



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PUMA NORTH AMERICA, INC.,
Petitioner,

v.

NIKE, INC.,
Patent Owner.

Case IPR2019-01042
Patent 9,314,065 B2

Before MITCHELL G. WEATHERLY, AMANDA F. WIEKER, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

PUMA North America, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–6 (“challenged claims”) of U.S. Patent No. 9,314,065 B2 (Ex. 1001, “the ’065 patent”). Paper 1 (“Pet.”). NIKE, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, *see* Paper 7, Petitioner filed a Reply addressing 35 U.S.C. §§ 314(a) and 325(d), and Patent Owner filed a Sur-Reply. Paper 8 (“Reply”); Paper 9 (“Sur-Reply”).

We have authority to determine whether to institute an *inter partes* review, under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. For the reasons provided below, we do not institute an *inter partes* review.

B. *Related Proceeding*

The parties identify the following matter related to the ’065 patent (Pet. 54; Paper 4, 2):

NIKE, Inc. v. PUMA North America, Inc., No. 1:18-cv-10876
(D. Mass.).

C. *The ’065 Patent*

The ’065 patent is titled “Article of Footwear with Base Plate Having Structure and Studs” and issued on April 19, 2016, from U.S. Application No. 13/524,044 (“the ’044 application”), filed June 15, 2012. Ex. 1001, at codes (21), (22), (45), (54).

The ’065 patent discloses an article of footwear, e.g., a cleated soccer shoe, designed to “optimize propulsion during the first step of sprinting and provide stability and responsiveness while also moderating stud pressure during quick directional changes.” *Id.* at 1:6–17, 3:65–67, Fig. 1.

Figure 5 of the '065 patent is reproduced below.

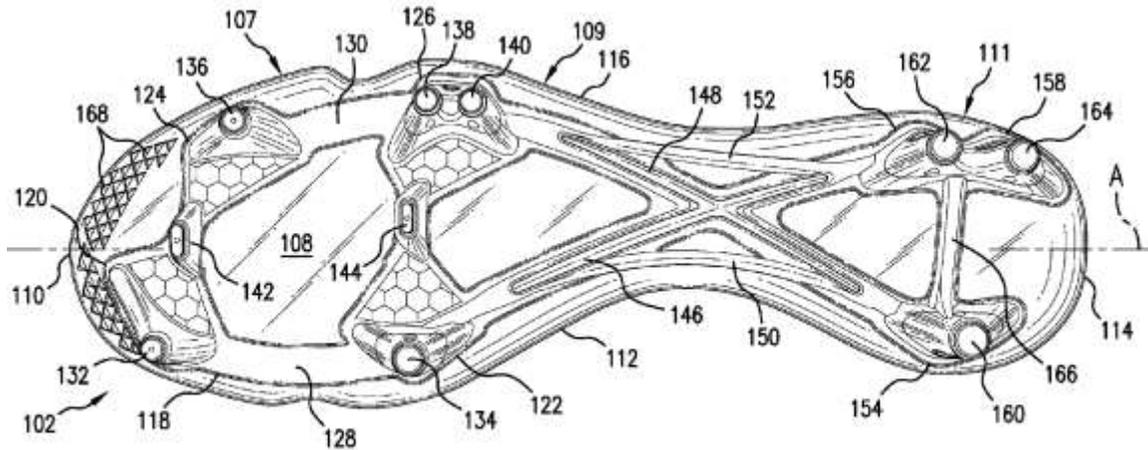


FIG. 5

Figure 5 depicts a plane view of the bottom surface of an exemplary shoe. *Id.* at 3:53–54.

The shoe includes base plate 102, which includes forefoot region 107, midfoot region 109, and heel region 111. *Id.* at 4:27–47. Base plate 102 “may be a carrier plate for a structure 118,” which acts as a frame or brace. *Id.* at 5:3–4.

As shown in Figure 5, the base plate includes various features to improve performance of the shoe, including various:

- *pads* (first medial forefoot pad 120, second medial forefoot pad 122, first lateral forefoot pad 124, second lateral forefoot pad 126, medial heel pad 154, first lateral heel pad 156, second lateral heel pad 158),
- *bars* (medial forefoot bar 128, lateral forefoot bar 130, medial midfoot bar 150, lateral midfoot bar 152),
- *ribs* (first diagonal rib 146, second diagonal rib 148, heel rib 166), and
- *studs* (first medial forefoot stud 132, first lateral forefoot stud 136, second medial forefoot stud 134, second lateral forefoot stud 138, third lateral forefoot stud 140, first center stud 142, second center stud

144, medial heel stud 160, first lateral heel stud 162, second lateral heel stud 164).

Id. at 5:50–60, 6:20–23, 7:3–8, 7:59–60, 8:9–10, 8:32, 8:54, 10:11–15, 11:3–4. For example, “[t]ogether, medial midfoot bar 150 and lateral midfoot bar 152 may provide base plate 102 with torsional stiffness resisting twisting in midfoot region 109.” *Id.* at 12:47–49.

D. Illustrative Claim

The ’065 patent includes twelve claims, six of which are challenged. Claim 1 is the sole challenged independent claim. Claim 1 is illustrative and is reproduced below, with bracketed paragraph letters added.

1. An article of footwear comprising:

[a] a base plate including a forefoot region, a heel region, a midfoot portion disposed between the forefoot region and the heel region, a longitudinal axis extending through the forefoot region and heel region, a forward edge, a rearward edge, a medial edge, and a lateral edge;

[b] a structure disposed on the base plate, the structure including a medial forefoot pad disposed on the forefoot region proximate the midfoot portion and the medial edge, a lateral forefoot pad disposed on the forefoot region proximate the midfoot portion and the lateral edge, a medial heel pad disposed on the heel region proximate the medial edge, a first lateral heel pad disposed on the heel region proximate the lateral edge, a first diagonal rib extending from the medial forefoot pad to the first lateral heel pad, a second diagonal rib extending from the lateral forefoot pad to the medial heel pad, *a medial midfoot bar substantially parallel to the longitudinal axis and disposed proximate the medial edge*, and a lateral midfoot bar substantially parallel to the longitudinal axis and disposed proximate the lateral edge;

[c] a medial forefoot stud disposed on the medial forefoot pad;

[d] a medial heel stud disposed on the medial heel pad;

[e] a first lateral forefoot stud disposed on the lateral forefoot pad; and

[f] a first lateral heel stud disposed on the first lateral heel pad;

[g] the first diagonal rib having a first lateral edge intersecting with the first lateral heel pad;

[h] the second diagonal rib having a second lateral edge intersecting with the first lateral forefoot pad;

[i] the lateral midfoot bar having a third lateral edge;

[j] wherein the medial midfoot bar extends from a first point on the first diagonal rib to a second point on the second diagonal rib; and

[k] wherein the third lateral edge of the lateral midfoot bar intersects with, and terminates at, a third point on the second diagonal rib at a forward end of the lateral midfoot bar;

[l] wherein the third lateral edge of the lateral midfoot bar intersects with, and terminates at, a fourth point on the first diagonal rib at a rearward end of the lateral midfoot bar;

[m] wherein the third point is spaced from the lateral forefoot pad; and

[n] wherein the fourth point is spaced from the first lateral heel pad.

Ex. 1001, 12:60–13:39 (emphasis added and elements labeled [a]–[n] to aid discussion).

E. Applied References

Petitioner relies upon the following references:

Anderton, U.S. Patent No. 5,461,801, filed August 18, 1993, issued October 31, 1995 (Ex. 1004, “Anderton”); and

Auger et al., U.S. Patent No. 8,056,267 B2, filed May 30, 2008, issued November 15, 2011 (Ex. 1005, “Auger”).

Pet. 18. Petitioner also relies upon the Declaration of Darren J. Stefanyshyn, Ph.D., P.Eng. Ex. 1006. Patent Owner supports its Preliminary Response with a Declaration of Kim B. Blair, Ph.D. Ex. 2001.

F. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–6 of the ’065 patent based on the following ground. Pet. 18.

Claims Challenged	Statutory Basis	Reference(s)
1–6	§ 103	Anderton and Auger

II. DISCUSSION

A. *Claim Construction*

For petitions filed on or after November 13, 2018, a claim shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b) (2018).

Petitioner filed its Petition on May 3, 2019. Paper 1. Thus, we apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). We determine that no claim term requires express construction for purposes of this Decision.

B. Principles of Law

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *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) objective evidence of non-obviousness.¹ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006)). Whether a combination of prior art

¹ At this stage of the proceeding, Patent Owner has not presented objective evidence of non-obviousness.

elements would have produced a predictable result weighs in the ultimate determination of obviousness. *Id.* at 416–417.

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003). In the context of claims that invoke 35 U.S.C. § 112 ¶ 6, “a challenger who seeks to demonstrate that a means-plus-function limitation was present in the prior art must prove that the corresponding structure—or an equivalent—was present in the prior art.” *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 582 F.3d 1288, 1299–1300 (Fed. Cir. 2009) (*citing Donaldson Company, Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)). “[I]t is firmly established . . . that a structural analysis is required . . . [and] a functional analysis alone will not suffice.” *Id.*

In an *inter partes* review, the petitioner must show with particularity why each challenged claim is unpatentable. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); 37 C.F.R. § 42.104(b). The burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

We analyze the challenges presented in the Petition in accordance with the above-stated principles.

C. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art at the relevant time would have had “at least an undergraduate degree in consumer or industrial product design, engineering, or a related field, or at least around 2–4 years of practical work experience in the design and development of

athletic footwear.” Pet. 14 (*citing* Ex. 1006 ¶ 17). Petitioner further contends that such a person “would have at least a general understanding of functional requirements of cleated footwear as well as general construction processes and materials used in the manufacturing process of cleated footwear.” *Id.*

Patent Owner does not offer an assessment of the appropriate level of skill in the art, although Patent Owner’s declarant, Dr. Blair, accepts the assessment offered by Petitioner. *See generally* Prelim. Resp.; Ex. 2001 ¶¶ 30–31.

For purposes of this Decision, we apply Petitioner’s assessment, which is consistent with Dr. Stefanyshyn’s testimony. Ex. 1006 ¶ 17.

D. 35 U.S.C. § 325(d)

The Director has discretion to deny a petition when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

In evaluating whether to exercise our discretion under § 325(d), we consider several non-exclusive factors (herein, the “*Becton Dickinson* factors”) including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;

(e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential in relevant part).

Patent Owner requests that we deny institution of *inter partes* review under § 325(d) “because the Petition relies on the same combination of prior art (Anderton and Auger) that the Examiner applied in the original prosecution.” *See, e.g.*, Prelim. Resp. 1. Although Petitioner acknowledges that the Examiner considered the same prior art offered in the Petition, Petitioner contends that it “provides new evidence and argument” that warrant consideration. *See, e.g.*, Pet. 6–11, 24–27.

Upon review of the relevant prosecution history and the parties’ arguments, we find that the *Becton Dickinson* factors, when considered as a whole, weigh in favor of exercising our discretion under 35 U.S.C. § 325(d) to deny institution of an *inter partes* review.

1. *Becton Dickinson Factor (a)*

Becton Dickinson factor (a) considers “the similarities and material differences between the asserted art and the prior art involved during examination.” *Becton Dickinson*, Paper 8 at 17.

The parties agree that the prior art asserted in the Petition is identical to that involved during examination. Pet. 6, 18; Prelim. Resp. 27.

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

2. *Becton Dickinson Factor (b)*

Becton Dickinson factor (b) considers “the cumulative nature of the asserted art and the prior art evaluated during examination.” *Becton Dickinson*, Paper 8 at 17.

Because the asserted prior art is identical to that involved during examination, we need not consider *Becton Dickinson* factor (b). See *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 13 (PTAB Sept. 12, 2018) (precedential).

Accordingly, this factor is neutral.

3. *Becton Dickinson Factor (c)*

Becton Dickinson factor (c) considers “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” *Becton Dickinson*, Paper 8 at 17.

The parties agree that the Examiner twice rejected claims 1–6 as obvious over the combined teachings of Anderton and Auger, under 35 U.S.C. § 103, which is the same ground of unpatentability asserted in the Petition. Compare Pet. 18, with, e.g., Ex. 1003, 194–196 (Non-Final Rejection, including claims 1–6), 442–444 (Final Rejection, including claims 1–6); Pet. 6–11; Prelim. Resp. 7–12, 27.

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

4. *Becton Dickinson Factor (d)*

Becton Dickinson factor (d) considers “the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art.”

Becton Dickinson, Paper 8 at 17–18. Therefore, we compare the Examiner’s application of the prior art with the Petitioner’s application of the prior art in the Petition.

In a Non-Final Rejection, the Examiner relied upon Anderton as teaching every limitation of challenged claims 1–6, except the “medial midfoot bar.” Ex. 1003, 194–196. For this limitation, the Examiner relied upon Auger’s teachings. *Id.* at 195. The Examiner determined that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a medial midfoot bar, as taught by Auger, to the base plate of Anderton in order to provide[] increased support to the medial midfoot portion.” *Id.* In response, the applicant amended the claims. *Id.* at 224–231. Following the amendment, the Examiner entered a Final Rejection, again relying upon Auger for the “medial midfoot bar” limitation. *Id.* at 442–444 (same reasoning of “increased support”).

In an After-Final amendment, the applicant further amended the claims, by adding the “spaced apart” limitations. *Id.* at 466–474; *see supra* Section I.D (claim 1, limitations [m] and [n]). In distinguishing the amended claims, the applicant argued:

Applicant’s claimed configuration of lateral midfoot bar (152) intersecting the diagonal ribs (146 and 148) spaced from (and therefore medially of) the lateral forefoot stud and the lateral heel stud, Applicant’s lateral midfoot bar provides a relatively less significant degree of reinforcement. However, Applicant provides a second midfoot bar (i.e., medial midfoot bar 150), and thus, lateral midfoot bar 152 need not be as robust as the reinforcement rib 18 of Anderton, which must supplement the reinforcement of ribs 12 and 13 all by itself. Applicant’s claimed configuration opts to use two midfoot bars, one on each side of the shoe, in order to provide a more symmetrical reinforcement of the midfoot region.

Anderton provides a configuration designed to provide reinforcement while minimizing the amount of bulk added to the sole. Accordingly, Anderton opts to use a single, robust reinforcement rib 18 to supplement the support provided by ribs 12 and 13.

Ex. 1003, 479 (paragraph break added). After this amendment, the applicant and the Examiner participated in an interview, in which “[d]ifferences between the instant application and the prior art of record were discussed, including the intersection of the midfoot bars with the diagonal ribs (outer edge of bar intersects diagonal rib, portion of diagonal rib extending past intersection), and the distinction between the pads and the studs.” *Id.* at 515–517. Following the interview, the Examiner allowed, *inter alia*, claims 1–6. *Id.* at 518–528.

As in prosecution before the Examiner, Petitioner also contends that Anderton teaches every limitation of the challenged claims, except the “medial midfoot bar,” for which Petitioner also relies upon Auger. *See, e.g.*, Pet. 22–24 (summarizing Auger’s teachings regarding a medial midfoot bar), 25–26 (summarizing Dr. Stefanyshyn’s opinion that “adding the medial midfoot bar of Auger to . . . Anderton would not materially alter the fundamental operating principle”), 27–54; *see also* Prelim. Resp. 28–29 (comparing the Examiner’s mapping to Petitioner’s mapping).

During prosecution, the Examiner determined that it would have been obvious to incorporate Auger’s medial midfoot bar into Anderton to provide “increased support” in the midfoot region. *See, e.g.*, Ex. 1003, 195. Similarly, in the Petition, Petitioner contends that this same modification would have been obvious “to provide a structural reinforcement at the medial midfoot region to improve the pronation control and stability of the

cleated shoe.” Pet. 37 (*citing* Ex. 1006 ¶ 37); *see also id.* at 32 (“to improve traction”), 34 (to provide “improved stability and responsiveness”), 36 (to provide “pronation control”). We agree with Patent Owner that Petitioner’s reasoning is substantially the same as the Examiner’s, albeit with slightly different wording. Prelim. Resp. 30; Sur-Reply 1–2.

Thus, there is a high degree of overlap between the arguments made during examination and the manner in which Petitioner relies upon the prior art. Specifically, the Examiner and Petitioner rely upon the same references, for the same claim limitations. Indeed, the Examiner and Petitioner propose the same modification of those references, i.e., incorporating Auger’s medial midfoot bar into Anderton. Moreover, the Examiner and Petitioner provide substantially the same rationale for this modification—to provide the midfoot region with either “increased support,” or with increased “structural reinforcement,” “traction,” and “stability.”

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

5. *Becton Dickinson Factor (e)*

Becton Dickinson factor (e) considers “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art.” *Becton Dickinson*, Paper 8 at 18.

The Petition identifies two purported errors in the Examiner’s evaluation of Anderton and Auger. Pet. 24–27. First, Petitioner contends, the Examiner erred by allowing the Challenged Claims because a person of ordinary skill would integrally mold the medial midfoot bar of Auger, as an additional reinforcement structure, with the lateral midfoot bar and diagonal ribs of Anderton to improve traction, and could vary the molded dimensions of the

reinforcement structures to control the cumulative weight of such structures.

Id. at 26; *see also* Reply 4 (same argument). Second, Petitioner contends that “the Examiner erred because the ‘spaced from’ limitations added to claim 1 during prosecution were design choices known to persons of skill in the art that do not confer novelty and do not make the Challenged Claims non-obvious.” Pet. 27. We address these allegations of error in turn.

First, we have considered Petitioner’s argument that a skilled artisan would have varied the dimensions of the reinforcement structures to control for the added weight of Auger’s medial midfoot bar. *Id.* at 26. However, this does not identify error on the Examiner’s part. Whether a skilled artisan would have known how to implement a modification does not address the question of whether the modification would have been obvious in the first place. In other words, that a skilled artisan could have successfully controlled for the weight associated with adding Auger’s medial midfoot bar to Anderton’s device does not speak to *why* such an artisan would have had reason to add the bar to begin with. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed inventions.”); *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (stating that “it is not enough” to show that “a skilled artisan, once presented with the two references, would have understood that they *could be* combined”); *see also* Sur-Reply 2. As discussed above, the Examiner considered whether it would have been obvious to incorporate Auger’s medial midfoot bar into Anderton, for the reason of increased

support, as also suggested by Petitioner. Nonetheless, the Examiner determined that the claims as a whole would not have been obvious over this exact combination of prior art references, regardless of this reasoning. Petitioner disagrees with that determination, but has not articulated how or why the Examiner erred.

In its Reply, Petitioner argues that it “does not merely ‘disagree’ with the Examiners’ decision to allow the challenged claims, but explains that Anderton and Auger both disclose the goals of increasing traction, imparting stability, providing maneuverability, and controlling foot motion.” Reply 3 (*citing* Prelim. Resp. 32). According to Petitioner, “[t]he fact that Anderton and Auger address the same problems is sufficient motivation to combine these references.” *Id.* at 3–4.²

We disagree. This fact bears more on the question of whether the references are analogous than whether there would have been reason to combine them. Demonstrating that references are analogous and relevant to the problem being solved is not sufficient to establish that a skilled artisan would have had reason to combine them in the manner set forth in the claim. *See Securus Techs., Inc. v. Global Tel*Link Corp.*, 701 Fed. App’x 971, 977 (Fed. Cir. 2017) (unpublished) (“[A] broad characterization of [two prior art references] as both falling within the same alleged field . . . without more, is not enough for [Petitioner] to meet its burden of presenting a sufficient rationale to support an obviousness conclusion.”); *Microsoft Corp. v. Enfish, LLC*, 662 Fed. App’x 981, 990 (Fed. Cir. 2016) (unpublished) (“[The] Board correctly concluded that [the petitioner] did not articulate a sufficient

² This rationale was not presented in the Petition. *See* 37 C.F.R. § 41.23(b).

motivation to combine. With respect to [certain challenged claims], [the petitioner] gave no reason for the motivation of a person of ordinary skill to combine [the two references] except that the references were directed to the same art or same techniques.”). As such, this does not demonstrate error in the Examiner’s evaluation of the prior art.

Second, we have considered Petitioner’s argument that a skilled artisan would have recognized that the “spaced from” limitations “were design choices known to persons of skill in the art that do not confer novelty and do not make the Challenged Claims non-obvious.” Pet. 27. Petitioner relies upon Dr. Stefanyshyn’s testimony that such spacing was a matter of “aesthetic design choice,” and that the ’065 patent does not define the quantity of space required. Ex. 1006 ¶¶ 46–47. As such, Dr. Stefanyshyn opines that a skilled artisan may provide *any* spacing when integrally molding the base plate, wherein such spacing would not affect mechanics of the sole. Ex. 1006 ¶ 47. Petitioner also states that “Dr. Stefanyshyn notes that the ’044 Application does not articulate any description of or reason for having a space, and in fact, is devoid of the term ‘space.’” Pet. 27 (*citing* Ex. 1006 ¶ 47; Ex. 1002).

We are not persuaded that the Examiner erred as alleged by Petitioner. First, we disagree with Petitioner’s suggestion that the prosecution history “does not articulate any description of or reason for having a space.” *Id.* This is not supported by the cited testimony of Dr. Stefanyshyn. Ex. 1006 ¶¶ 46–48. Moreover, as discussed above, the applicant explained the reason for the claimed spacing, when amending the claims.

Applicant’s claimed configuration of lateral midfoot bar (152) intersecting the diagonal ribs (146 and 148) *spaced from* (and therefore medially of) the lateral forefoot stud and the lateral heel

stud, Applicant's lateral midfoot bar *provides a relatively less significant degree of reinforcement*. However, Applicant provides a second midfoot bar (i.e., medial midfoot bar 150), and thus, lateral midfoot bar 152 need not be as robust as the reinforcement rib 18 of Anderton, which must supplement the reinforcement of ribs 12 and 13 all by itself. Applicant's claimed configuration opts to use two midfoot bars, one on each side of the shoe, in order *to provide a more symmetrical reinforcement of the midfoot region*.

Ex. 1003, 479 (emphasis added). Thus, the applicant explained that the claimed spacing results in “a relatively less significant degree of reinforcement” at the lateral midfoot bar, which is accounted for by the inclusion of a medial midfoot bar, and wherein the two bars together provide “more symmetrical reinforcement of the midfoot region.” *Id.*

The Examiner considered this argument regarding the impact of the spacing on the necessity for, and operation of, the lateral and medial support bars, as contrasted to the operation of Anderton's single bar arrangement, and allowed the claims. *Id.* at 515–517 (Examiner's statement that “[d]ifferences between the instant application and the prior art of record were discussed, including the intersection of the midfoot bars with the diagonal ribs,” where the intersections occur at the claimed third and fourth points, as recited in the “spaced from” limitations); *see also id.* at 476 (the applicant stating, “[a]s acknowledged by the Examiner during the interview, Anderton does not teach that the midfoot bars, particularly the lateral midfoot bar, intersects the diagonal ribs some distance from the midfoot studs/pads and some distance from the heel studs/pads”); *contra* Reply 5. Despite citing this portion of the prosecution history, neither Petitioner nor Dr. Stefanyshyn address this discussion of the claimed spacing. Pet. 45 (*citing* Ex. 1003, 217–243, 463–482, 515–517, 527–529), 46 (same);

Ex. 1006 ¶¶ 46–48. Accordingly, the prosecution history casts doubt on Petitioner’s contention that the “spaced from” limitations were obvious design choices, and that the Examiner erred in failing to so recognize.

Moreover, neither Petitioner nor Dr. Stefanyshyn sufficiently support the argument that the “spaced from” limitations were merely a matter of aesthetic design choice. Pet. 26–27, 43–47; Ex. 1006 ¶¶ 46–47.

Dr. Stefanyshyn testifies that this spacing was an obvious aesthetic design choice, and that a skilled artisan “may provide at least some minimal spacing,” and that doing so would not harm sole mechanics. Ex. 1006 ¶ 47. However, Dr. Stefanyshyn fails to identify any fact-based reasoning to support this statement, and fails to offer *any affirmative reason why* a skilled artisan would have made the specific design choice reflected in the claims. That the modification would not be detrimental to sole mechanics is not sufficient to demonstrate *why* a skilled artisan would have been motivated to make this purported “design choice.” *See Cutsforth, Inc. v. Motivepower, Inc.*, 636 Fed. App’x 575, 578 (Fed. Cir. 2016) (unpublished) (“Merely stating that a particular placement of an element is a design choice does not make it obvious. The Board *must offer a reason for why* a person of ordinary skill in the art would have made the specific design choice to locate the spring on the mounting block.”) (emphasis added); Prelim. Resp. 35–36; *contra* Reply 5.

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

6. *Becton Dickinson Factor (f)*

Becton Dickinson factor (f) considers “the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.” *Becton Dickinson*, Paper 8 at 18.

The parties agree that Dr. Stefanyshyn’s declaration is additional evidence that was not before the Examiner. Pet. 24–27; Prelim. Resp. 33. However, as discussed in our evaluation of *Becton Dickinson* factor (e), Dr. Stefanyshyn’s testimony that a skilled artisan would have known how to control for the weight associated with Auger’s medial midfoot bar is irrelevant to *why* such an artisan would have desired to add that medial midfoot bar in the first place. Likewise, and as also discussed above, at least the portion of Dr. Stefanyshyn’s testimony directed to “design choice” lacks sufficient evidentiary support and conflicts with the prosecution history of record. *See ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (“[T]he expert’s testimony on obviousness was essentially a conclusory statement that a person of ordinary skill in the art would have known, based on the ‘modular’ nature of the claimed components, how to combine any of a number of references to achieve the claimed inventions. This is not sufficient and is fraught with hindsight bias.”). As such, we are not persuaded that this additional evidence warrants reconsideration of the same prior art and arguments previously considered by the Examiner.

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

7. *Summary*

The Examiner previously considered the same prior art asserted in the Petition, twice rejecting the challenged claims in the same manner proposed by Petitioner. Moreover, Petitioner has not demonstrated persuasively that the Examiner erred in considering this prior art. Although Petitioner provides declarant testimony that was not considered by the Examiner, we determine that portions of this testimony are irrelevant to the modification proposed by Petitioner, and that other portions are unsupported by sufficient evidence.

Accordingly, for the reasons discussed above, we determine that the *Becton Dickinson* factors as a whole weigh heavily in favor of exercising our discretion to deny institution of *inter partes* review.

III. CONCLUSION

For the foregoing reasons, we deny institution of an *inter partes* review.

IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

IPR2019-01042
Patent 9,314,065 B2

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