

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NIKE, INC.,
Patent Owner.

IPR2025-00144
Patent 9,918,511 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. 9,918,511 B2 (“the ’511 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 6 (“Prelim. Resp.”). With our authorization (*see* Ex. 2003), Petitioner filed a Preliminary Reply, and Patent Owner filed a Preliminary Sur-reply. Paper 7 (“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. 128; Paper 3, 2.

B. *Related Matters*

Both parties identify the following related matters: *Nike, Inc. v. Skechers U.S.A., Inc.*, No. 2:23-cv-09346 (C.D. Cal.) and *Nike, Inc. v. New Balance Athletics, Inc.*, No. 1:23-cv-12666 (D. Mass.) (“the related lawsuits”). Pet. 128; Paper 3, 2.

C. The '511 Patent

The '511 patent was filed July 31, 2017, but claims priority from numerous ancestor applications, the first of which was filed on March 3, 2004. Ex. 1001, code (60), 1:7–29.¹ Patent Owner asserts that the claims of the '511 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. 30.

The '511 patent is titled “Article of Footwear Having A Textile Upper.” Ex. 1001, code (54). Figure 1 is reproduced below.

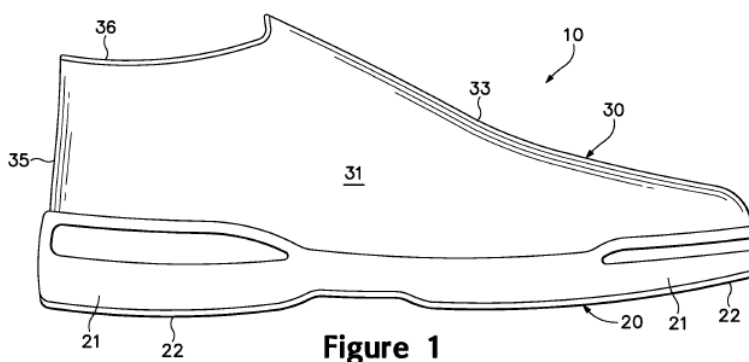


Figure 1 shows “[t]he primary elements of footwear,” namely “a sole structure 20 and an upper 30.” Ex. 1001, 4:63–64. The sole structure “is secured to a lower portion of” the upper and “provides a durable, wear-

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 ’511 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).

resistant component that imparts cushioning as footwear 10 impacts the ground.” *Id.* at 4:64–66. 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 4:66–5:3.

Figure 8 is reproduced below.

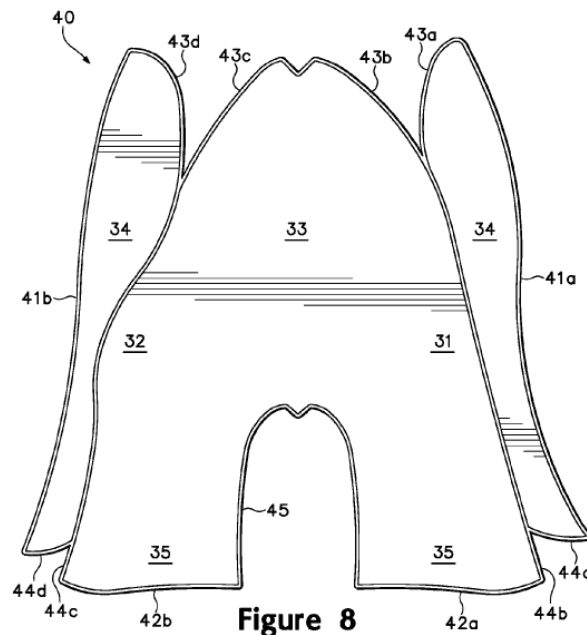


Figure 8 shows textile element 40 prior to its configuration into upper 30, as shown in Figure 1. *Id.* at 6:14–15; *see also id.* at Figs. 2–7 (depicting upper 30 formed from textile element 40). As shown in Figure 8, textile element 40 has “a generally smooth, non-varied stitch configuration,” as “similar stitches are utilized throughout textile element 40 to impart a common texture to the various portions of textile element.” *Id.* at 9:23–26.

Figure 10 is reproduced below.

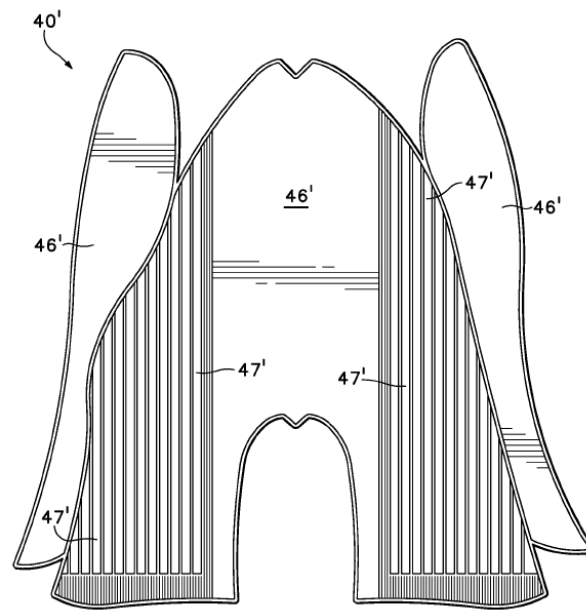


Figure 10

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 9:37–40. The '511 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 '511 patent, namely claims 1–20. Claims 1 and 15 are the independent claims. They are reproduced below:

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

a flat knit textile element comprising (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, at least one flat knit edge being a curved flat knit edge, and (2) a first knit strip having a first property and a second knit strip having a second property that is different from the first property;

wherein the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper.

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

a flat knit textile element comprising (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, at least one flat knit edge being a curved flat knit edge, and (2) a first knit strip having a first property and a second knit strip having a second property that is different from the first property;

wherein the first knit strip and the second knit strip are positioned adjacent to each other along one or more of a lateral side and a medial side of the upper; and

a sole structure secured to the upper.

Ex. 1001, 12:9–22, 13:1–13.

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 Clark, ³ Spencer ⁴
1–20	103(a)	Herbert, ⁵ Cusinato, Glidden, ⁶ Spencer

Pet. 30.

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 meaning is the

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

³ US 2,440,393, issued Apr. 27, 1948 (“Clark,” Ex. 1015).

⁴ David J. Spencer, *Knitting Technology: A Comprehensive Handbook And Practical Guide* (3rd ed.) (2001) (“Spencer,” Ex. 1050).

⁵ US 2,400,692, issued May 21, 1946 (“Herbert,” Ex. 1016).

⁶ US 2,147,197, issued Feb. 14, 1939 (“Glidden,” Ex. 1017).

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 POSITA [(i.e., a person of ordinary skill in the art)] in the field of the '511 [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 POSITA would have at least a general understanding of general construction processes and materials used in the manufacturing process of fabric-based articles. *See 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.

Pet. 30–31. Patent Owner does not oppose Petitioner's proposal. Prelim. Resp. 10–11. 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. 31–36; Prelim. Resp. 11–15. 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. 31. 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, 170). 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 ’511 patent encompasses hosiery, stockings, or socks. Instead, Patent Owner argues, an “article of footwear” must have an upper and a sole structure. Prelim. Resp. 11–12. 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 11–14 (citing Ex. 1001; Ex. 2001⁷).

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, 1:40–41 (cited at Prelim. Resp. 12); *see also* Ex. 1001, 4:63–64 (“The primary elements of footwear 10 are depicted in FIG. 1 as being a sole structure 20 and an upper 30.”). Additionally, Patent Owner points out (correctly) that “[e]very figure of the ’511 patent confirms” its construction because the figures “depict knitted textile elements which are designed to be, or are, incorporated into a shoe.” Prelim. Resp. 12. Finally, Patent Owner points to surrounding claim language in both of independent claims 1 and 15 that supports its construction. Prelim. Resp. 12. 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 15, Patent Owner points out that it “recite[s] . . . an ‘article of footwear comprising’ an ‘upper.’” *Id.* (quoting

⁷ Exhibit 2001 is a declaration by Christopher M. Pastore, Ph.D.

claim 15). 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, according to Petitioner, "indicates a sole is optional." Pet. 31. A sole is optional, Petitioner argues, because the Abstract of the '511 patent states that "[t]he footwear *may* include an upper and a sole structure." Pet. 31 (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 "[o]ther intrinsic evidence" supports its construction. Pet. 31–32 (citing Ex. 1053, 4:55–58; Ex. 1002 ¶92). The alleged intrinsic evidence, however, is an unrelated patent, US 2,675,631, which purportedly was cited during the prosecution of the '511 patent. *Id.* 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 id.* (no citation to the prosecution history provided). Further, even assuming US 2,675,631 is cited in the prosecution history of the '511 patent and thus part of the intrinsic evidence,⁸ Petitioner fails to show that it is probative of

⁸ 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).

what *the inventors of the '511 patent* meant by “article of footwear.”

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 '511 patent. Ex. 1053, 4:55–58 (partly quoted at Pet. 31–32). 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 '511 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.

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 '511 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.

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 '511 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, Clark, Spencer)

The Petition asserts that claims 1–20 would have been obvious over Cusinato, Clark, and Spencer. Pet. 36–86.

1. Independent Claims 1 and 15

Claim 1 is directed to “[a]n upper for an article of footwear, the upper comprising” certain features. Claim 15 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 15 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 15 are limiting. *See* Pet. 51 (“To the extent the preamble is limiting, Cusinato and Clark each disclose an upper for an article of footwear.”), 84 (claim 15 analysis referring back to claim 1 analysis).⁹

We construe the preambles of claims 1 and 15 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 15. *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

⁹ Claim 15 is similar to claim 1, and, in challenging claim 1, Petitioner merely refers back to and relies exclusively on its analysis for claim 1. *See* Pet. 84 (Ground 1), 124–125 (Ground 2). Thus, although we may we discuss claim 1 alone at times, our analysis applies equally to claim 15.

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 15, 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 15 in three ways. Pet. 51 (claim 1). All three have fatal flaws.

The first way is not persuasive because it is premised on Petitioner’s construction of an “article of footwear,” as encompassing any foot covering including slippers, hose, or socks. Pet. 51. More specifically, 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.* (quoting Ex. 1014 ¶¶10, 13 (all emphasis and modifications being Petitioner’s)). As discussed above, we reject Petitioner’s construction of “article of footwear.” Further, Petitioner overstates what the cited teachings of Cusinato disclose. Paragraph 13 does not mention “boot” at all. Ex. 1014 ¶13. Paragraph 10 uses “boot” only as an adjective for a shape, not in reference to an actual boot. Thus, there is no reasonable likelihood of Petitioner prevailing when relying on Cusinato for the preambles.

The second way Petitioner maps the asserted prior art to the preambles of claims 1 and 15 is by relying, not on Cusinato, but on Clark. In that regard, Petitioner argues that “Clark ‘relates primarily to *shoemaking* and consists in a novel process of making of textile material a last-fitting

upper.” Pet. 51 (quoting Ex. 1015, 1:1–7). We agree with Petitioner that Clark discloses the preambles of claims 1 and 15.

By relying on Clark, however, Petitioner’s obviousness challenge becomes untenable. Recall that claim 1 is directed to “[a]n upper for an article of footwear, the upper comprising” certain features and that claim 15 similarly is directed to “[a]n article of footwear comprising: an upper comprising” certain features. If Petitioner relies on Clark for the preambles, then Petitioner must show that Clark’s upper comprises the features that the claims go on to recite *or* that it would have been obvious to modify Clark’s upper to incorporate such features. Yet Petitioner does not purport to do either. With respect to claim 1, for example, the first such feature (limitation “1[a1]” per Petitioner) recites “a flat knit textile element comprising (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, at least one flat knit edge being a curved flat knit edge.” Pet. x.¹⁰ For this limitation, the Petition relies extensively on Cusinato and fails to propose any modification of Clark, let alone in view of Cusinato. Pet. 51–54. The only mention of Clark with respect to limitation 1[a1] appears in the final paragraph of Petitioner’s arguments regarding the limitation. That paragraph states the following:

To the extent Cusinato does not disclose a flat knit textile element on its own, it would have been obvious to a POSITA to use flat knitting, as expressly taught in Clark and Spencer, and a POSITA would reasonably have expected to do so successfully. EX1002, ¶¶176–77. For example, Clark teaches that the fabric

¹⁰ The Petition includes a series of pages of non-argument that are paginated with Roman numerals, of which pages x–xii include a Claim Listing.

used in its claimed upper “may be knitted as a strip *in a flat bed knitting machine*.” EX1015, 2:13–14. As discussed above, Spencer teaches that flat knitting machines produce flat pieces of fabric with finished edges. See EX1050, 63, 86–87. EX1002, ¶¶176–77.

Pet. 55. Among other things, Petitioner does not assert that Clark teaches “a curved flat knit edge,” as recited in claims 1 and 15. Thus, for at least that reason, there is no reasonable likelihood of Petitioner prevailing when relying on Clark for the preambles of claims 1 and 15.

The third way Petitioner maps the asserted prior art to the preambles of claims 1 and 15 is by relying on a modification of Cusinato. Petitioner’s entire argument in this regard is as follows:

If Patentee were to argue (contrary to the intrinsic and extrinsic evidence) that “footwear” must include a sole, a “shoe bottom” or sole is disclosed in Clark, and a POSITA would consider it obvious to add a sole to Cusinato’s “*boot-like*” form. EX1002, ¶¶157–561^[11].

Pet. 51. Petitioner does not cite directly to Clark in support. *Id.* Instead, Petitioner cites exclusively to declaration testimony of Sabit Adanur, Ph.D. *Id.* In the cited testimony, Dr. Adanur identifies where Clark teaches a “shoe bottom.” See Ex. 1002 ¶160 (citing Ex. 1015, 3:10). We are persuaded that Clark discloses an upper as well as a “shoe bottom,” which Petitioner reasonably interprets to disclose a sole.

¹¹ Exhibit 1002 is a declaration by Sabit Adanur, Ph.D. Based on how Dr. Adanur organizes his declaration and titles its various subsections, we presume that the Petition’s citation to paragraphs “157–561” was a typographical error and that the Petitioner intended to cite instead to paragraphs 157–161.

However, it is not enough that Clark discloses a sole. *See KSR Int'l*, 550 U.S. at 418 (“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”). Petitioner must show that it would have been obvious to modify Cusinato to include a sole. *Id.* (“[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.”); *see also In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

On this aspect, Petitioner fails. The Petition summarily states that “a POSITA would consider it obvious to add a sole to Cusinato’s ‘*boot*-like’ form” but – as noted by Patent Owner – the Petition does not explain why. Pet. 51; *see* Prelim. Resp. 35 (“The Petition is silent with respect to any alleged motivation.”). Dr. Adanur’s testimony does not add much. He summarily opines that “it would be obvious to add a sole to Cusinato’s ‘boot-like’ form to provide cushioning and protection.” Ex. 1002 ¶160.

Patent Owner argues that Dr. Adanur does not point to any teaching in the asserted prior art to support the stated reasoning. *See* Prelim. Resp. 35 (“Dr. Adanur’s declaration provides only a single motivation that has no connection to the asserted combinations or the cited references and is also insufficient as a matter of law.”). Moreover, Patent Owner argues that, even if it were known in the art that a sole provides cushioning and protection in

shoes,¹² Dr. Adanur does not provide an adequate reason for why a person of ordinary skill in the art would modify Cusinato's "'stocking' to transform it into a shoe with a sole," adding that "stockings, slippers, and socks in general, have their own purposes that are distinct from the purposes of shoes." Prelim. Resp. 36 (citing Ex. 2001 ¶65). In the cited declaration testimony, Dr. Pastore points out, among other things, that "socks, stockings, and slippers are typically designed to be worn either alone (*e.g.*, for comfort indoors), or inside of a shoe." Ex. 2001 ¶65. We credit Dr. Pastore's testimony in this regard, and we agree with Patent Owner that Petitioner has not explained why a person of ordinary skill in the art allegedly would seek to add a sole to Cusinato.

We have considered all three ways that Petitioner purports to map the prior art to the preambles of claims 1 and 15, but each has a problem that is fatal to Petitioner's obviousness ground. For this reason, the Petition fails to demonstrate that the asserted prior art teaches, or renders obvious, the subject matter of claims 1 and 15. 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 2–14 and 16–20, all ultimately depend from either claim 1 or claim 15. Thus, there is not a reasonable

¹² That soles were known in the art to provide cushioning and protection to shoes seems both likely to be accurate and provable, but – as Patent Owner points out – Dr. Adanur does not cite any prior art teaching to support it. *See* Prelim. Resp. 35 (citing Ex. 1002 ¶¶157–161). For purposes of this Decision, we assume for the sake of argument that it was known.

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, Glidden, Spencer)

The Petition asserts that claims 1–20 would have been obvious over Herbert, Cusinato, Glidden, and Spencer. Pet. 86–127.

1. Independent Claims 1 and 15

Petitioner does not have a reasonable likelihood of prevailing with respect to either of claims 1 and 15 because, as explained below, the Petition fails to show how the prior art teaches, or renders obvious, an upper for an article of footwear.

Petitioner purports to map the asserted prior art to the preambles of claims 1 and 15 using three separate references, asserting, “[i]f the preamble is limiting, Herbert, Glidden and Cusinato each disclose an upper for an article of footwear.” Pet. 94 (citing Ex. 1002 ¶266).

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. 94 (quoting Ex. 1016, 1:48, 3:17¹³). 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

¹³ Although Hebert includes a page 3, that page lacks any content beyond line 11. Ex. 1016, 3. We understand Petitioner’s citation to “3:17” to be a typographical error, and we presume that Petitioner instead intended to cite to line 17 of page 2.

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 2:16–19 (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 ““a fabric . . . [that] directly forms the stocking or *footwear*,’ specifically a ‘*boot*.’” Pet. 95 (quoting Ex. 1014 ¶¶10, 13 (Petitioner's modifications)). 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. 94–95), 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 mapping the preambles of claims 1 and 15 to either of Herbert and Cusinato is not persuasive.

The remaining reference asserted with respect to the preambles is Glidden. Pet. 94 (citing Ex. 1017). Petitioner argues that it "relates to 'articles of footwear . . . and is especially useful in the manufacture of shoes.'" *Id.* (quoting Ex. 1017, 1:1–4). We agree with Petitioner that Glidden discloses the preambles of claims 1 and 15.

By relying on Glidden, however, Petitioner's obviousness challenge becomes untenable. If Petitioner relies on Glidden for the preambles, then Petitioner must show that Glidden's upper comprises the features that the claims go on to recite *or* that it would have been obvious to modify Glidden's upper to incorporate such features. Petitioner fails to do either. First, Petitioner does not allege that Glidden discloses, for example, "flat knit edges" as recited in limitation 1[a1]. *See* Pet. 95–96 (discussing Herbert, Cusinato, and Spencer but not Glidden). Second, Petitioner fails to propose any modification of Glidden. *See id.* at 95 (arguing that "Herbert in view of Cusinato and Glidden and, if necessary, Spencer discloses Element 1[a1] under either party's construction."); *see also id.* at 97 (vaguely arguing that "A POSITA in possession of Herbert, Glidden, Cusinato, and if necessary, Spencer, would thus have understood that a combination of their teachings would have disclosed the claimed 'curved flat knit edge.'" (citing Ex. 1002 ¶278¹⁴)).

¹⁴ The cited declaration testimony states: "Moreover, Herbert in view of Glidden could be combined with the teachings of Cusinato and, if necessary, Spencer, and a POSITA would have been motivated to make this

We have considered all of the ways that Petitioner purports to map the prior art to the preambles of claims 1 and 15, but each has a problem that is fatal to Petitioner's obviousness ground. For this reason, the Petition fails to demonstrate that the asserted prior art teaches, or renders obvious, the subject matter of claims 1 and 15. 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 2–14 and 16–20, all ultimately depend from either claim 1 or claim 15. Thus, there is not a reasonable likelihood of Petitioner prevailing as to any of the dependent claims. *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.

combination and would have had a reasonable expectation of success in doing so.” Ex. 1002 ¶278.

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