heel is inclined. To the contrary, we find that one skilled in the art would have presumed the heel section to be flat, absent any disclosure to the contrary. Indeed, Under Armour’s expert testifies that “[h]aving a heel platform of consistent 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, at

this stage, we are not persuaded that the heel section in Kim is inclined in the same manner as the forefoot section.

Athalonz does not dispute Under Armour's showing that Kim discloses the remaining limitations of claim 1, as well as those of dependent claims 4–5. *See* Prelim. Resp. 34–42 (arguing only the “three slopes” and “athletic positioning” limitations). In reviewing the preliminary record, we find that Under Armour sufficiently shows that Kim discloses each of those additional limitations. *See* Pet. 12–14, 21–26. Thus, at this stage, Under Armour demonstrates a reasonable likelihood of showing that claims 1–5 are unpatentable as obvious over Kim.

E. Under Armour's Additional Challenges

Under Armour also challenges claims 1–5 of the '291 patent as obvious over Dufour and Kim and as obvious over Rubin and Kim. *See* Pet. 2, 26–54. Like Kim, Dufour and Rubin also disclose golf shoes. *See generally* Exs. 1006, 1007. With respect to the Dufour/Kim challenge, Athalonz contends that Under Armour “mixes and matches [Dufour's] separate embodiments” to show the claimed three slopes. Prelim. Resp. 43. In particular, Athalonz notes Under Armour's reliance on Figures 9 and 10, as well as Figures 11 and 12, in Dufour. *See id.* at 44–46 (citing Pet. 35–36). According to Athalonz, these figures “are directed to two different embodiments with different features.” *Id.* at 42. Indisputably, Dufour states that Figures 11 and 12 are “another embodiment” compared to that of Figures 9 and 10. Ex. 1006, 3:26–29. That said, however, all of these figures share some common features, and to the extent Under Armour relies on a feature in one figure to better illustrate the same feature in another figure, we find nothing wrong with that approach. Thus, we are not

persuaded that Under Armour’s reliance on various figures in Dufour amounts to any meaningful difference.

Athalonz also contends that Dufour discloses the heel area of the shoe to be “at the same height as the big toe area.” Prelim. Resp. 42. But, aside from attorney argument, Athalonz does not persuasively explain how Dufour discloses that to be the case. *See id.* In contrast, Under Armour points specifically to Dufour’s Figures 11 and 12 to satisfy the slope limitation requiring the heel area to be higher than the toe area. *See* Pet. 32, 34–35. Indeed, the heel area visually appears to be higher than the toe area in Figures 11 and 12, as supported by the testimony of Under Armour’s expert. *See* Ex. 1002 ¶¶ 81–82. Thus, we reject the notion that the toe area in Dufour is the same height as the heel area.

Athalonz’s arguments with respect to the Rubin/Kim challenge generally follow those made with respect to the Dufour/Kim challenge. *See* Prelim. Resp. 47–55. Thus, we find them equally unpersuasive for the reasons discussed above.

III. CONCLUSION

For the above reasons, we determine that Under Armour demonstrates a reasonable likelihood of proving that claims 1–5 are unpatentable as obvious over Kim. And because “[e]qual treatment of claims and grounds for institution purposes has pervasive support in *SAS*,” we institute on all the challenges as raised in the petition. *See* 37 C.F.R. § 42.108(a), (c); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)).

IV. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review of claims 1–5 of the '291 patent is *instituted*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial, which will commence on the entry date of this Decision.

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