

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 IPR2016-00874
Patent D723,781 S

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

WARD, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Skechers, U.S.A., Inc. (“Skechers”) filed a Petition to institute an *inter partes* review of the claim for a “Shoe Sole” in U.S. Patent No. D725,781 (“the ’781 patent”). Paper 1 (“Pet.”). Nike, Inc. (“Nike”) filed a Preliminary Response. Paper 10 (“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 ’781 patent.

B. Additional Proceedings

The parties identify that the ’781 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; Paper 8, 2. Nike also identifies a number of related patents involved in other requests for *inter partes* review. Paper 8, 2.

C. The ’781 Patent and Illustrative Claim

The ’781 patent (Ex. 1001) issued March 10, 2015 naming Mark C. Miner as the inventor and is assigned to Nike. The title of the ’781 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

being claimed as these latter elements are illustrated by solid lines.¹ *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 1 and 2 of the ’781 patent illustrating the claimed shoe sole are set forth below.

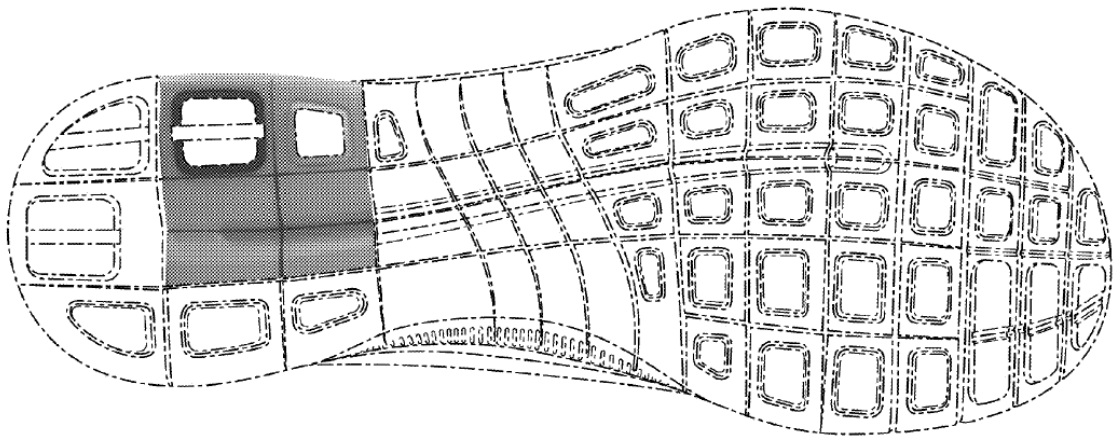


FIG. 1

Figure 1, 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 (“The broken lines showing the remainder of the

¹ 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.

shoe are for environmental purposes only and form no part of the claimed design.”).

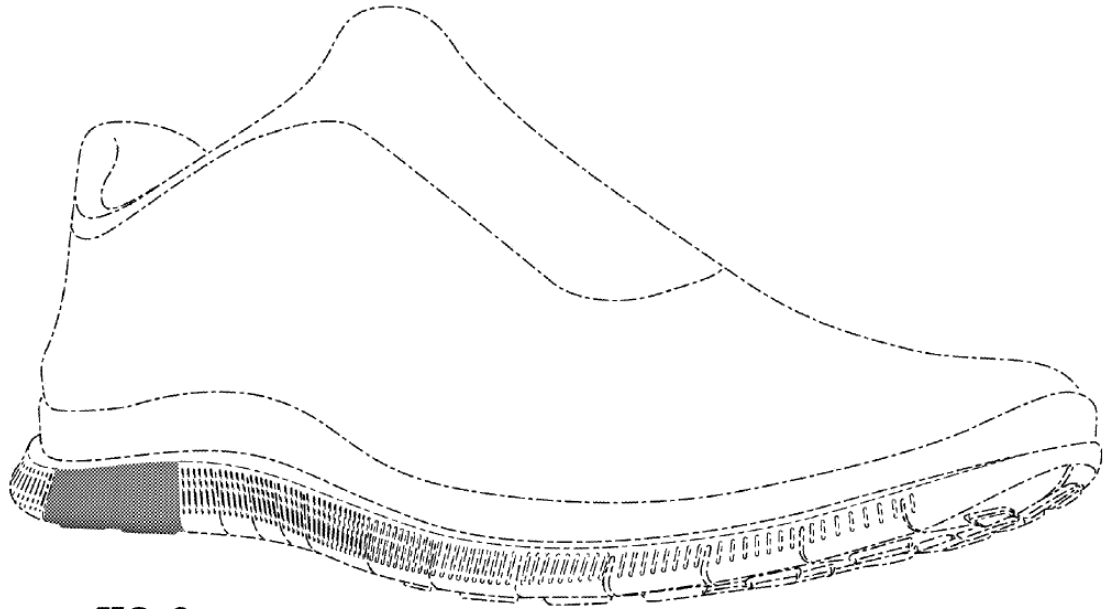


FIG. 2

Figure 2, above, is a front perspective view illustrating the claimed shoe sole in solid lines and unclaimed remainder of the shoe.

D. The Alleged Ground of Unpatentability

Skechers contends that the challenged claim is unpatentable on the following specific ground.²

References	Basis
RCD 0015 ³	§ 103

² Skechers supports its challenge with a Declaration of Mr. Robert Anders, B.I.D. (Ex. 1012). *See infra*.

³ Ex. 1011, OHIM Cert. of Reg. No. 002000489-0015 (Feb. 29, 2012) (“Nike’s European design registration”).

Additionally, in order to reach this obviousness ground the Petition challenges the '781 patent's claim to priority from U.S. Design Patent Application No. 29/414,576 ("the '576 application") filed Feb. 29, 2012. Pet. 24–44. Skechers contends that the '781 patent is not entitled 35 U.S.C. § 120 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 ¶ 1.⁴ Pet. 24–25. 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 '781 Patent is entitled only to its May 31, 2014 filing date." Pet. 24. 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 '781 patent, is intervening prior art. *Id.* at 45–46.⁵

Because the priority issue is dispositive with respect to institution we address at the outset the '781 patent's claim to priority under 35 U.S.C. § 120.

E. The Effective Filing Date of the '781 Patent

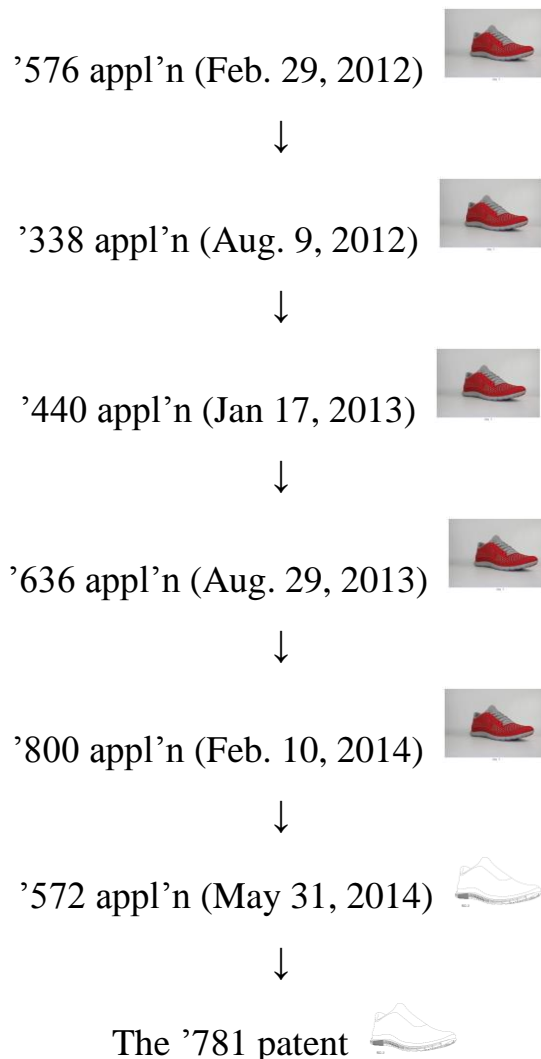
1. The Continuations

The '781 patent issued from U.S. Application Serial No. 29/492,572 filed May 31, 2014 ("the '572 application"), which was a continuation of

⁴ 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).

⁵ Nike's European design registration issued March 2, 2012 and published on March 6, 2012. Ex. 1011, 11; Pet. 45.

U.S. Application Serial No. 29/481,800, filed Feb. 10, 2014 (“the ’800 application”). Ex. 1001, 1. The face page of the ’781 patent sets out the 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.* Below is a diagrammatic representation of the continuation timeline and priority chain.



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, 92–99. Notably, until the '572 application, each continuation application included the same 140 photographs and listed inventor as in the '576 application. *See* Exs. 1005, 1006, 1007, 1008, 1009. Instead of photographs, the '572 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 '781 patent on the right, with Figure 7 of the '576 application on the left.



FIG. 7

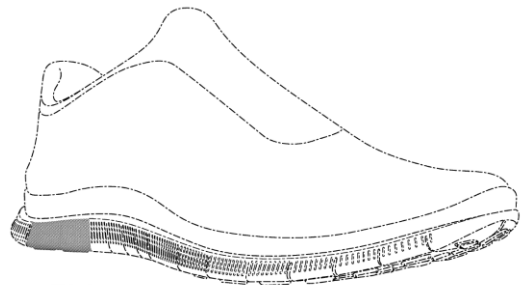


FIG. 2

Ex. 1004, Fig. 7; Ex. 1001, Fig. 2. On the left, above, is a perspective photograph depicting a front perspective view of a shoe from Figure 7 of the '576 application, and on the right is Figure 2, a line drawing in front perspective view illustrating a shoe sole claimed in the '572 application. *See id.*

2. Prosecution History of the '781 Patent

Nike requested during prosecution of the '572 application, expressly, that the Examiner consider and grant a priority claim of February 29, 2012

for this application which became the '781 patent. Pet. 15 (citing Ex. 1002, 53–54). 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, 65. 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 65–66. 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 65–66.

The Examiner, in comments provided with the Notice of Allowability, noted that all the prior continuing applications in the priority claim (leading up to the '572 application) had the same drawings, in this instance photographs, as the parent '576 application. *Id.* at 79. 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 1 through 7 as well as in Figures 71 through 77 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. In the prosecution of the application leading to the '781 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 1–7 and 71–77 of the '800 parent application. *Id.* 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 (it is noted that 29/481,800; 29/465,636; 29/443,440; and 29/429,338; each repeat the drawing disclosure of the original parent application 29/414,576).” *Id.*

Skechers argues that the '781 Patent cannot benefit from the priority date of the '576 Application. *See* Pet. 24–44. As discussed in detail below, we are not persuaded by Skechers’ comparative micro-analysis of the line drawings in the '781 patent and the photographs of the '576 application, e.g. comparisons detailing minor drawing inconsistencies and use of broken lines to indicate unclaimed subject matter, that “Nike has claimed an entirely new design in the '781 Patent” as Skechers argues. Pet. 44.

II. ANALYSIS

A. Ability to Benefit Under 35 U.S.C. § 120 From an Earlier Filing Date In the U.S.

Under 35 U.S.C. § 120, an applicant may claim the benefit of an application previously filed in the United States for a subsequent application which names an inventor or joint inventor in the previously filed application, 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 ’781 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. Comparison of the Photographs in the '576 Application and the Drawings in the '781 Patent

Skechers’ primary argument against the priority claim of the ’781 patent is that the photographs submitted as the claimed invention in the ’576 application do not provide written description support for the claim of the ’781 patent. Pet. 3. Skechers asserts that there are at least three notable features 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 7 of the ’576 parent application is reproduced below.



FIG. 7

Ex. 1004, Fig. 7. Figure 7 of the ’576 application above is a color photograph showing a front perspective 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 line drawing of Figure 2 of the '781 patent.

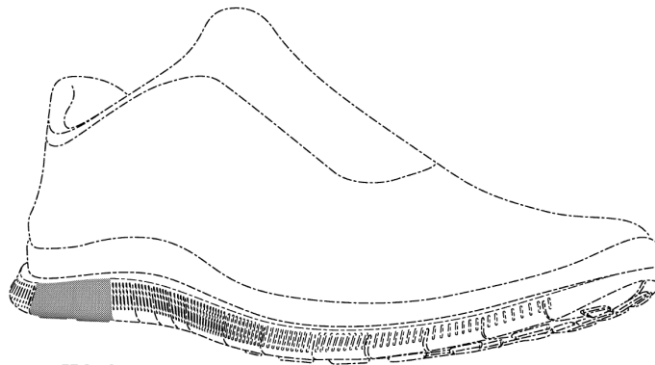


FIG. 2

Ex. 1001, Fig. 2. Figure 2 shown above is a front perspective view illustrating the claimed shoe sole in solid lines and the unclaimed portions of the shoe in dashed lines. *Id.*

Observing Figure 7 from the parent application and Figure 2 of the '781 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 by Skechers on this record that the line drawing in the '781 patent is not an accurate 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 Supreme Court explained that “though variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same?”)

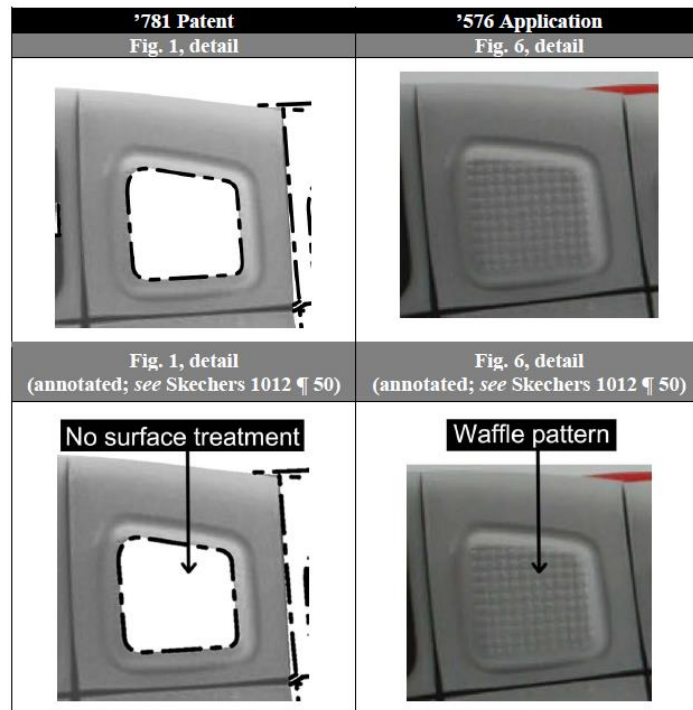
Skechers fails to establish sufficiently that the line drawings do not faithfully reproduce, the curvatures and relative dimensions of the shoe sole. Skechers advances various arguments asserting that the photographs do not support the priority claim of the '781 patent to the parent '576 application.

First, Skechers alleges that the '576 application fails to disclose at least three features of the design claimed in the '781 patent. Pet. 25–32. Second, Skechers alleges that a person of ordinary skill in the art would not clearly recognize the design claimed in the '781 patent from the '576 application. *Id.* at 32–44. We address each of these arguments in turn below.

1. *Alleged Differences Between the Photographs and the Line Drawings*

a. *Piston Surface*

One of the features Skechers alleges Nike failed to disclose in the '576 application is a surface treatment on the foremost piston claimed in the '781 patent. Pet. 26–28. Skechers refers to the protrusions in the outsole as “pistons.” Pet. 22–24. Nike refers to the pistons as lugs and states that they are the portion of the shoe that contacts the ground when the shoe is in use. Prelim. Resp. 17. Skechers’ annotated versions of Figure 1 of the '781 patent and Figure 6 of the '576 application are reproduced below.



Pet. 27 (providing annotated excerpts of Ex. 1001, Fig. 1; Ex. 1004, Fig. 6). The figure above depicts Skechers' comparison of a magnified portion of Figure 1 of the '781 patent on the left, to the corresponding magnified portion of Figure 6 in the '576 application on the right. *See id.* Skechers alleges that the piston surface treatments on the bottom-most surface of the outsole depicted in Figure 1 of the '781 patent were not disclosed in the parent '576 application. Pet. 26–27. Skechers argues that the pistons in the '781 patent have a “plain surface treatment” and do not illustrate the waffle pattern surface treatment of the pistons disclosed in the photographs of the '576 application. *Id.* On that basis, Skechers argues Nike has departed from the original disclosure and introduced prohibited new matter. Pet. 28.

The Description portion of the '781 patent states that:

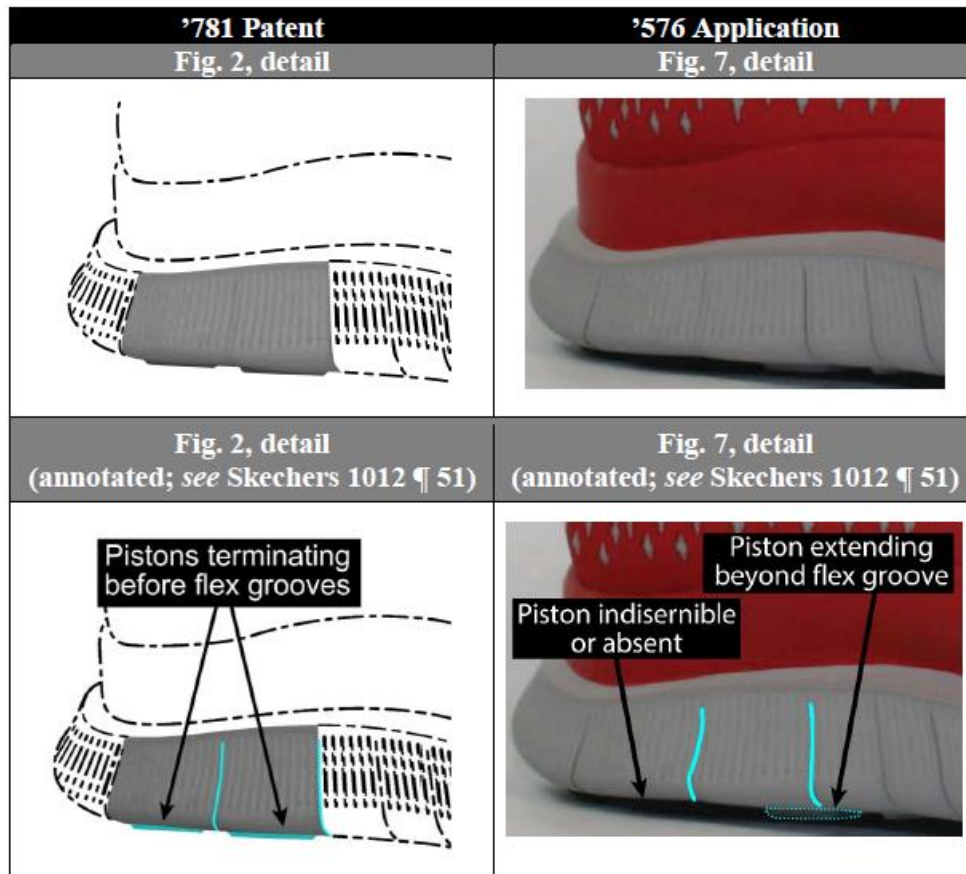
The broken lines showing the remainder of the shoe are for environmental purposes only and form no part of the claimed design.

Ex. 1001, 1. We understand that the broken lines depicting the disclaimed waffle pattern form no part of the design. *See* 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.”). 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 In re Daniels* 144 F.3d 1452, 1457 (Fed. Cir. 1998). (“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.”). Therefore, we are not persuaded by Skechers’ argument that the “’781 patent claims the foremost claimed piston as having a plain surface treatment” (Pet. 27), but rather that this area of the piston was appropriately disclaimed by Nike. *See* Ex. 1001, Fig. 1. Accordingly, we are not persuaded by Skechers that Nike failed to disclose, in the ’576 application, a surface treatment on the foremost (or toemost) piston claimed in the ’781 patent.

b. Front Perspective View of Pistons

Skechers also argues that the ’781 patent claims new matter related to pistons protruding from the lateralmost portion of the shoe. Pet. 28. Specifically, Skechers argues that “the ’781 patent claims a piston that protrudes from the lateralmost, second rearmost outsole section that appears to terminate before the right-adjacent flex groove when viewed from the front perspective,” but that no such piston is visible in Figure 7 of the ’576 application. Pet. 28–29. Skechers’ annotated versions of Figure 2 of the ’781 patent and Figure 7 of the ’576 application are reproduced below.



Pet. 29 (providing annotated excerpts of Ex. 1001, Fig. 2; Ex. 1004, Fig. 7). Skechers also argues that the '781 patent claims a piston that protrudes from the lateralmost, third rearmost outsole section that “*appears to terminate before the right-adjacent flex groove when viewed from the front perspective*” but the '576 application “discloses a piston that—to the extent perceptible in the shadows under the shoe—extends beyond the edge of the third rearmost medial-to-lateral flex groove.” Pet. 29 (emphasis added). As Skechers concedes, its arguments are based upon features a person of ordinary skill in the art may not be able to perceive from the figures. *See id.* Furthermore Skechers’ arguments are based upon magnifications of particular portions of the cited figures. *See id.* Unmodified versions of

Figure 7 of the '576 application and Figure 2 of the '781 patent are reproduced below.



FIG. 7

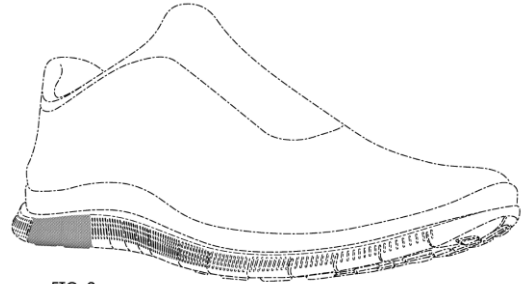


FIG. 2



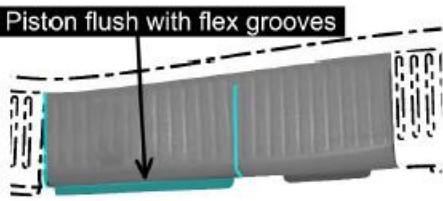
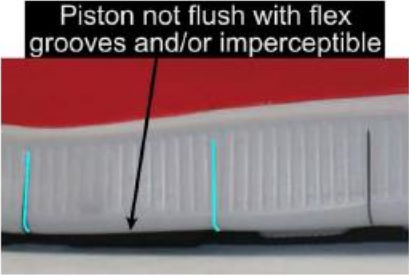
Ex. 1004, Fig. 7; Ex. 1001, Fig. 2. As shown above, we determine that one of ordinary skill in the art viewing Figure 2 of the '781 patent would not be able to perceive precisely where a piston that protrudes from the lateralmost, third rearmost outsole section terminates or where a piston that protrudes from the lateralmost, second rearmost outsole section terminates. *See* Ex. 1001, Fig. 2. Furthermore, the precise termination of these pistons is also not perceptible from Figure 7 of the '576 application. *See* Ex. 1004, Fig. 7.

Even assuming it was possible for one of ordinary skill in the art to perceive these differences, Skechers' magnification of these differences between certain elements in the photographs and drawings, at least on the evidence in this case, is an over-emphasis of fairly trivial inconsistencies, to the extent they exist, of the claimed design relative to the photographs. Considering the shoe sole design as a whole, we determine, on these facts, that these differences, to the extent they exist, are minor inconsistencies between the parent application and the claimed design depicted in the '781 patent. The drawings are sufficiently consistent with the photographs such that we determine Skechers fails to sufficiently establish that that the

inventor did not have 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.”).

c. Lateral View of Piston and Piston Length

Skechers also argues that by claiming the lateralmost, second rearmost piston from the lateral view in Figure 3 of the '781 patent, Nike has departed from the original disclosure and introduced prohibited new matter. Pet. 31. Specifically, Skechers argues that the '781 patent claims a piston that, from the lateral view, protrudes from the lateralmost, second rearmost outsole section to *align flush* with the first and second rearmost medial-to-lateral flex grooves. Pet. 30 (emphasis added). Skechers also argues that “[t]he '576 [a]pplication—to the extent perceptible in the cast shadows—discloses a shorter corresponding piston that does not align flush with these medial-to-lateral flex grooves.” *Id.* (citing Ex. 1012 ¶ 52). Skechers’ annotated versions of Figure 3 of the '781 patent and Figure 3 of the '576 application are reproduced below.

'781 Patent Fig. 3, detail	'576 Application Fig. 3, detail
	
Fig. 3, detail (annotated; see Skechers 1012 ¶ 52)	Fig. 3, detail (annotated; see Skechers 1012 ¶ 52)
	

Pet. 30 (providing annotated excerpts of Ex. 1001, Fig. 3; Ex. 1004, Fig. 3).

As with its previous arguments, Skechers' argument is based upon magnifications of particular portions of the cited figures. *See id.*

Unmodified versions of Figure 3 of the '576 application and Figure 3 of the '781 patent are reproduced below.



FIG. 3

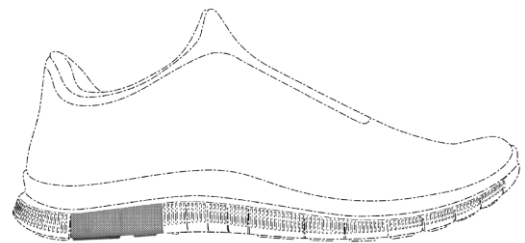


FIG. 3

Ex. 1004, Fig. 3; Ex. 1001, Fig. 3. As can be understood from a review of the above Figure 3, we determine that one of ordinary skill in the art viewing Figure 3 of the '576 application would not be able to perceive precisely whether a piston that, from the lateral view, protrudes from the lateralmost,

second rearmost outsole section *aligns flush* with the first and second rearmost medial-to-lateral flex grooves. *See* Ex. 1004, Fig. 7. Furthermore, as can be understood from a review of the above Figure 2 of the '781 patent, one of ordinary skill in the art would not be able to determine whether these pistons *align flush* with the first and second rearmost medial-to-lateral flex grooves of Figure 3 of the '781 patent. *See* Ex. 1001, Fig. 3.

Even assuming it was possible for one of ordinary skill in the art to perceive these differences, Skechers' magnification of these differences between certain elements in the photographs and drawings, at least on the evidence in this case, is an over-emphasis of fairly trivial inconsistencies, to the extent they exist, of the claimed design relative to the photographs. Considering the shoe sole design as a whole, we determine, on these facts, that these differences, to the extent they exist, are minor inconsistencies between the parent application and the claimed design depicted in the '781 patent. The drawings are sufficiently consistent with the photographs such that we determine Skechers fails to sufficiently establish that that the inventor did not have possession of the claimed design at the time of filing of the '576 application. *See Ex Parte Asano*, 201 USPQ (BNA) ¶ 315. Additionally, we note that it is not imperative, for these elements that the drawings in the continuation be *exactly* the same as the photographs of the parent. *Daniels*, 144 F.3d at 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))).

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. 31-32. 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 Skechers fails to persuasively establish sufficient visual distinctions between the claimed design and photographs to preclude the ability of the '781 patent to claim priority under 35 U.S.C. § 120 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. 24-31. 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 minimal differences do not detract from understanding of the design as a whole. Accordingly, we determine that Skechers fails to sufficiently establish 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 '781 patent sufficient for a claim of priority under 35 U.S.C. § 120. *See Ariad Pharms.*, 598 F.3d at 1351.

2. *Whether a Person of Ordinary Skill in the Art Would Recognize the Design Claimed in the '781 Patent As That in the Parent '576 Application*

Skechers alleges that a person of ordinary skill in the art would not clearly recognize the design claimed in the '781 patent from the '576 application. Pet. 32. Skechers provides three arguments to support this contention, each addressed below. Pet. 32–44.

a. *Whether by Claiming only a “Sole Portion of a Shoe,” the '781 Patent Claims a Design Not Disclosed in the '576 Application*

Skechers further argues Skechers further argues that the originally filed '576 application was improper because it contained multiple patentably distinct shoe designs. Pet. 32–33. For this proposition Skechers refers to *In re Rubinfeld*, 270 F.2d 391 (CCPA 1959) which supports the Patent Office's practice of limiting a design patent to a single claim. *See id.* at 396, (“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.”). Contrary to Skechers’ 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.”).

b. Whether the ’781 Patent Improperly Disclaimed Elements of the Design

Skechers additionally argues that the ’781 patent “claims a new, undisclosed design by disclaiming too much of the original shoe design disclosed by that embodiment.” Pet. 35 (citing *In re 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 ’781 Patent apart from the whole shoe design claimed in the ’576 Application at the time of the filing of the ’576 Application.

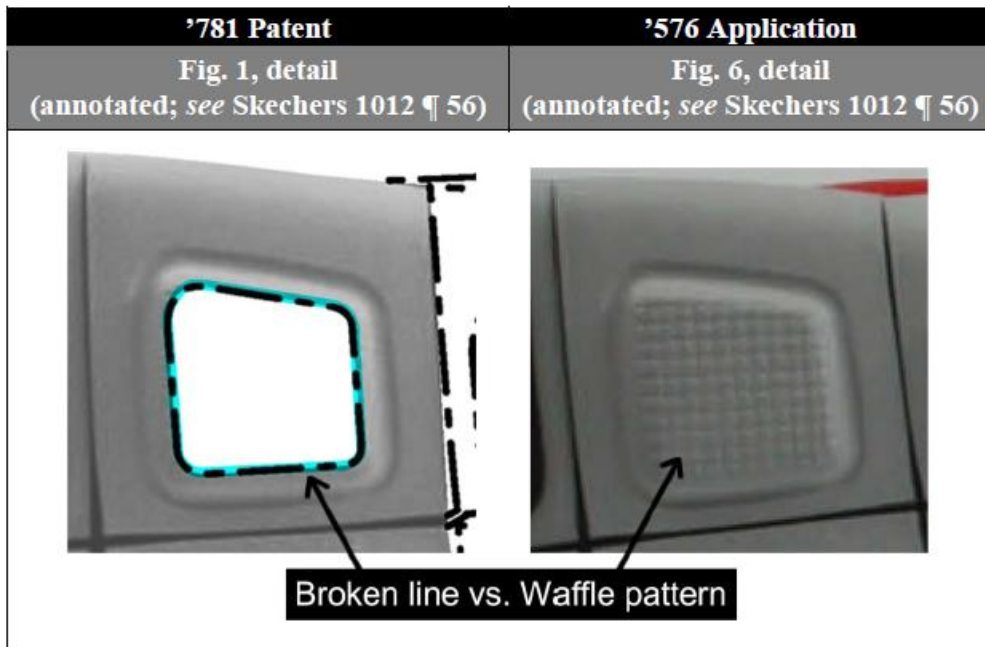
Ex. 1012 ¶ 54. Mr. Anders’s testimony is not persuasive here because it is based on the erroneous assertion that “the ’781 Patent’s claimed configuration of flex grooves, outsole sections, and pistons is absent from nine of the ten shoe designs depicted in the ’576 Application.” *Id.* at ¶ 55. On the contrary, our comparison of the flex grooves, outsole sections, and pistons shown in solid lines in the ’781 patent with the parent ’576 application reveals that these features *are* clearly visible in the

photographs of the underlying parent application. *Compare* Ex. 1004, Figs. 3, 6, 7 *with* Ex. 1001, Figs. 1-3.

Additionally, it is not, as Skechers contends, improper to disclaim portions of a design by changing solid lines to dashed lines. *See Owens* at 1368. 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* 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 the photographs in the parent ’576 application clearly show and delineate the claimed midsole and outsole elements of the design in addition to the showing discussed above that the inventor had possession of the invention, i.e. the shoe sole, claimed in the ’781 patent. *See* Ex. 1004, Figs. 3, 6, 7.

c. Whether Broken Lines Introduce New Matter

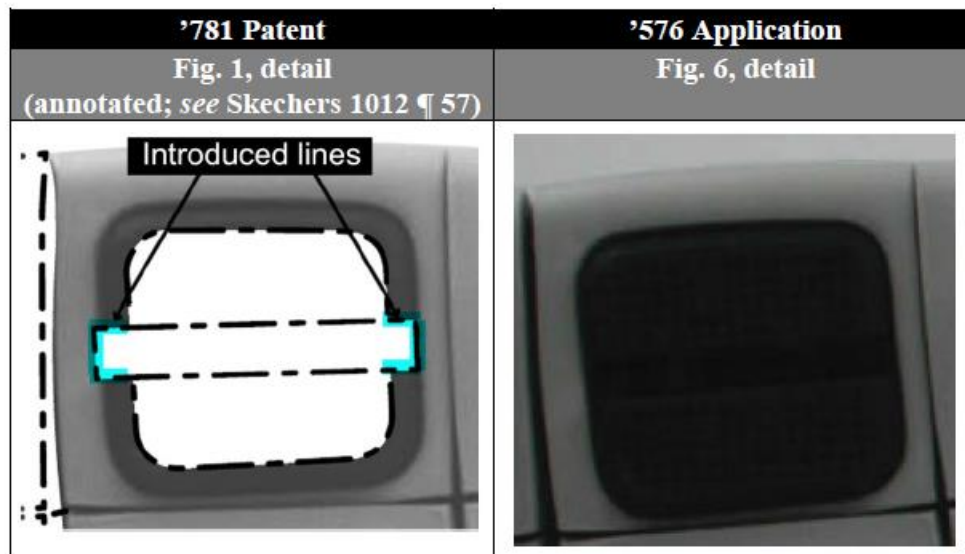
Skechers further relies upon *Owens* and contends that Nike has introduced new matter in the ’781 patent. Pet. 37–42. For example, Skechers argues that whereas the ’576 application discloses an outsole with pistons featuring a waffle pattern, the design claimed by the ’781 patent replaces this waffle pattern with a plain surface. Pet. 39 (citing Ex. 1001, Fig. 1; Ex. 1004, Fig. 6). Skechers’ annotated versions of Figure 1 of the ’781 patent and Figure 6 of the ’576 application are reproduced below.



Pet. 39 (providing annotated excerpts of Ex. 1001, Fig. 1; Ex. 1004, Fig. 6). Skechers argues that the '781 patent “replaces this waffle pattern with a plain surface enclosed by a broken line tracing the edge of the foremost claimed piston.” Pet. 39. As discussed above, we understand that the broken lines depicting the disclaimed waffle pattern form no part of the design. *See* 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.”). “[U]nclaimed boundary lines allow the patentee to adjust his patent coverage and encompass embodiments that differ slightly but insignificantly from the originally-filed design.” *Owens*, 710 F.3d at 1367. Because the waffle pattern on the surface of the piston in the parent application, does not obscure the piston design shown in the parent application drawings, we are

not persuaded by Skechers' argument that the '781 patent replaces the waffle pattern with a plain surface treatment. *See* Pet. 39, *see also Daniels* 144 F.3d at 1457. Accordingly, we are not persuaded by Skechers that this new broken line constitutes prohibited new matter.

Skechers also argues that Figure 1 of the '781 patent introduces six new lines and that Figure 6 of the '576 application does not disclose lines dividing the segment bisecting the outsole piston. Pet. 40. Skechers' annotated versions of Figure 1 of the '781 patent and Figure 6 of the '576 application are reproduced below.



Pet. 40 (providing annotated excerpts of Ex. 1001, Fig. 1; Ex. 1004, Fig. 6). Skechers argues that one of ordinary skill in the art would not have recognized upon viewing the photographs in the '576 application that Nike might separately claim two portions of the piston-enclosing shapes rather than the singular shape. Pet. 40–41. We note that Figure 6 of the '576 application does disclose at least a portion of the lines with respect to the identified piston. *See* Ex. 1004, Fig. 6. Additionally, the lines alleged by Skechers to have been improperly introduced in Figure 1 of the '781 patent

are broken lines, which disclaim material. *See* Ex. 1001, Fig. 1.

“[U]nclaimed boundary lines allow the patentee to adjust his patent coverage and encompass embodiments that differ slightly but insignificantly from the originally-filed design.” *Owens*, 710 F.3d at 1367. Furthermore, as with Skechers’ arguments above, Skechers’ magnification of certain elements in the photographs and drawings, at least on the evidence in this case, is an over-emphasis of fairly trivial inconsistencies, to the extent they exist, of the claimed design relative to the photographs.

We determine that the remainder of Skechers’ arguments with respect to the addition of new elements into the ’781 patent are similarly unpersuasive. Accordingly we are not persuaded by Skechers that a person of ordinary skill in the art would not recognize the design claimed in the ’781 patent based on the shoe disclosed in the ’576 application.

3. *Alleged Omission of Front, Rear, Medial, and Top Views*

Skechers argues that the ’781 patent claims only three figures, omitting from the claimed design the front, rear, medial, and top views of the shoe depicted in Figures 1, 2, 4, and 5 of the ’576 application. Pet. 42 (citing Ex. 1004, Figs. 1, 2, 4, 5). Skechers argues that including three figures instead of seven figures in the ’781 patent amounts to the addition of new matter. Pet. 42 (citing *Ex. parte Chu*, No. 2001-0959, 2003 WL 22282257, at *7 (BPAI 2003) (Ex. 1018)).

On the facts before us in this case, we do not agree that disclaimer of the shoe outsole and lack of submission of additional figures showing additional 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 ’781 patent includes drawings illustrating a portion of the outsole of the shoe sole in broken lines signifying that the indicated portion of the outsole is disclaimed.⁶ The outsole is therefore not omitted or eliminated from the design, it is merely disclaimed. 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. Notably, the ’576 application is directed to a “Shoe,” while the ’781 patent is directed to a “Shoe Sole.” *See* Ex. 1003, 2; Ex. 1001, Title. Accordingly, we are not persuaded by Skechers that the lack of an inclusion of these figures amounts to new matter.

III. CONCLUSION

For the reasons set forth above, Skechers has failed to persuade us that the claim of the ’781 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 we determine that 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 ’781 patent more than one year before the filing of the ’781 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

⁶ The ’781 Patent states that broken lines “form no part of the claimed design.” Ex. 1001, 1.

on the alleged ground of unpatentability with respect to the claim of the '781 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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