

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 IPR2017-00617 (Patent D723,772 S)
Case IPR2017-00619 (Patent D725,356 S)
Case IPR2017-00623 (Patent D725,359 S)

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

BARRETT, *Administrative Patent Judge*.

DECISION¹

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

¹This Decision addresses the same legal and factual issues raised in IPR2017-00617, IPR2017-00619, and IPR2017-00623. The patents at issue in all three cases are related, and the arguments made by the parties largely are the same in all the three cases. Therefore, we issue one Decision to be entered in each case.

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I. INTRODUCTION

A. *Background and Summary*

Skechers U.S.A., Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of U.S. Patent No. D723,772 S (“the ’772 patent,” Ex. 1001). IPR2017-00617, Paper 1 (“Pet.”). Petitioner also filed a Petition requesting *inter partes* review of U.S. Patent No. D725,356 S (“the ’356 patent”), IPR2017-00619, Paper 1, and a Petition requesting *inter partes* review of U.S. Patent No. D725,359 S (“the ’359 patent”), IPR2017-00623, Paper 1.² Each Petition challenges the patentability of the sole claim of the respective patent on the grounds of obviousness under 35 U.S.C. § 103. Nike, Inc. (“Patent Owner”) filed in each case a Preliminary Response to the Petition. *See, e.g.*, IPR2017-00617, Paper 12 (“Prelim. Resp.”).

An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Having considered the arguments and evidence presented by Petitioner and Patent Owner, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of the challenged claim of the ’772 patent, the challenged claim of the ’356 patent, or the challenged claim of the ’359 patent.

² For clarity and expediency, we treat IPR2017-00617 as representative of IPR2017-00617, IPR2017-00619, and IPR2017-00623. Unless indicated otherwise, all citations are to papers filed in IPR2017-00617.

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B. Related Proceedings

One or both parties identify, as matters involving or related to the '772 patent, the '356 patent, or the '359 patent: *Nike, Inc. v. Skechers U.S.A., Inc.*, No. 3:16-cv-00007-PK (D. Or.) and several related *inter partes* review cases, including IPR-2016-00870 (the '356 patent), IPR-2016-00871 (the '359 patent), and IPR-2016-00872 (the '772 patent). Pet. 3; Paper 3, 2.

C. The '772 Patent, the '356 Patent, the '359 Patent, and the Claims

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). With regard to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679–80; *cf. High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

The '772 patent, the '356 patent, and the '359 patent each are titled “Shoe Sole,” and the claim of each patent recites “[t]he ornamental design for a shoe sole, as shown and described.” *E.g.*, IPR2017-00617, Ex. 1001 (54), (57). The drawings of the claim of the '772 patent and of the claim of

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the '356 patent depict a shoe with the shoe “upper” and “outsole” (the bottom of the shoe) illustrated as unclaimed by broken lines, and the “midsole” as being claimed. *See id.* at 1 (“The broken lines showing the remainder of the shoe are for environmental purposes only and form no part of the claimed design.”). The '772 patent contains six figures. Figures 2, 4, and 5 are reproduced below.

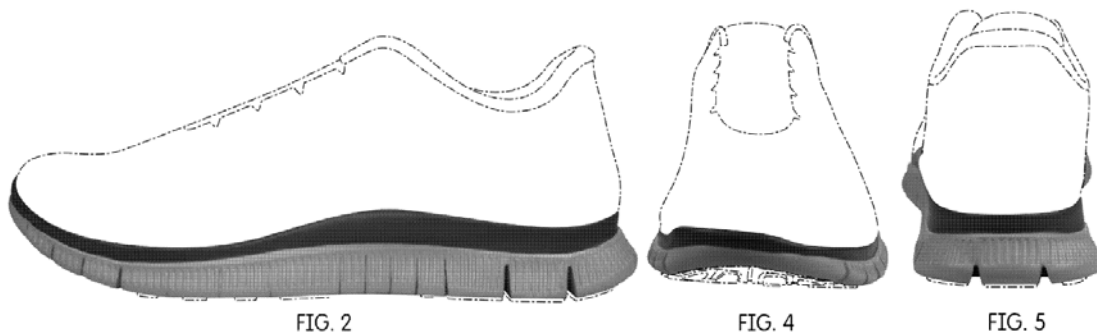


Figure 2 is a lateral side view of a shoe sole, and Figures 4 and 5, respectively, are front and rear views thereof. *Id.*

The '356 patent contains six figures. Figures 2, 4, and 5 are reproduced below.

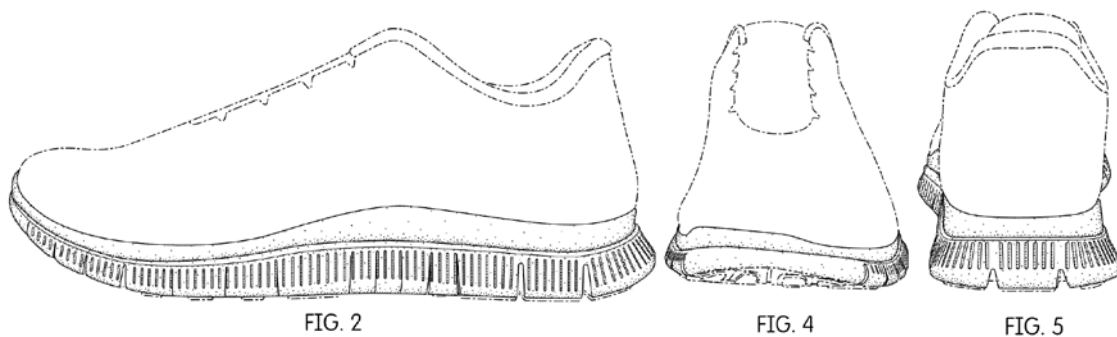


Figure 2 is a lateral side view of a shoe sole, and Figures 4 and 5, respectively, are front and rear views thereof. IPR2017-00619, Ex. 1001, 1.

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The claimed design of the '359 patent, which contains seven figures, includes certain aspects of the “outsole” as well as the midsole. Figures 2, 4, 5, and 7 are reproduced below.

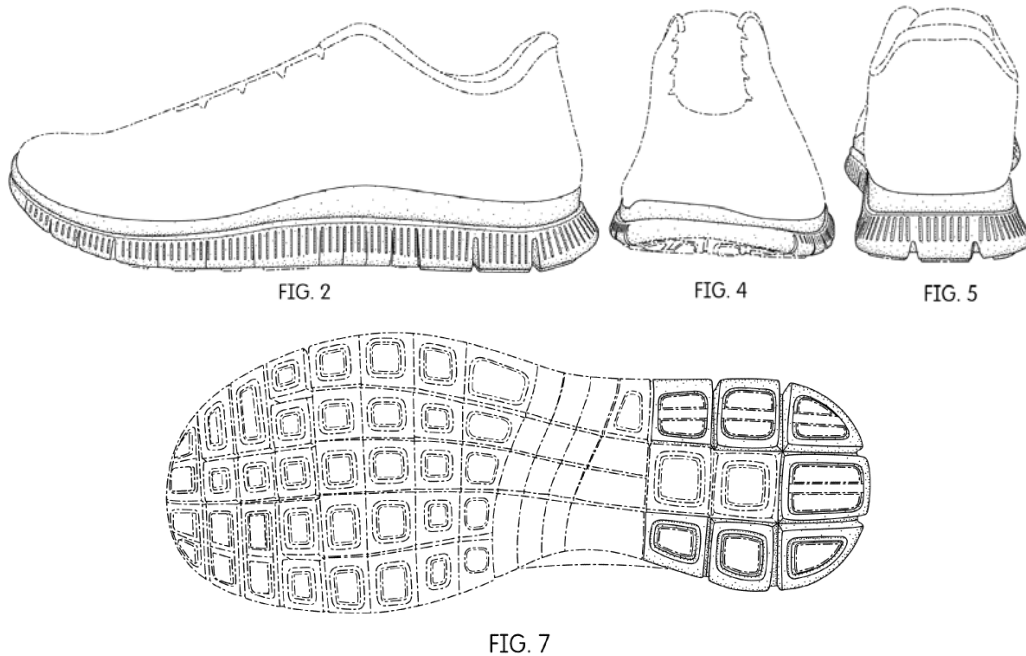


Figure 2 is a lateral side view of a shoe sole, and Figures 4 and 5, respectively, are front and rear views thereof. IPR2017-00623, Ex. 1001, 1. Figure 7 is a bottom view of the outsole illustrating certain heel portions of the bottom surface as claimed and the rest of the outsole illustrated as unclaimed by broken lines. *See* IPR2017-00623, Ex. 1001, 1.

We determine that the following verbal descriptions will be helpful by pointing out “various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679–80. Common features among the three subject patents that contribute to the overall appearance of the claimed designs—and specifically the midsole—include that which

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