

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKECHERS U.S.A., INC.,
Petitioner,

v.

NIKE, INC.,
Patent Owner.

IPR2025-00143
Patent 9,986,781 B2

Before KEN B. BARRETT, MICHAEL J. FITZPATRICK, and MATTHEW
S. MEYERS, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Skechers U.S.A., Inc., filed a Petition to institute an *inter partes* review of all claims, namely claims 1–20, of U.S. Patent No. 9,986,781 B2 (“the ’781 patent,” Ex. 1001) pursuant to 35 U.S.C. § 311(a). Paper 1 (“Pet.”). Patent Owner, Nike, Inc., filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 8 (“Prelim. Resp.”). With our authorization (*see* Ex. 3001), Petitioner filed a Preliminary Reply, and Patent Owner filed a Preliminary Sur-reply. Paper 8 (“Prelim. Reply”); Paper 9 (“Prelim. Sur-reply”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). For the reasons explained below, we determine there is not a reasonable likelihood that Petitioner would prevail with respect to any claim. *See* 35 U.S.C. § 314(a). Accordingly, we deny the Petition.

A. *Real Parties In Interest*

Each party identifies itself alone as the real party in interest. Pet. 112; Paper 3, 2.

B. *Related Matters*

Both parties identify the same sole related matter: *Nike, Inc. v. Skechers U.S.A., Inc.*, No. 2:23-cv-09346-AB-PVC (C.D. Cal.) (“the related lawsuit”). Pet. 112; Paper 3, 2.

C. *The ’781 Patent*

The ’781 patent was filed May 31, 2017, but claims priority from numerous ancestor applications, the first of which was filed on March 3, 2004. Ex. 1001,

code (60), 1:8–28.¹ Patent Owner asserts that the claims of the '781 patent have an effective filing date of March 3, 2004. Prelim. Resp. 5. The Petition is silent as to the effective filing date but implicitly assumes it is March 3, 2004, by virtue of defining the level of skill in the art as of that date. Pet. 36.

The '781 patent is titled “Article of Footwear Having A Textile Upper.” Ex. 1001, code (54). Figure 1 is reproduced below.

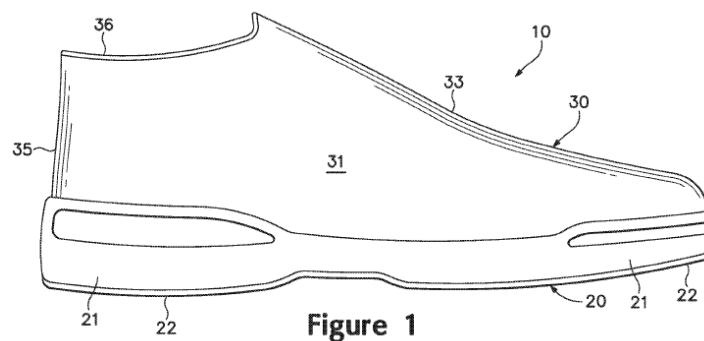


Figure 1 shows “[t]he primary elements of footwear,” namely “a sole structure 20 and an upper 30.” Ex. 1001, 4:62–63. The sole structure “is secured to a lower portion of” the upper and “provides a durable, wear-resistant component that imparts cushioning as footwear 10 impacts the ground.” *Id.* at 4:63–66. The upper “is at least partially formed from a textile element 40 that defines an interior void for comfortably receiving a foot and securing a position of the foot relative to sole structure 20.” *Id.* at 4:66–5:2.

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, which was enacted September 16, 2011, made amendments to 35 U.S.C. §§ 102 and 103. AIA § 3(b)–(c). Those amendments became effective eighteen months later on March 16, 2013. *Id.* at § 3(n). Because the application from which the '781 patent issued claims priority to an application filed before March 16, 2013, any citations herein to 35 U.S.C. §§ 102 and 103 are to their pre-AIA versions. *Id.* at § 3(n)(1).

Figure 8 is reproduced below.

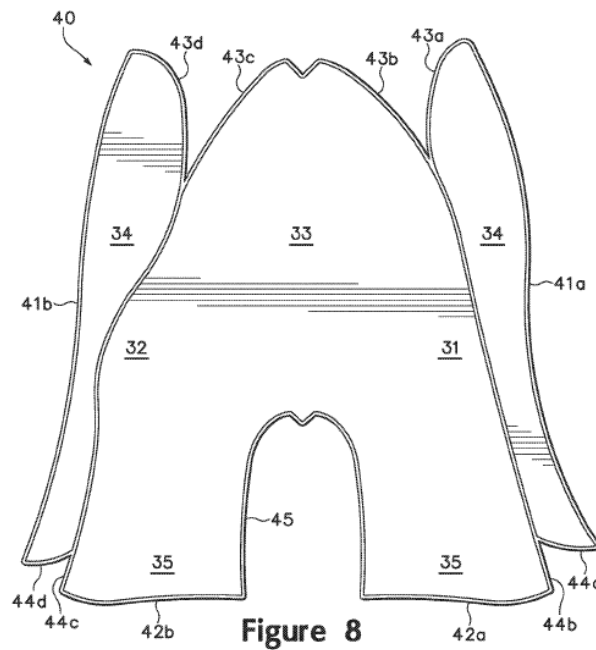


Figure 8 shows textile element 40 prior to its configuration into upper 30, as shown in Figure 1. *Id.* at 6:13–14; *see also id.* at Figs. 2–7 (depicting upper 30 formed from textile element 40). As shown in Figure 8, textile element 40 has “a generally smooth, non-varied stitch configuration,” as “similar stitches are utilized throughout textile element 40 to impart a common texture to the various portions of textile element.” *Id.* at 9:24–26.

Figure 10 is reproduced below.

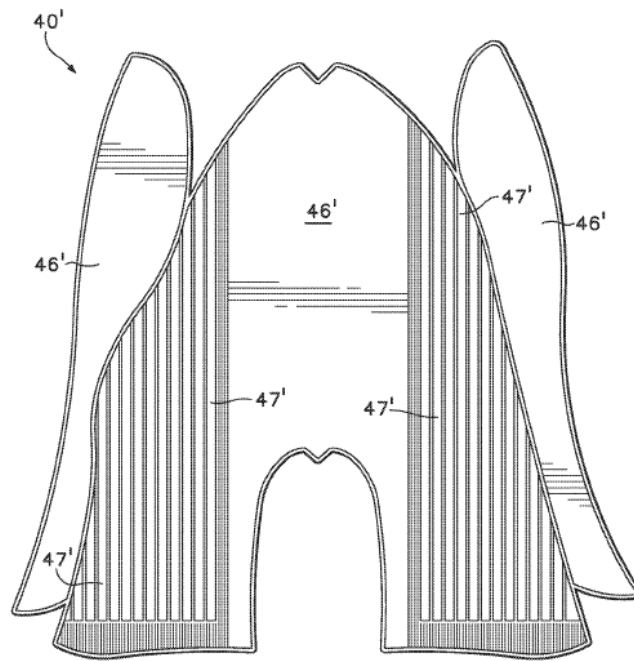


Figure 10

Figure 10 shows “a textile element 40' with the general shape of textile element 40” but “having various areas with different textures.” *Id.* at 9:34–36. More specifically, the textile element of Figure 10 includes a first texture 46' that “is generally smooth” and a second texture 47' that “is a plurality of longitudinal ribs.” *Id.* at 9:36–40. The '781 patent explains:

When incorporated into footwear 10, the ribs will extend longitudinally along lateral region 31 and medial region 32, and the ribs may extend into heel region 35. The ribs may be present for aesthetic purposes, or may affect the stretch properties of upper 20, for example. Accordingly, textile element 40' exhibits areas with different textures in a single element of textile material.

Id. at 9:40–46.

D. The Challenged Claims

Review is sought for all of the claims of the '781 patent, namely claims 1–20. Claims 1 and 12 are the independent claims. They are reproduced below:

1. An upper for an article of footwear, the upper comprising:

a flat knit textile element having: (1) flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed, and (2) a plurality of ribs integrally knitted into the flat knit textile element,

wherein one or more ribs extend longitudinally along one or more of a lateral side and a medial side of the upper, the one or more ribs extending from the forefoot region toward the heel region and terminating in one of the midfoot region or the heel region.

12. An article of footwear comprising:
an upper comprising:

a flat knit textile element having: (1) flat knit edges free of surrounding textile structure such that the flat knit edges are not surrounded by textile structure from which the textile element must be removed, and (2) a plurality of ribs integrally knitted into the flat knit textile element,

wherein the plurality of ribs include one or more ribs extending longitudinally along a lateral side and one or more ribs extending longitudinally along a medial side of the upper, wherein the one or more ribs on the lateral side and the one or more ribs on the medial side extend from the forefoot region toward the heel region and terminate in one of the midfoot region or the heel region.

Ex. 1001, 12:8–20, 12:49–64.

C. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–20	103(a)	Cusinato, ² Bellak, ³ Dua, ⁴ and Spencer ⁵
1–20	103(a)	Herbert, ⁶ Cusinato, Hlavacs, ⁷ and Spencer

Pet. 35.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere of Kan. City*, 383 U.S. 1, 17 (1966). “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). It is also whose vantage point from which the meaning of the claims is assessed. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary

² EP 1,338,690 A1, published Aug. 27, 2003 (“Cusinato,” Ex. 1014).

³ US 1,841,518, issued Jan. 19, 1932 (“Bellak,” Ex. 1015).

⁴ US 6,910,288 B2, issued June 28, 2005 (“Dua,” Ex. 1017).

⁵ David J. Spencer, *Knitting Technology: A Comprehensive Handbook And Practical Guide* (3rd ed.) (2001) (“Spencer,” Ex. 1050).

⁶ US 2,400,692, issued May 21, 1946 (“Herbert,” Ex. 1016).

⁷ US D461,951 S, issued Aug. 27, 2002 (“Hlavacs,” Ex. 1018).

meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal quotation marks omitted).

As to this hypothetical construct, Petitioner proposes the following:

A person of ordinary skill in the art (“POSITA”) in the field of the '781 [patent] in March 2004 would have been someone with at least a few years of experience in knit materials and knitting methods and machines that can be used in making footwear, or a bachelor’s degree in textile-related sciences, engineering, or industrial product design, or equivalent academic or work experience, including in the footwear industry. *See* EX1002, ¶78. Such a person of ordinary skill would have at least a general understanding of general construction processes and materials used in the manufacturing process of fabric-based articles. *Id.* For individuals with a lower educational level, a person could still be of ordinary skill in the art provided that person’s working experience compensates for any such lower educational level, or vice versa. *Id.*

Pet. 36. Patent Owner does not oppose Petitioner’s proposal. Prelim. Resp. 14–15. Thus, for purposes of deciding the Petition, we adopt Petitioner’s proposal.

A. Claim Construction

The challenged claims should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See Translogic Tech.*, 504 F.3d at 1257 (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal quotation marks omitted); *see also* 37 C.F.R. § 42.100(b) (stating that claims are construed in IPRs according to the same standard as used in federal court).

The parties proffer express constructions for multiple terms. *See* Pet. 36–41; Prelim. Resp. 15–21. However, for purposes of this Decision, we need only address the construction of “article of footwear.”

Petitioner proposes that “article of footwear” means “any foot covering in the form of shoes, boots, slippers, or hose (e.g., socks) used for utility and/or dress wear.” Pet. 37. Petitioner’s primary support for its construction is *The Complete Footwear Dictionary*, which provides almost verbatim support for it. *Id.* (citing Ex. 1022, 67, 88). There is no dispute that the cited *extrinsic* evidence supports Petitioner’s construction. However, *intrinsic* evidence is more probative of the meaning of the claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (“[W]hile extrinsic evidence can shed useful light on the relevant art, we have explained that it is less significant than the intrinsic record in determining the legally operative meaning of claim language.” (quotation marks and citations omitted), 1318 (“We have viewed extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms.”), *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996) (“Only if there were still some genuine ambiguity in the claims, after consideration of all available intrinsic evidence, should the trial court have resorted to extrinsic evidence, such as expert testimony, in order to construe claim 1.”). Moreover, not all intrinsic evidence is the same; the Specification is paramount. *See Phillips*, 415 F.3d at 1315 (“[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” (internal quotation marks and citation omitted), 1317 (“[B]ecause the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final

product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes.”).

Patent Owner disputes that an “article of footwear” as used in the claims of the ’781 patent encompasses hosiery, stockings, or socks. Instead, Patent Owner argues, an “article of footwear” must have an upper and a sole structure. Prelim. Resp. 16. Patent Owner supports its position by citing to the Specification and to its declarant’s interpretation of how the Specification would be interpreted by one of ordinary skill. *Id.* at 15–19 (citing Ex. 1001; Ex. 2001⁸).

As for the Specification, Patent Owner cites its statement that “[c]onventional articles of athletic footwear include two primary elements, an upper and a sole structure.” Ex. 1001, 1:3940 (cited at Prelim. Resp. 16). Patent Owner also cites its statement that “[t]he primary elements of footwear 10 are depicted in FIG. 1 as being a sole structure 20 and an upper 30.” Ex. 1001, 4:62–63 (cited at Prelim. Resp. 16). Additionally, Patent Owner points out (correctly) that every figure of the ’781 patent “depict[s] shoes[] or textile elements that are designed to be incorporated into shoes.” Prelim. Resp. 16. Finally, Patent Owner points to surrounding claim language in both of independent claims 1 and 12 that supports its construction. With respect to claim 1, Patent Owner points out that it “recite[s] an ‘upper’ that is ‘for an article of footwear.’” *Id.* (quoting claim 1). With respect to claim 12, Patent Owner points out that it “recite[s] . . . an ‘article of footwear comprising’ an ‘upper.’” *Id.* (quoting claim 12). We agree that the Specification supports Patent Owner’s construction.

Although Petitioner bases its construction on extrinsic evidence, Petitioner argues that its construction “is consistent with” the intrinsic evidence, which,

⁸ Exhibit 2001 is a declaration by Christopher M. Pastore, Ph.D.

according to Petitioner, “indicates a sole is optional.” Pet. 37. A sole is optional, Petitioner argues, because the Abstract of the ’781 patent states that “[t]he footwear *may* include an upper and a sole structure.” Pet. 37 (quoting Ex. 1001, Abstr. (Petitioner’s emphasis)). We are not persuaded. Petitioner reads too much into the sentence it quotes from the Abstract and its use of the word “may.” Indeed, by Petitioner’s logic, both the upper and the sole structure would be optional and footwear would lack any required structure.

Petitioner also argues that the doctrine of claim differentiation supports its construction, pointing to claim 20’s dependence from claim 12. Pet. 37 (citing *Phillips*, 415 F.3d at 1314–15). Petitioner has a point here. Claim 20 recites: “The *article of footwear* of claim 12 *further comprising a sole structure* secured to the upper.” Ex. 1001, 13:22–23 (emphasis added). Under *Phillips*, “the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.” 415 F.3d at 1314–15. However, the impact of this argument is somewhat muted by the fact that claim 12 clearly is focused on the upper. It recites “an article of footwear comprising: an upper comprising:” with the remainder of the claim specifying limitations of the recited upper.

Additionally, Patent Owner counters with another canon of claim construction, that all terms of a claim preferably should carry meaning. *See* Prelim. Resp. 16 (quoting *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005): “A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”). In that regard, Patent Owner argues that Petitioner’s construction of “article of footwear” to include a sock would render meaningless the term “upper,” which is also recited in independent claims 1 and 12. This is true. Under Petitioner’s proposal, claim 1

would encompass an upper for a sock and claim 12 would encompass a sock comprising an upper, and neither would make sense.

Patent Owner also proffers testimony from Dr. Pastore that a person of ordinary skill in the art would have understood an “article of footwear,” as used in the claims of the ’781 patent, to mean “an upper and a sole structure, and to exclude hose, hosiery, stockings, socks, and the like.” Ex. 2001 ¶32. In support of his opinion, Dr. Pastore cites to the Specification and also relies on his “professional understanding of how ‘article of footwear’ is used in the art.” *Id.* ¶¶32–33. In addition, Dr. Pastore explains that “the term ‘upper’ takes its meaning from the context of being one of the primary elements of a shoe. . . . In other words, ‘upper’ has a specialized meaning as a component of footwear, and derives that meaning in part from its relationship to the sole structure component.” *Id.* ¶33. Dr. Pastore’s testimony is consistent with the Specification.

Lastly, we consider Petitioner’s argument that “other intrinsic evidence” supports its construction. Pet. 37 (citing Ex. 1053). The alleged intrinsic evidence, however, is an unrelated patent, US 2,675,631, which purportedly was cited during the prosecution of the ’781 patent. Pet. 37. This argument is undeveloped by Petitioner. First, Petitioner fails to substantiate that US 2,675,631 is cited in the prosecution history, merely asserting it as fact without pointing to supporting evidence. *See* Pet. 37 (no citation to the prosecution history provided). Further, even assuming US 2,675,631 is cited in the prosecution history of the ’781 patent and thus part of the intrinsic evidence,⁹ Petitioner fails to show that it

⁹ The Federal Circuit has held that “[t]he prosecution history, which we have designated as part of the ‘intrinsic evidence,’ consists of the complete record of the proceedings before the PTO *and includes the prior art cited during the examination of the patent.*” *Phillips*, 415 F.3d at 1317 (emphasis added).

is probative of what *the inventors of the '781 patent* meant by “article of footwear.” Pet. 37. Petitioner points out that the inventor of US 2,675,631 considers “knitted footwear” as encompassing “hose, golf hose, three-quarter hose, half-hose and socks” but does not explain why such meaning should be incorporated into the '781 patent. Ex. 1053, 4:55–58 (partly quoted at Pet. 37). US 2,675,631 is titled “Footwear Article of The Slipper-Sock Type.” Ex. 1053, Title. As is evidently clear from the specifications of both patents, the '781 patent and US 2,675,631 are directed to different types of footwear within the broader (dictionary) definition cited by Petitioner. Ex. 1022, 67, 88.

In sum, an overwhelming majority of the intrinsic evidence supports Patent Owner’s construction. That evidence includes textual excerpts from the Specification, its figures, and surrounding claim language. This intrinsic evidence is further supported by Dr. Pastore’s opinion of how a person of ordinary skill in the art “reading the claims in light of the '781 Patent specification in 2004 would have understood the ordinary and customary meaning of an ‘article of footwear.’” Ex. 2001 ¶32.

B. Obviousness Generally

A claim is unpatentable “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). “Obviousness is a question of law based on underlying facts.” *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1167 (Fed. Cir. 2015). The underlying facts include (i) the scope and content of the prior art, (ii) the differences between the prior art and the claimed invention, (iii) the level of ordinary skill in the field of

the invention, and (iv) any relevant objective considerations of nonobviousness. *Id.* (citing *Graham*, 383 U.S. at 17–18). An additional underlying fact is whether there was a reason to combine prior art teachings when so asserted. *Id.*; *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–19 (2007) (“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”).

C. Ground 1 (Cusinato, Bellak, Dua, and Spencer)

The Petition asserts that claims 1–20 would have been obvious over Cusinato, Bellak, Dua, and Spencer. Pet. 41–87.

1. Independent Claims 1 and 12

Claim 1 is directed to “[a]n upper for an article of footwear, the upper comprising” certain features. Claim 12 is directed to “[a]n article of footwear comprising: an upper comprising” certain features. Petitioner does not have a reasonable likelihood of prevailing with respect to either of claims 1 and 12 because, as explained below, the Petition fails to show how the prior art teaches, or renders obvious, an upper for an article of footwear.

A claim’s preamble is not necessarily limiting. *See, e.g., Pitney Bowes Inc. v. Hewlett Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). The Petition does not take a position as to whether the preambles of claims 1 and 12 are limiting. *See* Pet. 53 (“If the preamble [of claim 1] is limiting, Cusinato, Bellak, and Dua each disclose an upper for an article of footwear.”), 85 (claim 12 analysis referring back to claim 1 analysis).

We construe the preambles of claims 1 and 12 to be limiting, as guided by case law. It is clear that the preambles are being used to help define the invention, i.e., an upper for an article of footwear in the case of claim 1 and an article of footwear having an upper in the case of claim 12. *See Bell Communications Research Inc. v. Vitalink Commcations Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995) (“[A] claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.”). Moreover, the bodies of both claims recite “the upper” which, in the case of claim 1, derives its antecedent basis directly from the preamble and, in the case of claim 12, relies on the preamble’s article of footwear which is recited as comprising an upper. *See Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (“When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.”).

Petitioner purports to map the asserted prior art to the preambles of claims 1 and 12 in two ways. Pet. 53.

The first way is not persuasive because it is premised on Petitioner’s construction of an “article of footwear,” as encompassing “any foot covering in the form of shoes, boots, slippers, or hose (e.g., socks) used for utility and/or dress wear.” Pet. 37. For example, with respect to Cusinato, Petitioner argues that it discloses an upper for an article of footwear in the form of “‘a fabric . . . [that] directly forms the stocking or *footwear*’ having a ‘*boot*-like shape.’” *Id.* at 53 (quoting Ex. 1014 ¶¶10, 13 (all emphasis and modifications being Petitioner’s)). Similarly, with respect to Bellak, Petitioner argues that it discloses an upper for an

article of footwear in the form of “a ‘*foot covering*’ in the form of a knitted ‘*slipper*.’” *Id.* (quoting Ex. 1015, 1:14–26 (all emphasis and modifications being Petitioner’s)). As discussed above, we reject Petitioner’s construction of “article of footwear.” Thus, Petitioner’s first way of mapping the preambles of claims 1 and 12 to either of Cusinato and Bellak is not persuasive.

Petitioner’s second way of mapping the preambles to the asserted prior art references is based on a modification to either of Cusinato or Bellak in view of Dua. In Petitioner’s words: “If . . . ‘footwear’ must include a sole, a sole is disclosed in Dua, and a POSITA would consider it obvious to add a sole to Cusinato’s ‘*boot-like*’ form or Bellak’s ‘*slipper*.’” Pet. 53 (citing Ex. 1017, 4:17–37; Ex. 1002 ¶¶164–170).

Dua clearly teaches a sole, as well as an entire shoe. *See* Ex. 1017, 2:38–39 (“The present invention is an article of footwear having a sole structure and an upper secured to the sole structure.”). However, the Petition does not explain why a person of ordinary skill in the art would have added a sole to either of Cusinato or Bellak. It simply asserts as much in conclusory fashion. *See* Pet. 53 (asserting “a POSITA would consider it obvious to add a sole to Cusinato’s ‘boot-like’ form or Bellak’s ‘slipper’”).

Further, the cited declaration testimony, i.e., paragraphs 164 through 170 of Dr. Adanur’s declaration, does not add much. Paragraph 164 is premised on Petitioner’s claim construction of “article of footwear,” which we have rejected. Ex. 1002 ¶164. Paragraphs 165 and 166 identify the structures from Cusinato and Bellak, respectively, to which Petitioner proposes adding a sole structure. *Id.* ¶¶165–166. Paragraph 167 states (correctly) that “Dua discloses a shoe, including an upper.” *Id.* ¶167. Paragraph 168 states (correctly) that “Dua discloses a sole structure.” *Id.* ¶168. Of the cited paragraphs, *only* paragraph 169 purports to

offer a reason for the modification, namely “because adding a sole structure would provide, for example, cushioning, support, and traction.” *Id.* ¶169 (citing Ex. 1017, 4:17–37)). Finally, paragraph 170 simply concludes: “Therefore, Cusinato in view of Bellak and Dua satisfies Element 1[pre].” *Id.* ¶170.

Patent Owner responds that Dr. Adanur’s reason for adding a sole to Cusinato and Bellak is not supported by the prior art teaching he identifies. Prelim. Resp. 43. The teaching Dr. Adanur identifies comes from Dua and states the following:

Sole structure 110 has a conventional configuration that includes an insole (not depicted), a midsole 111, and an outsole 112. The insole is a relatively thin, cushioning member located within upper 120 and adjacent to the foot for enhancing the comfort of footwear 100. Midsole 111 is attached to a lower portion of upper 120 and is formed of a cushioning foam material, such as ethylvinylacetate or polyurethane. Accordingly, midsole 111 attenuates ground reaction forces and absorbs energy associated with running or walking. To enhance the force attenuation and energy absorption characteristics of sole structure 110, midsole 111 may incorporate a fluid-filled bladder, as disclosed in U.S. Pat. Nos. 4,183,156 and 4,219,945 to Rudy. Alternately, midsole 111 may incorporate a plurality of columnar support elements, as disclosed in U.S. Pat. Nos. 5,353,523 and 5,343,639 to Kilgore et al. outsole 112, which may be formed from carbon black rubber compound, is attached to a lower surface of midsole 111 to provide a durable, wear resistant surface for engaging the ground. In addition, out sole 112 may incorporate a textured lower surface to enhance the traction characteristics of footwear 100.

Ex. 1017, 4:17–37 (cited at Pet. 53; cited at Ex. 1002 ¶169). This excerpt from Dua clearly discloses certain benefits of a sole structure. Patent Owner does not dispute this. Prelim. Resp. 43–44.

However, Patent Owner argues that Dua’s teaching regarding the benefits of a sole structure is in the context of shoes, and Petitioner never explains why a person of ordinary skill in the art “would supposedly be motivated to modify a

‘stocking’ or ‘slipper’ to transform them into shoes.” Prelim. Resp. 43–44. As Patent Owner furthers explains:

For Ground 1, Skechers’ expert Dr. Adanur offers only one opinion: that a POSITA allegedly would “add a sole” to Cusinato’s stocking or Bellak’s slipper, because “a sole structure would provide, for example, cushioning, support, and traction.” Paper 1, at 53 (citing Ex. 1002, at ¶170). But that’s a conclusory tautology, not a rationale—stockings and slippers have unique properties and purposes, as do shoes, and opining that a POSITA would transform a sock into a shoe, in order to obtain benefits *that a shoe already has*, is not an obviousness rationale.

Id. at 3–4. Patent Owner is correct. Petitioner has identified benefits that a sole structure provides to shoes but has not explained why a person of ordinary skill in the art allegedly would seek to add a sole to either of the structures Petitioner identifies in Cusinato and Bellak.

For this reason, the Petition fails to demonstrate that the asserted prior art teaches, or renders obvious, the subject matter of claims 1 and 12. Thus, there is not a reasonable likelihood of Petitioner prevailing as to either of the independent claims.

2. Dependent Claims

The remaining claims, namely claims 2–11 and 13–20, all ultimately depend from either claim 1 or claim 12. Thus, there is not a reasonable likelihood of Petitioner prevailing as to any of the dependent claims. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”).

D. Ground 2 (Herbert, Cusinato, Hlavacs, and Spencer)

The Petition asserts that claims 1–20 would have been obvious over Herbert, Cusinato, Hlavacs, and Spencer. Pet. 87–112.

1. Independent Claims 1 and 12

Petitioner does not have a reasonable likelihood of prevailing with respect to either of claims 1 and 12 because, as explained below, the Petition fails to show how the prior art teaches, or renders obvious, an upper for an article of footwear.

As with Ground 1, here again, Petitioner purports to map the asserted prior art to the preambles of claims 1 and 12 in two ways. Pet. 93–94.

The first way is not persuasive because it is premised on Petitioner’s erroneous construction of an “article of footwear” and also on a misreading of the cited prior art teachings.

With respect to Herbert, Petitioner argues that it discloses an upper for an article of footwear in the form of “a ‘*slipper*’ foot covering,’ including a ‘*sole*’.” Pet. 93 (quoting Ex. 1016, 1:48, 2:17). Petitioner overstates what Herbert teaches. Herbert discloses a “foot covering” that is essentially a low-cut sock or hose and which is designed to be worn in between a person’s foot and a shoe or slipper. *See, e.g.*, Ex. 1016, 1:3–6 (“This invention relates to knitted foot coverings and more particularly to the slipper type of knitted foot covering adapted to be worn inside a low cut ladies’ shoe or slipper.”). The “sole” that Petitioner quotes is actually just a bottom portion of the foot covering. *See id.* at 2: (referring to “the bottom or sole portion 19 of the slipper foot covering.”). Petitioner fails to show that Herbert’s foot covering includes a sole structure.

With respect to Cusinato, Petitioner argues that it discloses an upper for an article of footwear in the form of “‘stocking or *footwear*,’ specifically a ‘*boot*.’”

Pet. 53 (quoting Ex. 1014 ¶¶10, 13). As with Herbert, Petitioner overstates what the cited teachings of Cusinato disclose. Paragraph 13 does not mention “boot” at all. Ex. 1014 ¶13. Paragraph 10 does mention “boot” but only in the following manner: “[I]n order that the stocking or footwear perfectly takes the three-dimensional shape, it is necessary to carry out an operation of stretching which makes it possible to obtain in a definitive and uniform way a boot-like shape.” *Id.* ¶10. Thus, paragraph 10 uses the word “boot” to describe the shape of the “stocking or footwear.” *Id.* Petitioner fails to show that Cusinato discloses an actual boot.

As discussed above, Petitioner must identify, in the prior art, an upper that is for an article of footwear, which we have construed to require both an upper and a sole structure (e.g., a shoe). We recognize that Petitioner has identified the word “sole” used in Herbert and the word “boot” used in Cusinato (*see* Pet. 93–94), but the references’ use of those words, when read in their proper context, are insufficient to demonstrate that either reference discloses an article of footwear within the meaning of the challenged claims. Thus, Petitioner’s first way of mapping the preambles of claims 1 and 12 to either of Herbert and Cusinato is not persuasive.

Petitioner’s second way of mapping the preambles to the asserted prior art references is based on a modification to either of Herbert or Cusinato. In Petitioner’s words: “If Patentee were to argue that Herbert or Cusinato do not disclose a sole, which is contrary to their disclosures and not required by the term ‘footwear,’ a POSITA would consider it obvious to add a discrete sole to the ‘*slipper*’ in Herbert or the ‘*boot-like*’ form in Cusinato.” Pet. 94 (citing Ex. 1002, ¶¶286–88). However, the Petition does not offer any reason, let alone a sufficient

reason, why a person of ordinary skill in the art would have added a sole to either of Herbert or Cusinato. *Id.*

Further, the cited declaration testimony, i.e., paragraphs 286 through 288 of Dr. Adanur's declaration, is woefully insufficient. In paragraph 286, Dr. Adanur states his disagreement with prospective arguments he anticipates from Patent Owner and summarily asserts that "it would be obvious to add a discrete sole to Herbert's 'slipper' or Cusinato's 'boot-like' form." Ex. 1002 ¶286. Dr. Adanur provides no reason to supports his assertion of obviousness. *Id.* In paragraph 287, Dr. Adanur states that Hlavacs discloses a sole, which Patent Owner does not dispute. *Id.* ¶287; *see also* Ex. 1018, Figs. 1–5 (illustrating various views of a shoe including a sole). In paragraph 288, Dr. Adanur summarily concludes: "Therefore, Herbert in view of Cusinato and/or Hlavacs satisfies Element 1[pre]." *Id.* ¶288. Thus, Dr. Adanur likewise fails to offer any reason why a person of ordinary skill in the art would have added a sole to either of Herbert or Cusinato.

We have considered the declaration testimony Petitioner cites, but we find it unpersuasive to render obvious the proposed modification(s). In fact, Dr. Adanur's declaration testimony muddies what the proposed modification(s) is/are. In the Petition, Petitioner asserts alternative modifications of either Herbert or Cusinato. *See* Pet. 94 (asserting "a POSITA would consider it obvious to add a discrete sole to the '*slipper*' in Herbert or the '*boot-like*' form in Cusinato."). However, based on the syntax he employs, Dr. Adanur appears to suggest a modification of only Herbert. *See* Ex. 1002 ¶288 ("Therefore, Herbert in view of Cusinato and/or Hlavacs satisfies Element 1[pre].").

In any event, the Petition fails to demonstrate that the asserted prior art teaches, or renders obvious, the subject matter of claims 1 and 12. Thus, there is

not a reasonable likelihood of Petitioner prevailing as to either of the independent claims.

2. Dependent Claims

The remaining claims, namely claims 2–11 and 13–20, all ultimately depend from either claim 1 or claim 12. Thus, there is not a reasonable likelihood of Petitioner prevailing as to any of the dependent claims. *In re Fine*, 837 F.2d at 1076.

III. CONCLUSION

The Petition fails to show there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. Accordingly, we deny the Petition.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied, and no trial is instituted.

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