

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NIKE, INC.,
Patent Owner.

IPR2025-00151
Patent 9,510,636 B2

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

BARRETT, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

Skechers U.S.A., Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of U.S. Patent No. 9,510,636 B2 (“the ’636 patent,” Ex. 1001). Paper 2 (“Pet.”). The Petition challenges the patentability of claims 1–27 of the ’636 patent. Nike, Inc. (“Patent Owner”)² filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 8, “Pet. Prelim. Reply”) and Patent Owner filed a Sur-reply (Paper 10, “PO Prelim. Sur-reply”).

An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Having considered the arguments and evidence presented by Petitioner and Patent Owner, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on at least one of the challenged claims of the ’636 patent. Accordingly, we do *not* institute an *inter partes* review of the challenged claims.

B. Related Proceedings

Both parties identify, as matters involving or related to the ’636 patent, *Nike, Inc. v. Skechers U.S.A., Inc.*, No. 2:23-cv-09346-AB-PVC

¹ Petitioner identifies Skechers U.S.A., Inc. as real parties in interest. Pet. 124.

² Patent Owner identifies Nike, Inc. as the real party in interest. Paper 3, 2.

(C.D. Cal.), and *Nike, Inc. v. New Balance Athletics, Inc.*, No. 1:23-cv-12666-JEK (D. Mass). Pet. 124; Paper 3, 2.

C. The '636 Patent

The '636 patent “relates generally to articles of footwear, and, in particular, to an article of footwear incorporating a knitted component with an integral knit tongue.” Ex. 1001, 1:21–23.

Figure 1 of the '636 patent is reproduced below.

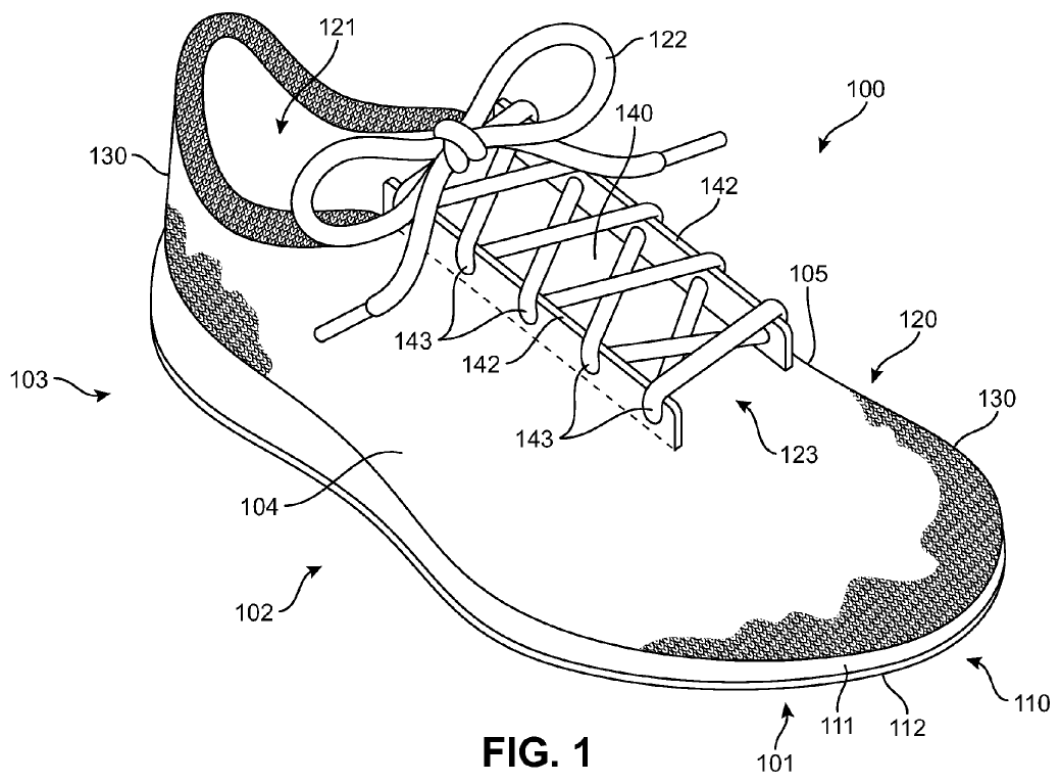


Figure 1 “is an isometric view of an exemplary embodiment of an article of footwear.” *Id.* at 3:37–38. The '636 patent explains that:

Many conventional footwear uppers are formed from multiple material elements (e.g., textiles, polymer foam, polymer sheets, leather, synthetic leather) that are joined through stitching or bonding, for example. In contrast, a majority of upper 120 is formed from a knitted component 130, which 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. . . . In some configurations, knitted component 130 may also extend under the foot.

Id. at 6:54–67. The ’636 patent further states that, “[i]n some embodiments, a throat area 123 extends from ankle opening 121 in heel region 103 over an area corresponding to an instep of the foot to an area adjacent to forefoot region 101.” *Id.* at 6:31–34. “In an exemplary embodiment, 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.* at 6:35–38.

D. Illustrative Claim

Of the challenged claims of the ’636 patent, claims 1, 13, and 21 are independent claims. Claim 1, reproduced below with bracketed annotations³ inserted, is illustrative.

1. [1Pre] An article of footwear having an upper and a sole structure secured to the upper, the article of footwear incorporating a knitted component comprising:
 - [1a1] a portion of the knitted component defining the upper,
[1a2] 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
 - [1b] an integral knit tongue formed with the upper and extending through a throat area of the knitted component; and
 - [1c] at least one raised element extending a height above the exterior surface of the knitted component,

³ We utilize Petitioner’s annotations for claim 1 but have retained the paragraph formatting from the issued patent.

[1d] 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.

Ex. 1001, 25:2–18.

E. Evidence

Petitioner relies on the following references:

Name	Reference	Exhibit No.
Dua-592	US 2005/0193592 A1, published Sept. 8, 2005	1014
McDonald	WO 98/43506, published Oct. 8, 1998	1016
Horii	JP H3-003203, published Jan. 14, 1991	1017 ⁴
Calderone	US 7,624,518 B2, issued Dec. 1, 2009	1018
Dua-956	US 7,774,956 B2, issued Aug. 17, 2010	1029

Petitioner also relies on the Declaration of Dr. Sabit Adanur (Ex. 1002) and the Declaration of Grant Delgatty (Ex. 1003) in support of its arguments. The parties also rely on other exhibits as discussed below.

F. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ⁵	Reference(s)/Basis
1–6, 8–17, 19–27	102(b)	Dua-956

⁴ Petitioner, for Horii, also cites Exhibit 1031, which includes a translator’s certification along with a document in Japanese and a translation. Pet. 20. We are unable to locate any other citations to that exhibit in the Petition. Like Petitioner, we cite herein to Exhibit 1017 for Horii.

⁵ The application that issued as the ’636 patent was filed before the effective date of the Leahy Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), and we apply the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

Claim(s) Challenged	35 U.S.C. § ⁵	Reference(s)/Basis
1–6, 8–17, 19–27	103(a)	Dua-956, Horii
1–6, 8–17, 19–27	103(a)	Dua-956, Horii, Calderone
7, 18	103(a)	Dua-956, Horii, Calderone, McDonald
1–6, 8–17, 19–27	103(a)	Dua-592, Calderone
7, 18	103(a)	Dua-592, Calderone, McDonald, Horii

II. ANALYSIS

A. Principles of Law

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see also Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008) (to anticipate a patent claim under 35 U.S.C. § 102, “a single prior art reference must expressly or inherently disclose each claim limitation”). Moreover, “[b]ecause the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Whether a reference anticipates is assessed from the perspective of one of ordinary skill in the art. *See Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368–69 (Fed. Cir. 2003) (“[T]he dispositive question regarding anticipation [i]s whether *one skilled in the art* would reasonably understand or infer from the

[prior art reference's] teaching' that every claim element was disclosed in that single reference.” (second and third alterations in original) (quoting *In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991))).

Additionally, “[u]nder the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999); see *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349–50 (Fed. Cir. 2002).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) if present, any objective evidence of obviousness or non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. The Level of Ordinary Skill in the Art

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995)

(quoting *Custom Accessories, Inc. v. Jeffrey–Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)).

Petitioner contends that:

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.*

Pet. 17–18. Patent Owner states that, “[f]or the purposes of this Preliminary Response only, Nike applies [Petitioner] Skechers’ proposed level of skill in the art.” Prelim. Resp. 19.

Petitioner’s definition is consistent with the level of ordinary skill reflected in the prior art references of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (recognizing that the prior art itself may reflect an appropriate level of skill in the art). For purposes of this decision, we apply Petitioner’s definition of the person of ordinary skill in the art.

C. Claim Construction

We apply the same claim construction standard used in district court actions under 35 U.S.C. § 282(b), namely that articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). In applying that standard, claim terms generally are given their ordinary and customary meaning as would have been understood by a person

of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips*, 415 F.3d at 1312–13. “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). “[W]hile extrinsic evidence can shed useful light on the relevant art, . . . it is less significant than the intrinsic record in determining the legally operative meaning of claim language.” *Phillips*, 415 F.3d at 1317 (internal quotation marks omitted).

Petitioner states that, “[h]ere, 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.” Pet. 18. Petitioner further states that “this Petition includes challenges of the claims based on Patent Owner’s reading of the claims onto the accused shoes in the parallel litigation,” and “[t]he Petition also challenges the claims under Petitioner’s constructions.” *Id.* at 19.

Patent Owner states that, “[f]or purposes of this IPR, [Patent Owner] Nike contends that no terms require construction,” and asserts that “[a]ll terms and phrases in the ’636 Patent claims have their ordinary and customary meanings, which are readily apparent, and no further construction is required.” Prelim. Resp. 20.

Despite the parties stating they offer no express constructions, they nonetheless present us with three different claim constructions for the term “integral knit tongue” in discussing the disputed issues of whether the prior art references disclose that tongue. *See* Pet. 33, 70–71; Prelim. Resp. 46–47.

The parties identify positions each argued or purportedly implicitly argued in the District Court, but offer little or no claim construction analysis in this *inter partes* review. *See* Pet. 33, 70–71; Prelim. Resp. 46–47; *cf. Phillips*, 415 F.3d at 1314 (“Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms idiosyncratically, the [tribunal] looks to ‘those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean.’ Those sources include ‘the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.’” (citations omitted)). We do not agree with the parties’ proposed constructions, which we discuss further below, and we need not simply adopt one party’s proposed construction. *Cf. Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995) (“The duty of the trial judge is to determine the meaning of the claims at issue, and to instruct the jury accordingly. In the exercise of that duty, the trial judge has an independent obligation to determine the meaning of the claims, notwithstanding the views asserted by the adversary parties.” (citation omitted)).

A proper claim construction analysis begins with the words of the claims. *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (“First, we look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention.”). All of the challenged independent claims recite an “integral knit tongue.”

See Ex. 1001, 25:10 (independent claim 1), 26:16 (independent claim 13), 26:59 (independent claim 21). Independent claim 1, for example, recites:

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

[1d] 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.

Id. at 25:10–18 (emphasis added).

Claim 1 further recites, in a separate limitation, an “upper.” *Id.* at 25:5 (limitation 1a1: “a portion of the knitted component defining the upper”). “Where a claim lists elements separately, ‘the clear implication of the claim language’ is that those elements are ‘distinct component[s]’ of the patented invention.” *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (quoting *Gaus v. Conair Corp.*, 363 F.3d 1284, 1288 (Fed. Cir. 2004)) (alteration in original). Thus, the claim language suggests that the “integral knit tongue” is a component distinct, at least to some degree, from the “upper.” See also Ex. 1001, 2:27–28 (the Specification stating that “[a] knitted component including the upper and an integral knit tongue is incorporated into the article of footwear.”).

Limitation 1d reinforces this understanding by requiring the tongue to be joined to a portion of the throat area of the upper. See *id.* at 6:35–38 (the Specification indicating that the “throat area” is an area of the upper); cf. Ex. 2014, 18–19 (defining “Throat”: “The main opening of a shoe extending from the vamp [(the front part of a shoe upper that covers the toes and part of the foot)] to the ankle.”). In addition to suggesting that the tongue is a component distinct from the upper, the claim language indicates

that the integral knit tongue extends through a throat area. *See* Ex. 1001, 25:10–11 (limitation 1b: “an integral knit tongue . . . extending through a throat area of the knitted component”). With that context, we turn to the parties’ arguments.

Petitioner begins by discussing what it characterizes as Patent Owner’s purported implied construction in the District Court of “integral knit tongue.” Pet. 32–33. Petitioner asserts that “[Patent Owner] Nike’s infringement contentions, portions of which are reproduced [in the Petition], indicate that Nike’s apparent understanding of ‘integral knit tongue’ refers generally to knitted material within the throat area.” *Id.* at 33; *see also id.* at 32 (Petitioner stating that it, in the District Court, “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.* at 35 (citing, *inter alia*, Ex. 1002 ¶ 120). Petitioner presumably does not agree with this purported construction and, not unsurprisingly, does not discuss in the Petition how any intrinsic or extrinsic evidence would support such a construction. *See id.* at 32–33 (merely reproducing annotated photographs of allegedly infringing footwear).⁶

On the present record, we do not agree with this construction offered by Petitioner—that “integral knit tongue” “generally refers to the material

⁶ The cited Exhibit 1002 is the declaration of Dr. Adanur. Paragraph 120 merely repeats Petitioner’s assertions without offering an opinion as to whether the constructions are correct. *See, e.g.*, Ex. 1002 ¶ 120 (“I understand that Skechers proposed in the litigation that”); *id.* (“I also note that Nike’s infringement contentions indicate that Nike’s apparent understanding of ‘integral knit tongue’ refers generally to”).

within the throat area.” Pet. 33. Such a construction, particularly as applied to the prior art, seemingly gives no weight to, and possibly reads-out, the recited structure of a tongue extending through the throat area of the separately recited “upper.” *See, e.g., id.* at 96. More specifically, Petitioner impliedly asserts that the tongue limitations of claim 1 are satisfied if the prior art discloses an upper having upper material over the area of the instep of the foot, notwithstanding that the claim recites both an upper and a tongue. *See id.*

Additionally, Petitioner, in asking us to evaluate patentability under this construction—for which neither party contends is correct and which may never be adopted by any tribunal—requests, in effect, that we set aside the challenged patent and instead compare the accused footwear against that of the prior art references. However, that is not a proper analysis. “Both anticipation under § 102 and obviousness under § 103 are two-step inquiries.” *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003). “The first step in both analyses is a proper construction of the claims . . . [and t]he second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Id.* Although an explicit claim construction analysis by a petitioner is not required in every case, a petition nonetheless must identify how the challenged claims are to be construed and how, as so construed, they are unpatentable under the statutory grounds asserted. 37 C.F.R. § 42.104(b)(3)–(4). And, being part of a *prima facie* case, such an analysis is part of Petitioner’s burden to demonstrate a reasonable likelihood of prevailing on its patentability challenges. Petitioner has failed to satisfy the threshold burden for every ground based on this construction.

Petitioner, in discussing the alternative construction for which it does advocate, states:

Skechers proposed [in the parallel litigation] 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. 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.

Pet. 70–71 (footnote omitted). The Petition does not contain a discussion of any intrinsic or extrinsic evidence that supports Petitioner’s position. *See id.*⁷

We do not agree with this proposed construction. First, although the Specification describes embodiments having two raised elements in a particular location, the independent claims do not recite overhanging portions or the location of plural raised elements, and we decline to read into the claims such a limitation. *See, e.g.*, Ex. 1001, 6:39–40 (The Specification stating: “A lace 122 extends through various lace apertures 143 in raised elements 142 of integral knit tongue 140 . . .”), Fig. 1 (depicting raised elements 142); *Phillips*, 415 F.3d at 1323 (“[A]lthough the specification often describes very specific embodiments of the invention, we have

⁷ As with Petitioner’s first construction, the pertinent portion of Dr. Adanur’s declaration is not opinion testimony as to the meaning of claim terms but rather repeats Petitioner’s arguments. *See* Ex. 1002 ¶ 227 (“I understand that Skechers has proposed that the term ‘integral knit tongue’ corresponds to . . .”).

repeatedly warned against confining the claims to those embodiments.”). For example, independent claim 1 broadly recites “at least one raised element extending a height above the exterior surface of the knitted component,” but it is not until dependent claim 5 (which depends from claim 4, which depends from claim 1) that a claim recites “at least two raised elements disposed on each of the lateral side and the medial side of the throat area of the upper.” Ex. 1001, 25:28–31; *see also id.* at 25:33–35 (dependent claim 6, which also depends from claim 4, further defining the “at least one raised element” as having a lace aperture); *id.* at 26:57–27:8 (independent claim 21 lacking even “at least one raised element”). Second, this construction, somewhat like Petitioner’s first alternative construction, purports to define a throat area of the upper rather than a distinct structure of an “integral knit tongue.” Petitioner does not explain how the addition of overhanging elements or raised elements to an otherwise tongueless upper would change the character of the upper within the throat area or create a distinct tongue element extending through that throat area. Third, Petitioner’s proposed construction, at least as to the raised element aspect, appears to be circular in that it first defines the tongue in terms of raised elements, and then defines the raised elements in terms of the tongue (i.e., a raised element extending along the length of the side of the tongue that purportedly is created by the location of the raised elements). Lastly, by simply stating its position taken in the District Court, Petitioner again fails to provide an adequate claim construction analysis to support a threshold showing of unpatentability.

Patent Owner asserts that Petitioner mischaracterizes Patent Owner’s position in the District Court, and that Patent Owner does *not* contend that

“integral knit tongue” refers generally to knitted material within the throat area. Prelim. Resp. 46 (citing Pet. 33). Rather, Patent Owner states that it articulated to the District Court that the “integral knit tongue” “is ‘integrally knitted’ with the upper, but still has distinctive features of a conventional tongue.” *Id.* (quoting Ex. 2014 (Nike’s supplemental claim construction brief in the District Court), 1); *see also id.* at 58 (Patent Owner referring to “Nike’s actual claim construction argument”). According to Patent Owner, “[i]n conventional articles of footwear, the tongue is a separate component stitched into the upper,” and that “[t]he ’636 Patent provides various non-limiting examples of an ‘integral knit tongue.’” *Id.* at 46. Patent Owner then catalogs certain admittedly-exemplary integral tongue embodiments in the Specification, including those: 1) having a portion that extends into the ankle opening, 2) having a free portion that provides an enlarged ankle opening, and 3) being made from a different yarn than the surrounding upper. *Id.* at 46–47 (citing Ex. 1001, 11:49–52, 13:24–36, 14:4–20, 17:6–27, Figs. 8, 10). According to Patent Owner, in the first two examples, “the integral knit tongue is identifiable by its upper boundary which extends beyond the adjacent periphery of the ankle opening,” and, in the third example, “the integral knit tongue may be visually and structurally distinct from the surrounding upper.” *Id.* at 47. Patent Owner, as a fourth example, asserts that “the integral knit tongue may have raised elements that may or may not incorporate lace apertures.” *Id.* (citing Ex. 1001, 10:1–31).

We do not find Patent Owner’s proposed construction to be sufficient. At least some of Patent Owner’s purportedly distinctive features do not affect the character of the throat area such that a tongue distinct from the upper is discernable. For example, Patent Owner asserts that an extension

into the ankle opening identifies a tongue, but that speaks only to the area of the ankle opening, and Patent Owner does not explain adequately how a distinctive “integral knit tongue extending through a throat area,” as recited in the independent claims, can be identified.⁸

In summary, for purposes of resolving the disputed issues before us, we construe “integral knit tongue” as a component distinct, at least to some degree, from the “upper” and that extends through the throat area. For purposes of addressing the dispositive issues in this case, we need not and do not reach the degree or substance of distinctiveness necessary to render an integral knit tongue a distinct element of the overall “knitted component” of the preamble of the independent claims.

D. The Alleged Anticipation of Claims 1–6, 8–17, and 19–27 by Dua-956 (Ground 1A)

Petitioner alleges that claims 1–6, 8–17, and 19–27 are anticipated by Dua-956 under what Petitioner characterizes as Patent Owner’s “apparent construction of ‘integral knit tongue.’” Pet. 20 (section heading); *see id.* at 24–44 (addressing independent claim 1).

⁸ This scenario may have been a topic of discussion during the claim construction hearing in the District Court.

MS. STAUBACH [(counsel for Patent Owner)]: . . . For example, like we just talked about with this shoe, it still has this. This piece right here, that would be the top of the tongue.

THE COURT: So if you cut that off, then it’s not a tongue.

MS. STAUBACH: So Nike’s position is that, if this shoe right here did not have this look, then this would not have an integral knit tongue.

Ex. 1033, 30:21–31:7.

1. *Dua-956 (Ex. 1029)*

Dua-956 “relates to an article of footwear having an upper and a sole structure secured to the upper,” where “[t]he upper includes a knitted element formed from at least one mechanically manipulated yarn.”

Ex. 1029, 2:54–57. Dua-956 also “relates to a method of manufacturing an article of footwear . . . [that] includes steps of flat knitting a textile element and incorporating the textile element into the article of footwear.” *Id.* at 2:63–66.

Figure 7 of Dua-956 is reproduced below.

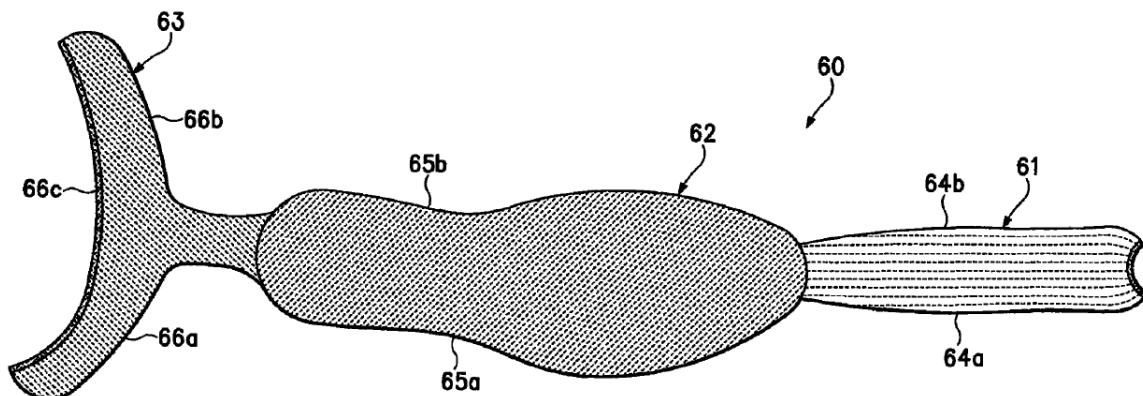
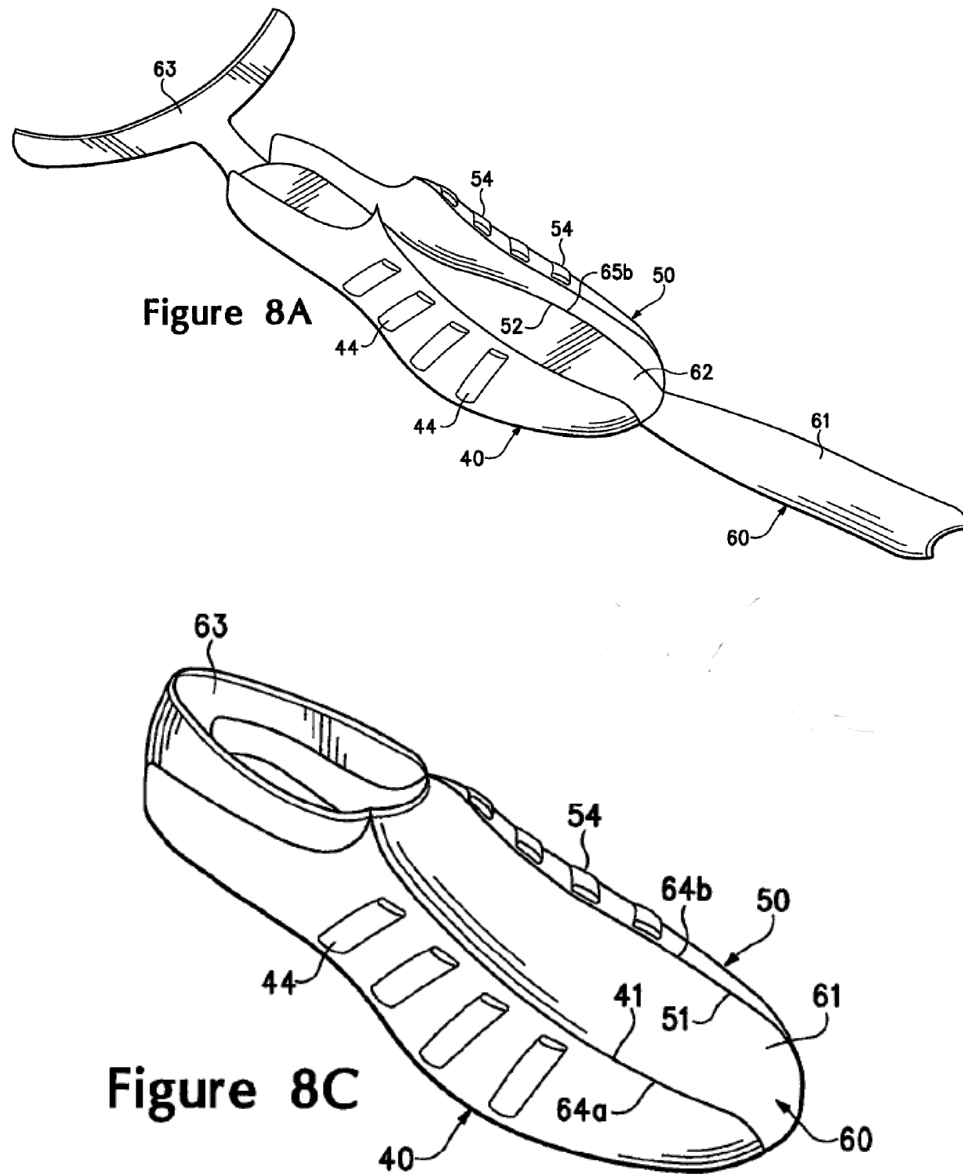


Figure 7

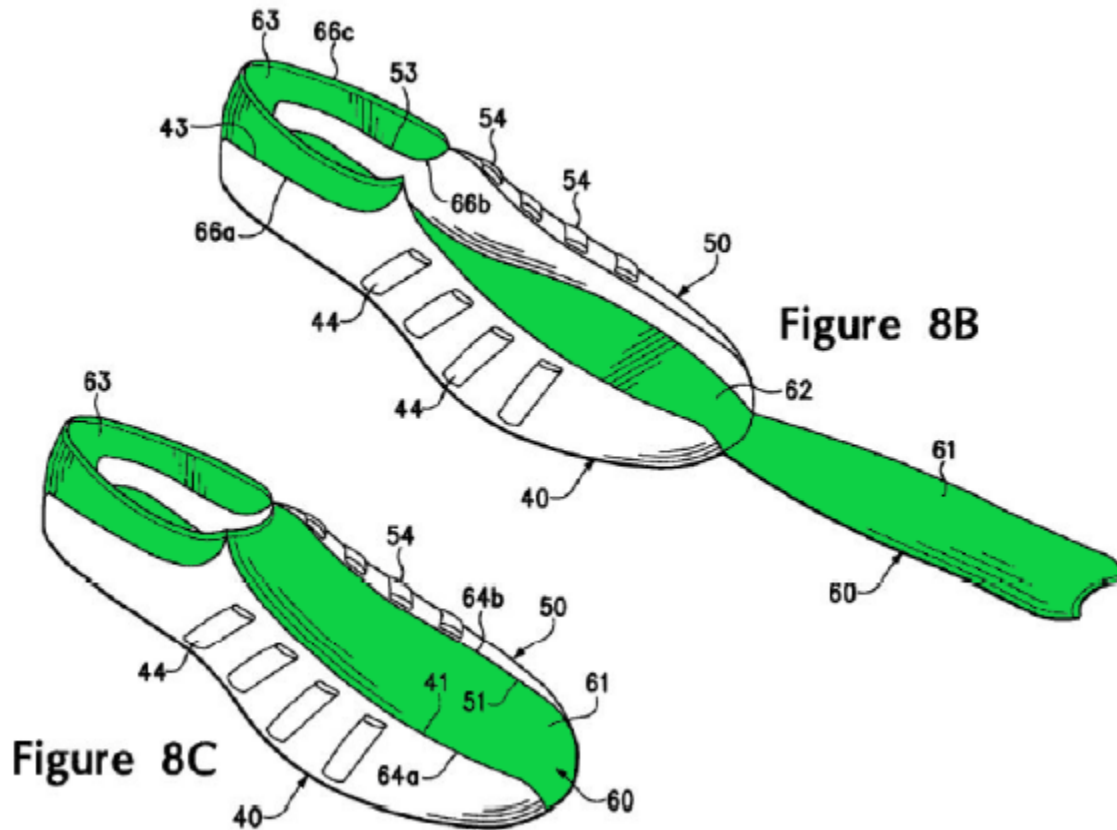
Figure 7 “is a plan view of a central textile element of the first upper.” *Id.* at 3:37–38. “Central textile element 60 . . . includes a forward portion 61, a center portion 62, and a rearward portion 63 formed of unitary (i.e., one piece) construction.” *Id.* at 6:46–49.

Figures 8A and 8C of Dua-956 are reproduced below.



claim language does not specify it, both parties contend that the “portion of the knitted component” constitutes the *majority* of the upper. *See* Pet. 25–26, 30 (Petitioner applying in this ground that which it characterizes as Patent Owner’s claim construction position); Prelim. Resp. 43 (Patent Owner noting that the Specification states that “a majority of upper 120 is formed from a knitted component 130,” and contending that limitation 1a1 means that “a majority *of the upper* must be knitted.” (quoting Ex. 1001, 6:57–59)). Nevertheless, we determine for the following reasons that Petitioner has not shown sufficiently that central textile element 60 of Dua-956 defines an upper within the meaning of the claims. *See* Pet. 26.

Petitioner contends that, “[w]ith 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.’” Pet. 27 (citing Ex. 1001, 1:44–46, 6:66–67). Petitioner reasons that, “[a]s 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.” *Id.* Applying this reasoning to the reference, Petitioner contends that, “[o]f 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,” and therefor “the majority of the parts of the upper are formed by the central element 60.” *Id.* at 30 (citing Ex. 1002 ¶¶ 103–109). Petitioner provides an annotated versions of Figures 8B and 8C of Dua-956, reproduced below, to depict its contentions.



Id. at 30. Above are Figures 8B and 8C of Dua-956—which are, respectively, perspective views depicting a second step and a third step in assembling the article of footwear (Ex. 1029, 3:41–45)—with central textile element 60 shaded green. As Petitioner concedes (Pet. 30) and as the annotated figures above show, central textile element 60 does not form the medial and lateral sides of the footwear. Thus, even if central textile element 60 constitutes the majority of parts of the upper, the sides of the upper remain undefined by the central textile element. Petitioner does not explain adequately how the upper is defined when the side components are missing. We determine that Petitioner has not demonstrated adequately for institution that Dua-956 discloses “a portion of the knitted component defining the upper,” as recited in independent claim 1.

Petitioner also has a one-sentence contention that “Dr. Adanur confirmed that the figures depict the central textile element 60 as comprising the majority of the area of the upper 30.” Pet. 30 (citing Ex. 1002 ¶¶ 110–114). Aside from Petitioner’s failure to explain the basis for its implied theory that the area is the pertinent variable, the area of the sides remains undefined. Thus, this area theory is no more persuasive than Petitioner’s primary theory based on part quantity.

The other independent claims in this ground are claims 13 and 21. Petitioner contends that those claims are “substantially similar” to independent claim 1 and “are therefore anticipated for the same reason.” Pet. 60; *see also id.* at 61 (claim chart indicating that Petitioner, for independent claims 13 and 21, is relying on its contentions for limitation 1a1). Thus, the flaw in Petitioner’s case for independent claim 1 extends to Petitioner’s challenge to independent claims 13 and 21 and their respective dependent claims.

In light of the above, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on its challenge to claims 1–6, 8–17, and 19–27 as anticipated by Dua-956.

E. The Alleged Obviousness of Claims 1–6, 8–17, and 19–27 over Dua-596 alone, or in combination with Horii (Ground 1B)

Petitioner contends that claims 1–6, 8–17, and 19–27 would have been obvious over Dua-596 alone or in combination with Horii. Pet. 62–70. Petitioner asserts that, “[i]f 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.” *Id.*

at 62. Petitioner first turns to the embodiment of Figure 10A of Dua-956, which is reproduced below.

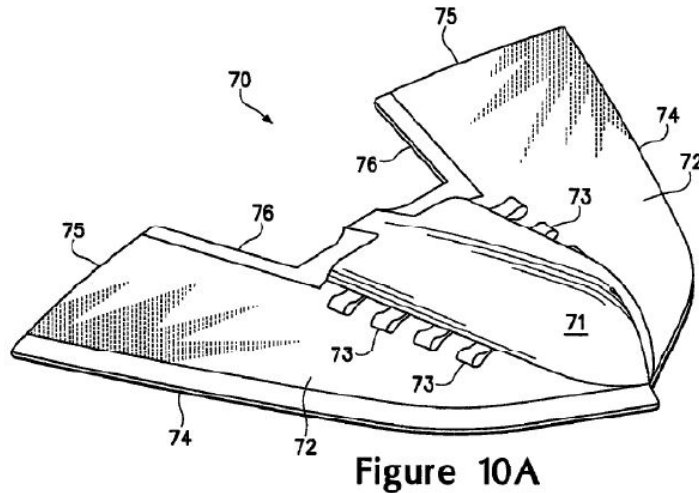
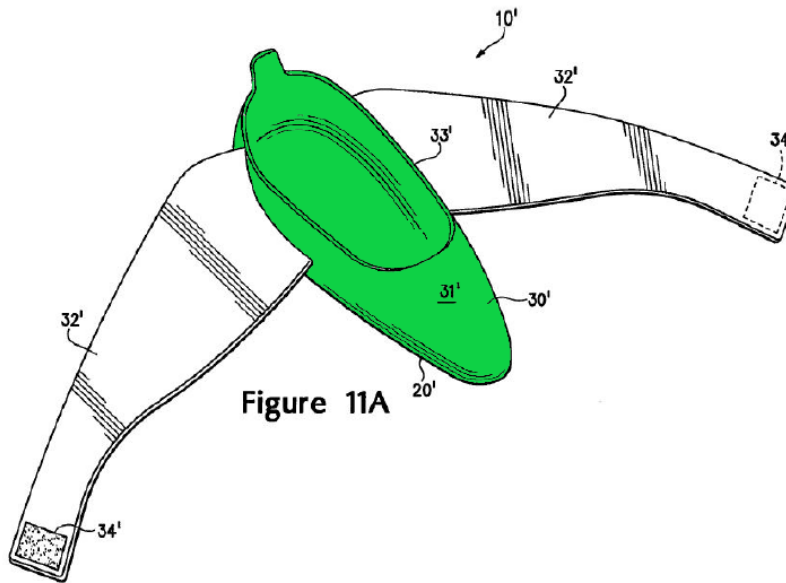


Figure 10A depicts upper 70, a three-dimensional structure formed through a flat knitting process. Ex. 1029, 9:58–60.

When assembled into an article of footwear, central portion 71 extends over the foot, and side portions 72 wrap under the foot. More particularly, side edges 74 are joined to each other (e.g., with stitching) to form a seam that extends under the foot and along a longitudinal length of the foot, . . . [and] rear edges 75 are joined to each other (e.g., with stitching) to form a seam that extends upward along the heel.

Id. at 9:63–10:2. Thus, the major seam is under the foot, unlike that of the Figure 7-8 embodiment, where the seams along the purported tongue are on the top.

Petitioner also refers to the embodiment of Figure 11A. We reproduce below Petitioner's annotated version of that figure.



Pet. 64. Above is Figure 11A of Dua-956, depicting another article of footwear 10', with foot-receiving portion 31', including upper 30', shaded green. *See* Ex. 1029, 10:20–21, 10:31. Dua-956 distinguishes this embodiment with the first embodiment upon which Petitioner relies, stating:

Whereas upper 30 is formed from three separate textile elements 40, 50, and 60 that are joined through stitching, upper 30' is formed from a single textile element formed of unitary construction. In contrast with upper 30, therefore, upper 30' is free from seams that may contact the foot during use.

Id. at 11:1–6.

Petitioner contends that “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.” Pet. 65.

Petitioner next turns to Horii, asserting that “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.” *Id.* at 67 (citing Ex. 1017, 9) (emphasis omitted). Petitioner reasons that “[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.” *Id.* at 68.

We disagree with Petitioner’s assertion that “[c]onstructing Dua-956’s upper 30 as a single, unitary knit component would not materially change the analysis under Ground 1A.” Pet. 70. In Ground 1A, Petitioner contends that “‘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.” *Id.* at 34. During the assembly of footwear 10, forward portion 61 is flipped over the top of the footwear and the separate textile elements 40 and 50 (the sides of the footwear) are stitched to the lateral and medial edges (64a and 64b) of forward portion 61—the purported tongue. *See* Ex. 1029, 9:5–11, Figs. 8B, 8C. Petitioner does not explain adequately how, when modifying the embodiment used in Ground 1A to have a seamless top portion, the purported integral knit tongue is retained in that combination. *See* Pet. 70 (Petitioner asserting that the proposed combination would still have an exterior surface, an inner surface, lace elements 33, channels 44/54, and loops 35, “along with the other structures identified under Ground 1A,” but not specifically discussing the purported integral knit tongue.).

We determine that Petitioner has not demonstrated a reasonable likelihood of demonstrating that claims 1–6, 8–17, and 19–27 would have been obvious over Dua-596 alone or in combination with Horii.

F. The Alleged Obviousness of Claims 1–6, 8–17, and 19–27 “under Grounds 1A–1B in further view of Calderone” (Ground 1C), and The Alleged Obviousness of Claims 7 and 18 “for the reasons articulated under each of Grounds 1A–1C in further view of McDonald and/or Horii” (Ground 1D)

For Ground 1C, Petitioner relies on Calderone for its raised flaps upon which lace openings are arranged and contends that “it would have been obvious to form Dua-956’s overhanging lace elements [of the Figure 3 embodiment] in the well-known manner of a continuous overhanging flap.” *See* Pet. 71–73.

For Ground 1D, Petitioner relies on McDonald and Horii in addressing limitations regarding the integral knit tongue having a free portion and proposes modifying the purported integral knit tongue of Figures 3, 8B–8D, namely forward portion 61’ of the central textile element 60. *See id.* at 75–81.

Petitioner’s articulations of Grounds 1C and 1D do not cure the defects discussed above for Grounds 1A and 1B. Accordingly, we determine that Petitioner has not demonstrated a reasonable likelihood of demonstrating that claims 1–6, 8–17, and 19–27 would have been obvious “under Grounds 1A–1B in further view of Calderone” (Ground 1C) or that claims 7 and 18 would have been obvious “for the reasons articulated under each of Grounds 1A–1C in further view of McDonald and/or Horii” (Ground 1D). Pet. 17 (listing of the grounds).

G. The Alleged Obviousness of Claims 1–6, 8–17, and 19–27 by Dua-592 and Calderone (Ground 2A)

Petitioner alleges that claims 1–6, 8–17, and 19–27 would have been obvious over Dua-592 and Calderone. Pet. 17; *see id.* at 81–102 (addressing independent claim 1). For the reasons discussed below, we determine that

Petitioner has not demonstrated a reasonable likelihood of prevailing on its assertion that the proposed combination teaches the recited “integral knit tongue.”

1. Dua-592 (Ex. 1014)

Dua-592 discloses “an upper for an article of footwear, the upper incorporating a textile element formed with a knitting machine, for example.” Ex. 1014 ¶ 13. “[T]he textile element has edges that are joined together to define at least a portion of a void for receiving a foot.” *Id.*

Figure 8 of Dua-592 is reproduced below.

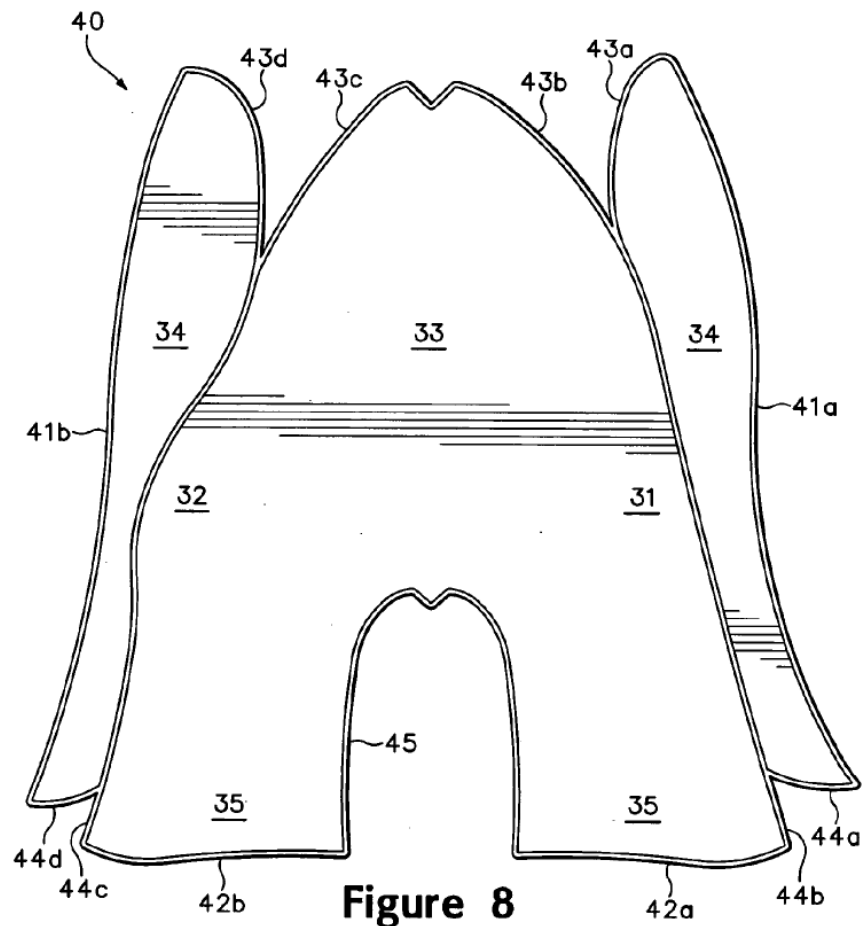


Figure 8 “is a plan view of a textile element that forms at least a portion of the upper.” *Id.* ¶ 25.

Figure 3 of Dua-592 is reproduced below.

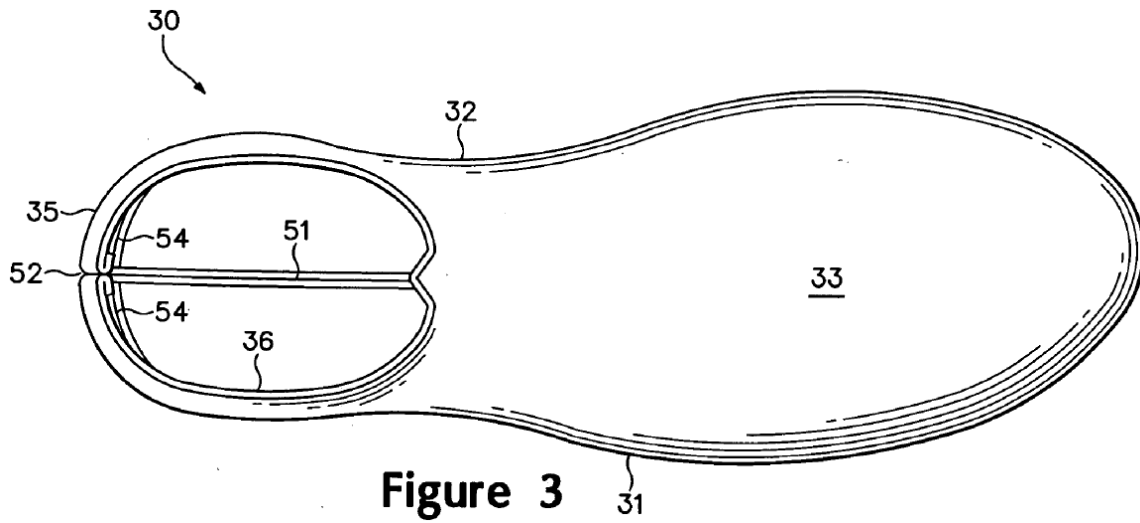
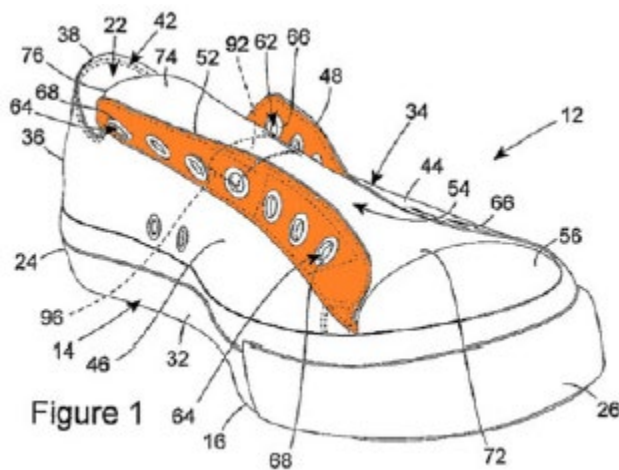


Figure 3 “is a top plan view of the upper.” *Id.* ¶ 20. “Upper 30 is at least partially formed from textile element 40, which forms regions 31–35, and may also include laces or other elements associated with a conventional upper for footwear.” *Id.* ¶ 37.

2. *Calderone (Ex. 1018)*

Calderone discloses “[a] construction of an oxford type, lace up athleisure shoe [that] enables the shoe to be slipped on the wearers foot and held securely on the foot without the need for lacing on the shoe.” Ex. 1018, code (57) (Abstract). According to Calderone, “[t]his provides the shoe with the appearance of a lace up shoe that is worn without lacing.” *Id.*

Reproduced below is Petitioner's annotated version of Figure 1 of Calderone.



Pet. 84. Depicted above is a perspective view of a shoe with Petitioner's annotations in the form of orange shading of upper left side edge 48 and upper right side edge 52 upon which eyelet lacing openings 62, 68 are arranged. *See* Ex. 1018, 2:6, 3:16–18. At least a portion of band 92 is constructed of an elastic material, and “[t]he elastic feature of the band 92 enables the forefoot opening 54 of the shoe 12 to be enlarged when inserting the 65 foot into the shoe.” *Id.* at 3:59–66. “The elastic band 92 extending across the forefoot area of the shoe wearers foot just forward of the ankle holds the shoe 12 securely to the foot without the need for lacing.” *Id.* at 4:6–9.

3. Discussion

The initial dispute as to this ground is whether Dua-592 discloses an integrated knit tongue as recited in each independent claim. *See* Prelim. Resp. 58–59. Petitioner contends that:

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.

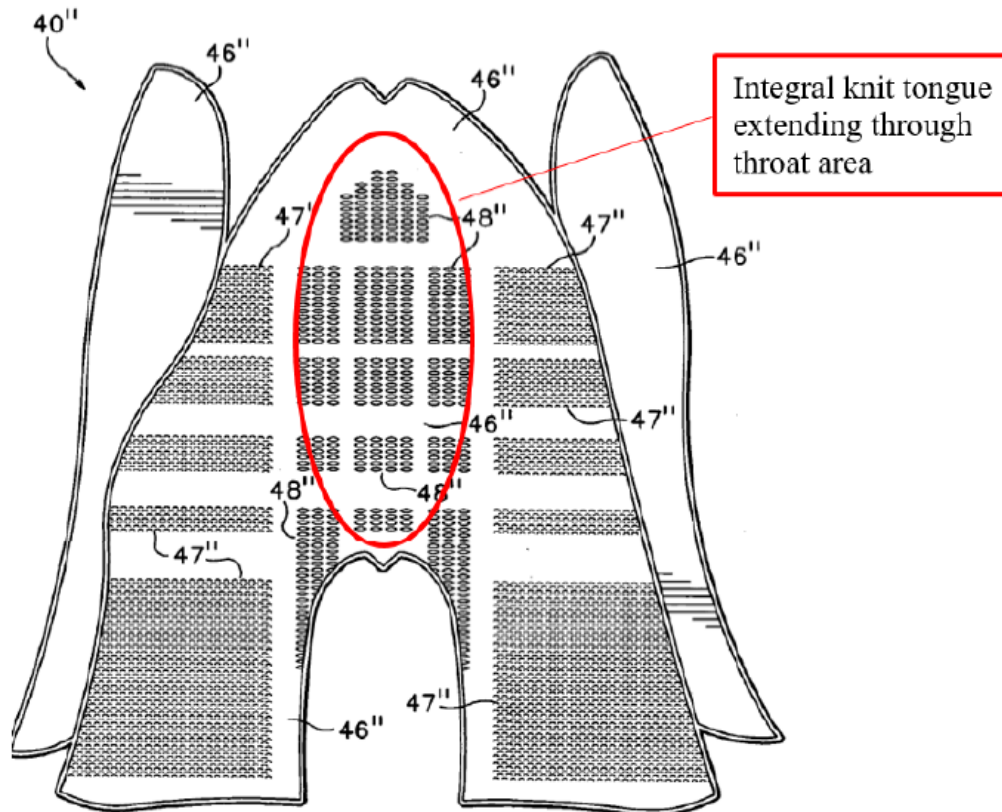


Figure 11

Pet. 93–94 (citing Ex. 1014, Fig. 11; Ex. 1002 ¶¶ 256–258). Above is Figure 11 of Dua-592—a plan view of a textile element having different textures—with Petitioner’s annotations in the form of a red oval around much of instep region of the assembled upper, and a red text box labeling the oval as “Integral knit tongue extending through throat area.” Ex. 1014 ¶¶ 28, 36, 55. Petitioner contends that, “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.” Pet. 95 (citing Ex. 1002 ¶ 259).

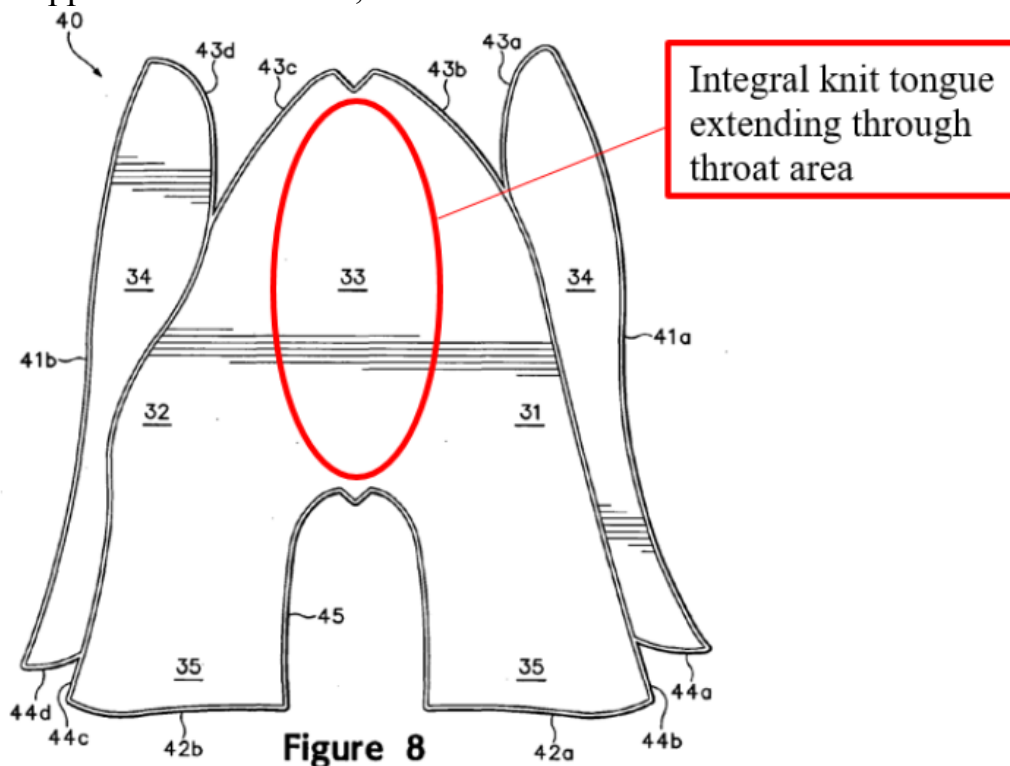
Petitioner, also referring to Figure 11, contends that:

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.”

Id. (citing Ex. 1014 ¶ 55); *see also* Ex. 1002 ¶ 259 (Dr. Adanur opining: “At least under Nike’s apparent construction, the area comprising the third texture 48” is an ‘integral knit tongue’ because it extends along a throat area.”).

Petitioner further contends that:

Embodiment #1 [of Dua-592] also comprises an integral knit tongue extending through a throat area under Nike’s apparent construction, as shown below.



Id. at 95–96 (citing Ex. 1014, Fig. 8). Above is Figure 8 of Dua-592—a plan view of another textile element—with Petitioner’s annotations in the

form of a red oval and red text box similar to that for annotated Figure 11 above. Ex. 1014 ¶ 25.

We do not find Petitioner's contentions regarding the two annotated figures to be persuasive. First, those contentions, and the cited opinions of Dr. Adanur, are based on a claim construction that, as discussed above, we reject and for which neither party advocates. Second, Petitioner does not explain adequately why a person of ordinary skill in the art would discern, even with Petitioner's added red ovals, a tongue distinct from the upper and tongue extending through the throat area.

To the extent that Petitioner contends that the differing textures serve to define an integral knit tongue, we do not find those contentions to be persuasive. *See* Pet. 94–95; Ex. 1002 ¶ 259. Even if differing textures could rise to the level of distinguishing an integral knit tongue from the upper, the purported tongue texture 48" is not confined to the area identified by Petitioner as the tongue. *See* Pet. 94 (annotated Figure 11, reproduced above). For example, texture 48" outside of Petitioner's oval appears to wrap approximately halfway around the ankle opening, which is not argued to be consistent with an ordinary artisan's understanding of a tongue. Or, put another way, there is no indication that the portion of the 48" texture within Petitioner's red oval, which purportedly represents the tongue, is distinguishable from the remaining portion of the 48" texture outside of the red oval. We are not persuaded that Petitioner has demonstrated a reasonable likelihood of proving that a person of ordinary skill in the art would consider the relatively large area depicted as having texture 48" to be an "integral knit tongue."

In light of the above, we determine that Petitioner has not demonstrated a reasonable likelihood of proving that Dua-592 discloses an integral knit tongue.

Petitioner also contends that “[i]t would have been obvious to add the raised elements of Calderone to the upper of Dua-592.” Pet. 96 (citing Ex. 1002 ¶ 261). Petitioner is referring to the annotated version of Calderone’s Figure 1 reproduced above and the orange shaded upper left side edge 48 and upper right side edge 52 upon which eyelet lacing openings 62, 68 are arranged. *See id.* at 84. According to Petitioner:

[T]he proposed combination also satisfies Element [1b] under [Petitioner] Skechers’ construction [of integral knit tongue] 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.

Id. at 96; *see also id.* at 97–98 (Petitioner addressing the “raised element” limitation 1c and describing the location of side edge 48 and upper right side edge 52 on Calderone’s shoe).

For the reasons discussed above, we reject the proposed construction used in this contention. Even if modified as Petitioner proposes, Petitioner has not demonstrated adequately that the character of the throat area of Dua-592 changes. In other words, Petitioner has not shown adequately that a distinct tongue is created in the throat area simply by the addition of lace flaps to define that throat area.

Petitioner has not demonstrated a reasonable likelihood of prevailing in its challenge to claims 1–6, 8–17, and 19–27 as being obvious over Dua-592 and Calderone.

*H. The Alleged Obviousness of Claims 7 and 18 “for the reasons articulated under Ground 2A in further view of McDonald and/or Horii”
(Ground 2B)*

Petitioner alleges that dependent claims 7 and 18 would have been obvious “for the reasons articulated under Ground 2A in further view of McDonald and/or Horii.” Pet. 17 (ground listing); *see id.* at 118–123 (discussion of the ground).

Dependent claims 7 and 18 recite “the integral knit tongue comprises at least a partially integral portion and a free portion.” Ex. 1001, 25:36–38, 26:39–40.

Petitioner contends, via annotated versions of Figures 8 and 11 of Dua-592, that the reference discloses a tongue with a partially integral portion (the area in the red oval previously mapped to the integral knit tongue) and a free portion (an added green circle around the small triangular shape in the ankle opening). *See* Pet. 118–119. Petitioner additionally contends that “[i]t 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.” *Id.* at 120.

For the reasons discussed above, we reject the proposed constructions used in the ground and determine that Petitioner has not established adequately for institution that Dua-956 has an integral knit tongue. Accordingly, it has not been shown adequately that the asserted prior art

teaches or renders obvious “the integral knit tongue compris[ing] a partially integral portion and a free portion,” as recited in claims 7 and 18.

Petitioner has not demonstrated a reasonable likelihood of prevailing in its challenge to claim 7 and 18 as being obvious “for the reasons articulated under Ground 2A in further view of McDonald and/or Horii.”

III. CONCLUSION

Petitioner has not demonstrated that there is a reasonable likelihood of establishing the unpatentability of any of claims 1–27 of the ’636 patent.

IV. ORDER

For the foregoing reasons, it is

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

IPR2025-00151
Patent 9,510,636 B2

PETITIONER:

Samuel Lu
Keith Orso
Jonathan Lindsay
Jie Gao
IRELL & MANELLA LLP
slu@irell.com
korso@irell.com
jlindsay@irell.com
jgao@irell.com

PATENT OWNER:

Michael Harris
Aaron Bowling
Michael Sebba
ARNOLD & PORTER KAYE SCHOLER LLP
michael.harris@arnoldporter.com
aaron.bowling@arnoldporter.com
michael.sebba@arnoldporter.com