

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NIKE, INC.,
Patent Owner.

Case IPR2016-00871
Patent D725,359

Before KEN B. BARRETT, SCOTT A. DANIELS, and
TRENTON A. WARD, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Skechers, Inc. (“Skechers”) filed a Petition to institute an *inter partes* review of the claim for a “Shoe Sole” in U.S. Patent No. D725,359 (Ex. 1001, “the ’359 patent”). Paper 1 (“Pet.”). Nike, Inc. (“or “Nike”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

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(a). Upon consideration of the Petition and the Preliminary Response, we determine that Skechers has failed to establish a reasonable likelihood of prevailing on the claim challenged in the Petition. For the reasons expressed below, we deny institution of an *inter partes* review of the claim in the ’359 patent.

B. Additional Proceedings

The parties identify that the ’359 patent is at issue in *Nike, Inc. v. Skechers U.S.A., Inc.*, Case No. 3:16-cv-00007-PK, in the U.S. District Court for the District of Oregon. Pet. 5¹; Paper 5.

C. The ’359 Patent and Illustrative Claim

The ’359 patent (Ex. 1001) issued March 31, 2015 naming Mark C. Miner as the inventor and is assigned to Nike. The title of the ’359 patent (Ex. 1001), “Shoe Sole,” is particularly fitting, as the drawings of the claim depict generally a shoe or sneaker with the shoe “upper” illustrated as unclaimed by broken lines, and the “midsole” and “outsole” of the shoe

¹ We refer to the actual page numbers of the Petition in this Decision, not Skechers’s annotated page numbers.

being claimed as these latter elements are illustrated by solid lines.² *See* 37 C.F.R. § 1.152, *see also* MPEP 1503.02, subsection III (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”). Figures 2 and 7 of the ’359 patent illustrating the claimed shoe sole are set forth below.

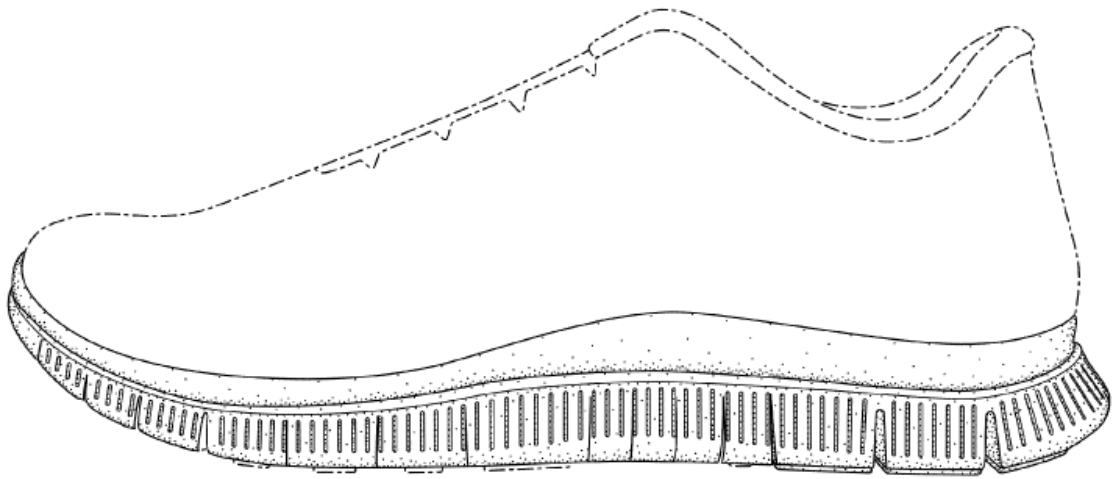


FIG. 2

Figure 2, above, is a side elevation view illustrating the claimed shoe sole in solid lines and unclaimed upper.

² Nike explains that “[a] shoe is generally divided into three parts: (a) the ‘upper’ refers to the material that more or less surrounds the top of a foot; (b) the ‘outsole’ refers to a durable tread that ordinarily contacts the ground; and (c) the ‘midsole’ refers to the portion of a shoe that typically provides cushioning and is generally located between the upper and the outsole.” PO Resp. 17.

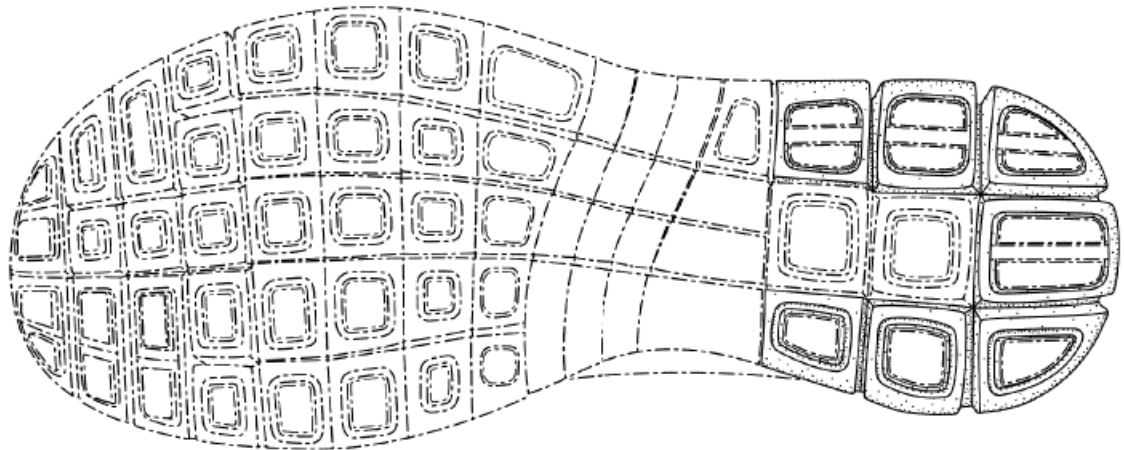


FIG. 7

Figure 7, above, is a plan view of a bottom surface of the outsole illustrating certain heel portions of the bottom surface as claimed and the rest of the outsole illustrated as unclaimed by respective broken lines. *See* Ex. 1001, 1, Description (stating that, apart from the midsole and outsole, “[t]he broken lines showing the remainder of the shoe are for environmental purposes only and form no part of the claimed design”).

D. The Alleged Ground of Unpatentability

Skechers contends that the challenged claim is unpatentable on the following specific ground.³

References	Basis
RCD 0008 ⁴	§ 103

Additionally, in order to reach this obviousness ground the Petition challenges the '359 patent's claim to priority from U.S. Design Patent

³ Petitioner supports its challenge with a Declaration of Mr. Robert Anders, B.I.D. (Ex. 1012). *See infra*.

⁴ Ex. 1011, OHIM Cert. of Reg. No. 002000489-0008 (Feb. 29, 2012) (“Nike’s European design registration”).

Application No. 29/414,576 (“the ’576 application”) filed Feb. 29, 2012. Pet. 6–13. Skechers contends that the ’359 patent is not entitled to an effective filing date of February 29, 2012 accorded to the asserted parent ’576 application because the ’576 application does not comply with the written description requirement of Section 112 ¶ 1.⁵ Specifically, Skechers argues that the disclosure in the ’576 application is insufficient to convey to a person of skill in the art that the inventor had possession of the claimed subject matter as of February 29, 2012 and, therefore, “the ’359 Patent is entitled only to its May 31, 2014 filing date.” Pet. 20. Based on this argument Skechers contends that Nike’s European design registration (Ex. 1011) including photographs of the same shoe and sole design and filed the same day as the ’576 application, February 29, 2012, more than one year before the filing of the ’359 patent, is intervening prior art. *Id.* at 21–22.⁶

Because the priority issue is dispositive with respect to institution we address at the outset the ’359 patent’s claim to priority.

E. The Effective Filing Date of the ’359 Patent

a. The Continuations

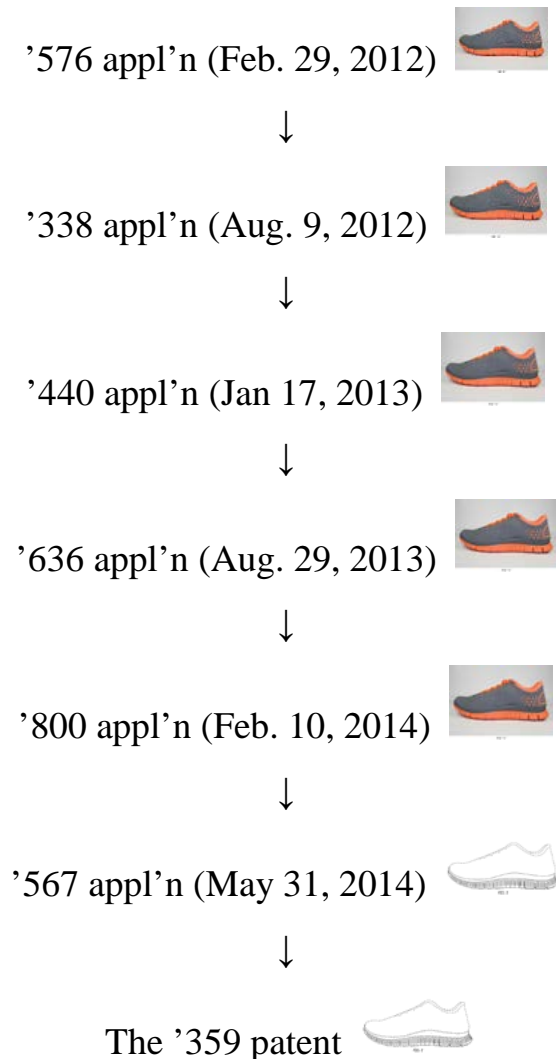
The ’359 patent issued from U.S. Application Serial No. 29/492,567 filed May 31, 2014 (“the ’567 application”), which was a continuation of U.S. Application Serial No. 29/481,800, filed Feb. 10, 2014 (“the ’800 application”).⁷ Ex. 1001, 1. The face page of the ’359 patent sets out the

⁵ The written description requirement, which is now found at 35 U.S.C. § 112(a), was codified previously at 35 U.S.C. § 112, ¶ 1 (1975).

⁶ Nike’s European design registration issued March 2, 2012 and published on March 6, 2012. Ex. 1011, 1; Pet. 13.

⁷ For purposes of clarity, the ’567 application which became the ’359 patent, should not be confused with the parent ’576 application which was the application from which the ’359 patent ultimately claims priority.

priority claim indicating that the '800 application was in turn a continuation of U.S. Application Serial No. 29/465,636, filed Aug. 29, 2013 ("the '636 application"), which was a continuation of U.S. Application Serial No. 29/443,440, filed Jan 17, 2013 ("the '440 application"), which was a continuation of U.S. Application Serial No. 29/429,338, filed Aug. 9, 2012 ("the '338 application"), which was a continuation of the '576 application accorded the asserted priority date of Feb. 29, 2012. *Id.* A diagrammatic representation of the continuation timeline and asserted priority chain is shown below.



The '576 application included 140 photographs depicting multiple embodiments of a "Shoe." *See* Ex. 1004. Starting with the '338 continuation application, Nike paid the basic filing fee, late filing fee, and fee for a three month extension for each preceding application, while at the same time filing the next continuation application. *See* Ex. 1006, 64–65. Notably, until the '567 application, each continuation application included the same 140 photographs and listed inventors as in the '576 application. *Id.* Instead of photographs, the '567 application consisted of black and white line drawings depicting a single embodiment selected from the various embodiments depicted in the photographs of the prior continuations. Below is a comparison of Figure 2 of the '567 application on the right, with Figure 17 of the '576 application on the left.



On the left, above, is a photograph depicting a side elevation view of a shoe from Figure 17 of the '576 application, and on the right is Figure 2, a line drawing in side elevation view illustrating a shoe sole claimed in the '567 application.

b. Prosecution History of the '359 Patent

Nike requested during prosecution of the '567 application, expressly, that the Examiner consider and grant a priority claim of February 22, 2012 for this application which became the '359 patent. Pet. 19–20. Nike explained to the Examiner that

[t]he claimed design in the present application substantially corresponds to an embodiment made commercial by the assignee more than one year prior to the actual filing date of the present application. The claimed design would not be valid if the effective filing date of the currently claimed design is determined not to be February 29, 2012 (i.e., the filing date of the parent application). Accordingly, applicant respectfully requests that the priority claim to the parent application be granted.

Ex. 1002, 68 (emphasis added). Foreshadowing the issue now before us, Nike explicitly described the circumstances of the continuation applications and necessity for the priority claim to the Examiner, including that the current claim depicted a specific embodiment disclosed in the parent '576 application and asserting that the earlier '576 application specifically disclosed the embodiment illustrated by line drawings in the current application. *Id.* at 68–69. Nike stated to the Examiner that

it is evident to one of ordinary skill in the art that the inventor objectively had possession of the claimed design at the time of the filing of the parent at least because the subset of elements forming the newly identified design claim is a self-contained design and/or share an operational and/or visual connection.

Id. at 69.

The Examiner, in comments provided with the Notice of Allowability clearly noted that all the prior continuing applications in the priority claim (leading up to the '567 application) had the same drawings, in this instance photographs, as the parent '576 application. *Id.* at 83. The Examiner stated that

the claimed design of the instant application is evident in the earliest application as a subset of elements forming a self-contained design. In this instance, the claimed design is seen in original Figures 15 through 21 as well as in Figures 85 through 91 in 29/481,800 (its immediate parent) and similarly throughout

the series of continuation applications back to 29/414,576. As such, the claim to continuity is considered by the examiner to be valid and proper.

Id. at 84. In the prosecution of the application leading to the '359 patent the Examiner explicitly considered, and, as understood from the above well-articulated analysis, compared the line drawings of the patent application at issue with particular photographs, i.e. Figures 15–21 and 85–91 of the '576 parent application. These comments and analyses show that the Examiner reviewed the drawings in each of the continuation applications in the chain of priority and had an evidentiary and factual basis for stating that “[r]egarding continuity back to U.S. Application No. 29/414,576, the examiner agrees that the design of the instant application has basis in the series of parent applications.” *Id.*

Skechers argues that the '359 Patent cannot benefit from the priority date of the '576 Application. *See* Pet. 20–53. As discussed in detail below, we are not persuaded by Skechers’s comparative micro-analysis of the line drawings in the '359 patent and the photographs of the '576 application, e.g. comparisons detailing minor drawing inconsistencies, slight shading variations and use of broken lines to indicate unclaimed subject matter, that “Nike has claimed an entirely new design in the '359 Patent” as Skechers argues. Pet. 53.

II. ANALYSIS

A. *The Benefit of an Earlier Filing Date in the U.S. Under 35 U.S.C. § 120*

Under 35 U.S.C. § 120, an applicant may claim the benefit of an application previously filed in the United States by the same inventor, if it is “[a]n application for patent for an invention disclosed in the manner

provided by section 112(a).” The test for determining compliance with the written description requirement under 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of filing of the claimed subject matter. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). To be entitled to the ’576 application’s effective filing date under 35 U.S.C. § 120, the ’359 patent, as a continuation, must comply with the written description requirement. *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013). “The test for sufficiency of the written description, which is the same for either a design or a utility patent, has been expressed as ‘whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’” *Id.* (quoting *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)). “In the context of design patents, the drawings provide the written description of the invention. Thus, when an issue of priority arises under § 120 in the context of design patent prosecution, one looks to the drawings of the earlier application for disclosure of the subject matter claimed in the later application.” *Owens*, 710 F.3d at 1366 (citations omitted). As the Federal Circuit explained in *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998) (citation omitted): “[i]n general, precedent establishes that although the applicant ‘does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed.’”.

B. The Overall Appearance of the Photographs in the '576 Application and the Drawings in the '359 Patent

Skechers's main argument is that the photographs submitted as the claimed invention in the '576 application do not provide written description support for the claim of the '359 patent. Pet. 3. Skechers asserts that there are at least 13 differences that “constitute new matter undisclosed in the '576 Application, precluding any claim to priority based on that parent application.” *Id.* (citing *Munchkin, Inc. et al. v. Luv N' Care Ltd.*, IPR2013–00072 slip Op. 6–8 (PTAB April 21, 2014) (Paper 28)).

Figure 17 of the '576 parent application is reproduced below.



FIG. 17

Figure 17 is a color photograph showing a side elevation view of a shoe including clear depictions of portions of the upper, midsole and outsole of the shoe. For purposes of comparison, we reproduce, below, the corresponding line drawing of Figure 2 of the '359 patent.

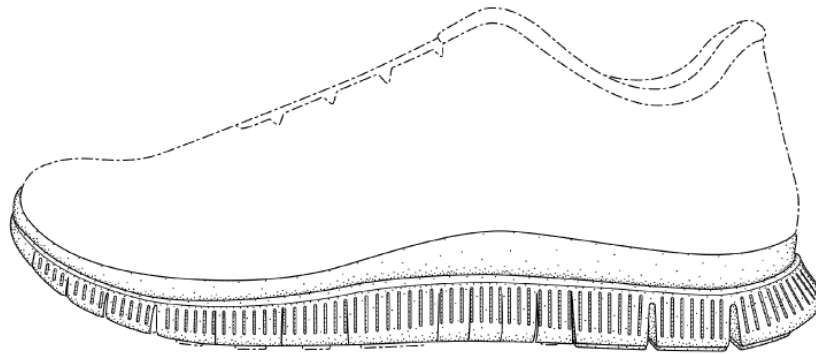


FIG. 2

Figure 2 is a side elevation view illustrating the claimed shoe sole in solid lines and the unclaimed upper in dashed lines.

By way of example, observing Figure 17 from the parent application and Figure 2 of the '359 patent, together, and considering the overall appearance and visual impressions of the photograph relative to the line drawing as a whole, we are not persuaded that the line drawing in the '359 patent is, on its face, an inaccurate portrayal of the photograph. *See Daniels* 144 F.3d at 1456, *cf. Gorham Mfg. Co. v. White*, 81 U.S. 511, 530 (1871) (Comparing designs in the context of infringement the Federal Circuit explained that “though variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same?”).

Skechers fails to establish sufficiently that the line drawing does not faithfully reproduce, using in part a stippling technique, the curvatures and relative dimensions of the top-most portion of the shoe sole, referred to by Nike as the “paint line.” *See* Prelim. Resp. 18–19. Skechers also fails to establish sufficiently that the line drawing does not reproduce accurately the curvature and relative thickness of the intermediate portion of the shoe sole, called the “paint line break point” by Nike, and referred to as the “midsole ridge” by Skechers. Pet. 19; Prelim. Resp. 18–19. The thicker midsole

portion of the shoe sole including ornamental indicia, i.e. “hash marks” as referred to by Skechers, is portrayed in the line drawing with comparative precision. Additionally, the midsole drawing replicates the same upwardly curved and tapering toe portion, the rearwardly flared heel portion, as well as the “sipes” or “grooves” i.e. the segmentation lines, which give the midsole its crenelated appearance.

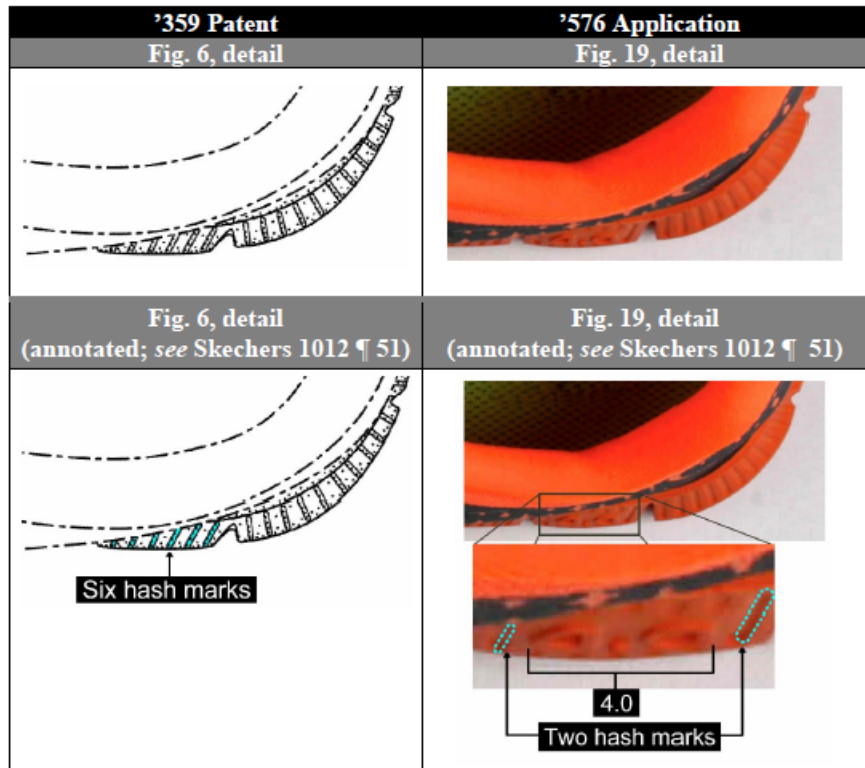
Having considered also the design as a whole with respect to the remaining photographs (Figures 15–16 and 18–21) from the parent ’576 application, in comparison with the relative line drawings (Figures 1 and 3–7) of the claimed embodiment illustrated in the ’359 patent, we are not persuaded that Skechers has established the overall appearance of the claimed “shoe sole” to be substantially different or inaccurate relative to the overall appearance of the photographs in the underlying ’576 application.

Skechers advances various arguments asserting that the photographs do not support the priority claim of the ’359 patent to the parent ’576 application. First, Skechers alleges that there are 13 differences between the photographs and the line drawings. Pet. 29–48. Second, Skechers alleges that a person of ordinary skill in the art would not clearly recognize the design claimed in the ’359 patent as that in the parent ’576 application. *Id.* at 41–53. Third, Skechers alleges that inconsistencies between the photographs of the ’576 application render the parent application non-enabling. *Id.* at 53–54. We address each of these arguments in turn below.

a. Alleged Differences Between the Photographs and the Line Drawings

To emphasize certain alleged discrepancies between the figures, Skechers provides a side-by-side comparison of a portion of the line drawing in Figure 6 of the ’359 patent to the corresponding photograph in Figure 19

of the '576 application, including an annotated blow-up photograph of the detail in question, as reproduced below.



Pet. 24. The figure above depicts Skechers's comparison of a portion of Figure 6 of the '359 patent on the left, to the corresponding portion of the photograph, and blow-up photograph, of Figure 19 in the '576 application.

As an initial matter, we find that Skechers's comparison of certain aspects of the sole design between the photographs and line drawings is an excessively critical micro-analysis that any observer, when comparing the photograph to the respective line drawing, would be hard-pressed to discern. For example, Skechers asserts that Figure 19 of the '576 application depicts a "4.0" instead of the hash marks on the sidewall of the midsole shown in Figure 6 of the '359 patent. See Pet. 24 (providing an annotated and magnified version of Fig. 19. But, observing Figure 19 of the '576 application as it is portrayed on a half-page in the application as a top plan

view of the shoe, it is to us, almost, if not entirely imperceptible, that this photograph depicts a “4.0” instead of hash marks on the sidewall of the midsole. Indeed, we note it is difficult to see the “4.0” even in this blow-up version. Moreover, contrary to Skechers’s assertion, the seven hash marks are disclosed in the ’576 application. *See* ’576 App., Figs. 17, 21. Compare Figures 17, 19, and 21 from the ’576 application, reproduced below on the left, with Figures 1, 2, and 6 from the ’359 patent, reproduced on the right..



FIG. 17

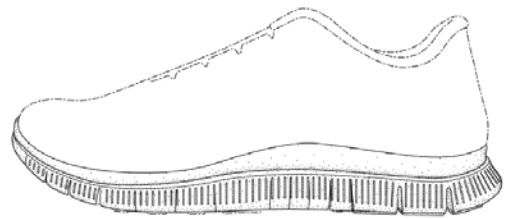


FIG. 2



FIG. 21

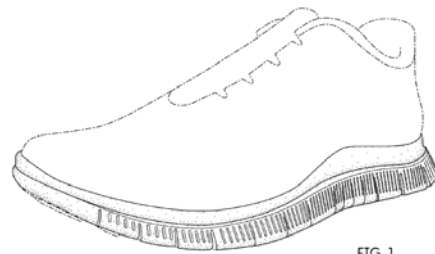


FIG. 1



FIG. 19

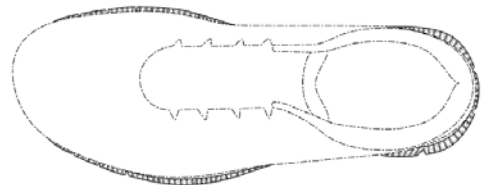
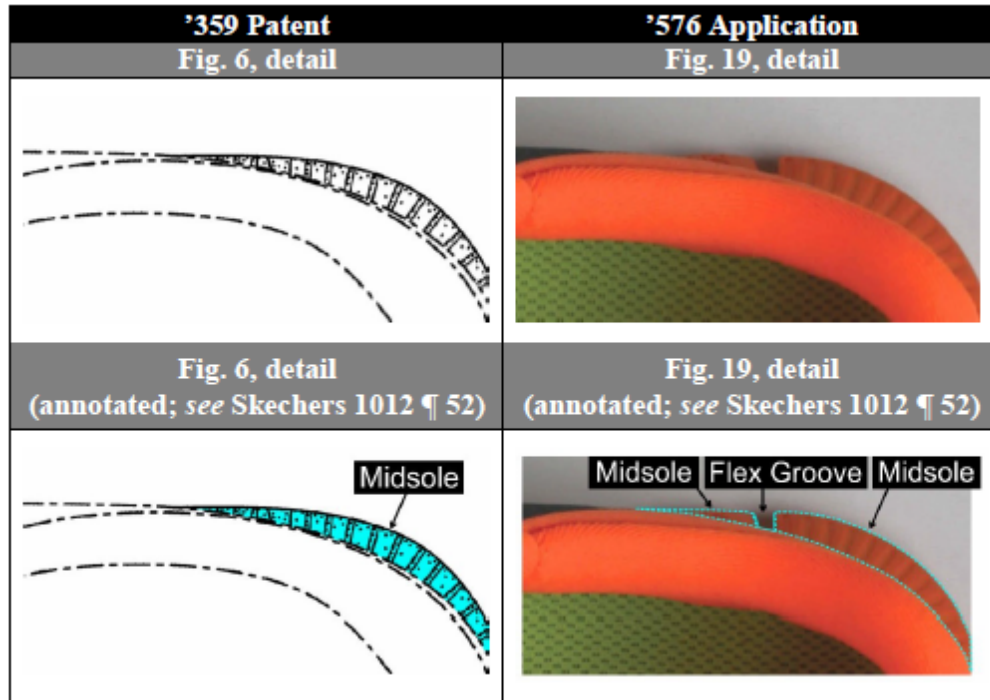


FIG. 6

Observing the photographs of the same portion of the sidewall of the midsole in Figures 17 and 21, what is more clearly seen in these figures are

seven hash marks, which is consistent with the line drawings in both Figures 1, 2 and 6 of the '359 patent.

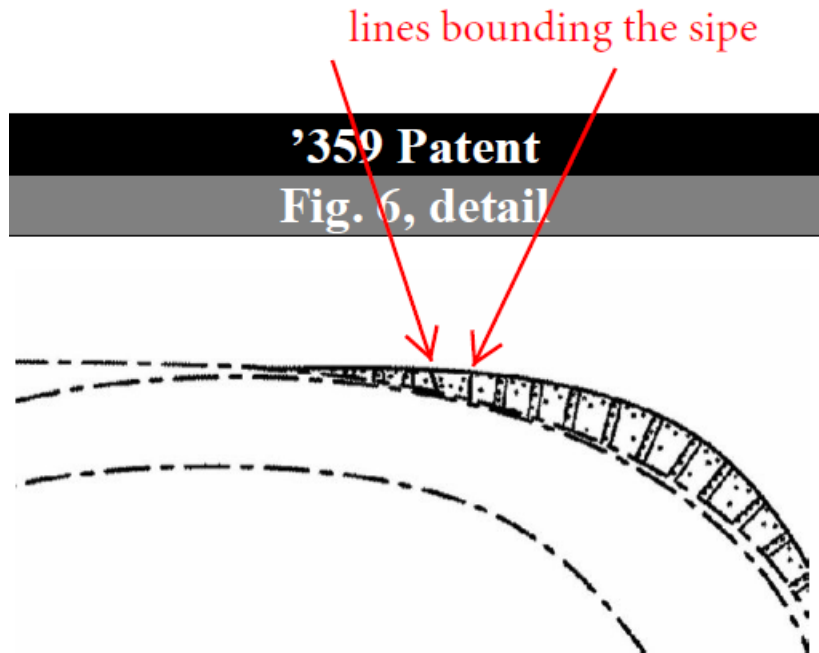
Skechers also alleges, using the annotated graphic reproduced below, that the plane-view drawing in Figure 6 claims an “undivided midsole” that is not shown in the photograph of Figure 19. *Id.* at 24–25.



The figure above depicts Skechers’s comparison of a portion of Figure 6 of the '359 patent on the left, to the corresponding portion of the photograph, and enhanced photograph, of Figure 19 in the '576 application on the right.

We agree that the line drawing in Figure 6 is somewhat indistinct in that it provides surface stippling and a connecting line along a portion of the outsole sidewall where a “sipe” or “groove” is shown in the photograph. *See* Ex. 1001 Figure 6. On the other hand, the lines illustrating the sipe in Figure

6 of the outsole can be seen and are consistent with the same portion of the outsole in a comparison of the photograph in Figure 19. *Id.*



The figure above is an annotated magnified portion of Skechers table comparing Fig. 6 of the '359 patent with Fig. 19 of the '756 application, including our annotation indicating the lines in Fig. 6 bounding the sipe.

Additionally, we note that the area constituting the alleged “undivided midsole” in Figure 6 is so small that, without a blow up view, it does not provide the observer with the intricacies of this feature. To the extent that the stippling introduces ambiguity into the claimed design drawing, observing the elevation view in Figure 3 of the '359 patent, we observe the sipe, as well as stippling on the inner surface of the sipe, accurately illustrates the sipe from the photograph as part of the claimed design. We find that any slight ambiguity caused by the plan view and surface stippling in Figure 6 can be resolved by reference to Figure 3 shown below, as showing a sipe in the portion of the sole in question.

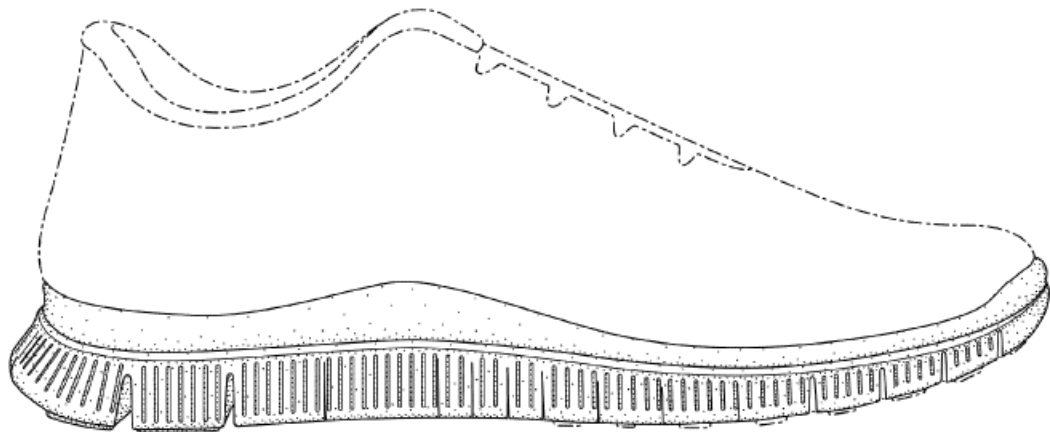
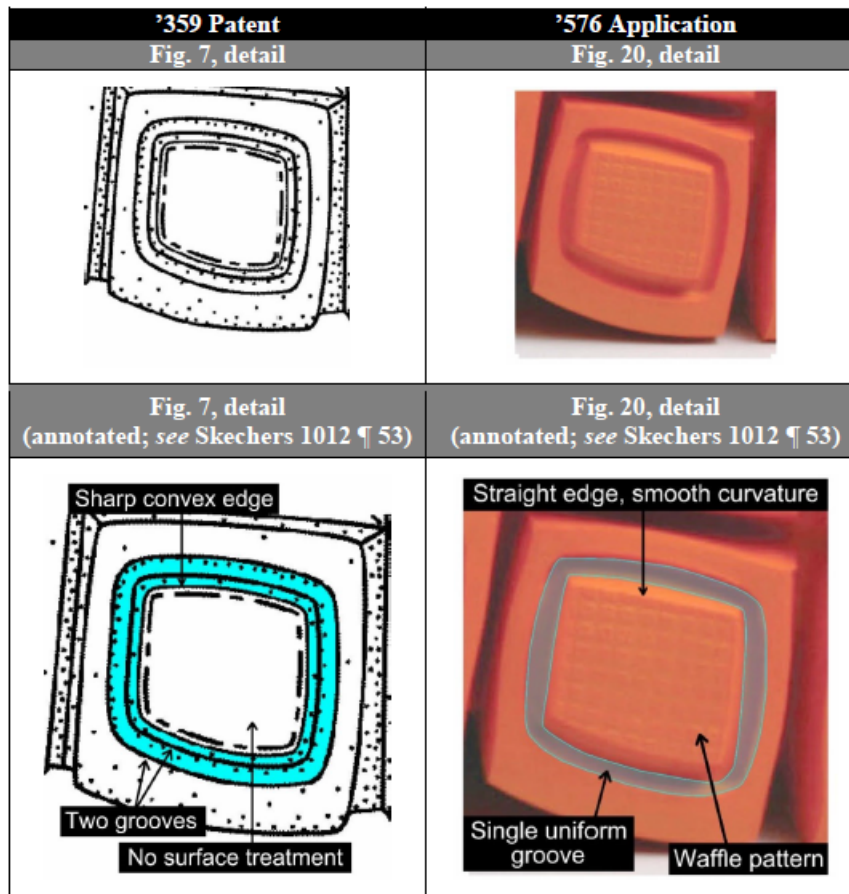


FIG. 3

Figure 3 from the '359 patent, above, is a line drawing illustrating the medial side elevation view of the shoe sole. Ex. 1001, Fig. 3.

Thus, we are not persuaded that Figure 6 introduces new matter of an “undivided midsole” into the claimed design.

The bottom of the shoe sole, i.e. the outsole, includes a series of polygonal protrusions, called “pistons” by Skechers, and “lugs” by Nike. Pet. 20, Prelim. Resp. 17. Skechers alleges that the piston shapes on the bottom-most surface of the outsole depicted in Figure 7 of the '359 patent were not disclosed in the parent '576 application. Pet. 25–27. Skechers argues that the pistons in the '359 patent do not illustrate a waffle pattern or the same shape and three-dimensional form of the pistons disclosed in the photographs of the '576 application and therefore introduce new matter into the '359 patent. *Id.* We reproduce below Skechers’s figure from the Petition comparing the pistons.



Id. at 27. The line drawings of Figure 7 on the left in Skechers’s annotated figure above illustrate the surface treatment of the pistons with broken lines depicting the disclaimed waffle pattern as originally shown in the corresponding photograph in the ’576 application, on the right.

The ’359 patent states that:

The broken lines within the shaded area form no part of the claimed design. The broken lines showing the remainder of the shoe are for environmental purposes only and form no part of the claimed design.

Ex. 1001, 1. We understand clearly from the first sentence of the quotation above that the broken lines depicting the disclaimed waffle pattern form no part of the design. 37 C.F.R. 1.152, *see also* MPEP 1503.02 III.

(“Unclaimed subject matter may be shown in broken lines for the purpose of

illustrating the environment in which the article embodying the design is used. Unclaimed subject matter must be described as forming no part of the claimed design or of a specified embodiment thereof.”). We also observe that the original photograph in the ’576 application shows a piston on the outsole of the shoe having a clearly discernable substantially flat two-dimensional piston surface upon which the indicia of a waffle pattern is shown. Ex. 1004, Fig. 20. The disclaimed waffle pattern fits squarely within the framework of proper amendments to a design patent claim by reducing surface treatment to broken lines where it is clear that Nike possessed the underlying shoe sole design in the earlier application. *See Daniels* 144 F.3d at 1457 (“The leaf ornamentation in the parent application, superimposed upon the design of the leecher itself, does not obscure that design, which is fully shown in the parent application drawings. On the correct law, it must be concluded that Mr. Daniels possessed the invention that is claimed in the continuation application, and that he is entitled to claim priority under § 120.”).

Additionally, we do not agree with Skechers’s assertion that the ’359 patent drawings illustrate around the piston “two concentric rings with differing levels of stippling, representing two grooves of differing depths.” Pet. 26. Our review of the drawings in Figure 6 reveals a single groove surrounding a piston where Skechers’s alleged second, or inner, groove is more accurately the slightly tapering sidewalls of the piston itself. Ex. 1004, Fig. 6. We are also not persuaded that the minor inconsistency between the very slightly curved line of the top edge of the piston drawn in the ’359 patent, and the straight top edge shown in the photograph, is sufficient to show that Nike did not have possession of the claimed invention. *Compare*

Ex. 1004, Fig. 20, *with* Ex. 1001, Fig. 7. It is not imperative, for this element, or any others with which Skechers takes issue, that the drawings in the continuation be *exactly* the same as the photographs of the parent.

Daniels, 144 F.3d 1456 (“The test for sufficiency of the written description is the same, whether for a design or a utility patent. This test has been expressed in various ways; for example, ‘whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” (*quoting Ralston Purina Co. v. Far–Mar–Co, Inc.*, 772 F.2d 1570, 1575 (Fed.Cir.1985))). We determine that the almost imperceptible difference between the ever-so-slightly convex line of the finally issued patent claim and the corresponding piston edge shown in the underlying parent photograph is a mechanical drawing inconsistency undoubtedly within the range of reasonableness required by the Federal Circuit.

Moreover, Skechers’s arguments discussed above rely in each case upon magnification of particular portions of the figures in both the ’359 patent and the ’576 parent application. *See* Pet. 23–27. The magnification of these differences between certain elements in the photographs and drawings highlights, at least on the evidence in this case, an over-emphasis of fairly trivial inconsistencies of the claimed design relative to the photographs. Considering the shoe sole design as a whole, we determine, on these facts, that these differences are minor inconsistencies between the parent application and the claimed design depicted in the ’359 patent. The drawings are sufficiently consistent with the photographs to support our finding that the inventor had possession of the claimed design at the time of filing of the ’576 application. *See Ex Parte Asano*, 201 USPQ (BNA) 315

(Nov. 27, 1978) (“Mechanical drawing errors and inconsistencies between the figures of the drawing, which do not preclude the overall understanding of the drawing as a whole are an insufficient basis for holding the design both indefinite and insufficiently disclosed under 35 USC 112.”).

We have reviewed each of Skechers’s thirteen arguments with respect to the alleged differences between the ’576 application and the ’359 patent, and find the remaining ten arguments equally unpersuasive as to any material difference sufficient to find that the photographs do not reasonably convey to those skilled in the art that the inventor had possession of the claimed design as shown in the drawings of the ’359 patent. *See* Pet. 28–40.

Because Skechers compares the present case to the Board’s Decision in *Munchkin, Inc. et al. v. Luv N’ Care Ltd.*, IPR2013–00072 slip op. 6–8 (PTAB April 21, 2014) (Paper 28), we believe it is useful to explain why we reach a different conclusion based on the facts in the present case. *See* Pet. 40. In *Munchkin*, the Board determined that a parent utility patent application *did not* support the priority claim to a later filed design patent. *Munchkin* at 8. The Board’s decision in *Munchkin* is distinguishable on the facts and evidence. In *Munchkin*, the Board considered the claimed design and parent drawings as a whole in a side-by-side visual comparison. *Id.* at 7. The side-by-side comparison was undertaken by the Board without any embellishment or magnification of the drawings. Based on this comparison, the Board found the originally filed utility patent drawing of the spout of a drinking vessel to be different in relative size, shape and structure from the spout in the claimed design; thereby determining the drawings, as a whole, to be sufficiently different to lack proper written description support. *Id.* at 7.

On the facts presented here, different from *Munchkin*, we determine that Skechers fails to persuasively establish sufficient visual distinctions between the claimed design and photographs to preclude the '359 patent from claiming priority to the '576 application. Indeed, to point out the asserted differences, Skechers has presented magnified views of minute details of the design along with annotated drawings that enhance and embellish the minor drawing inconsistencies relative to the photographs. *See* Pet. 24–27. We are not persuaded that a person of ordinary skill, comparing the design in the photographs with that of the drawings without such magnified and annotated figures and photographs as provided by Skechers, would readily, if at all, discern such differences as Skechers has presented in its Petition. To the extent any differences submitted by Skechers are visually apparent, we conclude that such differences are trivial and/or minor drafting inconsistencies that do not detract from understanding the design as a whole. Accordingly, we are not persuaded that the photographs of the parent '576 application do not reasonably convey to those skilled in the art that the inventor had possession of the claimed design as shown in the '359 patent. *See Ariad Pharms.*, 598 F.3d at 1351.

b. Whether a person of ordinary skill in the art would recognize the design claimed in the '359 patent as that in the parent '576 application

Skechers argues that the originally filed '576 application was improper because it contained multiple patentably distinct shoe designs and that the claimed design in the '359 patent “is completely absent from nine of the ten embodiments disclosed in the '576 Application, all of which have strikingly different midsole and outsole designs.” *See* Pet. 41–43. For this proposition Skechers refers to *In re Rubinfeld*, 270 F.2d 391, 396 (C.C.P.A.

1959), which supports the Patent Office’s practice of limiting a design patent to a single claim: “The fact that it may be permissible, in a proper case, to illustrate more than one embodiment of a design invention does not require or justify more than one claim.”. Contary to Skechers’s assertion, *Rubinfield* does not stand for the proposition that it is somehow improper that an applicant may file an application with patentably distinct embodiments, embodiments which then may become continuations or divisional applications based on a restriction requirement. *See id.* at 393; *see also* MPEP 1504.20. The Patent Office’s restriction practice permits the examiner to restrict patentably distinct designs, but does not prevent the applicant from filing an initial application to multiple patentably distinct designs. *See* MPEP 1504.05 (“Restriction will be required under 35 U.S.C. 121 if a design patent application claims multiple designs that are patentably distinct from each other.”).

i. Whether the ’359 Patent Improperly Disclaimed Elements of the Design

Skechers additionally argues that the ’359 patent “claims a new, undisclosed design by disclaiming too much of the original shoe design disclosed by that embodiment.” Pet. 43–44 (citing *Owens*, 710 F.3d at 1366). Skechers also relies on Mr. Anders’s testimony that

In my opinion, a designer of ordinary skill in the art would not recognize that Nike possessed the portions of the shoe sole design claimed in the ’359 Patent apart from the whole shoe design claimed in the ’576 Application at the time of the filing of the ’576 Application.

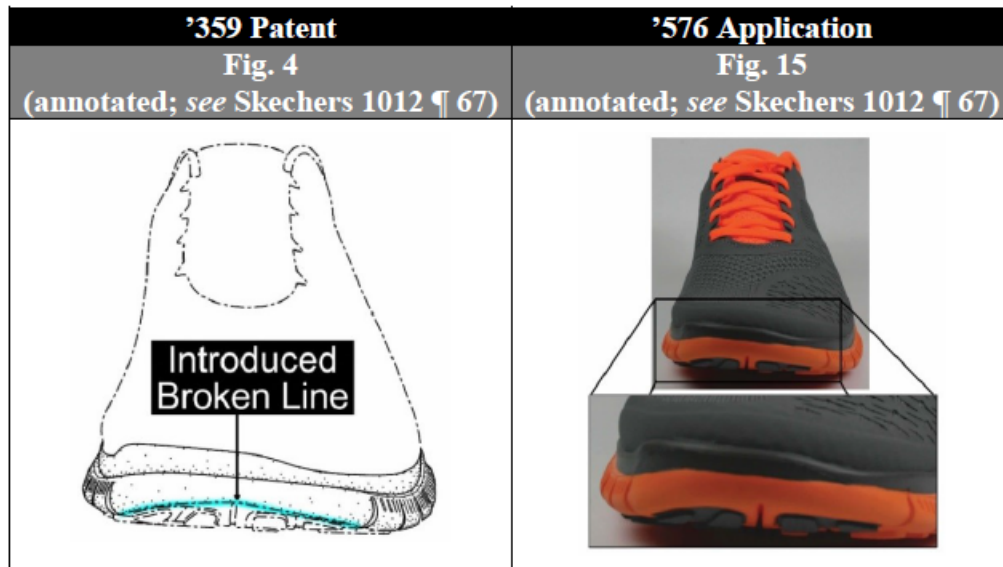
Ex. 1012 ¶ 65. Mr. Anders’s testimony is not persuasive here because it is based on the erroneous assertion that “the ’359 Patent’s claimed horseshoe of outsole pistons is not visible in any of the ten shoe designs depicted in the

'576 Application (including Figure 20).” *Id.* at ¶ 66. On the contrary, our comparison of the outsole pistons shown in solid lines in the '359 patent with the parent '576 application reveals that the outsole pistons *are* clearly visible in the photographs of the underlying parent application. *Compare* Ex. 1004, Fig. 20, *with* Ex. 1001, Fig. 7. Moreover, it is not, as Skechers contends, improper to disclaim portions of a design by changing solid lines to dashed lines. *See* Pet. 46 (asserting that “Nike’s disclaimer in the '359 Patent of substantial portions of the whole shoe design depicted in the '576 Application prevents a designer of ordinary skill in the art from being able to determine whether Nike possessed the claimed design at the time of filing the application” (citing *Owens*, 710 F.3d at 1366)).

In *Owens*, the issue was not that the applicant had disclaimed *too much*, but turned on the introduction of an arbitrary *new* unclaimed line in a continuation application that effectively created a new “trapezoidal” element of a previously claimed pentagonal shaped panel on a bottle. *Owens*, 710 F.3d at 1368. Agreeing with the Board that the new trapezoidal element had no basis in the parent application, the Federal Circuit explained that “the parent disclosure does not distinguish the now-claimed top trapezoidal portion of the panel from the rest of the pentagon in any way.” *Id.* Unlike *Owens*, in this case we are not persuaded that the photographs in the parent '576 application fail to clearly show and delineate the claimed midsole and outsole elements of the design in addition to the upper showing that the inventor had possession of the invention, i.e. the shoe sole, claimed in the '359 patent. *See* Ex. 1004, Figs. 15–21.

ii. Whether the Broken Lines Introduce New Matter

Skechers further relies upon *Owens* and contends that Nike has introduced new matter in the '359 patent, for example, where a broken line is shown across the toe portion of the shoe sole. Pet. 47–51. Skechers provides the following comparison, reproduced below.



Id. at 48. Skechers argues that, just as in *Owens*, “Figure 4 of the '359 Patent introduces a broken line that divides the claimed toe of the sole from the unclaimed sole of the shoe.” *Id.* We are not persuaded by Skechers’s analysis for at least two reasons. First, as discussed above, in *Owens* the addition of the new line created an entirely new trapezoidal element of the design not present in the parent application. Here, as recognized by Skechers, the broken line represents the division between the existing and clearly shown midsole and outsole. Second, we observe that the alleged “introduced broken line” *is shown* in the original photographs because the broken line accurately continues and connects the solid lines along the sides of the soles illustrating the delineation between the midsole and outsole.

Compare Ex. 1004, Figs. 21, 15, 20, *with* Ex. 1001, Figs. 1, 4, 7. The nature of the front elevation view and the curvature of the midsole to the outsole here may make this delineation seemingly less apparent in the photograph of Figure 15, but nonetheless, we understand from the photograph that there is a delineation around the toe portion, as there is around the entire shoe sole, between the midsole and the outsole. *See* Ex. 1004, Figs. 15–21. The remainder of Skechers’s arguments with respect to the addition of new elements into the ’359 patent are similarly unpersuasive.

C. Enablement

Skechers also argues that the photographs of the ’576 application are non-enabling because the photographs are themselves internally inconsistent. Pet. 53–55. Skechers asserts that the “4.0” in the photograph of Figure 19 and the hash marks in Figures 17 and 21 are so inconsistent that “a designer of ordinary skill in the art would be incapable of creating the shoe purportedly disclosed in the ’576 Application; indeed, creation of such a shoe would be physically impossible.” *Id.* at 54 (citing Ex. 1012 ¶ 71).

Petitioner relies, *inter alia*, on MPEP § 1504.04, which provides:

[I]f the appearance and shape or configuration of the design for which protection is sought cannot be determined or understood due to an inadequate visual disclosure, . . . such disclosure fails to enable a designer of ordinary skill in the art to make an article having the shape and appearance of the design for which protection is sought.

MPEP § 1504.04.

Skechers’s declarant, Mr. John Anders, states that the inconsistency between Figures 17, 19 and 21 “are so great that a designer of ordinary skill in the art would not be capable of creating the shoe ‘embodiment’ purportedly disclosed in those figures.” Ex. 1012 ¶ 71. We are not

persuaded by this testimony for several reasons. First, as discussed above, Mr. Anders's testimony relies upon a magnified partial view of Figure 19 including annotations which highlight the alleged discrepancy relative to the other photographs. *Id.* We find to the contrary; the relied upon inconsistency visibly challenging to discern without magnification. *See* Ex. 1004, Fig. 19. Second, the very nature of the top plan view of Figure 19, viewed as a whole, makes it progressively harder to distinguish the hash mark designs of the midsole sidewall itself proceeding from the more flared, or angled edge at the heel, towards a more vertical edge in the middle of the midsole. *Id.*



FIG. 19

In other words, the relative clarity of the hash marks observed on the flared heel portion to the right of the region in question in Figure 19, become less and less distinct to the left in the photograph due to the nature of the plan view itself. *Id.* This, however, is why a design patent consists of various views. *See* 37 C.F.R. 1.152 (“The design must be represented by a drawing that complies with the requirements of § 1.84 and must contain a sufficient number of views to constitute a complete disclosure of the

appearance of the design.”). As discussed above, observing Figure 19 as a whole we find it nearly imperceptible, without magnification, that this photograph depicts a “4.0” instead of hash marks on the midsole sidewall portion in question. *See* Ex. 1004, Fig. 19. To the extent that the photograph in Figure 19 may be insufficient to adequately discern a certain portion of the claimed design, we find it reasonable that a person of skill in the art would resolve any such insufficiency by reference to other figures which clarify the design of the midsole sidewall. *See* 37 C.F.R. § 1.152. In the photographs in Figures 17 and 21, it is readily observed that there are seven hash marks along the portion of the midsole sidewall in question. Ex. 1004, Figs. 17, 21. Based on the overall disclosure of the claimed shoe sole, and having considered the drawings as a whole including the hash marks along the midsole sidewall in at least Figures 17, 19, and 21, we are not persuaded that the overall appearance of the design is sufficiently unclear and inaccurately depicted so that a designer of ordinary skill would not be able to make a shoe sole having the shape and appearance of the claimed design.

III. CONCLUSION

For the reasons set forth above, Skechers has failed to persuade us that the claim of the ’359 patent is not entitled to the benefit of the February 29, 2012 filing date of the ’576 application. On the facts and evidence presented in the Petition, Nike’s European design registration (Ex. 1011), filed the same day as the ’576 application, February 29, 2012, disclosing the allegedly similar shoe and sole designs as in the ’359 patent more than one year before the filing of the ’359 patent, is therefore *not* prior art.

Accordingly, we determine that the information presented in the Petition fails to establish a reasonable likelihood that Skechers would prevail on the alleged ground of unpatentability with respect to the claim of the '359 patent.

IV. ORDER

For the reasons given, it is

ORDERED that the Petition is *denied* and *inter partes* review is not instituted.

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Patent D725,359

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