

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NIKE, INC.,  
Patent Owner.

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Case IPR2016-00872  
Patent D723,772

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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. D723,772 (Ex. 1001, “the ’772 patent”). Paper 1 (“Pet.”). Nike, Inc. (“Nike”) filed a Preliminary Response. Paper 7 (“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 ’772 patent.

### B. Additional Proceedings

The parties identify that the ’772 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. 5<sup>1</sup>; Paper 5.

### C. The ’772 Patent and Illustrative Claim

The ’772 patent (Ex. 1001) issued March 10, 2015 naming Mark C. Miner as the inventor and is assigned to Nike. The title of the ’772 patent (Ex. 1001), “Shoe Sole,” is particularly fitting, as the drawings of the claim depict generally a shoe or sneaker with the shoe “upper” and “outsole” illustrated as unclaimed by broken lines, and the “midsole” of the shoe being

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

claimed as these latter elements are illustrated by solid lines.<sup>2</sup> 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 4 of the ’772 patent illustrating the claimed shoe sole are set forth below.

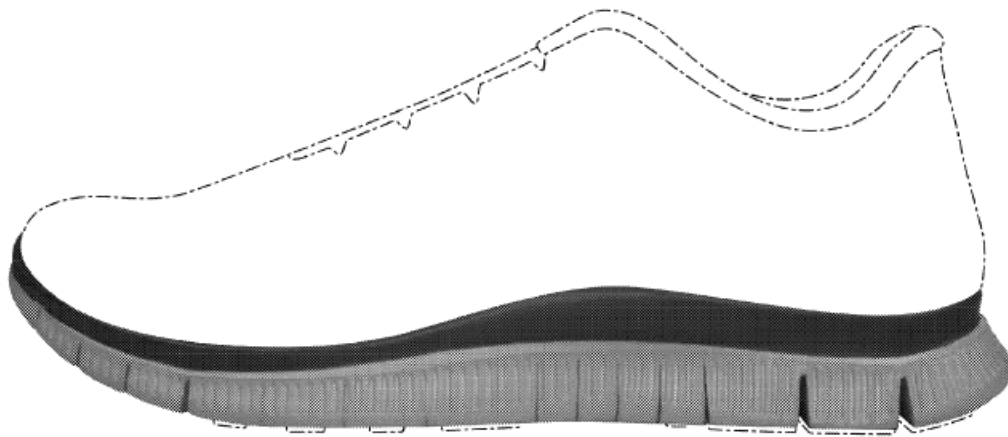


FIG. 2

Figure 2, above, is a side elevation view illustrating the claimed shoe sole as a greyscale image and unclaimed upper and outsole in dashed lines.

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<sup>2</sup> 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.” Prelim. Resp. 17.

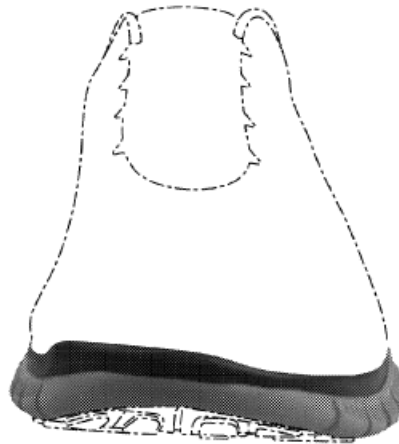


FIG. 4

Figure 4, above, is a front elevation view of the midsole as a greyscale image and also illustrating the upper and outsole as unclaimed by respective broken lines. *See* Ex. 1001, 1, Description (stating that, apart from the midsole, “[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.<sup>3</sup>

References	Basis
RCD 0008 <sup>4</sup>	§ 103

Additionally, in order to reach this obviousness ground the Petition challenges the ’772 patent’s claim to priority from U.S. Design Patent

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

<sup>4</sup> 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 ’772 patent is not entitled under 35 U.S.C. § 120 to an effective filing date of February 29, 2012 accorded the asserted parent ’576 application because the ’576 application does not comply with the written description requirement of Section 112 ¶ 1. *Id.* at 22.<sup>5</sup> 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 ’772 Patent is entitled only to its May 31, 2014 filing date.” *Id.* 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 ’772 patent, is intervening prior art. *Id.*<sup>6</sup>

Because the priority issue is dispositive with respect to institution we address at the outset the ’772 patent’s claim to priority.

*E. The Effective Filing Date of the ’772 Patent*

*a. The Continuations*

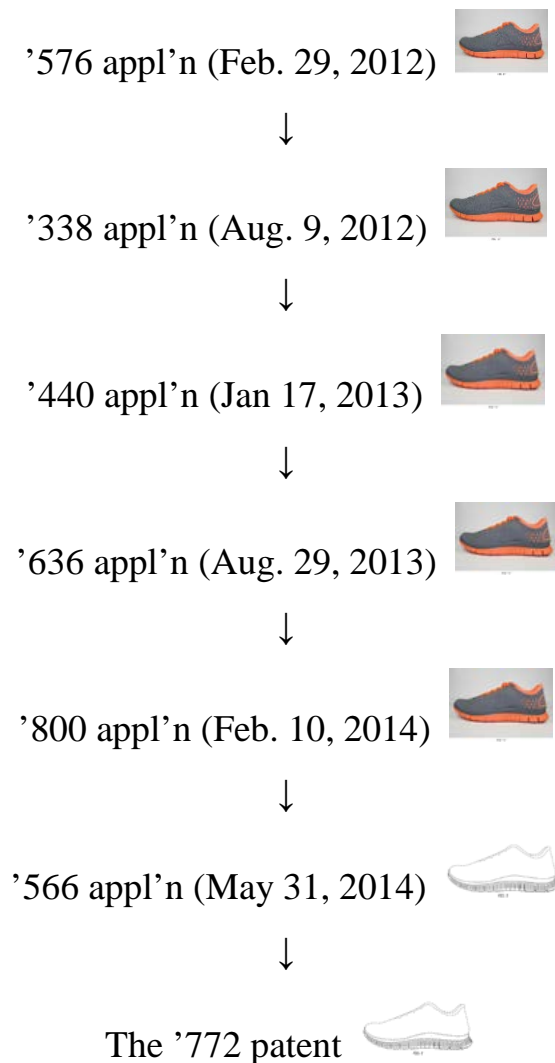
The ’772 patent issued from U.S. Application Serial No. 29/492,566 filed May 31, 2014 (“the ’566 application”), which was a continuation of U.S. Application Serial No. 29/481,800, filed Feb. 10, 2014 (“the ’800 application”). Ex. 1001, 1. The face page of the ’772 patent sets out the priority claim indicating that the ’800 application was in turn a continuation

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<sup>5</sup> 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).

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

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 e.g.*, Ex. 1006, 94–95. Notably, until the '566 application, each continuation application included the same 140 photographs and listed inventors as in the '576 application. *Id.* Instead of just photographs, the '566 application consisted in part of black and white line drawings of a single shoe embodiment selected from the various embodiments depicted in the photographs of the prior continuations. *See* Ex. 1002, 9–13. In the figures of the '566 application the line drawings are shown in combination with superimposed photographs of the midsole.<sup>7</sup> Below is a comparison of Figure 2 of the '566 application on the right, with Figure 17 of the '576 application on the left.



FIG. 17

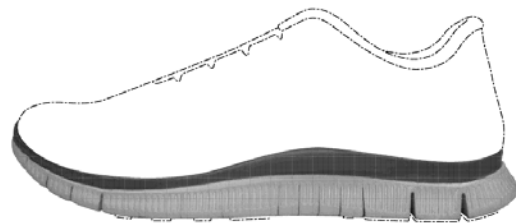


FIG. 2

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<sup>7</sup> Although Skechers refers to the line drawings as having a superimposed “photograph” of the midsole, we find it unclear whether this is truly a photograph or some other computer generated graphics file or process such as computer-aided design. The type of image in this case however, has no bearing on our ability to observe the design of the sole. So that no confusion arises with respect to the original photographs from the '576 application, we refer to the midsole shown in the '566 application and the '772 patent as a “greyscale image.”

On the left, above, is a color 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 with a greyscale image of the midsole overlaid on the line drawing in side elevation view illustrating a shoe sole in the '566 application.

*b. Prosecution History of the '772 Patent*

Nike requested during prosecution of the '566 application, expressly, that the Examiner consider and grant a priority claim of February 29, 2012 for this application which became the '772 patent. Pet. 19–20, Prelim. Resp. 9–10. 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, 67–68 (emphasis added). Foreshadowing the issue now before us, Nike explicitly described the circumstances of the continuation applications and necessity for review of 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 the line drawings in the current application. *Id.* 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 68.

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 '566 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 81. In the prosecution of the application leading to the '772 patent the Examiner explicitly considered, and, as understood from the above well-articulated analysis, compared the 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 '772 Patent cannot benefit from the priority date of the '576 Application. Pet. 22. As discussed below, we are not persuaded by Skechers’s comparative micro-analysis of the drawings in the '772 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 ’772 Patent” as Skechers argues. Pet. 41.

## 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 ’772 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 ’772 patent. Pet. 3. Skechers asserts that there are at least three 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)).

All three of the alleged differences pertain to Figure 6 of the ’772 patent and the corresponding photograph of Figure 19 in the ’576 parent application. Both figures are reproduced below.



FIG. 19

Figure 19 is a color photograph showing a top plan view of a shoe including depictions of portions of the upper and midsole of the shoe. For purposes of comparison we reproduce below the corresponding line drawing of Figure 6 of the '772 patent.

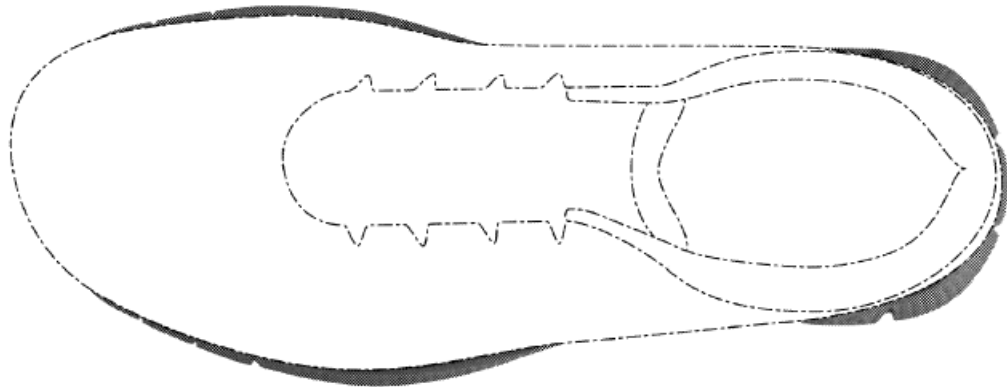


FIG. 6

Figure 6 is a top plan view illustrating the claimed shoe midsole in solid lines as a grey scale image and the unclaimed upper in dashed lines.

By way of example, observing Figure 19 from the parent application and Figure 6 of the '772 patent, together, and considering the overall appearance and visual impressions of the photograph relative to the line drawing and grey scale image as a whole, we are not persuaded that the drawing and grey scale image in the '772 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 Figure 6 does not faithfully reproduce the sidewall with substantially the same relative dimensions and curvatures of the visible portions of the midsole portion of the shoe sole. Pet. 24–26. Skechers also fails to establish sufficiently that the line drawing and grey scale image also does not reproduce accurately the ornamental indicia, i.e. “hash marks” as referred to by Skechers, with relative comparative precision. Pet. 26–27. Additionally, the midsole grey scale image replicates the rearwardly flared heel portion, as well as the “sipes” or “flex grooves” i.e. the segmentation lines which give the midsole its crenelated appearance. *See id.*

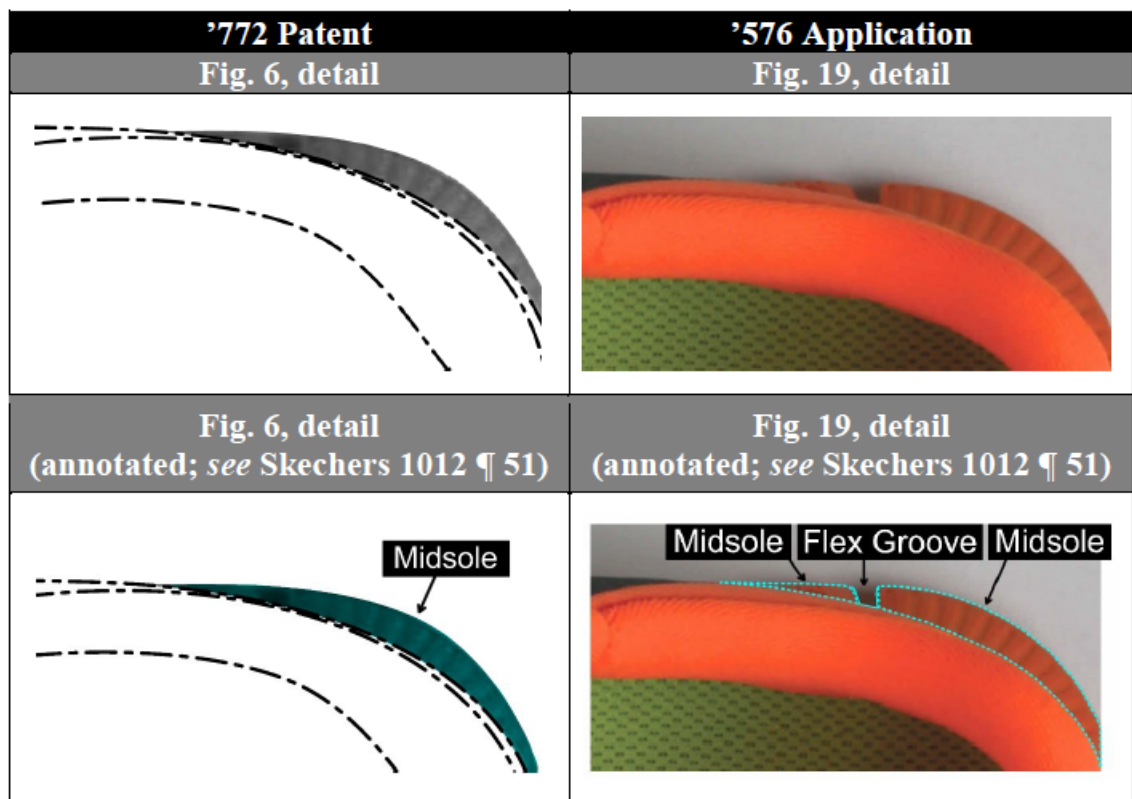
Having considered also the design as a whole with respect to the remaining photographs (Figures 15–19 and 21) from the parent ’576 application, in comparison with the relative line drawings and grey scale images (Figures 1–6) of the claimed embodiment illustrated in the ’772 patent, we are not persuaded 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 makes several arguments to support its contention that the ’772 patent is not entitled to the priority date of the ’576 application under Section 112 ¶ 1. *Id.* at 22. First, the ’576 application does not disclose at least three elements of the claimed design. *Id.* Second, the claimed design introduces new matter by the inclusion of a broken line and disclaiming the outsole of the shoe sole. *Id.* Third, inconsistencies in the original photographs of the ’576 application fail to satisfy the enablement

requirements of § 112 ¶ 1. *Id.* We address each of these arguments in turn below.

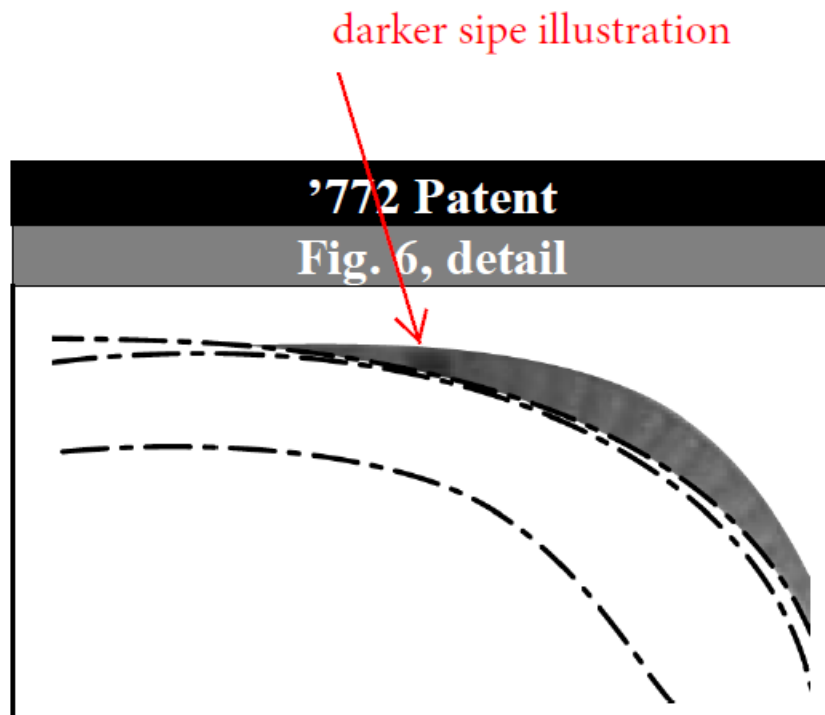
*a. Alleged Differences Between the Photographs and the Line and Greyscale Drawings*

To emphasize discrepancies between the figures, Skechers provides a comparison of a portion of the line and greyscale drawing in Figure 6 of the '772 patent to the corresponding photograph in Figure 19 of the '576 application, including an annotated photograph, of the detail in question, as reproduced below.



Pet. 25. The figure above depicts Skechers's comparison of a portion of Figure 6 of the '772 patent on the left, to the corresponding portion of the photograph, of Figure 19 in the '576 application. Both Figures have been enhanced and annotated to ostensibly better indicate the asserted discrepancies.

We find that Skechers's comparison of minor differences or discrepancies between the photograph and drawing is an excessive micro-analysis that any observer, when comparing the overall design of the shoe and shoe sole from the photograph to the respective claimed shoe sole depicted in the drawing image, would be hard-pressed to discern. For example, Skechers alleges that the plan view in Figure 6 claims an "undivided" medial-side midsole that is not shown in the original photograph of Figure 19. *Id.* at 25. We observe that the greyscale image in Figure 6 is somewhat indistinct where a darker or shadowed section is observed along a medial portion of the midsole sidewall, as compared to where a more distinct "sipe" or "groove" is shown in the photograph. On the other hand, the darker illustration of the sipe in Figure 6 can be seen, and when viewed in the context of the original unannotated greyscale image, is consistent with the same portion of the midsole sidewall in the photograph of Figure 19. *Id.*



The figure above is an annotated magnified portion of Skechers table comparing Fig. 6 of the '772 patent with Fig. 19 of the '756 application, including our annotation indicating the darker illustration in Fig. 6 defining 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. Furthermore, to the extent that the darker or shadowed section in the greyscale image introduces ambiguity into the claimed design, observing the elevation view in Figure 3 of the '772 patent, shown below, we determine that the greyscale image illustrates accurately the sipe, as shown in the original photograph, as part of the claimed design. Ex. 1001, Fig. 3.

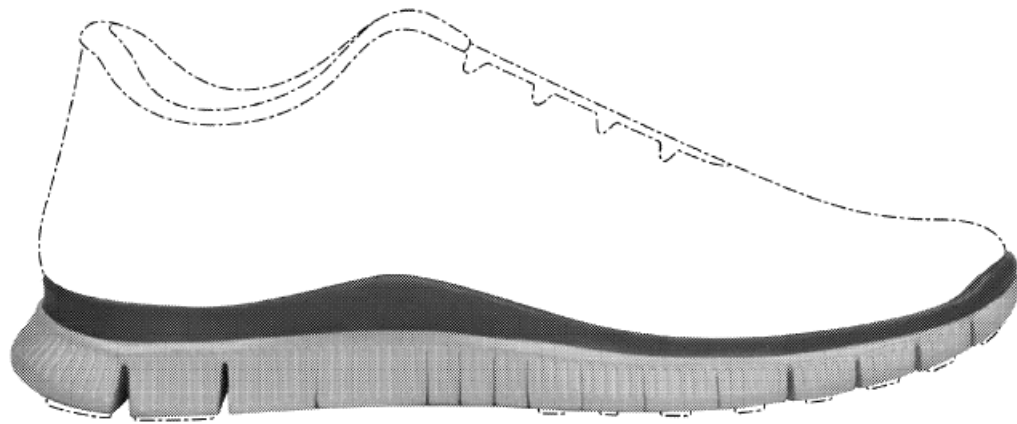


FIG. 3

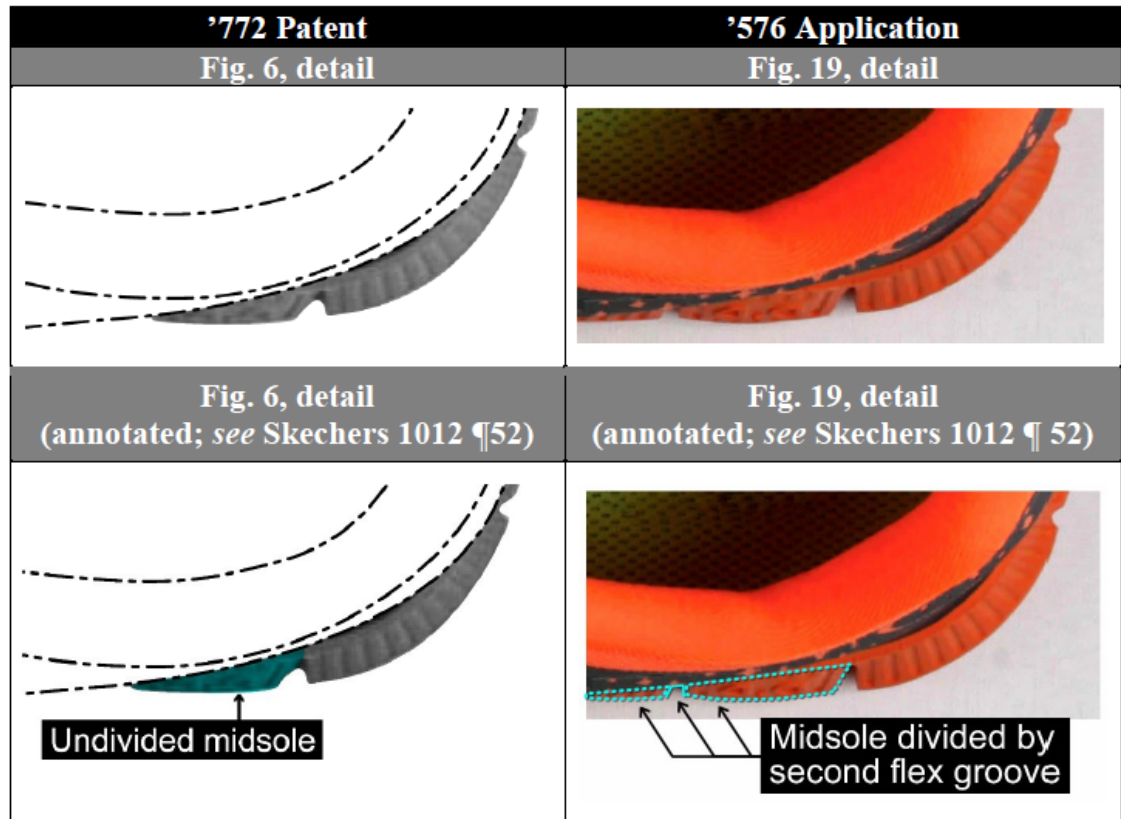
Figure 3 from the '772 patent, above, is a line drawing and grey scale image illustrating the medial side elevation view of the shoe sole. Ex. 1001, Fig. 3.

We find it reasonable that a person of ordinary skill in the art would be able to resolve any slight ambiguity caused by the plan view and shadowed section in Figure 6 by reference to Figure 3 as showing a sipe in



the medial sidewall of the midsole. *Compare* Ex. 1001, Figs. 3, 6. Thus, we are not persuaded that Figure 6 introduces an undivided medial-side midsole into the claimed design.

Skechers similarly alleges that the greyscale image of Figure 6 in the '772 patent discloses an “undivided” lateral sidewall of the midsole that is not apparent in the parent '576 application. *Id.* at 25–26. Skechers’s figure from their Petition portraying this discrepancy, is reproduced below.



*Id.* at 26. The figure above depicts Skechers’s comparison of a portion of Figure 6 of the '772 patent on the left, to the corresponding portion of the photograph, of Figure 19 in the '576 application.

The minor difference here is due in great respect to the nature of the plan view itself. *See* Ex. 1001 Fig. 6, Ex. 1004, Fig. 19. It appears to us that

the absence of an exact reproduction of the “second flex groove” in the line and greyscale drawing is caused by either an ever-so-slightly different plan view or a mechanical drawing inconsistency. This difference is so miniscule that in viewing the overall appearance of the design in the photograph and that of the claimed design, we are not persuaded that one of skill in the art would understand that the design depicted in the line and greyscale figures claims an “an undivided midsole on the lateral side,” as asserted by Skechers. Pet. 25. Moreover, observing the elevation view in Figure 2 of the ’772 patent, reproduced below, we determine that the greyscale image accurately illustrates the sipe, or “second groove,” as shown in the original photograph, as part of the claimed design.

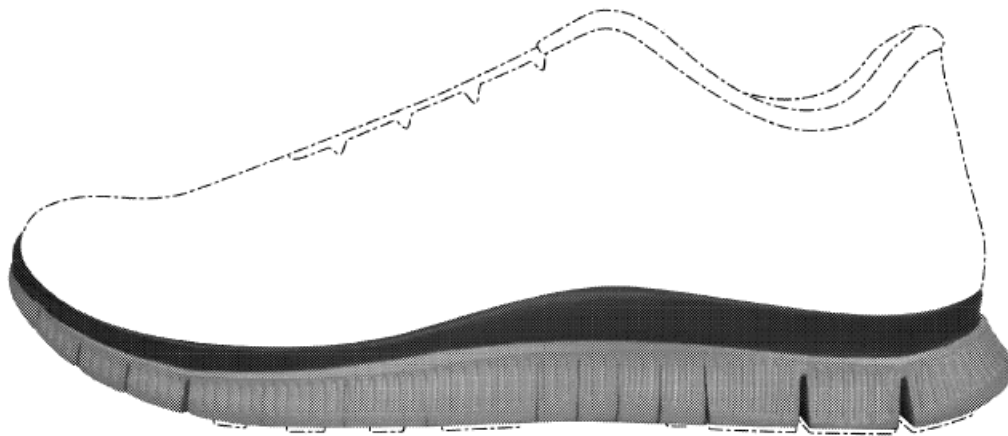


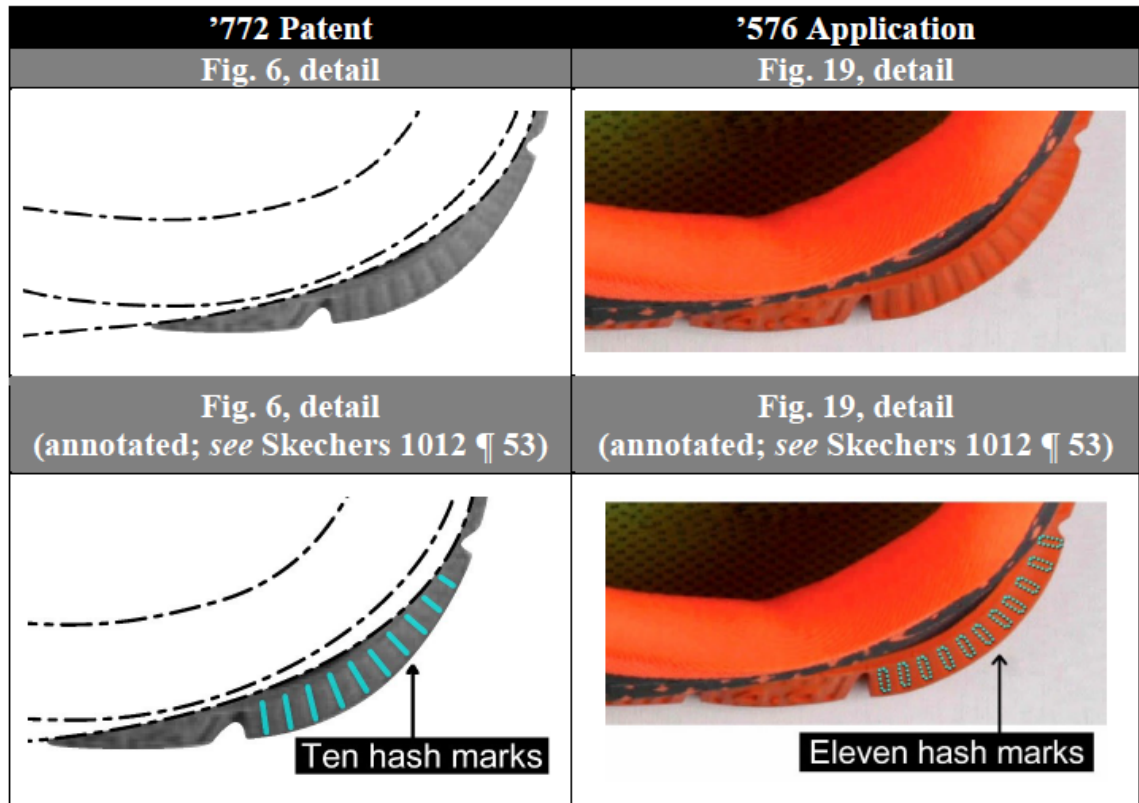
FIG. 2

Figure 2 from the ’772 patent, above, is a line drawing and grey scale image illustrating the lateral side elevation view of the shoe sole. Ex. 1001, Fig. 3.

We find it reasonable that a person of ordinary skill in the art would be able to resolve any ambiguity caused by the plan view and shadowed section in Figure 6 at least by reference to Figure 2 as showing a sipe in the lateral sidewall of the midsole. *Compare* Ex. 1001, Figs. 2, 6. Thus, we are

not persuaded that Figure 6 introduces an undivided lateral side midsole into the claimed design.

As shown below in the figure reproduced from the Petition, Skechers also alleges that the design claims ten hashmarks, as opposed to eleven hashmarks disclosed in the underlying '576 application.



*Id.* at 27. The figure above depicts Skechers's comparison of a portion of Figure 6 of the '772 patent on the left, to the corresponding portion of the photograph, of Figure 19 in the '576 application. Both figures have been enlarged and annotated to ostensibly better indicate the asserted discrepancies.

Although it is not the epitome of clarity, we find that a person of skill in the art, observing the greyscale image in Figure 6 of the '772 patent, as it has been enlarged by Skechers, would discern eleven hashmarks, not ten as

Skechers illustrates with the annotations above. Ex. 1001, Fig. 6. Observing the photograph of the same portion of the sidewall of the midsole in Figure 19 we find it equally challenging, but not impossible, to observe eleven hashmarks on the midsole. Ex. 1004, Fig. 19. Thus, we find the claimed design on the '772 patent and the underlying photograph from the '576 application to be consistent and we are not persuaded that the greyscale image in Figure 6 introduces fewer hashmarks into the claimed design.

It is not imperative, for the elements 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, 227 U.S.P.Q. 177, 179 (Fed.Cir.1985))). We determine that the almost imperceptible differences asserted by Skechers with respect to the finally issued patent claim and the corresponding elements shown in the underlying parent photograph are essentially mechanical drawing inconsistencies or due in part to the nature of the plan view itself. Compare Ex. 1004, Fig. 19, with Ex. 1001, Fig. 6. Viewing the design as a whole as depicted in all the figures together we find the design depicted in the original photographs to fall within a range of reasonableness required for providing sufficient written description. *Id.*

Moreover, Skechers’s arguments discussed above rely in each case upon magnification of particular portions of the figures in both the '772

patent and the '576 parent application. *See* Pet. 24–27. The magnification and enhancement of the differences between certain elements in the photographs and drawings highlights, at least on the evidence in this case, and is 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 '772 patent. The drawings are sufficiently consistent with the photographs, based on the evidence before us, 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.”). Accordingly, we determine that the photographs of the parent '576 application reasonably convey to those skilled in the art that the inventor had possession of the claimed design as shown in the '772 patent. *See Ariad Pharms.*, 598 F.3d at 1351.

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. 27–28. 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 substantially different in relative size, shape and structure from the spout in the claimed design; thereby, determining as a whole the drawings 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 '772 patent from claiming priority to the '576 application. Indeed, to point out the asserted differences Skechers has presented magnified views and illustrative annotations of minute details of the design along with annotated drawings that enhance and embellish the minor drawing inconsistencies relative to the photographs. *See* Pet. 24–28. We are not persuaded based on the facts before us that a person of ordinary skill, comparing the photographs with the claimed design as a whole and viewing the design with or without benefit of magnified and annotated figures and photographs as provided by Skechers, would readily, if at all, discern or find such differences materially determinative with respect to the written description requirement of section 112 ¶ 1 as Skechers argues. 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 '772 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 '772 patent as that in the parent '576 application*

Skechers further argues that one of skill in the art viewing the parent '576 application would not have recognized that the design features claimed in the '772 patent could have been separately claimed from the embodiments originally disclosed in the parent application. Pet. 20. Skechers supports this position by asserting that the originally filed '576 application contained multiple patentably distinct shoe designs, only one of which included the claimed midsole design. *See id.* at 20 (Skechers asserts that “[t]his [midsole] design is completely absent from nine of the ten embodiments disclosed in the '576 Application, all of which have strikingly different midsole designs.”

Skechers argument is essentially that the specific midsole embodiment claimed in the '772 patent is not “an inventive concept disclosed in the '576 Application.” *Id.* at 31. 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.”. This argument is not persuasive because *Rubinfeld* does not, as Skechers asserts, stand for the proposition that it is somehow improper that an applicant may later file an application with patentably distinct embodiments, such as continuations or divisional applications for example, 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 '772 Patent Improperly Disclaimed Elements of the Design*

Skechers argues further that the '772 patent “claims a new, undisclosed design by disclaiming too much of the original shoe design disclosed by that embodiment.” Pet. 31 (citing *In re Owens*, 710 F.3d at 1366). Skechers contends that

no one reasonably skilled in the art would have recognized from the shoe design disclosed in the '576 Application that Nike might disclaim the entire upper of the shoe, nearly all of the outsole, and portions of the midsole, leaving only a separate claim of the midsole periphery.

Pet. 32 (citing Ex. 1012 ¶¶ 55–56). Skechers also relies on its Declarant 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 '772 Patent apart from the whole shoe design claimed in the '576 Application at the time of the filing of the '576 Application.

Ex. 1012 ¶ 55. Mr. Anders’s testimony is not persuasive here for at least two reasons. First, Mr. Anders does not explain *why* the disclaimer of the upper and outsole portions of the shoe is “significant.” *Id.* Second, his opinion is based on the erroneous assertion that the various allegedly patentably distinct embodiments in the '576 application cannot be later claimed in separate continuations. *See id.* at ¶ 56 (“nine of the ten



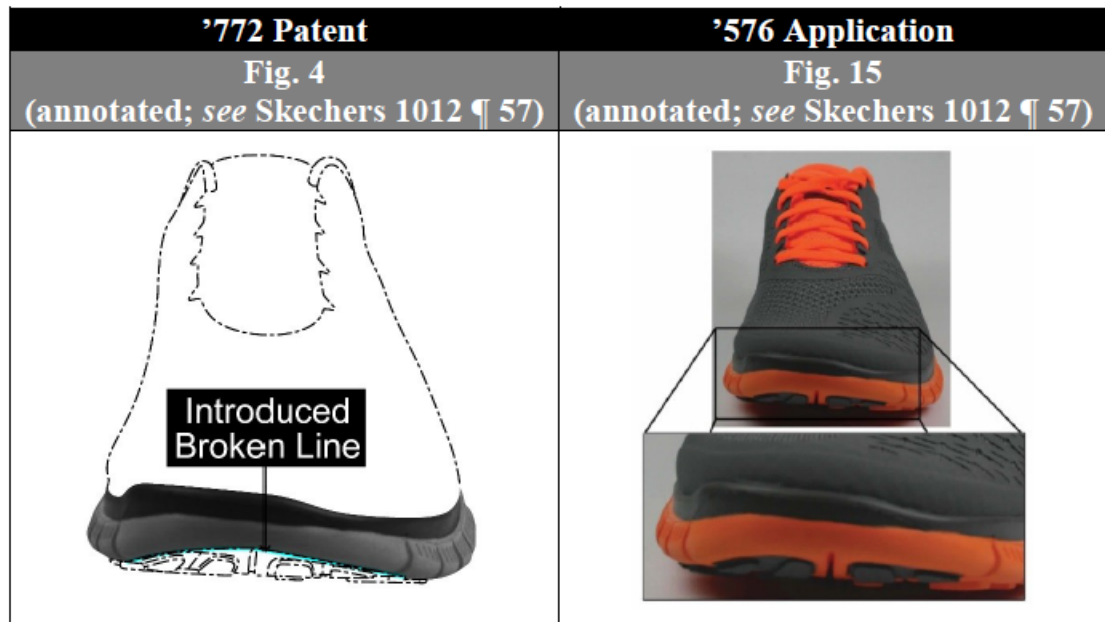
embodiments in the '576 Application disclose configurations of flex grooves and midsole sections that are wholly dissimilar from the design claimed in the '772 Patent.”).

Moreover, it is not as Skechers and its Declarant contend, improper to disclaim portions of a design. *See* Pet. 33–34 (asserting that “Nike’s disclaimer in the '772 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 elements of the design in addition to the upper and outsole elements, showing that the inventor had possession of the invention, i.e. the midsole, claimed in the '772 patent. *See* Ex. 1004, Figs. 15–21.

*ii. Whether the Broken Lines Introduce New Matter*

Skechers further relies upon *Owens* arguing that Nike has introduced new matter in the '772 patent, for example, where a broken line is shown

across the toe portion of the shoe sole. Pet. 34–41. Skechers provides the following comparison, reproduced below.



*Id.* at 36. Skechers contends that, just as in *Owens*, “Figure 4 of the ’772 Patent introduces a broken line on the underside of the outsole that divides the claimed toe of the sole from the unclaimed sole of the shoe.” *Id.* at 35. 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. *See Owens* at 1368. Here, as recognized by Skechers, the broken line represents the division between the existing and clearly shown midsole “toe” portion and the outsole. Second, we observe that the alleged “introduced broken line” *is shown* in the original photographs because the broken line dividing the “toe” from the outsole accurately continues and connects the solid lines along the sides of the sole illustrating the delineation between the midsole and outsole. *Compare* Ex. 1004, Figs. 21, 17, 18, and 15, *with* Ex. 1001, Figs. 1, 2, 3, and 4. The nature of the front elevation view and the

curvature of the midsole to the outsole here in the “toe” portion of the midsole may make this delineation seemingly less apparent in the photograph of Figure 15, but nonetheless, we understand from the photographs that there is a visible delineation around the toe portion, as there is around the entire shoe sole, between the midsole and the outsole. The remainder of Skechers’s arguments with respect to the addition of new elements into the ’772 patent are similarly unpersuasive.

*iii. Whether Omission of the Bottom View of the Outsole in the Claimed Design is New Matter*

Skechers argues next that “[n]arrowing of the ’772 Patent to six figures from seven figures amounts to the addition of new matter because the ’576 Application fails to provide a written description for a design absent a bottom view and its associated surface ornamentation. Pet. 38 (citing *Ex parte Chu*, Case No. 2001-0959, 2003 WL 22282257, at \*7 (BPAI 2003)). On the facts before us in this case, we do not agree that disclaimer of the shoe outsole and elimination of a figure showing the entire disclaimed subject matter, amounts to new matter. On the facts in *Chu*, the Board found that there was no written description support for a new embodiment of a chair with *only* a seat and backrest, introduced in a reissue application, “including the removal of the bottom showing of the design patent itself.” *Chu* at \*6. *Chu* did not, however, erect a per se rule that the omission of a figure constitutes new matter. Different from the facts in *Chu*, the ’772 patent includes a drawing, Figure 4, illustrating a portion of the outsole of the shoe sole in broken lines signifying that the outsole is disclaimed.<sup>8</sup> The

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<sup>8</sup> The ’772 Patent states that broken lines “form no part of the claimed design.” Ex. 1001, 1.

outsole is therefore not omitted or eliminated from the design, it is merely disclaimed. We are not persuaded that an artisan would not recognize what is within the scope of the claim, even in the absence of a figure corresponding to the photograph in Figure 20. From Figures 1–6 of the '772 patent we observe that the disclaimed outsole of the claimed design is simply not shown in its entirety. We are aware of no case law or rule that requires all disclaimed subject matter must be shown in its entirety, nor has Skechers pointed us to any. Skechers argument, therefore, does not persuade us that the lack of a complete view of the disclaimed outsole, on these facts, is new matter.

*C. Enablement*

Skechers also argues that the photographs of the '576 application are non-enabling because the photographs are themselves internally inconsistent. Pet. 41–43. Skechers asserts that the “4.0” in the photograph of Figure 19 and the hash marks in Figures 17 and 21 in the midsole heel portion of the shoe sole 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 43 (citing Ex. 1012 ¶ 61).

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 15 through 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 ¶ 61. We are not persuaded by this testimony for several reasons. Mr. Anders's testimony relies upon various magnified views of Figures 17, 19 and 21 including annotations which highlight the alleged discrepancies relative to the other photographs. *See id.*, Pet. 42. We find the relied upon inconsistencies visibly challenging to discern, with or without magnification. Also, 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 on 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. In other words, moving left to right, the relative clarity of the hash marks observed on the flared heel portion in question in Figure 19, become less and less distinct to the left in the photograph due to the nature of the plan view of the shoe. 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."). 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.



FIG. 19

Figure 19 from the '576 application, above, is a photograph of the top plan view of the shoe and shoe sole. 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 more readily observed that there are seven hash marks along the portion of the midsole sidewall in question. 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 '772 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 '772 patent more than one year before the filing of the '772 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 '772 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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