

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNDER ARMOUR, INC.,
Petitioner,

v.

ATHALONZ, LLC,
Patent Owner.

IPR2024-00638
Patent 11,064,760 B2

Before HYUN J. JUNG, CARL M. DeFRANCO, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Dismissing Patent Owner's Motion to Exclude
37 C.F.R. § 42.64(c)

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) (2024) and 37 C.F.R. § 42.73 (2023). For the reasons that follow, we determine that Under Armour, Inc. (“Petitioner”) has shown by a preponderance of the evidence that claims 1–11 of U.S. Patent No. 11,064,760 B2 (Ex. 1001, “the ’760 patent”) are unpatentable.

A. *Background and Summary*

Petitioner filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 1–11 of the ’760 patent. Athalonz, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review of claims 1–11 of the ’760 patent on all presented challenges. Paper 8 (“Inst. Dec.”), 13.

After institution, Patent Owner filed a Response (Paper 12, “PO Resp.”), to which Petitioner filed a Reply (Paper 15, “Pet. Reply”), and Patent Owner thereafter filed a Sur-reply (Paper 23, “PO Sur-reply”). In addition, Patent Owner filed a Motion to Exclude (Paper 29, “Mot.”), Petitioner filed an Opposition to the Motion to Exclude (Paper 30, “Opp.”), and Patent Owner filed a Reply in Support of the Motion to Exclude. Paper 33 (“Mot. Reply”). An oral hearing in this proceeding was held on June 17, 2025; a transcript of the hearing is included in the record. Paper 38.

B. *Real Parties in Interest*

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

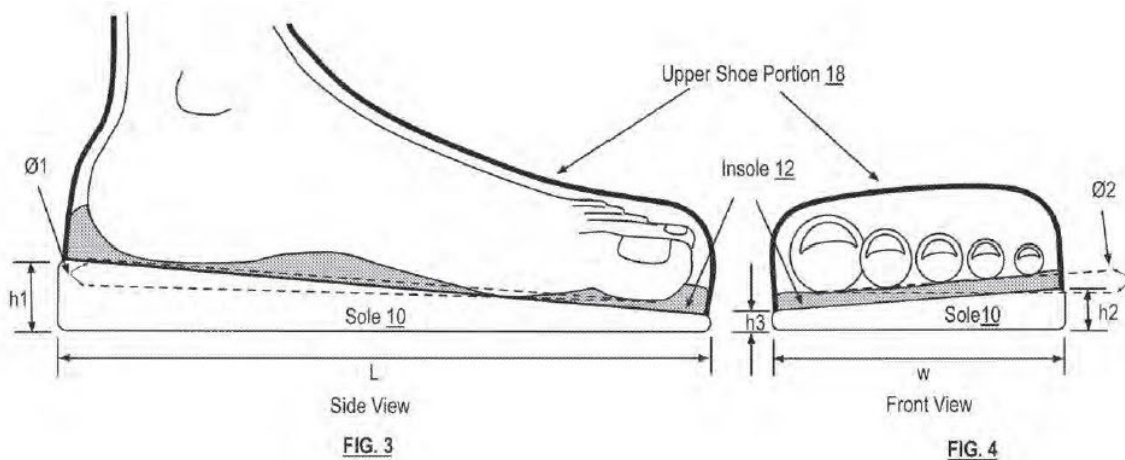
C. Related Matters

The parties both identify *Athalonz, LLC v. Under Armour, Inc.*, Case No. 2:23-cv-00193 (E.D. Tex.) as a related matter. Pet. x; PO Resp. 24; Paper 4, 1.

Patent Owner also identifies several of its patents challenged by Petitioner in: IPR2024-00637 (U.S. Pat. No. 11,013,291); IPR2024-00636 (U.S. Pat. No. 10,674,786); IPR2024-00639 (U.S. Pat. No. 11,375,768); and IPR2024-00640 (U.S. Pat. No. 11,510,456). PO Resp. 24–25.

D. Overview of the '760 Patent (Ex. 1001)

The '760 patent is directed to a pair of shoes that positions a big toe lower than an outer toe, both of which are lower than the heel. Ex. 1001, Abstract. 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 $h1$, the little toe is at height $h2$, and the big toe is at height $h3$, where $h3 < h2 < h1$. *Id.* at 9:9–24.

E. Illustrative Claim

Claims 1–11 are challenged. Claim 1 is independent and is reproduced below.

1. A pair of shoes comprises:

a left foot shoe including:

a left upper shoe portion; and

a left sole coupled to the left upper shoe portion, wherein a foot platform of the left sole provides an athletic positioning of a left big toe area of the left shoe at a lower position than a left heel area of the left shoe and at a lower position than an outer small toe area of the left shoe, wherein, from an inner edge to an outer edge of the left shoe, the left heel area has substantially no slope, and wherein, from the inner edge to the outer edge of the left shoe at a cross section at a ball of ball, a bottom of the left sole is substantially linear; and

a right foot shoe including:

a right upper shoe portion; and

a right sole coupled to the right upper shoe portion, wherein a foot platform of the right sole provides an athletic positioning of a right big toe area of the right shoe at a lower position than a right heel area of the right shoe and at a lower position than an outer small toe area of the right shoe and wherein, from an inner edge to an outer edge of the right shoe, the right heel area has substantially no slope, and wherein, from the inner edge to the outer edge of the right shoe at a cross section at a ball of ball, a bottom of the right sole is substantially linear.

Ex. 1001, 43:14–40.

F. Instituted Grounds of Unpatentability

We instituted *inter partes* review of all challenged claims based on the six grounds of unpatentability, which are provided in the table below:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–3, 6–8, 11	103	Kim ²
1–3, 6–8, 11	103	Dufour ³
1–3, 6–8, 11	103	Rubin ⁴
4, 5, 9, 10	103	Kim, De Obaldia ⁵
4, 5, 9, 10	103	Dufour, De Obaldia
4, 5, 9, 10	103	Rubin, De Obaldia

Pet. 2. Petitioner also relies on a Declaration of Grant Delgatty (Ex. 1002) and Supplemental Declaration of Mr. Delgatty (Ex. 1022). Patent Owner provides a Declaration of Timothy Markison. Ex. 2008.

Mr. Markison was cross-examined. *See* Ex. 1023 (deposition transcript of Mr. Markison). Mr. Delgatty was also cross-examined. *See* Ex. 2010 (first deposition transcript of Mr. Delgatty); Ex. 2022 (second deposition transcript of Mr. Delgatty).

¹ The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the ’760 patent claims priority to an application filed before that date, our citations to 35 U.S.C. §§ 102 and 103 in this Decision are to their pre-AIA versions. *See* Pet. 5 (noting that the ’760 patent “claims the benefit of U.S. Provisional Patent Application No. 61/450,485, filed March 8, 2011”); *see also* PO Resp. 23 (stating the same).

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”).

⁵ US Pat. 4,754,561, issued July 5, 1988 (Ex. 1008, “De Obaldia”).

II. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent [claim] it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail in an *inter partes* review, the petitioner must support its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

Petitioner contends that the challenged claims of the ’760 patent are unpatentable under § 103. Pet. 2. A claim is unpatentable under § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made 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) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Whether a combination of elements produces a predictable result weighs in the ultimate determination of obviousness. *Id.* at 416–417.

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). Petitioner adds, however, that “the claims are obvious in view of any reasonable definition of a POSITA [(Person of Skill in the Art)].” *Id.*

Patent Owner responds that “[f]or purposes of this proceeding, Patent Owner does not dispute Petitioner’s level of ordinary skill.” PO Resp. 23 (citing Pet. 15). Patent Owner adds that Mr. Markison’s “knowledge and experience, which includes 13 years of designing and developing athletic shoes that embody the patent at issue here, far exceeds the proposed level of ordinary skill in the art.” *Id.* at 24 (citing Ex. 2008 ¶¶ 43–44).

Based on the full record, we determine that Petitioner’s proposed level of skill is reasonable and consistent with the ’760 patent and the asserted prior art. Thus, for these reasons, we adopt Petitioner’s level of skill in the art 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 argues that all claim limitations are met in the prior art under any interpretation of the challenged claims. Pet. 12. Petitioner does, however, draw our attention to the way Patent Owner has allegedly characterized some of the limitations in the claims of the '760 patent related to construction of what constitutes an “inner edge” and “outer edge” of a “heel area.” *Id.* at 12–13. Petitioner asserts that Patent Owner appears “to mean the edges of the portion of the shoe where the heel of the foot sits, not the inner and outer-most edges of the shoe,” and “construe[s] this limitation to include a heel area that includes some degree of curvature and height change from its inner edge to its outer edge.” *Id.* (citing Ex. 1009, Ex. B, p. 23; Ex. 1021 (excerpt from Patent Owner’s Infringement Contentions)).

Patent Owner agrees that “Petitioner’s construction of ‘inner edge’ and ‘outer edge’ to mean the ‘edges of the portion of the shoe where the foot sits’ is consistent with how a POSITA would understand those terms in light of the specification.” PO Resp. 26 (citing Ex. 2008 ¶¶ 85–89, 90–91). Patent Owner adds that “[i]n light of the specification, the ‘inner’ and ‘outer edges’ in the claims do not refer to the edges of the exterior of the shoe.” *Id.* (citing Ex. 2008 ¶¶ 90–91).

Based on the full record, the parties’ agreed-upon construction of the terms “inner edge” and “outer edge” appears consistent with the plain language of the claims and Specification. Thus, we adopt it.

1. “Athletic Positioning”

Patent Owner argues that the term “athletic positioning” in independent claim 1 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.” PO Resp. 27; PO Sur-reply 7–8. According to Patent Owner, “[a]llowing ‘athletic positioning’ to have some broader or

different meaning, or no meaning because of other limitations, is inconsistent with the patent’s own description.” PO Resp. 29.

In the Institution Decision, we declined to explicitly construe “athletic positioning” because we determined it was unnecessary in view of the claim language. Inst. Dec. 8. More particularly, we stated “independent claim 1 already appears to itself define the term ‘athletic positioning.’ In particular, the claim recites that the big toe area is at a lower position than the heel area and the small toe area.” *Id.*

Based on the full record, we maintain that it is unnecessary to explicitly construe “athletic positioning” because its meaning is already captured in the claim through the recitation of the relationship between the various slopes of the sole that provide “athletic positioning” of the foot. *See* Ex. 1001, 43:17–27, 43:30–40. The recitations setting forth a relationship between a “big toe area,” a “heel area,” and a “small toe area” translate into the relative heights proposed in Patent Owner’s construction. Patent Owner contends that the Board should adopt Patent Owner’s proposed construction because it:

incorporates the specification’s consistent descriptions of “athletic positioning” in terms of relative heights and slopes. For example, one embodiment of an “athletic positioning shape” is where “the heel platform may be 10 to 30 mm higher” than “the toe cup and/or the ball of foot cup.” [Ex. 1001], 13:49–51. Another embodiment discloses “an athletic positioning sole that includes an overall geometric shape” including “the heel of the sole [at] a particular height (e.g., h1, which may be 1’s to 10’s of mm) that slopes at an angle (e.g., Ø1) to the toe on the inside edge of the sole” which “may have a height of zero to a few millimeters.” *Id.*, 10:20–46.

PO Resp. 29. However, we find Patent Owner’s contention regarding particular heights and specific angles attempts to import limitations from the

Specification into claims. *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim.”).

Based on the full record, we determine that express claim construction of “athletic positioning” is not necessary to resolve the present dispute. See *Realtime Data, 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))).

2. Other Terms

Based on the full record, express construction of other terms is not necessary to determine whether Petitioner shows a reasonable likelihood of prevailing. *Realtime Data*, 912 F.3d at 1375.

D. Obviousness Over Kim (Ground 1: Claims 1–3, 6–8, and 11)

Petitioner contends that claims 1–3, 6–8, and 11 would have been obvious over Kim. Pet. 15–28. Petitioner also relies on the testimony of Mr. Delgatty to support its arguments. *Id.* (citing Ex. 1002). Patent Owner responds to Petitioner’s assertions. See PO Resp. 30–40 (citing Ex. 2008); PO Sur-reply 8–16.

We address Petitioner’s contentions and Patent Owner’s arguments below, beginning with a brief overview of Kim. We then address the evidence and arguments related to secondary considerations.

1. Kim (Ex. 1005)

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. Figure 2 depicts an exploded perspective view of the outsole of the golf shoe according to Kim's invention:

FIG. 2

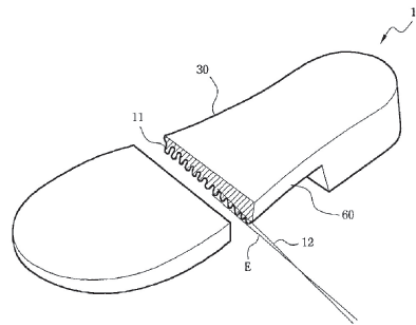


Figure 2 depicts a perspective view of the outsole of a golf shoe. *Id.* ¶ 19.

Kim discloses that

The outsole 10 includes a lower surface 12 inclined from its outer edge 60 to its inner edge 30 so that the outer edge 60 has a thickness larger than that of the inner edge 30. Except 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.

Id. ¶ 27.

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. Ex. 1005 ¶¶ 14–15.

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

FIG. 3b

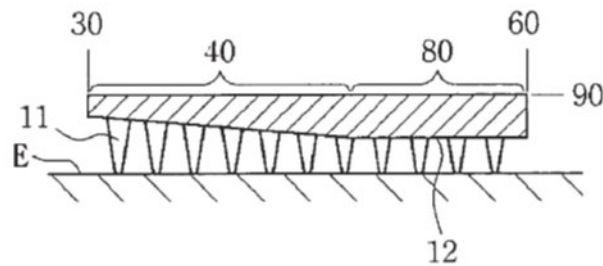


Figure 3b depicts a cross-section of an outsole of a golf shoe. *Id.* ¶ 21. The height of spikes 11 at inner edge 30 of the sole is shown larger than that of spikes 11 at outer edge 60 of the sole, while the thickness of the sole is thinner at inner edge 30 than outer edge 60. *Id.* ¶ 36. Accordingly, 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. *Id.* ¶ 38. Figures 5a and 5b of Kim show these positions:

FIG. 5a

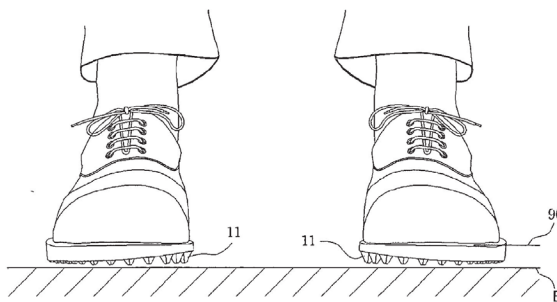


FIG. 5b

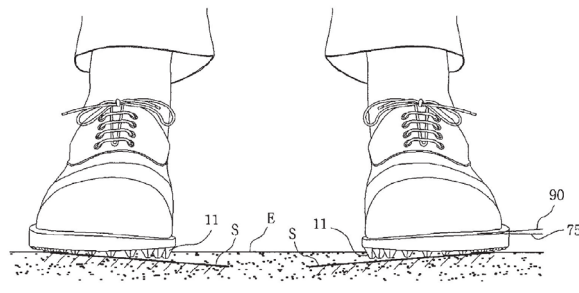


Figure 5a (left) illustrates the feet of a golfer in a pair of golf shoes standing on hard ground. *Id.* The lengths of the spikes on the ground ensure that the golfer's feet are parallel with the ground (despite the sloped sole). *Id.*

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. *Petitioner's Assertions for Claim 1*

a) [1.0] *"A pair of shoes comprises:"*

Petitioner asserts that, to the extent the preamble is limiting, "Kim discloses 'a pair of golf shoes' for 'assisting a golfer in taking a stable position during address and swing motions.'" Pet. 16 (citing Ex. 1005, Abstract, Fig. 5b; Ex. 1002, § IX.A.a).

b) [1.1] *"a left foot shoe including;"*

Petitioner asserts that Kim teaches or suggests "a left shoe." Pet. 16 (citing Ex. 1005, Fig. 5a, Abstract; Ex. 1002, § IX.A.b).

c) [1.2] *"a left upper shoe portion;"*

Petitioner asserts that Kim teaches "a golf shoe having an 'upper leather portion 20 for accommodating a golfer's foot.'" Pet. 17 (citing Ex. 1005 ¶¶ 27–28, Fig. 5b; Ex. 1002, § IX.A.c).

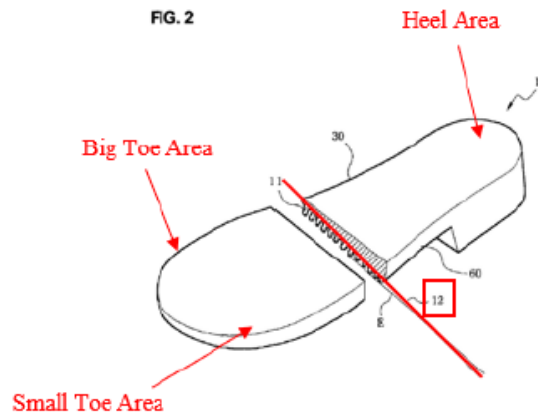
d) [1.3] *"a left sole coupled to the left upper shoe portion;"*

Petitioner asserts that "Kim discloses a pair of golf shoes, each having an 'outsole 10 attached to the lower surface of the upper leather portion.'" Pet. 17 (citing Ex. 1005 ¶¶ 14, 27, 28, Abstract, Figs. 1–3b; Ex. 1002, § IX.A.d).

e) [1.4] *"wherein a foot platform of the left sole provides an athletic positioning of a left big toe area of the left shoe at a*

lower position than a left heel area of the left shoe and at a lower position than an outer small toe area of the left shoe,”

Petitioner asserts that Kim teaches or suggests “a foot platform, including an outsole that includes a lower surface 12 that is inclined between its outer and inner edge.” Pet. 17–18 (citing Ex. 1002, § IX.A.e). Petitioner provides the following copy of Figure 2 of Kim, and annotated to identify, a “small toe area,” a “big toe area,” and a “heel area.” *Id.* at 18 (citing Ex. 1005, Fig. 2).



Annotated Figure 2 illustrates a perspective view of the outsole of Kim’s golf shoe. Ex. 1005 ¶ 19, Fig. 2. According to Petitioner, the claimed relationship between the “big toe area,” “heel area,” and “small toe area” “is accomplished by the outer edge having a larger thickness than the inner edge, as shown” above in Kim’s Figure 2. Pet. 18 (citing Ex. 1005 ¶¶ 15, 27, 36; Ex. 1002, § IX.A.e).

Petitioner asserts that “Kim also discloses an alternate embodiment shown in Figures 3a and 3b that includes an outsole that is thicker at its outer edge than its inner edge in addition to spikes that become longer at the outer edge.” Pet. 20 (citing Ex. 1005 ¶ 41). Petitioner reproduces Figures 3a and 3b.

FIG. 3a

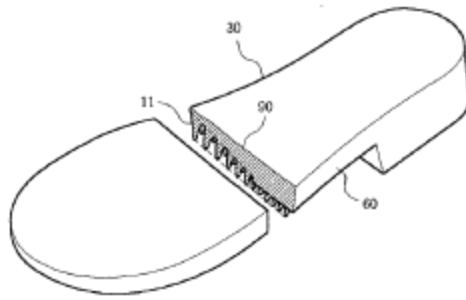


FIG. 3b

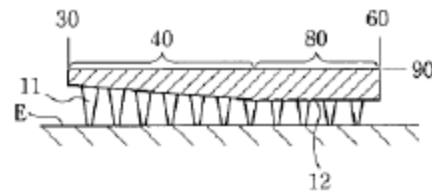
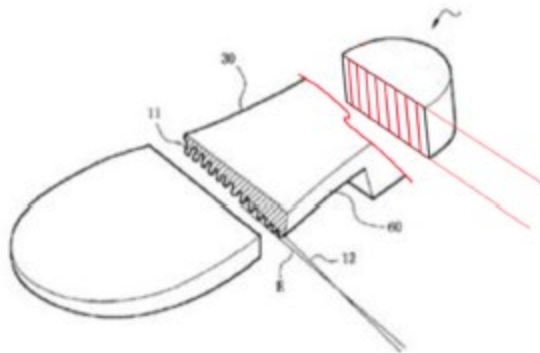


Figure 3a illustrates another perspective view of the outsole of Kim's golf shoe according to another embodiment. Ex. 1005 ¶ 20, Fig. 3a. Figure 3b illustrates a cross-sectional view of the outsole of Kim's golf shoe according to another embodiment. *Id.* ¶ 21, Fig. 3b. Petitioner identifies that “the heel area is also elevated as compared to the front inner edge of the outsole” (Pet. 20 (citing Ex. 1005 ¶ 41, Figs. 2, 3a)), and as such, argues that, “in each embodiment, Kim discloses a sole that places the front inner edge, or big toe area, at a lower position than both the front outer edge (small toe area), and the heel area” (*id.* (citing Ex. 1002, § IX.A.e)).

f) [1.5] “wherein, from an inner edge to an outer edge of the left shoe, the left heel area has substantially no slope,”

Petitioner asserts that Kim teaches or suggests “that the heel area has substantially no slope from the inner edge to the outer edge.” Pet. 20 (citing Ex. 1005, Figs. 2, 3a; Ex. 1002 § IX.A.f). Petitioner provides the following copy of Figure 2 of Kim, modified and annotated to identify, a heel area with a uniform height. *Id.* at 21 (citing Ex. 1005, Fig. 2).

FIG. 2

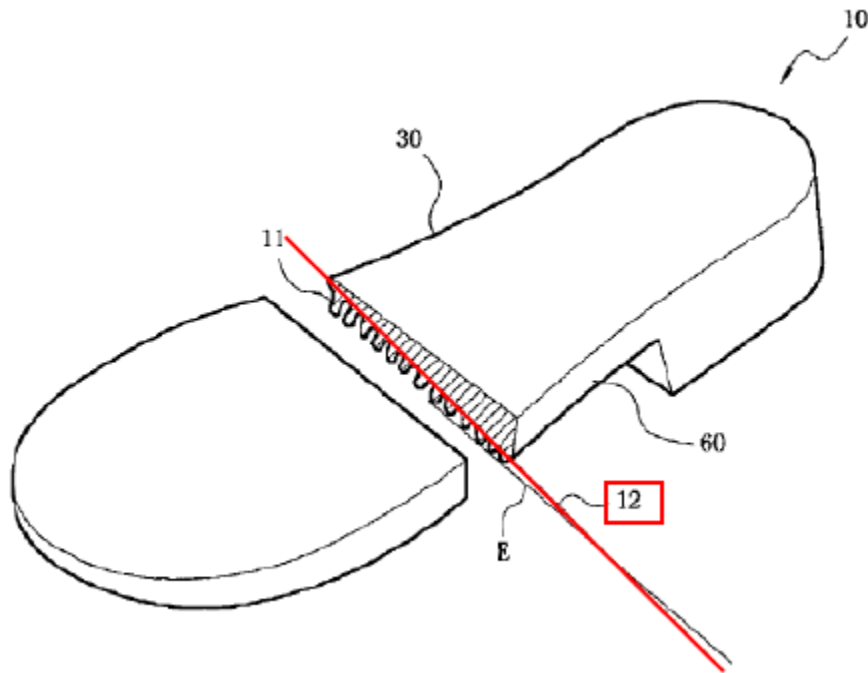


Modified Figure 2 illustrates a perspective view of the outsole of Kim’s golf shoe. Ex. 1005 ¶ 19, Fig. 2. Petitioner asserts that Kim discloses “that ‘the inclined plane may be formed only at the front portion of the outsole.’” Pet. 21 (citing Ex. 1005 ¶ 46; Ex. 1002 ¶ 61). Petitioner identifies that Kim teaches that its golf shoe “is substantially the same as *conventional* golf shoes,” “[e]xcept for the outsole including the inclined lower surface.” *Id.* (citing Ex. 1005 ¶ 27) (alteration in original). And, relying on the Declaration testimony of Mr. Delgatty, Petitioner contends that one of ordinary skill in the art “would have known that conventional athletic shoes, including golf, basketball, running and skateboard shoes included heel areas with substantially no slope from the inner edge to the outer edge.” *Id.* (citing Ex. 1002 ¶¶ 49–54, 62–63).

g) [1.6] “and wherein, from the inner edge to the outer edge of the left shoe at a cross section at a ball of [foot], a bottom of the left sole is substantially linear; and”

Petitioner asserts that Kim teaches or suggests “that the bottom of the outsole in Figure 2 is substantially linear from the inner edge to the outer edge ‘at a cross section at a ball of [foot].’” Pet. 21 (citing Ex. 1002 § IX.A.g) (alteration in original). Petitioner provides the following copy of

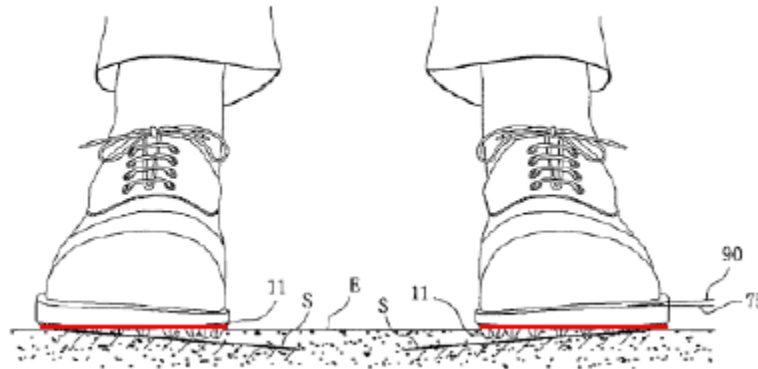
Figure 2 of Kim, annotated to identify, lower surface 12. *Id.* at 22 (citing Ex. 1005, Fig. 2).



Annotated Figure 2 illustrates a perspective view of the outsole of Kim’s golf shoe. Ex. 1005 ¶ 19, Fig. 2. According to Petitioner, one of ordinary skill in the art “would understand that outsole 10 has a linear bottom surface from the inner edge to the outer edge at the ball of the foot, as indicated by line 12.” Pet. 22 (citing Ex. 1002 ¶ 64).

Petitioner provides the following copy of Figure 5b of Kim, annotated to identify, a golfer’s feet being parallel with ground E. Pet. 22–23 (citing Ex. 1005, Fig. 2).

FIG. 5b



Annotated Figure 5b illustrates the feet of a golfer in a pair of golf shoes standing on a green with their feet sloped inward. Ex. 1005 ¶ 36, Fig. 5b. Petitioner asserts that Kim discloses “the reference numeral 90 denotes a line representing the level of the golfer’s feet being parallel with the ground E, and the reference numeral 75 denotes a line being parallel with a line (S) representing the level of the bottoms of the spikes 11.” Pet. 22–23 (citing Ex. 1005 ¶ 39; Ex. 1002 § IX.A.g). Petitioner adds that Kim discloses “an otherwise ‘conventional golf shoe’” (*id.* at 23 (citing Ex. 1005 ¶ 27)), and as such, one of ordinary skill in the art “would have known that conventional athletic shoes, including golf, basketball, running and skateboard shoes, have sole bottoms that are substantially linear at the balls of the feet” (*id.* (citing Ex. 1002 ¶¶ 55–59, 65)).

h) Remaining limitations of claim 1 directed to “a right foot shoe”

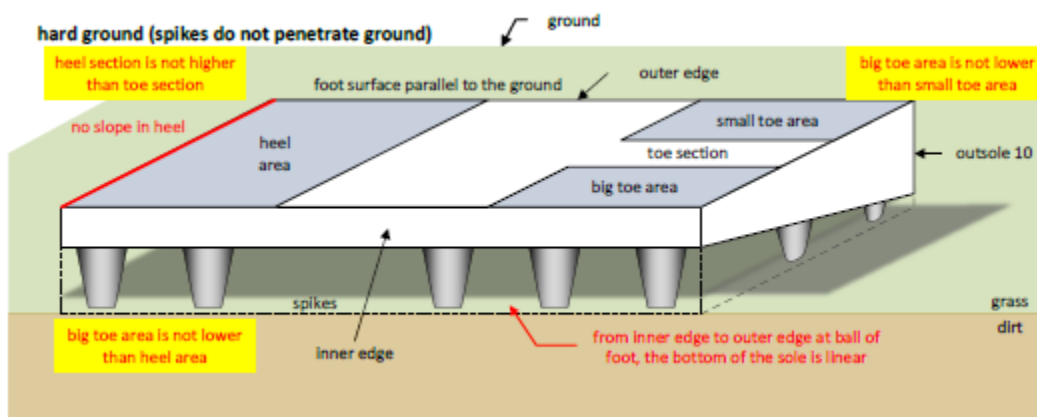
With respect to the “right shoe” limitations [1.7]–[1.12], Petitioner relies on its assertions for the substantially similar “left shoe” limitations [1.1]–[1.6]. Pet. 23–24 (citing Ex. 1002 ¶¶ 66–71).

3. Patent Owner's Contentions for Claim 1

Patent Owner contends that Petitioner's ground of unpatentability based on Kim is deficient. PO Resp. 30–40; PO Sur-reply 8–16. Patent Owner argues that the Petition fails to show that Kim discloses or renders obvious “a foot platform that provides an athletic positioning of a big toe area at a lower position than a heel area.” PO Resp. 31. In addition, Patent Owner argues that “Kim does not disclose or render obvious a toe section lower than a heel platform section.” *Id.* We address Patent Owner's arguments in greater detail below.

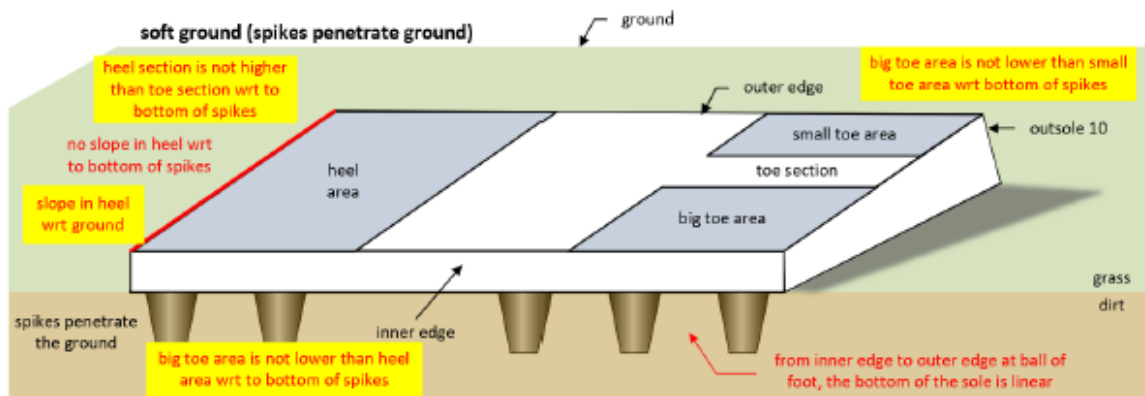
4. Analysis of Claim 1

Patent Owner argues that Kim fails to teach or suggest “a foot platform that provides an athletic positioning of a big toe at a lower position than a heel area,” as called for by claim 1, because Kim “makes clear that the upper surface of the outsole is flat, from front to back and side to side.” PO Resp. 31–33 (citing Ex. 1005 ¶¶ 14, 15, 33, 39, Figs. 3b, 4a–4c, 5a, 5b; Ex. 2008 ¶¶ 99–106, 180–184), 38–40 (citing Ex. 2008 ¶¶ 110, 112, 180, 187); PO Sur-reply 8–10. To support its argument, Patent Owner provides the following diagram illustrating Kim's shoe on hard ground (PO Resp. 34 (citing Ex. 2008 ¶ 180)):



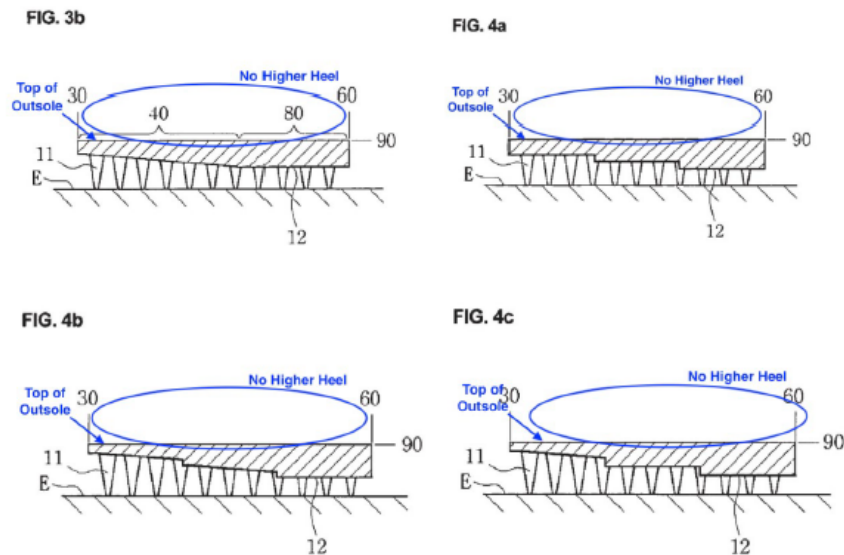
According to Patent Owner, this diagram represents Kim's shoe on hard ground, and demonstrates that the big toe area is at the same position as the heel area. *Id.* Thus, Patent Owner contends that "[b]ecause the big toe area is at the same height relative to the bottom of the shoe as the heel area, in Kim's hard ground arrangement, Kim does not teach or suggest a big toe area at a lower position than the heel area." *Id.* at 35 (citing Ex. 2008 ¶ 186).

Patent Owner argues that Kim's "soft ground" arrangement (PO Resp. 13–15 (citing Ex. 1005, Fig. 5b)) also fails to teach or suggest the claimed arrangement (*id.* at 35–36 (citing Ex. 2008 ¶ 187–190)). To support its argument, Patent Owner provides the following diagram illustrating Kim's shoe on soft ground (*id.* at 35 (citing Ex. 2008 ¶ 187)):



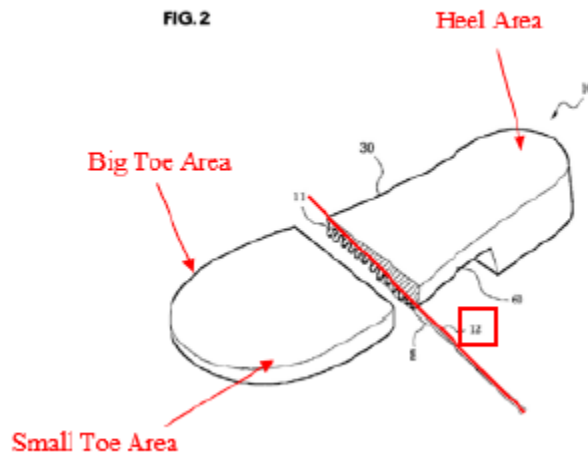
According to Patent Owner, this diagram represents Kim's shoe on soft ground, and illustrates that "the heel section is still at the same position as the toe section at all points along a line running parallel to the inner or outer edge." *Id.* at 36 (citing Ex. 2008 ¶ 189). Thus, Patent Owner argues that Kim's "soft ground" arrangement also fails to teach or suggest "a big toe area at a lower position than a heel area, as required by claim 1." *Id.* (citing Ex. 2008 ¶¶ 187–190).

In addition, Patent Owner argues that its position is further supported by the cross-sectional pictures depicted in Figures 3b and 4a–4c of Kim. PO Resp. 32–33. Patent Owner provides the following reproduction of Kim’s Figures 3b and 4a–4c side-by-side. *Id.* at 33 (citing Ex. 1005, Figs. 3b, 4a, 4b, 4c).



Figures 3b and 4a–4c depict cross-sectional views of the outsole of Kim’s golf shoe according to various embodiments. Ex. 1005 ¶¶ 20–22. According to Patent Owner, “[i]f the heel were to rise to a level above the toe section” in Figures 3b and 4a–4c “there would be some representation of the heel (likely a trapezoidal shape) above line 90 in each figure. But there is not.” PO Resp. 33. And, relying on the Declaration testimony of Mr. Markison, Patent Owner argues that one of ordinary skill in the art “would understand from Kim’s disclosures and its cross sectional figures that the outsole is parallel to the ground from front to back, i.e., the same height at all points on a line running from the front to the back of the shoe.” *Id.* (citing Ex. 2008 ¶¶ 99–106, 180–184). We disagree with Patent Owner.

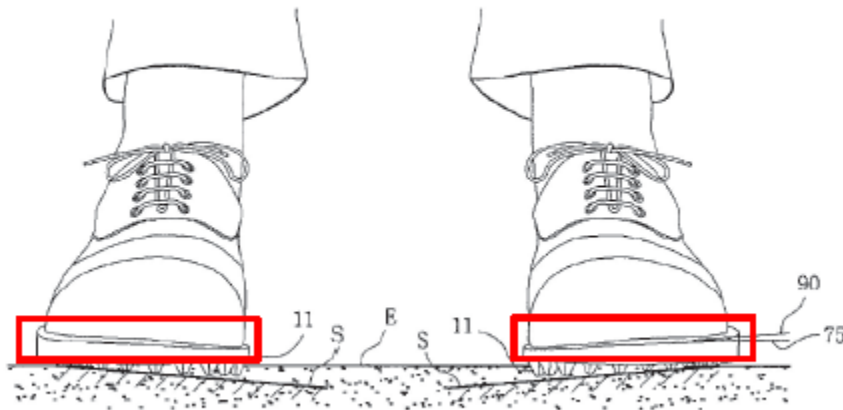
Instead, we agree with Petitioner that Patent Owner’s “hard ground” and “soft surface” diagrams misrepresent “Kim’s heel section being at the same level as the toe section . . . and having an identical thickness and inclined surface as the forefoot section.” Pet. Reply 8. Petitioner provides the following copy of Figure 2 of Kim, annotated to identify, a small toe area, big toe area, and heel area. *Id.* at 6 (citing Pet. 18; Ex. 1005, Fig. 2).



Annotated Figure 2 illustrates a perspective view of the outsole of Kim's golf shoe. Ex. 1005 ¶ 19, Fig. 2. With reference to Annotated Figure 2, Petitioner asserts, and we agree, that one of ordinary skill in the art would not reasonably interpret the outsole shown in Figure 2 of Kim to support Patent Owner's position that "the big toe position is the same as the position of the heel area is the same in all embodiments of Kim." Pet. Reply 5 (citing PO Resp. 31).

Petitioner also provides the following copy of Figure 5b of Kim, annotated to identify, a portion of the sole of Kim's golf shoes. Pet. Reply 6 (citing Ex. 1005, Fig. 5b).

FIG. 5b



Annotated Figure 5b illustrates a schematic view of Kim's golf shoes on soft ground. Ex. 1005 ¶ 24, Fig. 5b. Relying on the Declaration testimony of Mr. Delgatty, Petitioner argues that Figure 5b “shows the top of a surface area on the part of the sole that sticks out beyond the upper, suggesting the shoes are tilted forward.” Pet. Reply 13 (citing Ex. 1022 ¶ 10; Ex. 2010, 80:14–81:22).

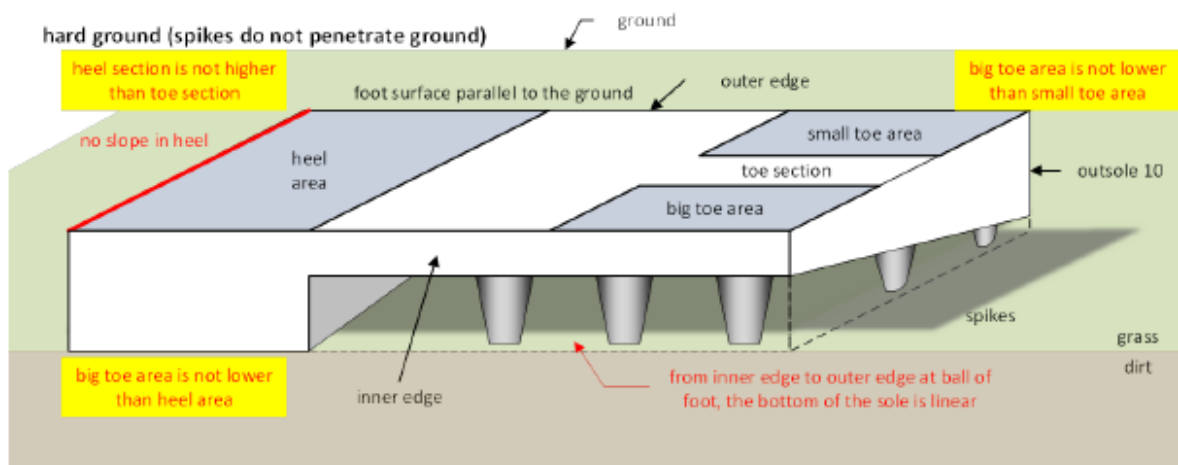
We find the record supports Petitioner's assertion that one of ordinary skill in the art at the time of the invention would have appreciated that Kim teaches or suggests “a sole that places the front inner edge, or big toe area, at a lower position than both the front outer edge (small toe area), and the heel area.” Pet. 20 (citing Ex. 1002, § IX.A.e). We also find Mr. Delgatty's Declaration testimony to be supported by Kim's disclosure. In this regard, Kim discloses that “‘the inclined plane may be formed only at the front portion of the outsole,’ and that ‘[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.’” Pet. Reply 8 (citing Ex. 1022 ¶ 10; Ex. 1005 ¶¶ 27, 46). In this regard, we find Mr. Delgatty's testimony together with Kim's disclosure outweighs Patent Owner's

suggestion that Kim’s cross-sectional figures support its position. *See* PO Resp. 32–33. Therefore, we are not persuaded that Kim fails to teach or suggest the argued limitation “[b]ecause big toe position is the same as the position of the heel area is the same in all embodiments of Kim.” *Id.* at 31.

Additionally, with respect to what Patent Owner characterizes as Petitioner’s “what if” embodiments, Patent Owner asserts that

Petitioner’s expert incorrect[s] interpreting Kim’s suggestion (in a single paragraph at the end of the specification) that the incline plane can be formed only at the front portion of the outsole (EX1005 46) to mean that Kim could show a shoe with a heel higher than the toe or a heel without the spikes that are disclosed throughout Kim as extending through the heel.

PO Resp. 36–37 (citing Ex. 2008 ¶¶ 195–200); *see also* PO Sur-reply 10–11 (arguing same). Patent Owner argues that, relying on this paragraph, Mr. Delgatty suggests that “Kim discloses a sole with no different length spikes and no corresponding slope in the heel at all. [Ex. 2008 ¶¶ 116–121, 182–194 (citing Ex. 1005 ¶ 46)]. Even if this were true (which it is not), such a modified version of Kim would still not render claim 1 obvious.” PO Resp. 37 (citing Ex. 2008 ¶ 192). To support its position, Patent Owner provides the following diagram illustrating Kim’s shoe on hard ground without spikes in the heel (*id.* (citing Ex. 2008 ¶¶ 192–194)):

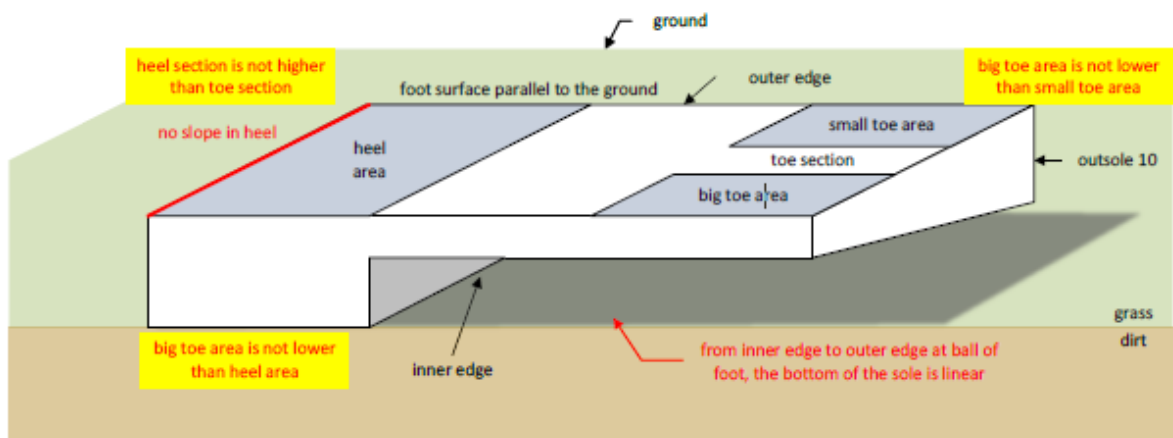


According to Patent Owner, this diagram represents Kim's shoe on hard ground without different length spikes and no corresponding slope in the heel. *Id.* Patent Owner argues that

a version of Kim without different length spikes and no corresponding slope in the heel would still have the same height at the heel area as at the big toe and small toe areas—that is, it would still not disclose a big toe area at a lower position than a heel area or at a lower position than a small toe area.

Id. at 37–38 (citing Ex. 2008 ¶¶ 192–194).

Patent Owner provides another diagram illustrating Kim's shoe on hard ground without spikes in the heel or the forefoot (PO Resp. 38 (citing Ex. 2008 ¶ 195)):



According to Patent Owner, the diagram above represents Kim's shoe on hard ground without spikes in either the heel or the forefoot. *Id.* Relying on the Declaration testimony of Mr. Markison, Patent Owner argues that this embodiment also fails to "disclose a big toe area lower than a heel area either (on either hard or soft surface), and in any event would not make any sense to a POSITA." *Id.* (citing Ex. 2008 ¶¶ 196–200). Thus, Patent Owner concludes that Kim fails to disclose or suggest that argued limitation because "Kim discloses an entire sole at a single height parallel to the bottom surface

of the shoes, which is true regardless of a hard or soft surface.” *Id.* at 39 (citing Ex. 2008 ¶¶ 110, 112, 180, 187).

Petitioner responds arguing that Patent Owner’s “what if” diagrams still fail to rebut Petitioner’s showing of obviousness because they “misrepresents Kim’s disclosure that the heel section is higher than the toe section,” are on hard ground, and as such, “ignore[] that the spikes would enter soft ground when worn, causing the big toe area be lower than the heel area and the small toe area.” Pet. Reply 8–10 (citing Ex. 1022 ¶¶ 15–16). Relying on the Declaration testimony of Mr. Delgatty, Petitioner argues that one of ordinary skill in the art would “understand that, when worn, the toe area would be on the ground, and thus lower than the heel, and based on the sloped forefoot, the big toe would be lower than the small toe.” *Id.* at 10 (citing Ex. 1022 ¶ 16). Petitioner notes that “[c]laim 1 requires that the forefoot platform of the sole provide the big toe area at a lower position than the heel area and the small toe area,” and argues that one of ordinary skill in the art “would recognize that the ‘sole’ of the shoe does not include the spikes and that the claimed heel and toes positions should be measured relative to one another when the shoe is being used as intended, i.e. when golfing on soft ground.” *Id.* at 12 (citing Ex. 1022 ¶ 20).

Patent Owner replies arguing that “Petitioner’s construction is illogical as it requires shoes being used only on soft ground and manipulated to certain angles that are nowhere in the claims.” PO Sur-reply 12. Patent Owner appears to acknowledge that “cleats are separate components from the sole,” but argues that

claim 6 makes clear that the foot platform can include a specific bottom such as cleats. And the patent claims an “athletic positioning apparatus” with a particular foot positioning. EX1001, Title. The purpose of the invention is to put an athlete

into a better athletic position with a shoe that independently manipulates foot position to create the slopes and angles in the claims.

Id. at 14 (citing Ex. 2008 ¶¶ 58–59).

We have considered Petitioner’s arguments and evidence, and Patent Owner’s counterarguments and find, on the complete trial record, that Petitioner demonstrates, by a preponderance of the evidence, that Kim teaches or suggests “a foot platform that provides an athletic positioning of a big toe area at a lower position than a heel area,” as called for by claim 1.

In this regard, we credit Mr. Delgatty’s Declaration testimony that one of ordinary skill in the art “would understand that, when worn, the toe area would be on the ground, and thus lower than the heel, and based on the sloped forefoot, the big toe would be lower than the small toe.” Pet. Reply 10 (citing Ex. 1022 ¶ 16). We also credit Mr. Delgatty’s opinion that one of ordinary skill in the art would have understood “that the shape and orientation of the sole (i.e., the platform on which an athlete stands) in relation to the **ground** is what determines if the foot is placed in an athletic position when in use.” *Id.* at 14 (citing Ex. 1022 ¶ 23).

We find Mr. Delgatty’s opinion to be reasonable and supported by Kim’s disclosure. *See, e.g.*, Ex. 1005 ¶¶ 37, 43, 44. Here, as Petitioner points out, “the ’760 patent distinguishes between the ‘sole’ and ‘cleats’ as separate components of the shoe” (Pet. Reply 12 (citing Ex. 1001, 1:62–64)), and claim 1 only “requires that the forefoot platform of the sole provide the big toe area at a lower position than the heel area and the small toe area” (*id.* (citing Ex. 1022 ¶ 20)). When asked during deposition, Mr. Markison confirmed that “cleats” or “sport-specific bottom 190” may be “different item[s] in the shoe than the athletic-positioning sole.” Ex. 1023, 85:18–22.

And, while claim 6 recites that “[t]he pair of shoes of claim 1” requires “a specific bottom,” it is not limited to a spike or cleat pattern, but also recites that it may be a “sport specific tread pattern.” Ex. 1001, 44:13–19. Based on the full record, we agree with Petitioner that “[w]hether or not a shoe has cleats, an athlete’s foot will be positioned the same with respect to the surface of the ground when in use, and thus obtain the same positioning benefits the ’760 patent purports to provide.” Pet. Reply 14 (citing Ex. 1022 ¶ 22).

Accordingly, upon review of the information in the Petition and corresponding evidence, and considering Patent Owner’s arguments, we find Petitioner has proven, by a preponderance of the evidence, on the complete trial record, that Kim teaches or suggests the subject matter of claim 1.

5. *Claim 1: Conclusion*⁶

For the foregoing reasons, we find Petitioner has demonstrated persuasively that Kim teaches or suggests all of the limitations of claim 1. We address *infra*, in Section II.D.7, the parties’ arguments and evidence pertaining to secondary considerations.

6. *Dependent Claims 2, 3, 6–8, and 11*

Claims 2, 3, 6–8, and 11 depend from claim 1. Ex. 1001, 43:41–44:56. Petitioner contends that the additional limitations of dependent claims 2, 3, 6–8, and 11 are rendered obvious by Kim. Pet. 24–28 (citing Ex. 1005). Petitioner also relies on the Declaration testimony of Mr. Delgatty to support its arguments. *Id.* (citing Ex. 1002).

⁶ For the sake of convenience, we have organized the Decision by addressing the claim limitations first and later addressing the secondary considerations. We note that our conclusions are in view of the entire record, including taking secondary considerations into account.

Patent Owner does not make any specific arguments regarding these claims. Instead, Patent Owner states simply that “[b]ecause independent claim 1 is patentable over Kim, the more specific dependent claims are also patentable for the same reasons.” PO Resp. 40 (citing Ex. 2008 ¶ 202).

After our review of Petitioner’s assertions and the supporting evidence, we determine that Petitioner has shown by a preponderance of the evidence that Kim teaches or suggests the subject matter of claims 2, 3, 6–8, and 11.

*7. Alleged Objective Evidence of Nonobviousness
(Secondary Considerations)*

Patent Owner argues that Petitioner’s arguments for obviousness are outweighed in light of Patent Owner’s evidence of secondary considerations, such as long-felt need, skepticism by others, industry praise and unexpected results, and copying. PO Resp. 69–77 (citing Ex. 2008); PO Sur-reply 26–29. At the outset, Patent Owner argues that Mr. Delgatty admitted that he “did not perform any analysis of any of the secondary considerations.” PO Resp. 71 (citing Ex. 2010, 117:14–118:2, 120:17–121:22). Petitioner replies that Mr. Delgatty has considered Patent Owner’s objective indicia of nonobviousness and maintains that the claims are unpatentable. Pet. Reply 29 (citing Ex. 1022 ¶ 50). Patent Owner replies that Petitioner’s reply declaration is entitled to no weight because it parrots arguments in Petitioner’s Reply, and Mr. Delgatty “has no proffered expertise or personal knowledge in commercial success, golfer’s performance, or copying to render him an expert in these areas.” PO Sur-reply 27.

Based on the full record, we are satisfied that Petitioner’s declarant has adequately considered Patent Owner’s asserted objective indicia of nonobviousness that was presented for the first time in Patent Owner’s

Response and could not have been considered for the Petition. Ex. 1022 ¶ 50.

a) Nexus

Patent Owner argues that “the requisite nexus exists here, owing to the legally and factually sufficient connection between the evidence of non-obviousness and the patented invention.” PO Resp. 70. According to Patent Owner, “Mr. Markison has provided unrebutted evidence that [Patent Owner]’s products practice and are coextensive with the claims of the ’760 patent, entitling it to a presumption of nexus.” *Id.* (citing Ex. 2008 ¶ 285; Ex. 2014).

Petitioner does not present any arguments regarding nexus. *See* Pet. Reply.

Based on the full record, we determine that Patent Owner fails to show nexus between the claimed invention and the asserted objective indicia of nonobviousness. PO Resp. 69–77; PO Sur-reply 26–29. Other than asserting that “the requisite nexus exists here” (PO Resp. 70), and citing to the Declaration testimony of Mr. Markison (*id.* (citing Ex. 2008 ¶ 285)), Patent Owner’s response does not provide an analysis of Patent Owner’s product with respect to the claims of the ’760 patent, and thus does not demonstrate nexus. To the extent Patent Owner references Mr. Markison’s testimony, Mr. Markison’s testimony consists solely of the statement that Patent Owner “sells and markets golf and baseball shoes that embody the claims of the ’760 patent” with reference to an exhibit from district court litigation. *See* Ex. 2008 ¶ 285 (citing Ex. 2014). We find Patent Owner’s reliance on Mr. Markison’s testimony to be insufficient to establish a rebuttable presumption of nexus. Thus, Patent Owner is not entitled to a rebuttable presumption of nexus, because Patent Owner has not shown that

the asserted evidence is tied to a specific product that is the disclosed and claimed invention. *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019).

Patent Owner also does not provide any evidence that the asserted objective indicia of nonobviousness is the direct result of unique characteristics of the claimed invention. *Fox Factory*, 944 F.3d at 1373–75; PO Resp. 69–77; PO Sur-reply 26–29. At best, Patent Owner merely implies that they are the result of unique characteristics of the claimed shoe. For our analysis below, even if nexus were shown, we identify additional reasons why we would give little weight to the asserted objective indicia of nonobviousness.

b) Long-Felt Need

Patent Owner argues that Petitioner’s asserted references show “that there was a long-felt need for an athletic shoe that put an athlete in a better athletic position,” but the shoes of the asserted prior art “are not prevalent in the market,” thereby indicating that there is still a “need for putting the golfer into a better athletic position.” PO Resp. 71–72 (citing Ex. 2008 ¶¶ 286–287; Ex. 2010:123:8–124:6). Patent Owner, thus, argues that “there was a long-felt and [unmet need] until the ’760 Patent was filed.” *Id.* at 72.

Petitioner replies that Patent Owner “fails to show a persistent need recognized by a POSITA, why the cited prior art in the grounds above did not meet such a need, nor evidence of how the alleged invention did.” Pet. Reply 29 (citing Ex. 1022 ¶ 51). Patent Owner replies that none of the prior art was used in commercial products and failed to solve industry needs, thus demonstrating a long-felt need for the claimed invention. PO Sur-reply 27 (citing Ex. 2008 ¶¶ 286–287).

Based on the full record, we agree with Petitioner that Patent Owner fails to show a recognized persistent need, fails to explain why the cited prior art did not meet the need, and fails to show that the claimed invention met the need. Pet. Reply 29–30. We also determine that prior art shoes would have met Patent Owner’s alleged long-felt “need for putting athletes into a better athletic position.” *See, e.g.*, Ex. 1005 ¶ 12 (“[I]t is an object of the present invention to provide a pair of golf shoes, which assist a golfer in concentrating his/her proper weight balance on the inner edges of soles of feet during the address and swing motions, thus allowing the golfer to perform the swing motion while maintaining his/her stable position.”). Thus, even if nexus were shown, we would give little or no weight to Patent Owner’s evidence of long-felt need.

c) Skepticism by Others

Patent Owner contends that it “introduced a baseball shoe in 2015 that embodied the invention of the ’760 Patent, and was met with limited success” because “the industry did not believe that the shoes would improve athletic positioning.” PO Resp. 72 (citing Ex. 2008 ¶ 288). According to Patent Owner, this was because up until this time, “achieving a better athletic position was viewed primarily as a problem for the athlete to solve with their body.” *Id.* (citing Ex. 2008 ¶ 288).

Petitioner responds arguing that Patent Owner’s contention “relies entirely on the unsupported personal beliefs of Mr. Markison for why its baseball shoe was met with limited success in 2015.” Pet. Reply 30 (citing PO Resp. 72). Petitioner argues that Patent Owner “fails to demonstrate a skepticism by others regarding the patented invention.” *Id.* (citing Ex. 1022 ¶ 52).

Based on the full record, we agree with Petitioner that Patent Owner fails to show skepticism by others based on the uncorroborated Declaration testimony of Mr. Markison. Patent Owner asserts that a product embodying the '760 patent “was met with limited success” (PO Resp. 73 (citing Ex. 2008 ¶ 288)), but neither Patent Owner nor Mr. Markison establishes that this “limited support” was due to the claimed features of the '760 patent, as opposed to economic or commercial factors.

Thus, even if nexus were shown, there is insufficient evidence to establish skepticism by others.

d) Industry Praise and Unexpected Results

Patent Owner asserts that in 2018, it “released the EnVe golf shoe, which embodied the invention of the '760 Patent.” PO Resp. 73 (citing Ex. 2008 ¶ 289). Patent Owner argues that its “golf shoes were praised by people in the industry, including by Bernhard Langer and professional World Long Drive (WLD) athletes.” *Id.* (citing Ex. 2013 (article titled, “Athalonz Golf Shoes: The Golf Shoe for Distance?”)). According to Patent Owner, at a competition in the summer of 2018, a golf pro named Mitch McDowell was wearing “a prototype of the EnVe golf shoes, which embodied the '760 Patent’s invention,” and

[a]nother golfer, Ryan Steenberg, who was at the event, asked Mr. McDowell if he could try [Patent Owner’s] golf shoes, and Mr. McDowell agreed to let him try them. At the time, Mr. Steenberg had been competing in WLD for 8 years, was ranked number 6 in the world, but had never won an event. Mr. Steenberg got his first WLD win while wearing [Patent Owner’s] shoes. Mr. Steenberg won the next event, as well, again while wearing [Patent Owner’s] shoes. When other players asked him what he had changed, he responded that it was his shoes.

Id. at 73 (citing Ex. 2008 ¶¶ 290–292).

Petitioner replies that Patent Owner’s “evidence of alleged industry praise and unexpected results is unreliable,” and based “on hearsay statements that Mitch McDowell and Ryan Steenberg allegedly made to one another, with no supporting evidence for their truthfulness or accuracy.” Pet. Reply 30. In addition, Petitioner asserts that “Mr. Markison admitted that the article on which [Patent Owner] relies purporting to praise [Patent Owner]’s shoes was written as a result of [Patent Owner]’s marketing department’s solicitation for reviews.” *Id.* at 31 (citing Ex. 1023, 217:20–219:1; Ex. 1022 ¶ 53; Ex. 2013).

Based on the full record, we are not persuaded that Patent Owner establishes the requisite showing that the alleged industry praise has a nexus to the claimed invention. Patent Owner does not identify whether the praise in Exhibit 2013 is due to specific features that are present in the claims or due to unclaimed features. For example, Exhibit 2013 identifies that benefits come from using “EnVe technology paired with their Grip & Glide Technology.” Ex. 2013, 3. Industry praise that is general or directed towards unclaimed features, or that is simply a result of pre-existing market share, will not carry significant weight in demonstrating non-obviousness.

We note that Mr. Markison’s testimony concerning statements made between Mitch McDowell and Ryan Steenberg at a competition in the summer of 2018 is unsubstantiated, and therefore entitled to little weight. Moreover, it is unclear as to whether the industry praise was directed to claimed features.

We also are not persuaded that Patent Owner establishes a difference between its alleged “unexpected results” and the closest prior art. “To be particularly probative, evidence of unexpected results must establish that there is a difference between the results obtained and those of the closest

prior art, and that the difference would not have been expected by one of ordinary skill in the art at the time of the invention.” *Bristol-Meyers Squibb Co. v. Teva Pharms. USA, Inc.*, 752 F.3d 967, 977 (Fed. Cir. 2014). Also, “[w]hen assessing unexpected properties, . . . we must evaluate the significance and ‘kind’ of expected results along with the unexpected results.” *Id.* Here, we find the record establishes that the results alleged by Patent Owner as unexpected, were in fact, expected and known results in the art. *See, e.g.*, Ex. 1005 ¶ 44 (explaining that Kim’s golf shoes allow a “golfer to correctly hit (impact) a golf ball and to strengthen his/her force imposed on the swing motion, and prevents the soles of the golfer’s feet from being pushed toward the outer edges of the outsoles of the golf shoes.”).

Thus, even if nexus were shown, we would give little weight to Patent Owner’s evidence of “industry praise” or “unexpected results.”

e) Copying

Patent Owner argues that it met with personnel from Petitioner and gave a presentation about the patent. PO Resp. 74–77 (citing Ex. 2008 ¶¶ 296–303; Ex. 2012 (Presentation Titled “Athletic Positioning Shoe: Presentation to Under Armour, August 22, 2013”), 13, 54). According to Patent Owner, it offered Petitioner an opportunity to acquire or license the technology, and Petitioner received physical samples for testing. *Id.* at 76 (citing Ex. 2012, 47–49; Ex. 2008 ¶ 300). Also, according to Patent Owner, Petitioner stopped responding and released a product that copied the athletic positioning claimed by the ’760 patent. *Id.* (citing Ex. 2008 ¶ 302; Ex. 1009).

Petitioner replies that Patent Owner fails to provide any analysis of Petitioner’s products, any evidence that Petitioner’s product practices the

claims, and any evidence that Petitioner's products are similar to Patent Owner's products. Pet. Reply 31–32 (citing Ex. 1022 ¶ 54; Ex. 1023, 220:3–223:12). Patent Owner replies that infringement contentions provide analysis of Petitioner's products, there is no requirement for direct evidence of copying, and there is ample evidence that Petitioner had access to Patent Owner's "patents and products and the infringing products are substantially similar." PO Sur-reply 28–29 (citing Ex. 2008 ¶¶ 296–303; Ex. 2012; Ex. 1031 ¶¶ 33–89; Ex. 1025; Ex. 1036).

There is no dispute that a presentation was given, and subsequently Petitioner produced a shoe that has been accused of infringement. PO Resp. 74–77; Pet. Reply 31–32. Evidence of copying is more persuasive of nonobviousness when it shows that the other manufacturer has expended great effort to develop its own solution. The full record does not include such evidence. And, even if this were probative evidence of similarity, "[n]ot every competing product that arguably falls within the scope of a patent is evidence of copying" because "[o]therwise every infringement suit would automatically confirm the nonobviousness of the patent." *Iron Grip Barbell Co. v. USA Sports Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004).

Thus, even if nexus were shown, we would give little weight to Patent Owner's evidence of copying.

8. *Conclusion for Ground 1*

We have considered all of the arguments and evidence adduced at trial. For the reasons explained, we find Petitioner has persuasively demonstrated that Kim teaches or suggests all limitations of claims 1–3, 6–8, and 11. We also find that the value of Patent Owner's objective evidence of non-obviousness is weak in comparison to the evidence regarding the prior art under the first three *Graham* factors.

Accordingly, we find Petitioner has shown by a preponderance of the evidence that claims 1–3, 6–8, and 11 of the '760 patent would have been obvious over Kim.

*E. Obviousness Over Kim and De Obaldia
(Ground 4: Claims 4, 5, 9, and 10)*

Petitioner contends that claims 4, 5, 9, and 10 would have been obvious over Kim and De Obaldia. Pet. 49–54 (citing Exs. 1005, 1008). Petitioner also relies on the testimony of Mr. Delgatty to support its arguments. *Id.* (citing Ex. 1002).

With respect to claims 4 and 9, Petitioner asserts that Kim teaches or suggests the subject matter of claim 2 (*see* Pet. 51–52, 54), but does not disclose a “‘stabilizing cup’ in the big toe area that functions to ‘at least one of, stabilize and position’” the big toe in a particular location.” *Id.* at 51. To address this feature, Petitioner relies on De Obaldia. *Id.* (citing Ex. 1002 ¶ 119). More particularly, Petitioner asserts that “De Obaldia discloses an article of footwear that includes a molded body member 2, a molded foot support member 4, which supports the wearer’s foot, and a flexible harness 6.” *Id.* at 52 (citing Ex. 1008, 2:23–44, Abstract). According to Petitioner, the upper surface of De Obaldia’s “‘foot support member is configured to correspond to and provide anatomical support for the wearer’s foot. Preferably, this configuration includes at least one **toe recess 24**, [and] a recess 26 for accommodating a ball of the wearer’s foot.’” *Id.* (citing Ex. 1008, 2:63–68, claims 5, 13).

With respect to claim 5, Petitioner asserts that Kim teaches or suggests the subject matter of claim 2 (*see* Pet. 53–54), but does not disclose “a ‘stabilizing cup’ in the big toe area that functions to ‘at least one of, stabilize and position’ the ball of the foot in a particular location in the big

toe area.” *Id.* at 53. To address this feature, Petitioner relies on De Obaldia. *Id.* (citing Ex. 1002 ¶ 120). More particularly, Petitioner asserts that the upper surface of De Obaldia’s “‘foot support member is configured to correspond to and provide anatomical support for the wearer’s foot. Preferably, this configuration includes at least one toe recess 24, [and] **a recess 26 for accommodating a ball of the wearer’s foot.**’” *Id.* (citing Ex. 1008, 2:63–68, claims 5, 13) (alteration in original).

Relying on the Declaration testimony of Mr. Delgatty, Petitioner argues that “[i]t would have been obvious to incorporate recesses for the wearer’s toe(s) and balls of the feet, like that described in De Obaldia, into the pair of shoes disclosed in Kim.” Pet. 49–50 (citing Ex. 1002 ¶ 115). Petitioner asserts that doing so would have been would have been a predictable and provided several benefits such as the addition of recesses that would “provide increased anatomical support for the wearer’s foot.” *Id.* at 50 (citing Ex. 1008, 1:14–18, 2:63–68). Petitioner adds that Kim and De Obaldia are analogous art, and one of ordinary skill in the art “would have had a reasonable expectation of success in incorporating toe and/or ball-of-foot recesses, like those disclosed in De Obaldia into the pair of shoes disclosed in Kim.” *Id.* at 50–51 (citing Ex. 1002 ¶¶ 117–118).

Patent Owner does not make any specific arguments regarding Petitioner’s assertions for these claims. Instead, Patent Owner contends that Ground 4 is deficient because Petitioner does not argue or show that De Obaldia would be combined with Kim to resolve the issues identified for independent claim 1. PO Resp. 69 (citing Ex. 2008 ¶ 282).

After our review of Petitioner’s assertions and the supporting evidence, we determine that Petitioner has shown by a preponderance of the evidence that Kim and De Obaldia teaches or suggests the subject matter of

claims 4, 5, 9, and 10. We also determine that one of ordinary skill in the art would have combined Kim and De Obaldia in the manner asserted with a reasonable expectation of success. *See* Pet. 50–51 (citing Ex. 1002 ¶¶ 116–117). Accordingly, we find Petitioner has shown by a preponderance of the evidence that claims 4, 5, 9, and 10 would have been obvious over Kim and De Obaldia.

F. Remaining Challenges

As noted previously, Petitioner presents a number of other grounds of unpatentability of the challenged claims. *See, e.g.*, Pet. 2, 28–49, 54–59. However, as we have determined that claims 1–11 are unpatentable as obvious over Kim (Ground 1), and Kim and De Obaldia (Ground 4), it is unnecessary to address the additional grounds. *See* 35 U.S.C. § 318(a); *see also SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 371 (2018) (holding that a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (non-precedential) (recognizing that the “Board need not address issues that are not necessary to the resolution of the proceeding” and, thus, agreeing that the Board has “discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”).

Thus, there is no additional dispute to resolve between the parties regarding these claims, and we decline to separately address these additional asserted grounds of unpatentability.

III. PATENT OWNER’S MOTION TO EXCLUDE

Patent Owner filed a Motion to Exclude the Exhibits 1032–1034.

Mot. 1. Exhibits 1032 and 1033 are purported to be dictionary definitions of

the terms “cross section” and “perspective,” respectively. *Id.* at 2. Exhibit 1034 is purported to be a “‘compil[ation]’ of ‘the PGA tour’s official stats.’” *Id.* at 4 (alteration in original). Petitioner filed an Opposition (Opp.) and Patent Owner filed a Reply to the Opposition (Mot. Reply).

Our Decision does not rely on any of the challenged evidence, and we therefore dismiss Patent Owner's Motion to Exclude as moot.

IV. CONCLUSION⁷

In summary:

Claims	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–3, 6–8, 11	103(a)	Kim	1–3, 6–8, 11	
1–3, 6–8, 11	103(a)	Dufour ⁸		
1–3, 6–8, 11	103(a)	Rubin ⁹		
4, 5, 9, 10	103(a)	Kim, De Obaldia	4, 5, 9, 10	
4, 5, 9, 10	103(a)	Dufour, De Obaldia ¹⁰		
4, 5, 9, 10	103(a)	Rubin, De Obaldia ¹¹		
Overall Outcome			1–11	

⁷ Should Patent Owner wish to pursue amendment of the challenged claim in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

⁸ As explained in Section II.F, we do not reach this ground.

⁹ As explained in Section II.F, we do not reach this ground.

¹⁰ As explained in Section II.F, we do not reach this ground.

¹¹ As explained in Section II.F, we do not reach this ground.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–11 of U.S. Patent No. 11,064,760 B2 have been shown, by a preponderance of the evidence, to be unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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