

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NIKE, INC.,
Patent Owner

Patent No. 9,510,636

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 9,510,636**

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EX1001	U.S. Patent No. 9,510,636 (the “’636 patent”)
EX1002	Declaration of Sabit Adanur, Ph.D.
EX1003	Declaration of Grant Delgatty
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EX1005	Joint Claim Construction and Prehearing Statement (May 15, 2024)
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EX1017	Japanese Patent Publication No. JP H3-003203 (“Horii”) - Translation
EX1018	U.S. Patent No. 7,624,518 (“Calderone”)
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EX1025	Maya Wei-Haas, <i>How Chuck Taylor Taught America How to Play Basketball</i> , SMITHSONIAN MAG. (Aug. 8, 2016), https://www.smithsonianmag.com/innovation/how-chuck-taylor-taught-america-how-play-basketball-180960050/
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EX1032	Aaron Nojima, <i>Remembering Crooked Tongues</i> , SNEAKER HISTORY (Jan. 28, 2015), https://sneakerhistory.com/2015/01/28/remembering-crooked-tongues
EX1033	Transcript of Claim Construction Hearing (September 20, 2024) in <i>Nike, Inc. v. Skechers U.S.A., Inc.</i> , No. 23-cv-09346 (C.D. Cal.)
EX1034	U.S. Patent No. 9,573,331 (“McDowell”)
EX1035	U.S. Patent No. 4,766,681
EX1036	Majority Analysis
EX1037	U.S. Patent No. 9,730,484 (“Dua-484”)
EX1038	Patent Owner’s Response for IPR2023-01460
EX1039	H. Hong et al., The development of 3D shaped knitted fabrics for technical purposes on a flat knitting machine, <i>Indian Journal of Fibre & Textile Research</i> , Vol. 1, September 1994, pp. 189-194
EX1040	Excerpts from Nike's Supplemental Infringement Contentions for '636 patent
EX1041	Future Materials – 2004
EX1042	melliand International, November 1999
EX1043	Textile network, May 2007

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EX1044-1049	Reserved
EX1050	David J. Spencer, KNITTING TECHNOLOGY: A COMPREHENSIVE HANDBOOK AND PRACTICAL GUIDE (3rd ed.) (Woodhead Publishing Limited, Cambridge, England 2001)
EX1051	U.S. Patent No. 1,803,554 (“Knilans”)
EX1052	U.S. Patent No. 2,047,724 (“Zuckerman”)
EX1053	U.S. Patent No. 2,675,631 (“Doughty”)
EX1054	Excerpts of Sandy Black, KNITWEAR IN FASHION (Thames & Hudson 2002)
EX1055	CN 2187379Y (“Li”) - Translation
EX1056	CN 2187379Y (“Li”)
EX1057	Excerpts of Man-Made Fiber and Textile Dictionary (4th ed.) (Celanese Corporation, December 1978)
EX1058	M. Legner, <i>3D-Products for Fashion and Technical Textile Applications from Flat Knitting Machines</i> , MELLIAND INTERNATIONAL (September 2003), 238-241
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EX1061	Derek T. Ward, <i>The Future of Knitting</i> , INTERNATIONAL TEXTILE BULLETIN (May 2023), 46-50
EX1062	Sabit Adanur, WELLINGTON SEARS HANDBOOK OF INDUSTRIAL TEXTILES (Johnston Industries Group 1995)

CLAIM LISTING

Claim/ Element	Text of Claim
1[pre]	An article of footwear having an upper and a sole structure secured to the upper, the article of footwear incorporating a knitted component comprising:
1[a1]	a portion of the knitted component defining the upper,
1[a2]	the upper including a portion of at least one of an exterior surface of the knitted component and an opposite interior surface of the knitted component, the interior surface defining a void for receiving a foot; and
1[b]	an integral knit tongue formed with the upper and extending through a throat area of the knitted component; and
1[c]	at least one raised element extending a height above the exterior surface of the knitted component,
1[d]	wherein the integral knit tongue is joined to a forward portion of the throat area and at least along a portion of a lateral side and a medial side of the throat area of the knitted component extending from the forward portion to an ankle opening of the upper.
2	The article of footwear recited in claim 1, wherein at least a portion of the integral knit tongue and a portion of the upper include at least one course having a common yarn.
3	The article of footwear recited in claim 1, wherein at least a portion of the upper and a portion of the integral knit tongue are formed from a common knit structure.
4	The article of footwear recited in claim 1, wherein the at least one raised element is formed of unitary knit construction with the upper and the integral knit tongue.
5	The article of footwear recited in claim 4, wherein the knitted component includes at least two raised elements disposed on each of the lateral side and the medial side of the throat area of the upper and extending a height above the exterior surface of the knitted component.
6	The article of footwear recited in claim 4, wherein the at least one raised element further comprises at least one lace aperture configured to receive a lace.
7	The article of footwear recited in claim 1, wherein the integral knit tongue comprises at least a partially integral portion and a free portion;

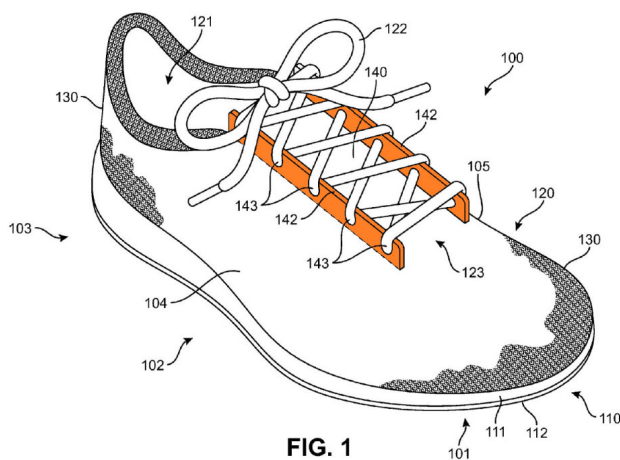
Claim/ Element	Text of Claim
	the partially integral portion being of unitary knit construction with the upper at the forward portion of the throat area and at least along the portion of the lateral side and the medial side of the throat area of the knitted component; and the free portion being of unitary knit construction with the partially integral portion at a rearward portion of the integral knit tongue and remaining unattached to the remaining portions of the knitted component.
8	The article of footwear recited in claim 1, wherein the upper comprises a first type of yarn; and wherein the integral knit tongue comprises a second type of yarn, the second type of yarn being different from the first type of yarn.
9	The article of footwear recited in claim 8, wherein the second type of yarn is an elastic yarn.
10	The article of footwear recited in claim 1, wherein the knitted component comprises at least two knit element layers, the at least two knit element layers including: a first knit element layer comprising a portion of the knitted component associated with the exterior surface; and a second knit element layer comprising a portion of the knitted component associated with the interior surface; and wherein the second knit element layer further includes the integral knit tongue.
11	The article of footwear recited in claim 10, wherein at least a first portion of the first knit element layer and the second knit element layer are decoupled along the throat area of the knitted component.
12	The article of footwear recited in claim 11, wherein at least a second portion of the first knit element layer and the second knit element layer are joined along the throat area of the knitted component.
13[pre]	A knitted component for an article of footwear, the knitted component comprising:
13[a]	a portion of the knitted component defining an upper, the upper including a portion of at least one of an exterior surface of the knitted component and an opposite interior surface of the knitted component, the interior surface configured to define a void for receiving a foot; and

Claim/ Element	Text of Claim
13[b]	an integral knit tongue with the upper and extending through a throat area of the knitted component; and
13[c]	at least one raised element having at least one lace aperture configured to receive a lace,
13[d]	wherein the integral knit tongue is joined to a forward portion of the throat area and at least along a portion of a lateral side and a medial side of the throat area of the knitted component extending from the forward portion to an ankle opening of the upper.
14	The knitted component recited in claim 13, wherein at least a portion of the integral knit tongue and a portion of the upper include at least one course having a common yarn.
15	The knitted component recited in claim 13, wherein at least a portion of the upper and a portion of the integral knit tongue are formed from a common knit structure.
16	The knitted component recited in claim 13, wherein the at least one raised element is formed of unitary knit construction with the upper and the integral knit tongue.
17	The knitted component recited in claim 16, comprising at least two raised elements disposed on each of a lateral side and a medial side of the upper and extending a height above the exterior surface of the knitted component.
18	The knitted component recited in claim 13, wherein the integral knit tongue comprises at least a partially integral portion and a free portion; the partially integral portion being of unitary knit construction with the upper at the forward portion of the throat area and at least along the portion of the lateral side and the medial side of the throat area of the knitted component; and the free portion being of unitary knit construction with the partially integral portion at a rearward portion of the integral knit tongue and remaining unattached to the remaining portions of the knitted component.
19	The knitted component recited in claim 13, wherein the upper comprises a first type of yarn; and wherein the integral knit tongue comprises a second type of yarn, the second type of yarn being different from the first type of yarn.
20	The knitted component recited in claim 19, wherein the second type of yarn is an elastic yarn.

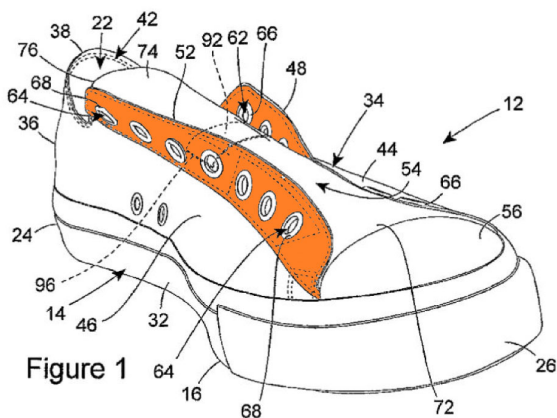
Claim/ Element	Text of Claim
21[pre]	A knitted component for an article of footwear, the knitted component comprising:
21[a]	an upper and an integral knit tongue formed of unitary knit construction with the upper and extending through a throat area of the knitted component;
21[b]	the knitted component comprising at least two knit element layers, including: a first knit element layer comprising a portion of an exterior surface of the knitted component; and a second knit element layer comprising a portion of an interior surface of the knitted component, the interior surface disposed opposite to the exterior surface and the interior surface being configured to define a void for receiving a foot; and
21[c]	wherein the integral knit tongue is joined to a forward portion of the throat area and at least along a portion of a lateral side and a medial side of the throat area of the knitted component extending from the forward portion to an ankle opening of the upper.
22	The knitted component recited in claim 21, wherein the second knit element comprises the integral knit tongue.
23	The knitted component recited in claim 21, wherein at least a first portion of the first knit element layer and the second knit element layer are decoupled along the throat area of the knitted component.
24	The knitted component recited in claim 23, wherein at least a second portion of the first knit element layer and the second knit element layer are joined along the throat area of the knitted component.
25	The knitted component recited in claim 21, wherein at least a portion of the integral knit tongue and a portion of the upper include at least one course having a common yarn.
26	The knitted component recited in claim 21, further comprising at least one raised element that is formed of unitary knit construction with the upper and the integral knit tongue.
27	The knitted component recited in claim 26, wherein the first knit element layer comprises the at least one raised element.

I. INTRODUCTION

The claims of the '636 patent are directed to articles of footwear comprised of basic features known long before the priority date, including in Nike's own prior publications. The '636 patent coins terms like "integral knit tongue" to refer to an old concept that Nike and others had already described years earlier. But that concept, standing on its own, was rejected as being anticipated by a much earlier Nike publication by the same named inventor (US2005/0115284 Dua). EX1013, 4-7. So Nike took to introducing another coined term, this time adding a "raised element" that extends above the exterior surface of the upper (EX1013, 12, 14). This led to allowance. EX1013, 25. But "raised elements" of the type described in the '636 patent include shoe-lace structures like those shown in orange in the figure below from a 2006 patent filing by Converse (a wholly-owned subsidiary of Nike's), six years before the '636 patent's earliest possible priority date.



'636 Patent



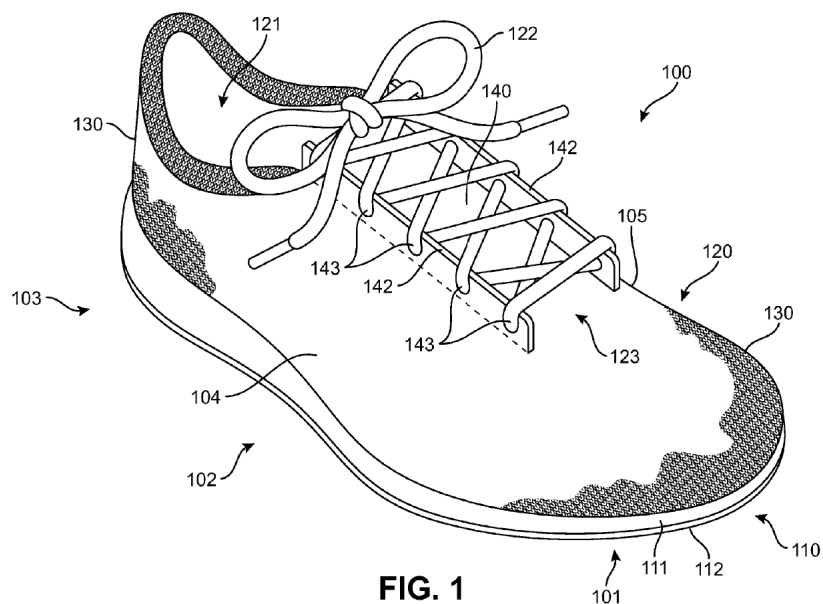
Converse Prior Art

EX1001, FIG. 1 (“raised elements 142” shown in orange); EX1018 (Calderone), FIG. 1 (prior art “raised elements” annotated in orange). Nike itself disclosed the use of “raised elements,” at least under Nike’s construction of the term, years before the priority date of the ’636 patent. *See infra*, Section VI.

Repackaging old concepts using newly-coined terms to describe basic shoe components is not novel, and not the type of effort worthy of a patent. For these and additional reasons below, the claims of the ’636 patent should be found unpatentable.

II. OVERVIEW OF THE CHALLENGED PATENT

The ’636 patent describes footwear 100 having an upper 120 formed from a knitted component 130 that “extends through each of forefoot region 101, midfoot region 102, and heel region 103, along both lateral side 104 and medial side 105, over forefoot region 101, and around heel region 103.” EX1001, 6:57-62.



EX1001, FIG. 1. Moreover, “an integral knit tongue 140 is formed of unitary knit construction with upper 120 and extends through throat area 123 of upper 120 between lateral side 104 and medial side 105.” *Id.*, 6:35-38. Raised elements 142 are disposed along the sides of the throat area, as shown in FIG. 1, and include lace apertures 143 through which a lace 122 extends. *See id.*, 6:39-46.

III. IDENTIFICATION OF CHALLENGE AND GROUNDS

The asserted grounds rely on the following references, each of which is prior art to the '636 patent under pre-AIA §102(b):

- US7,774,956 by Nike, Inc., entitled “Article of Footwear Having a Flat Knit Upper Construction or Upper Construction,” issued on August 17, 2010 (“Dua-956”) (EX1029).
- WO 98/43506 by FILA U.S.A., Inc. was published on October 8, 1998 (“McDonald”) (EX1016).
- Japanese Application Publication No. H3-3203 by Mizuno Corp. was published on January 14, 1991 (“Horii”) (EX1017; EX1031).
- US2005/0193592 by Nike, Inc., entitled “Article of Footwear Having a Textile Upper,” was published on September 8, 2005 (“Dua-592”) (EX1014).
- US7,552,547 by Converse, Inc., entitled “Slip On Athleisure Shoe,” issued on June 30, 2009 (“Calderone”) (EX1018).

The asserted grounds are:

- Ground 1A: Claims 1-6, 8-17, and 19-27 are anticipated under 35 U.S.C. § 102(b) by Dua-956.
- Ground 1B: Claims 1-6, 8-17, and 19-27 are obvious under 35 U.S.C. § 103 over Dua-956 alone or in combination with Horii.
- Ground 1C: Claims 1-6, 8-17, and 19-27 are obvious under 35 U.S.C. § 103 under Grounds 1A-1B in further view of Calderone.
- Ground 1D: Claims 7 and 18 are obvious under 35 U.S.C. § 103 for the reasons articulated under each of Grounds 1A-1C in further view of McDonald and/or Horii.
- Ground 2A: Claims 1-6, 8-17, and 19-27 are obvious under 35 U.S.C. § 103 over Dua-592 and Calderone.
- Ground 2B: Claims 7 and 18 are obvious under 35 U.S.C. § 103 for the reasons articulated under Ground 2A in further view of McDonald and/or Horii.

IV. LEVEL OF ORDINARY SKILL IN THE ART

The '636 patent relates to an article of footwear that incorporates a knitted component that has an upper and an integral knit tongue. EX1001, Abstract. A person of ordinary skill in the art ("POSITA") in the field of the '636 patent in February 2012 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. EX1002, ¶68. 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. 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. *See id.*

This Petition does not turn on this specific definition of the level of ordinary skill. The claims would be obvious from the perspective of any reasonable definition of a POSITA.

V. CLAIM CONSTRUCTION

In the parallel litigation, the parties have agreed to constructions for some terms and proposed constructions for other terms. EX1005-EX1006.

However, "claim terms need only be construed 'to the extent necessary to resolve the controversy.'" *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011). Here, Petitioner believes that no terms require express construction for purposes of resolving the issues raised in the Petition because the claims are invalid under both parties' interpretations.

In parallel litigation, Patent Owner is taking the position that no claim terms require construction. EX1007, 1. Accordingly, this Petition includes challenges of the claims based on Patent Owner's reading of the claims onto the accused shoes in the parallel litigation. *Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00086, Paper 8 at 21 (PTAB April 27, 2020) (permitting the petitioner to base its challenge "on claim constructions implied by Patent Owner's district court infringement contentions without expressing subjective agreement with those constructions"); *id.*, 18 (concluding that 37 C.F.R. § 42.104(b)(3) "does not prohibit Petitioner from submitting a claim construction it believes is incorrect and relying on that construction to show how the claim is unpatentable"); *Western Digital Corp. v. SPEX Techs., Inc.*, IPR2018-00084, Paper 14 (PTAB April 25, 2018).

The Petition also challenges the claims under Petitioner's constructions.

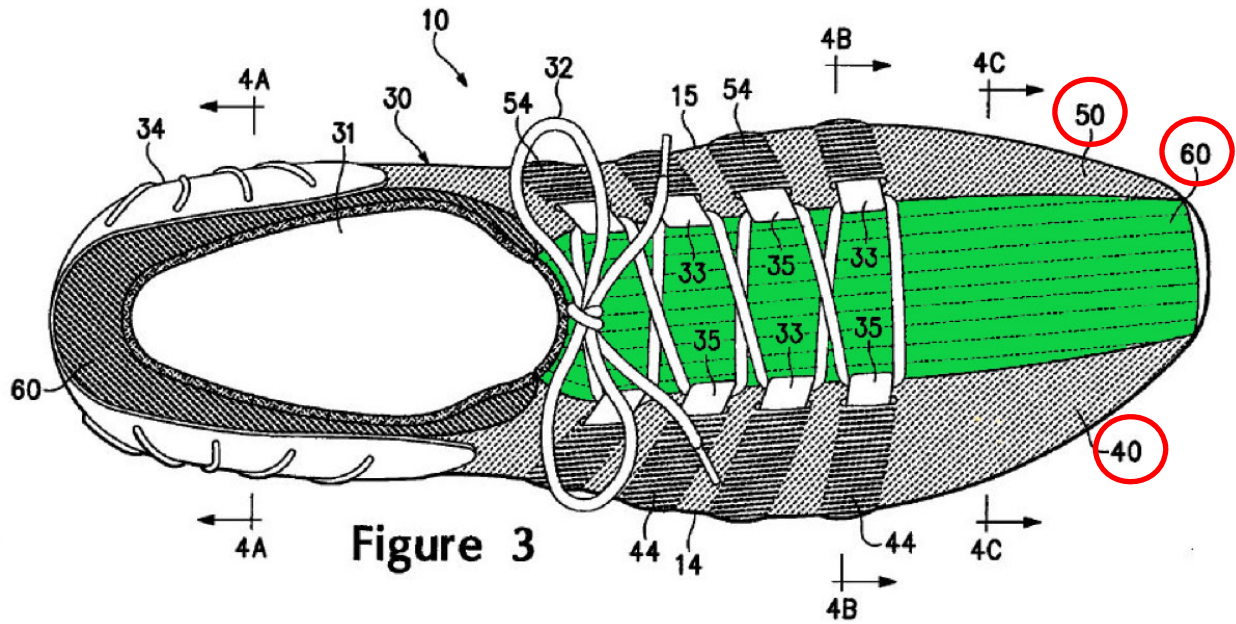
VI. GROUND 1A: CLAIMS 1-6, 8-17, AND 19-27 ARE ANTICIPATED BY DUA-956 AT LEAST UNDER NIKE’S APPARENT CONSTRUCTION OF “INTEGRAL KNIT TONGUE”¹

A. Overview of Dua-956

Dua-956 is generally directed to articles of footwear having uppers “at least partially formed from a material produced through a flat knitting process.” EX1029, 4:7-10. Dua-956 discloses various embodiments for its flat knitted upper, including a first embodiment, referred to as “first upper,” illustrated in FIGs. 1-9B (“Embodiment #1”). EX1002, ¶¶74-75.

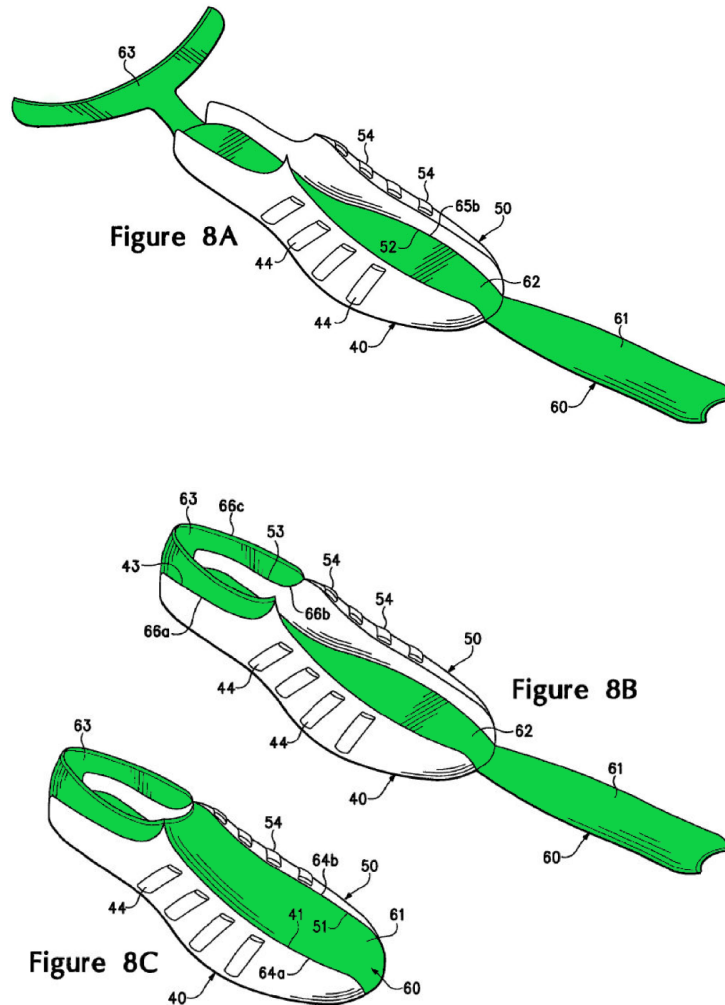
The upper 30 of Embodiment #1 comprises a lateral textile element 40, a medial textile element 50, and a central textile element 60, each of which is formed of a unitary (i.e., one-piece) construction through a flat knitting process. *See id.*, 6:4-49, 7:5-6. Dua-956 explains that these textile elements include “a lateral textile element 40, a medial textile element 50, and a central textile element 60 [colored in green],” as show below. EX1029, 5:54-56; EX1002, ¶76.

¹ None of the references to “integral knit tongue” or “tongue” in this Ground 1A and below for Ground 1B, including in the figure annotations, is made under Skechers’ proposed construction, which is separately addressed in Ground 1C.

EX1029, FIG. 3.²

Dua-956 further explains that the “central textile element 60 forms portions of upper 30 extending under the foot, over forward portions of the foot, and around the heel of the foot.” *Id.*, 5:60-62. The central textile element 60 “includes a forward portion 61, a center portion 62, and a rearward portion 63 formed of unitary (i.e., one piece) construction,” as shown below. *Id.*, 6:46-49.

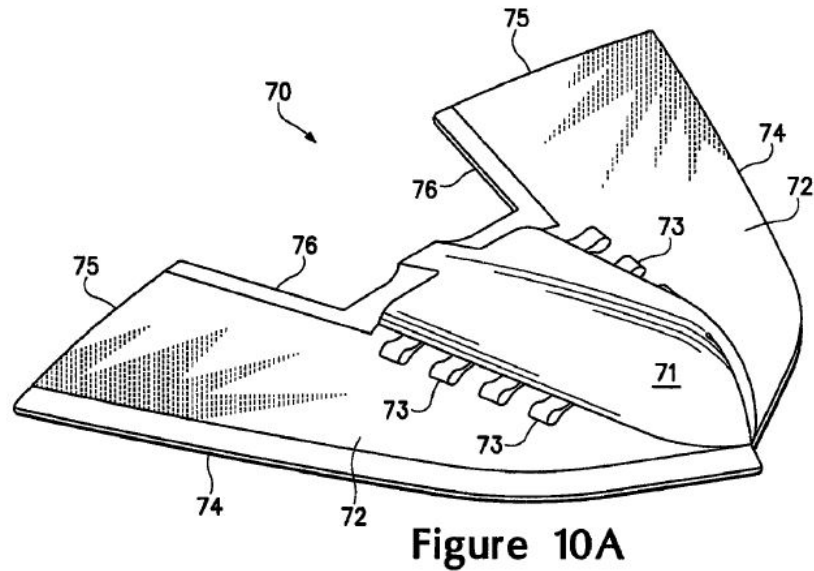
² Unless otherwise indicated, all color and text boxes in patent figures are added.



FIGS. 8A-8C.

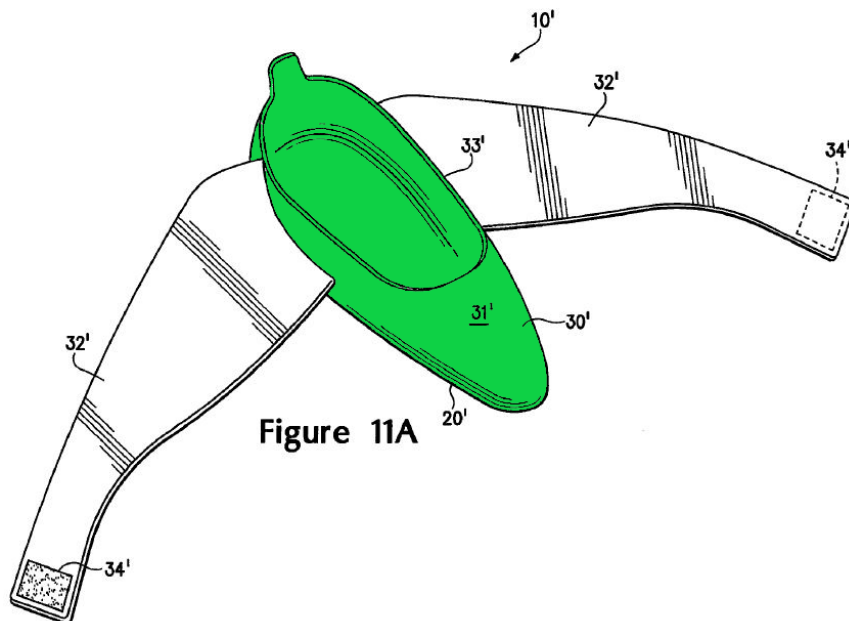
As shown above, once knitted, each of textile elements 40 and 50 are “stitched or otherwise joined to central textile element 60 ... to form an interior void shaped to receive the foot.” *Id.*, 8:49-9:14.

In contrast to upper 30 of Embodiment #1—in which textile elements 40, 50, and 60 may be knitted individually before being joined together—the upper 70 of Embodiment #2 (FIGs. 10A-10C) “includes a central portion 71, a pair of side portions 72, and eight lace loops 73,” as shown below. *Id.*, 9:58-61.



Id., FIG. 10A; EX1002, ¶¶77-79.

For upper 30' of Embodiment #3 (FIGs. 11A-B), Dua-956 discloses that the “[u]pper 30' includes a foot-receiving portion 31' and a pair of straps 32',” where the “[f]oot-receiving portion 31'” (colored in green) “is formed of unitary (i.e., one piece) construction by the flat knitting process.” EX1029, 10:31-35.

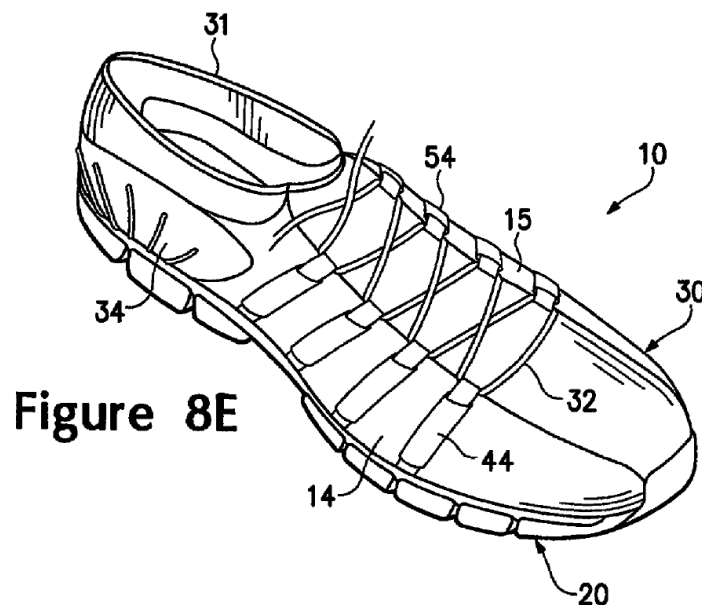


Id., FIG. 11A. Dua-956 explains that the unitary (i.e., one piece) flat knit foot-receiving portion 31' is “a textile element shaped to extend around the foot” and “has an opening 33' for inserting and removing the foot from upper 30'.” *Id.*, 10:35-38; EX1002, ¶¶80-81. The upper 130 of Embodiment #4 (FIGs. 12-13) is also of a unitary knit construction. EX1029, 11:13-16, 11:18-22.

B. Claim 1

Element 1[pre]: *An article of footwear having an upper and a sole structure secured to the upper, the article of footwear incorporating a knitted component comprising:*

Dua-956 discloses an article of footwear (e.g., footwear 10) that includes a sole structure 20 secured to an upper 30, as shown for example in FIGs. 1-2, 4A-4C, and 8E (below). EX1029, 5:9-10), 9:25-26.



Dua-956 also discloses that its article of footwear can incorporate a knitted component. For example, in footwear 10 the “upper 30 is substantially assembled

by joining edges of textile elements 40, 50, and 60 to impart a general shape of the void [for the foot],” and “[e]ach of textile elements 40, 50, and 60 may be formed through a flat knitting process.” *Id.*, 5:66-67, 5:54-65, 7:5-6, 7:5-8:41 (section entitled “Flat Knitting and Yarn”).

Thus, Element 1[pre] is satisfied by Dua-956; EX1002, ¶¶97-99.

Element 1[a1]: *a portion of the knitted component defining the upper,*

Nike has taken the position that the knitted component defining the upper need only constitute “a *majority*” of the upper. EX1009, 7 (original emphasis included). This interpretation is also reflected in Nike’s infringement contentions, which include uppers having non-knit portions around the entire heel area, highlighted in cyan below. (note: the labels and red arrows below are from Nike’s infringement contentions. Skechers has only added the cyan border around the non-knit portion)

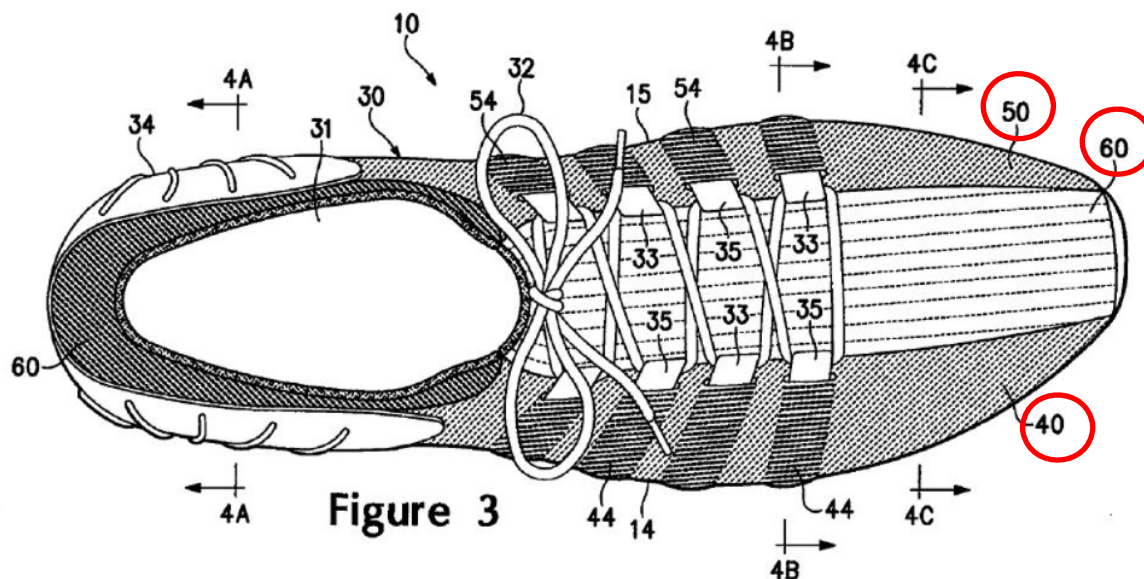




EX1011 (Nike's Infringement Contentions), 9-10.

Under Nike's construction, a POSITA would understand that at least the central textile element 60 of Embodiment #1 satisfies Element 1[a1] as described below. EX1002, ¶¶100-115.

Embodiment #1 includes textile elements 40, 50, and 60, each of which are formed through a flat knitting process and which are assembled to form upper 30. EX1029, 5:54-67, 7:5-6; EX1002, ¶101.



Id., FIG. 3.

In the assembly process, which is illustrated in FIGs. 8A-8E, “upper 30 is substantially assembled by joining edges of textile element 40, 50, and 60 to impart a general shape of the void.” *Id.* 5:65-67; *see also id.*, 8:44-45, 8:44-9:26. The final form of assembled footwear 10 is shown in FIGs. 1-4. *See id.*, 4:56 (“An article of footwear is depicted in FIGS. 1-4C.”).

With respect to what defines the upper, the '636 patent discloses that the “upper generally extends over the instep and toe areas of the foot, along the medial and lateral sides of the foot, under the foot, and around the heel area of the foot.” EX1001, 1:44-46; *see also id.*, 6:66-67. As such, the '636 patent describes the upper as extending around six parts of the foot: (1) the instep area, (2) the toe area, (3) the medial side, (4) the lateral side, (5) under the foot, and (6) the heel area. Consistent

with that description, a POSITA would understand that the central textile element 60 alone comprises a “majority” of the upper. EX1002, ¶103. Under Nike’s district court construction, the central textile element 60 defines the upper, per Element 1[a1], because the majority of upper 30 is formed by the central element 60. EX1009, 7. For example, Dua-956 discloses that the central textile element 60 “includes a forward portion 61, a center portion 62, and a rearward portion 63 formed of unitary (i.e., one piece) construction.” EX1029, 6:46-49; *see also id.*, 7:5-6 (“Each of textile elements 40, 50, and 60 may be formed through a flat knitting process.”); EX1002, ¶104. An example of the central textile element 60 is shown in FIG. 7 below:

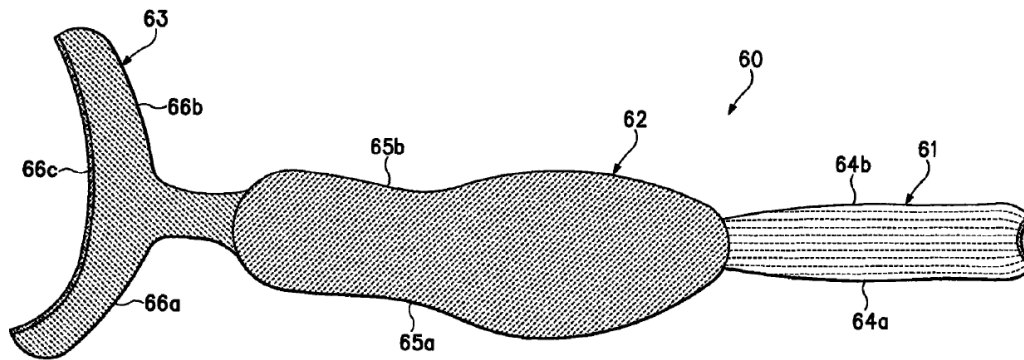
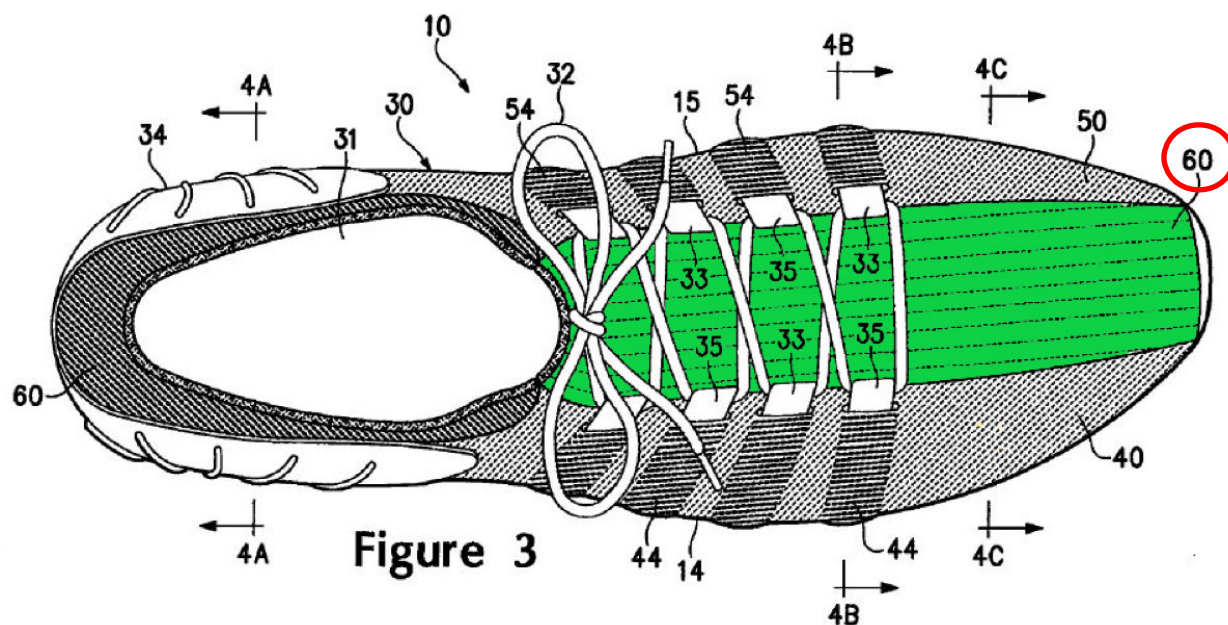
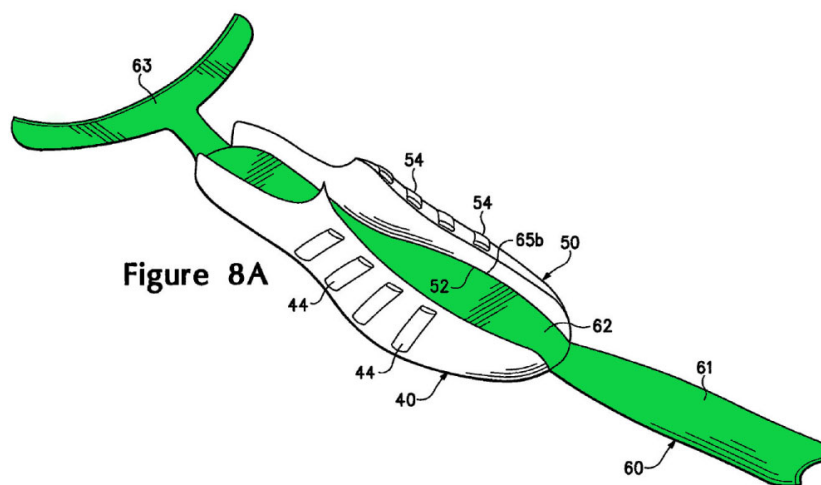


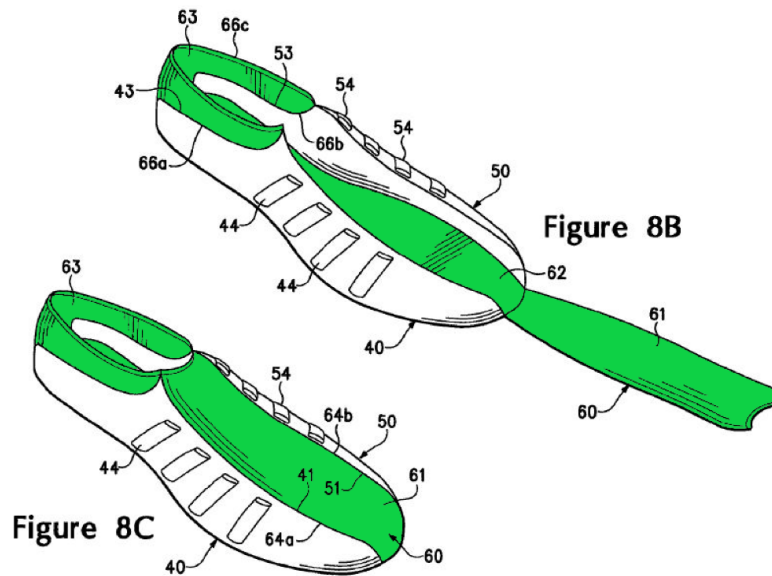
Figure 7

As further shown in FIGs. 3 and 8A-8C below, the forward portion 61 of the central textile element 60 extends over both the instep and toe areas of the foot. EX1029, 6:49-52.



Id., FIG. 3; EX1002, ¶105. In addition, the central portion 62 of central textile element 60 extends under the foot, while its rearward portion 63 extends around the heel and ankle, as colored in green below.





Id., FIG. 8A-8C; 8:66-9:11; EX1002, ¶106.

Of the six upper parts identified in the '636 patent, only two of them—the medial and lateral sides—are not formed by the central textile element 60. EX1002, ¶¶103-107. Dua-956's figures are in accord with the express disclosure that the majority of the parts of the upper are formed by the central element 60. EX1002, ¶¶108-109. Dr. Adanur confirmed that the figures depict the central textile element 60 as comprising the majority of the area of the upper 30. EX1002, ¶¶110-114.

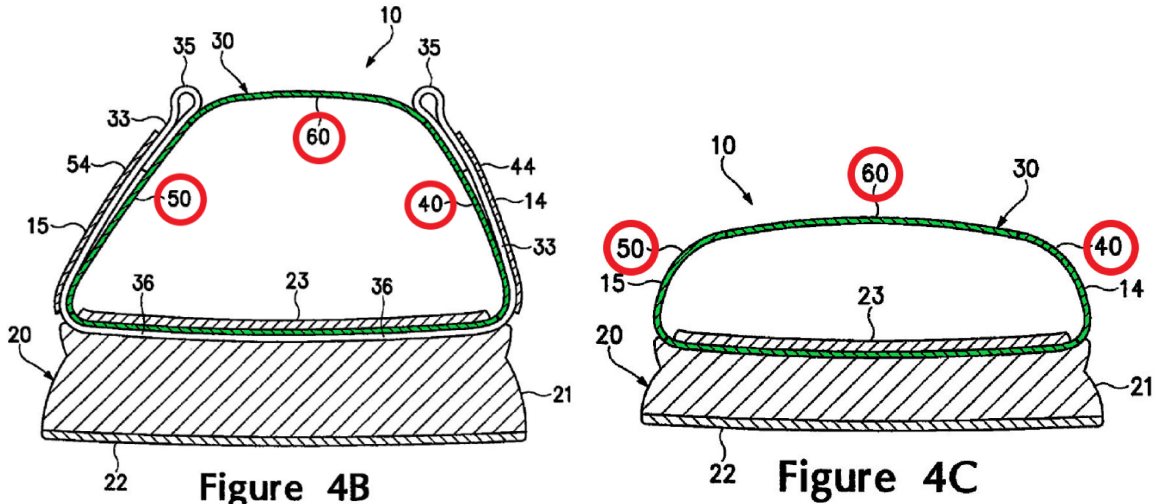
Thus, Element 1[a1] is satisfied by Dua-956.

Element 1[a2]: *the upper including a portion of at least one of an exterior surface of the knitted component and an opposite interior surface of the knitted component, the interior surface defining a void for receiving a foot; and*

The central textile element 60 of Embodiment #1 also satisfies Element 1[a2] because it is a knitted component having an exterior surface³ and because it has an opposite interior surface that defines a void for receiving the foot.⁴ EX1002, ¶¶116-119. For example, for Embodiment #1 Dua-956 discloses that “[t]extile elements 40, 50, and 60 are depicted as forming portions of both an exterior surface and an opposite interior surface of footwear 10.” EX1029, 6:4-7. Dua-956 also discloses that the textile elements, 40, 50, and 60 may form “the interior surface (e.g., an interior liner or bootie for the footwear structure).” *Id.*, 6:7-9. As shown below, this interior surface of the upper 30 defines a void for receiving a foot because, as Dua-956 states, the “textile elements 40, 50, and 60 are joined to each other to form an interior void shaped to receive the foot.” *Id.*, 9:12-14.

³ Element 1[a2] only requires that the upper includes an exterior surface of the knitted component, not that the knitted component forms an exterior surface of the upper. Regardless, central textile element 60 both has an exterior surface and forms an exterior surface of the upper. EX1029, FIGs. 1-3, 4B-4C, 8A-8E.

⁴ Element 1[a2] requires the upper to have *either* an exterior *or* interior surface of the knitted component. The central textile element 60 has both.



Id., FIGs. 4B-4C; *see also* FIG. 4A.

Thus, consistent with Nike's construction, the central textile element 60 would similarly have an interior surface defining a majority of the void for receiving a foot. EX1002, ¶¶116-119. Element 1[a2] is also separately satisfied by the exterior surface of the central textile element 60, as shown above in FIGs. 4B-4C.

Element 1[b]: *an integral knit tongue formed with the upper and extending through a throat area of the knitted component; and*

In the parallel litigation, Skechers proposed that the term “throat area” in the context of the '636 patent means “an area of the upper that extends from an ankle opening over the instep to an area adjacent to the forefoot region.” EX1008, 12-13. Nike appears to agree with this construction. EX1033, 5:18-19, 6:7-12.⁵

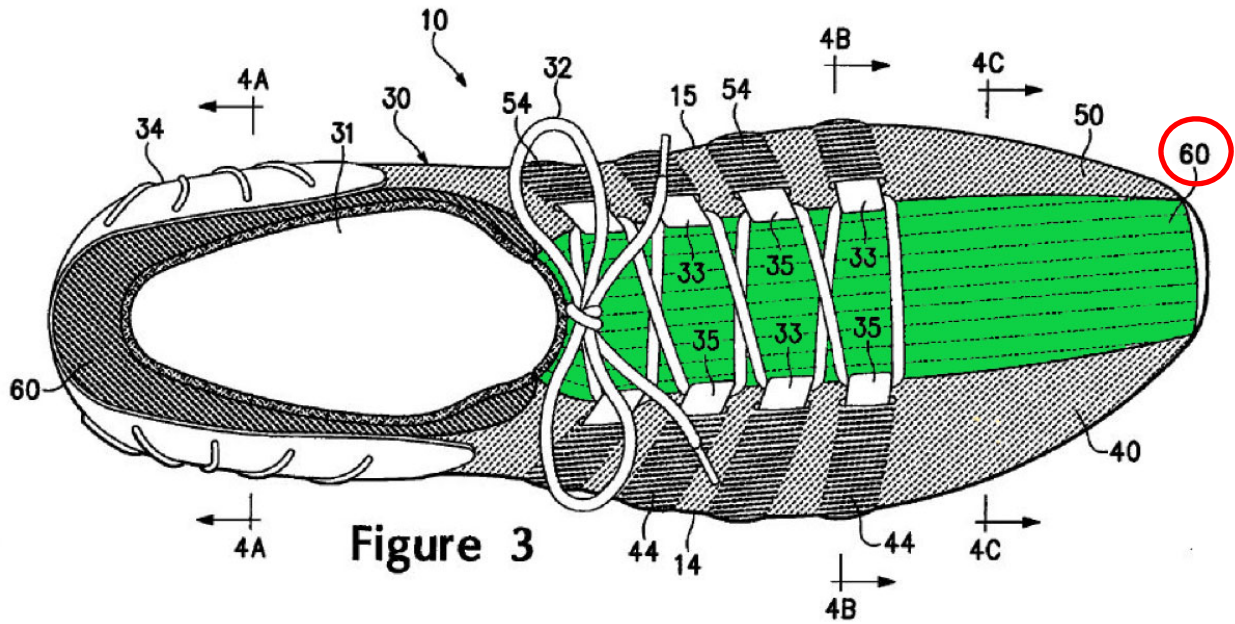
⁵ The parties' separate dispute about “ankle opening” does not impact the analysis of the prior art here.

For “integral knit tongue,” Nike argued that the term has an (unarticulated) ordinary and customary meaning that should apply. EX1007, 17-20. Nike’s infringement contentions, portions of which are reproduced below, indicate that Nike’s apparent understanding of “integral knit tongue” refers generally to knitted material within the throat area.

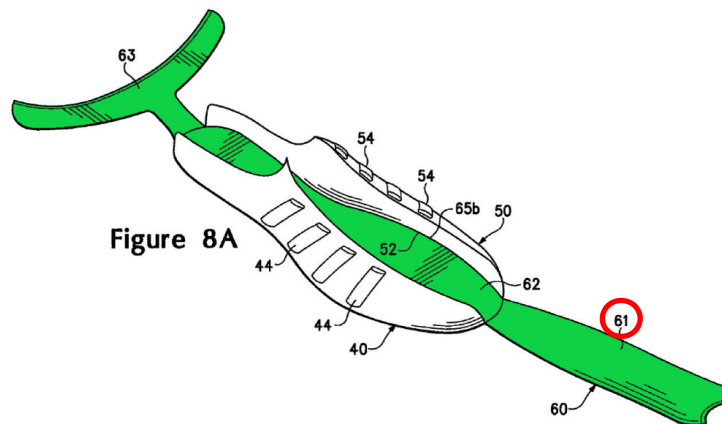


EX1011, 54, 57; EX1066, 71, 77.

Dua-956 discloses an integral knit tongue in the form of forward portion 61 of central textile element 60. EX1029, 5:54-56, 6:46-52.

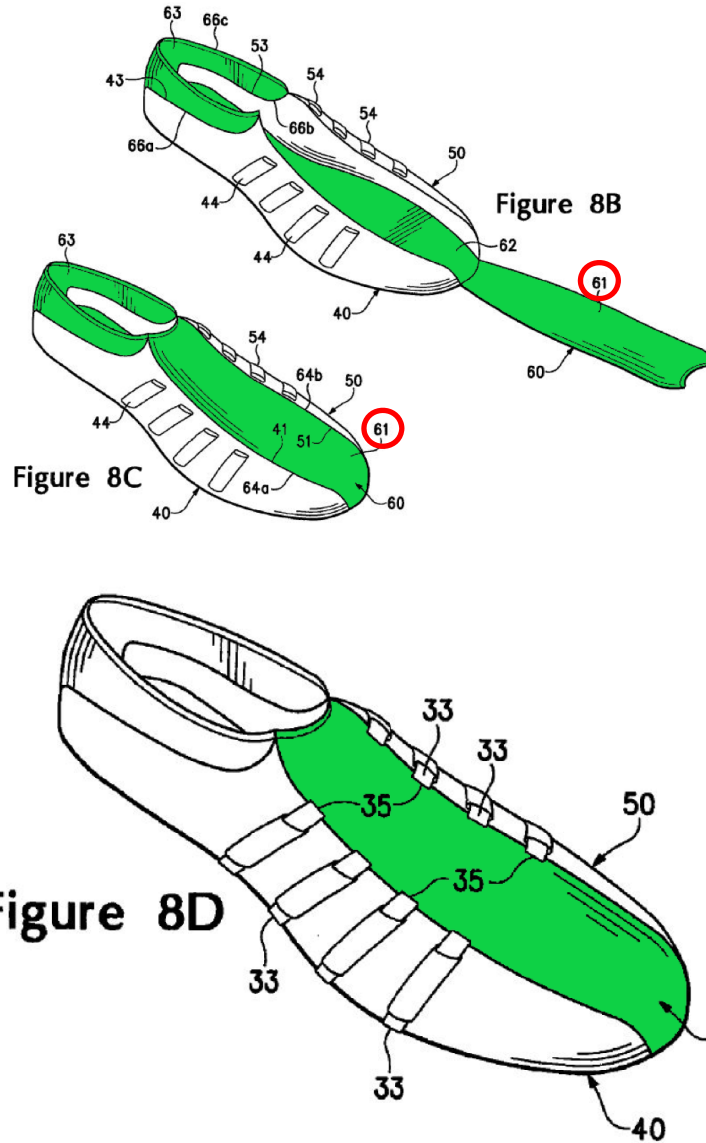


Id., FIG. 3. Specifically, forward portion 61 of central textile element 60 is shown below.



Id., FIG. 8A.

At least the “forward portion 61” of the central textile element 60 is an integral knit tongue that extends through a throat area of the knitted component in the assembled upper 30, as shown in green below. *Id.*, 5:60-62, 6:46-49.



Id., FIG. 8B-8D; 8:66-9:11; EX1002, ¶¶120-123.

For example, Dua-956 discloses that the “[f]orward portion 61 is primarily located in a throat area of footwear 10,” as expressly shown in FIG. 8C above, for example. EX1029, 6:49-50; *see also* FIGs. 3, 7, 8A-8E. Moreover, Dua-956 discloses that the “forward portion 61 of central element 60 is depicted as having a ribbed configuration that stretches to a different degree than the non-ribbed

configurations of center portion 62 and rearward portion 63,” and that “textile elements 40 and 50 may be formed from a less stretchable type of stitch than forward portion 61” *Id.*, 7:45-52. This is consistent with the ’636 patent’s description, including the disclosure of an “integral knit tongue portion 1310 of fourth knitted component 1300 [that] may be configured with throat area 1320 that is allowed to stretch to accommodate a foot of a wearer” EX1001, 16:17-29; *see also id.*, 17:62-67; 24:19-22; EX1002, ¶124. Thus, the forward portion 61 is an “integral knit tongue” because it is located in a throat area of the central textile element 60 (and of the overall upper 30). Moreover, the forward portion 61 provides for additional expansion of the upper through the throat area by virtue of its ribbed configuration, which is a basic feature of shoe design. EX1002, ¶125; EX1003, ¶¶19-21. The “forward portion 61” is also an *integral knit* tongue because it is formed as a unitary single piece with the rest of central textile element 60 (i.e., with center portion 62 and rearward portion 63). EX1029, 7:46-49. Thus, a POSITA would understand the forward portion 61 is an integral knit tongue at least under Nike’s apparent interpretations. EX1002, ¶¶125-127.

Therefore, Dua-956 satisfies Element 1[b].

Element 1[c]: *at least one raised element extending a height above the exterior surface of the knitted component;*

In the parallel litigation, Nike argued that the term “raised element” has an (unarticulated) ordinary and customary meaning that should apply. EX1007, 20-21.

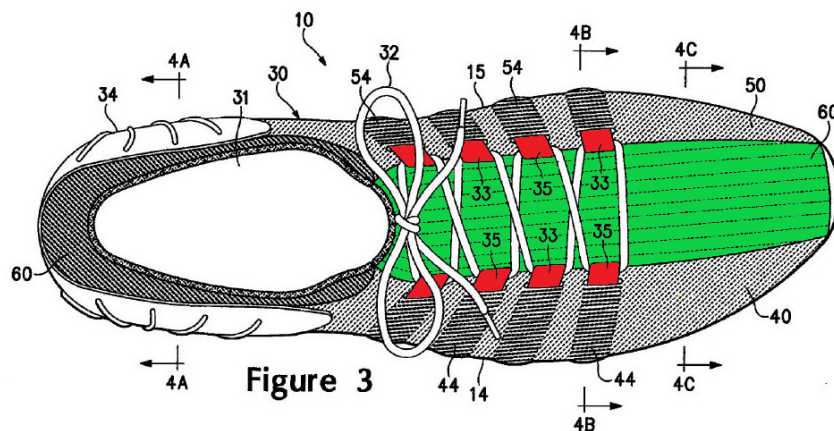
Nike's infringement contentions, portions of which are reproduced below, indicate that Nike's apparent understanding of "raised elements" is any structure of the footwear that extends above the exterior surface of the knitted component, which appears to also include the shoe laces. See below.

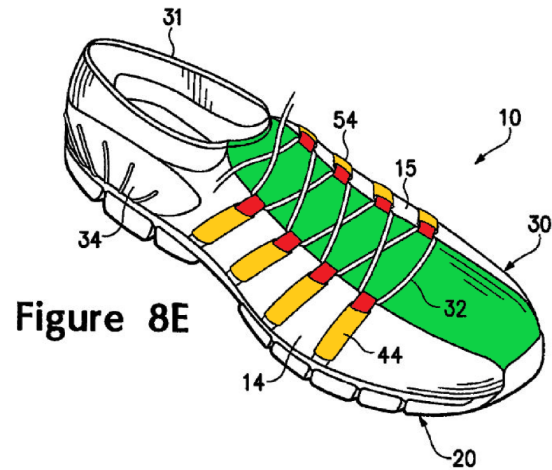
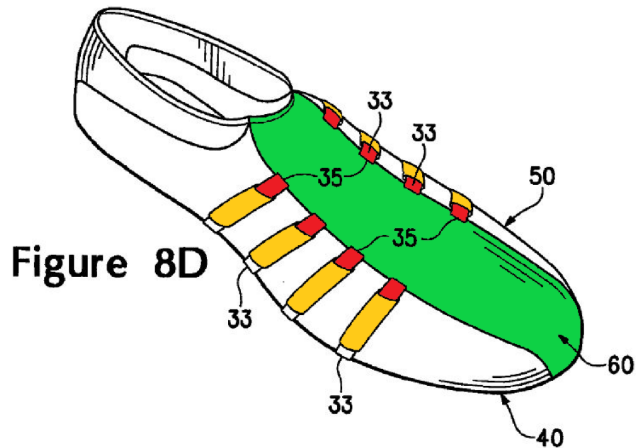




EX1011, 83-86.

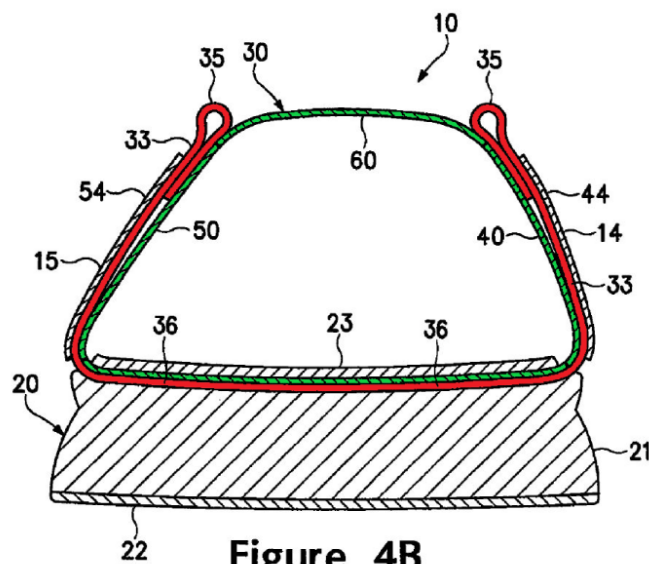
Dua-956 satisfies Element 1[c] under Nike's construction. Specifically, Embodiment #1 includes lace elements 33 extending through channels 44/54 and which have loops 35 formed on opposite ends of a central section, where the loops 35 are configured to receive lace 32. EX1029, 5:43-47; 9:15-21; 6:36-45.



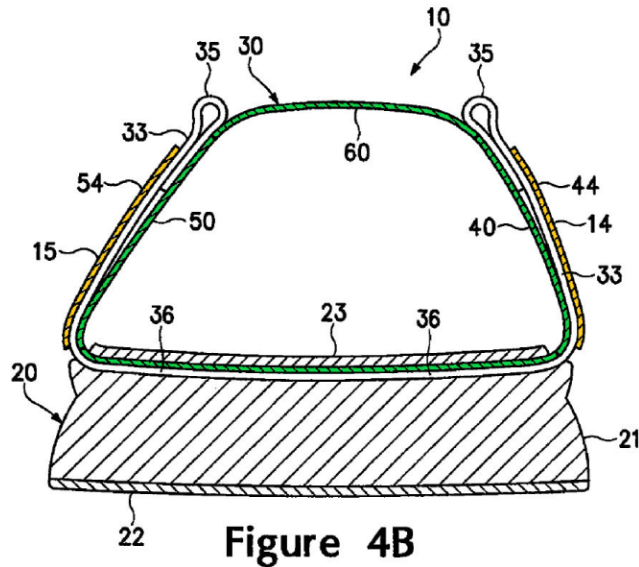


Id., FIGs. 3, 8D-8E (central section (corresponding to forward portion 61, per FIGs. 8B-8C) is colored in green, loops in red, and channels in yellow).

A POSITA would understand that loops 35 extend above the exterior surface of the upper 30 (knitted component), as is expressly shown in at least FIGs. 1-3, 4B, 8D-8E. See below showing exterior surface of the knitted element in green and lace elements 33 and loops 35 in red.

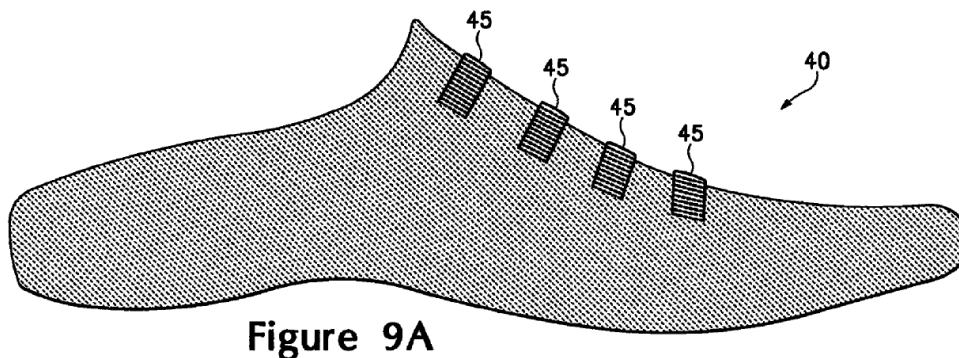


Id., FIG. 4B (annotated); EX1002, ¶¶128-132. In addition, channels 44/54 (colored in yellow below) similarly extend above the exterior surface of the upper 30, as shown in at least FIGs. 8A-8E.



EX1029, FIG. 4B.

Embodiment #1, which also includes FIGs. 9A-9B, includes lace loops 45 that extend above the exterior surface of the knitted component, as shown below.



Thus, at least Embodiment #1 satisfies Element 1[c] under at least Nike's apparent construction of "raised elements." EX1002, ¶¶128-135.

Element 1[d]: *wherein the integral knit tongue is joined to a forward portion of the throat area and at least along a portion of a lateral side and a medial side of the throat area of the knitted component extending from the forward portion to an ankle opening of the upper.*

Dua-956 expressly discloses an integral knit tongue (forward portion 61) that is joined along both lateral and medial sides of the throat area of the knitted component extending from a forward portion to an ankle opening of the upper. EX1002, ¶136. Specifically, with reference to FIGs. 7 and 8C, Dua-956 explains that the lateral edge 64a and media edge 64b of forward portion 61 are stitched to the textile elements 40 and 50, respectively. EX1029, 6:49-55 (“***Forward portion 61 is primarily located in a throat area*** of footwear 10 (i.e., under lace 32) and has an elongate configuration defined by a lateral edge 64a and a medial edge 64b.... [A]t least a portion of lateral edge 64a is joined to lateral textile element 40 and at least a portion of 55 medial edge 64b is joined to medial textile element 50.”); 9:5-11 (“[U]pper edge 41 of lateral textile element 40 is stitched to lateral edge 64a of forward portion 61, and upper edge 51 of medial textile element 50 is stitched to medial edge 64b of forward portion 61.”).

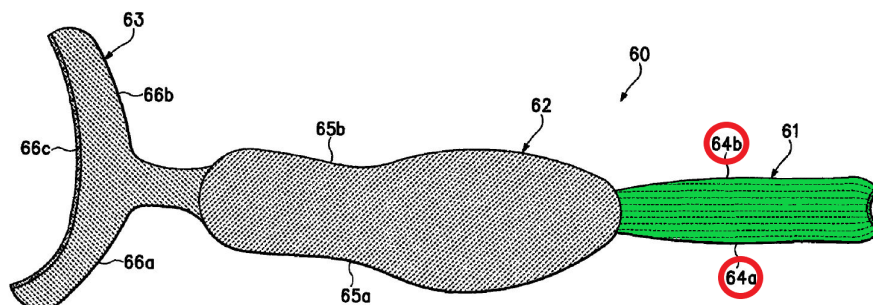
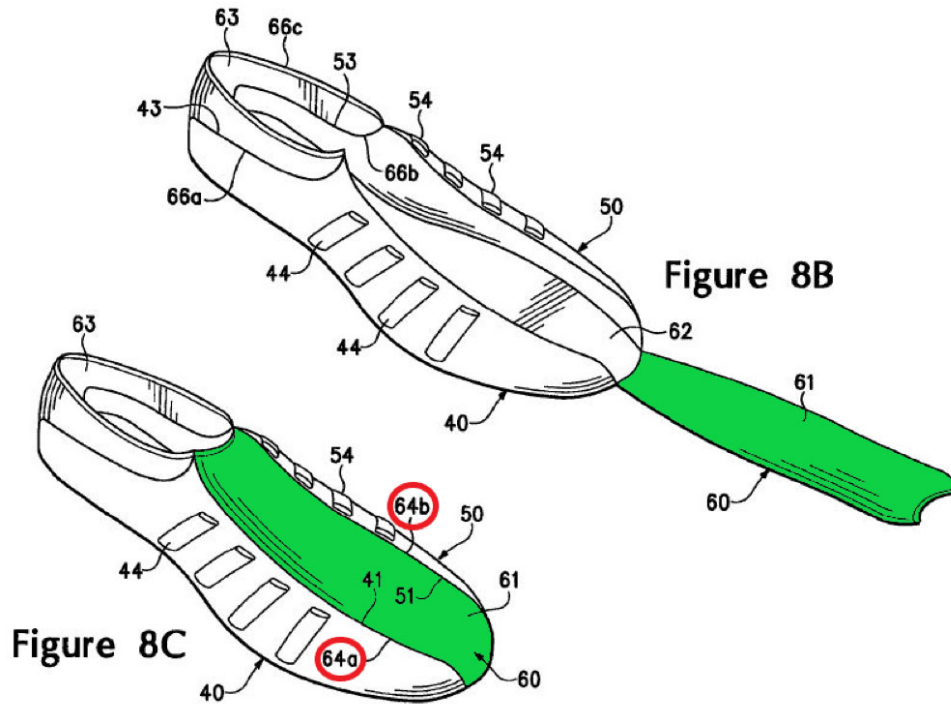


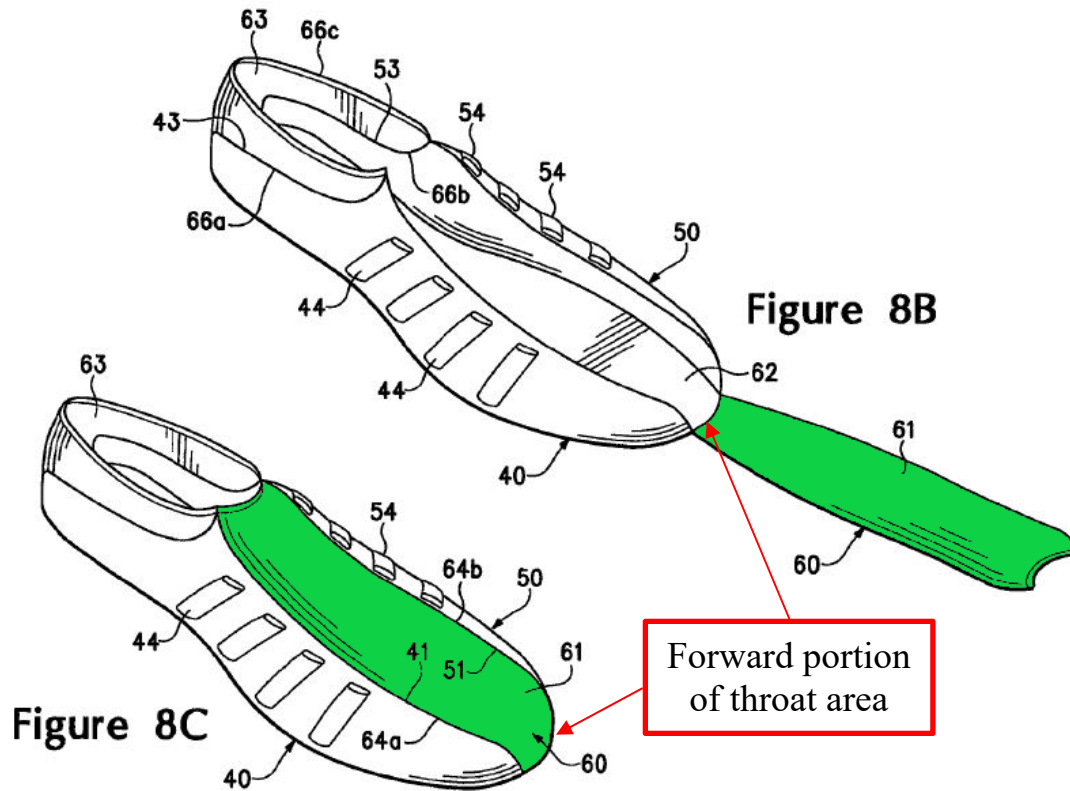
Figure 7



EX1029, FIGs. 7, 8B-8C (colored to show tongue in green and lateral/medial edge references in red).

Dua-956's integral knit tongue (forward portion 61) is joined to the forward portion of the throat area at least where the forward portion 61 is joined to the rest of central textile element 60 (i.e., joined to center portion 62), as shown below.

EX1002, ¶137.



Moreover, the claims do not define a forward *limit* on the throat area (i.e., where the throat area begins with respect to the front of the footwear), nor do they preclude joining other portions of the integral knit tongue. Moreover, Element 1[d] does not limit how the integral knit tongue is joined to the forward portion of the throat area, and therefore a POSITA would understand that the integral knit tongue may be joined to the forward portion of the throat area by knitting or stitching, as both can be used to join different parts of knitted textiles. EX1002, ¶138. In fact, the '636 patent discloses *joining* material both during the knitting process and after. See EX1001, 9:50-52 (stating that the “integral knit tongue 512 is *joined through knitting* to upper 502 at the forward portion of throat area 520”), 8:17-19

(“Although portions of first knitted component 500 may be *joined* to each other (e.g., edges of first knitted component 500 being joined together) *following the knitting process*”).

Therefore, Dua-956 anticipates claim 1 at least under Nike’s apparent constructions.

C. Claim 2

Dua-956 satisfies claim 2. For example, the integral knit tongue (forward portion 61) would be made using at least one course having a common yarn as the rest of central textile element 30 (e.g., center portion 62). EX1002, ¶140. In knitting, a course is a row of loops made with the same piece of yarn. EX1050, 8, 16-17 (“[A] course of loops is composed of a single length of yarn”); EX1002, ¶140. Dua-956 discloses that its central element 60, which is formed through a knitting process (EX1029, 7:5-6), includes “a forward portion 61, a center portion 62, and a rearward portion 63 *formed of unitary (i.e., one piece) construction.*” EX1029, 6:46-49. A POSITA understands that such a unitary, one-piece knit structure would include rows of loops (courses) formed with the same piece of common yarn which extends from the forward portion 61 to at least the center portion 62. EX1002, ¶140. Thus, Dua-956’s integral knit tongue (forward portion 61) would have a common course (row of loops) formed with the same yarn as that used for at least the center portion 62 of the one-piece central textile element 60, thereby anticipating claim 2. *Id.* This

is consistent with the '636 patent's disclosure that "integral knit tongue 512 is joined through knitting to upper 502 at the forward portion of throat area 520 such that integral knit tongue 512 and upper 502 include *at least one course in common* and/or include courses that are substantially continuous between integral knit tongue 512 and upper 502 at the forward portion of throat area 520." EX1001, 9:50-56; EX1002, ¶141.

D. Claim 3

The '636 patent discloses that a knit structure can be a "knit type" or yarn type. EX1001, 14:25-42, 18:6-8; EX1002, ¶143. Nike's infringement contentions indicate Nike has a broad understanding of the term.

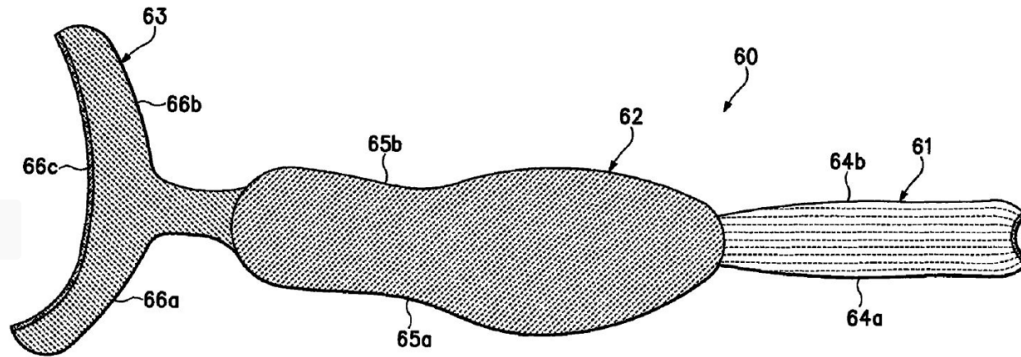


EX1011, 148.



Id., 163.

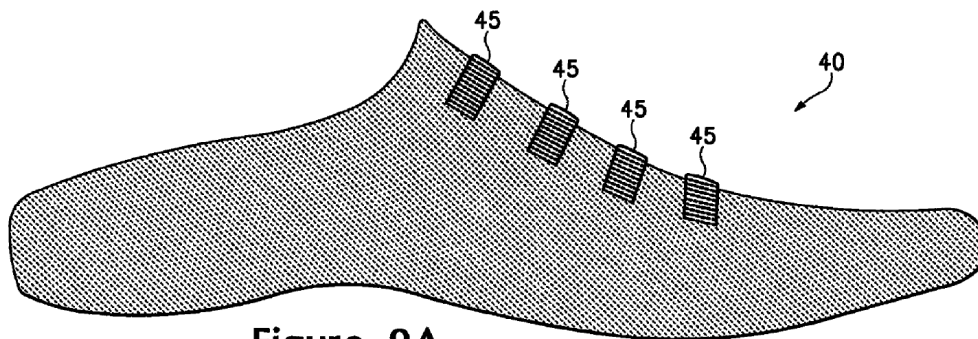
A POSITA would understand that a knitted component that is formed as a one-piece unitary structure would be generally formed using the same knit type, *e.g.*, a flat knit structure, a circular knit structure, etc. EX1002, ¶144. Consistent with that, Dua-956 anticipates claim 3 by disclosing that the central textile element 60 “may be formed through a flat knitting process,” and that the central textile element 60, which includes the tongue (forward portion 61) as well as other portions of the upper (center portion 62 and rearward portion 63), is “formed of unitary (i.e., one piece) construction.” EX1029, 6:46-49, 7:5-6.

**Figure 7**

In addition, those portions of the integral knit tongue that have a common course (row of loops) formed with the same yarn as the surrounding portions would similarly be formed from a common knit structure. EX1002, ¶¶145-147; *supra*, claim 2.

E. Claim 4

Under Nike's apparent construction of "raised elements," Dua-956 anticipates claim 4 at least because the three-dimensional lace loops 45 (shown below in FIG. 9A), which are used in place of channels 44/54, are formed using the same flat knitting process as the upper. EX1029, 9:29-57; EX1002, ¶¶148-149.

**Figure 9A**

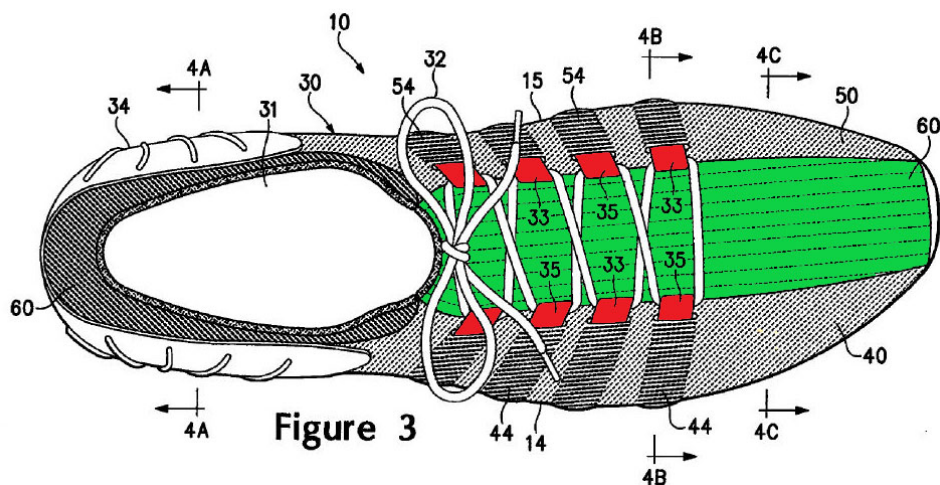
Moreover, unlike the channels 44/54, lace loops 45 depicted as being formed of unitary knit construction with the integral knit tongue at least because the lace loops 45 extend over the throat area (and therefore over the integral knit tongue), as shown above. EX1002, ¶¶149-150.

F. Claim 5

Under Nike's apparent construction of "raised element," Dua-956 anticipates claim 5 by disclosing multiple raised elements on each side of the throat area, extending above the exterior surface of the knitted component. *Supra*, Elements 1[b]-1[c]; *see also*, EX1002, ¶¶151-155.

G. Claim 6

Dua-956 anticipates claim 6 by disclosing lace apertures that receive laces at least in the form of loops 35 which are configured to receive lace 32. EX1029, 5:43-47; 9:15-21; 6:36-45.



Id., FIGs. 3; *see also* Elements 1[b]-1[c]; EX1002, ¶¶156-158. Embodiment #1 of Dua-956 also includes lace loops 45 in FIGs. 9A-9B, which receive portions of a lace. EX1029, 9:29-57.

H. Claim 8

Dua-956 anticipates claim 8 for the reasons above under Element 1[b]. For example, Dua-956 discloses that “the yarn selected for textile elements 40 and 50 may be more wear-resistant than the yarn selected for forward portion 61.” EX1029, 7:50-52. Dua-956 further discloses that “the knit/yarn combination utilized for rearward portion 63 may be selected to impart stretch and recovery to ankle opening 31,” (*Id.*, 7:53-55), which a POSITA would understand means that a different type of yarn can be used for rearward portion 63 than for forward portion 61. EX1002, ¶159. Moreover, Dua-956 broadly discloses that “the flat knitting process may be utilized to form a generally three-dimensional or overlapping structure having areas with different properties that are produced from combinations of different types of stitches and *different types of yarns*.” EX1029, 7:55-59, 12:21-26. In fact, Dua-956 expressly claims an upper having a knitted element formed from “a first yarn and a different second yarn, the first yarn being located in a first area of the upper, and the second yarn being located in a second area of the upper.” *Id.*, Claim 10.

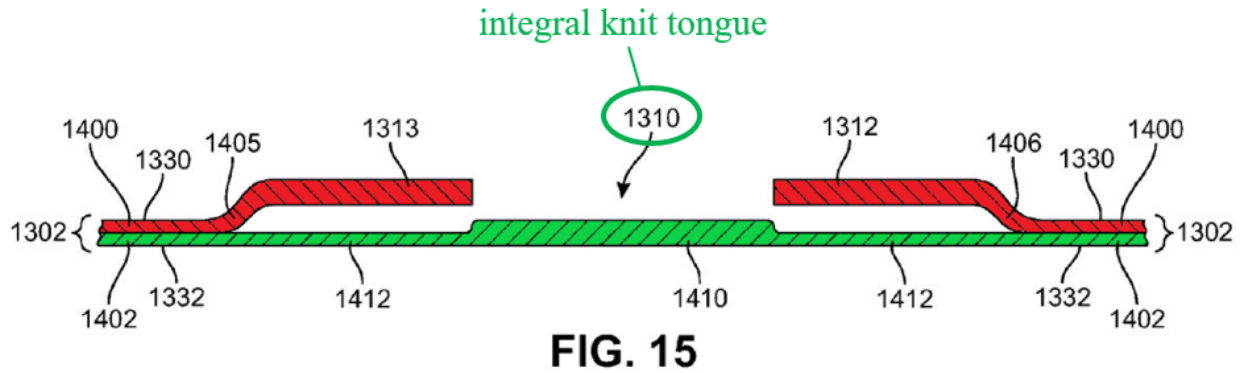
Therefore, the second type of yarn for forward portion 61 (integral knit tongue) would be different than the first type of yarn for other areas of the upper. EX1002, ¶159.

I. Claim 9

Dua-956 anticipates claim 9 by disclosing that “[i]n order to provide the stretch and recovery properties to upper 30, and particularly textile elements 40, 50, and 60, a yarn that incorporates an elastane fiber may be utilized.... Other fibers or filaments exhibiting elastic properties may also be utilized.” EX1029, 8:12-22; *see also* 8:27-28 (“Elastane fibers, as discussed above, provide substantial stretch and recoverability.”). Because the forward portion 61 (integral knit tongue) is part of central element 60, and because Dua-956 expressly discloses using elastane and other fibers having “elastic properties” for the central element 60, Dua-956 anticipates claim 9. EX1002, ¶¶161-162.

J. Claim 10

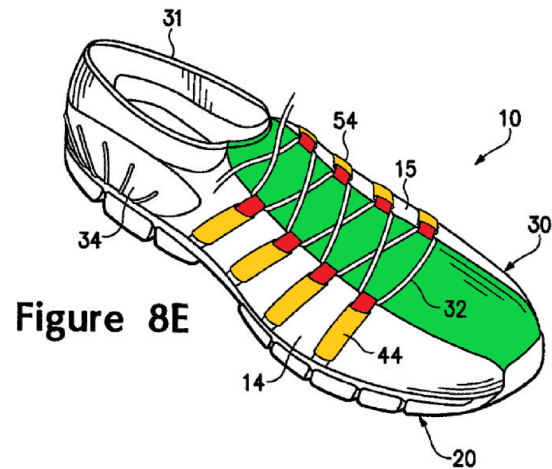
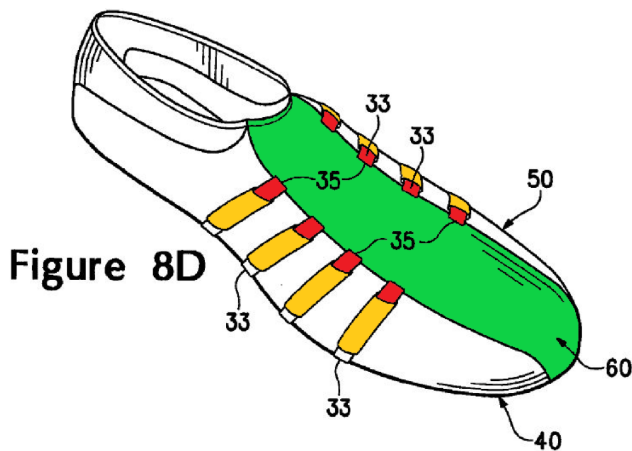
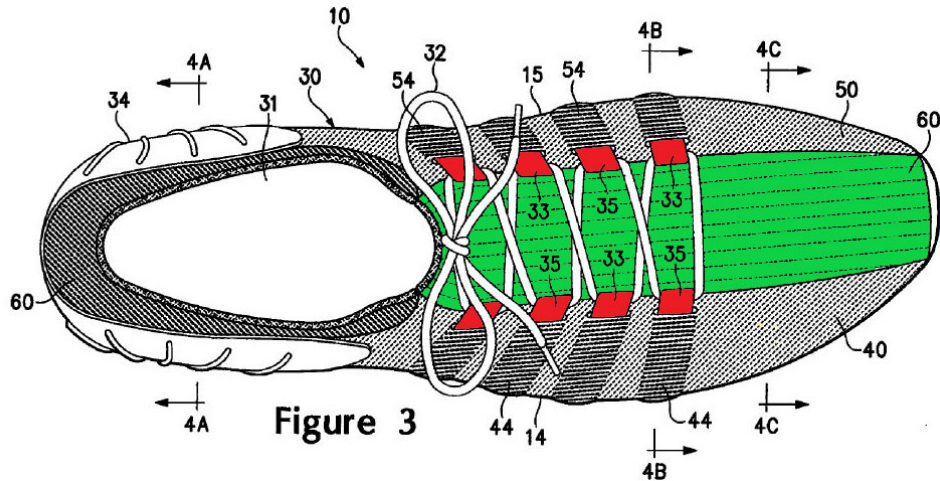
The '636 patent describes the first and second knit layers of claim 10 with reference to FIGs. 13-15. EX1001, 14:60-17:67. In particular, with reference to FIG. 15 the '636 patent describes a first knit element layer 1400 (colored in red) associated with an exterior surface (surface 1330), and a second knit element layer 1402 (colored in green) associated with an interior surface (surface 1332). *Id.*, 16:32-36.



EX1001, FIG. 15.

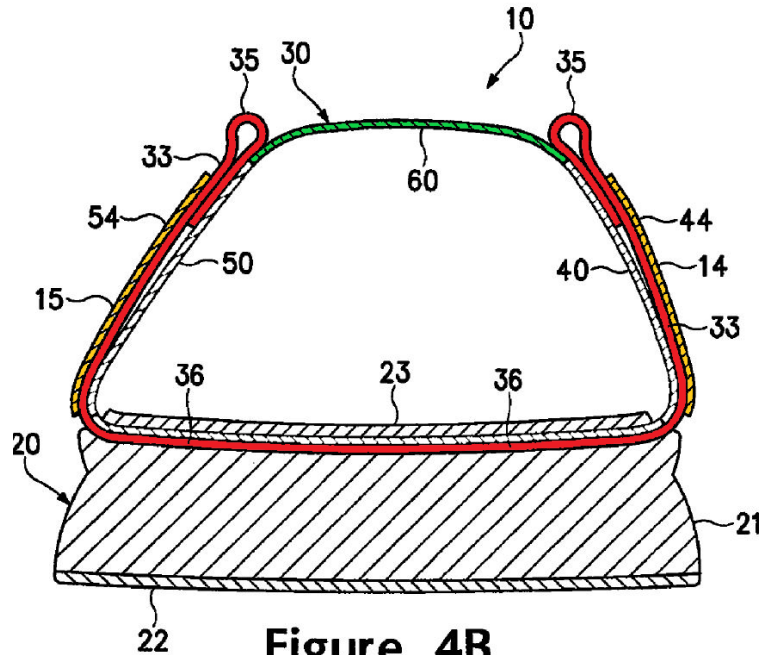
As shown above, the second layer 1402 includes integral knit tongue 1310, which in the embodiment of FIG. 15 has a first knit structure 1410 and second knit structure 1412. EX1001, 16:56-17:5; EX1002, ¶164. Moreover, although not claimed, the '636 patent describes the first layer 1400 as including the raised elements, i.e., “lateral raised element 1312 and medial raised element 1313.” *Id.*, 17:1-5.

Similarly, as described under Element [1b], Dua-956 discloses that the tongue (forward portion 61) is located in the throat area (EX1029, 6:49-55), with raised elements along the sides of tongue and throat area. In particular, Dua-956 discloses lace elements 33 extending through channels 44/54 and which have loops 35 formed on opposite ends of a central section. *Id.*, 5:43-47; 9:15-21; 6:36-45.



Id., FIGs. 3, 8D-8E (central section (corresponding to forward portion 61, per FIGs. 8B-8C) is colored in green, loops in red, and channels in yellow); EX1002, ¶165.

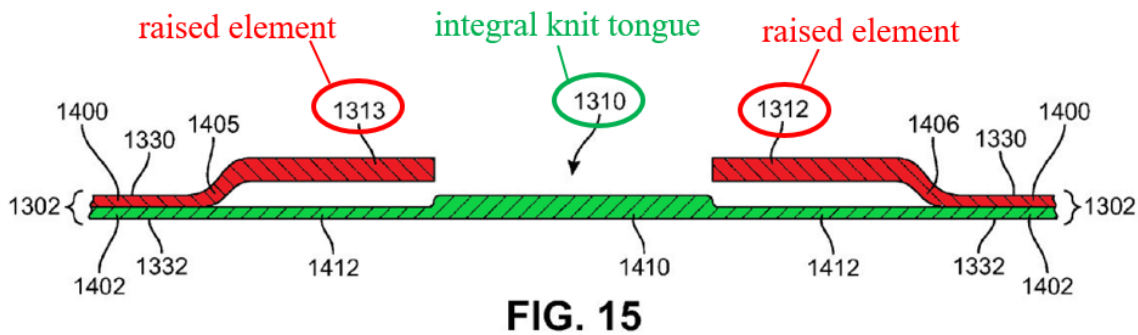
Dua-956 anticipates claim 10 at least because of the lace elements 33 and loops 35 (colored in red) and/or channels 44/54 (colored in yellow) that individually or in combination comprise the claimed “first knit element layer,” *i.e.*, a portion of the knitted component (e.g., upper 10) that is associated with the exterior surface. This is expressly shown in at least FIGs. 1-3, 4B, 8D-8E.



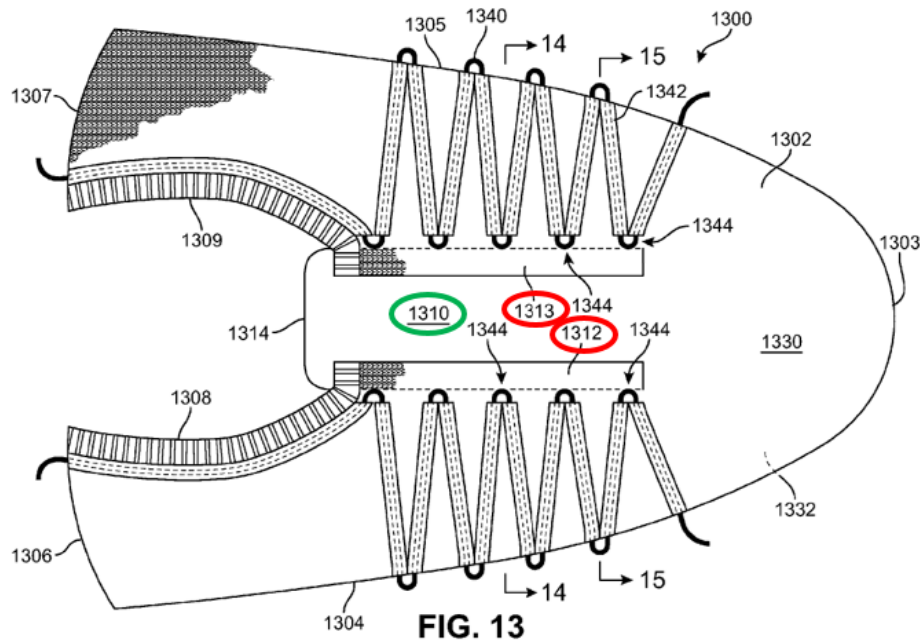
Id., FIG. 4B; EX1002, ¶166. Dua-956 also discloses the claimed “second knit element layer” which includes the “integral knit tongue” of central textile element 60 (colored in green above), which comprises a portion of the knitted component (upper 10) associated with the interior surface. EX1002, ¶167; *supra*, Element 1[a] (forward portion 61 of central textile element 60 is an integral knit tongue). Moreover, Dua-956 discloses that “the flat knitting process may be utilized to form generally three-dimensional structures wherein *layers of material* overlap each other (i.e., are at least partially coextensive) *to form loops* or other overlapping configurations, as with channels 44 and 54.” EX1029, 7:34-39, 6:36-41 (layers forming channels), 7:39-43 (same).

K. Claim 11

The '636 patent describes that the first and second layers 1400, 1402 are decoupled in the region associated with the integral knit tongue 1310. EX1001, 16:27-55. Specifically, the decoupled portion corresponds to a lateral raised element 1312 and a medial raised element 1313 that are formed of unitary knit construction with upper 1302, as shown below. *Id.*, 15:63-16:7; EX1002, ¶169.



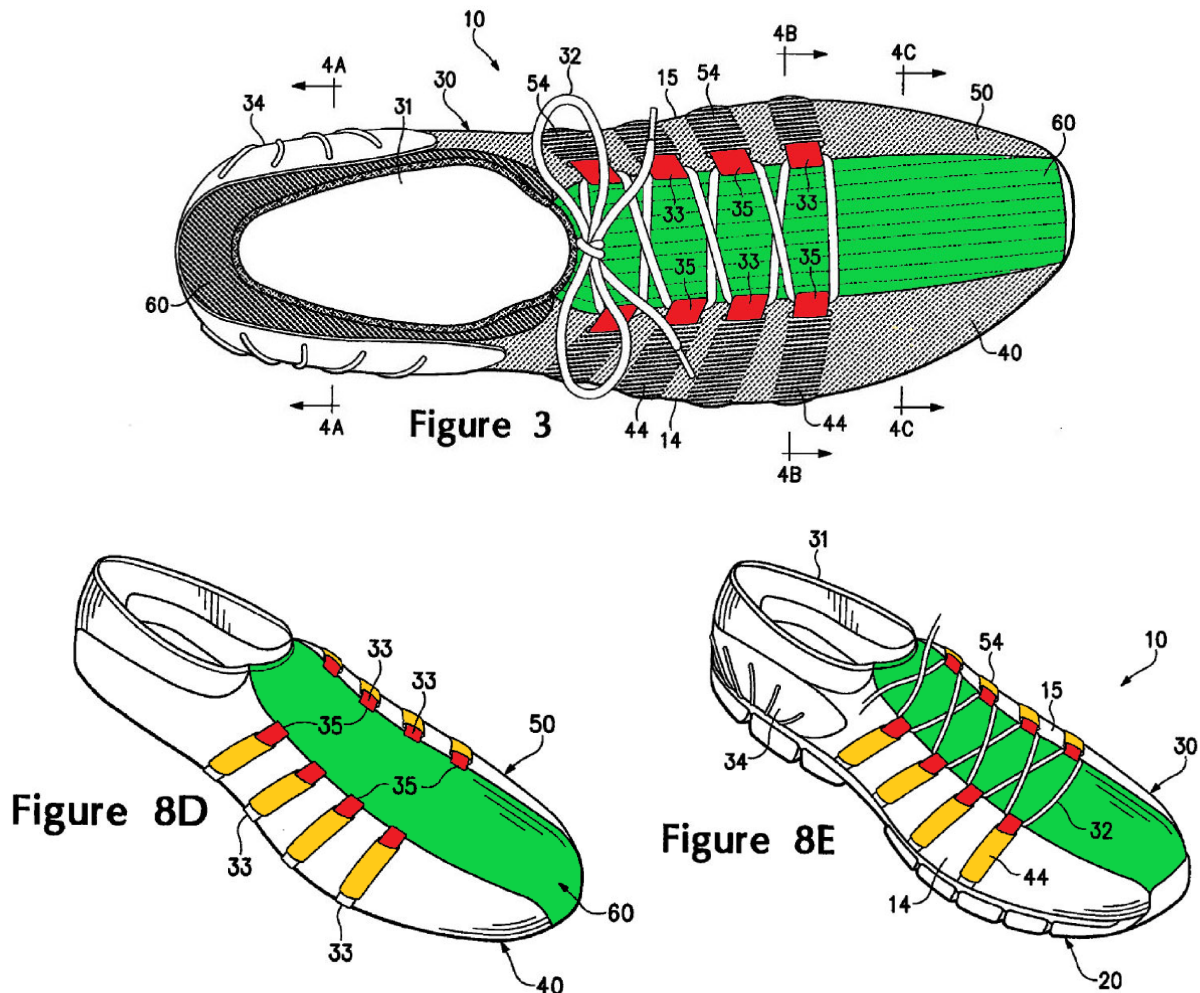
EX1001, FIG. 15. The integral knit tongue 1310 is depicted as being in the throat area between raised elements 1312/1313, as shown in FIG. 13 below.



EX1001, FIG. 13.

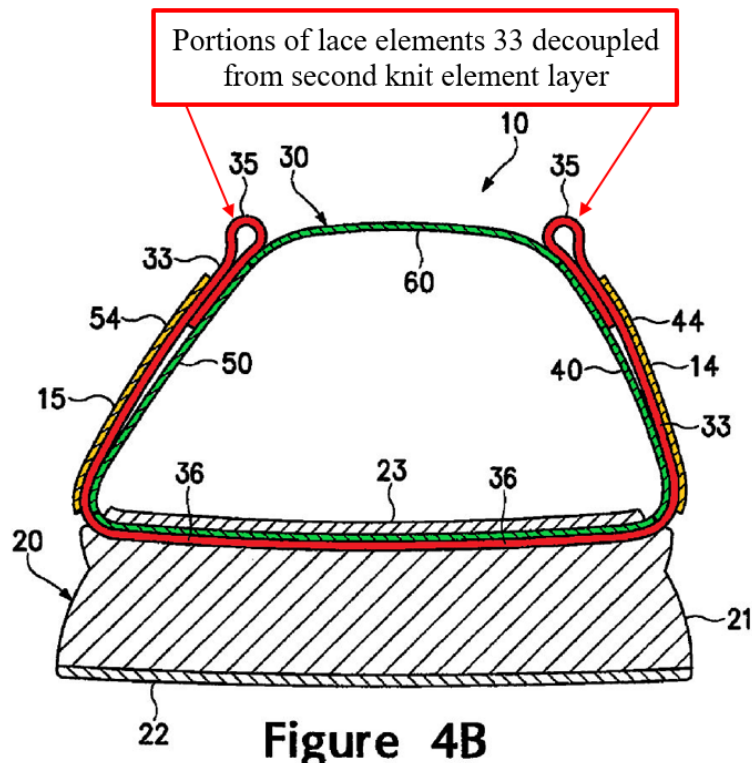
Thus, a POSITA would understand that the raised elements 1312/1313 correspond to claim 11's first portion of the first knit element layer (layer 1400 in red) being decoupled from the second knit element layer (layer 1402 in green) along the throat area. EX1002, ¶171.

Similarly, Dua-956 discloses raised elements in the form of lace elements 33 extending through channels 44/54 and forming loops 35 along the sides of the tongue (forward portion 61). EX10029 5:43-47; 9:15-21; 6:36-45.



Id., FIGs. 3, 8D-8E (central section (corresponding to forward portion 61, per FIGs. 8B-8C) is colored in green, loops in red, and channels in yellow).

Dua-956 anticipates claim 11 at least because the lace elements 33 and loops 35 (colored in red above and below) and/or channels 44/45 (colored in yellow above and below), which individually or in combination comprise the claimed “first knit element layer,” have a portion that is decoupled from the second knit element layer (colored in green above and below).

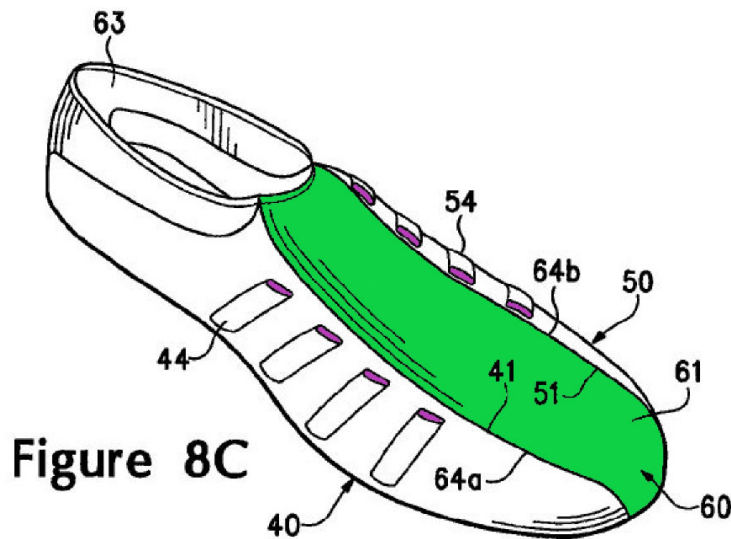


Id., FIG. 4B; EX1002, ¶¶172-173.

For example, at least the loop 35 portion of the lace elements 33, as well as the middle of channels 44/54, are decoupled from the layer forming upper 30 in an analogous fashion as the raised elements 1312/1313 of the '636 patent, as shown for

example in FIGs. 1-3, 4B, 5-6, 8A-8E, 9A-9B, and 10A-10B of Dua-956. EX1002, ¶174. Dua-956 particularly discloses forming “generally three-dimensional structures wherein *layers of material* overlap each other (i.e., are at least partially coextensive) *to form loops* or other overlapping configurations, as with *channels 44 and 54.*” EX1029, 7:34-39, 6:36-41, 7:39-43.

Also, because channels 44/54 accommodate the lace elements 33 and loops 35 along the medial and lateral sides of forward portion 61 (integral knit tongue) which is along the throat area (EX1029, 6:49-55), the layers forming such channels 44/54 are similarly decoupled along the adjacent sides of the throat area, particularly at the opening of the channels proximate the throat area, as shown below in purple.

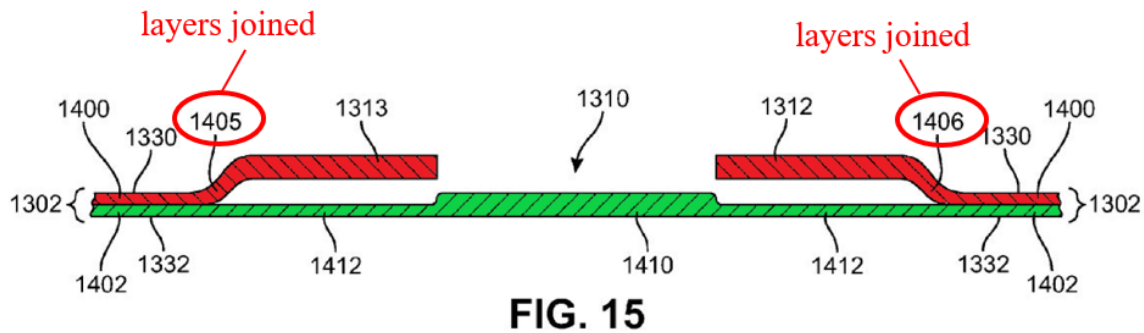


EX1029, FIG. 8C (forward portion 61 (integral knit tongue) shown in green, channel opening in purple); EX1002, ¶¶175-176.

Thus, Dua-956 also anticipates Claim 11.

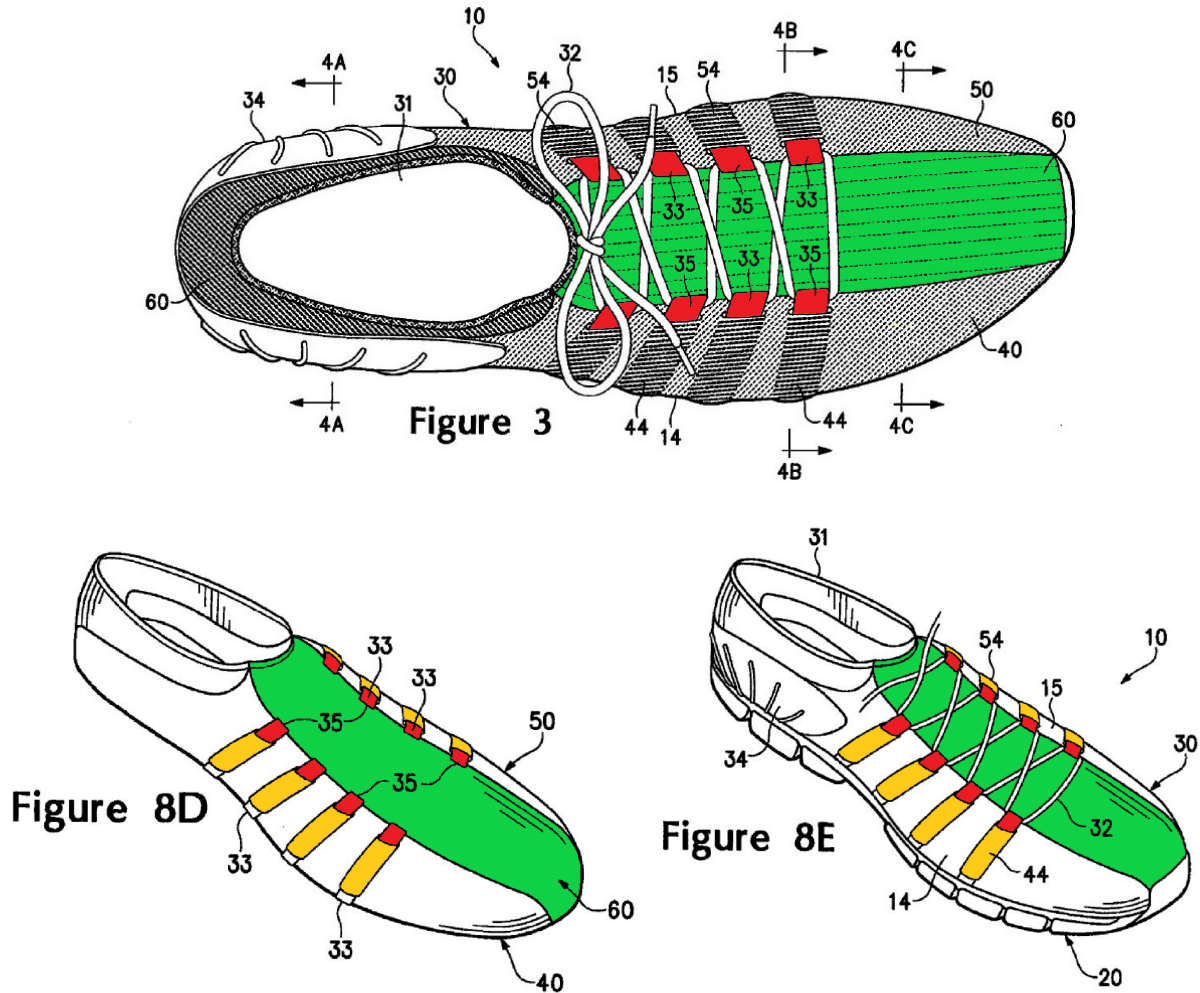
L. Claim 12

The '636 patent describes, with reference to FIGs. 14-15, that the first knit element layer 1400 is joined to the second knit element layer 1402 at a first end 1405 where raised element 1312 begins, and a second end 1406 where the medial raised element 1313 begins. EX1001, 17:28-67.



EX1001, FIG. 15; *see also* FIG. 14.

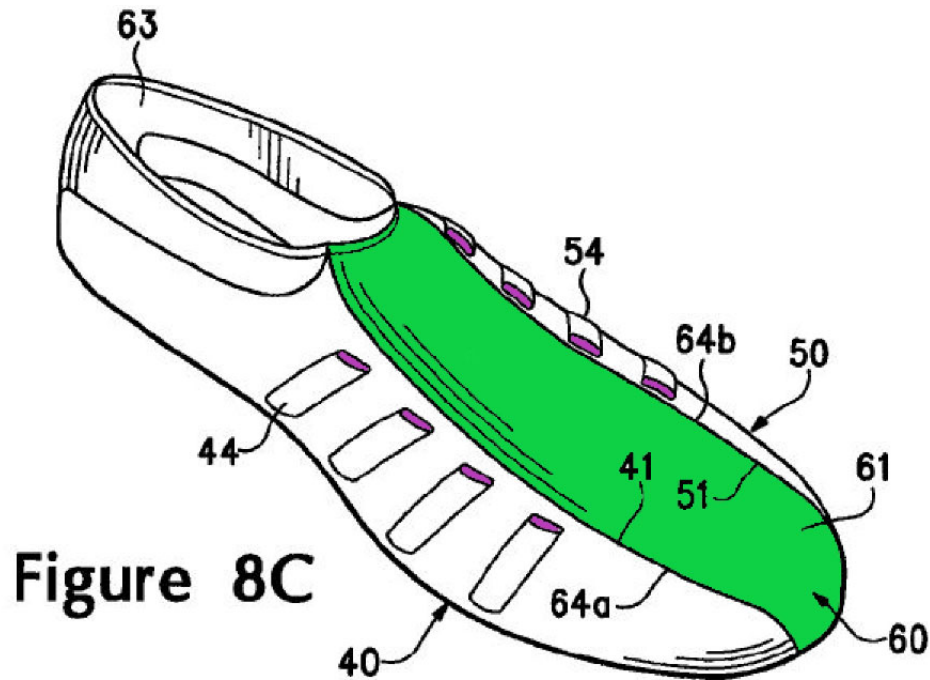
Similarly, Dua-956's lace elements 33 and loops 35 (colored in red below) and/or channels 44/45 (colored in yellow below), which individually or in combination comprise the claimed "first knit element layer," have portions that are joined to the second knit element layer (colored in green below) along the throat area of the knitted component (e.g., upper 30).



Id., FIGs. 3, 8D-8E (central section (corresponding to forward portion 61, per FIGs. 8B-8C) is colored in green, loops in red, and channels in yellow).

Specifically, the layer forming channels 44/54 has a portion joined to the layer forming the upper 30 (second knit element layer), as shown in FIG. 4B for example. EX1029, 6:36-41, 7:34-43 (describing layers forming loops and channels); EX1002, ¶¶177-179. Because the channels 44/54 accommodate the lace elements 33 and loops 35 along the medial and lateral sides of forward portion 61 (integral knit tongue), which is along the throat area (EX1029, 6:49-55), the layers forming such

channels 44/54 are similarly joined along the adjacent sides of the throat area, particularly at the sides defining the opening of the channels proximate the throat area, as shown below in purple.



EX1029, FIG. 8C (forward portion 61 (integral knit tongue) shown in green, channel opening in purple); EX1002, ¶¶179-180.

M. Claims 13-17 and 19-27

Claims 13-17 and 19-27 are substantially similar to claims 1-6 and 8-12 and are therefore anticipated for the same reason. The analysis corresponding to each of claims 13-17 and 19-27 is identified in the table below.

Claim	Corresponding Analysis
13[pre]	Element 1[pre]; EX1002, ¶¶97-99, 181.

13[a]	Element 1[a1]-1[a2]; EX1002, ¶¶100-119, 182.
13[b]	Element 1[b]; EX1002, ¶¶120-127, 183.
13[c]	Element 1[c]; Claim 6 for lace aperture configured to receive a lace; EX1002, ¶¶128-135, 156-158, 184.
13[d]	Element 1[d]; EX1002, ¶¶136-139, 185
14	Claim 2; EX1002, ¶¶140-142, 186.
15	Claim 3; EX1002, ¶¶143-147, 187.
16	Claim 4; EX1002, ¶¶148-150, 188.
17	Claim 5; EX1002, ¶¶151-155, 189.
19	Claim 8; EX1002, ¶¶159-160, 190.
20	Claim 9; EX1002, ¶¶161-162, 191.
21[pre]	Element 1[pre]; EX1002, ¶¶97-99, 192.
21[a]	Elements 1[a1], 1[a2], 1[b]; EX1002, ¶¶100-127, 193-196.
21[b]	Claim 10; EX1002, ¶¶163-168, 197-198. Element 1[a2] for additional analysis of interior/exterior surfaces and void for receiving a foot; EX1002, ¶¶116-119.
21[c]	Element 1[d]; EX1002, ¶¶136-139, 199.
22	Claim 10; EX1002, ¶¶163-168, 200.
23	Claim 11; EX1002, ¶¶169-176, 201.
24	Claim 12; EX1002, ¶¶177-180, 202.
25	Claim 2; EX1002, ¶¶140-142, 203.
26	Claim 4; EX1002, ¶¶148-150, 204.

27	Element 1[c] and Claim 10; EX1002, ¶¶128-135, 163-168, 205.
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VII. GROUND 1B: CLAIMS 1-6, 8-17, AND 19-27 ARE OBVIOUS OVER DUA-956 ALONE OR IN VIEW OF HORII

A. It Would Have Been Obvious to Construct Embodiment #1 Using Dua-956's Approach for Embodiments #2-#3

If Dua-956 alone is deemed not to expressly disclose “the knitted component defining the upper” of Element 1[a1], it would have been obvious to form Dua-956's upper 30, for example, as a single, unitarily knitted component based on Dua-956's express disclosure of other embodiments that are formed as a unitarily knitted component. For example, Dua-956 discloses a “second upper” described with reference to FIGs. 10A-10C (“Embodiment #2”), and a “third upper” described with reference to FIGs. 11A-11B (“Embodiment #3”). EX1029, 3:24-64. In contrast to upper 30 of Embodiment #1 in which textile elements 40, 50, and 60 may be knitted individually before being joined together by stitching, the uppers of Embodiments #2-#3 are each formed as a one-piece unitary flat knit structure. EX1002, ¶¶207-211. For example, Embodiment #2 (FIGs. 10A-10C) includes an upper 70 described as “another example of a three-dimensional structure formed through a flat knitting

process,” where the “[u]pper 70 includes a central portion 71, a pair of side portions 72, and eight lace loops 73,” as shown below. *Id.*, 9:58-61.⁶

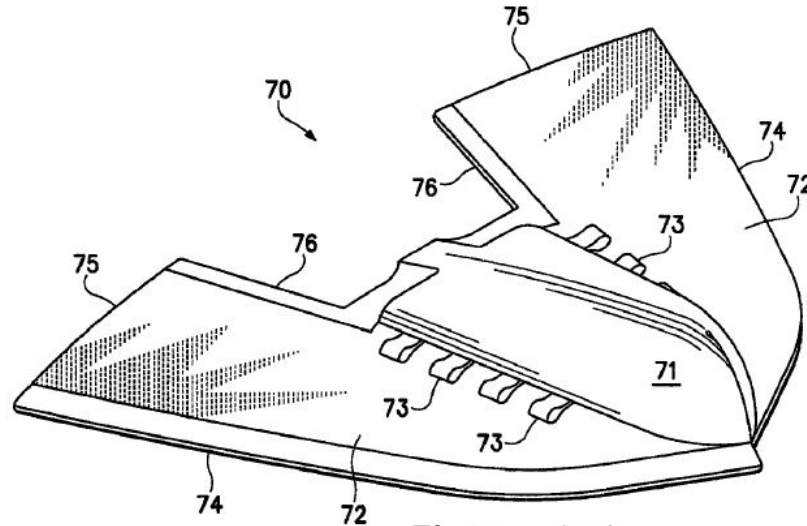


Figure 10A

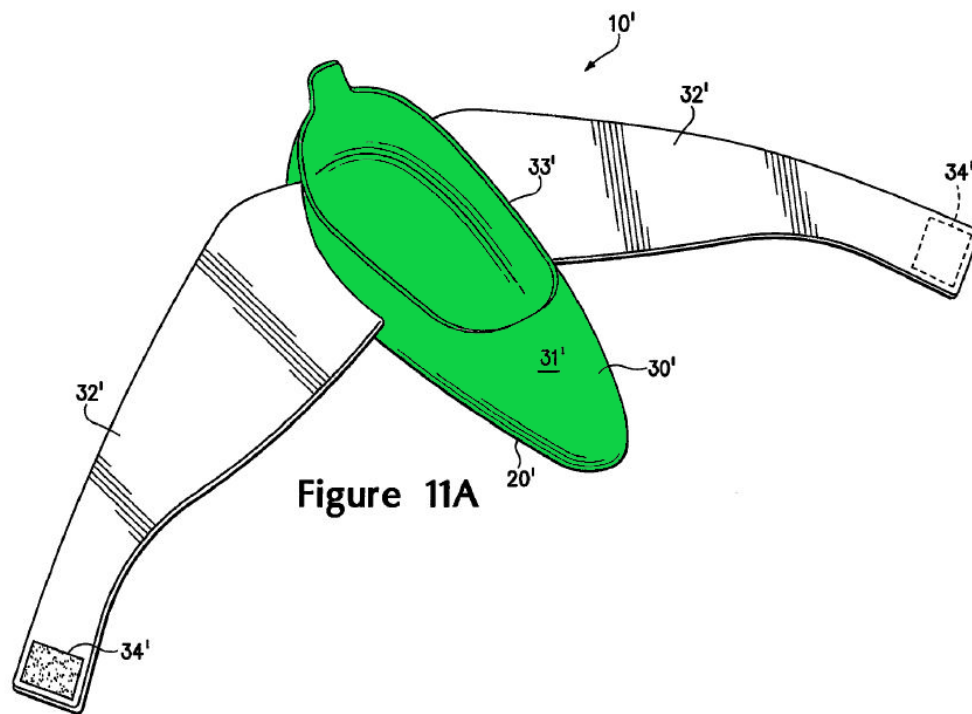
Id., FIG. 10A.

Because upper 70 is “a three-dimensional structure formed through a flat knitting process” (*Id.*, 9:58-61), a POSITA would understand that the central portion and the side portions of upper 70 are part of a unitary (one-piece) knit structure.

⁶ While the concepts disclosed in the ’636 patent are illustrated as being associated with footwear designed for running, those “concepts also may be applied to footwear styles that are generally considered to be non-athletic, including dress shoes, loafers, sandals, and work boots” and generally “may be applied to a wide variety of footwear types.” EX1001, 5:25-36.

EX1002, ¶210. This is consistent with Nike’s own representation of FIG. 10A. EX1038 (IPR2023-01460, Paper 19), 5 (“Figure 10A of the ’484 Patent, which is reproduced below, shows an embodiment of an upper having a knitted element with a ‘three-dimensional structure formed through a flat knitting process.’”).⁷

Similarly, for upper 30' of Embodiment #3 Dua-956 discloses that the “[u]pper 30' includes a foot-receiving portion 31' and a pair of straps 32',” where the “[f]oot-receiving portion 31'” (colored in green) “is formed of unitary (i.e., one piece) construction by the flat knitting process.” EX1029, 10:31-35.



⁷ The ’484 patent is related to and shares a common specification with Dua-956.

EX1037 (’484 patent).

Id., FIG. 11A. Dua-956 explains that the unitary (i.e., one piece) flat knit foot-receiving portion 31' is “a textile element shaped to extend around the foot” and “has an opening 33' for inserting and removing the foot from upper 30'.” *Id.*, 10:35-38.

Thus, both upper 70 and 30' are constructed as a single, unitary knit element that defines the upper, and it would have been obvious to construct upper 30 in the same manner. EX1002, ¶¶207-213. For example, a POSITA would have been motivated to construct upper 30 of Embodiment #1 in the manner described for uppers 70 and 30' (Embodiments #2-#3), including at least for reasons found in Dua-956. For example, in contrasting upper 30 (the “first upper”) with upper 30' (the “third upper”), Dua-956 explains that “upper 30' is free from seams that may contact the foot during use” because the “foot-receiving portion 31' of this example structure 10' is formed to extend around the foot and does not include seams adjacent the foot.” EX1029, 11:1-12. In addition to avoiding seams contacting the foot, as Dua-956 discloses, there was a known desire to minimize the amount of seaming required for constructing shoe uppers. EX1003, ¶11; EX1002, ¶213. Adopting the use of a single, unitary knit structure for upper 30 would achieve that benefit. *Id.*

Constructing uppers as unitary structures, as found both in Dua-956 and generally, provides additional benefits. For example, Dua-956 describes that one of the benefits of flat knitted elements is that they “can be formed directly in desired three dimensional shapes, which can help avoid the need to use additional support

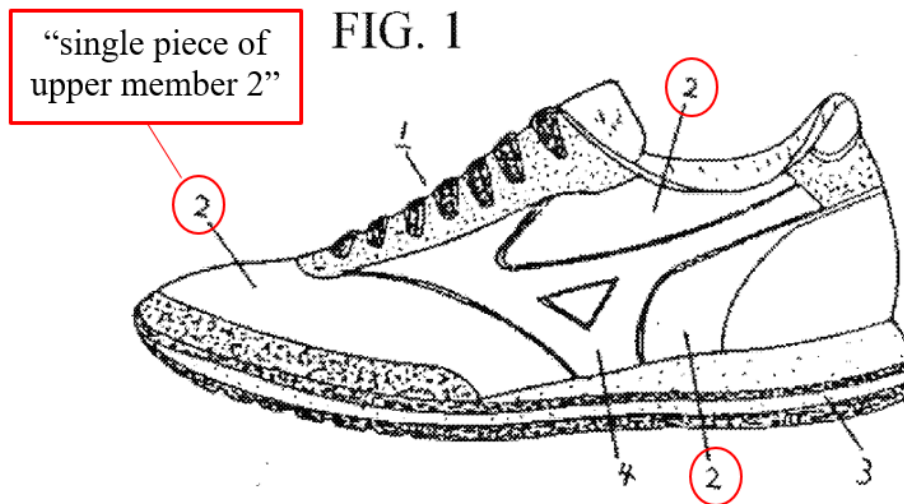
structures in the overall footwear construction (which also saves time, money, etc.; produces a lighter and/or more flexible product; may eliminate seams and at least some sewing, etc.; etc.)” EX1029, 4:34-39. Thus, a POSITA would understand that additional benefits would flow from forming upper 30 in the final “desired three dimensional shape” of the upper as a single, unitary component. For example, the additional step of stitching together or assembling textile elements 40, 50, and 60 into upper 30 would no longer be necessary, thereby saving the time and cost associated with the additional assembly process. EX1002, ¶214. Forming upper 30 as a single, unitary component in its final “desired three dimensional shape,” as Dua-956 discloses for Embodiments #2 and #3, would be referred to as a “knit-to shape” upper, which Nike has argued would eliminate cutting and sewing post-processing steps. EX1038, 3-4; EX1002, ¶214. In addition, the manners in which uppers 30, 30' and 70 are formed represent a finite number of options for the construction of an upper. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“finite number of identified, predictable solutions” that lead to anticipated success “is likely the product, not of innovation, but of ordinary skill and common sense”). It would at least have been obvious to try to construct Embodiment #1 using the approach expressly disclosed in the same reference. EX1002, ¶¶215-216. Moreover, a POSITA would have regarded the approach of Embodiments #2-#3 as at least a “suitable option” for constructing the Embodiment #1. *Id.*; *See Intel Corporation v.*

Qualcomm Incorporated, 21 F.4th 784, 800 (Fed. Cir. 2021) (“It’s not necessary to show that a combination is ‘the best option, only that it be a suitable option.’”) (quoting *PAR Pharmaceutical, Inc. v. TWI Pharmaceuticals, Inc.*, 773 F.3d 1186, 1197–98 (Fed. Cir. 2014)). Moreover, a POSITA would have reasonably expected success in constructing upper 30 as a single, unitary knit component, as Dua-956 expressly discloses. EX1002, ¶47-66, 217.

B. It Would Have Been Obvious to Modify Embodiment #1 of Dua-956 With Horii

It would also have been obvious to combine Dua-956 and Horii in order to construct Dua-956’s upper 30 (Embodiment #1) as a single, unitary knit component based on Horii teachings. EX1002, ¶¶218-224.

Horii discloses “shoes 1 that are characterized by the fact that the *entire upper is constructed of a single piece of upper member 2 that is made through weft knitting or circular knitting.*” EX1017, 9.



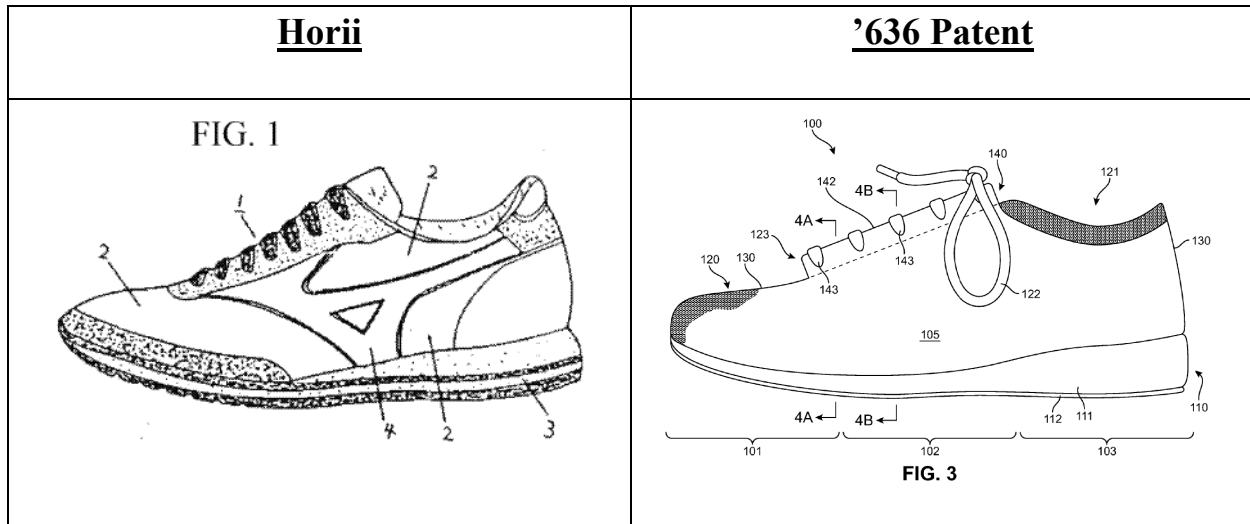
Id., FIG. 1.

Horii discloses its unitary knit upper can be formed by flat knitting or circular knitting. *See id.*, 7 (describing “shoes [that] are made of fabric made through weft knitting formed ***using a flat knitting machine*** or multi-layer knit fabric made through circular knitting formed using a circular knitting machine as the upper member”); 1, 4-5, 7-9 (describing entire upper member 2 as a single piece of knitted fabric). Dua-956 similarly describes its uppers as being formed by a flat knitting process, and that “other types of knitting may also be utilized,” including circular knitting. EX1029, 7:27-33.

A POSITA would have been motivated to manufacture Dua-956’s upper 30, for example, using the multilayer, single fabric of Horii because Horii’s single-piece knit upper would have provided upper 30 with a seamless structure, which Dua-956 expressly touts as desirable (EX1029, 11:1-12). Implementing Horii’s single-piece construction would also achieve the other benefits regarding time and cost savings described above. *Supra*, Section VII.A; EX1002, ¶¶219-221.

A POSITA would have particularly looked to Horii because it is directed to “sports shoes,” similar to at least some embodiments of footwear 100 of the ’636 patent. EX1017, 4, 11, 14; EX1001, 5:25-36 (characterizing the illustrations in the ’636 patent “as having a general configuration suitable for running,” and explaining

that the concepts of the '636 patent “may be applied to a wide variety of footwear types,” including “a variety of other athletic footwear types”). EX1002, ¶¶222.



Moreover, a POSITA would be particularly motivated to incorporate Horii's teachings when constructing the upper 30 of Dua-956 because Horii describes a single fabric, multilayer structural knit component that provides “good breathability and cushioning” for the shoe (EX1017, 9), and which is expressly described as overcoming conventional drawbacks of using woven and knit fabrics for shoes. EX1017, 6-9, 12-13; EX1002, ¶223.

Finally, a POSITA would have reasonably expected success in constructing upper 30 as a single, unitary knit component, particularly since both Horii and Dua-956 disclose doing so. EX1002, ¶¶47-66, 224.

C. Dua-956's Unitary Knit Upper Satisfies Claims 1-6, 8-17, and 19-27 For the Reasons Provided Under Ground 1A

As explained in Sections VII.A-VII.B, it would have been obvious to construct Dua-956's upper 30 as a single, unitary knit element, like Dua-956's upper 70 and 30'. This unitary knit upper, which would be obvious to construct in light of Dua-956 alone or in combination with Horii, satisfies claims 1-6, 8-17, and 19-27 for the reasons described above under Ground 1A. *Supra* Section VI.

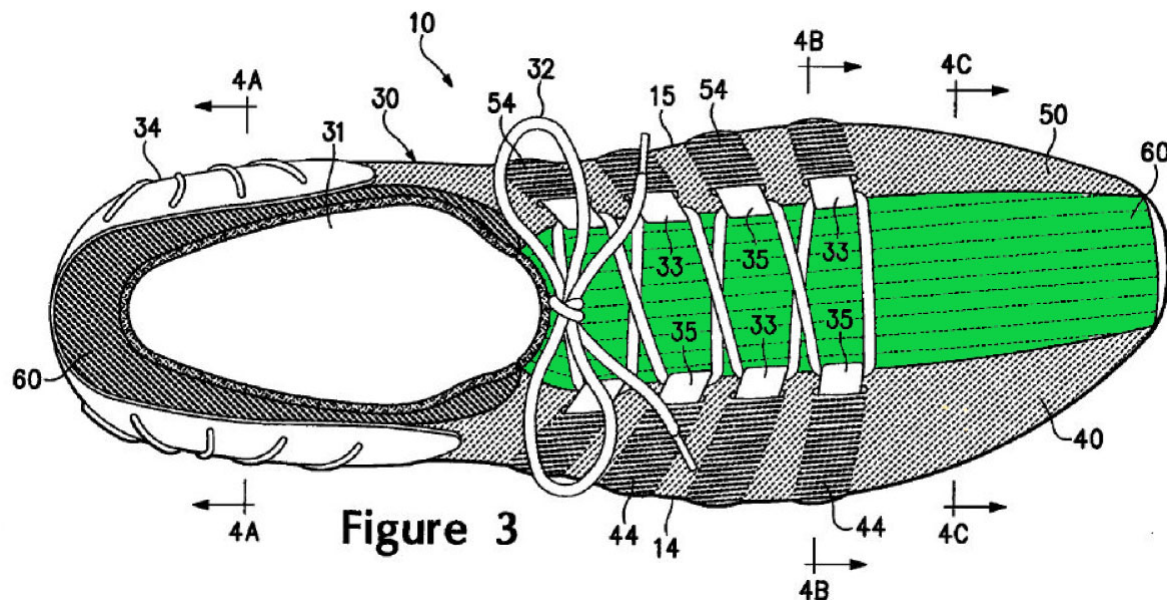
Constructing Dua-956's upper 30 as a single, unitary knit component would not materially change the analysis under Ground 1A. For example, a POSITA would understand that the unitary knit upper would still have an exterior surface and an inner surface defining a void for a receiving a foot, per Element 1[a2]. EX1002, ¶¶225-226. Similarly, lace elements 33, channels 44/54, and loops 35, along with the other structures identified under Ground 1A, would remain in their same location and configuration even when constructing upper 30 as a single, unitary component. *Id.*

VIII. GROUND 1C: CLAIMS 1-6, 8-17, and 19-27 ARE OBVIOUS UNDER GROUNDS 1A-1B IN FURTHER VIEW OF CALDERONE

In the parallel litigation, Skechers proposed that certain claim terms should be construed. Specifically, Skechers proposed that the term “integral knit tongue” corresponds to the “throat area between overhanging portions of the upper or adjacent to one or more raised elements.” EX1008, 5-12. Skechers further proposed

that the term “throat area” in the context of the ’636 patent means “an area of the upper that extends from an ankle opening over the instep to an area adjacent to the forefoot region.” *Id.*, 12-13.⁸ Finally, Skechers proposed that “raised element” means “a flap or overhanging portion that extends outward away from the surface of the upper and along the length of the side of the tongue.” *Id.*, 5.

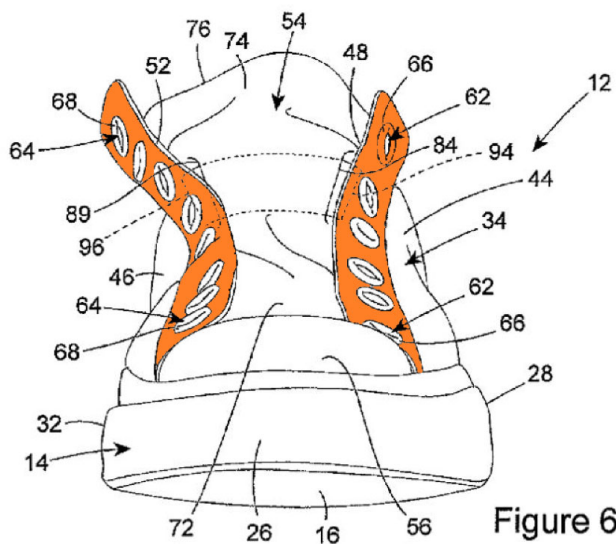
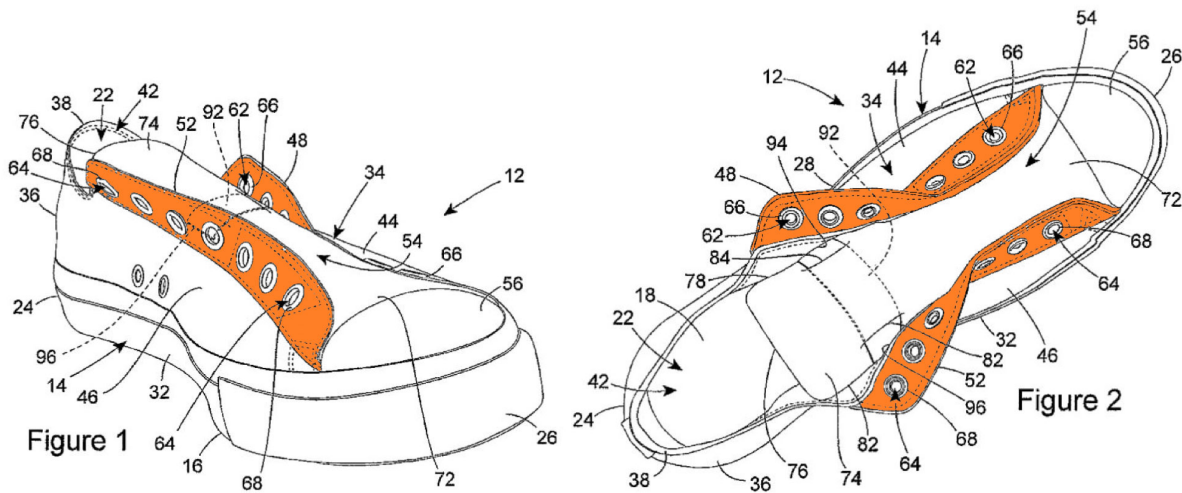
Dua-956 alone discloses overhanging portions that extends outward away from the upper and along the side of the tongue. EX1002, ¶229. Specifically, at least lace elements 33 and/or loops 35 are portions of the upper overhanging the throat area, as illustrated below.



⁸ As noted above. Nike appears to agree with this construction. EX1033, 5:18-19, 6:7-12.

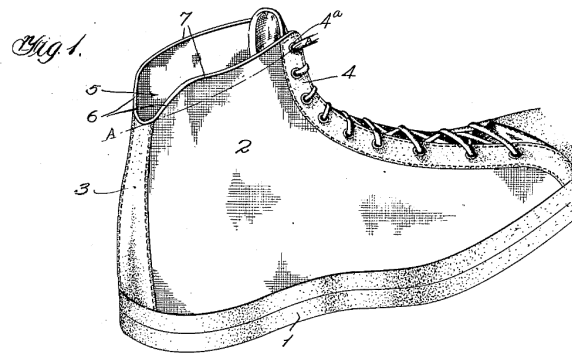
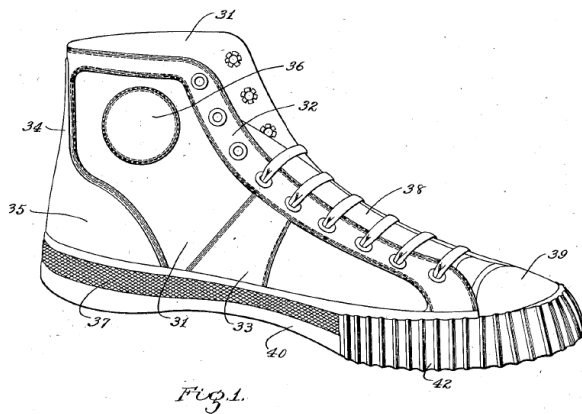
EX1029, FIG. 3 (ends of elements 33/35 overhang the throat area (green)).

And while Dua-956 discloses discontinuous overhanging portions (Ground 1A), it would have been obvious to form Dua-956's overhanging lace elements in the well-known manner of a continuous overhanging flap. EX1003, ¶¶22-23; EX1002, ¶230. For example, Calderone describes “an oxford type, lace up athleisure shoe” (EX1018, Abstract) that can be constructed of fabric (*Id.*, 2:35-36) with an upper left side edge 48 and the upper right side edge 52, colored in orange below.



EX1018, FIGs. 1-2, 6.

Calderone discloses that a “plurality” of “lacing openings 62, 64 are arranged in lines along the upper left side edge 48 and along the upper right side edge 52.” *Id.*, 2:62-3:8. The upper left and right side edges 48/52 are “raised elements” consistent with Skechers’ district court construction, i.e., they are each a flap/overhanging portion extending from the upper and along the length of the side of the tongue. *Id.*, 3:17-24. And it would have been obvious to construct Dua-956’s overhanging portions based on Calderone’s teachings because Calderon’s raised flap design was well known and a classic design used by Converse and others dating back to 1924. EX1002, ¶¶231-232.



EX1023 (US1,952,628); EX1024 (US1,573,299).

Circa 1957 Advertisement



Circa 1982 Advertisement



EX1025 (Chuck Taylor Article).

A POSITA would have been motivated to modify Dua-596's shoe to incorporate well-received design features, as other manufacturers have done with Calderone's design (EX1003, ¶¶22-23), and because Calderone's design represents a suitable option for accommodating the laces expressly disclosed in Dua-596. EX1002, ¶232; *see also infra* Section X.C.

As modified, Dua-596 would continue to meet the other claim limitations for the reasons described above for Grounds 1A-1B. In addition, Dua-596, as modified

by Calderon's raised element teachings, satisfies the "raised element" limitations of claims 4-6 for the same reasons as described below in Ground 2A. EX1002, ¶233. Similarly, modified Dua-592 would satisfy the "first knit element layer" limitations of claims 10-12 for the reasons described below in Ground 2A. *Id.*

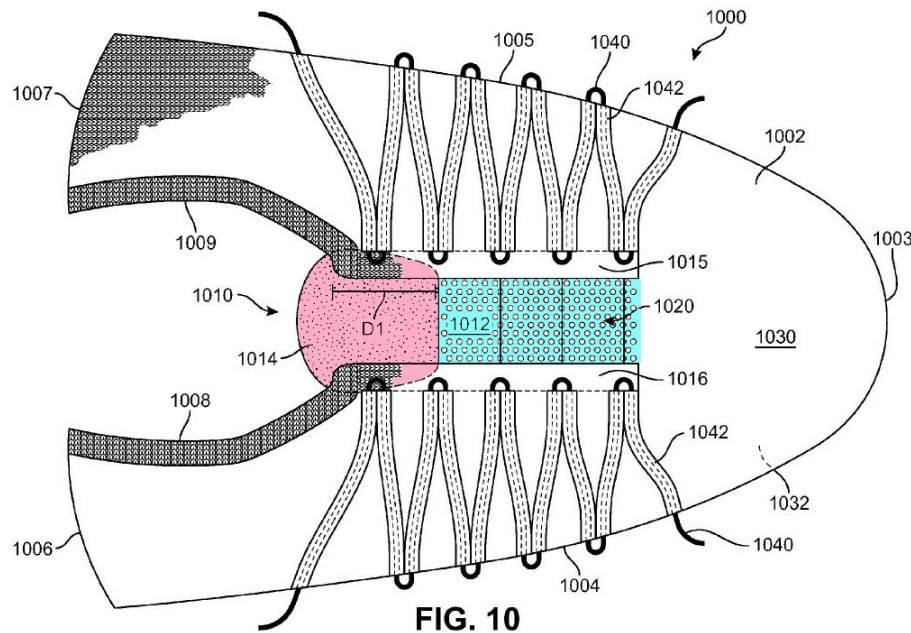
IX. GROUND 1D: CLAIMS 7 AND 18 ARE OBVIOUS OVER GROUNDS 1A-1C IN FURTHER VIEW OF MCDONALD AND/OR HORII⁹

Claims 7 and 18 recite that the integral knit tongue includes "a partially integral portion and a free portion." The partially integral portion is "of unitary knit construction with the upper at the forward portion of the throat area and at least along the portion of the lateral side and the medial side of the throat area of the knitted component." This is similar to Element 1[d], and it is disclosed by Dua-956 for the same reasons as are described under Element 1[d], in combination with the additional reasoning in this Section IX.

Claims 7 and 18 further recite the "free portion being of unitary knit construction with the partially integral portion at a rearward portion of the integral knit tongue and remaining unattached to the remaining portions of the knitted

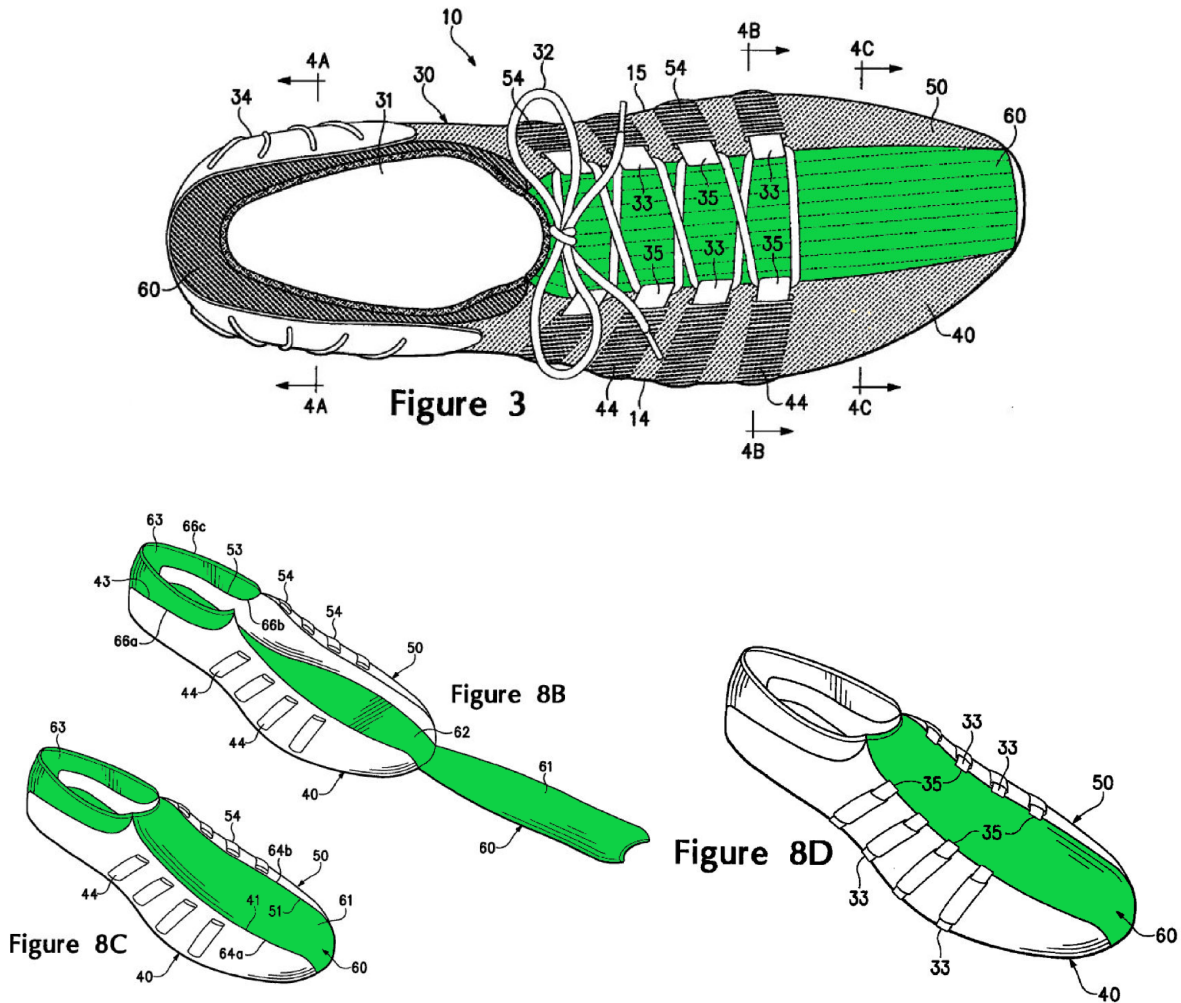
⁹ Because the challenge of dependent claims 7 and 18 in this Ground 1D depends on the analysis of independent claims 1 and 13 under each of Grounds 1A-1C above, references to "tongue" and "integral knit tongue" in this Ground 1D refer to the corresponding constructions applied under Grounds 1A-1C, respectively.

component.” For example, the ’636 patent discloses integral knit tongue 1010 having a partially integral portion 1012 (aqua below) and a free portion 1014 (pink below), as shown below. EX1001, 13:34-37.



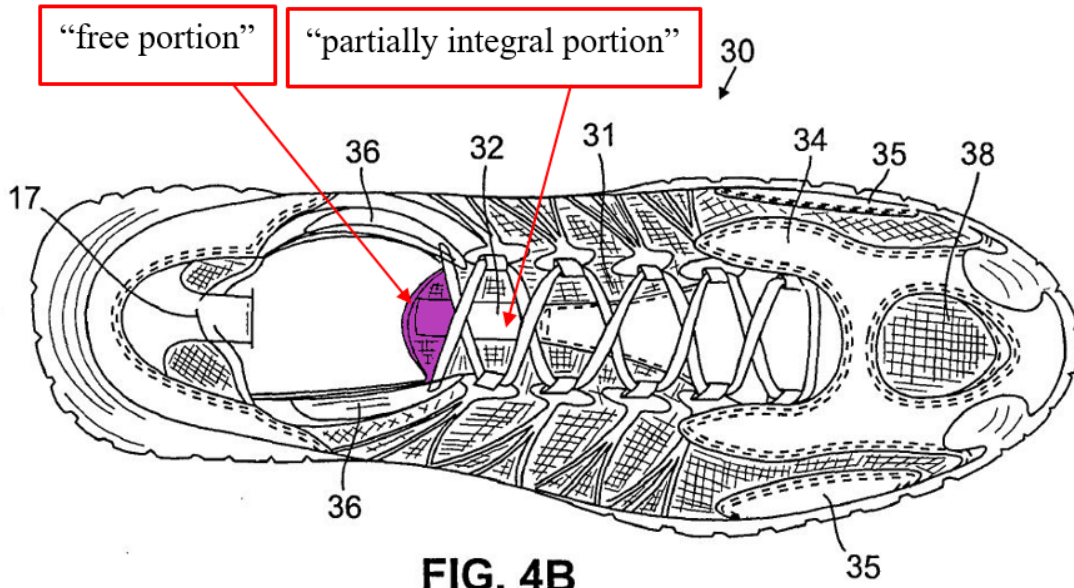
EX1001, FIG. 10 (annotated).

Like the “partially integral portion” of claims 7 and 18, the integral knit tongue of Dua-956 comprises an integral portion that is of unitary knit construction with the upper along a forward portion, a lateral side, and a medial side of the throat area of the knitted component for the same reasons described above for Elements 1[b] and 1[d] under Grounds 1A-1C. See below.



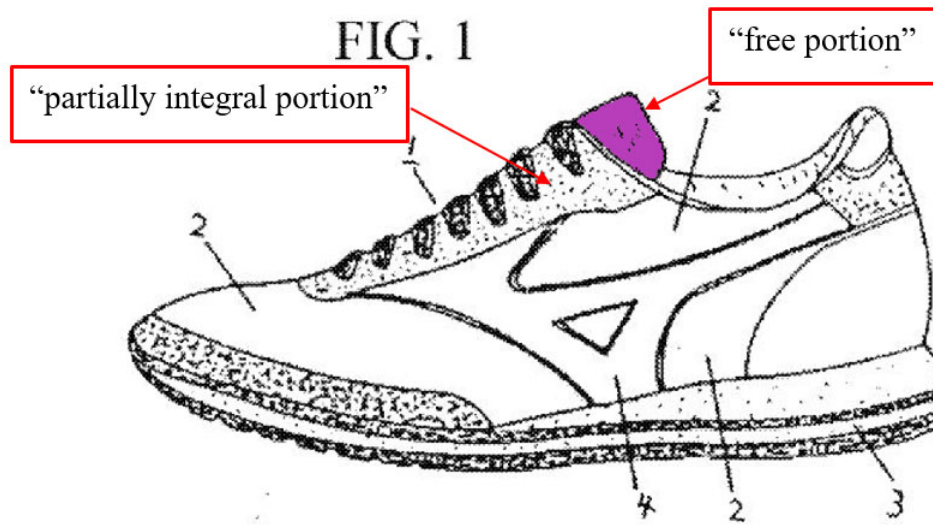
EX1029, FIGs. 3, 8B-8D (integral portion colored in green).

It would have been obvious to form the rearward portion of Dua-956's integral tongue so to have a convex shape instead of a concave shape. EX1002, ¶¶234-237. For example, McDonald is directed to "[a] lightweight, strong, durable engineered textile for use in a shoe upper ..." EX1016, Abstract. McDonald discloses eliminating a separate tongue, i.e., using an integral tongue, in order to provide "a lighter-weight, comfortable and less bulky shoe, as shown in Figs. 4A and 4B." *Id.*, 12.



Id., FIG. 4B; 13 (“[T]he upper 10 could be formed as a substantially continuous piece of stretchable textile so that there is no tongue per se”). McDonald’s integral tongue area comprises both an integral portion and a free portion (in purple).

Moreover, as described under Ground 1B, Horii discloses “shoes 1 that are characterized by the fact that the entire upper is constructed of a single piece of upper member 2 that is made through weft knitting or circular knitting.” EX1017 (Horii), 9. As shown below, Horii’s upper member 2 also comprises an integral portion and a free portion (in purple).



Id., FIG. 1.

A POSITA would have been motivated to incorporate such a “free portion” into Dua-956’s integral tongue (from any of Grounds 1A-1C) because constructing knitted shoe uppers with a “free portion” was a generally known feature and a popular design choice for athletic shoes, generally. EX1003, ¶¶24-25; EX1002, ¶¶238-239.

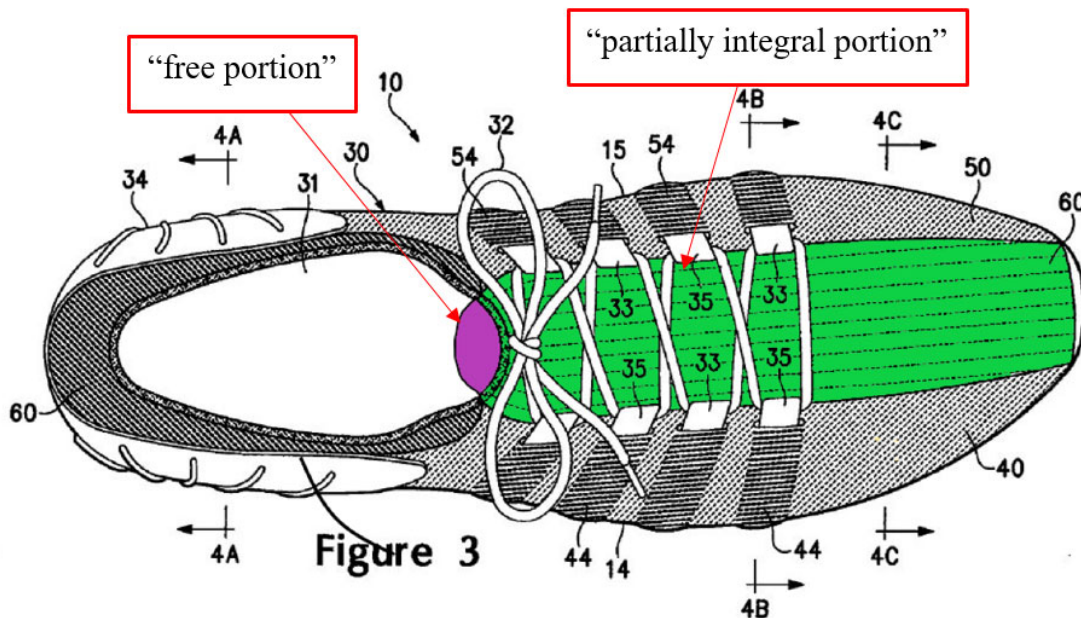




EX1032, 11, 13.

Moreover, McDonald and Horii represent knowledge in the art and are analogous to the Dua-956 patent and the '636 patent. EX1002, ¶240. A POSITA would have been motivated to learn from McDonald and/or Horii and to incorporate a free portion into Dua-956's integral tongue from Grounds 1A-1C. *Id.*, Specifically, a POSITA would have been motivated to do so because it was known that the incorporation of such a tab (i.e., free portion) would beneficially allow the wearer to grasp and pull the shoe into the wearer's foot in an easier fashion. *See e.g.*, EX1018, 3:66-4:3 (disclosing that a shoe wearer may "pull[] upwardly on the tongue 74 adjacent the tongue distal end 76 to stretch the band 92 and remove a portion of the tongue from the forefoot opening 54" to allow the shoe wearer to "slip[] their foot into the shoe interior 22 beneath the tongue 74"). McDonald expressly discloses this benefit as well. EX1016, 13:3-4; EX1003, ¶¶24-25; EX1002, ¶240.

A POSITA would have had a reasonable expectation of success. The field was predictable in the relevant timeframe (February 2012), and a POSITA would have been able to make any necessary modifications to implement the Ground. Adding a tab (i.e., free portion) to Dua-956's integral knit tongue would have been a matter of applying routine knitting techniques, as exemplified below. EX1002, ¶241.



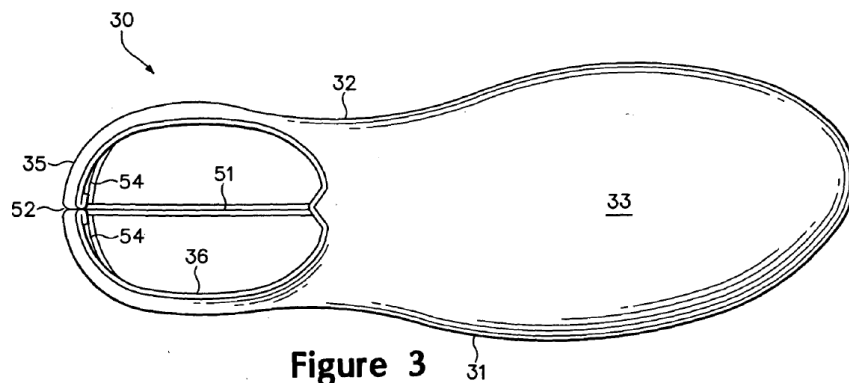
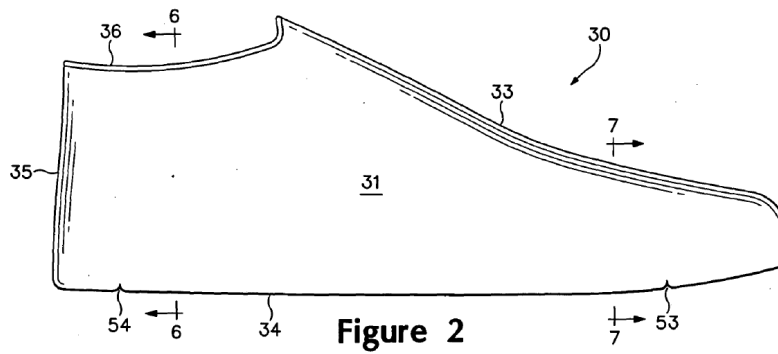
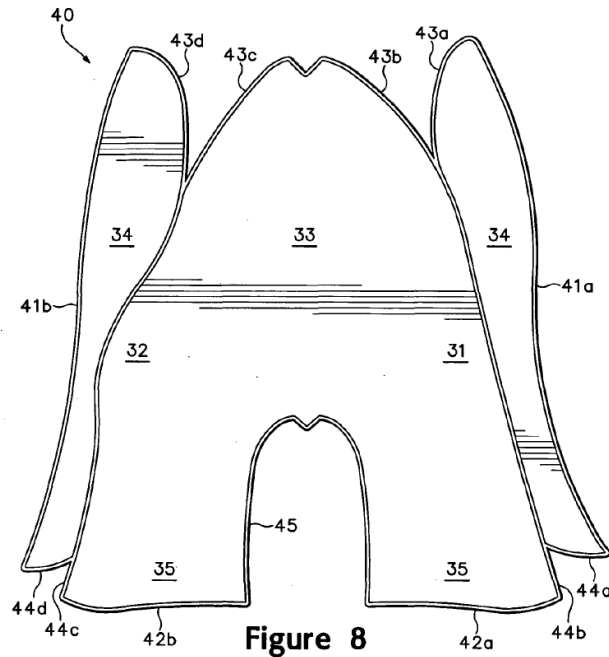
EX1029, FIG. 3 (modified to include a “free portion (in purple) to illustrate the obviousness of the design change).

X. GROUND 2A: CLAIMS 1-6, 8-17, AND 19-27 ARE OBVIOUS OVER DUA-592 AND CALDERONE.

A. Overview of Dua-592

Dua-592 is generally directed to an article of footwear having an “upper incorporating a textile element formed with a knitting machine,” where “the textile

element has edges that are joined together to define at least a portion of a void for receiving a foot.” EX1014, [0013], [0038].



Dua-592 discloses various embodiments, summarized below:

Embodiment #1 – textile element 40 of FIGs. 1-9;

Embodiment #2 – textile element 40' of FIG. 10;

Embodiment #3 – textile element 40'' of FIG. 11;

Embodiment #4 – textile element 140 of FIG. 12; and

Embodiment #5 – textile element 240 of FIGs. 13-14.

Dua-592's embodiments share many common features, including for example having the same “general shape” and the fact that each comprises a knitted textile element that is formed into a shoe upper. EX1014, [0053]-[0055]. EX1002, ¶¶88-92. For example, Embodiment #3 differs from Embodiment #1 only with respect to having differing textured areas, as shown below.

Embodiment #1

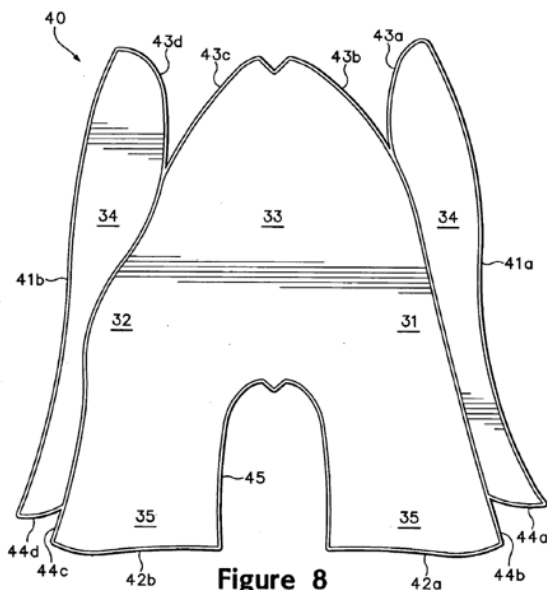


Figure 8

Embodiment #3

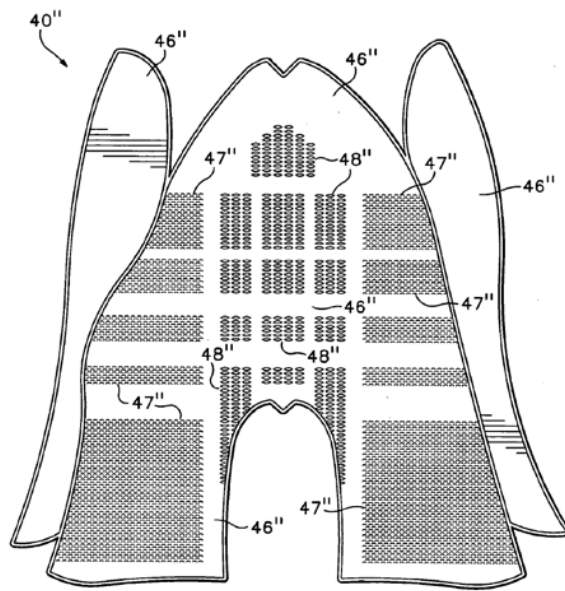
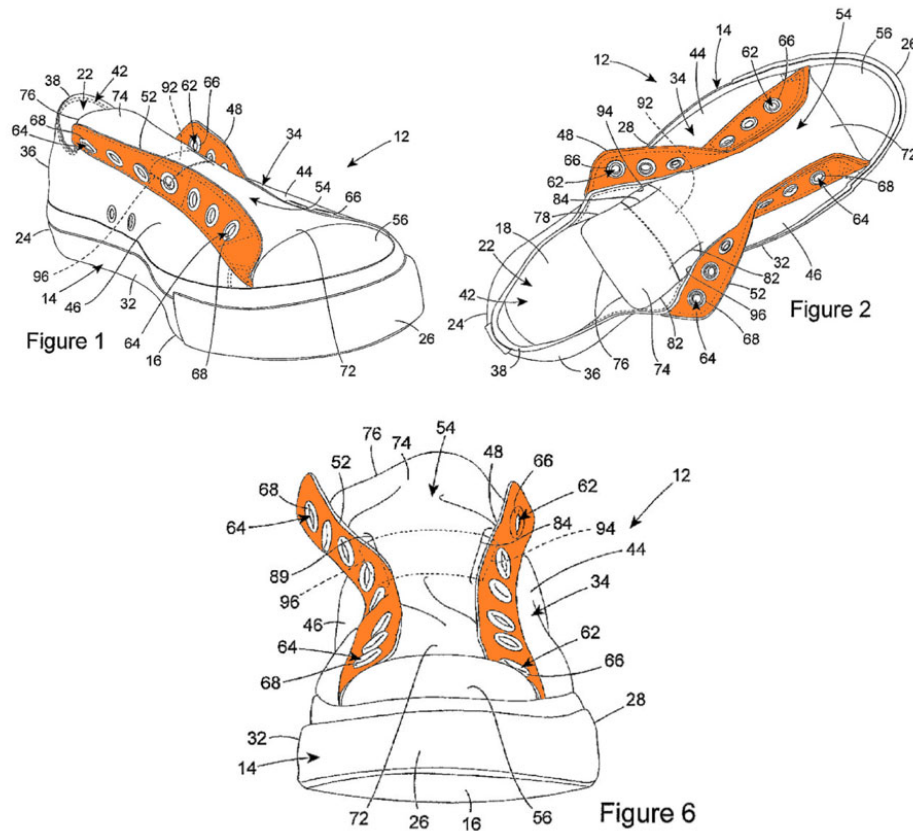


Figure 11

Moreover, Dua-592's disclosure of Embodiment #3 specifically teaches how its various textured areas extend over the lateral region 31, medial region 32, and instep region 33 which are depicted in FIGs. 1-8. EX1014, [0055]. Thus, Dua-592's teachings for Embodiment #1 equally applicable to at least Embodiment #3. EX1002, ¶¶88-92.

B. Overview of Calderone

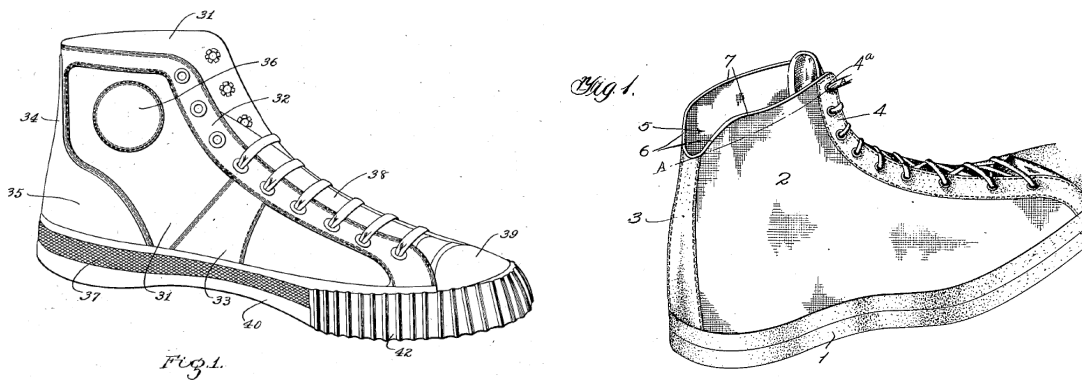
As described above, Calderone includes raised elements under either party's construction in the form of an upper left side edge 48 and the upper right side edge 52, colored in orange below.



EX1018, FIGs. 1-2, 6; *id.*, 3:17-24; EX1002, ¶¶93-96.

C. The Proposed Combination

Dua-592 teaches that at least Embodiment #1 “may also include laces or other elements associated with a conventional upper for footwear.” EX1014, [0037]. One example of such elements associated with conventional footwear are Calderone’s raised flaps along the sides of the throat area in the form of upper left side edge 48 and the upper right side edge 52, colored in orange above. EX1003, ¶¶22-23. Calderon’s raised flaps with lace openings were exceedingly well known and a classic design used by Converse and others dating back to 1924.



EX1023 (US1,952,628); EX1024 (US1,573,299).

Circa 1957 Advertisement



Circa 1982 Advertisement



EX1025 (Chuck Taylor Article).

A POSITA would have been motivated to modify Dua-592's shoe to incorporate well-received design features, as other manufacturers have done with Calderone's design. EX1003, ¶¶22-23; EX1002, ¶¶242-243.

Because Calderone's raised elements include lace openings 62, 64, they would provide a suitable option for accommodating the laces that Dua-592 expressly discloses can be used for Embodiment #1, as demonstrated by the Converse shoes shown above. And while Calderone discloses that an elastic band 92 can extend across the forefoot opening and be used to eliminate the need for laces (EX1018, 3:29-67), that feature is not required by the proposed combination. Dua-592's

Embodiment #1 expressly can include laces, and the Converse shoes shown above establish that Calderone's raised elements can be used to accommodate laces. EX1002, ¶¶244-245.

It would also have been obvious to add Calderone's raised elements to Dua-592's Embodiment #3. Laces are conventional features of shoes which Dua-592 already uses for other embodiments. EX1002, ¶246. Embodiment #3 specifically references the same "lateral region 31, medial region 32, and instep region 33" as Embodiment #1, which "may [] include laces," (EX1014, [0037], [0057]), and therefore a POSITA would have been motivated to do the same for Embodiment #3. EX1002, ¶246. Once the design choice to incorporate laces into Embodiment #3 is made, for the reasons above it would have been obvious to use Calderone's raised elements as a suitable option for accommodating those laces. *Id.* Indeed, Embodiment #3 is already configured with suitable locations along each side of its integral knit tongue to attach/join Calderone's raised elements, as shown below.

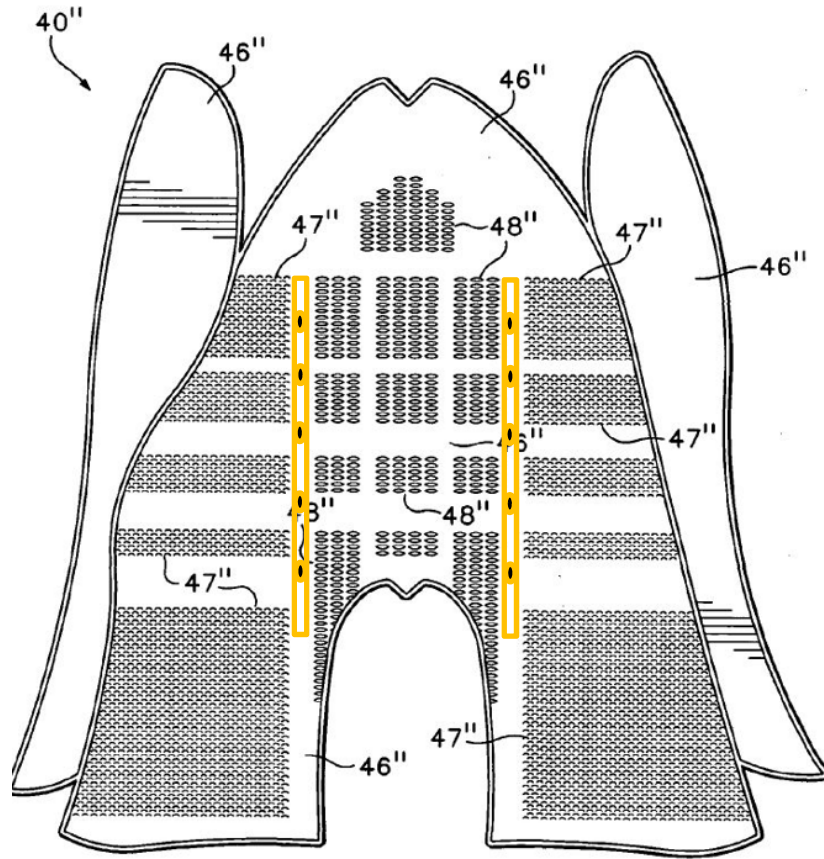


Figure 11

EX1014, FIG. 11 (annotated to show exemplary location of Calderone's raised elements and lace openings).

It would have been a matter of applying routine knitting techniques to include raised elements and lace openings as part of the unitary knit textile elements 40 and 40". EX1002, ¶247; EX1026, 22 ("fully fashioned front with pockets" having a flap and a button opening)). A POSITA would also have had a reasonable expectation of success in doing so. EX1002, ¶248.

D. Claim 1

Element 1[pre]:

Each of Dua-592's textile elements are knitted components formed into a shoe upper. EX1002, ¶249. For example, the footwear 10 of Embodiment #1 includes sole structure 20 and an upper 30, where "[s]ole structure 20 is secured to a lower portion of upper 30." EX1014, [0033]; *see also* [0034]-[0035] (describing sole structure). Dua-592's uppers are formed from textile elements, such as textile element 40, which "may form substantially all of upper 30" *Id.*, [0033]. The same would be understood for Embodiment #3. EX1002, ¶249.

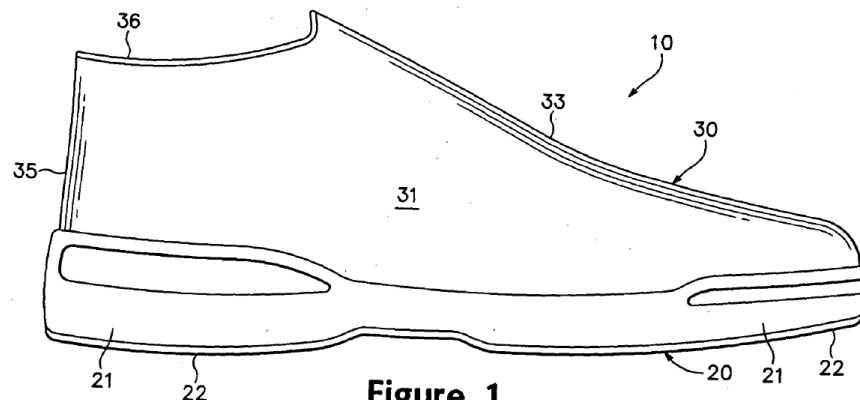


Figure 1

Dua-592 describes its textile elements as unitarily knitted components formed through a mechanical knitting processes. EX1014, Abstract, [0013], [0042]-[0045]; [0055]-[0056] (describing Embodiment #3 as a "single, unitary element of material" formed using one of a variety of knitting processes); EX1002, ¶250.

Element 1[a1]:

Dua-592 satisfies Element 1[a1]. Each of Dua-592's textile elements are knitted components defining the upper under either party's construction of "defining the upper," as they are knitted in the shape of an upper and assembled to form an

upper. *Supra*, Section X.A; Element 1[pre]. For example, for Embodiment #1 the “textile element 40 forms both an exterior surface and an interior surface of upper 30,” where “various edges of textile element 40 are secured together to form the shape of upper 30.” EX1014, [0037]. Specifically, and with reference to the figures below, the “[t]extile element 40 exhibits the general shape depicted in FIG. 8 prior to the formation of seams 51-54. Following formation of seams 51-54, however, textile element 40 exhibits the shape of upper 30 depicted in FIGS. 2-7.” *Id.*, [0038].

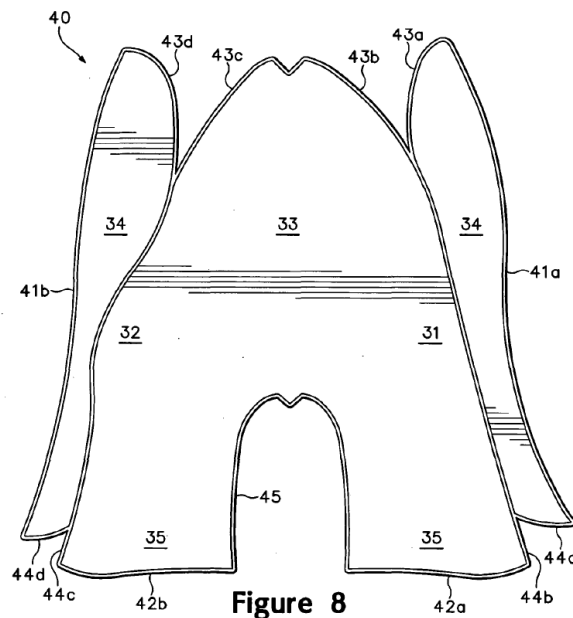


Figure 8

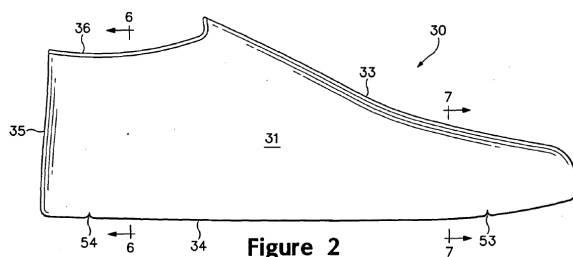


Figure 2

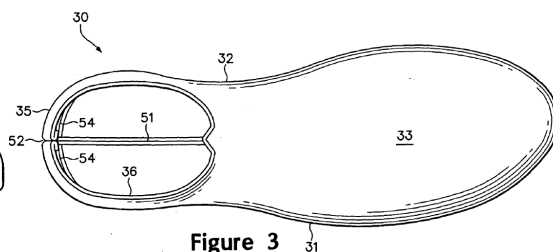


Figure 3

Embodiment #3 is described as having the same “general shape” as Embodiment #1 and is described as having various textured areas extending over the lateral region 31, medial region 32, and instep region 33 of FIGs. 1-8 (*Id.*, [0055]), and therefore it would define the entire upper in the same manner as Embodiment #1. EX1002, ¶¶251-252. The textile element of Embodiment #3 is similarly “a single, unitary element of textile.” EX1014, [0054].

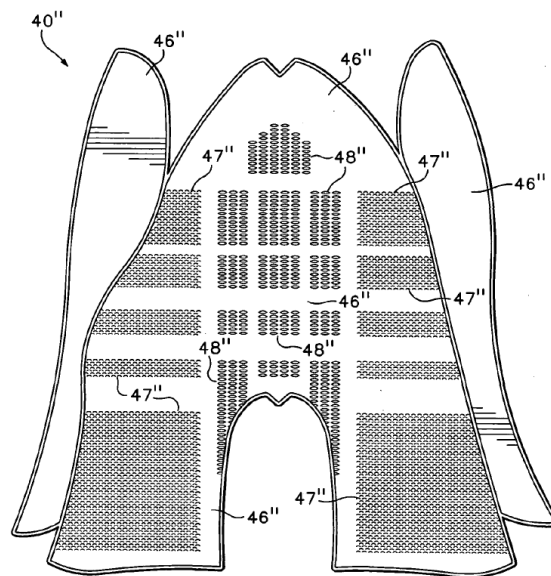


Figure 11

Element 1[a2]:

Each of Dua-952’s textile elements are formed into uppers, as described above under Element 1[a1], and at least form the interior surface defining a void for receiving a foot. EX1002, ¶253. For example, in the Summary of Invention section, Dua-592 expressly states that “the textile element has edges that are joined together to define at least a portion of a void for receiving a foot.” EX1014, [0013]. Moreover, for Embodiment #1 Dua-592 discloses that “[u]pper 30 is at least partially

formed from a textile element 40 that defines an interior void for comfortably receiving a foot,” and that “[i]n some embodiments, textile element 40 may form substantially all of upper 30.” *Id.*, [0033]; [0036], [0039]. The “textile element 40 forms both an exterior surface and an interior surface of upper 30,” where “various edges of textile element 40 are secured together to form the shape of upper 30.” *Id.*, [0037]. A POSITA would understand the same for Embodiment #3, which has the same “general shape” as Embodiment #1. *Id.*, [0055]; EX1002, ¶254.

Thus, Dua-592 satisfies Elements 1[a1]-1[a2].

Element 1[b]:

As noted above, there is a dispute between the parties regarding the meaning of “integral knit tongue” However, the Board need not resolve the claim construction dispute because Dua-592 in combination with Calderone discloses Element 1[b] under either proposed construction.

As noted above, Nike apparently construes “integral knit tongue” as knitted material within the throat area, as reflected in Nike’s infringement contentions below.



EX1011, 54, 57; EX1041, 71, 77.

At least under Nike's apparent construction, each of Dua-592's embodiments have an integral knit tongue formed with the upper and extending through a throat area of the knitted component, for example in the form of the area of the upper encompassing the third texture 48" of Embodiment #3, outlined in red below.

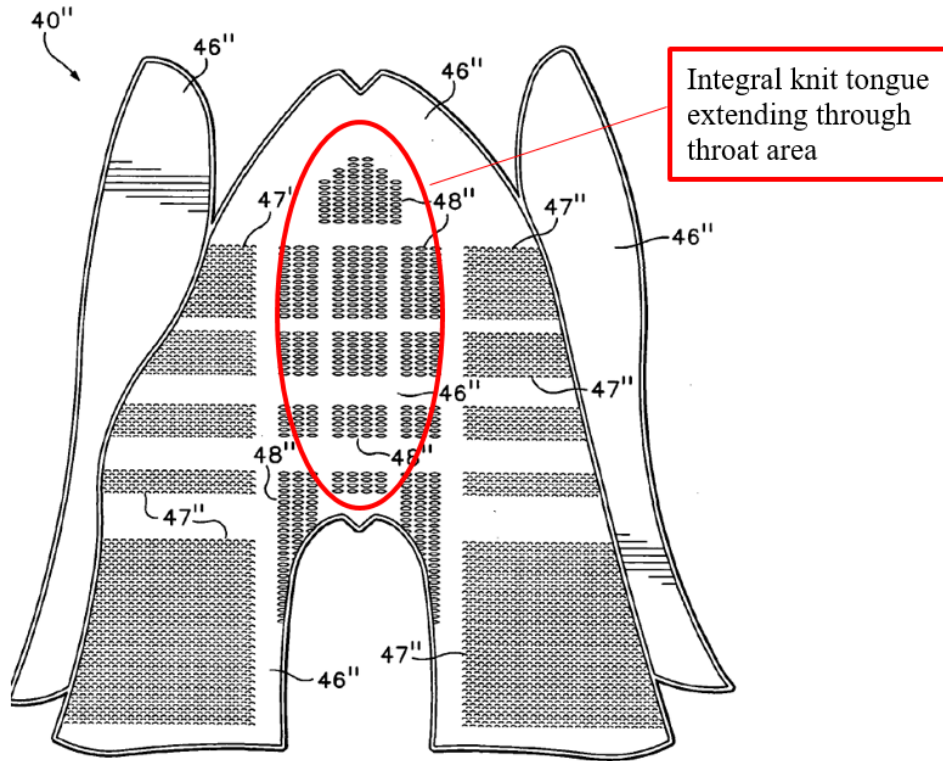


Figure 11

EX1014, FIG. 11. Specifically, Dua-592 discloses that “the area of textile element 40'' corresponding with *instep region 33* includes a third texture 48'',” where the instep region 33 corresponds to the area covering the top middle of the foot, as shown below. EX1014, [0055]; EX1002, ¶¶256-258.

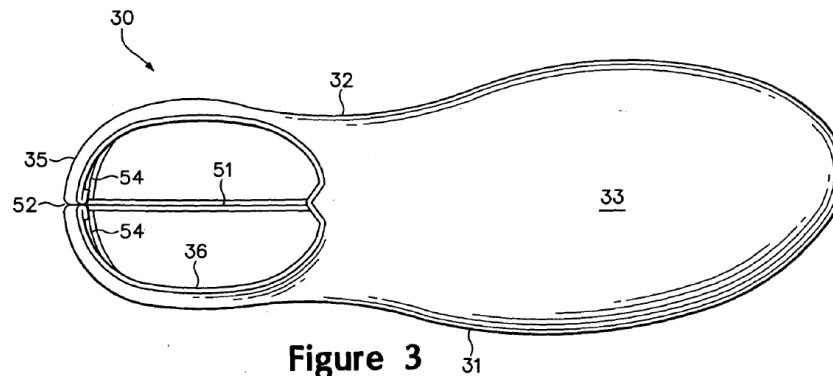
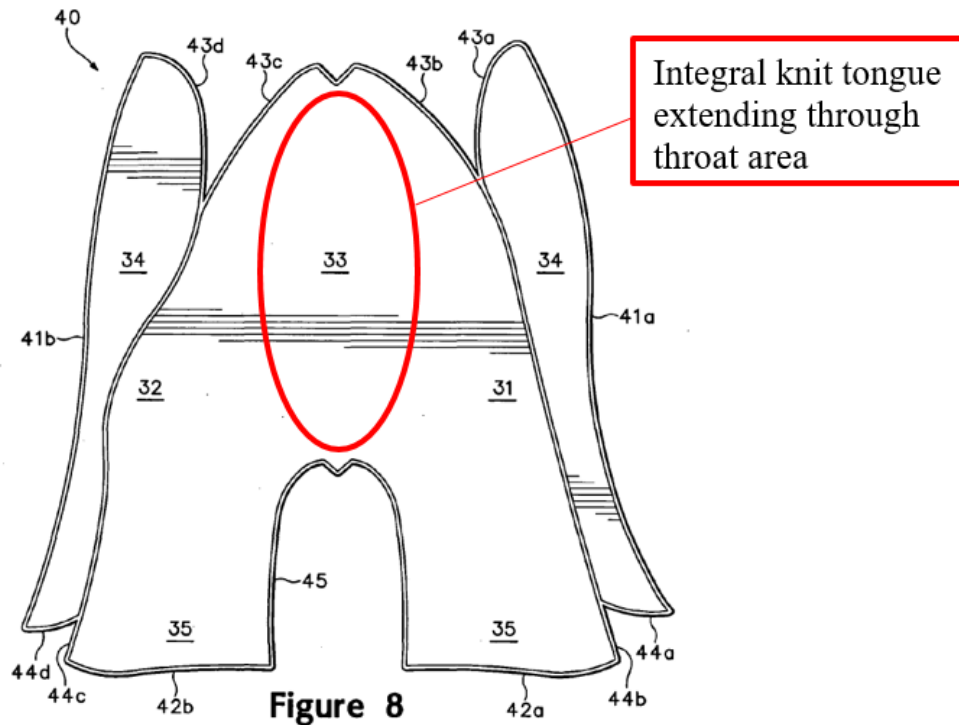


Figure 3

Thus, at least under Nike's apparent construction, the area comprising the third texture 48" of Embodiment #3 is an "integral knit tongue" because it extends along a throat area, and combining Dua-592 with Calderone would preserve this feature. EX1002, ¶259. Moreover, Dua-592 discloses that "[t]extures 46"-48" may exhibit aesthetic differences, or the differences may be structural. For example, the degree of stretch in areas with textures 46"-48" may be different, or the wear resistance of the areas may vary depending upon the stitch utilized." EX1014, [0055]. A POSITA would understand that the area comprising the third texture 48" would, or advantageously could, provide additional expansion through the throat area for inserting a foot by varying the stitch and/or type of yarn, which is a basic feature of shoe design. EX1002, ¶259; EX1003, ¶¶19-21. Dua-592 expressly discloses that stitch or yarn type can be varied "to impart different properties," including the degree of stretch. EX1014, [0055]-[0056].

Like Embodiment #3, Embodiment #1 also comprises an integral knit tongue extending through a throat area at least under Nike's apparent construction, as shown below.



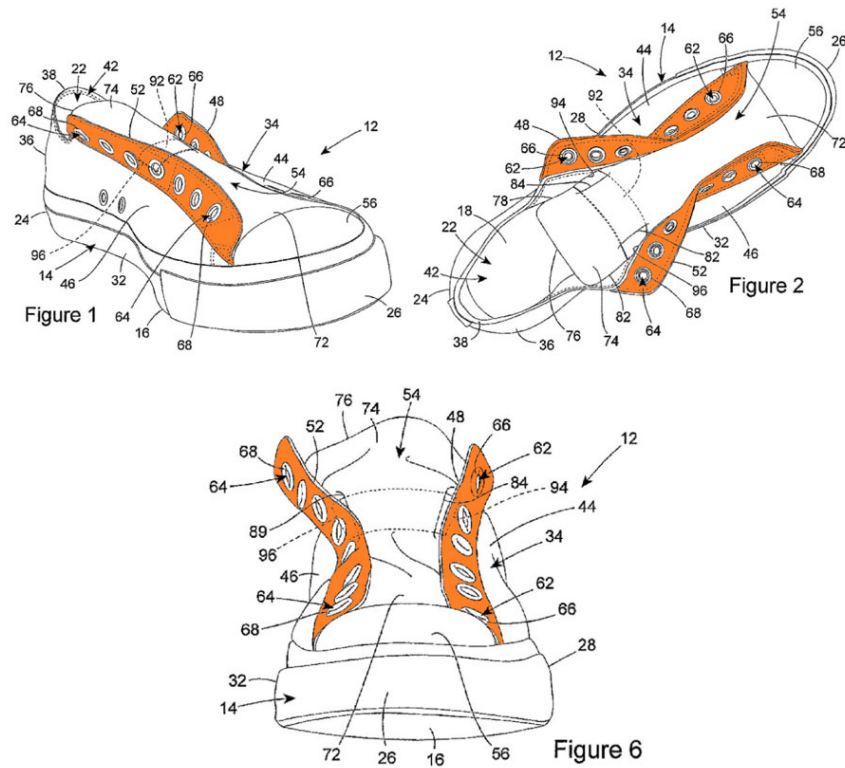
EX1014, FIG. 8.

It would have been obvious to add the raised elements of Calderone to the upper of Dua-592. *Supra*, Section XC; EX1002, ¶261. In doing so, the proposed combination also satisfies Element [1b] under Skechers' construction because Dua-592's throat area is adjacent to one or more raised elements that extend outward away from the surface of the upper (i.e., are raised) and that extend along the sides of the integral knit tongue (e.g., area with third texture 48"). *See also infra*, Element 1[c]. The incorporation of Calderone's raised elements would not change the properties of Dua-592's integral knit tongue.

Therefore, Dua-592 and Calderone renders Element 1[b] obvious under either party's construction.

Element 1[c]:

Under either party's construction, Skechers' combination of Dua-592 and Calderone satisfies Element 1[b]. EX1007, 20-21; EX1008, 5-11. Specifically, Calderone's shoe includes an upper left side edge 48 and the upper right side edge 52, colored in orange below.



EX1018, FIGs. 1-2, 6.

Each of the upper left side edge 48 and the upper right side edge 52 comprises “a flap or overhanging portion that extends outward away from the surface of the upper and along the length of the side of the tongue,” consistent with Skechers' proposed construction of “raised elements.” EX1008, 5-11. Specifically, Calderone

explains that its shoe includes an “upper left side 44 [that] extends upwardly ... to an upper left side edge 48” and an “upper right side 46 [that] extends upwardly ... to an upper right side edge 52,” where “the upper left side edge 48 and the upper right side edge 52 extend forwardly from opposite sides of the upper collar edge 38 toward the front toe end 26 of the shoe,” and where “[t]he length of the upper left side edge 48 and the upper right side edge 52 define a forefoot opening 54 in the shoe upper 34.” EX1018, 2:44-53. Calderon’s shoe upper 34 also includes a tongue 74 that “*extend[s] ... over the forefoot opening 54* of the shoe,” where the tongue “extends along the lengths of the upper left side 44 and the upper right side 46” and is “position[ed] ... beneath the upper left side 44 and the upper right side 46.”” *Id.*, 3:17-24.

As such, Calderone’s upper left side edge 48 and the upper right side edge 52 are raised elements under both party’s constructions, satisfying Element 1[c]. Moreover, it would have been obvious to incorporate Calderone’s raised elements into at least Embodiment #1 and #3 for the reasons described above. *Supra*, Section X.C; EX1002, ¶¶263-266.

Element 1[d]:

The combination of Dua-592 and Calderone discloses an integral knit tongue under either party’s construction. *Supra*, Elements 1[b]-1[c].

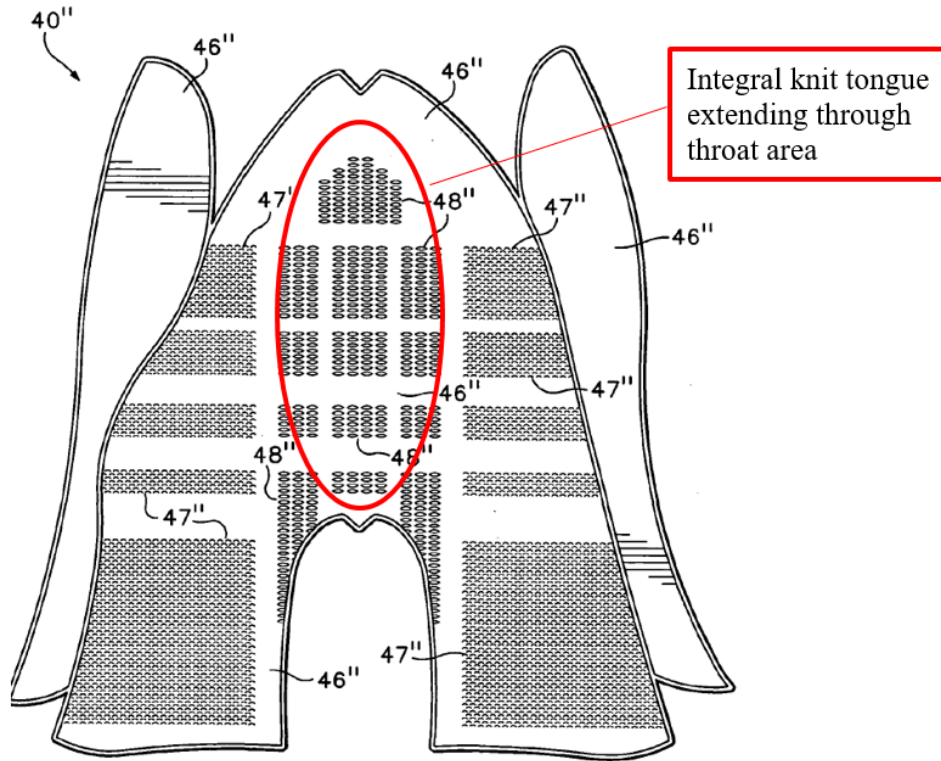


Figure 11

EX1014, FIG. 11; see also FIG. 8 (annotated under Element 1[b]).

The '636 patent expressly discloses that the integral knit tongue can be joined to the forward portion of the throat area (as well as to the lateral and medial sides) by knitting. EX1001, 9:41-67. Similarly, a POSITA would understand that Dua-592's integral knit tongue is joined during the knitting process to a forward portion of the throat area and along the lateral and medial sides of the throat area from the forward portion to an ankle opening of the upper given that the "[t]extile element 40 is a *single material element* that is formed to exhibit *a unitary (i.e., one-piece) construction*" EX1014, [0037]; [0055] (describing textile element 40" of Embodiment #3 as "a single, unitary element of material"); EX1002, ¶¶267-268.

For example, as shown below the integral knit tongue of Embodiment #3 would be joined during the knitting process in the claimed manner by virtue of being part of the “unitary (i.e., one-piece) construction”:

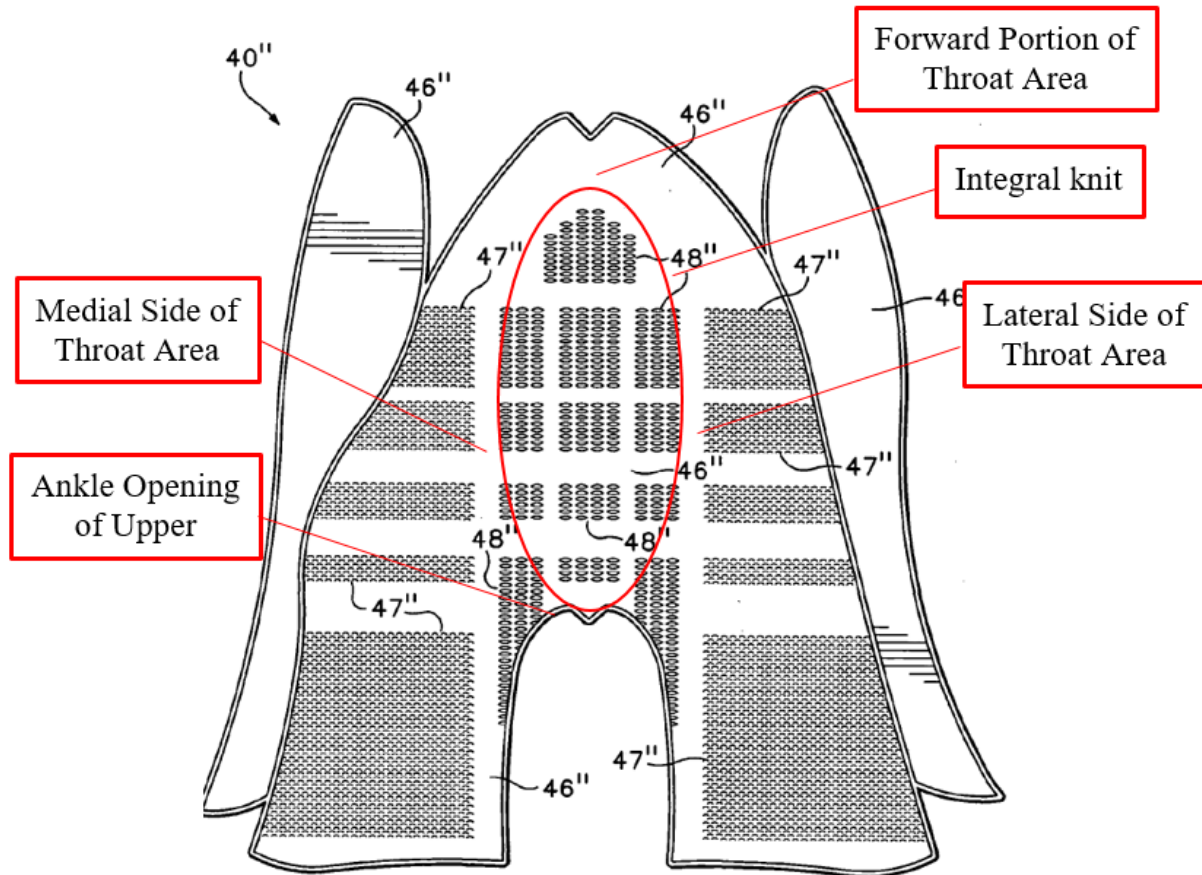


Figure 11

EX1014, FIG. 11; EEX1002, ¶269.

In knitting, a course is a row of loops made with the same piece of yarn. EX1002, ¶270. Knitting the unitary textile element 40 of Dua-592 involves the “formation of a plurality of columns of intermeshed loops” (EX1014, [0043]), where such intermeshed loops comprise courses made with the same yarn. EX1002, ¶270.

Thus, when the knitting process in Dua-592 reaches the area where the lateral or medial sides are joined to the tongue, a column of courses formed of intermeshed loops is formed at the intersection of the lateral and medial sides, on the one hand, and the integral knit tongue , on the other hand, as shown below. *Id.*

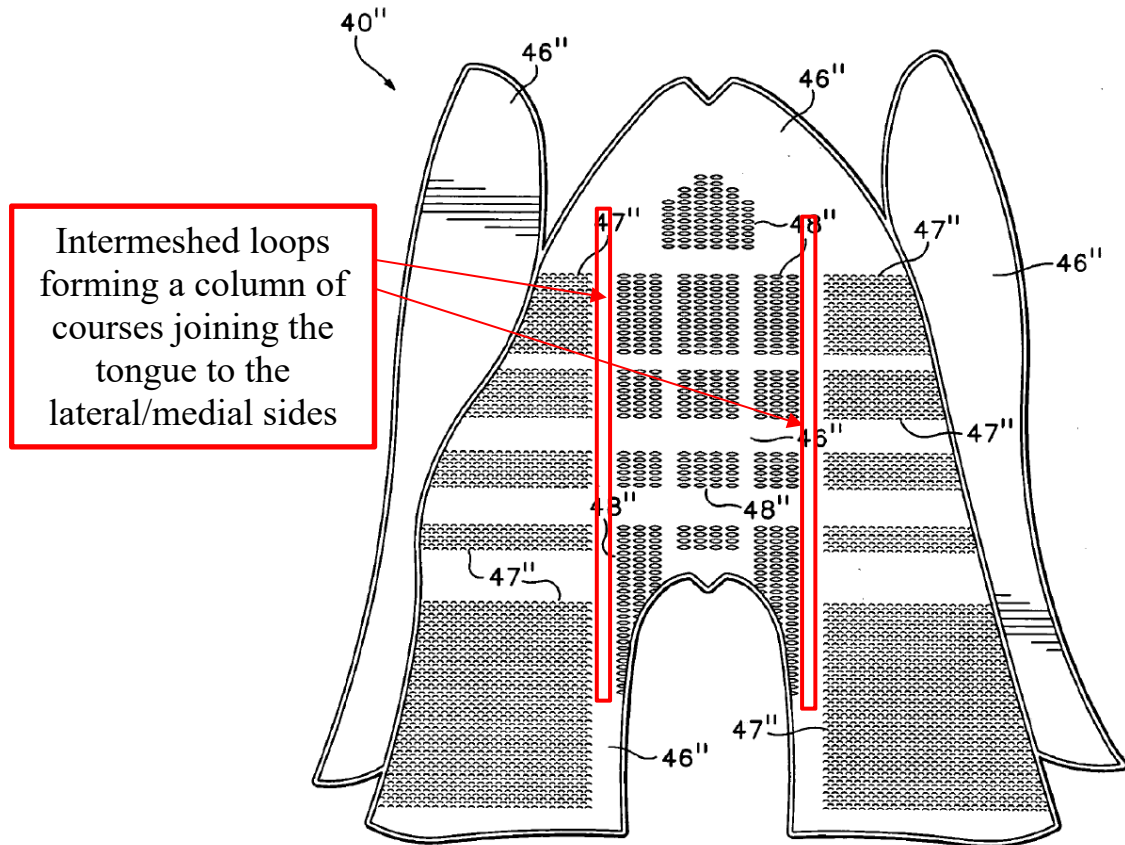
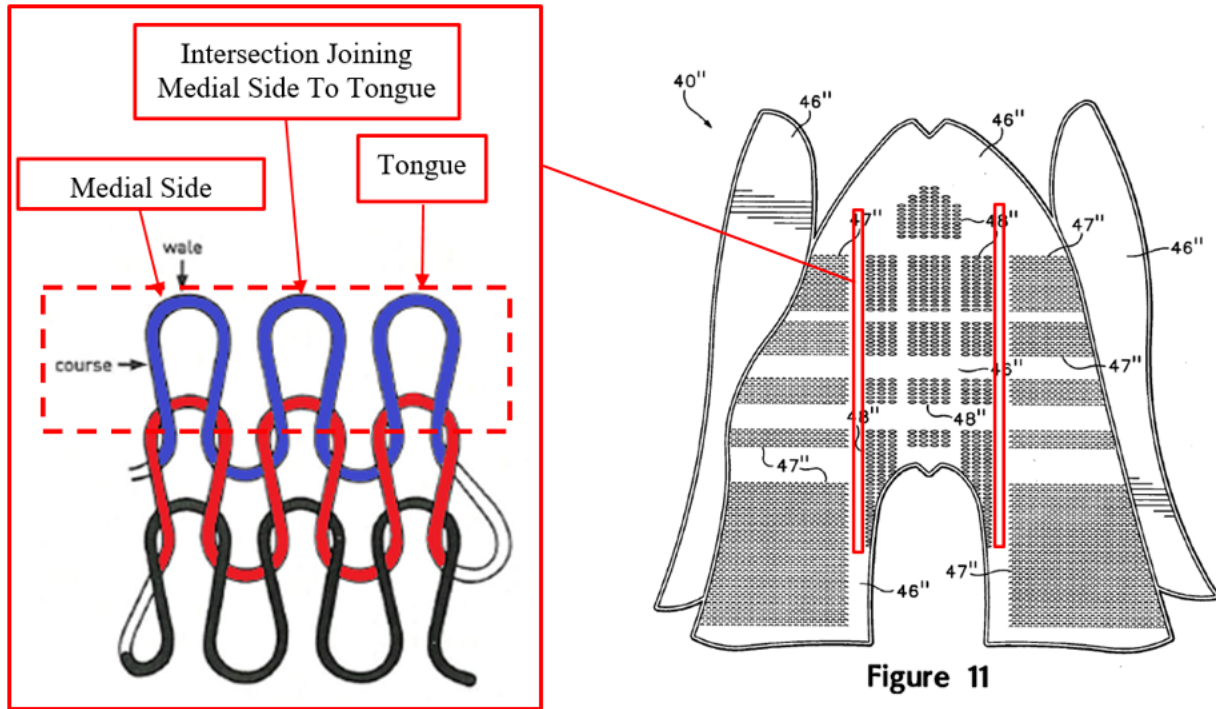


Figure 11

EX1014, FIG. 11; FIG. 8 (Embodiment #1).



EX1054, 26 (printed page 174); EX1014, FIG. 11.

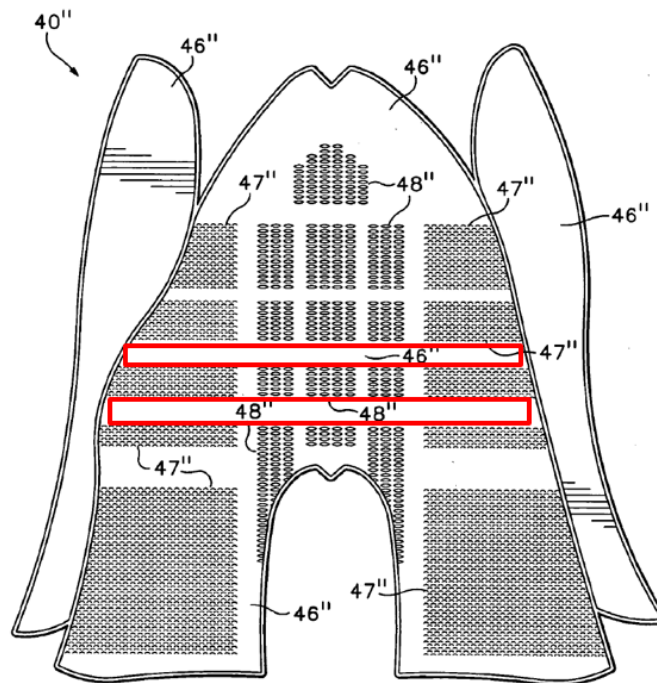
Joining Dua-592's integral knit tongue to the forward portion of the throat area would similarly comprise the formation of intermeshed loops at the intersection of the forward portion and integral knit tongue. EX1002, ¶271.

Moreover, the inclusion of Calderone's raised elements per Skechers' constructions (supra, Elements 1[b]-1[c]) would not change the manner in which the integral knit tongue is otherwise joined to the other portions of the knitted component. EX1002, ¶272.

Therefore, Dua-592 and Calderone render claim 1 obvious.

E. Claim 2

As described above, Dua-592 discloses that the textile elements of at least Embodiment #1 and #3 are single-piece, unitary knit structures. *Supra*, Elements 1[pre], 1[d]. As described above for Element 1[d], Dua-592's one-piece knit structure would include rows of loops (courses) formed with the same piece of common yarn and that extended from the integral knit tongue area of the textile element to the surrounding areas. EX1002, ¶275. For example, for Embodiment #3 at least the portions of the integral knit tongue with texture 46" would have a common course (row of loops) formed with the same yarn as the surrounding portions of the textile element 40" that share texture 46", thereby satisfying claim 2. *Id.* This is consistent with the '636 patent's disclosure. EX1001, 9:50-56.

**Figure 11**

EX1014, FIG. 11 (annotated to show exemplary areas where courses would have a common yarn); see also FIG. 8 (Embodiment #1).

F. Claim 3

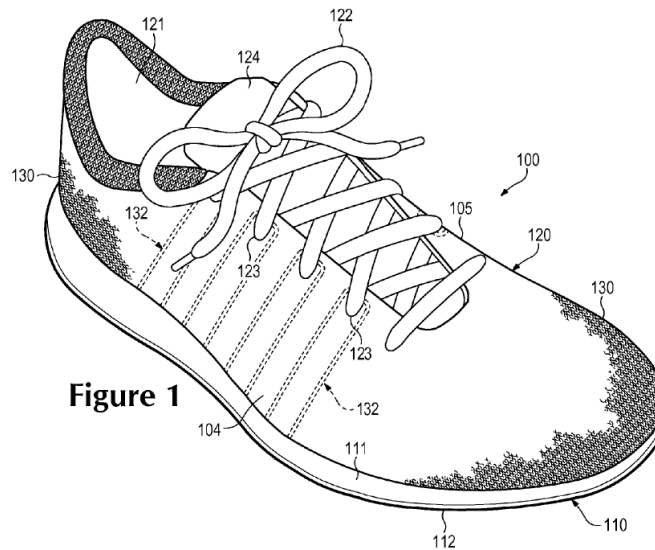
As noted above, the '636 patent discloses that a knit structure can be a “knit type.” EX1001, 14:25-42; EX1002, ¶277. And Nike’s infringement contentions indicate Nike has a broad understanding of the term. EX1011, 148, 163.

Dua-592 discloses claim 3. For example, Dua-592 discloses that “[t]extile element 40 is a *single material element* that is formed to exhibit *a unitary (i.e., one-piece) construction*” EX1014, [0037]; [0053] (“Textile element 40 is depicted as having a generally smooth, *non-varied stitch configuration*.”). Moreover, Dua-592 discloses that “similar stitches are utilized throughout textile element 40 to impart a common texture to the various portions of textile element 40.” *Id.*, [0053], [0055] (Embodiment #3); EX1002, ¶278-279. In addition, those portions of the integral knit tongue that have a common course (row of loops) formed with the same yarn as the surrounding portions, as described above, would similarly be formed from a common knit structure. *Id.*; *supra*, claim 2.

G. Claim 4

Dua-592, as modified by Calderone, discloses claim 4 under either party’s construction of “raised elements.” For example, as described above, Calderone discloses that its shoe can be constructed of fabric (EX1018, 2:35-36), which is

consistent with the knit construction of Dua-592's upper. EX1002, ¶281; *supra*, Sections X.B-X.C. Integrally knitting lace receiving structures into a unitary knit upper was known at the time, as shown below.



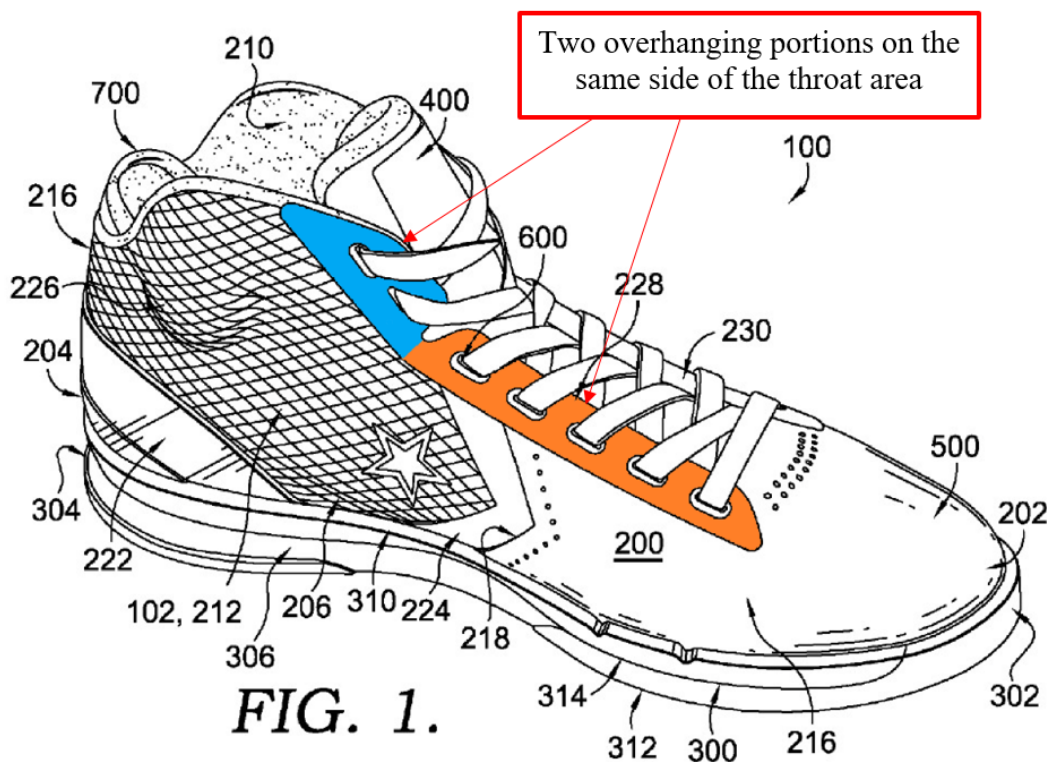
EX1019 (US 2012/0233882), FIG. 1 (showing lace apertures 123 in knitted component 130 forming upper 120); [0037]; EX1054 (Knitwear in Fashion), 8. And it would have been obvious to do the same with Calderone's raised elements to eliminate the extra step of sewing the raised elements onto the upper. EX1002, ¶282; EX1029 ('956), 4:34-39 (describing benefits of flat knitting as including "eliminat[ing] seams and at least some sewing").

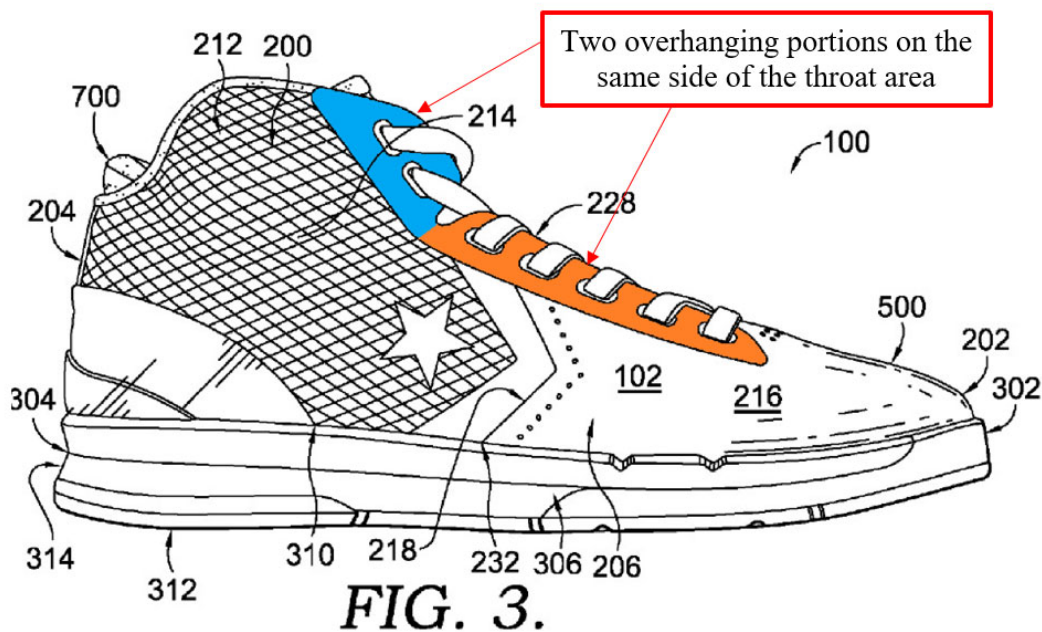
Moreover, integrally knitting Calderone's raised element with Dau-592's textile elements would have been an application of a known technique for incorporating known lace receiving structures into a prior art upper. *Supra*, Elements 1[b]-1[c]; EX1002, ¶282. Dua-592 and Calderone render claim 4 obvious.

H. Claim 5

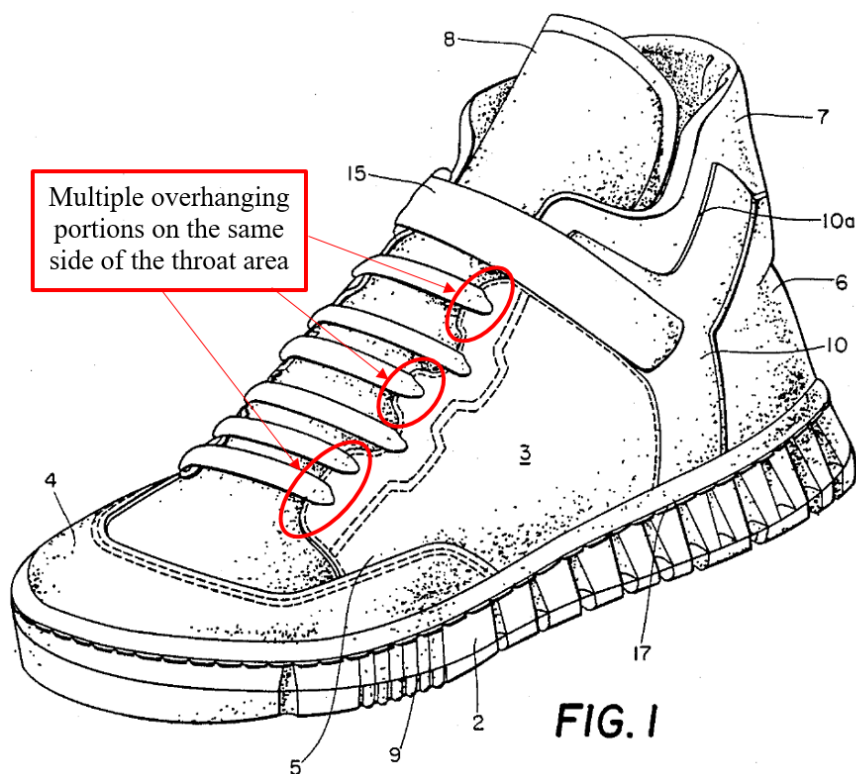
Dua-592 alone discloses multiple raised elements on each side of the throat area, extending above the exterior surface of the knitted component under at least Nike's construction. *See e.g.*, EX1014, FIG. 13. Moreover, Dua-592 in view of Calderone discloses multiple raised elements on each side of the throat area, extending above the exterior surface of the knitted component under either parties' construction. *Supra*, Section X.D (Element 1[c]); EX1002, ¶284.

Alternatively, it would have been obvious and a mere design choice to implement Calderone's raised elements as discontinuous overhanging portions, as Converse itself did in earlier versions of similar designs. EX1002, ¶285. See below.





EX1034 (US9,573,331), FIGs. 1, 3.



EX1035 (US4,766,681), FIG. 1.

This would have involved no more than routine skill applying basic techniques in textile manufacturing. EX1002, ¶¶47-66, 286. Therefore, Dua-592 and Calderone render claim 5 obvious.

I. Claim 6

Dua-592 in combination with Calderone discloses lace apertures configured to receive laces. *Supra*, Elements 1[b]-1[c], Claim 4; EX1002, ¶288

J. Claim 8

Dua-592 and Calderone disclose an integral tongue in the form of the area of textile element 40" corresponding with instep region 33 that includes a third texture 48". *Supra*, Element [1b]; EX1014, [0055]. Dua-592 further discloses that areas corresponding to the various textures 46"-48" may exhibit aesthetic or structural differences, including varying "the degree of stretch in areas with textures 46"-48"" *Id.*, [0055]. Dua-592 discloses that different yarn types may be utilized to impart different properties." *Id.*, [0056]. Specifically, Dua-592 identifies a number of different types of yarn which may be used to "impart differing properties to the areas corresponding with textures 46'-47' and 46"-48", including that "elastane may be utilized to impart stretch, wool may be utilized for insulation, and nylon may be utilized for durability." *Id.*; *see also id.*, [0051]-[0052] (describing the use of elastane fibers for textile element 40).

In view of Dua-592's express disclosure of varying yarn type to vary physical properties, including durability and degree of stretch, a POSITA would be motivated to use a yarn with a higher degree of stretch (e.g., elastane) for the third texture 48" corresponding to the integral knit tongue, while using a more durable yarn (e.g., nylon) for other areas of the upper, thereby resulting in an "integral knit tongue compris[ing] a second type of yarn ... [that is] different from the first type of yarn" comprising the upper, per claim 8. This would be obvious because it would advantageously provide additional expansion through the throat area for inserting a foot, which is a basic feature of shoe design. EX1002, ¶¶289-290 (citing EX1028-EX1030); EX1003, ¶¶19-21. This would also be obvious because the choice to use a more elastic yarn for the third texture 48" would not compromise durability or wear resistance in other areas of the shoe since the third texture 48" is limited to the throat area. EX1002, ¶290.

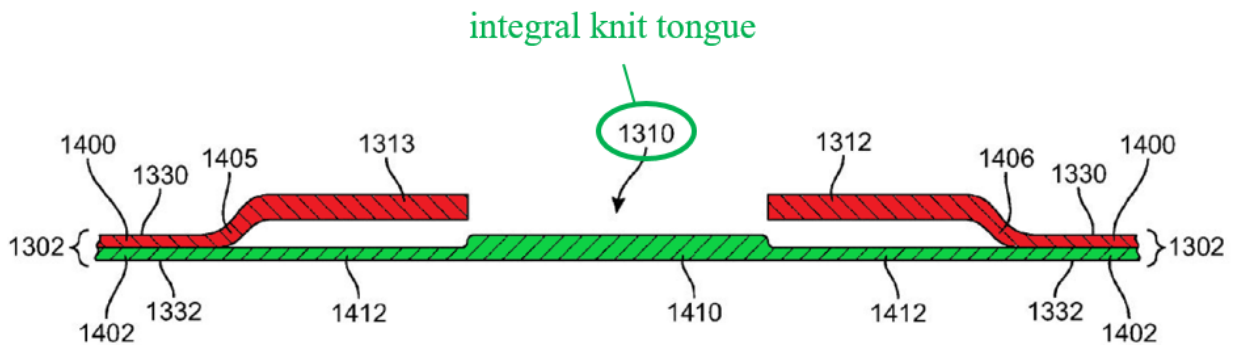
Therefore, claim 8 is obvious in view of Dua-592 alone or with Calderone.

K. Claim 9

For the reasons described for claim 8, it would have been obvious to use a yarn with a higher degree of stretch, such as elastane, for the integral knit tongue portion of Dua-592's upper. EX1014, [0055]; EX1002, ¶292.

L. Claim 10

As describe above for claim 10 under Ground 1A, the '636 patent describes a first knit element layer 1400 (colored in red) that is associated with an exterior surface (surface 1330), and a second knit element layer 1402 (colored in green) that is associated with an interior surface and that includes integral knit tongue 1310.

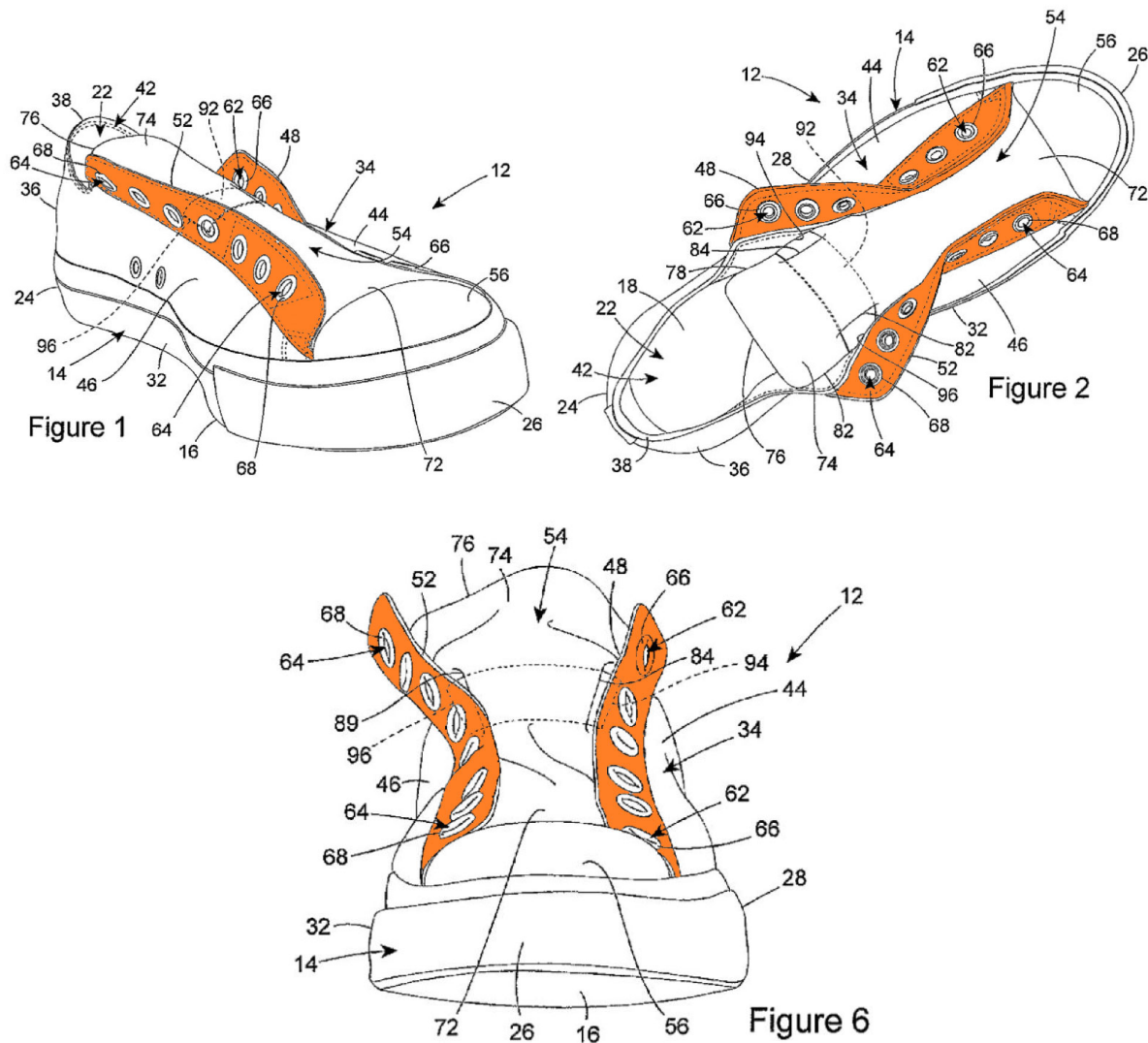
**FIG. 15**

EX1001, FIG. 15.

The combination of Dua-592 and Calderone, described above with respect to Elements 1[b]-1[c], comprises the claimed “second knit element layer” in the form of the textile elements of either Embodiment #1 or #3, both of which form an interior surface and comprise the integral knit tongue per Elements 1[b]-1[c]. *See* EX1014, [0033] (“Upper 30 is at least partially formed from a textile element 40 that defines an interior void for comfortably receiving a foot”); [0037] (“[T]extile element 40 forms both an exterior surface and an interior surface of upper 30.”); [0055] (describing Embodiment #3 as having the same “general shape” as Embodiment #1

and textured areas extending over the lateral region 31, medial region 32, and instep region 33 of Embodiment #1).

In the combination, the claimed “first knit element layer” would be comprised of Calderone’s incorporated raised elements (e.g., upper left side edge 48 and the upper right side edge 52, colored in orange below), as described under Elements 1[b]-1[c].



EX1018, FIGs. 1-2, 6; EX1002, ¶¶293-295.

Once incorporated into the textured upper of Dua-592, an example of which is shown below, Calderone's raised elements would comprise a portion of the knitted component's exterior surface, per Element 1[a1] and claim 10.

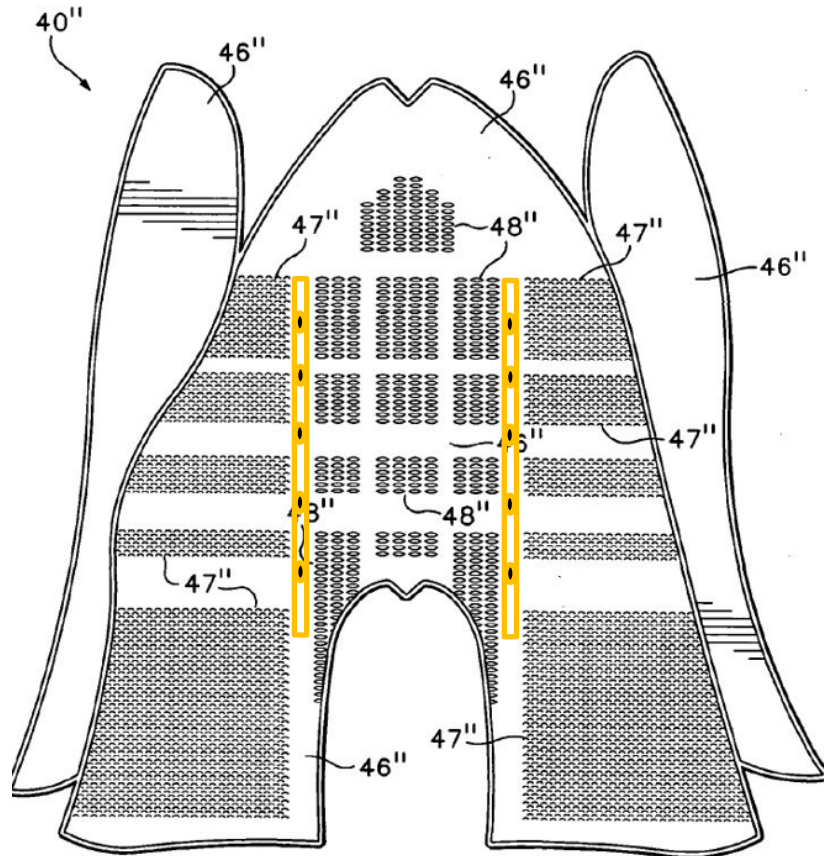


Figure 11

EX1014, FIG. 11 (annotated to show exemplary location of Calderone's raised elements and lace apertures); EX1002, ¶296.

For the reasons described above for Claim 4, it would have been obvious to integrally knit Calderone's raised elements in a unitary knit construction with Dua-592's textile elements, both for the advantages it provided—e.g., eliminating the extra step of sewing the raised elements onto the upper—and because integrally

forming lace receiving structures was well known at the time, as Dua-956 discloses at least with respect to the lace loops 45 of FIGs. 9A-9B, 10A-10C. EX1002, ¶297.

M. Claim 11

Under the parties' apparent agreed construction of "throat area," the combination of Dua-592 and Calderone renders claim 11 obvious. As described above under Ground 1A (Claim 11), the '636 patent describes the context of Claim 11 with respect to FIGs. 13 and 15. See below.

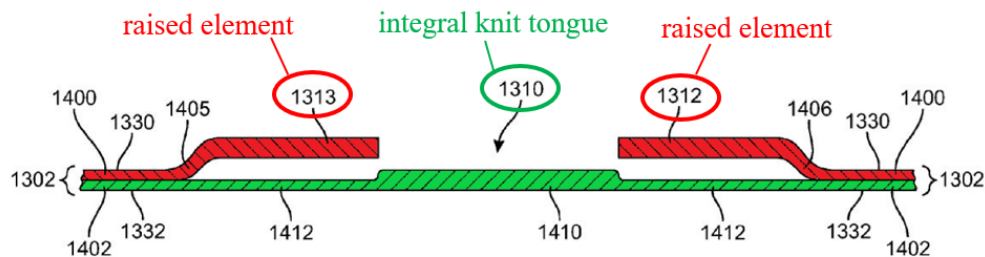


FIG. 15

EX1001, FIG. 15; 15:63-16:7, 16:27-55.

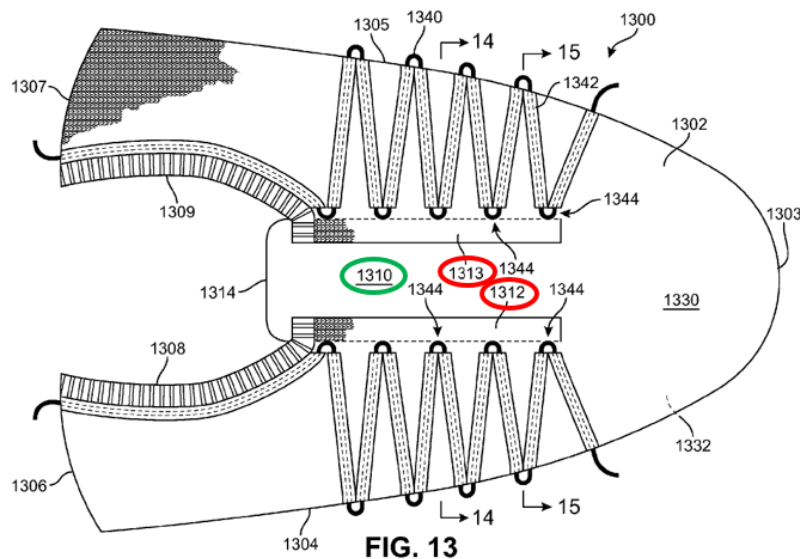
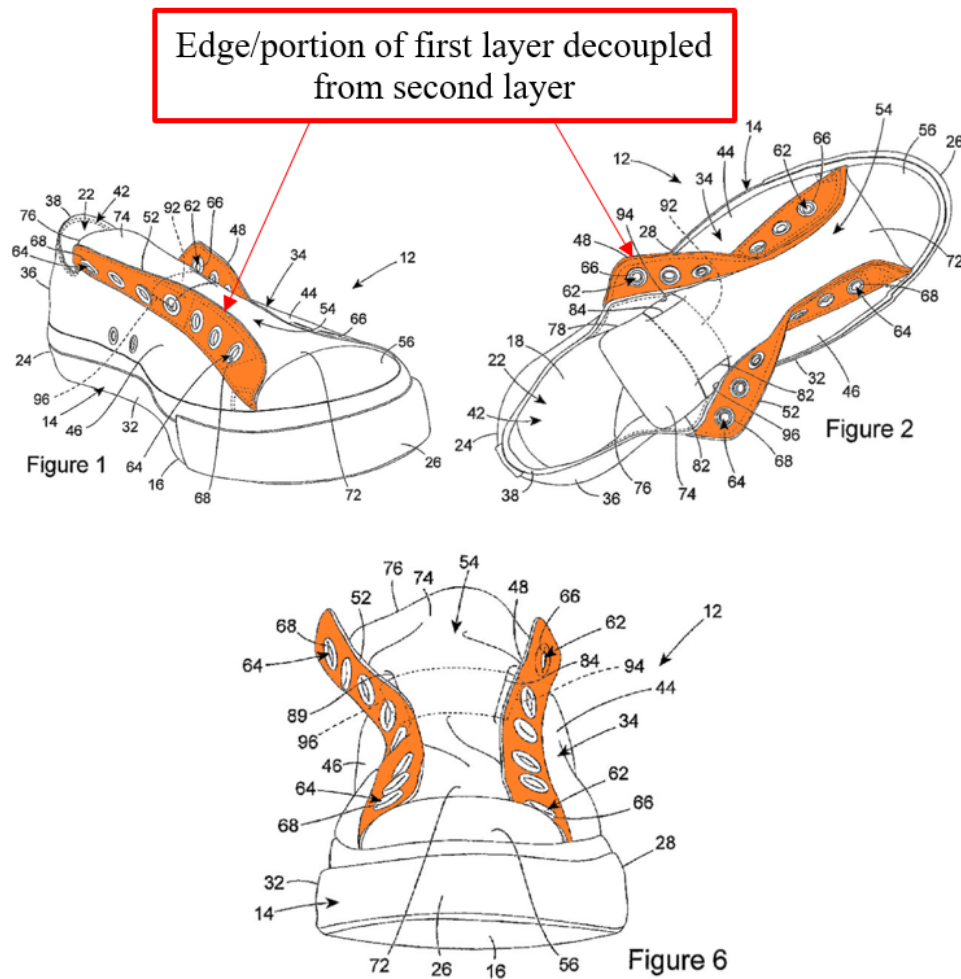


FIG. 13

EX1001, FIG. 13.

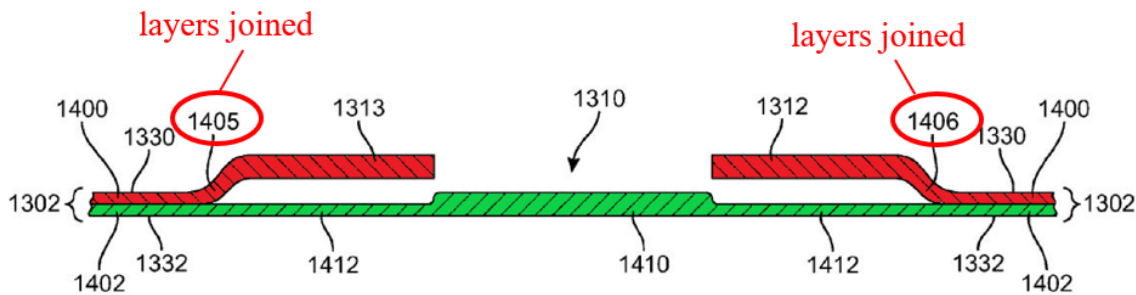
Per Claim 10, Dua-592 in combination with Calderone discloses the “first knit element layer” in the form of Calderone’s raised elements (e.g., upper left side edge 48 and the upper right side edge 52, colored in orange below). Similarly, in the combination of Dua-592 and Calderone described above under Elements 1[b]-1[c] and claim 10, Calderone’s raised elements have a portion that is decoupled from the second knit element layer along the throat area in an analogous fashion as the raised elements 1312/1313 of the ’636 patent, as shown below.



EX1018, FIGs. 1-2, 6; EX1002, ¶¶299-301.

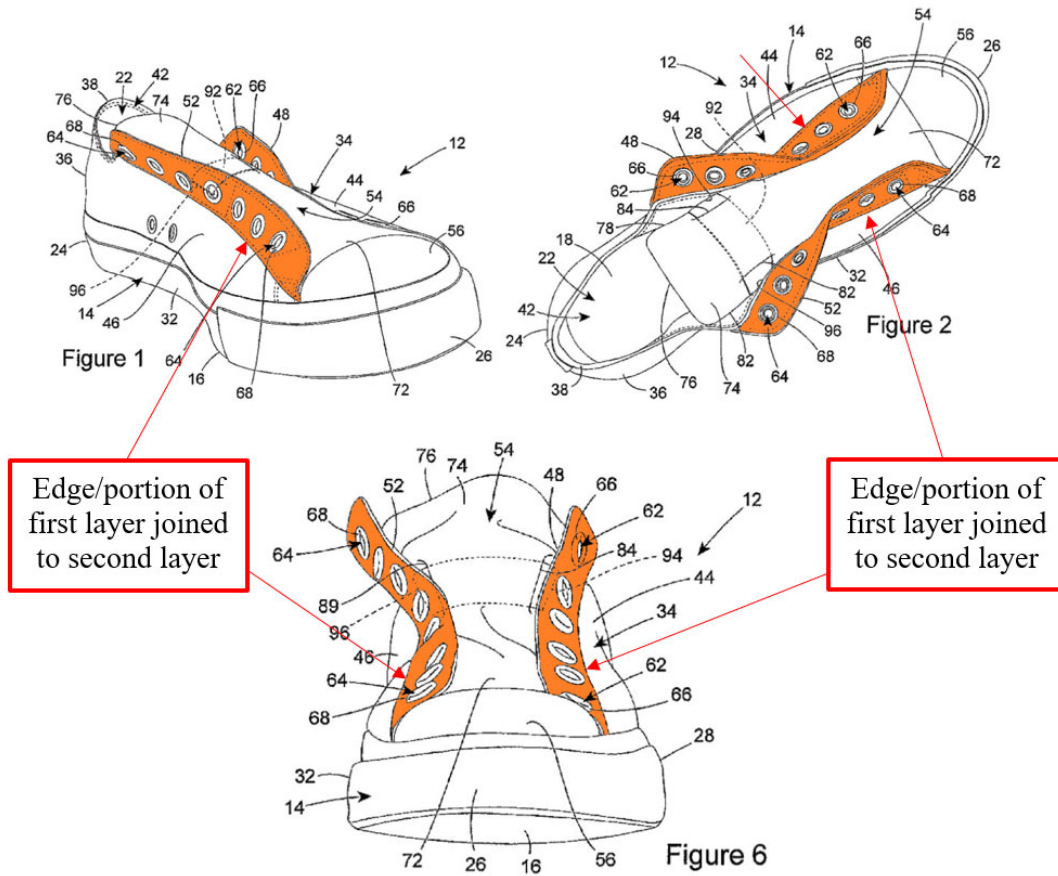
N. Claim 12

Under the parties' apparent agreed construction of "throat area," the combination of Dua-592 and Calderone renders claim 12 obvious. As described above under Ground 1A (Claim 11), the '636 patent describes the first knit element layer 1400 being joined to the second knit element layer 1402 at a first end 1406 where raised element 1312 begins, and a second end 1405 where the medial raised elements 1313 begins. EX1001, 17:28-67.

**FIG. 15**

EX1001, FIG. 15; *see also* FIG. 14.

Similarly, in the combination of Dua-592 and Calderone (*supra*, Elements 1[b]-1[c] and claim 10), Calderone's raised elements (colored in orange below) have a portion that is joined to the second knit element layer along the throat area in an analogous fashion as the raised elements 1312/1313 of the '636 patent. See below.



EX1018, FIGs. 1-2, 6; EX1002, ¶¶302-304.

O. Claims 13-17 and 19-27

Claims 13-17 and 19-27 are substantially similar to claims 1-6 and 8-12 and are therefore obvious for the same reason. The analysis corresponding to each of claims 13-17 and 19-27 is identified in the table below.

Claim	Corresponding Analysis
13[pre]	Element 1[pre]; EX1002, ¶¶249-250, 305.
13[a]	Element 1[a1]-1[a2]; EX1002, ¶¶251-254, 306.
13[b]	Element 1[b]; EX1002, ¶¶255-262, 307.

13[c]	Element 1[c]; Claim 6 for lace aperture configured to receive a lace; EX1002, ¶¶262-266, 288, 308.
13[d]	Element 1[d]; EX1002, ¶¶267-273, 309
14	Claim 2; EX1002, ¶¶274-276, 310.
15	Claim 3; EX1002, ¶¶277-280, 311.
16	Claim 4; EX1002, ¶¶281-283, 312.
17	Claim 5; EX1002, ¶¶284-287, 313.
19	Claim 8; EX1002, ¶¶289-291. 314.
20	Claim 9; EX1002, ¶¶292, 315.
21[pre]	Element 1[pre]; EX1002, ¶¶249-250, 316.
21[a]	Elements 1[a1], 1[a2], 1[b]; EX1002, ¶¶251-262, 317.
21[b]	Claim 10; EX1002, ¶¶293-298, 318. Element 1[a2] for additional analysis of interior/exterior surfaces and void for receiving a foot; EX1002, ¶¶253-254, 319__.
21[c]	Element 1[d]; EX1002, ¶¶267-273, 320.
22	Claim 10; EX1002, ¶¶293-298, 321.
23	Claim 11; EX1002, ¶¶299-301, 322.
24	Claim 12; EX1002, ¶¶302-304, 323.
25	Claim 2; EX1002, ¶¶273-276, 324.
26	Claim 4; EX1002, ¶¶281-283, 325.
27	Element 1[c] and Claim 10; EX1002, ¶¶263-266, 293-298, 326.

XI. GROUND 2B: CLAIMS 7 AND 18 ARE OBVIOUS UNDER GROUND 2A IN FURTHER VIEW OF MCDONALD AND/OR HORII

The “partially integral portion” limitations of Claims 7 and 18 are similar to Elements 1[b] and 1[d], as described above. *See* Section IX. Regarding the “free portion” limitation, at least Embodiments #1 and #3 include such a “free portion” in form of the tab highlighted below in green.

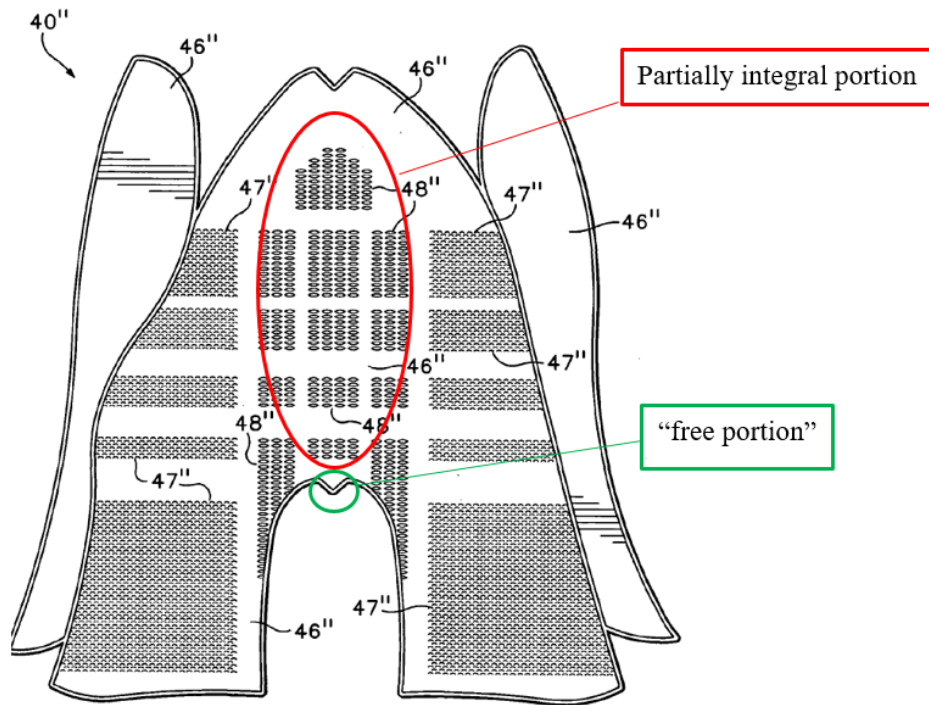
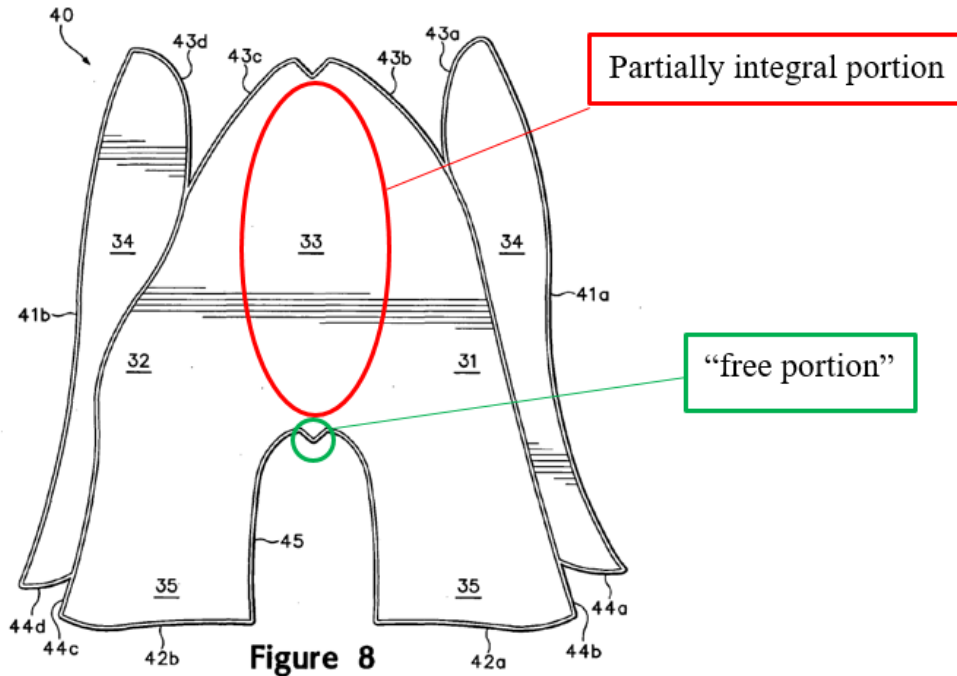


Figure 11



EX1014, FIGs. 8 & 11.

That Dua-592's figures depict a "free portion" in accordance with claims 7 and 18 is consistent with Nike's apparent interpretation of the term, as reflected in its infringement contentions. See below.

Ultra Flex 3.0 - Big Plan (#149854):



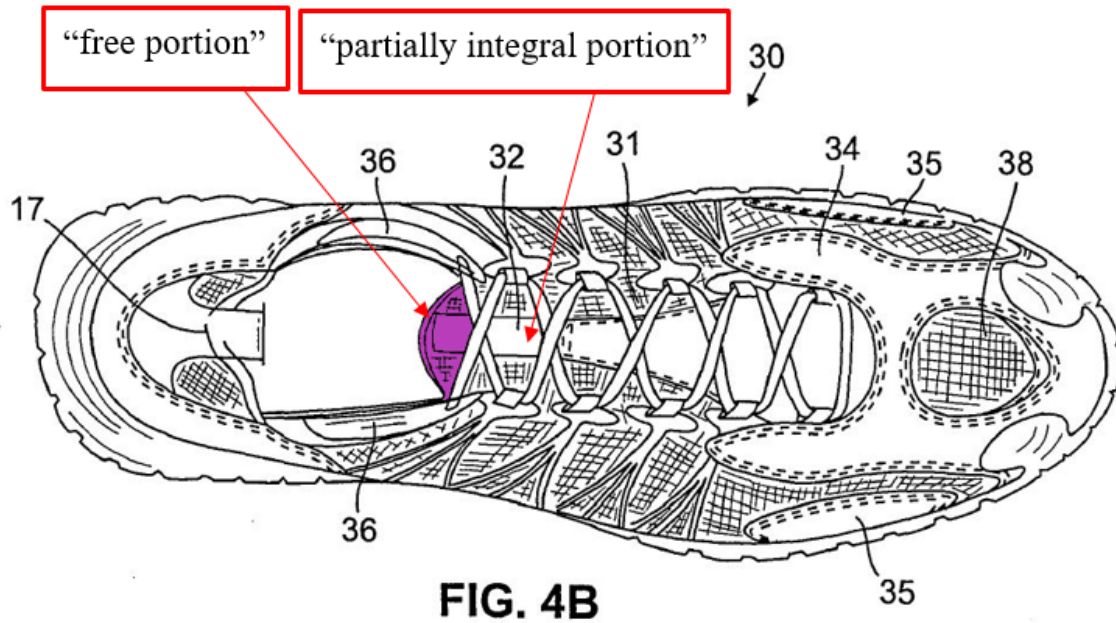


EX1011 (Nike's '636 Infringement Contentions), 433, 448.



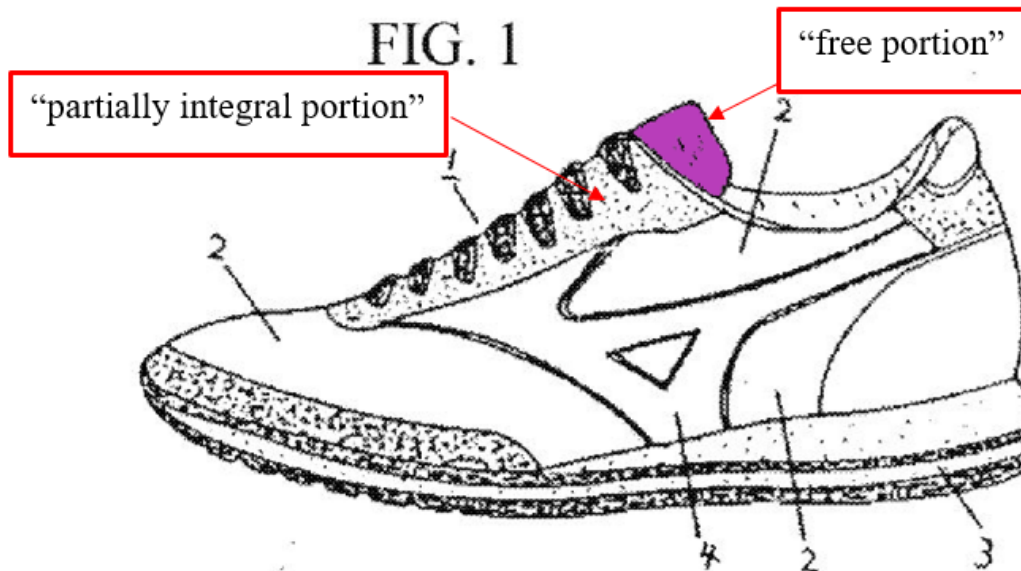
EX1040, 432, 447.

It would have been obvious to further extend the existing tab of Dua-592's integral tongue to form a more pronounced "free portion," and a POSITA would have had a reasonable expectation of success in doing so, as was generally known from at least McDonald and/or Horii. *Supra*, Ground 1D; EX1002, ¶¶327-332. For example, McDonald discloses an integral tongue having a free portion.



EX1016, FIG. 4B; *id.*, 12-13; EX1002, ¶333.

Horii also discloses a unitary knit shoe, as described above under Grounds 1B and 1D. And, as shown below, Horii's upper member 2 also comprises an integral portion and a free portion (in purple).



EX1017, Fig. 1; EX1002, ¶334.

Constructing uppers with a “free portion” was a generally known feature and a popular design choice for athletic shoes, generally. EX1003, ¶¶24-25; EX1002, ¶335.



EX1032, 11, 13.

In addition to the fact that “free portions” of integral knit tongues were generally known, a POSITA would have been motivated to further extend the tab of

Dua-592's integral tongue in the manner disclosed in McDonald and Horii because it would allow the wearer to more easily grasp and pull the shoe onto the wearer's foot. See e.g., EX1018, 3:66-4:3; EX1016, (13:3-4 ("As shown in Fig. 4B, an element 32 is provided for grasping when inserting the foot into the shoe."); EX1003, ¶¶24-25; EX1002, ¶336. A POSITA would have a reasonable expectation of success. EX1002, ¶337.

XII. DISCRETIONARY FACTORS

A. § 314(a) Does Not Favor Denial

This Petition raises a compelling case of unpatentability for all claims of the '562 patent. Per the Director's June 21, 2022, Memorandum on the "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" ("Guidance Memorandum"), this fact "alone demonstrates that the [Board] should not discretionarily deny institution under *Fintiv*." EX1012, 4-5.

B. § 325(d) Does Not Favor Denial

McDonald, Horii and Calderone were not before the Examiner. And while Dua-956 and Dua-592 were cited during prosecution along with nearly 200 other references (EX1001, 2-3), the Examiner did not address either reference during prosecution, and therefore the record supports the fact that the Examiner overlooked the full scope of their teachings. Moreover, Dua-956 and Dua-592 are each combined, at least in the alternative, with McDonald, Horii and/or Calderone, and

therefore the Petition presents new combinations and arguments not previously considered by the Office.

Moreover, the Petition makes a strong showing that all claims are unpatentable, and therefore the Board should not discretionarily decline institution.

XIII. STATUTORY REQUIREMENTS

A. Notice of Real Party-In-Interest (37 C.F.R. § 42.8(b)(1))

The real party-in-interest for this Petition is Skechers U.S.A., Inc.

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

The '636 Patent is currently asserted in the following ongoing litigations:

- *Nike, Inc. v. Skechers U.S.A., Inc.*, Case No. 2:23-cv-09346-AB-PVC
(C.D. Cal.)
- *Nike, Inc. v. New Balance Athletics, Inc.*, Case No. 1:23-cv-12666-
JEK (D. Mass)

To Petitioner's counsel's knowledge, there are no other judicial or administrative matters regarding the '636 patent that would affect or be affected by a decision in this proceeding.

C. Designation of Lead And Back-Up Counsel (37 C.F.R. § 42.8(b)(3))

Lead Counsel: Samuel K. Lu (Reg. No. 40,707)

Backup Counsel: Keith Orso (Reg. No. 52,084)

Backup Counsel: Jonathan M. Lindsay (Reg. No. 45,810)

Backup Counsel: Michael Rosen (*pro hac vice* to be requested)

Backup Counsel: Jie Gao (Reg. No. 73,835)

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Telephone: (310) 277-1010
Fax: (310) 203-7199

D. Service Information (37 C.F.R. § 42.8(b)(4))

Please address all correspondence to lead counsel at the address above.

Petitioner consents to email service at: SkechersNikeIPRs@irell.com.

E. Fees

The Office is authorized to charge Deposit Account No. 09-0946 for any fees required.

F. Grounds for Standing

Petitioner certifies that the '636 patent is eligible for IPR and that Petitioner is not barred or estopped from requesting an IPR of the '636 Patent.

XIV. CONCLUSION

For the reasons above, claims 1-27 of the '636 patent should be deemed unpatentable.

Dated: November 5, 2024

Respectfully submitted,

/Samuel K. Lu/

Samuel K. Lu (Reg. No. 40,707)

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Los Angeles, CA 90067-4276

CERTIFICATE OF WORD COUNT

I hereby certify, pursuant to 37 C.F.R. section 42.24, that the foregoing Petition contains 13,889 words, excluding the words in the table of contents, table of authorities, exhibit list, this certificate of word count, and certificate of service. The word count is based on the word count of the Microsoft Word program used to prepare the Petition.

/Jonathan M. Lindsay/
Jonathan M. Lindsay

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of this PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,510,636, PETITIONER'S POWER OF ATTORNEY, AND EXHIBITS 1001-1019, 1023-1026, 1028-1043 and 1050-1062, are being via Priority Mail Express on Patent Owner at the correspondence address of record for the subject patent as follows:

78342 - SHOOK, HARDY & BACON LLP/NIKE, INC.
2555 Grand Boulevard
Kansas City, MO 64108

An electronic courtesy copy has been sent on this day to Patent Owner's counsel of record in the matters identified in Section XIII.B by email as follows:

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Pia S. Kamath

/Pia S. Kamath/