

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELITE PERFORMANCE FOOTWEAR, LLC,
Petitioner,

v.

REEBOK INTERNATIONAL LIMITED,
Patent Owner.

Case IPR2017-01676
Patent 7,637,035 B1

Before MEREDITH C. PETRAVICK, KEVIN W. CHERRY, and
JAMES A. WORTH, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

Elite Performance Footwear, LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–4, 9–15, 18, 19, and 23–27 of U.S. Patent No. 7,637,035 B1 (Ex. 1001, “the ’035 patent”). Paper 2 (“Petition” or “Pet.”). Reebok International Limited (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Preliminary Response” or “Prelim. Resp.”).

Pursuant to 35 U.S.C. § 314(a), we determined the Petition showed a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–4, 9–15, 18, 19, and 23–27, and instituted an *inter partes* review of these claims on one of a number of asserted grounds of unpatentability. Paper 7 (“Institution Decision” or “Inst. Dec.”). On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 318(a) may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). Following the Supreme Court’s decision in *SAS*, the Office issued guidance that the Board would now institute on all challenges and would supplement any institution decision that had not instituted on all grounds to institute on all grounds. See April 26, 2018, *Guidance on the Impact of SAS on AIA Trial Proceedings*.¹ Accordingly, on May 1, 2018, we issued an order instituting on the other grounds of unpatentability asserted in the Petition that we had not originally instituted review on. See Paper 16.

Patent Owner filed a Patent Owner Response. Paper 20 (“PO Resp.”). Petitioner filed a Reply to Patent Owner’s Response. Paper 22 (“Pet.

¹ Available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

Reply”). Pursuant to our authorization, Patent Owner also filed a Sur-Reply. Paper 27 (“Sur-Reply”).

Patent Owner filed a Contingent Motion to Amend. Paper 21. Petitioner filed an opposition to Patent Owner’s Motion to Amend. Paper 23. Patent Owner filed a Reply to Petitioner’s Opposition to the Motion to Amend. Paper 28. Petitioner filed a Sur-Reply to Patent Owner’s Motion to Amend. Paper 32.

Petitioner also filed a Motion to Exclude certain evidence. Paper 34. Patent Owner filed an Opposition to Petitioner’s Motion to Exclude. Paper 36.

An oral hearing was held on October 25, 2018. Paper 37 (“Tr.”).

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine Petitioner *has not proven* by a preponderance of the evidence that claims 1–4, 9–15, 18, 19, and 23–27 of the ’035 patent are unpatentable. *See* 35 U.S.C. § 316(e). We *dismiss* Patent Owner’s Contingent Motion to Amend and Petitioner’s Motion to Exclude *as moot*.

I. BACKGROUND

A. RELATED PROCEEDINGS

Patent Owner has asserted infringement of the ’035 patent in *Reebok International Ltd. v. TRB Acquisitions LLC*, Case No. 16-cv-1618 (D. Oregon). Paper 4, 1; Pet. 69. The ’035 patent is one of a number of related issued patents some of which are also subject to pending petitions for *inter partes* review. *See* Paper 4, 1. The ’035 patent was also the subject of *In the*

Matter of Certain Athletic Footwear, Inv. No. 337-TA-1018 (2016) in the United States International Trade Commission. Pet. 10; Paper 4, 1.

B. THE '035 PATENT

The '035 patent is titled “Collapsible Shoe” and issued on December 29, 2009. Ex. 1001, (45), (54). The '035 patent discloses a shoe that has an upper and a sole formed of a lightweight, flexible material. *Id.* at 2:6–11. “The flexible sole and upper allows the article of footwear to be rolled, folded or collapsed on itself so that the article of footwear may be easily stored, packed or distributed.” *Id.* at 2:13–16. Figure 3 of the '035 patent is reproduced below.

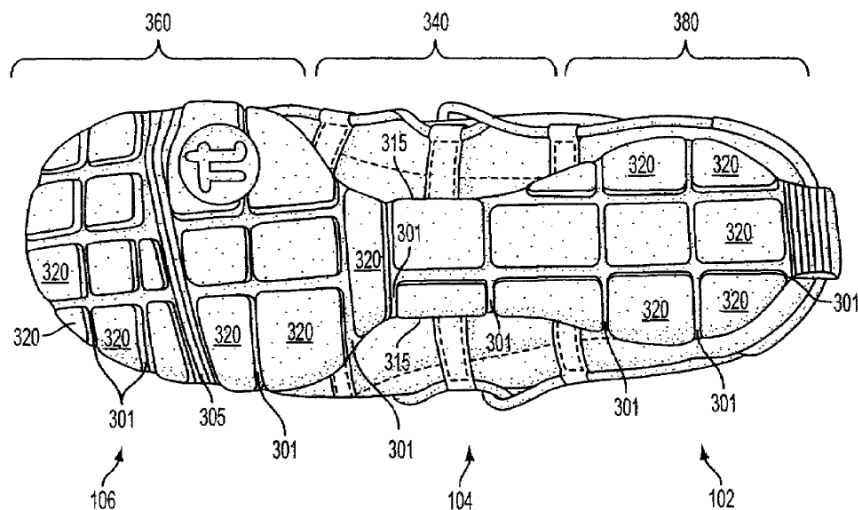


FIG. 3

Figure 3 depicts sole 102 having flexure lines 301, 305 and sole plates 320. *Id.* at 5:23–26. Flexure lines 301, 305 “allow sole [102] to flex and curve,” “allow shoe 100 to be folded,” and “provides additional comfort while the foot is in motion.” *Id.* at 4:62–63, 5:24–25, 5:40–41. “[S]ole [102] has a larger portion 360 generally located in forefoot area 106, a narrower portion 340 generally located in arch area 104 . . . , and a mid-sized portion 380 generally located in heel area 102.” *Id.* at 5:58–62.

The sole “is preferably made of a flexible, lightweight and durable foam material,” for example, “a mixture of ethyl vinyl acetate (EVA), rubber and other compounds, such as the 3D Ultralite material.” *Id.* at 4:23–31. The upper “may be made of any suitable, breathable and stretchable materials, such as spandex, cotton, or the like.” *Id.* at 3:19–22.

Figure 4 of the '035 patent is reproduced below.

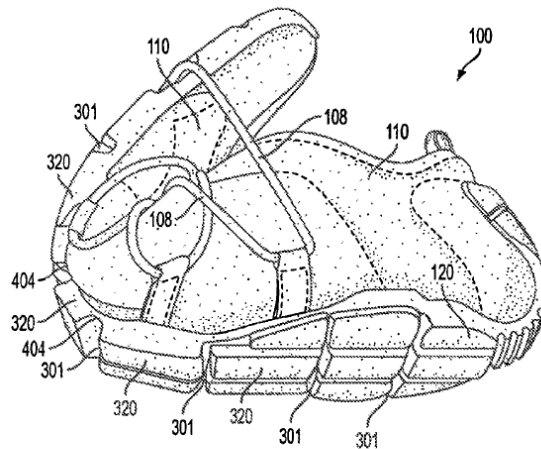


FIG. 4

Figure 4 depicts the article of footwear in a partially collapsed state. *Id.* at 2:39–40, 5:10–13. In this configuration, the “[l]acing 108 and flexible upper 110 are collapsed upon each other, such that flexible sole 120 envelopes the upper 110 and lacing 108.” *Id.* at 5:2–4. “As shoe 100 is rolled, each flexure line 301 allows sole plates 320 to move apart from each other around the outside of the collapsed shoe, as seen at flexure points 404 of FIG. 4, providing more flexibility in sole 120 and a more compact collapsed state for shoe 100.” *Id.* at 5:4–8.

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