UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

adidas AG
Petitioner

NIKE, Inc.
Patent Owner

Patent No. 7,347,011
Filing Date: March 3, 2004
Issue Date: March 25, 2008
Title: ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

Inter Partes Review No. 2012-000[illegible]

REVISED PETITION FOR INTER PARTES REVIEW
UNDER 35 U.S.C. §§ 311-31 AND 37 C.F.R. § 42.100 *ET SEQ.*

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EXHIBITS

Exhibit 1001: Declaration of Ed. and Dr. (Ned) Frederick, Ph.D. ("Frederick Dec.")

Exhibit 1002: U.S. Patent No. 7,647,711 to Dua et al. ("'711 patent")

Exhibit 1003: The '711 patent file history

Exhibit 1004: Form PTO SB42

Exhibit 1005: U.S. Patent No. 5,345,638 to Nishida ("Nishida")

Exhibit 1006: JP Pub. No. H01-133905 to Osamu ("Osamu"), including a certified English translation thereof

Exhibit 1007: U.S. Patent No. 2,147,197 to Gluckin ("Gluckin")

Exhibit 1008: U.S. Patent No. 2,514,088 to Dowley ("Dowley")

Exhibit 1009: U.S. Patent No. 2,641,024 to Whiting et al. ("Whiting")

Exhibit 1010: International App. Pub. No. WO 99/02744 to Cuney ("Cuney")

Exhibit 1011: U.S. Patent No. 3,765,558 to Shiomura ("Shiomura")

Exhibit 1012: Devid J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third ed., Woodhead Publishing, Ltd. 2001)

Exhibit 1013: Excerpt of Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth - Verlag GmbH 2002)

Through counsel, real party in interest adidas AG ("Petitioner") hereby petitions for *inter partes* review under 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42 of claims 1-40 of U.S. Patent No. 7,347,011 ("the '011 patent") and asserts there is a reasonable likelihood that it will prevail with respect to at least one of the claims challenged in this petition. The Office mailed a Notice of Filing Date Accorded to Petition on December 4, 2012 that identified a defect in the Petition and required correction within five (5) business days. Petitioner has revised the Petition responsive to the notice and the December 5, 2012 conference with Judge Tierney, and Petitioner hereby submits this revised, timely petition in response.

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(1)

A. Real Party-in-Interest under 37 C.F.R. § 42.8(b)(1)

Petitioner, adidas AG, is the real party-in-interest for the instant petition.

B. Related Matters under 37 C.F.R. § 42.8(b)(2)

No related matters are currently known to Petitioner.

C. Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)

Petitioner provides the following designation of counsel:

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D. Service Information

As identified in the attached Certificate of Service, a copy of the present petition is

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is entirely is being served to the address of the attorney or agent of record. Address AG may be served at the lead counsel address provided in Section (C) of this Petition.

E. Power of Attorney

A power of attorney is being filed with the designation of counsel in accordance with 37 C.F.R. § 42.10(b).

II. PAYMENT OF FEES: 37 C.F.R. § 42.103

This petition for *inter partes* review requests review of 40 claims of the '011 patent and is accompanied by a payment of $42,000, which includes $23,250 for 20 claims and an additional $15,600 for 26 claims in excess of 20 claims. See 37 C.F.R. § 42.15. Thus, this petition meets the fee requirements under 35 U.S.C. § 312(a)(1).

III. REQUIREMENTS FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.104

A. Grounds For Standing under 37 C.F.R. § 42.104(a)

Petitioner certifies that the '011 patent is eligible for *inter partes* review and further certifies that Petitioner is not barred or otherwise estopped from requesting *inter partes* review challenging the identified claims on the grounds identified within the present petition.

B. Identification of Challenge under 37 C.F.R. § 42.104(b) and Relief Requested

Petitioner requests *inter partes* review of claims 1-40 of the '011 patent on the grounds set forth in the table below and requests that each of the claims be found unpatentable. An explanation of how claims 1-40 are unpatentable under the statutory grounds identified below, including the identification of where each element is found in the

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prior art patents or publications and the relevance of the prior art reference is provided in the form of detailed claim charts. Additional explanation and support for each ground of rejection is set forth in the Declaration of Edward C. (Ned) Kaiser, Ph.D. (Ex. 1001).

Ground	'011 Patent Claims	Basis for Rejection
Ground 1	1-16, 19-34, 36, 39-46	Anticipated under § 102(b) by Nishida
Ground 2	1-16, 19-46	Obvious under § 103(a) in view of Nishida
Ground 3	1-7, 10-12, 14, 16-20, 32-33, 37	Obvious under § 103(a) by Nishida in view of McDonald
Ground 4	8-9, 13-21-23	Obvious under § 103(a) by Nishida in view of McDonald and Curley
Ground 5	8-9, 13, 21-23	Obvious under § 103(a) by Nishida in view of McDonald and Shiomura
Ground 6	9, 13, 22-23	Obvious under § 103(a) by Nishida in view of McDonald and Glidden
Ground 7	1-7, 10-12, 14-16, 19-20, 32-33, 44-46	Obvious under § 103(a) by Nishida in view of Whiting
Ground 8	8-9, 13, 21-23	Obvious under § 103(a) by Nishida in view of Whiting and Curley
Ground 9	8-9, 13, 21-23	Obvious under § 103(a) by Nishida in view of Whiting and Shiomura
Ground 10	9, 13, 17-18, 22-23	Obvious under § 103(a) by Nishida in view of Whiting and Glidden
Ground 11	17-18	Obvious under § 103(a) by Nishida in view of Whiting and McDonald
Ground 12	1-18, 19-23, 30-32, 34, 43-46	Obvious under § 103(a) by Nishida in view of Curley
Ground 13	8-9, 13, 21-23, 30-31, 34-35, 39-42	Obvious under § 103(a) by Nishida in view of Shiomura
Ground 14	9, 13-23, 30-31, 43	Obvious under § 103(a) by Nishida in view of Glidden
Ground 15	1-2, 7-14, 16-23	Anticipated under § 102(b) by Glidden
Ground 16	1-2, 7-14, 16-23	Obvious under § 103(a) by Glidden in view of McDonald
Ground 17	1-2, 7-14, 18-23	Obvious under § 103(a) by Glidden in view of Whiting
Ground 18	1-16, 19-46	Obvious under § 103(a) in view of Osamu

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Ground	011 atent C aims	asis for e ection
Ground 19	1-7, 9-10, 13-14, 16-20, 22-33, 36-37, 39-43	Obvious under § 103(a) by Osamu in view of McDonald
Ground 20	8, 21, 34	Obvious under § 103(a) by Osamu in view of McDonald and Curley
Ground 21	8, 21, 34-35, 38	Obvious under § 103(a) by Osamu in view of McDonald and Shiomura
Ground 22	11-12	Obvious under § 103(a) by Osamu in view of McDonald and Glidden
Ground 23	11-12, 34	Obvious under § 103(a) by Osamu in view of McDonald and Nishida
Ground 24	1-7, 9-10, 13-16, 19-20, 22-33, 39, 39-44, 46	Obvious under § 103(a) by Osamu in view of Whiting
Ground 25	8, 21, 34	Obvious under § 103(a) by Osamu in view of Whiting and Curley
Ground 26	8, 21, 34-35, 38	Obvious under § 103(a) by Osamu in view of Whiting and Shiomura
Ground 27	11-12, 17-18, 45	Obvious under § 103(a) by Osamu in view of Whiting and Glidden
Ground 28	11-12, 34-45	Obvious under § 103(a) by Osamu in view of Whiting and Nishida
Ground 29	1-7, 9-13, 16-19, 19-29, 22-33, 34, 36, 39-46	Obvious under § 103(a) by Osamu in view of Nishida
Ground 30	8, 21	Obvious under § 103(a) by Osamu in view of Nishida and Curley
Ground 31	8, 21, 35-38	Obvious under § 103(a) by Osamu in view of Nishida and Shiomura
Ground 32	17-18	Obvious under § 103(a) by Osamu in view of Nishida and Glidden
Ground 33	14, 17-18, 33, 37	Obvious under § 103(a) by Osamu in view of Nishida and McDonald
Ground 34	14, 17, 37	Obvious under § 103(a) by Osamu in view of Nishida and Whiting
Ground 35	1-7, 9-13, 16-20, 22-32, 36, 39-43	Obvious under § 103(a) by Osamu in view of Glidden
Ground 36	8, 21, 34	Obvious under § 103(a) by Osamu in view of Glidden and Curley
Ground 37	8, 21, 34-35, 38	Obvious under § 103(a) by Osamu in view of Glidden and Shiomura

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Ground	'011 Patent Claims	Basis for Rejection
Ground 38	1-10, 13, 16, 19-32, 34-36, 39-44, 46	Obvious under § 103(a) by Osamu in view of Curley
Ground 39	35, 36	Obvious under § 103(a) by Osamu in view of Curley and Shiomura

Each of the references relied upon in the grounds set forth above qualify as prior art under 35 U.S.C. § 102(b). Specifically, Nishida issued on September 13, 1994 and therefore qualifies as prior art under 35 U.S.C. § 102(b). Osamu published on April 28, 1994 and therefore qualifies as prior art under 35 U.S.C. § 102(b). Glidden issued on February 14, 1939 and therefore qualifies as prior art under 35 U.S.C. § 102(b). Millspaugh issued on March 16, 1943 and therefore qualifies as prior art under 35 U.S.C. § 102(b). Hiting issued on June 9, 1953 and therefore qualifies as prior art under 35 U.S.C. § 102(b). Curley published on April 19, 1990 and therefore qualifies as prior art under 35 U.S.C. § 102(b). Shiomura issued on November 22, 1988 and therefore qualifies as prior art under 35 U.S.C. § 102(b).

SUMMARY OF THE '011 PATENT

A. Brief Description

The '011 patent relates to an article of footwear having a textile upper. ('011 patent (Ex. 1002), 1:5-19). The '011 patent specifically teaches that the upper incorporates a textile element which may be formed with a "lifting mechanism." (*Id.*, 3:20-22).

B. Summary of the Prosecution History of the '011 Patent

The original patent application No. 10/791,269 ("the '269 application"), attached hereto as a part of Exhibit 1003, was filed on March 3, 2004 with claims 1-67. Original

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independent claims 1, 20, 28, 41, and 65 were directed to articles of footwear having an upper incorporating a textile element, and original independent claims 50 and 68 were directed to methods of manufacturing a footwear element. The PTO issued a restriction requirement requiring election of either the claims drawn to an article of footwear or the claims drawn to a method of knitting a footwear element. (Oral file history (Ex. 1004), 01/05/2006 Office Action, p. 2).

In response, applicants filed a reply to the restriction requirement electing to prosecute claims directed to an article of footwear, claims 1-49 and 65-67. (Oral file history (Ex. 1003), 01/19/2006 response, p. 1). The PTO then issued a first Office Action on the merits, rejecting all pending claims. (Oral file history (Ex. 1003), 09/12/2006 Office Action, pp. 2-4). Specifically, the Examiner rejected claims 1-11, 13, 14, 16-24, 26-35, 37-49, 65, and 67 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,668,172 to John ("John"). (*Id.*, pp. 2-3). Several of the independent claims, in addition to claiming structural elements of the footwear article, claimed the knitting method by which it was formed (e.g., "formed by weft knitting"). The Examiner noted that in reference to the specific method by which the upper is knitted, "such phrases have been treated as product by process limitations; and does NOT serve to resolve the issue concerning patentability of the product." (*Id.*, p. 2). The Examiner further noted "that the numerous types of knitting are well known in the art and are noted in scope of the cited references." (*Id.*, pp. 2-3).

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The Examiner also rejected claims 1, 2, 7-11, 13-24, 26, 27, 41-43, 47-49, and 65-67 under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 5,308,438 to Thorneburg ("Thorneburg"). (*Id.* at p. 3). The Examiner reiterated the statements regarding product by process limitations and the known types of knitting. (*Id.*)

The Examiner further rejected claims 12, 25, and 38 under 35 U.S.C. § 103 as being unpatentable over Johanson in view of U.S. Patent No. 5,746,013 to Fay, Sr. ("Fay"). (*Id.*, p. 4).

The Examiner rejected claims 12 and 26 under 35 U.S.C. § 103 as being unpatentable over Thorneburg in view of Fay. (*Id.*).

In response to the Office Action, the Applicants submitted an amendment and response along with a petition for a one month extension of time. (See file history (Ex. 1003), 01/12/2007 response). In the response, Applicants cancelled original claims 7-10, 30, 47, and 50-64 and amended original claims 1, 2, 11-18, 20, 23-25, 27, 28, 31-33, 35, 43, 44, 46, and 65 to distinguish over the prior art of record. (*Id.* at p. 3-8).

In particular, with respect to the rejections of claims 1-28 and 41, Applicants amended the claims limiting the claimed footwear article to a single type of textile having a plurality of knit constructions, and further argued that neither Johanson nor Thorneburg discloses an upper incorporating a single type of textile having a plurality of constructions. (*Id.* at p. 8-10). With respect to amended claim 20, Applicants argued that neither Johanson nor Thorneburg teaches a weft knitted textile element having first and second areas, each having a different stitch configuration to impart varying properties to each area of the textile

element. (*Id.* p. 19). Applicants made similar arguments with respect to the claim rejections under 35 U.S.C. § 103. (*Id.* p. 11-12). Applicants however did not challenge or otherwise address the Examiner's comments regarding the unpatentability of claiming a specific method by which an upper is knitted, particularly since numerous types of knitting were well-known in the art.

With respect to the rejection of amended claim 59 based on Johe, Applicants argued that Johe did not disclose a first area having a first set of properties and a second area having a second set of properties different from the first set. (*Id.* p. 10). With respect to the rejection of amended claim 65 based on Thorneburg, Applicants argued that Thorneburg did not disclose an upper having two different areas with each area having a different construction. (*Id.*).

The Examiner then allowed claims 1-6, 11-29, 31-46, 48, 49 and 65-67 (renumbered as claims 1-48). (*See* file history (Ex. 1001), 11/02/2007 Notice of Allowance). The Examiner responded to the Applicants' amendment and response by moving directly to a rejection of the pending claims under 35 U.S.C. § 102 to allowance – because the missing elements addressed in the Applicants' response are taught by several of the references of record (*see* Nishida (Ex. 1005), Hoden (Ex. 1007)), it appears that the Examiner may not.

The Examiner had rejected dependent claims 12, 25, and 36 under 35 U.S.C. § 103, but Applicants reiterated the arguments made with respect to the independent claims as amended to overcome this rejection.

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have reconsidered the question of anticipation by Ghrist references of record or obviousness under 35 U.S.C. § 103 before deciding to allow the claims.

Applicants transmitted the issue fee payment on February 1, 2008, and the '011 patent issued on March 25, 2008. ('011 file history (Ex. 1003), 02/01/2008 Issue Fee Payment).

Applicants later filed a request for a Certificate of Correction alleging a PTO mistake in the printing of claims 2, 8, and 22. ('011 file history (Ex. 1003), 01/13/2009 Request for Certificate of Correction). A Certificate of Correction issued February 17, 2009. ('011 file history (Ex. 1003), 02/17/2009 Certificate of Correction).

CLAIM CONSTRUCTIONS UNDER 37 C.F.R. § 42.104(b)(3)

A. Legal Overview

A claim subject to *inter partes* review ("IPR") is given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b). This means that the words of the claim are given their plain meaning unless that meaning is inconsistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). This Petition shows that the claims of the '011 patent are anticipated or rendered obvious by the prior art identified herein when the challenged claims are given their broadest reasonable interpretation in light of the specification. Petitioner submits for the purposes of the IPR only that the claim terms are presumed to take on their broadest

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reasonable interpretation in view of the specification of the '011 patent."

Clarification of "A Single Type of Textile"

Claims 1, 24 and 36 recite that the textile element incorporates "a single type of textile." The '011 patent specification states that "textile element 40 is primarily formed from one or more yarns that are mechanically manipulated through either an interweaving, interknitting and twisting, or interlooping process." ('011 patent (ex. 1002), p. 6, ll. 24-26). The '011 patent specification further states "[a]textile element 40 is a single material element that is formed to exhibit a unitary, one-piece construction." (*Id.* p. 6, ll. 28-30; see also p. 11, ll. 12). As such, a broadest reasonable interpretation of "a single type of textile" is a single material element that may include one or more yarns.

C. Clarification of "Weft Knitted Textile Element" and "Flat Knitted Textile Element"

Claims 1, 4, 14-16, 19-21, 23, 32, and 33 recite that the textile element is "weft knitted" or has a "weft knitted configuration." Claim 24 recites that the textile element is "flat knitted." In the Office Action dated September 12, 2016 during prosecution of the '[illegible] such as [illegible] to have different standards of proof and claim interpretation that are not applied by the PTO for *inter partes* review. Accordingly, any interpretation or construction of the challenged claims in this IPR either implicitly or explicitly is not binding on Petitioner in any future litigation related to the '011 patent. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

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application that led to the '011 patent, the Examiner noted that numerous types of knitting recited in the claims (*e.g.*, weft knitted and flat knitted) were well known in the art. Thus, the Examiner did not deem particular claimed knitting techniques to distinguish the claimed invention from the prior art. The specification also explains that various knitting processes may be used to manufacture the textile element, including without limitation weft knitting, warp knitting, circular knitting, and flat knitting. (See, *e.g.*, '011 patent (Ex. 1002), 5:56-7:10, 11:4-7, 11:1-41). The specification describes tricot, raschel, and double needle bar raschel as specific sub-types of warp knitting. (*Id.*, 7:2-7). Similarly, circular knitting and flat knitting are described as sub-types of weft knitting. (*Id.*, 7:7-10). The specification states that the textile element that forms the shoe upper may be formed through any of these knitting processes and does not express a preference or advantage for any one process over the others. (*Id.*, 7:10-14). Thus, it is reasonable to interpret these claim limitations as consistent with their ordinary meaning and as conventional, known knitting techniques.

Clarification of "Unitary Construction"

Claim 16 recites that the textile element has a first area and a second area with a "unitary construction." Claim 44 originally recited the same language. The specification states, "As defined for purposes of the present invention, unitary construction is intended to express a configuration wherein portions of a textile element are not joined together by seams or other connections, as depicted with textile element 40 in the '011 patent (Ex. 1002), 6:41-46).

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The Applicants later amended claim 44 to recite that the textile element has a first area with a first "unitary construction" and a second area with a second "unitary construction different from the first "unitary construction" (1011 file history, 5/10/2010 response, p. 7). In making this amendment, Applicants attempted to overcome a prior art rejection based on Thorneburg and stated in the remarks that "[a]lthough Thorneburg teaches that the ball portion and heel portion of the footbed are thickened, ***the construction of that within is not of a different construction than other areas of the upper.***" (*Id.*, p. 10) (emphasis added).

Thus, according to the specification and claim 16, a broadest reasonable interpretation of "unitary construction" is a one piece construction. The amendments to claim 44 and related arguments focused on the differences between the two different constructions, rather than the existence of two different *unitary* constructions, as different *unitary* constructions is inconsistent with the invention as described in the specification and claim 16. Based on the intrinsic evidence, a broadest reasonable interpretation of a "first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction" consistent with the teachings of the specification and arguments made during prosecution is a unitary construction with two areas, each area having a different construction and set of properties in accordance with the additional language of claim 44.

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I. THERE IS A REASONABLE LIKELIHOOD THAT AT LEAST ONE CLAIM OF THE '011 PATENT IS UNPATENTABLE

As detailed in the claim charts below, through the various identified prior art references or arguments some of which were not before the Examiner during prosecution of the '011 patent and none of which were expressly considered by the Examiner, all limitations of claims 1-46 of the '011 patent were well known in the prior art. Regarding various combinations of prior art, the '011 patent claims merely recite the combination of "prior art elements according to known methods to yield predictable results" and/or the "use of known technique[s] to improve similar devices (methods or products) in the same way." MPEP, §2143(A)-(G).

As a preliminary matter, during the prosecution of the '011 patent, the Examiner pointed out – and the Applicant failed to argue otherwise – that certain recited features common to or all of the claims were well known. For example, the prior art establishes that an upper incorporating a textile element as well as knitted uppers generally were well known. The prior art also teaches that securing a sole structure to the upper was well known. Likewise, as stated by the Examiner, numerous types of knitting (e.g., weft knitted, flat knitted, warp knitted, or formed with a knitting machine) were well known in the art. ('011 file history (Ex. 1003) at 0-1/12/2009 Office Action, pp. 2-3). Applicants did not challenge this assertion.

In addition, during the prosecution of the '011 patent, the Examiner pointed out – and the Applicant failed to argue otherwise – that other recited features of independent claims 1,

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24 and 36 were well known. For example, it was well known that textile elements were

edges joined together to define at least a portion of a void for receiving a foot (claims 1 and 24);

as was the idea of using the edges together to form seams, the seams including a first

seam and a second seam, the first seam extending from a heel area to a forefoot area of

the footwear along a lower surface of the upper, and the second seam extending vertically

in the heel area (claim 24). Removing the textile element from a textile structure that

includes an outline of the textile element was also a well known technique (claim 36).

A "Single Type of Textile ... having a Plurality of ... Knit Constructions" in Claims 1, 15 and 24-42

As discussed above, the Applicants amended independent claims 1, 24, and 36 to

require that the textile element incorporate "a single type of textile having a plurality of knit

constructions." (1011 Nishida at Ex. 1015, at 01/12/2007 Response, pp. 2, 9, and 11). The

Applicants further relied on this element as the sole basis for distinguishing claims 1, 24,

and 36 over the prior art of record. (*Id.*; see Hanley (Ex. 1009), at 9/24/2009 Response,

pp. 12). Indeed, the next action from the PTO was a Notice of Allowance. It appears that

the Examiner relied on this ground as the reason for allowing claims 1, 24, and 36

over several prior art references, which either were not before the Examiner or were

not applied by the Examiner for this feature during prosecution. Each textile element

incorporating a single type of textile having a plurality of knit constructions as required by

claims 1, 24, and 36. For example, Nishida (Ex. 1005) and Judson (Ex. 1007) each

describe textile elements incorporating a single type of textile having a plurality of knit

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constructions. Frederick ... ex. (Ex. 1001) ¶¶ 67, 72, 79, 4). Specifically, Nishida states:

> In FIGS. 1 and 2, a web of material is identified by 1, and is produced by a conventional textile process ... for example, by weaving and/or knitting and/or embroidering. The web of material 1 can be provided with a single or with a plurality of layouts 2 of the shape of a shoe upper 3, as it is represented from the side, for example, in FIG. 3. The web of material has a backing 4 that can be a conventionally used material formed, for example, of a warp and filling or a knitted fabric. ***Layout 2 is divided into different individual parts or areas, which differ from one another, such as by being of another material style and/or by being of different fibers or yarns,*** for example from wool, wool with metal yarns, silk, silk with metal yarns, wool with plastic fibers or the like and/or by being formed of different colors, such as from fibers or yarns of different colors, including those of metals, or by different color prints, ***and/or by being differently designed fiber extrudates or fiber extrudate compositions, such as [ ]stext processed parallel or the like.***

(Nishida (Ex. 1005), 3:6-26 (emphasis added).)

Gleitzer, which dates to 1939, describes:

> In fabricating the unitary upper as by knitting, areas thereof which are normally subjected to greater wear, and ***in which a lower degree of elasticity is desired, such as the toe 11 and the heel portion 12, may be more densely fabricated to provide therein heavier weight and less extensibility than in the other parts of the upper, as by changing the type of stitch or amount of thickness of the yarn in the knitting.*** Other areas, such as the ankle portion 13, are preferably made so as to provide softness and elasticity, as by making them of ribbed construction, as shown

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(Gaudan IEx. 1007) p. 1, 2:33-44 (emphasis added).

At least a third prior art reference, Osanai (Ex. 1008), teaches this same concept for a woven textile element. For each shoe location, the appropriate weave structure is used. For example, *"a cap 10 is formed of a weave structure of high yarn count and density, and upper surface 11 is formed of a weave structure with high breathability."* (Osanai (Ex. 1008) [0039] (emphasis added)).

As demonstrated by the foregoing exemplary excerpts from selected references, the use of textile elements incorporating a single type of textile having a plurality of knit constructions was well known in the art at the time of the priority date of the '011 patent. These references also show that the use of a single type of textile having a plurality of knit constructions was well known as a way to provide different properties to a knitted textile for decades. (Frederick Dec. (Ex. 1001) ¶¶ 72, 84).

As set forth in the grounds and the claim charts below, Nishida, Gaudan, and Osanai anticipate, or at the very least, render obvious claims 1-15 and 24-43 of the '011 patent alone or in combination with other prior art. Specifically, grounds 1 and 15 set forth how these claims are anticipated by Nishida or Gaudan, as further reflected in the charts below. Furthermore, the '011 patent claims merely recite the combination of prior art elements according to known methods to yield predictable results and or the use of known techniques to improve similar devices (methods or products) in the same way. *See, e.g., International Co. v. Teleflex Inc.*, 550 U.S. 398, 417, 422 (2007).

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For example, a person of ordinary skill in the art would have understood that using a single type of textile having a plurality of knit constructions was well known in the textile industry. (Frederick Dec. (Ex. 1001), ¶¶ 37-65, 67-72, 79-94). This concept is clearly shown in the prior art. With regard to the other recited elements in claims 1, 24, and 30, it is undisputed the prior art discloses the combination of these features in uppers for an article of footwear.

Moreover, one of ordinary skill in the art would have understood and expected the benefits of using a single type of textile having a plurality of knit constructions for an upper, that is, that a single type of textile having a plurality of knit constructions would provide the advantages of different properties in the shoe upper, such as breathability and elasticity, while increasing the efficiency of the manufacturing process. (911 patent (Ex. 1002), 2:62-3:15; 11:12-18). Specifically, each of Shida, Glidden, McDonald, Whitag, and Shiomura teach the construction of and or process for constructing a knitted shoe upper. These references explicitly show that since at least the late 1930's it was desirable and known to provide comfort, stretchability, light weight, breathability and absorption properties in an article of footwear and to provide for economy of materials and convenience of procedure in the manufacture of the same. (Glidden (Ex. 1007), p. 1, l. 25-30). See also

- "My invention is a shoe comprising a circular knit fabric sock having a stretchable elastic weft." (McDonald (Ex. 1006), p. 1, l. 1-2).
- "the production of such a shoe upper is nevertheless possible in an efficient,

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and economical way." (Ishida (Ex. 1005), 1:49-4:1, "designed to be relatively deformably soft or elastic" ... has a good air exchange capability" (1:__-2:42, 5:__).

- "[O]bjective: To develop uppers material for shoes responsive to manufacturing methods that increase the economic efficiency of production by reducing the rigidity of uppers materials for shoes as much as possible thus simplifying the sewing process" (Usami (Ex. 1007), 2:__-3:__). "For each shoe in which the stretchable weave structure is used ... and upper structure 11 is formed of a weave structure with high breathability" (2:__-3:__).
- "the resultant uppers are lightweight and yet are elastic" (Ishida (Ex. 1005), 1:40-41).
- "A object of the present invention is to provide a shoe ... of which the shoe upper has a combination of suitable elasticity with both air permeability ..." (Tanimura (Ex. 1011), 1:38-41).

The common teachings of these prior art references show that it would have been obvious for a person of ordinary skill in the art to combine their teachings in designing a knitted shoe upper to achieve the claimed features of the '___ patent. Thus, claims 1-15 and 24-40 of the '011 patent are not patentable in view of the above noted references considered individually or in combination.

With respect to claims 1-15 and 24-33, the specific grounds of rejection are set forth

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in Section III above and the specific citations to the teachings of the cited art are in the chart cited.

As stated in ground 1, Nishida anticipates all of claims 1-15 and 24-43 except for dependent claims 16-37 and 38. With respect to claims 1-14, 15, and 32-34, a person of ordinary skill in the art ("POSITA") at the time of the priority date of the '011 patent would have understood Nishida's teaching of "conventional" knitting processes to include weft knitting, including both circular and flat knitting, and warp knitting when features are recited in claims 1-14, 15, and 32-34. (See cites in chart; Frederick Dec. at ¶72). In addition, it would have in any event been obvious at the time of the priority date of the '011 patent to incorporate weft-knitted textile elements as disclosed by McDonald, Whiting, or Curley, including the circular-knitted elements of McDonald or Whiting or flat-knitted element of Whiting, or warp-knitted textile elements as disclosed by Cutley or Shimmura, into Nishida's upper, for reasons such as those described in, e.g., '580, 3:37-41, 4:17-42. (See Frederick Dec. at ¶72).

With respect to Nishida and claim 8, a POSITA at the time of the priority date of the '011 patent would have understood Nishida's use of two or more layers to include three layers, and that the knit textile element and knitted backing layer of the textile element forms a portion of the interior layer. (See cites in chart; Frederick Dec. at ¶72). In addition, it would have been obvious at the time of the priority date of the '011 patent to incorporate three layers, wherein a knit textile element forms a portion of an inner layer and an outer

layer – as disclosed by Culley or Shiomura – into Nishida's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 72).

With respect to Nishida and claims 1 and 30, a POSITA at the time of the priority date of the '011 patent would have understood that Nishida's knit textile element and/or knit backing layer may form at least a portion of the interior and exterior surfaces of the upper. (See cites in chart; Frederick Dec. at ¶ 72). In addition, it would have been obvious at the time of the priority date of the '011 patent to incorporate a knitted upper, where the knitted material forms a portion of both interior and exterior surfaces of the upper – as disclosed by Culley, Shiomura or Glidden – into Nishida's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 72).

With respect to Nishida and claims 13, 31 and 43, a POSITA at the time of the priority date of the '011 patent would have understood Nishida's knit textile element and/or knitted backing layer may form an interior surface of the upper and one additional layer may form an exterior surface (or, vice versa, by claim 21 only). (See cites in chart; Frederick Dec. at ¶ 72). In addition, it would have been obvious at the time of the priority date of the '011 patent to incorporate a knit textile element that forms an interior surface of the upper, along with an additional layer forming an exterior surface – as disclosed by Culley, Shiomura or Glidden – into Nishida's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 72).

With respect to Nishida and claims 35, 37, and 3[illegible], Nishida discloses the use of

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conventional knitting processes to form the textile element of the upper, and it would have been obvious to a POSITA at the time of the priority date of the '011 patent to use flat, dual double needle bed raschel knitting machines or wide tube circular knitting machines, for reasons such as those identified in *KSR*, 550 U.S. at 417-422, which were also taught by Shortmire or McDonald. (See Frederick Dec. at ¶ 72).

As stated in ground 15, Gridden anticipates claims 1, 2, and 7-14. A POSITA at the time of the priority date of the '011 patent would have understood from Gridden that it describes circular knitting, which has been used for making socks for many decades. (See claim chart; Frederick Dec. at ¶ 84). In addition, it would have at any event been obvious at the time of the priority date of the '011 patent to incorporate weft knitted (circular) textile elements, as disclosed by McDonald or Huang, into Gridden's upper, for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 84).

As stated in the grounds, Osamu alone or in combination with other art renders claims 1-15 and 24-43 obvious. For example, Osamu describes every element of independent claims 1, 24, and 31, except that Osamu discloses using a woven textile element rather than a weft knitted or knitted textile element. A POSITA at the time of the priority date of the '011 patent would have understood that woven and knitted textiles are both suitable for use in uppers and the selection of one versus the other is an obvious design choice, as described by Ishida and Jolley for example. (See Frederick Dec. at ¶). In addition, it would have been obvious at the time of the priority date of the '011 patent

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to incorporate a weft knitted textile as disclosed by Dua, Dunley, Miller, McDonald, or Whiting into Osanai's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 93).

With respect to Osanai and dependent claims 14, 15, and 32-34, a POSITA at the time of the priority date of the '044 patent would have understood that the selection of circular knitting or flat knitting, each a sub-type of weft knitting, or warp knitting is an obvious design choice or a selection from among a finite number of knitting (weft or warp) techniques. (See Frederick Dec. at ¶ 94). In addition, it would have in any event been obvious at the time of the priority date of the '044 patent to incorporate the circular knitted elements of McDonald or Whiting or flat knitted element of Whiting or warp knitted textile elements as disclosed by Dunley in Shoemura into Osanai's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 94). Similarly, for dependent claims 16-17 and 19, a POSITA would have understood that the selection of a guard plate, needle bar, rachel, a sub-type of warp knitting machines or wide tube circular knitting machines (such as those taught by Shoemura or McDonald) is an obvious design choice or a selection from among a finite number of warp knitting techniques. (See Frederick Dec. at ¶ 94).

With respect to Osanai and claim 1, a POSITA at the time of the priority date of the '044 patent would have understood Osanai's use of two or more layers to include three layers and that the textile element forms a portion of the outer layer. (See also Osanai

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Frederick Dec. at ¶ 91). "In addition, it would have been obvious at the time of the priority date of the '011 patent to incorporate three layers" wherein a knit textile element forms a portion of an inner layer and an outer layer "as disclosed by Dorsey or Shiomura into Osamu's upper for reasons such as those identified in KSR, 550 U.S. at 417, 422." (See Frederick Dec. at ¶ 91).

With respect to Osamu and claims 11 and 12, a POSITA at the time of the priority date of the '011 patent would have understood that such additional elements may be secured to a forefoot area and/or a heel area of the upper from Osamu's disclosure. (See cites in chart; Frederick Dec. at ¶ 91). "In addition, it would have been obvious at the time of the priority date of the '011 patent to incorporate an additional element secured to a forefoot area and/or a heel area of the upper" as disclosed by Nishida or Gridden into Osamu's upper for reasons such as those identified in KSR, 550 U.S. at 417, 422. (See Frederick Dec. at ¶ 91).

'011 Patent Claims	Description of Prior Art
1. An article of footwear comprising:	Grounds 1, 3, 7, 12 **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72. Nishida at Abstract, FIG. 3 Grounds 16-17 **Gridden** discloses an article of footwear. Frederick Dec. at ¶ 84. Gridden at Title, p. 4:13-14 Grounds 18-19, 24-25, 35-36 **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91. Osamu at Title, [0001], [0007]
an upper incorporating a weft knitted textile element having edges that are joined together	Grounds 1-2 **Nishida** discloses an upper incorporating a weft textile element having edges made by conventional knitting processes and having edges that are joined together
that are joined together to define at least a portion of a void for	that are joined together to define at least a portion of a void for

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to define "at least a portion of a void for receiving a foot."

Description of Prior Art

receiving a foot. Frederick Dec. at ¶ 72; Nishida at 3:6-12, 3:31-42; FIGS. 2-3.

Grounds 3, 7, 12

Nishida + other art

Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. See McDonald at p. 1, 2:26-38; Whiting at 2:39-56; Dumey at p. 7, line 32-p. 8, line 25.

Ground 12

Glidden discloses an upper incorporating a knit textile element that defines at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 84; Glidden at p. 1, 2:3-10, 2:45-48; FIGS. 1-6, 8.

Grounds 10, 17

Glidden + other art

Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. See McDonald at p. 1, 2:26-38; Whiting at 2:39-56.

Ground 18

Osamu discloses an upper incorporating a textile element having edges that are sewed together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 91; Osamu at [0002], [0009], [0010], [0011]; FIGS. 1-3. Osamu describes a woven textile element rather than a weft-knitted textile element.

Grounds 19, 24, 29, 35, 36

Osamu + other art

Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. See Nishida at 1:61-62, 1:67-68, 2:42-45, 3:5-10, 3:45-52, 3:60-68, 5:62-6:2, 6:23-25; Dumey at p. 7, lines 32-33, p. 8, lines 7-23, p. 10, lines 5-6. Additionally, Glidden, McDonald, Whiting, and Dumey each discloses an upper incorporating a weft-knitted textile element. See Glidden at p. 1, 2:45-48; FIGS. 1, 6, 8; McDonald at p. 1, 2:26-38; Whiting at 2:39-56; Dumey at p. 7, line 32-p. 8, line 25.

Grounds 1-3, 7, 12

Wherein the weft-knitted textile element incorporates a single textile element having a plurality of knit constructions

Nishida discloses that the knit textile element may be a single textile element having a plurality of knit constructions. Frederick Dec. at ¶ 72; Nishida at 3:15-4:18, 4:47-60, 5:41-45, 5:63-6:2,

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'911 Patent Teiras	Description of Prior Art
plurality of knit constructions; and	6:4-41 Grounds 15-17 **Glidden** discloses that the knit textile element may be a single textile element having a plurality of knit constructions. Frederick Dec. at ¶ 4; Glidden at p. 1, 2:33-44, FIG. 1 Grounds 18-19; 24; 29; 35; 36
	Osamu discloses that the textile element may be a single textile element having a plurality of constructions. Frederick Dec. at ¶ 31; Osamu at [0005], [0007], [0009], [0012]; claim 1 Grounds 1-3, 7, 12
a sole structure secured to the upper.	**Nishida** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 72; Nishida at Abstract; FIG. 3 Grounds 15-17
	Glidden discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 84; Glidden at p. 2, 1:9-10; 2:5-15; 2:23-30; FIGS. 1-6 Grounds 15-19; 24; 29; 35; 36
	Osamu discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; Osamu at [0001], [0007], [0013], [0015]
2. The article of footwear recited in claim 1, wherein the weft knitted textile element forms at least a portion of a lateral side, a medial side, and an instep region of the upper.	Grounds 1-3, 7, 12 **Nishida** discloses that the knit textile element may form at least a portion of a lateral side, a medial side, and an instep region of the upper. Frederick Dec. at ¶ 72; Nishida at 3:15-4:46, FIGS. 1-5 Grounds 15-17 **Glidden** discloses that the knit textile element may form at least a portion of a lateral side, a medial side, and an instep region of the upper. Frederick Dec. at ¶ 84; Glidden at p. 1, 2:3-10; FIGS. 1-3 Grounds 18-19; 24; 29; 35; 36 **Osamu** discloses that the textile element may form at least a portion of a lateral side, a medial side, and an instep region of the upper. Frederick Dec. at ¶ 91; Osamu at [0007], [0010]; FIGS. 1-3 Grounds 1-3, 7, 12
3. The article of footwear recited in claim 1, wherein the edges include a pair of first edges that are oriented to form a first seam extending longitudinally along a lower region of the upper.	**Nishida** discloses that edges of the knit textile element may include a pair of first edges that are oriented to form a first seam

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'011 Patent	Claims	Description of Prior Art
edges that are joined to form a first seam extending longitudinally along a lower region of the upper.		Frederick Dec. at ¶ 72; Nishida at 5:3-13; FIG. 4 Grounds 12-19, 24, 29, 35, 38 **Osamu** discloses that edges of the textile element may include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper. Frederick Dec. at ¶ 91; Osamu at [0007]; FIG. 1.
4. The article of footwear recited in claim 3, wherein the edges include a pair of second edges that are joined to form a second seam extending along a heel region of the upper.		Grounds 1-3, 7, 12 **Nishida** discloses that edges of the knit textile element may also include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 72; Nishida at 3:31-36; 4:8-11; FIGS. 2, 4 Grounds 18-19, 24, 29, 35, 38; **Osamu** discloses that edges of the textile element may also include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 91; Osamu at [0010]; FIGS. 1, 3.
5. The article of footwear recited in claim 4, wherein the second seam extends vertically.		Grounds 1-3, 7, 12 **Nishida** discloses that the second seam extends vertically. Frederick Dec. at ¶ 72; Nishida at 3:31-36; 4:8-11; FIGS. 2-4 Grounds 18-19, 24, 29, 35, 38 **Osamu** discloses that the second seam extends vertically. Frederick Dec. at ¶ 91; Osamu at [0010]; FIGS. 1, 3.
6. The article of footwear recited in claim 4, wherein the edges include at least a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper.		Grounds 1-3, 7, 12 **Nishida** discloses that edges of the knit textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 72; Nishida at 4:19-30; FIG. 4 Grounds 18-19, 24, 29, 35-38; **Osamu** discloses that edges of the textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 91; Osamu at FIG. 1.
7. The article of footwear recited in claim 1, wherein the weft knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.		Grounds 1-3, 7, 12 **Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; Nishida at 3:6-9; 3:36-41; FIG. 2 Grounds 15-17 **Glidden** discloses that the knit textile element may at least a an exterior layer of the upper. see FIG. 1. and or an interior

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011 Patent Claims	Description of Prior Art
upper.	layer of the upper. Frederick Dec. at ¶ 84; Gilduen at p. 1, 23-28, p. 2, 1:68-74; FIGS. 1-3, 6-8. Grounds 18-19, 21, 29-35, 38. **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; Osamu at [0001], [0005], [0010], claim 1. Grounds 1-2. **Nishida** discloses that the upper may include two or more layers and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 72; Nishida at 2:5-9, 3:62-4:1. Grounds 4-5, 8-9, 12-13. **Nishida + other art** Uppers incorporating three layers wherein a knit textile element forms a portion of an inner layer and an outer layer were well-known in the art at the time of the priority date of the 011 patent. See Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. Grounds 15-17.
6. The article of footwear recited in claim 1 wherein the upper includes an exterior layer, an intermediate layer and an interior layer and the weft-knitted textile element forms at least a portion of the interior layer.	**Gilduen** discloses that the knit textile element may at least a an exterior layer of the upper and/or an interior layer of the upper. Frederick Dec. at ¶ 84; Gilduen at p. 1, 2:3-23, p. 2, 1:68-74; FIGS. 1-2. Grounds 18. **Osamu** discloses that the upper may include two or more layers and the textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 91; Osamu at [0001], [0005], [0006], [0010], claim 1. Grounds 20-21, 25-26, 30-31, 35-38. **Osamu + other art** Uppers incorporating three layers wherein a knit textile element forms a portion of an inner layer and an outer layer were well-known in the art at the time of the priority date of the 011 patent. See Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. Grounds 1-2.
8. The article of footwear recited in claim 1 wherein the weft-knitted textile element forms at	**Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; Nishida at 2:5-4:49; FIG. 3.

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'011 Patent Claims	Description of Prior Art
least a portion of both an interior surface and an exterior surface of the upper.	Grounds 4-5, 8-10, 12-14: **Nishida** other art **Nishida** discloses a knit textile element that forms a portion of an interior surface and an exterior surface were well-known in the art at the time of the priority date of the '011 patent. See Conley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 3; Shigemura at 2:26-45; Glidden at FIGS. 1-2; p. 1, 2:5-32. Grounds 16-17: **Glidden** discloses that the knit textile element forms at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 4; Glidden at p. 1, 2:3-23; p. 2, 1:65-74; FIGS. 1-2, 6-8. Grounds 18-19, 24-29, 32-38: **Osamu** discloses that the textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 91; Osamu at [0001], [0055], [0091]; claim 1.
10. The article of footwear recited in claim 9, wherein at least one additional element is secured to the exterior surface and forms a portion of the exterior surface.	Grounds 1-2, 7, 12: **Nishida** discloses that elements such as toe caps or heel counters may be secured to the exterior surface of the upper and may form a portion of the exterior surface of the upper. Frederick Dec. at ¶ 72; Nishida at 2:26-47, 3:37-42, 7:23-36, 8:9-11; FIG. 3. Grounds 15-17: **Glidden** discloses that counters, heel reinforcements, bluchers, saddle toe caps, and heel straps may be secured to the exterior surface of the upper and may form a portion of the exterior surface of the upper. Frederick Dec. at ¶ 84; Glidden at p. 2, 1:9-19, 1:50-55, 1:64-74, 2:24-26; FIGS. 1-5. Grounds 18-19, 24-29, 32-38: **Osamu** discloses that other elements may be secured to the exterior surface of the upper and may form a portion of the exterior surface of the upper. Frederick Dec. at ¶ 91; Osamu at [0006].
11. The article of footwear recited in claim 10, wherein the additional element is secured to a forefoot	Grounds 1-3, 7, 11: **Nishida** discloses that a toe cap may be secured to a forefoot area of the upper. Frederick Dec. at ¶ 72; Nishida at 3:37-42. Grounds 15-17: **Glidden** discloses that a toe cap may be secured to a forefoot

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'011 Patent Claims	Description of Prior Art
area of the upper.	area of the upper. Frederick Dec. at ¶4; Glidden at p. 2, 2:24-26; FIGS. 6-8. Ground 18. **Osamu** discloses that other elements may be secured to the exterior surface of the upper. Frederick Dec. at ¶ 21; Osamu at [0006]. Grounds 22-23, 27-29, 35. **Osamu + other art** The incorporation of additional features onto a forefoot area of an upper were well-known in the art at the time of the priority date of the '011 patent. See Nishida at 3:37-42; Glidden at p. 2, 2:24-26; FIGS. 6-8.
12. The article of footwear recited in claim 10, wherein the additional element is secured to a heel area of the upper.	Grounds 1-3, 7-11. **Nishida** discloses that a heel counter may be secured to the heel area of the upper. Frederick Dec. at ¶ 22; Nishida at 4:9-11. Grounds 15-17. **Glidden** discloses that a heel counter or heel reinforcement may be secured to the heel area of the upper. Frederick Dec. at ¶ 4; Glidden at p. 2, 1:8-19, 2:24-26; FIGS. 1-6. Ground 18. **Osamu** discloses that other elements may be secured to the exterior surface of the upper. Frederick Dec. at ¶ 21; Osamu at [0006]. Grounds 22-23, 27-29, 35. **Osamu + other art** The incorporation of additional features onto a heel area of an upper were well-known in the art at the time of the priority date of the '011 patent. See Nishida at 4:9-11; FIG. 3; Glidden at p. 2, 1:9-19, 2:24-26; FIGS. 1-6.
13. The article of footwear recited in claim 1, wherein the textile element forms an interior surface of the upper.	Grounds 1-2. **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 22; Nishida at 3:6-46. Grounds 4-6, 8-10, 12-14. **Nishida + other art** The incorporation knit textile elements that form an interior surface of the upper were well-known in the art at the time of the priority date of the '011 patent. See Cutley at p. 5, lines 30-32, p. 30; claim 3; Sakamura at 2:26-46; Glidden at FIGS. 1-2, p. 1.

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'611 Patent Claims	Description of Prior Art
	2, 3, 32 Grounds 15-17 **Gridden** discloses that the knit textile element forms an inner surface of the upper. Frederick Dec. at ¶ 84; Gridden at p. 1, 2:3-23; p. 2, 1:1-8:74; FIGS. 1-3, 6-8 Grounds 15-19, 24, 29-30, 33 **Osamu** discloses that the textile element forms an inner surface of the upper. Frederick Dec. at ¶ 83; Osamu at [0001]; [0005]; [0010]; claim 1 Grounds 1-2 **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72; Nishida at 2:6-12 Grounds 3 **Nishida + other art** Uppers incorporating textile elements formed by circular knitting were well-known in the art at the time of the priority date of the '611 patent. See McDonald at p. 1, 2:26-30; Whiting at 2:39-56 Ground 15 **Gridden** describes fabricating a "unitary knit upper as a shaped 'sock like' article." Frederick Dec. at ¶ 84; Gridden at p. 1, 2:3-10; 2:45-49; FIGS. 1-3, 6 Grounds 18-19 **Gridden + other art** Uppers incorporating textile elements formed by circular knitting were well-known in the art at the time of the priority date of the '611 patent. See McDonald at p. 1, 2:26-30; Whiting at 2:39-56 Ground 16 **Osamu** See claim 1 Grounds 19, 24, 29, 34 **Osamu + other art** Uppers incorporating textile elements formed by circular knitting, a sub-type of weft knitting, were well-known in the art at the time of the priority date of the '611 patent. See Whiting at 2:39-56; McDonald at p. 1, 2:26-30 Grounds 1-2
13 – The article of footwear recited in claim 1, wherein the weft-knitted textile element is created by circular knitting	**Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72; Nishida at 2:6-12 Grounds 3 **Nishida + other art** Uppers incorporating textile elements formed by circular knitting were well-known in the art at the time of the priority date of the '611 patent. See McDonald at p. 1, 2:26-30; Whiting at 2:39-56 Ground 15 **Gridden** describes fabricating a "unitary knit upper as a shaped 'sock like' article." Frederick Dec. at ¶ 84; Gridden at p. 1, 2:3-10; 2:45-49; FIGS. 1-3, 6 Grounds 18-19 **Gridden + other art** Uppers incorporating textile elements formed by circular knitting were well-known in the art at the time of the priority date of the '611 patent. See McDonald at p. 1, 2:26-30; Whiting at 2:39-56 Ground 16 **Osamu** See claim 1 Grounds 19, 24, 29, 34 **Osamu + other art** Uppers incorporating textile elements formed by circular knitting, a sub-type of weft knitting, were well-known in the art at the time of the priority date of the '611 patent. See Whiting at 2:39-56; McDonald at p. 1, 2:26-30 Grounds 1-2
15 – The article of footwear recited in claim 1, wherein the weft-knitted	**Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72;

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'011 Patent: teams knitted textile element is created by flat knitting	Description of Prior Art Nishida at 1:6-12 Gratkowski ¶ 7 **Nishida + other art** Uppers incorporating textile elements formed by flat knitting were well-known in the art at the time of the priority date of the '011 patent. See Whiting at 2:39-56 Ground 12: **Osamu** See claim 1 Ground 24, 34: **Osamu + other art** Uppers incorporating textile elements formed by flat knitting, a sub-type of weft knitting, were well-known in the art at the time of the priority date of the '011 patent. See Whiting at 2:39-56
24. An article of footwear comprising:	Grounds 1-2: **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72; Nishida at Abstract; FIG. 3 Grounds 18-19, 24, 29, 35, 36: **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91; Osamu at 1:6-11; 10:6-11; 10:60-11:7 Grounds 1-2: **Nishida** discloses an upper incorporating a textile element having edges that are joined together to form seams and define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 72; Nishida at Abstract; 5:6-12; 3:31-42; FIGS. 2-3 Grounds 18-19, 24, 29, 35, 36: **Osamu** discloses an upper incorporating a textile element having edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 91; Osamu at 10:67-11:6; 10:10-11; FIGS. 1-2
the seams including a first seam and a second seam, the first seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper and the second seam extending	Grounds 1-2: **Nishida** discloses that the seams include a first seam that extends from a heel area to a forefoot area of the footwear along a lower surface of the upper and a second seam that extends vertically in the heel area. Frederick Dec. at ¶ 72; Nishida at 3:31-36; 4:6-11; 6:3-13; FIGS. 2-4 Grounds 18-19, 24, 29, 35, 36: **Osamu** discloses that the seams include a first seam that extends from a heel area to a forefoot area of the footwear along

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vertically in the heel area.

Wherein the textile element incorporates a single type of textile having a plurality of knit constructions and

a sole structure secured to the upper.

25. The article of footwear recited in claim 24, wherein the footwear includes a third seam extending through the forefoot area of the upper.

Description of Prior Art

a lower surface of the upper and a second seam that extends vertically in the heel area. Frederick Dec. at ¶ 91; Osamu at [0007]; [0010]; Figs. 1, 3.

Grounds 1-2.

Nishida discloses that the textile element may be a single textile element having a plurality of knit constructions. Frederick Dec. at ¶ 72; Nishida at 1:15-4:19; 4:47-5:41-45; 5:63-6:2; 6:4-43.

Ground 16.

Osamu discloses that the textile element may be a single textile element having a plurality of constructions. Frederick Dec. at ¶ 91; Osamu at [0030]; [0007]; [0010]; [0012]; claim 1. Osamu describes a woven textile element with a plurality of weave structures, rather than a knitted textile element with a plurality of knit constructions.

Grounds 19; 24; 29; 35; 39;

Osamu; other art

Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the patent. See Nishida at 1:61-65; 1:67-68; 2:42-45; 2:8-10; 3:45-52; 3:56-58; 5:63-6:2; 6:23-25; Culley et al. p. 2, lines 32-33; p. 8, lines 7-9; p. 16, lines 1-5. Additionally, McDonald, Whiting, and Culley each discloses an upper incorporating a weft-knitted textile element. See McDonald at p. 1, 22-32; Whiting at 2:30-36; Culley at p. 7, line 12; p. 8, line 26.

Grounds 1-2.

Nishida discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 72; Nishida at Abstract; FIG. 3.

Grounds 18-19; 24; 29; 35; 39.

Osamu discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; Osamu at [0004]; [0007]; [0013]; [0016].

Grounds 1-2.

Nishida discloses that the footwear includes a third seam that extends through a forefoot area of the upper. Frederick Dec. at ¶ 72; Nishida at 4:19-30; FIG. 4.

Grounds 19; 24; 29; 35; 39.

Osamu discloses that the footwear includes a third seam that extends through a forefoot area of the upper. Frederick Dec. at ¶ 91; Osamu at FIG. 1.

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'011 Patent claims	Description of Prior Art
26. The article of footwear recited in claim 24, wherein at least one of the knit constructions forms an aperture in the textile element.	Grounds 1-2 **Nishida** discloses that at least one knit construction may form a net-like structure (i.e. having apertures) in the textile element. Frederick Dec. at ¶72; Nishida at 3:41-52. Grounds 18-19; 24; 29; 35; 38 **Osamu** discloses at least one configuration may form a sleeve structure with high breathability (i.e. having apertures) in the textile element. Frederick Dec. at ¶ 91; Osamu at [0009].
27. The article of footwear recited in claim 24, wherein the knit constructions produce varying properties in the textile element including a varying elasticity of the textile element.	Grounds 1-2 **Nishida** discloses that the knit constructions may produce varying elasticity of the textile element. Frederick Dec. at ¶ 72; Nishida at 2:26-37; 3:43-52; 6:16-31. Grounds 18-19; 24; 29; 35; 38 **Osamu** discloses that the knit constructions may produce varying elasticity of the textile element. Frederick Dec. at ¶ 91; Osamu at [0008]; [0009].
28. The article of footwear recited in claim 24, wherein the knit constructions produce varying properties in the textile element including a varying air permeability of the textile element.	Grounds 1-2 **Nishida** discloses that the knit constructions may produce a varying air permeability of the textile element. Frederick Dec. at ¶ 72; Nishida at 3:43-52; 6:16-31. Grounds 18-19; 24; 29; 35; 38 **Osamu** discloses that the constructions may produce a varying air permeability of the textile element. Frederick Dec. at ¶ 91; Osamu at [0008].
29. The article of footwear recited in claim 24, wherein the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	Grounds 1-2 **Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; Nishida at 3:6-9; 3:66-4:1; FIG. 3. Grounds 18-19; 24; 29; 35; 38 **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; Osamu at [0002]; [0004]; [0010]; claim 1.
30. The article of footwear recited in claim 24, wherein the textile element forms at least a portion of both an interior surface and an exterior surface of the upper.	Grounds 1-2 **Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; Nishida at 3:6-9; 4:46; FIG. 3. Grounds 12-14 **Nishida** and other art users having a knit textile element that forms a portion of an

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'611 Patent Claims	Description of Prior Art
	interior surface and an exterior surface were well known in the art at the time of the priority date of the '611 patent. See Curley at p. 6 lines 28-32; p. 30 claim 34; p. 7 line 32 p. 8 line 5; Shromm at 2:26-45; Glidden at FIGS. 1-2; p. 1 2-3 32; Grounds 16 19 24 28 35 38;
	Osamu discloses that the textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 91; Osamu at [0031], [0035], [0010], claim 1; Grounds 1 2;
31. The article of footwear recited in claim 24, wherein the textile element forms an interior surface of the footwear and at least one additional layer forms an exterior surface of the footwear.	**Nishida** discloses that the upper may include two or more layers and that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; Nishida at 2:37-39, 2:64-65, 4:9-11; Grounds 12 14;
	Nishida + other art
	Uppers incorporating knit textile elements that form an interior surface of the footwear and have at least one additional layer forming an exterior surface were well known in the art at the time of the priority date of the '611 patent. See Curley at p. 6 lines 30-32; p. 30 claim 34; Shromm at 2:26-35, FIG. 1; Glidden at p. 2 1 9-19; 7 66-74; FIGS. 1-6, 8; Grounds 16 19 24 28 35 38;
	Osamu discloses that the textile element forms an interior surface of the footwear and at least one additional layer forms an exterior surface of the footwear. Frederick Dec. at ¶ 91; Osamu at [0031], [0035], [0036], [0010], claim 1;
32. The article of footwear recited in claim 24, wherein at least a portion of the textile element has a weft-knitted construction.	Grounds 1 2;
	Nishida discloses the use of conventional knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72; Nishida at 3:6-12; Grounds 2 7 12;
	Nishida + other art
	Uppers incorporating weft-knitted textile elements were well known in the art at the time of the priority date of the '611 patent. See, e.g., Donald at 2:1-2:20, 3:0 – ending at 2:30-55; Curley at p. 7 line 32 p. 8 line 25;
	Ground 12;
	Osamu

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'011 Patent Claims	Description of Prior Art
	See claim 29 Grounds 19, 24-27, 35-38 **Osamu +other art** Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. See Nishida at 1:61-62, 1:67-68, 2:42-45, 2:6-19, 3:45-52, 3:65-68, 5:63-6:2, 6:23-25; Curley at p. 7, lines 32-33, p. 8, lines 7-9, p. 10, lines 5-8. Additionally, Glidden, McDonald, Whiting, and Curley discloses an upper incorporating a weft-knitted textile element. See Glidden at p. 1, 2:3-19, p. 1, 2:45-49, FIGS. 1, 6, 8; McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25.
33. The article of footwear recited in claim 32, wherein the weft-knitted construction is produced by one of circular knitting and flat knitting.	Grounds 1-2 **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. Nishida at 2:1-12 Grounds 3, 7 **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. Uppers incorporating textile elements formed by circular knitting and/or flat knitting, both sub-types of weft knitting, were well-known in the art at the time of the priority date of the '011 patent. See McDonald at p. 1, 2:26-39; Whiting at 2:39-56. It would have been obvious at the time of the priority date of the patent to incorporate circular knitted and/or flat knitted textile elements as disclosed by McDonald or Whiting into Nishida's upper. Frederick Dec. at ¶ 72. See MPEP 2143(A)-(G). Ground 18
	Osamu See claim 24 Grounds 19, 24, 35-38 **Osamu +other art** Uppers incorporating textile elements formed by circular knitting and/or flat knitting, both sub types of weft knitting, were well-known in the art at the time of the priority date of the '011 patent. See Whiting at 2:39-56; McDonald at p. 1, 2:26-39.
34. The article of footwear recited in claim 24, wherein the textile	Grounds 1-2 **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72.

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'011 Patent Claims	Description of Prior Art
element has a warp knitted construction	Nishida at 3:4-12 Grounds 12-13 **Nishida + other art** Uppers incorporating textile elements formed by warp knitting were well-known in the art at the time of the priority date of the '011 patent. See Dua at p. 7, lines 31-32; Shiomura at 3:4-43 Ground 18 **Osamu** See claim 24 Grounds 20-21, 23-25, 28-32, 35-36 **Osamu + other art** Uppers incorporating textile elements formed by warp knitting were well-known in the art at the time of the priority date of the '011 patent. See Dua at p. 7, lines 31-32; Shiomura at 3:4-43
35. The article of footwear recited in claim 24, wherein the warp knitted construction is produced by a jacquard double needle bar raschel	Group 2 **Nishida** discloses the use of conventional knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72 Nishida at 3:6-12 Ground 13 **Nishida + other art** Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle bar raschel were well-known in the art at the time of the priority date of the '011 patent. See Shiomura at 3:4-43; Fig. 5 Ground 19 **Osamu** describes or suggests woven textile element which may be formed by a weaving machine. Frederick Dec. at ¶ 91 Osamu at [0008], [0012], [0014] Grounds 23, 25, 31, 37, 39 **Osamu + other art** Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle bar raschel were well-known in the art at the time of the priority date of the '011 patent. See Shiomura at 3:4-43
36. An article of footwear comprising:	Grounds 1-2 **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72 Nishida at Abstract; Fig. 2 Grounds 15-19, 24, 29, 35, 36 **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91

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'011 Patent Claims	Description of Prior Art
an upper incorporating a knitted textile element formed with a knitting machine, the textile element being removed from a textile structure that includes an outline of the textile element; and	Osamu at the [0001]-[0007] Grounds 1-2: Nishida discloses an upper incorporating a knitted textile element that may be formed with a knitting machine where the textile element is removed from a textile structure that includes an outline of the textile element. Frederick Dec. at ¶ 72; Nishida at Abstract; 1:48-2:47, 3:9-12, 4:12-18, 4:31-42, 4:47-55, 5:63-6:2, 6:12-35; FIG. 2 Ground 18: Osamu discloses an upper incorporating a textile element that may be formed with a weaving machine where the textile element is removed from a textile structure that includes an outline of the textile element. Frederick Dec. at ¶ 91; Osamu at [0005]-[0007],[0009]-[0012], [0014]; FIG. 1. Osamu describes a woven textile element rather than a knitted textile element. Grounds 18-19, 24, 29, 36, 38: Osamu, other art: Woven and knitted textiles are both suitable for use in uppers and were well known in the art at the time of the priority date of the '011 patent. See Nishida at 1:51-62, 1:67-2:6, 2:42-43, 3:5-10, 3:45-52, 3:66-68, 5:63-6:2, 6:21-26; Gurley at p. 7, lines 32-33; p. 9, lines 7-9; p. 10, lines 2-8. Additionally, Glidden, McDonald, Whiting, and Gurley, each, disclose an upper incorporating a weft-knitted textile element. See Glidden at p. 1, 2:45-46; FIGS. 1-6, 8; McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Gurley at p. 7, line 32-p. 8, line 29.
the textile element having edges that are joined together to define at least a portion of a void for receiving a foot,	Grounds 1-2: Nishida discloses that the knitted textile element may have edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 72; Nishida at Abstract; 2:6-12, 3:31-42; FIGS. 2-3 Grounds 18-19, 24, 29, 36, 38: Osamu discloses that the textile element may have edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 91; Osamu at [0008], [0010]; FIGS. 1-3
wherein the textile element incorporates a single type of textile single textile element having a plurality of knit constructions	Grounds 1-2: Nishida discloses that the knitted textile element may be a single textile element having a plurality of knit constructions

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'011 Patent claims	Description of Prior Art
having a plurality of knit constructions, and	Frederick Dec. at ¶ 72, Nishida at 3:15-4:18, 4:47-60, 5:41-43, 5:63-6:2, 6:4-41 Grounds 16-19, 24, 29, 35, 36 Osamu discloses that the textile element may be a single textile element having a plurality of constructions. Frederick Dec. at ¶71, Osamu at [0005], [0007], [0009], [0012], claim 1. Grounds 1-2.
a sole structure secured to the upper	Nishida discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 72, Nishida at Abstract, F. G. 3 Grounds 16-19, 24, 29, 35, 36. Osamu discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 71, Osamu at [0001], [0007], [0012], [0014]. Ground 2.
27. The article of footwear recited in claim 26, wherein the knitted textile element has a structure formed by a wide-tube circular knitting machine.	Nishida discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72, Nishida at 3:6-12. Ground 3. Nishida + other art. Uppers incorporating textile elements formed by a wide-tube circular knitting machine were well-known in the art at the time of the priority date of the '011 patent. See McDonald at p. 1, 22(a-30. Ground 11a. Osamu discloses that a woven textile element may be formed by a weaving machine. Frederick Dec. at ¶ 91, Osamu at [0012], [0014]. Ground 10, 33. Osamu + other art. Uppers incorporating textile elements formed by a wide-tube circular knitting machine were well-known in the art at the time of the priority date of the '011 patent. See McDonald at p. 1, 22(a-30.
28. The article of footwear recited in claim 26, wherein the knitted textile element has a structure formed by a flat double needle	Ground 2. Nishida discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72, Nishida at 3:6-12. Ground 13. Nishida + other art.

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'011 Patent: Jarmo Bar raschel knitting machine

Designation of Prior Art

Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle bar raschel knitting machine were well-known in the art at the time of the priority date of the '011 patent. See Shishkina at 3:4-43.

Ground 1B:

Osamu describes a jacquard woven textile element which may be formed by a weaving machine. Frederick Dec. at ¶ 91; see also Osamu at [0015]; [0012]; [0016].

Grounds 2I, 2G, 3I, 3K, 3G.

Osamu, other art

Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle bar raschel knitting machine were well-known in the art at the time of the priority date of the '011 patent. See Shishkina at 3:4-43.

39. The article of footwear recited in claim 38, wherein the edges include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper.

Grounds 1-2:

Nishida discloses that edges of the knit textile element may include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper. Frederick Dec. at ¶ 72; Nishida at 5:3-13; FIG. 4.

Grounds 1B-1G, 2A-2G, 3I-3K.

Osamu discloses that edges of the textile element may include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper. Frederick Dec. at ¶ 91; Osamu at [0027]; FIG. 3.

40. The article of footwear recited in claim 39, wherein the edges include a pair of second edges that are joined to form a second seam extending along a heel region of the upper.

Grounds 1-2:

Nishida discloses that edges of the knit textile element may also include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 72; Nishida at 5:31-35; 4:9-11; FIGS. 2-4.

Grounds 1B-1G, 2A-2G, 3I-3K.

Osamu discloses that edges of the textile element may also include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 91; Osamu at [0027]; FIGS. 1-3.

41. The article of footwear recited in claim 40, wherein the edges include at least a pair of third edges that are

Grounds 1-2:

Nishida discloses that edges of the knit textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 72; Nishida at 4:19-30; FIG. 4.

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'911 Patent Claims	Description of Prior Art
joined to form a second seam extending through a forefoot area of the upper.	Grounds 16-19, 24, 29, 35, 36 **Osamu** discloses that edges of the textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 91; Osamu at FIG. 1 Grounds 1-2
42. The article of footwear recited in claim 36, wherein the knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	**Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; Nishida at 3:6-9, 3:58-4:1; FIG. 3 Grounds 16-19, 24, 29, 35, 36 **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; Osamu at [0001], [0005], [0010]; claim 1 Grounds 1-2
43. The article of footwear recited in claim 36, wherein the knitted textile element forms an interior surface of the upper.	**Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; Nishida at 3:6-46 Grounds 12-14 **Nishida** other art Uppers incorporating knit textile elements that form an internal surface of the upper were well-known in the art at the time of the priority date of the '911 patent. See Curley at p. 6, lines 30-32, p. 30, claim 34; Shiomura at 2:20-42; Gaudet at FIGS. 1-2, p. 1, ¶ 3, p. 2 Grounds 16-19, 24, 29, 35, 36 **Osamu** discloses that the knit textile element forms an interior surface of the upper. Frederick Dec. at ¶ 91; Osamu at [0001], [0005], [0010]; claim 1

B. "Textile Element . . . aving A First Area And A Second Area . . . ith A Unitary Construction, The First Area Being Formed Of A First Stitch Configuration, And The Second Area Being Formed Of A Second Stitch Configuration That Is Different From The First Stitch Configuration To Impart . . . arying Properties To The Textile Element" in Claims 16-23

As discussed above, the Applicants argued that the prior art of record did not teach a textile element having first and second areas that each has a different stitch configuration to

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impart varying properties to each area of the textile element as the sole basis for distinguishing claim 16 over the prior art of record (see file history (Ex. 1003) at 01/12/2007 response pp. 10-12), because the next action from the PTO was a Notice of Allowance, the Examiner appears to have relied on this ground as the reason for allowance of claim 16.

81. Several prior art references which were not before the Examiner or apparently were not applied by the Examiner for the feature during prosecution teach textile elements having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element as required by claim 16. For example, Bishop, Glidden and Osborne all discuss textile elements having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element. (Frederick, ec (E. 1001) at 6:6-72; 8:1-64; 8:65-9:1). For example, Glidden states:

> a fabric using the unitary upper as by knitting areas thereof which are normally subjected to greater wear and in which a lower degree of elasticity is desired such as the toe 11 and the heel portion 12 may be more densely fabricated to provide therein heavier weight and less extensibility than in the other parts of the upper as by changing the type of stitch or amount of tightness of the yarn in the knitting. Other areas such as the ankle portion 13 are preferably made so as to provide softness and elasticity as by making them of ribbed construction as shown.

(Glidden (Ex. 1007) p. 1, col. 2, 31-44).

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the use of textile elements having a first area and a second area with a unitary construction, the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the textile element was well known in the art at the time of the priority date of the '013 patent.

As set forth in the claim charts below, Nishida, Gulden, and/or some or all of the very least render obvious claims 16-23 of the '013 patent, alone or in combination. Specifically, grounds 1 and 4 set forth how these claims are anticipated by Nishida or Gulden, as further referenced in the charts below. Regarding various combinations of prior art, the '013 patent claims merely recite the combination of prior art elements according to known methods to yield predictable results and or the "use of known technique to improve similar devices (methods, or products) in the same way." See MPEP 2143 (A-D). For example, it is the opinion of ordinary skill in the art would have understood that using a knitted textile element having first and second areas that each had a different stitch configuration to impart varying properties to each area of the textile element was a well known endeavor among those in the textile industry. (Frederick ¶¶ (Ex. 1001), 2, 4, 11). In regard to the other recited elements in claim 16, it is undisputed the prior art discloses the combination of these features in uppers for an article of footwear.

Moreover, one of ordinary skill in the art would have understood and expected the benefits of using a knitted textile element having first and second areas that each had a

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different stitch configuration to impart varying properties to each area of the textile element with such an upper – that is, an article having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element would provide the advantages of different properties in the shoe upper, such as breathability and elasticity, while increasing the efficiency of the manufacturing process. (011 patent, col. 1, lines 62-65; col. 2, lines 11-12.) Specifically, the prior art references cited in Section IV.A above teach the construction of and or process for constructing a knitted shoe upper. The common teachings of these prior art references show that it would have been obvious to a person of ordinary skill in the art to combine their teachings in designing a knitted shoe upper to achieve the claimed features of the '011 patent. Thus, claims 16-21 of the '011 patent are not patentable in view of the above noted references combined individually or in combination.

With respect to claims 16-22, the specific grounds of rejection are set forth in Section III. above and the specific citations to the teachings of the cited art are in the chart below.

As stated in the grounds, Nishida anticipates claims 16 and 17-22, and claims 16-22 are also obvious in view of Nishida alone or Nishida and other prior art. With respect to claim 16, a POSITA at the time of the priority date of the '011 patent would have understood Nishida's teaching of conventional knitting processes to include weft knitting. (See cites in chart; reference 1, pp. 8-9.) Likewise, a POSITA at the time of the priority date of the '011 patent would have understood that Nishida describes varying stitch configurations to

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impart different properties to two different areas. (See cites in Direct Frederick Decl. at ¶72). In addition, it would have been obvious at the time of the priority date of the '011 patent to incorporate well knitted to the elements as disclosed by McDonald, Whiting or Tuley in different stitch configurations as disclosed by Glidden or McDonald into Nishida's upper for reasons such as those identified in KSR, 550 U.S. at 417-422. (See Frederick Decl. at ¶72). A POSITA at the time of the priority date of the '011 patent would have understood that is an obvious design choice or a selection from among a finite number of techniques to do so. (See Frederick Decl. at ¶72).

With respect to Nishida and claims 17-18, it would have been obvious at the time of the priority date of the '011 patent to incorporate the stitch configurations as disclosed by Glidden or McDonald into Nishida's upper for reasons such as those identified in KSR, 550 U.S. at 417-422. (See Frederick Decl. at ¶72).

With respect to Nishida and claim 21, see the discussion of dependent claim 3 in Section VI.A above. With respect to Nishida and claim 22, see the discussion of dependent claim 7 in Section VI.A above. With respect to Nishida and claim 23, see the discussion of dependent claim 13 in Section VI.A above.

As stated in the grounds, Glidden anticipates claims 1-7, 23. A POSITA at the time of the priority date of the '011 patent would have understood from Glidden that it describes circular knitting, a form of weft knitting, which has been used for making socks for many decades. (See cites in order, Frederick Decl. at ¶84). In addition, it would have in any

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even if not obvious at the time of the priority date of the '011 patent to incorporate weft knitted (circular) textile elements as disclosed by McDonald or Whiting into Glidden's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 84).

As stated in the grounds, Osamu, alone or in combination with other art renders claims 16-21 obvious. For example, Osamu discloses every element of independent claim 16 except that Osamu discloses using a woven textile element rather a weft knitted textile element. A POSITA at the time of the priority date of the '011 patent would have understood that woven and knitted textiles are both suitable for use in uppers and the selection of one versus the other is an obvious design choice as described by Nishida and Curley for example. (See Frederick Dec. at ¶ 91). In addition, it would have been obvious at the time of the priority date of the '011 patent to incorporate a weft knitted textile as disclosed by Nishida, Curley, Glidden, McDonald or Whiting into Osamu's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 91).

With respect to Osamu and claims 17-18, it would have been obvious at the time of the priority date of the '011 patent to incorporate the stitch configurations as disclosed by Glidden, McDonald or Nishida into Osamu's upper for reasons such as those identified in *KSR*, 550 U.S. at 417-422. (See Frederick Dec. at ¶ 91). A POSITA at the time of the priority date of the '011 patent would have understood that varying stitch configurations to

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impart different properties to two different areas is an obvious design choice or a selection from among a finite number of techniques to do so. See Frederick Dec. at ¶ 91.

With respect to Claims and claim 21, see the discussion of dependent claim 6 in Section VI.A above.

Patent Claims	Description of Prior Art
16. An article of footwear comprising:	Grounds 1-3, 7-12 **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72; Nishida at Abstract; FIG. 2. Grounds 15-17 **Glidden** discloses an article of footwear. Frederick Dec. at ¶ 84; Glidden at Title; p. 1 1:1-4. Grounds 18-19; 24; 29-35; 38 **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91; Osamu at Title; [0001]; [0007]. Grounds 1-2
an upper incorporating a weft knitted textile element, the textile element having a first area and a second area with a unitary construction;	**Nishida** discloses an upper incorporating a knit textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 72; Nishida at Abstract; 3:5-12; 3:15-26; 4:12-18; FIGS. 2-3. Grounds 3-7, 12 **Nishida + other art** Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. See McDonald at e. 1, 2:26-32; Whiting at 2:30-36; Conley at p. 7, line 32-p. 8, line 22. Ground 16 **Glidden** discloses an upper incorporating a weft knitted textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 84; Glidden at p. 1, 2:3-19; p. 1, 2:33-44; p. 1, 2:45-48; FIGS. 1, 6, 8. Grounds 16-17 **Glidden + other art** Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. See McDonald at e. 1, 2:26-32; Whiting at 2:30-36. Ground 18

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'011 Patent Claims

1. An article of footwear comprising:

an upper incorporating a textile element having a first area and a second area, the first area being formed of a first stitch configuration and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the textile element; and

Description of Prior Art

Osamu discloses an upper incorporating a textile element having first and second areas with a unitary construction. Frederick Dec. at ¶91; Osamu at [0015]; [0007]; [0009]-[0012]; claim 1; FIGS. 1-3. Osamu describes a woven textile element rather than a weft-knitted textile element.

Grounds 1B, 1D, 2A, 2B, 3B, 3D

Osamu + other art

Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. See Nishida at 1:61-62; 1:67-68; 2:42-45; 3:8-10; 3:45-52; 3:56-58; 5:53 to 6:2; 6:22-25; Curley at p. 7, lines 32-33; p. 8, lines 7-9; p. 10, lines 5-6. Additionally, Ghidini, McDonald, Whiting and Curley each discloses an upper incorporating a weft-knitted textile element. See Ghidini at p. 1, 2:45-48; FIGS. 1, 6, 8; McDonald at p. 1, 2:26-39; Whiting at 2:35-55; Curley at p. 7, line 32 p. 8, line 25.

Grounds 1-2

Nishida discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶2; Nishida at 3:15-4:18; 4:47-60; 5:41-46; 5:63-6:2; 6:4-41.

Grounds 3, 7, 12

Nishida + other art

Others incorporating different stitch configurations to impart varying properties to a textile element were well-known in the art at the time of the priority date of the '011 patent. See Ghidini at p. 1, 2:33-44. See McDonald at p. 1, 2:26-49; FIG. 1.

Grounds 10-11

Ghidini discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶4; Ghidini at p. 1, 2:33-44; FIGS. 1, 2, 6.

Ground 15

Osamu discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶91; Osamu at [0005]; [0007]; [0009]; claim 1.

Grounds 1B, 2A, 2B, 3B, 3D

Osamu + other a

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011 Patent claims

a sole structure secured to the upper;

17. The article of footwear recited in claim 16, wherein the first stitch configuration provides a substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smooth texture.

18. The article of footwear recited in claim 17, wherein the second stitch configuration forms a rib structure in the second area.

Description of Prior Art

Tippets incorporating different stitch configurations to impart varying properties to a textile element were well known in the art at the time of the priority date of the 011 patent. See Glidden at p. 1, 2:33-44; McDonald at p. 1, 2:26-43; FIG. 1; Niehuis at 3:16-26; 3:43-52; 5:41-49.

Grounds 1-3, 7, 12:

Niehuis discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 72. Niehuis at Abstract, 4:39-46; FIG. 3.

Grounds 15-17:

Glidden discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 84; Glidden at p. 2, 1:9-19; 2:5-15; 2:22-30; FIGS. 1-6.

Grounds 18-19, 24, 25, 35, 36:

Osamu discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; Osamu at [0001]; [0007]; [0013]; [0015].

Grounds 3, 10, 11, 19, 27, 32-33, 35:

Niehuis + other art

Osamu + other art

Uppers with a first stitch configuration that provides a substantially smooth texture to the first area, and a second stitch configuration that provides a texture to the second area that is rougher than the smooth texture were well known in the art at the time of the priority date of the 011 patent. See Glidden at p. 1, 2:35-44; McDonald at p. 1, 2:26-43; FIG. 1.

Grounds 15-17:

Glidden discloses that the first stitch configuration provides a substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smooth texture. Frederick Dec. at ¶ 84; Glidden at p. 1, 2:33-44; FIGS. 1, 2, 5.

Grounds 3, 10, 11, 19, 27, 32-33, 35:

Niehuis + other art

Osamu + other art

Uppers with a first stitch configuration that provides a substantially smooth texture to the first area, and a second stitch configuration that forms a rib structure were well known in the art at the time of the priority date of the 011 patent. See

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014 Patent Claims	Description of Prior Art
	Glidden at p. 1, 2:35-44, FIGS. 1, 2, 6; McDonald et al. p. 1, 2:26-49, FIG. 1 Grounds 15-17;
19. The article of footwear recited in claim 18, wherein at least one of the first stitch configuration and the second stitch configuration forms an aperture in the weft-knitted textile element.	**Glidden** discloses that the second stitch configuration forms a rib structure in the second area. Frederick Dec. at ¶ 54; Glidden, at p. 1, 2:33-44 Grounds 1-3, 7-12; **Nishida** discloses that at one stitch configuration may form a net-like structure (i.e. having apertures) in the knit textile element. Frederick Dec. at ¶ 72, Nishida at 3:43-52, 6:25-41; Grounds 15-17; **Glidden** discloses that at least one stitch configuration may have high porosity for good ventilation (i.e. apertures) in the knitted textile element. Frederick Dec. at ¶ 64; Glidden at p. 1, 1:26-30, p. 2, 2:40-63; claims 1-5 Grounds 18, 19, 24, 29, 35, 38; **Osamu** discloses at least one stitch configuration may form a weave structure with high breathability (i.e. having apertures) in the textile element. Frederick Dec. at ¶ 31; Osamu at [0026]; Grounds 1-3, 7-12;
20. The article of footwear recited in claim 19, wherein the weft-knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	**Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72, Nishida at 3:5-7, 3:66-4:5; FIG. 3. Grounds 15-17; **Glidden** discloses that the knit textile element may at least be an exterior layer of the upper (see FIG. 1) and or an interior layer of the upper. Frederick Dec. at ¶ 64, Glidden at p. 1, 2:3-23, p. 2, 1:58-74; FIGS. 1-3, 6-8 Grounds 18-19, 24, 29, 35, 38; **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 31; Osamu at [0001], [0006], [0010]; claim 1 Grounds 1-2;
21. The article of footwear recited in claim 19, wherein the upper includes an exterior layer, an intermediate layer, and an interior	**Nishida** discloses that the upper may include two or more layers and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 72, Nishida at 3:62-4:1; Grounds 4-5, 8-9, 12-13;

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'211 Patent Claims	Description of Prior Art
layer, and the knit textile element forms at least a portion of the interior layer.	**Nishida** + other art Uppers incorporating three layers wherein a knit textile element forms a portion of an inner layer and an outer layer were well known in the art at the time of the priority date of the patent. See Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. Grounds 15-17.
	Gidden discloses that the knit textile element may at least be an exterior layer of the upper, and/or an interior layer of the upper. Frederick Dec. at ¶ 4; Gidden at p. 1, 2:3-22; p. 2, l. 9-19; p. 2, l. 66-74; FIGS. 1-2. Ground 13.
	Osanai discloses that the upper may include two or more layers and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 91; Osanai at [0001], [0005], [0008], [0010]; claim 1. Grounds 20-21, 23-25, 30-31, 36-38.
	Osanai + other art Uppers incorporating three layers wherein a knit textile element forms a portion of an inner layer and an outer layer were well-known in the art at the time of the priority date of the '211 patent. See Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. Grounds 1-2.
22. The article of footwear recited in claim 16, wherein the textile layer forms at least a portion of both the interior surface and an exterior surface of the upper.	**Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; Nishida at 3:3-4:35; FIG. 2. Grounds 4-6, 8-10, 12-14. **Nishida** + other art Uppers having a knit textile element that forms a portion of an interior surface and an exterior surface were well-known in the art at the time of the priority date of the '211 patent. See Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45; Gidden at FIGS. 1-2; p. 1, 2:3-32. Grounds 15-17.
	Gidden discloses that the knit textile element forms at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 84; Gidden at p. 1, 2:3-23; p. 2, l. 66-74; FIGS. 1-3, 6-8.

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011 Patent Claims	Description of Prior Art
	Grounds 18-19, 24, 29, 35, 38 **Osamu** discloses that the textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 91; Osamu at [0091], [0095], [0010], claim 1.
28. The article of footwear recited in claim 16, wherein the weft-knitted textile element forms an interior surface of the upper.	Grounds 1-2, 7 **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; Nishida at 3:6-40. Grounds 4-6, 8-10, 12-14 **Nishida** + other art Uppers incorporating knit textile elements that form an interior surface of the upper were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 8 lines 16-32, p. 10 claim; Shanmuta at 2:56-65; Gladden at FIGS. 1-2 ¶ 1, 2, 9, 32. Grounds 15-17 **Gladden** discloses that the knit textile element forms an interior surface of the upper. Frederick Dec. at ¶ 84; Gladden at p. 1 2:3-23, p. 2 1:68-74, FIGS. 1-6, 6-3. Grounds 18-19, 24, 29, 35, 38 **Osamu** discloses that the knit textile element forms an interior surface of the upper. Frederick Dec. at ¶ 91; Osamu at [0004], [0016], [0010], claim 1.

C. "Textile Element Having A First Area With A First Unitary Construction And A Second Area With A Second Unitary Construction Different From The First Unitary Construction" In Claims 44-46

The specification states that "[m]any conventional articles of footwear incorporate uppers with various material elements that each exhibit different properties. For example, a first material element may be smooth, and a second material element may be textured. The first and second material elements are then situated together to form a portion of the conventional upper. Textile element 40 also exhibits smooth and textured

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areas. In contrast with the conventional upper, however, *first texture 46 and second texture 48 are incorporated into a single unitary element of textile rather than two separate elements that are stitched or otherwise affixed together.*" (011 patent (Ex. 1002) 25:35 (emphasis added)).

As discussed above, the Applicants amended independent claim 44 to require "the [at least] knitted textile element having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction." (011 file history (Ex. 1003) at 01/12/2007 Response p. 8).

The Applicants relied on this element as the sole basis for distinguishing claim 44 over U.S. Patent No. 6,349,438 to Thorneburg ("Thorneburg"). (011 file history (Ex. 1003) at 01/12/2007 Response p. 10). The Applicants relied on language from the original claim stating that U.S. Patent No. 1,988,172 to Jobe ("Jobe") does not have a first area having a first set of properties and a second area having a second set of properties that is different from the first set of properties" as the sole basis for distinguishing claim 44 over Jobe. (*Id.*) Because the next action from the PTO was a Notice of Allowance, the Examiner appears to have relied on this ground as the reason for allowance of claim 44 over Thorneburg.

At several prior art references which were not before the Examiner or were not applied by the Examiner for the feature during prosecution teach textile elements having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction as required by claim 44.

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example, Nishida and Osamu each discuss textile elements having a unitary construction with two areas, each area having a different construction. (Frederick, ¶¶ [Ex. 1001], 2, 11).

As demonstrated by the various references that either were not before the Examiner or were not applied by the Examiner for this feature during prosecution of the '011 patent, the use of textile elements with a unitary construction with a first area and a second area with a different construction from the first area, as well as flat knitted textile elements having a first area having a first set of properties and a second area having a second set of properties that is different from the first set of properties, were well known in the art at the time of the priority date of the '011 patent.

As set forth in the claim charts below, Nishida and Osamu anticipate or, at the very least, render obvious claims 4-4, 6 of the '011 patent, alone or in combination with other prior art. Specifically, ground 1 sets forth that these claims are anticipated by Nishida, as further referenced in the charts below. Furthermore, the '011 patent claims merely recite the combination of "prior art elements according to known methods to yield predictable results" and/or the "use of known technique[s] to improve similar devices (methods, or products) in the same way." See, PEP, 2143 (I). For example, a person of ordinary skill in the art would have understood that using flat knitted textile elements having a unitary construction with a first area construction different from a second area construction, as well as flat knitted textile elements having a first area having a first set of properties and a

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