

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PUMA NORTH AMERICA, INC.,
Petitioner,

v.

NIKE, INC.,
Patent Owner.

Case IPR2019-01042
Patent 9,314,065 B2

Before MITCHELL G. WEATHERLY, AMANDA F. WIEKER, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background*

PUMA North America, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–6 (“challenged claims”) of U.S. Patent No. 9,314,065 B2 (Ex. 1001, “the ’065 patent”). Paper 1 (“Pet.”). NIKE, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, *see* Paper 7, Petitioner filed a Reply addressing 35 U.S.C. §§ 314(a) and 325(d), and Patent Owner filed a Sur-Reply. Paper 8 (“Reply”); Paper 9 (“Sur-Reply”).

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. For the reasons provided below, we do not institute an *inter partes* review.

B. *Related Proceeding*

The parties identify the following matter related to the ’065 patent (Pet. 54; Paper 4, 2):

NIKE, Inc. v. PUMA North America, Inc., No. 1:18-cv-10876
(D. Mass.).

C. *The ’065 Patent*

The ’065 patent is titled “Article of Footwear with Base Plate Having Structure and Studs” and issued on April 19, 2016, from U.S. Application No. 13/524,044 (“the ’044 application”), filed June 15, 2012. Ex. 1001, at codes (21), (22), (45), (54).

The ’065 patent discloses an article of footwear, e.g., a cleated soccer shoe, designed to “optimize propulsion during the first step of sprinting and provide stability and responsiveness while also moderating stud pressure during quick directional changes.” *Id.* at 1:6–17, 3:65–67, Fig. 1.

Figure 5 of the '065 patent is reproduced below.

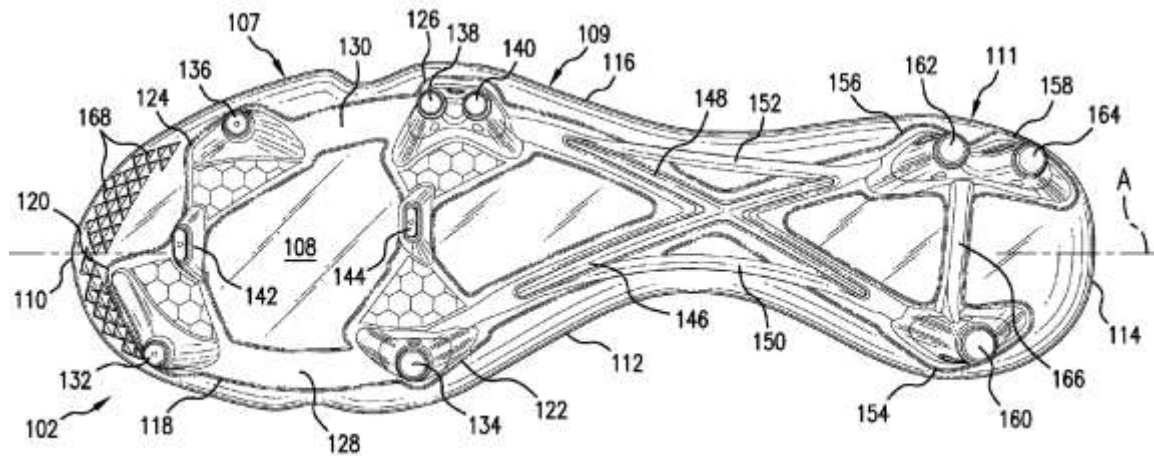


FIG. 5

Figure 5 depicts a plane view of the bottom surface of an exemplary shoe. *Id.* at 3:53–54.

The shoe includes base plate 102, which includes forefoot region 107, midfoot region 109, and heel region 111. *Id.* at 4:27–47. Base plate 102 “may be a carrier plate for a structure 118,” which acts as a frame or brace. *Id.* at 5:3–4.

As shown in Figure 5, the base plate includes various features to improve performance of the shoe, including various:

- *pads* (first medial forefoot pad 120, second medial forefoot pad 122, first lateral forefoot pad 124, second lateral forefoot pad 126, medial heel pad 154, first lateral heel pad 156, second lateral heel pad 158),
- *bars* (medial forefoot bar 128, lateral forefoot bar 130, medial midfoot bar 150, lateral midfoot bar 152),
- *ribs* (first diagonal rib 146, second diagonal rib 148, heel rib 166), and
- *studs* (first medial forefoot stud 132, first lateral forefoot stud 136, second medial forefoot stud 134, second lateral forefoot stud 138, third lateral forefoot stud 140, first center stud 142, second center stud

144, medial heel stud 160, first lateral heel stud 162, second lateral heel stud 164).

Id. at 5:50–60, 6:20–23, 7:3–8, 7:59–60, 8:9–10, 8:32, 8:54, 10:11–15, 11:3–4. For example, “[t]ogether, medial midfoot bar 150 and lateral midfoot bar 152 may provide base plate 102 with torsional stiffness resisting twisting in midfoot region 109.” *Id.* at 12:47–49.

D. Illustrative Claim

The ’065 patent includes twelve claims, six of which are challenged. Claim 1 is the sole challenged independent claim. Claim 1 is illustrative and is reproduced below, with bracketed paragraph letters added.

1. An article of footwear comprising:

[a] a base plate including a forefoot region, a heel region, a midfoot portion disposed between the forefoot region and the heel region, a longitudinal axis extending through the forefoot region and heel region, a forward edge, a rearward edge, a medial edge, and a lateral edge;

[b] a structure disposed on the base plate, the structure including a medial forefoot pad disposed on the forefoot region proximate the midfoot portion and the medial edge, a lateral forefoot pad disposed on the forefoot region proximate the midfoot portion and the lateral edge, a medial heel pad disposed on the heel region proximate the medial edge, a first lateral heel pad disposed on the heel region proximate the lateral edge, a first diagonal rib extending from the medial forefoot pad to the first lateral heel pad, a second diagonal rib extending from the lateral forefoot pad to the medial heel pad, *a medial midfoot bar substantially parallel to the longitudinal axis and disposed proximate the medial edge*, and a lateral midfoot bar substantially parallel to the longitudinal axis and disposed proximate the lateral edge;

[c] a medial forefoot stud disposed on the medial forefoot pad;

[d] a medial heel stud disposed on the medial heel pad;

[e] a first lateral forefoot stud disposed on the lateral forefoot pad; and

[f] a first lateral heel stud disposed on the first lateral heel pad;

[g] the first diagonal rib having a first lateral edge intersecting with the first lateral heel pad;

[h] the second diagonal rib having a second lateral edge intersecting with the first lateral forefoot pad;

[i] the lateral midfoot bar having a third lateral edge;

[j] wherein the medial midfoot bar extends from a first point on the first diagonal rib to a second point on the second diagonal rib; and

[k] wherein the third lateral edge of the lateral midfoot bar intersects with, and terminates at, a third point on the second diagonal rib at a forward end of the lateral midfoot bar;

[l] wherein the third lateral edge of the lateral midfoot bar intersects with, and terminates at, a fourth point on the first diagonal rib at a rearward end of the lateral midfoot bar;

[m] wherein the third point is spaced from the lateral forefoot pad; and

[n] wherein the fourth point is spaced from the first lateral heel pad.

Ex. 1001, 12:60–13:39 (emphasis added and elements labeled [a]–[n] to aid discussion).

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