

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 IPR2017-01680
Patent 8,505,221 B2

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

CHERRY, *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 1–6 and 11–20 of U.S. Patent No. 8,505,221 B2 (Ex. 1001, “the ’221 patent”). Paper 2 (“Petition” or “Pet.”). Patent Owner filed a Preliminary Response (Paper 6, “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, 2, 5, 6, and 11–15, and instituted an *inter partes* review of these claims on one of the seven 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 fewer 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. *See* U.S. Patent and Trademark Office, *Guidance on the Impact of SAS on AIA Trial Proceedings* (Apr. 26, 2018).¹ Accordingly, on May 1, 2018, we issued an order instituting on the seven claims and six other grounds of unpatentability asserted in the Petition on which we had not originally instituted review. *See* Paper 16.

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

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

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

Patent Owner filed a Contingent Motion to Amend. Paper 22 (“PO Mot. Amend”). Petitioner filed an opposition to Patent Owner’s Motion to Amend. Paper 23 (“Pet. Opp. Mot. Amend”). Patent Owner filed a reply to Petitioner’s Opposition to the Motion to Amend. Paper 28 (“PO Reply Mot. Amend”). Petitioner filed a sur-reply to Patent Owner’s Motion to Amend. Paper 32 (“Pet. Sur-Reply Mot. Amend”).

Petitioner also filed a Motion to Exclude certain evidence. Paper 34 (“Pet. Mot. Exclude”). Patent Owner filed an Opposition to Petitioner’s Motion to Exclude. Paper 36 (“PO Opp.”). 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 1–6 and 11–20 of the ’221 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 ’221 patent in *Reebok International Ltd. v. TRB Acquisitions LLC*, Case No. 3:16-cv-1618 (D. Oregon). Paper 4, 1; Pet. 76. The ’221 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 ’221 patent was also the subject of *In the Matter of Certain Athletic Footwear*, Inv. No. 337-TA-1018 (2016), (“the

previous ITC case”) in the United States International Trade Commission.
Pet. 10; Paper 4, 1.

B. THE '221 PATENT

The '221 patent is directed to articles of footwear with a flexible upper portion and a sole composed of flexible material which can be rolled, folded, or collapsed onto itself to reduce the dimensions of the footwear.

Ex. 1001, Abstract. Figure 3 is reproduced below:

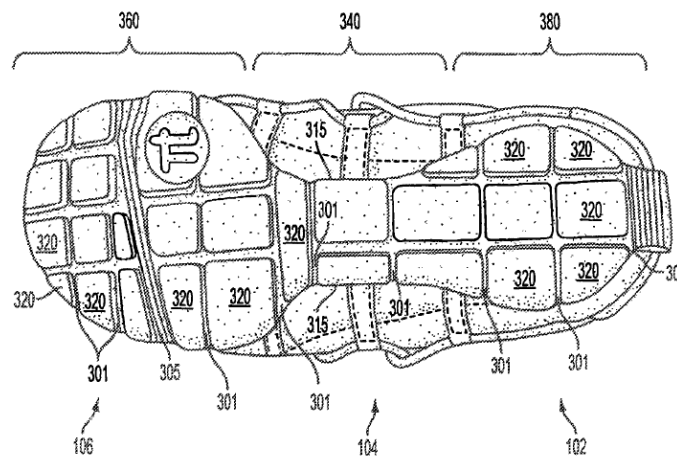


FIG. 3

Figure 3 shows the outsole of an article of footwear of the preferred embodiment of the '221 patent in an uncollapsed state. *Id.* at 2:37–38, 2:46–47. Sole 120 of Figure 3 has a plurality of flexure lines 301, which allow sole 120 to flex and curve. *Id.* at 5:4–5. “The flexible material of sole 120 allows sole 120 to roll to some extent on its own, but the flexure lines 301 divide the sole into a plurality of sole plates 320 which individually curve around the outside of shoe 100 when in a collapsed state.” *Id.* at 5:5–9. “FIG. 3 shows a larger flexure line 305 located diagonally across the width of sole 120 . . . The larger flexure line 305 provides additional flexibility.” *Id.* at 5:46–49. Various sole plates 320 are shown arrayed across the face of the exemplary outsole depicted by Figure 3, which also provides guidance

regarding the general position of the forefoot area 360, arch area 340, and heel area 380 of the outsole. *Id.* at 5:7–8, 5:67–6:4. Figure 4 is illustrated below:

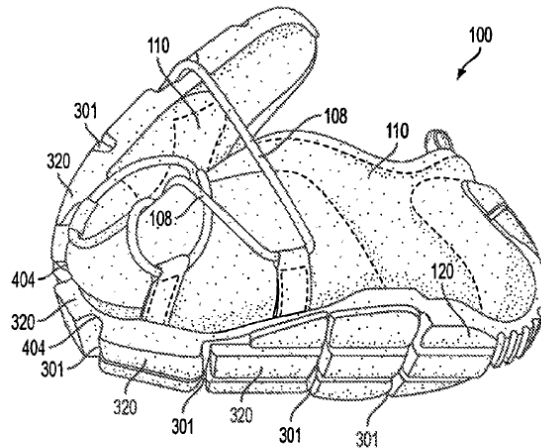


FIG. 4

Figure 4 shows the article of footwear in a partially collapsed state. *Id.* at 2:48–49, 5:10. 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 5:11–13. “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 5:13–17.

C. ILLUSTRATIVE CLAIM

Claims 1 and 16, both article claims, are the only independent claims of the '221 patent. Claims 2–15 each depend from claim 1. Claims 17–20 each depend from claim 16. Claim 1 is illustrative of the subject matter in this proceeding, and is reproduced below.

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