UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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adidas AG
Petitioner

v.

Nike, Inc.
Patent Owner

Patent No. 7,347,011
Filing Date: March 3, 2004
Issue Date: March 25, 2008
Title: ARTICLE OF FOOTWEAR HAVING A TEXTILE UPPER

Inter Partes Review No. Unassigned

PETITION FOR *INTER PARTES* REVIEW
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *ET SEQ.*

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EXHIBITS

Exhibit 1001: Declaration of Edward C. (Ned) Frederick, Ph.D. ("Frederick Dec.")

Exhibit 1002: U.S. Patent No. 7,347,011 to Dua et al. ("'011 patent")

Exhibit 1003: The '011 patent file history

Exhibit 1004: Form PTO-SB/42

Exhibit 1005: U.S. Patent No. 5,345,638 to Nishida ("Nishida")

Exhibit 1006: JP Pub. No. H6-113905 to Osamu ("Osamu"), including a certified English translation thereof

Exhibit 1007: U.S. Patent No. 2,147,197 to Glidden ("Glidden")

Exhibit 1008: U.S. Patent No. 2,314,098 to McDonald ("McDonald")

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Exhibit 1010: International App. Pub. No. WO 90/03744 to Curley ("Curley")

Exhibit 1011: U.S. Patent No. 4,785,558 to Shiomura ("Shiomura")

Exhibit 1012: David J. Spencer, Knitting Technology: A Comprehensive Handbook and Practical Guide (Third ed., Woodhead Publishing Ltd. 2001)

Exhibit 1013: Excerpt of Hannelore Eberle et al., Clothing Technology (Third English ed., Beuth-Verlag GmbH 2002)

Through counsel, real party in interest adidas AG ("Petitioner") hereby petitions for *inter partes* review under 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42 of claims 1-46 of U.S. Patent No. 7,347,011 ("the '011 patent"), and asserts there is a reasonable likelihood that it will prevail with respect to at least one of the claims challenged in this petition.

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(1)

A. Real Party-In-Interest under 37 C.F.R. § 42.8(b)(1)

Petitioner, adidas AG, is the real party-in-interest for the instant petition.

B. Related Matters under 37 C.F.R. § 42.8(b)(2)

No related matters are currently known to Petitioner.

C. Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)

Petitioner provides the following designation of counsel.

LEAD COUNSEL	BACK-UP COUNSEL
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D. Service Information

As identified in the attached Certificate of Service, a copy of the present petition, in its entirety, is being served to the address of the attorney or agent of record. adidas AG may be served at the lead counsel address provided in Section I(C) of this Petition.

E. Power of Attorney

A power of attorney is being filed with the designation of counsel in accordance with

37 C.F.R. § 42.10(b).

II. PAYMENT OF FEES – 37 C.F.R. § 42.103

This petition for *inter partes* review requests review of 46 claims of the '011 patent and is accompanied by a payment of $42,800, which includes $27,200 for 20 claims and an additional $15,600 for 26 claims in excess of 20 claims. *See* 37 C.F.R. § 42.15. Thus, this petition meets the fee requirements under 35 U.S.C. § 312(a)(1).

III. REQUIREMENTS FOR INTER PARTES REVIEW UNDER 37 C.F.R. § 42.104

A. Grounds For Standing under 37 C.F.R. § 42.104(a)

Petitioner certifies that the '011 patent is eligible for *inter partes* review and further certifies that Petitioner is not barred or otherwise estopped from requesting *inter partes* review challenging the identified claims on the grounds identified within the present petition.

B. Identification of Challenge under 37 C.F.R. § 42.104(b) and Relief Requested

Petitioner requests *inter partes* review of claims 1-46 of the '011 patent on the grounds set forth in the table below and requests that each of the claims be found unpatentable. An explanation of how claims 1-46 are unpatentable under the statutory grounds identified below, including the identification of where each element is found in the prior art patents or publications and the relevance of the prior art reference, is provided in the form of detailed claim charts. Additional explanation and support for each ground of rejection is set forth in the Declaration of Edward C. (Ned) Frederick, Ph.D. (Ex. 1001).

Ground	'011 Patent Claims	Basis for Rejection
Ground 1	1-16; 19-34; 36; 39-46	Anticipated under § 102(b) by Nishida
Ground 2	1-16; 19-46	Obvious under § 103(a) in view of Nishida
Ground 3	1-7; 10-12; 14; 16-20; 32-33; 37	Obvious under § 103(a) by Nishida in view of McDonald
Ground 4	8-9; 13; 21-23	Obvious under § 103(a) by Nishida in view of McDonald and Curley
Ground 5	8-9; 13; 21-23	Obvious under § 103(a) by Nishida in view of McDonald and Shiomura
Ground 6	9; 13; 22-23	Obvious under § 103(a) by Nishida in view of McDonald and Glidden
Ground 7	1-7; 10-12; 14-16; 19-20; 32-33; 44-46	Obvious under § 103(a) by Nishida in view of Whiting
Ground 8	8-9; 13; 21-23	Obvious under § 103(a) by Nishida in view of Whiting and Curley
Ground 9	8-9; 13; 21-23	Obvious under § 103(a) by Nishida in view of Whiting and Shiomura
Ground 10	9; 13; 17-18; 22-23	Obvious under § 103(a) by Nishida in view of Whiting and Glidden
Ground 11	17-18	Obvious under § 103(a) by Nishida in view of Whiting and McDonald
Ground 12	1-13; 16; 19-23; 30-32; 34; 43-46	Obvious under § 103(a) by Nishida in view of Curley
Ground 13	8-9; 13; 21-23; 30-31; 34-35; 38; 43	Obvious under § 103(a) by Nishida in view of Shiomura
Ground 14	9; 13; 22-23; 30-31; 43	Obvious under § 103(a) by Nishida in view of Glidden
Ground 15	1-2; 7-14; 16-23	Anticipated under § 102(b) by Glidden
Ground 16	1-2; 7-14; 16-23	Obvious under § 103(a) by Glidden in view of McDonald
Ground 17	1-2; 7-14; 16-23	Obvious under § 103(a) by Glidden in view of Whiting
Ground 18	1-16; 19-46	Obvious under § 103(a) in view of Osamu
Ground 19	1-7; 9-10; 13-14; 16-20; 22-33; 36-37; 39-43	Obvious under § 103(a) by Osamu in view of McDonald
Ground 20	8; 21; 34	Obvious under § 103(a) by Osamu in view of McDonald and Curley
Ground 21	8; 21; 34-35; 38	Obvious under § 103(a) by Osamu in view of McDonald and Shiomura

Ground 22	11-12	Obvious under § 103(a) by Osamu in view of McDonald and Glidden
Ground 23	11-12; 34	Obvious under § 103(a) by Osamu in view of McDonald and Nishida
Ground 24	1-7; 9-10; 13-16; 19-20; 22-33; 36; 39-44; 46	Obvious under § 103(a) by Osamu in view of Whiting
Ground 25	8; 21; 34	Obvious under § 103(a) by Osamu in view of Whiting and Curley
Ground 26	8; 21; 34-35; 38	Obvious under § 103(a) by Osamu in view of Whiting and Shiomura
Ground 27	11-12; 17-18; 45	Obvious under § 103(a) by Osamu in view of Whiting and Glidden
Ground 28	11-12; 34; 45	Obvious under § 103(a) by Osamu in view of Whiting and Nishida
Ground 29	1-7; 9-13; 16; 19-20; 22-32; 34; 36; 39-46	Obvious under § 103(a) by Osamu in view of Nishida
Ground 30	8; 21	Obvious under § 103(a) by Osamu in view of Nishida and Curley
Ground 31	8; 21; 35; 38	Obvious under § 103(a) by Osamu in view of Nishida and Shiomura
Ground 32	17-18	Obvious under § 103(a) by Osamu in view of Nishida and Glidden
Ground 33	14; 17-18; 33; 37	Obvious under § 103(a) by Osamu in view of Nishida and McDonald
Ground 34	14; 15; 33	Obvious under § 103(a) by Osamu in view of Nishida and Whiting
Ground 35	1-7; 9-13; 16-20; 22-32; 36; 39-43	Obvious under § 103(a) by Osamu in view of Glidden
Ground 36	8; 21; 34	Obvious under § 103(a) by Osamu in view of Glidden and Curley
Ground 37	8; 21; 34-35; 38	Obvious under § 103(a) by Osamu in view of Glidden and Shiomura
Ground 38	1-10; 13; 16; 19-32; 34; 36; 39-44; 46	Obvious under § 103(a) by Osamu in view of Curley
Ground 39	35; 38	Obvious under § 103(a) by Osamu in view of Curley and Shiomura

Each of the references relied upon in the grounds set forth above qualify as prior art under 35 U.S.C. § 102(b). Specifically, Nishida issued on September 13, 1994, and therefore qualifies as prior art under 35 U.S.C. § 102(b). Osamu published on April 26, 1994, and therefore qualifies as prior art under 35 U.S.C. § 102(b). Glidden issued on February 14, 1939, and therefore qualifies as prior art under 35 U.S.C. § 102(b). McDonald issued on March 16, 1943, and therefore qualifies as prior art under 35 U.S.C. § 102(b). Whiting issued on June 9, 1953, and therefore qualifies as prior art under 35 U.S.C. § 102(b). Curley published on April 19, 1990, and therefore qualifies as prior art under 35 U.S.C. § 102(b). Shiomura issued on November 22, 1988, and therefore qualifies as prior art under 35 U.S.C. § 102(b).

IV. SUMMARY OF THE '011 PATENT

A. Brief Description

The '011 patent relates to an article of footwear having a textile upper. ('011 patent (Ex. 1002), 1:5-10). The '011 patent specifically teaches that the upper incorporates a textile element, which may be formed with a knitting machine. (*Id.*, 3:20-22).

B. Summary of the Prosecution History of the '011 Patent

The original patent application, No. 10/791,289 ("the '289 application"), attached hereto as a part of Exhibit 1003, was filed on March 3, 2004, with claims 1-67. Original independent claims 1, 20, 28, 41, and 65 were directed to articles of footwear having an upper incorporating a textile element, and original independent claims 50 and 58 were directed to methods of manufacturing a footwear element. The PTO issued a restriction

requirement requiring election of either the claims drawn to an article of footwear or the claims drawn to a method of knitting a footwear element. ('011 file history (Ex. 1003), 01/05/2006 Office Action, p. 2).

In response, applicants filed a reply to the restriction requirement, electing to prosecute claims directed to an article of footwear, claims 1-49 and 65-67. ('011 file history (Ex. 1003), 01/19/2006 Response, p. 1). The PTO then issued a first Office Action on the merits, rejecting all pending claims. ('011 file history (Ex. 1003), 09/12/2006 Office Action, pp. 2-4). Specifically, the Examiner rejected claims 1-11, 13, 14, 16-24, 26-35, 37-49, 65, and 67 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,888,172 to Joha ("Joha"). (*Id.*, pp. 2-3.) Several of the independent claims, in addition to claiming structural elements of the footwear article, claimed the knitting method by which it was formed (*e.g.*, "formed by weft knitting"). The Examiner noted that in reference to the specific method by which the upper is knitted, "such phrases have been treated as product by process limitations...[and] does NOT serve to resolve the issue concerning patentability of the product." (*Id.*, p. 2). The Examiner further noted "that the numerous types of knitting are well-known in the art and are noted in some of the cited references." (*Id.*, pp. 2-3).

The Examiner also rejected claims 1, 2, 7-11, 13-24, 26, 27, 41-43, 47-49, and 65-67 under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 6,308,438 to Throneburg ("Throneburg"). (*Id.*, p. 3). The Examiner reiterated the statements regarding product by process limitations and the known types of knitting. (*Id.*).

The Examiner further rejected claims 12, 25, and 36 under 35 U.S.C. § 103 as being unpatentable over Joha in view of U.S. Patent No. 5,746,013 to Fay, Sr. ("Fay"). (*Id.*, p. 4). The Examiner rejected claims 12 and 25 under 35 U.S.C. § 103 as being unpatentable over Throneburg in view of Fay. (*Id.*).

In response to the Office Action, the Applicants submitted an amendment and response, along with a petition for a one month extension of time. ('011 file history (Ex. 1003), 01/12/2007 Response). In the response, Applicants cancelled original claims 7-10, 30, 47, and 50-64, and amended original claims 1, 2, 11-13, 18-20, 23-25, 27, 28, 31-33, 35, 43, 48, 49, and 65 to distinguish over the prior art of record. (*Id.*, pp. 3-8).

In particular, with respect to the rejections of claims 1, 28, and 41, Applicants amended the claims limiting the claimed footwear article to a single type of textile having a plurality of knit constructions, and further argued that neither Joha nor Throneburg disclose an upper incorporating a single type of textile having a plurality of constructions. (*Id.*, pp. 9-10). With respect to amended claim 20, Applicants argued that neither Joha nor Throneburg teaches a weft-knitted textile element having first and second areas each having a different stitch configuration to impart varying properties to each area of the textile element. (*Id.*, p. 10). Applicants made similar arguments with respect to the claim rejections under 35 U.S.C. § 103. (*Id.*, p. 11-12). Applicants, however, did not challenge or otherwise address the Examiner's comments regarding the unpatentability of claiming a specific method by which an upper is knitted, particularly since numerous types of knitting

were well-known in the art.

With respect to the rejection of amended claim 65 based on Joha, Applicants argued that Joha did not disclose a first area having a first set of properties and a second area having a second set of properties different from the first set. (*Id.*, p. 10). With respect to the rejection of amended claim 65 based on Throneburg, Applicants argued that Throneburg did not disclose an upper having two different areas with each area having a different construction. (*Id.*).

The Examiner then allowed claims 1-6, 11-29, 31-46, 48, 49, and 65-67 (renumbered as claims 1-46). ('011 file history (Ex. 1003), 11/02/2007 Notice of Allowance). The Examiner responded to the Applicants' amendment and response by moving directly from a rejection of the pending claims under 35 U.S.C. § 102 to allowance.[1] Because the missing elements addressed in the Applicants' response are taught by several of the references of record (*see* Nishida (Ex. 1005), Glidden (Ex. 1007)), it appears that the Examiner may not have reconsidered the question of anticipation by other references of record or obviousness under 35 U.S.C. § 103 before deciding to allow the claims.

Applicants transmitted the issue fee payment on February 1, 2008, and the '011 patent issued on March 25, 2008. ('011 file history (Ex. 1003), 02/01/2008 Issue Fee

[1]The Examiner had rejected dependent claims 12, 25, and 36 under 35 U.S.C. § 103, but Applicants reiterated the arguments made with respect to the independent claims as amended to overcome this rejection.

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Applicants later filed a request for a Certificate of Correction, alleging a PTO mistake in the printing of claims 2, 8, and 23. ('011 file history (Ex. 1003), 01/13/2009 Request for Certificate of Correction). A Certificate of Correction issued February 17, 2009. ('011 file history (Ex. 1003), 02/17/2009 Certificate of Correction).

V. CLAIM CONSTRUCTIONS UNDER 37 C.F.R. § 42.104(b)(3)

A. Legal Overview

A claim subject to *inter partes* review ("IPR") is given its "broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b). This means that the words of the claim are given their plain meaning unless that meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). This Petition shows that the claims of the '011 patent are anticipated or rendered obvious by the prior art identified herein when the challenged claims are given their broadest reasonable interpretation in light of the specification. Petitioner submits, for the purposes of the IPR only, that the claim terms are presumed to take on their broadest reasonable interpretation in view of the specification of the '011 patent.[2]

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[2]Other forums, such as U.S. district courts, require different standards of proof and claim interpretation that are not applied by the PTO for *inter partes* review. Accordingly, any interpretation or construction of the challenged claims in this IPR, either implicitly or

B. Clarification of "A Single Type of Textile"

Claims 1, 24, and 36 recite that the textile element incorporates "a single type of textile." The '011 patent specification states that "textile element 40 is primarily formed from one or more yarns that are mechanically-manipulated through either an interweaving, intertwining and twisting, or interlooping process." ('011 patent (Ex. 1002), 6:51-54). The '011 patent specification further states: "Textile element 40 is a single material element that is formed to exhibit a unitary (i.e., one-piece) construction." (*Id.*, 5:38-39; *see also* 11:10-12). As such, a broadest reasonable interpretation of "a single type of textile" is a single material element that may include one or more yarns.

C. Clarification of "Weft-Knitted Textile Element" and "Flat-Knitted Textile Element"

Claims 1, 7-9, 14-16, 19-21, 23, 32, and 33 recite that the textile element is "weft-knitted" or has a "weft knitted" construction. Claim 44 states that the textile element is "flat-knitted." In the Office Action dated September 12, 2006, during prosecution of the application that led to the '011 patent, the Examiner noted that numerous types of knitting recited in the claims (*e.g.*, weft-knitted and flat-knitted) were well-known in the art. Thus, the Examiner did not deem particular claimed knitting techniques to distinguish the claimed invention from the prior art. The specification also explains that various knitting processes

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explicitly, is not binding on Petitioner in any future litigation related to the '011 patent. *See In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

may be used to manufacture the textile element, including without limitation weft-knitting, warp-knitting, circular knitting, and flat knitting. (*See* '011 patent (Ex. 1002), 6:66-7:10; 11:4-7; 11:19-41). The specification describes tricot, raschel, and double needle-bar raschel as specific sub-types of warp knitting. (*Id.*, 7:2-5). Similarly, circular knitting and flat knitting are described as sub-types of weft knitting. (*Id.*, 7:-10). The specification states that the textile element that forms the shoe upper may be formed through any of these knitting processes and does not express a preference or advantage for any one process over the others. (*Id.*, 7:11-14). Thus, it is reasonable to interpret these claim limitations as consistent with their ordinary meaning and as conventional, known knitting techniques.

D. Clarification of "Unitary Construction"

Claim 16 recites that the textile element has a first area and a second area with a "unitary construction." Claim 44 originally recited the same language. The specification states: "As defined for purposes of the present invention, unitary construction is intended to express a configuration wherein portions of a textile element are not joined together by seams or other connections, as depicted with textile element 40 in FIG. 8." ('011 patent (Ex. 1002), 6:41-46).

The Applicants later amended claim 44 to recite that the textile element has a first area with a first "unitary construction" and a second area with a second "unitary construction" different from the first "unitary construction." ('011 file history (Ex. 1003), 01/12/2007 Response, p. 8). In making this amendment, Applicants attempted to overcome

a prior art rejection based on Throneburg and stated in the remarks that "[a]lthough Throneburg teaches that the ball portion and heel portion of the footbed are 'thickened,' ***the construction of that knitting is not of a different construction than other areas of the upper.***" (*Id.*, p. 10, emphasis added).

Thus, according to the specification and claim 16, a broadest reasonable interpretation of "unitary construction" is a one-piece construction. The amendments to claim 44 and related arguments focused on the differences between the two different constructions, rather than the existence of two different ***unitary*** constructions, as different ***unitary*** constructions is inconsistent with the invention as described in the specification and claim 16. Based on the intrinsic evidence, a broadest reasonable interpretation of a "first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction," consistent with the teachings of the specification and arguments made during prosecution, is a unitary construction with two areas, each area having a different construction and set of properties in accordance with the additional language of claim 44.

VI. THERE IS A REASONABLE LIKELIHOOD THAT AT LEAST ONE CLAIM OF THE '011 PATENT IS UNPATENTABLE

As detailed in the claim charts below, through the various identified prior art references or arguments some of which were not before the Examiner during prosecution of the '011 patent and none of which were expressly considered by the Examiner, all limitations of claims 1-46 of the '011 patent were well-known in the prior art. Regarding

various combinations of prior art, the '011 patent claims merely recite the combination of "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." MPEP § 2143 (A, C).

As a preliminary matter, during the prosecution of the '011 patent, the Examiner pointed out – and the Applicant failed to argue otherwise – that certain recited features common to of all of the claims were well-known. For example, the prior art establishes that an upper incorporating a textile element, as well as knitted uppers generally, were well-known. The prior art also teaches that securing a sole structure to the upper was well-known. Likewise, as stated by the Examiner, numerous types of knitting (e.g., weft-knitted, flat-knitted, warp-knitted, or formed with a knitting machine) were well-known in the art. ('011 file history (Ex. 1003), at 09/12/2006 Office Action, pp. 2-3). Applicants did not challenge this assertion.

In addition, during the prosecution of the '011 patent, the Examiner pointed out – and the Applicant failed to argue otherwise – that other recited features of independent claims 1, 24, and 36 were well-known. For example, it was well-known that textile elements have edges joined together to define at least a portion of a void for receiving a foot (claims 1, 24), as was the idea of joining the edges together to form seams, the seams including a first seam and a second seam, the first seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper, and the second seam extending vertically

in the heel area (claim 24). Removing the textile element from a textile structure that includes an outline of the textile element was also a well-known technique. (claim 36).

A. "A Single Type of Textile Having a Plurality of Knit Constructions" in Claims 1-15 and 24-43

As discussed above, the Applicants amended independent claims 1, 24, and 36 to require that the textile element incorporate "a single type of textile having a plurality of knit constructions." ('011 file history (Ex. 1003), at 01/12/2007 Response, pp. 2, 5, and 7). The Applicants further relied on this element as the sole basis for distinguishing claims 1, 24, and 36 over the prior art of record. ('011 file history (Ex. 1003), at 01/12/2007 Response, pp. 9-12). Because the next action from the PTO was a Notice of Allowance, it appears that the Examiner relied on this ground as the reason for allowance of claims 1, 24, and 36.

Yet, several prior art references, which either were not before the Examiner or were not applied by the Examiner for this feature during prosecution, teach textile elements incorporating a single type of textile having a plurality of knit constructions as required by claims 1, 24, and 36. For example, Nishida (Ex. 1005) and Glidden (Ex. 1007) each disclose textile elements incorporating a single type of textile having a plurality of knit constructions. (Frederick Dec. (Ex. 1001), ¶¶ 67-72, 79-84). Specifically, Nishida states:

> In FIGS. 1 and 2, a web of material is identified by 1, and is produced by a conventional textile process, [for] example, by weaving and/or knitting and/or embroidering. The web of material 1 can be provided with a single or with a plurality of layouts 2 of the shape of a shoe upper 3, as it is represented from the side, for example, in FIG. 3. The web of material has a backing 4 that can

be a conventionally used material formed, for example, of a warp and filling or a knitted fabric. ***Layout 2 is divided into different individual parts or areas, which differ from one another, such as by being of another material style and/or by being of different fibers or yarns,*** for example, from wool, wool with metal yarns, silk, silk with metal yarns, wool with plastic fibers or the like and/or by being formed of different colors, such as from fibers or yarns of different colors, including those of metals, or by different color prints, ***and/or by being differently designed fiber extrudates or fiber extrudate compositions, such as twisted, processed parallel or the like.***

(Nishida (Ex. 1005), 3:6-26 (emphasis added)).

Glidden, which dates to 1939, describes:

> In fabricating the unitary upper, as by knitting, areas thereof which are normally subjected to greater wear and ***in which a lower degree of elasticity is desired, such as the toe 11 and the heel portion 12, may be more densely fabricated to provide therein heavier weight and less extensibility than in the other parts of the upper, as by changing the type of stitch or amount [of] thickness of the yarn in the knitting.*** Other areas, such as the ankle portion 13, are preferably made so as to provide softness and elasticity, as by making them of ribbed construction, as shown.

(Glidden (Ex. 1007), p. 1, 2:33-44 (emphasis added)).

At least a third prior art reference, Osamu (Ex. 1006), teaches this same concept for a woven textile element: "For each shoe location, the appropriate weave structure is used. For example, ***toe cap 10 is formed of a weave structure of high yarn count and density, and upper surface 11 is formed of a weave structure with high breathability.***"

(Osamu (Ex. 1006), [0009] (emphasis added)).

As demonstrated by the foregoing exemplary excerpts from selected references, the use of textile elements incorporating a single type of textile having a plurality of knit constructions was well-known in the art at the time of the priority date of the '011 patent. These references also show that the use of a single type of textile having a plurality of knit constructions was well-known as a way to provide different properties to a knitted textile for decades. (Frederick Dec. (Ex. 1001), ¶¶ 72, 84).

As set forth in the claim charts below, Nishida, Glidden, and Osamu anticipate or, at the very least, render obvious claims 1-15 and 24-43 of the '011 patent, alone or in combination with other prior art. The '011 patent claims merely recite the combination of "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See* MPEP § 2143 (A, C). For example, a person of ordinary skill in the art would have understood that using a single type of textile having a plurality of knit constructions was well-known in the textile industry. (Frederick Dec. (Ex. 1001), ¶¶ 37-65, 67-72, 79-84). This concept is clearly shown in the prior art. With regard to the other recited elements in claims 1, 24, and 36, it is undisputed the prior art discloses the combination of these features in uppers for an article of footwear.

Moreover, one of ordinary skill in the art would have understood and expected the benefits of using a single type of textile having a plurality of knit constructions for an upper –

that is, that a single type of textile having a plurality of knit constructions would provide the advantages of different properties in the shoe upper, such as breathability and elasticity, while increasing the efficiency of the manufacturing process. ('011 patent (Ex. 1002), 2:62-3:16; 11:12-18). Specifically, each of Nishida, Glidden, McDonald, Whiting, and Shiomura teach the construction of and/or process for constructing a knitted shoe upper. These references explicitly show that since at least the late 1930's it was desirable and known to "provide comfort, stretchability, light weight, breathability and absorption properties in an article of footwear and to provide for economy of materials and convenience of procedure in the manufacture of the same."(Glidden (Ex. 1007), p. 1, 1:25-30). *See also:*

- "My invention is a shoe comprising a circular-knit fabric sock having a stretchable elastic welt..." (McDonald (Ex. 1008), p. 1, 1:1-2);
- "the production of such a shoe upper is nevertheless possible in an efficient and economical way" (Nishida (Ex. 1005), 1:45-47); "designed to be relatively deformably soft or elastic....has a good air exchange capability" (*Id.*, 3:43-51);
- "[Objective] To develop uppers material for shoes indispensable to manufacturing methods that increase the economic efficiency of production by reducing the quantity of uppers materials for shoes as much as possible thus simplifying the stitching process" (Osamu (Ex. 1006), p. 1); "[f]or each shoe location, the appropriate weave structure is used... and upper structure

11 is formed of a weave structure with high breathability" (*Id.*, p. 4);

- "...the resultant uppers are form-retaining and yet are elastic..." (Whiting (Ex. 1009), 1:40-41).
- "An object of the present invention is to provide a shoe... of which the shoe upper has a combination of suitable elasticity with high air permeability." (Shiomura (Ex. 1011), 1:38-41).

The common teachings of these prior art references show that it would have been obvious for a person of ordinary skill in the art to combine their teachings in designing a knitted shoe upper to achieve the claimed features of the '011 patent. Thus, claims 1-15 and 24-43 of the '011 patent are not patentable in view of the above-noted references considered individually or in combination.

'011 Patent Claims	Description of Prior Art
1. An article of footwear comprising:	Grounds 1-3; 7; 12: **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 15-17: **Glidden** discloses an article of footwear. Frederick Dec. at ¶ 84; *see also* Glidden at Title; p. 1, 1:1-4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91; *see also* Osamu at Title; [0001]; [0007].
an upper incorporating a weft-knitted textile element having edges that are joined together to define at least a portion of a void for receiving a foot,	Grounds 1-2: **Nishida** discloses an upper incorporating a knit textile element having edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-12; 3:31-42; FIGS. 2-3. A person of ordinary skill in the art ("POSITA") at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include weft knitting. Frederick Dec. at ¶ 72.

	Grounds 3; 7; 12: **Nishida** discloses an upper incorporating a knit textile element having edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-12; 3:31-42; FIGS. 2-3. Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate weft-knitted textile elements as disclosed by McDonald, Whiting, or Curley into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 15: **Glidden** discloses an upper incorporating a knit textile element that defines at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-10, 2:45-48; FIGS. 1, 6, 8. A POSITA at the time of the priority date of the '011 patent would have understood from Glidden describes circular knitting, which has been used for making socks for many decades. Frederick Dec. at ¶ 84. Grounds 16-17: **Glidden** discloses an upper incorporating a knit textile element that defines at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-10; p. 1, 2:45-48; FIGS. 1, 6, 8. Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56. It would have been obvious at the time of the priority date of the '011 patent to incorporate weft-knitted textile elements as disclosed by McDonald or Whiting into Glidden's upper. Frederick Dec. at ¶ 84. *See* MPEP § 2143(A), (C). Ground 18: **Osamu** discloses an upper incorporating a textile element having edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]; [0009]; [0010]; [0011]; FIGS. 1, 3. Osamu describes a woven textile element, rather than a weft-knitted textile element. A POSITA at the time of the priority date of the '011 patent would have understood that woven and knitted textiles are both suitable for use in uppers and the selection of

	one versus the other is an obvious design choice. Frederick Dec. at ¶ 91. Grounds 19; 24; 29; 35; 38: **Osamu** discloses an upper incorporating a textile element having edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]; [0009]; [0010]; [0011]; FIGS. 1, 3. Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 1:61-62; 1:67-68; 2:42-45; 3:6-10; 3:45-52; 3;66-68; 5:63-6:2; 6:23-25; Curley at p. 7, lines 32-33; p. 8, lines 7-9; p. 16, lines 5-8. Additionally, Glidden, McDonald, Whiting, and Curley each disclose an upper incorporating a weft-knitted textile element. *See* Glidden at p. 1, 2:45-48; FIGS. 1, 6, 8; McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate a weft-knitted textile as disclosed by Nishida, Curley, Glidden, McDonald, or Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
wherein the weft-knitted textile element incorporates a single type of textile having a plurality of knit constructions; and	Grounds 1-3; 7; 12: **Nishida** discloses that the knit textile element may be a single textile element having a plurality of knit constructions. Frederick Dec. at ¶ 72; *see also* Nishida at 3:15-4:18; 4:47-60; 5:41-45; 5:63-6:2; 6:4-41. Grounds 15-17: **Glidden** discloses that the knit textile element may be a single textile element having a plurality of knit constructions. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:33-44; FIG. 1. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element may be a single textile element having a plurality of constructions. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]; [0012]; claim 1.
a sole structure secured to the upper.	Grounds 1-3; 7; 12: **Nishida** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 15-17: **Glidden** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 2, 1:9-19,

	2:8-15, 2:23-30; FIGS. 1, 6. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001], [0007], [0013], [0015].
2. The article of footwear recited in claim 1, wherein the weft-knitted textile element forms at least a portion of a lateral side, a medial side, and an instep region of the upper.	Grounds 1-3; 7; 12: **Nishida** discloses that the knit textile element may form at least a portion of a lateral side, a medial side, and an instep region of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:15-4:46; FIGS. 1-5. Grounds 15-17: **Glidden** discloses that the knit textile element may form at least a portion of a lateral side, a medial side, and an instep region of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-10; FIGS. 1-3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element may form at least a portion of a lateral side, a medial side, and an instep region of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]-[0010]; FIGS. 1, 3.
3. The article of footwear recited in claim 1, wherein the edges include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper.	Grounds 1-3; 7; 12: **Nishida** discloses that edges of the knit textile element may include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 5:3-13; FIG. 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that edges of the textile element may include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]; FIG. 1.
4. The article of footwear recited in claim 3, wherein the edges include a pair of second edges that are joined to form a second seam extending along a heel region of the upper.	Grounds 1-3; 7; 12: **Nishida** discloses that edges of the knit textile element may also include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:31-36; 4:9-11; FIGS. 2, 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that edges of the textile element may also include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0010]; FIGS. 1, 3.

5. The article of footwear recited in claim 4, wherein the second seam extends vertically.	Grounds 1-3; 7; 12: **Nishida** discloses that the second seam extends vertically. Frederick Dec. at ¶ 72; *see also* Nishida at 3:31-36; 4:9-11; FIGS. 2-4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the second seam extends vertically. Frederick Dec. at ¶ 91; *see also* Osamu at [0010]; FIGS. 1, 3.
6. The article of footwear recited in claim 4, wherein the edges include at least a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper.	Grounds 1-3; 7; 12: **Nishida** discloses that edges of the knit textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 4:19-30; FIG. 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that edges of the textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at FIG. 1.
7. The article of footwear recited in claim 1, wherein the weft-knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	Grounds 1-3; 7; 12: **Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:66-4:1; FIG. 3. Grounds 15-17: **Glidden** discloses that the knit textile element may at least be an exterior layer of the upper (*see* FIG. 1) and/or an interior layer of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:68-74; FIGS. 1-3, 6-8. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
8. The article of footwear recited in claim 1, wherein the upper includes an exterior layer, an intermediate layer, and an interior layer, and the weft-knitted textile element	Grounds 1-2: **Nishida** discloses that the upper may include two or more layers, and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:62-4:1. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's use of two or more layers to include three layers, and that the knit textile element and/or knitted backing layer of the textile element forms a

forms at least a portion of the interior layer.	portion of the interior layer. Frederick Dec. at ¶ 72. Grounds 4-5; 8-9; 12-13: **Nishida** discloses that the upper may include two or more layers, and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:62-4:1. Uppers incorporating three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. It would have been obvious at the time of the priority date of the '011 patent to incorporate three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer as disclosed by Curley or Shiomura into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the knit textile element may at least be an exterior layer of the upper and/or an interior layer of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:9-19; p. 2, 1:68-74; FIGS. 1-2. Ground 18: **Osamu** discloses that the upper may include two or more layers, and the textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0006]; [0010]; claim 1. A POSITA at the time of the priority date of the '011 patent would have understood Osamu's use of two or more layers to include three layers, and that the textile element forms a portion of the interior layer. Frederick Dec. at ¶ 91. Grounds 20-21; 25-26; 30-31; 36-38: **Osamu** discloses that the upper may include two or more layers, and the textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0006]; [0010]; claim 1. Uppers incorporating three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. It would have been obvious at the time of the priority date of the '011 patent to incorporate three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer as

	disclosed by Curley or Shiomura into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
9. The article of footwear recited in claim 1, wherein the weft-knitted textile element forms at least a portion of both an interior surface and an exterior surface of the upper.	Grounds 1-2: **Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-4:46; FIG. 3. A POSITA at the time of the priority date of the '011 patent would have understood that Nishida's knit textile element and/or knit backing layer may form at least a portion of the interior and exterior surfaces of the upper. Frederick Dec. at ¶ 72. Grounds 4-6; 8-10; 12-14: **Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-4:46; FIG. 3. Uppers having a knit textile element that forms a portion of an interior surface and an exterior surface were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45; Glidden at FIGS. 1-2, p. 1, 2:3-32. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knitted upper where the knitted material forms a portion of both interior and exterior surfaces of the upper as disclosed by Curley, Shiomura, or Glidden into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the knit textile element forms at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:68-74; FIGS. 1-3, 6-8. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
10. The article of footwear recited in claim 9, wherein at least one additional element is	Grounds 1-3; 7; 12: **Nishida** discloses that elements such as toe caps or heel counters may be secured to the exterior surface of the upper and may form a portion of the exterior surface of the upper.

secured to the exterior surface and forms a portion of the exterior surface.	Frederick Dec. at ¶ 72; *see also* Nishida at 2:37-47; 3:37-42; 3:53-58; 4:9-11; FIG. 3. Grounds 15-17: **Glidden** discloses that counters, heel reinforcements, blucher saddle, toe caps, and heel straps may be secured to the exterior surface of the upper and may form a portion of the exterior surface of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 2, 1:9-19, 1:50-55, 1:64-74, 2:24-26; FIGS. 1-8. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that other elements may be secured to the exterior surface of the upper and may form a portion of the exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0006].
11. The article of footwear recited in claim 10, wherein the additional element is secured to a forefoot area of the upper.	Grounds 1-3; 7; 11: **Nishida** discloses that a toe cap may be secured to a forefoot area of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:37-42. Grounds 15-17: **Glidden** discloses that a toe cap may be secured to a forefoot area of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 2, 2:24-26; FIGS. 6, 8. Ground 18: **Osamu** discloses that other elements may be secured to the exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0006]. A POSITA at the time of the priority date of the '011 patent would have understood that such additional elements may be secured to a forefoot area of the upper. Frederick Dec. at ¶ 91. Grounds 22-23; 27-29; 35: **Osamu** discloses that other elements may be secured to the exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0006]. The incorporation of additional features onto a forefoot area of an upper were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 3:37-42; Glidden at p. 2, 2:24-26; FIGS. 6, 8. It would have been obvious at the time of the priority date of the '011 patent to incorporate an additional element secured to a forefoot area of the upper as disclosed by Nishida or Glidden into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
12. The article of	Grounds 1-3; 7; 11:

footwear recited in claim 10, wherein the additional element is secured to a heel area of the upper.	**Nishida** discloses that a heel counter may be secured to the heel area of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 4:9-11. Grounds 15-17: **Glidden** discloses that a heel counter or heel reinforcement may be secured to the heel area of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 2, 1:9-19, 2:24-26; FIGS. 1-6. Ground 18: **Osamu** discloses that other elements may be secured to the exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0006]. A POSITA at the time of the priority date of the '011 patent would have understood that such additional elements may be secured to a heel area of the upper. Frederick Dec. at ¶ 91. Grounds 22-23; 27-29; 35: **Osamu** discloses that other elements may be secured to the exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0006]. The incorporation of additional features onto a heel area of an upper were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 4:9-11; FIG. 3; Glidden at p. 2, 1:9-19, 2:24-26; FIGS. 1-6. It would have been obvious at the time of the priority date of the '011 patent to incorporate an additional element secured to a heel area of the upper as disclosed by Nishida or Glidden into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
13. The article of footwear recited in claim 1, wherein the textile element forms an interior surface of the upper.	Grounds 1-2: **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-46. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's knit textile element and/or knitted backing layer may form an interior surface of the upper. Frederick Dec. at ¶ 72. Grounds 4-6; 8-10; 12-14: **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-46. Uppers incorporating knit textile elements that form an interior surface of the upper were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; Shiomura at 2:26-45; Glidden at FIGS. 1-2, p. 1, 2:3-32. It would have been obvious at the

	time of the priority date of the '011 patent to incorporate a knit textile element that forms an interior surface of the upper as disclosed by Curley, Shiomura, or Glidden into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the knit textile element forms an interior surface of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:68-74; FIGS. 1-3, 6-8. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element forms an interior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
14. The article of footwear recited in claim 1, wherein the weft-knitted textile element is created by circular knitting.	Grounds 1-2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include circular knitting. Frederick Dec. at ¶ 72. Grounds 3; 7: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. Uppers incorporating textile elements formed by circular knitting were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56. It would have been obvious at the time of the priority date of the '011 patent to incorporate circular-knitted textile elements as disclosed by McDonald or Whiting into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 15: **Glidden** describes fabricating a unitary knitted upper as a shaped, "sock-like" article. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-10, 2:45-48; FIGS. 1, 6, 8. A POSITA at the time of the priority date of the '011 patent would have understood that Glidden is describing a weft-knitted textile element, and that fabrication of this element would have utilized circular knitting, which has been used for making socks for many decades. Frederick Dec. at ¶ 84. Grounds 16-17: **Glidden** describes fabricating a unitary knitted upper as a shaped, "sock-like" article. Frederick Dec. at ¶ 84; *see also*

	Glidden at p. 1, 2:3-10, 2:45-48; FIGS. 1, 6, 8. Uppers incorporating textile elements formed by circular knitting were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56. It would have been obvious at the time of the priority date of the '011 patent to incorporate circular-knitted textile elements as disclosed by McDonald or Whiting into Glidden's upper. Frederick Dec. at ¶ 84. *See* MPEP § 2143(A), (C). Ground 18: As described above for claim 1, a POSITA at the time of the priority date of the '011 patent would have understood that the selection of circular knitting, a sub-type of weft knitting, is an obvious design choice or a selection from among a finite number of weft knitting techniques. Frederick Dec. at ¶ 91. Grounds 19; 24; 33; 34: Uppers incorporating textile elements formed by circular knitting, a sub-type of weft knitting, were well-known in the art at the time of the priority date of the '011 patent. *See* Whiting at 2:39-56; McDonald, at p. 1, 2:26-39. It would have been obvious at the time of the priority date of the '011 patent to incorporate circular-knitted textile elements as disclosed by McDonald or Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
15. The article of footwear recited in claim 1, wherein the weft-knitted textile element is created by flat knitting.	Grounds 1-2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include flat knitting. Frederick Dec. at ¶ 72. Ground 7: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. Uppers incorporating textile elements formed by flat knitting were well-known in the art at the time of the priority date of the '011 patent. *See* Whiting at 2:39-56. It would have been obvious at the time of the priority date of the '011 patent to incorporate flat-knitted textile elements as disclosed by Whiting into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 18:

	As described above for claim 1, a POSITA at the time of the priority date of the '011 patent would have understood that the selection of flat knitting, a sub-type of weft knitting, is an obvious design choice or a selection from among a finite number of weft knitting techniques. Frederick Dec. at ¶ 91. Ground 24; 34: Uppers incorporating textile elements formed by flat knitting, a sub-type of weft knitting, were well-known in the art at the time of the priority date of the '011 patent. *See* Whiting at 2:39-56. It would have been obvious at the time of the priority date of the '011 patent to incorporate flat-knitted textile elements as disclosed by Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
24. An article of footwear comprising:	Grounds 1-2: **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91; *see also* Osamu at Title; [0001]; [0007].
an upper incorporating a textile element having edges that are joined together to form seams and define at least a portion of a void for receiving a foot,	Grounds 1-2: **Nishida** discloses an upper incorporating a textile element having edges that are joined together to form seams and define at least a portion of a void for receiving a foot Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 3:6-12; 3:31-42; FIGS. 2-3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses an upper incorporating a textile element having edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]; [0009]; [0010]; FIGS. 1, 3.
the seams including a first seam and a second seam, the first seam extending from a heel area to a forefoot area of the footwear along a lower surface of the upper, and the second seam extending vertically in the heel area,	Grounds 1-2: **Nishida** discloses that the seams include a first seam that extends from a heel area to a forefoot area of the footwear along a lower surface of the upper and a second seam that extends vertically in the heel area. Frederick Dec. at ¶ 72; *see also* Nishida at 3:31-36; 4:9-11; 5:3-13; FIGS. 2, 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the seams include a first seam that extends from a heel area to a forefoot area of the footwear along a lower surface of the upper and a second seam that extends vertically in the heel area. Frederick Dec. at ¶ 91; *see also*

	Osamu at [0007]; [0010]; FIGS. 1, 3.
wherein the textile element incorporates a single type of textile having a plurality of knit constructions; and	Grounds 1-2: **Nishida** discloses that the textile element may be a single textile element having a plurality of knit constructions. Frederick Dec. at ¶ 72; *see also* Nishida at 3:15-4:18; 4:47-60; 5:41-45; 5:63-6:2; 6:4-41. Ground 18: **Osamu** discloses that the textile element may be a single textile element having a plurality of constructions. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]; [0012]; claim 1. Osamu describes a woven textile element with a plurality of weave structures, rather than a knitted textile element with a plurality of knit constructions. A POSITA at the time of the priority date of the '011 patent would have understood that woven and knitted textiles are both suitable for use in uppers and the selection of one versus the other is an obvious design choice. Frederick Dec. at ¶ 91. Grounds 19; 24; 29; 35; 38: **Osamu** discloses that the textile element may be a single textile element having a plurality of constructions. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]; [0012]; claim 1. Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 1:61-62; 1:67-68; 2:42-45; 3:6-10; 3:45-52; 3;66-68; 5:63-6:2; 6:23-25; Curley at p. 7, lines 32-33; p. 8, lines 7-9; p. 16, lines 5-8. Additionally, McDonald, Whiting, and Curley each disclose an upper incorporating a weft-knitted textile element. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knitted textile as disclosed by Nishida, Curley, Glidden, McDonald, or Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
a sole structure secured to the upper.	Grounds 1-2: **Nishida** discloses that a sole structure may be secured to the upper Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001], [0007],

	[0013], [0015].
25. The article of footwear recited in claim 24, wherein the footwear includes a third seam extending through the forefoot area of the upper.	Grounds 1-2: **Nishida** discloses that the footwear includes a third seam that extends through a forefoot area of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 4:19-30; FIG. 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the footwear includes a third seam that extends through a forefoot area of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at FIG. 1.
26. The article of footwear recited in claim 24, wherein at least one of the knit constructions forms an aperture in the textile element.	Grounds 1-2: **Nishida** discloses that at least one knit construction may form a net-like structure (i.e. having apertures) in the textile element. Frederick Dec. at ¶ 72; *see also* Nishida at 3:43-52. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses at least one configuration may form a weave structure with high breathability (i.e. having apertures) in the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0009].
27. The article of footwear recited in claim 24, wherein the knit constructions produce varying properties in the textile element including a varying elasticity of the textile element.	Grounds 1-2: **Nishida** discloses that the knit constructions may produce varying elasticity of the textile element. Frederick Dec. at ¶ 72; *see also* Nishida at 2:26-37; 3:43-52; 6:16-31. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the knit constructions may produce varying elasticity of the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0008]; [0009].
28. The article of footwear recited in claim 24, wherein the knit constructions produce varying properties in the textile element including a varying air permeability of the textile element.	Grounds 1-2: **Nishida** discloses that the knit constructions may produce a varying air permeability of the textile element. Frederick Dec. at ¶ 72; *see also* Nishida at 3:43-52; 6:16-31. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the constructions may produce a varying air permeability of the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0009].
29. The article of footwear recited in claim 24, wherein the textile element is one of an exterior layer, an intermediate layer, and	Grounds 1-2: **Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:66-4:1; FIG. 3. Grounds 18-19; 24; 29; 35; 38:

an interior layer of the upper.	**Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
30. The article of footwear recited in claim 24, wherein the textile element forms at least a portion of both an interior surface and an exterior surface of the upper.	Grounds 1-2: **Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-4:46; FIG. 3. A POSITA at the time of the priority date of the '011 patent would have understood that Nishida's knit textile element and/or knit backing layer may form at least a portion of the interior and exterior surfaces of the upper. Frederick Dec. at ¶ 72. Grounds 12-14: **Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-4:46; FIG. 3. Uppers having a knit textile element that forms a portion of an interior surface and an exterior surface were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45; Glidden at FIGS. 1-2, p. 1, 2:3-32. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knitted upper where the knitted material forms a portion of both interior and exterior surfaces of the upper as disclosed by Curley, Shiomura, or Glidden into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
31. The article of footwear recited in claim 24, wherein the textile element forms an interior surface of the footwear, and at least one additional layer forms an	Grounds 1-2: **Nishida** discloses that the upper may include two or more layers, and that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 2:37-39; 3:6-46; 4:9-11. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's knit textile element and/or knitted backing layer may form an interior

exterior surface of the footwear.	surface of the upper, and one additional layer may form an exterior surface. Frederick Dec. at ¶ 72. Grounds 12-14: **Nishida** discloses that the upper may include two or more layers, and that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 2:37-39; 3:6-46; 4:9-11. Uppers incorporating knit textile elements that form an interior surface of the footwear and have at least one additional layer forming an exterior surface were well-known in the art at the time of the priority date of the '011 patent.*See* Curley at p. 6, lines 30-32; p. 30, claim 34; Shiomura at 2:20-35; FIG. 1; Glidden at p. 2, 1:9-19, 1:68-74; FIGS. 1, 6, 8. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knit textile element that forms an interior surface, along with an additional layer forming an exterior surface, as disclosed by Curley, Shiomura, or Glidden into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element forms an interior surface of the footwear and at least one additional layer forms an exterior surface of the footwear. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0006]; [0010]; claim 1.
32. The article of footwear recited in claim 24, wherein at least a portion of the textile element has a weft knitted construction.	Grounds 1-2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include weft knitting. Frederick Dec. at ¶ 72. Grounds 3, 7, 12: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate weft-knitted textile elements as disclosed by McDonald, Whiting, or Curley into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C).

	Ground 18: As described above for claim 24, a POSITA at the time of the priority date of the '011 patent would have understood that woven and knitted textiles are both suitable for use in uppers and the selection of one versus the other is an obvious design choice. Frederick Dec. at ¶ 91. Grounds 19; 24; 29; 35; 38: Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 1:61-62; 1:67-68; 2:42-45; 3:6-10; 3:45-52; 3;66-68; 5:63-6:2; 6:23-25; Curley at p. 7, lines 32-33; p. 8, lines 7-9; p. 16, lines 5-8. Additionally, Glidden, McDonald, Whiting, and Curley discloses an upper incorporating a weft-knitted textile element. *See* Glidden at p. 1, 2:3-10; p. 1, 2:45-48; FIGS. 1, 6, 8; McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate a weft-knitted textile as disclosed by Nishida, Curley, Glidden, McDonald, or Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
33. The article of footwear recited in claim 32, wherein the weft knitted construction is produced by one of circular knitting and flat knitting.	Ground 1-2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include circular knitting and/or flat knitting. Frederick Dec. at ¶ 72. Grounds 3; 7: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. Uppers incorporating textile elements formed by circular knitting and/or flat knitting, both sub-types of weft knitting, were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56. It would have been obvious at the time of the priority date of the '011 patent to incorporate circular knitted and/or flat knitted textile elements as disclosed by McDonald or Whiting into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 18: As described above for claim 24, a POSITA at the time of the

	priority date of the '011 patent would have understood that the selection of circular knitting and/or flat knitting, both sub-types of weft knitting, is an obvious design choice or a selection from among a finite number of weft knitting techniques. Frederick Dec. at ¶ 91. Grounds 19; 24; 33-34: Uppers incorporating textile elements formed by circular knitting and/or flat knitting, both sub-types of weft knitting, were well-known in the art at the time of the priority date of the '011 patent. *See* Whiting at 2:39-56; McDonald, at p. 1, 2:26-39. It would have been obvious at the time of the priority date of the '011 patent to incorporate circular knitted and/or flat knitted textile elements as disclosed by McDonald or Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
34. The article of footwear recited in claim 24, wherein the textile element has a warp knitted construction.	Grounds 1-2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include warp knitting. Frederick Dec. at ¶ 72. Grounds 12-13: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. Uppers incorporating textile elements formed by warp knitting were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 7, lines 31-32; Shiomura at 3:4-43. It would have been obvious at the time of the priority date of the '011 patent to incorporate warp-knitted textile elements as disclosed by Curley or Shiomura into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 18: As described above for claim 24, a POSITA at the time of the priority date of the '011 patent would have understood that the selection of warp knitting is an obvious design choice or a selection from among a finite number of weft knitting techniques. Frederick Dec. at ¶ 91. Grounds 20-21; 23; 25-26; 28-29; 36-38: Uppers incorporating textile elements formed by warp knitting were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 7, lines 31-32; Shiomura at 3:4-43.

	It would have been obvious at the time of the priority date of the '011 patent to incorporate warp-knitted textile elements as disclosed by Curley or Shiomura into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
35. The article of footwear recited in claim 34, wherein the warp knitted construction is produced by a jacquard double needle-bar raschel.	Ground 2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include the use of jacquard double needle-bar raschel. Frederick Dec. at ¶ 72. Ground 13: **Nishida** discloses that a knitted textile element may be formed with a knitting machine. Frederick Dec. at ¶ 72; *see also* Nishida at 2:40-47; 4:12-18; 4:47-60; 5:63-6:2. Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel were well-known in the art at the time of the priority date of the '011 patent. *See* Shiomura at 3:4-43; FIG. 5. It would have been obvious at the time of the priority date of the '011 patent to incorporate textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel as disclosed by Shiomura into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 18: **Osamu** describes a Jacquard woven textile element, which may be formed by a weaving machine. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0012]; [0014]. As described above for claim 24, a POSITA at the time of the priority date of the '011 patent would have understood that the selection of jacquard double needle-bar raschel, a sub-type of warp knitting, is an obvious design choice or a selection from among a finite number of warp knitting techniques. Frederick Dec. at ¶ 91. Grounds 21; 26; 31; 37; 39: **Osamu** describes a Jacquard woven textile element, which may be formed by a weaving machine. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0012]; [0014]. Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel were well-known in the art at the time of the priority date of the '011 patent.

	See Shiomura at 3:4-43. It would have been obvious at the time of the priority date of the '011 patent to incorporate textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel as disclosed by Shiomura into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
36. An article of footwear comprising:	Grounds 1-2: **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91; *see also* Osamu at Title; [0001]; [0007].
an upper incorporating a knitted textile element formed with a knitting machine, the textile element being removed from a textile structure that includes an outline of the textile element, and	Grounds 1-2: **Nishida** discloses an upper incorporating a knitted textile element that may be formed with a knitting machine, where the textile element is removed from a textile structure that includes an outline of the textile element. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 1:48-2:47; 3:6-12; 4:12-18; 4:31-42; 4:47-55; 5:63-6:2; 6:32-35; FIG. 2. Ground 18: **Osamu** discloses an upper incorporating a textile element that may be formed with a weaving machine, where the textile element is removed from a textile structure that includes an outline of the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]-[0009]; [0012]; [0014]; FIG. 1. Osamu describes a woven textile element, rather than a knitted textile element. A POSITA at the time of the priority date of the '011 patent would have understood that woven and knitted textiles are both suitable for use in uppers and the selection of one versus the other is an obvious design choice. Frederick Dec. at ¶ 91. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses an upper incorporating a textile element that may be formed with a weaving machine, where the textile element is removed from a textile structure that includes an outline of the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]-[0009]; [0012]; [0014]. Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 1:61-62; 1:67-68; 2:42-45; 3:6-10; 3:45-52; 3;66-

	68; 5:63-6:2; 6:23-25; Curley at p. 7, lines 32-33; p. 8, lines 7-9; p. 16, lines 5-8. Additionally, Glidden, McDonald, Whiting, and Curley each disclose an upper incorporating a weft-knitted textile element. *See* Glidden at p. 1, 2:45-48; FIGS. 1, 6, 8; McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knitted textile as disclosed by Nishida, Curley, Glidden, McDonald, or Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
the textile element having edges that are joined together to define at least a portion of a void for receiving a foot,	Grounds 1-2: **Nishida** discloses that the knitted textile element may have edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 3:6-12; 3:31-42; FIGS. 2-3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element may have edges that are joined together to define at least a portion of a void for receiving a foot. Frederick Dec. at ¶ 91; *see also* Osamu at [0009]; [0010]; FIGS. 1, 3.
wherein the textile element incorporates a single type of textile having a plurality of knit constructions; and	Grounds 1-2: **Nishida** discloses that the knitted textile element may be a single textile element having a plurality of knit constructions Frederick Dec. at ¶ 72; *see also* Nishida at 3:15-4:18; 4:47-60; 5:41-45; 5:63-6:2; 6:4-41. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element may be a single textile element having a plurality of constructions. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]; [0012]; claim 1.
a sole structure secured to the upper.	Grounds 1-2: **Nishida** discloses that a sole structure may be secured to the upper Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001], [0007], [0013], [0015].
37. The article of footwear recited in claim 36, wherein the knitted	Ground 2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A

textile element has a structure formed by a wide-tube circular knitting machine.	POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include wide-tube circular knitting machines. Frederick Dec. at ¶ 72. Ground 3: **Nishida** discloses that a knitted textile element may be formed with a knitting machine. Frederick Dec. at ¶ 72; *see also* Nishida at 2:40-47; 4:12-18; 4:47-60; 5:63-6:2. Uppers incorporating textile elements formed by a wide-tube circular knitting machine were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-30. It would have been obvious at the time of the priority date of the '011 patent to incorporate textile elements formed by a wide-tube circular knitting machine as disclosed by McDonald into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 18: **Osamu** discloses that a woven textile element may be formed by a weaving machine. Frederick Dec. at ¶ 91; *see also* Osamu at [0012]; [0014]. As described above for claim 36, a POSITA at the time of the priority date of the '011 patent would have understood that the selection wide-tube circular knitting machine, a sub-type of weft knitting, is an obvious design choice or a selection from among a finite number of weft knitting techniques. Frederick Dec. at ¶ 91. Ground 19; 33: **Osamu** discloses that a woven textile element may be formed by a weaving machine. Frederick Dec. at ¶ 91; *see also* Osamu at [0012]; [0014]. Uppers incorporating textile elements formed by a wide-tube circular knitting machine were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-30. It would have been obvious at the time of the priority date of the '011 patent to incorporate textile elements formed by a wide-tube circular knitting machine as disclosed by McDonald into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
38. The article of footwear recited in claim 36, wherein the knitted textile element has a structure formed by a	Ground 2: **Nishida** discloses the use of "conventional" knitting processes to form the textile element of the upper. Frederick Dec. at ¶ 72. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to

jacquard double needle-bar raschel knitting machine.	include the use of jacquard double needle-bar raschel knitting machines. Frederick Dec. at ¶ 72. Ground 13: **Nishida** discloses that a knitted textile element may be formed with a knitting machine. Frederick Dec. at ¶ 72; *see also* Nishida at 2:40-45; 4:15-19. Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel knitting machine were well-known in the art at the time of the priority date of the '011 patent. *See* Shiomura at 3:4-43. It would have been obvious at the time of the priority date of the '011 patent to incorporate textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel knitting machine as disclosed by Shiomura into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 18; 21; 26; 31; 37; 39: **Osamu** describes a Jacquard woven textile element, which may be formed by a weaving machine. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0012]; [0014]. Uppers incorporating textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel knitting machine were well-known in the art at the time of the priority date of the '011 patent. *See* Shiomura at 3:4-43. It would have been obvious at the time of the priority date of the '011 patent to incorporate textile elements formed by warp knitted construction and produced by a jacquard double needle-bar raschel as disclosed by Shiomura into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
39. The article of footwear recited in claim 36, wherein the edges include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper.	Grounds 1-2: **Nishida** discloses that edges of the knit textile element may include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 5:3-13; FIG. 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that edges of the textile element may include a pair of first edges that are joined to form a first seam extending longitudinally along a lower region of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]; FIG. 1.
40. The article of footwear recited in claim	Grounds 1-2: **Nishida** discloses that edges of the knit textile element may also

39, wherein the edges include a pair of second edges that are joined to form a second seam extending along a heel region of the upper.	include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:31-36; 4:9-11; FIGS. 2, 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that edges of the textile element may also include a pair of second edges that are joined to form a second seam extending along a heel region of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0010]; FIGS. 1, 3.
41. The article of footwear recited in claim 40, wherein the edges include at least a pair of third edges that are joined to form a second [third?] seam extending through a forefoot area of the upper.	Grounds 1-2: **Nishida** discloses that edges of the knit textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 4:19-30; FIG. 4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that edges of the textile element may also include a pair of third edges that are joined to form a third seam extending through a forefoot area of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at FIG. 1.
42. The article of footwear recited in claim 36, wherein the knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	Grounds 1-2: **Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:66-4:1; FIG. 3. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
43. The article of footwear recited in claim 36, wherein the knitted textile element forms an interior surface of the upper.	Grounds 1-2: **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-46. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's knit textile element and/or knitted backing layer may form an interior surface of the upper. Frederick Dec. at ¶ 72. Grounds 12-14: **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-46. Uppers incorporating knit textile elements that form an interior surface of the upper were well-known in the art

	at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; Shiomura at 2:26-45; Glidden at FIGS. 1-2, p. 1, 2:3-32. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knit textile element that forms an interior surface of the upper as disclosed by Curley, Shiomura, or Glidden into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the knit textile element forms an interior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.

B. "Textile Element Having A First Area And A Second Area With A Unitary Construction, The First Area Being Formed Of A First Stitch Configuration, And The Second Area Being Formed Of A Second Stitch Configuration That Is Different From The First Stitch Configuration To Impart Varying Properties To The Textile Element" in Claims 16-23

As discussed above, the Applicants argued that the prior art of record did not teach a textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element as the sole basis for distinguishing claim 16 over the prior art of record. ('011 file history (Ex. 1003), at 01/12/2007 Response, pp. 10-12). Because the next action from the PTO was a Notice of Allowance, the Examiner appears to have relied on this ground as the reason for allowance of claim 16.

Yet, several prior art references, which were not before the Examiner or apparently were not applied by the Examiner for this feature during prosecution, teach textile elements having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element as required by claim 16. For example,

Nishida, Glidden, and Osamu all disclose textile elements having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element. (Frederick Dec. (Ex. 1001), ¶¶ 68, 72, 81, 84, 88-89, 91). For example, Glidden states:

> In fabricating the unitary upper, as by knitting, areas thereof which are normally subjected to greater wear and in which a lower degree of elasticity is desired, such as the toe 11 and the heel portion 12, may be more densely fabricated to provide therein heavier weight and less extensibility than in the other parts of the upper, as by changing the type of stitch or amount [of] thickness of the yarn in the knitting. Other areas, such as the ankle portion 13, are preferably made so as to provide softness and elasticity, as by making them of ribbed construction, as shown.

(Glidden (Ex. 1007), p. 1, col. 2, ll. 33-44).

The use of textile elements having a first area and a second area with a unitary construction, the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the textile element was well-known in the art at the time of the priority date of the '011 patent.

As set forth in the claim charts below, Nishida, Glidden, and Osamu anticipate or, at the very least, render obvious claims 16-23 of the '011 patent, alone or in combination. Regarding various combinations of prior art, the '011 patent claims merely recite the combination of "prior art elements according to known methods to yield predictable results"

and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See* MPEP § 2143 (A, C). For example, a person of ordinary skill in the art would have understood that using a knitted textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element was a well-known endeavor among those in the textile industry. (Frederick Dec. (Ex. 1001), ¶¶ 72, 84, 91). With regard to the other recited elements in claim 16, it is undisputed the prior art discloses the combination of these features in uppers for an article of footwear.

Moreover, one of ordinary skill in the art would have understood and expected the benefits of using a knitted textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element with such an upper – that is, that a knitted textile element having first and second areas that each has a different stitch configuration to impart varying properties to each area of the textile element would provide the advantages of different properties in the shoe upper, such as breathability and elasticity, while increasing the efficiency of the manufacturing process. ('011 patent (Ex. 1002), 2:62-3:16; 11:12-18). Specifically, the prior art references cited in Section VI.A above teach the construction of and/or process for constructing a knitted shoe upper. The common teachings of these prior art references show that it would have been obvious for a person of ordinary skill in the art to combine their teachings in designing a knitted shoe upper to achieve the claimed features of the '011 patent. Thus, claims 16-23 of

the '011 patent are not patentable in view of the above-noted references considered individually or in combination.

'011 Patent Claims	Description of Prior Art
16. An article of footwear comprising:	Grounds 1-3; 7; 12: **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 15-17: **Glidden** discloses an article of footwear. Frederick Dec. at ¶ 84; *see also* Glidden at Title; p. 1, 1:1-4. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91; *see also* Osamu at Title; [0001]; [0007].
an upper incorporating a weft-knitted textile element, the textile element having a first area and a second area with a unitary construction,	Grounds 1-2: **Nishida** discloses an upper incorporating a knit textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 3:6-12; 3:15-26; 4:12-18; FIGS. 2-3. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include weft knitting. Frederick Dec. at ¶ 72. Grounds 3; 7; 12: **Nishida** discloses an upper incorporating a knit textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 3:6-12; 3:15-26; 4:12-18; FIGS. 2-3. Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate weft-knitted textile elements as disclosed by McDonald, Whiting, or Curley into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 15: **Glidden** discloses an upper incorporating a knit textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-10; p. 1, 2:33-44; p. 1, 2:45-48; FIGS. 1, 6, 8. A POSITA at the time of the priority date of the '011 patent would have understood that

	Glidden is describing and showing a weft-knitted textile element. Frederick Dec. at ¶ 84. Grounds 16-17: **Glidden** discloses an upper incorporating a knit textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-10; p. 1, 2:33-44; p. 1, 2:45-48; FIGS. 1, 6, 8. Uppers incorporating weft-knitted textile elements were well-known in the art at the time of the priority date of the '011 patent. *See* McDonald at p. 1, 2:26-39; Whiting at 2:39-56. It would have been obvious at the time of the priority date of the '011 patent to incorporate weft-knitted textile elements as disclosed by McDonald or Whiting into Glidden's upper. Frederick Dec. at ¶ 84. *See* MPEP § 2143(A), (C). Ground 18: **Osamu** discloses an upper incorporating a textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]-[0012]; claim 1; FIGS. 1, 3. Osamu describes a woven textile element, rather than a weft-knitted textile element. A POSITA at the time of the priority date of the '011 patent would have understood that woven and knitted textiles are both suitable for use in uppers and the selection of one versus the other is an obvious design choice. Frederick Dec. at ¶ 91. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses an upper incorporating a textile element having first and second areas with a unitary construction. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]-[0012]; claim 1; FIGS. 1, 3. Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 1:61-62; 1:67-68; 2:42-45; 3:6-10; 3:45-52; 3;66-68; 5:63-6:2; 6:23-25; Curley at p. 7, lines 32-33; p. 8, lines 7-9; p. 16, lines 5-8. Additionally, Glidden, McDonald, Whiting, and Curley each disclose an upper incorporating a weft-knitted textile element. *See* Glidden at p. 1, 2:45-48; FIGS. 1, 6, 8; McDonald at p. 1, 2:26-39; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate a weft-knitted textile as disclosed by Nishida, Curley, Glidden, McDonald, or

	Whiting into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
the first area being formed of a first stitch configuration, and the second area being formed of a second stitch configuration that is different from the first stitch configuration to impart varying properties to the textile element; and	Grounds 1-2: **Nishida** discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶ 72; *see also* Nishida at 3:15-4:18; 4:47-60; 5:41-45; 5:63-6:2; 6:4-41. A POSITA at the time of the priority date of the '011 patent would have understood that varying stitch configurations to impart different properties to two different areas is an obvious design choice or a selection from among a finite number of techniques to do so. Frederick Dec. at ¶ 72. Grounds 3; 7; 12: **Nishida** discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶ 72; *see also* Nishida at 3:15-4:18; 4:47-60; 5:41-45; 5:63-6:2; 6:4-41. Uppers incorporating different stitch configurations to impart varying properties to a textile element were well-known in the art at the time of the priority date of the '011 patent. *See* Glidden at p. 1, 2:33-44; *See* McDonald at p. 1, 2:26-49; FIG. 1. It would have been obvious at the time of the priority date of the '011 patent to incorporate uppers with different stitch configurations as disclosed by Glidden or McDonald into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:33-44; FIGS. 1, 2, 6. Ground 18: **Osamu** discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]; claim 1. A POSITA at the time of the priority date of the '011 patent would have understood that varying stitch configurations to impart different properties to two different areas is an obvious design choice or a selection from among a finite number of techniques to do so.

	Frederick Dec. at ¶ 91. Grounds 19; 24; 29; 35; 38: **Osamu** discloses that the first and second areas may be formed of different stitch configurations to impart varying properties to the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]; claim 1. Uppers incorporating different stitch configurations to impart varying properties to a textile element were well-known in the art at the time of the priority date of the '011 patent. *See* Glidden at p. 1, 2:33-44; McDonald at p. 1, 2:26-49; FIG. 1; Nishida at 3:15-26; 3:43-52; 5:41-45. It would have been obvious at the time of the priority date of the '011 patent to incorporate uppers with different stitch configurations as disclosed by Glidden, McDonald, or Nishida into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
a sole structure secured to the upper.	Grounds 1-3; 7; 12: **Nishida** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 4:39-46; FIG. 3. Grounds 15-17: **Glidden** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 2, 1:9-19, 2:8-15, 2:23-30; FIGS. 1, 6. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001], [0007], [0013], [0015].
17. The article of footwear recited in claim 16, wherein the first stitch configuration provides a substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smooth texture.	Grounds 3; 10; 11; 19; 27; 32-33; 35: Uppers with a first stitch configuration that provides a substantially smooth texture to the first area, and a second stitch configuration that provides a texture to the second area that is rougher than the smooth texture were well-known in the art at the time of the priority date of the '011 patent. *See* Glidden at p. 1, 2:35-44; McDonald, p. 1, 2:26-49; FIG. 1. It would have been obvious at the time of the priority date of the '011 patent to incorporate the stitch configurations as disclosed by Glidden or McDonald into Nishida's or Osamu's upper. Frederick Dec. at ¶¶ 72, 91. See MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the first stitch configuration provides a

	substantially smooth texture to the first area, and the second stitch configuration provides a texture to the second area that is rougher than the smooth texture. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:33-44; FIGS. 1, 2, 6.
18. The article of footwear recited in claim 17, wherein the second stitch configuration forms a rib structure in the second area.	Grounds 3; 10; 11; 19; 27; 32-33; 35: Uppers with a first stitch configuration that provides a substantially smooth texture to the first area, and a second stitch configuration that forms a rib structure were well-known in the art at the time of the priority date of the '011 patent. *See* Glidden at p. 1, 2:35-44; FIGS. 1, 2, 6; McDonald at p. 1, 2:26-49; FIG. 1. It would have been obvious at the time of the priority date of the '011 patent to incorporate the stitch configurations as disclosed by Glidden or McDonald into Nishida's or Osamu's upper. Frederick Dec. at ¶¶ 72, 91. See MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the second stitch configuration forms a rib structure in the second area. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:33-44.
19. The article of footwear recited in claim 16, wherein at least one of the first stitch configuration and the second stitch configuration forms an aperture in the weft-knitted textile element.	Grounds 1-3; 7; 12: **Nishida** discloses that at one stitch configuration may form a net-like structure (i.e. having apertures) in the knit textile element. Frederick Dec. at ¶ 72; *see also* Nishida at 3:43-52; 6:25-31. Grounds 15-17: **Glidden** discloses that at least one stitch configuration may have high porosity for good ventilation (i.e., apertures) in the knitted textile element. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 1:25-30; p. 2, 2:40-53; claims 1-5. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses at least one stitch configuration may form a weave structure with high breathability (i.e. having apertures) in the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0009].
20. The article of footwear recited in claim 16, wherein the weft-knitted textile element is one of an exterior layer, an intermediate layer, and an interior layer of	Grounds 1-3; 7; 12: **Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:66-4:1; FIG. 3. Grounds 15-17: **Glidden** discloses that the knit textile element may at least be

the upper.	an exterior layer of the upper (*see* FIG. 1) and/or an interior layer of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:68-74; FIGS. 1-3, 6-8. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
21. The article of footwear recited in claim 16, wherein the upper includes an exterior layer, an intermediate layer, and an interior layer, and the weft-knitted textile element forms at least a portion of the interior layer.	Grounds 1-2: **Nishida** discloses that the upper may include two or more layers, and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:62-4:1. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's use of two or more layers to include three layers, and that the knit textile element and/or knitted backing layer of the textile element forms a portion of the interior layer. Frederick Dec. at ¶ 72. Grounds 4-5; 8-9; 12-13: **Nishida** discloses that the upper may include two or more layers, and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:13-15; 3:62-4:1. Uppers incorporating three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. It would have been obvious at the time of the priority date of the '011 patent to incorporate three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer as disclosed by Curley or Shiomura into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the knit textile element may at least be an exterior layer of the upper and/or an interior layer of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:9-19; p. 2, 1:68-74; FIGS. 1-2. Ground 18: **Osamu** discloses that the upper may include two or more layers, and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 91; *see also* Osamu at

	[0001]; [0005]; [0006]; [0010]; claim 1. A POSITA at the time of the priority date of the '011 patent would have understood Osamu's use of two or more layers to include three layers, and that the textile element forms a portion of the interior layer. Frederick Dec. at ¶ 91. Grounds 20-21; 25-26; 30-31; 36-38: **Osamu** discloses that the upper may include two or more layers, and the knit textile element may form at least a portion of the interior layer. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0006]; [0010]; claim 1. Uppers incorporating three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45. It would have been obvious at the time of the priority date of the '011 patent to incorporate three layers, wherein a knit textile element forms a portion of an inner layer and an outer layer as disclosed by Curley or Shiomura into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
22. The article of footwear recited in claim 16, wherein the textile layer forms at least a portion of both the interior surface and an exterior surface of the upper.	Grounds 1-2: **Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-4:46; FIG. 3. A POSITA at the time of the priority date of the '011 patent would have understood that Nishida's knit textile element and/or knit backing layer may form at least a portion of the interior and exterior surfaces of the upper. Frederick Dec. at ¶ 72. Grounds 4-6; 8-10; 12-14: **Nishida** discloses that the knit textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-4:46; FIG. 3. *See* Curley at p. 6, lines 30-32; p. 30, claim 34; p. 7, line 32-p. 8, line 5; Shiomura at 2:26-45; Glidden at FIGS. 1-2, p. 1, 2:3-32. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knitted upper where the knitted material forms a portion of both interior and exterior surfaces of the upper as disclosed by Curley, Shiomura, or Glidden into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C).

	Grounds 15-17: **Glidden** discloses that the knit textile element forms at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:68-74; FIGS. 1-3, 6-8. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the textile element may form at least a portion of an interior surface and an exterior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.
23. The article of footwear recited in claim 16, wherein the weft-knitted textile element forms an interior surface of the upper.	Grounds 1-2: **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-46. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's knit textile element and/or knitted backing layer may form an interior surface of the upper. Frederick Dec. at ¶ 72. Grounds 4-6; 8-10; 12-14: **Nishida** discloses that the knit textile element may form an interior surface of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-46. Uppers incorporating knit textile elements that form an interior surface of the upper were well-known in the art at the time of the priority date of the '011 patent. *See* Curley at p. 6, lines 30-32; p. 30, claim; Shiomura at 2:26-45; Glidden at FIGS. 1-2, p. 1, 2:3-32. It would have been obvious at the time of the priority date of the '011 patent to incorporate a knit textile element that forms an interior surface of the upper as disclosed by Curley, Shiomura, or Glidden into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Grounds 15-17: **Glidden** discloses that the knit textile element forms an interior surface of the upper. Frederick Dec. at ¶ 84; *see also* Glidden at p. 1, 2:3-23; p. 2, 1:68-74; FIGS. 1-3, 6-8. Grounds 18-19; 24; 29; 35; 38: **Osamu** discloses that the knit textile element forms an interior surface of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.

C. "Textile Element Having A First Area With A First Unitary Construction And A Second Area With A Second Unitary Construction Different From The First Unitary Construction" in Claims 44-46

The '011 specification states that "[m]any conventional articles of footwear incorporate uppers with various material elements that each exhibit different properties. For example, a first material element may be smooth, and a second material element may be textured. The first and second material elements are then stitched together to form a portion of the conventional upper. Textile element 40' also exhibits smooth and textured areas. In contrast with the conventional upper, however, ***first texture 46' and second texture 47' are incorporated into a single, unitary element of textile***, rather than two separate elements that are stitched or otherwise joined together." ('011 patent (Ex. 1002) 9:25-35 (emphasis added)).

As discussed above, the Applicants amended independent claim 44 to require "the flat-knitted textile element having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction." ('011 file history (Ex. 1003), at 01/12/2007 Response, p. 8).

The Applicants relied on this element as the sole basis for distinguishing claim 44 over U.S. Patent No. 6,308,438 to Throneburg ("Throneburg). ('011 file history (Ex. 1003), at 01/12/2007 Response, p. 10. The Applicants relied on language from the original claim, stating that U.S. Patent No. 1,888,172 to Joha ("Joha") does not have "a first area having a first set of properties and a second area having a second set of properties that is different

from the first set of properties" as the sole basis for distinguishing claim 44 over Joha. *(Id.)*. Because the next action from the PTO was a Notice of Allowance, the Examiner appears to have relied on this ground as the reason for allowance of claim 44 over Throneburg.

Yet, several prior art references, which were not before the Examiner or were not applied by the Examiner for this feature during prosecution, teach textile elements having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction as required by claim 44. For example, Nishida and Osamu each disclose textile elements having a unitary construction with two areas, each area having a different construction. (Frederick Dec. (Ex. 1001), ¶¶ 72, 91).

As demonstrated by the various references that either were not before the Examiner or were not applied by the Examiner for this feature during prosecution of the '011 patent, the use of textile elements with a unitary construction with a first area and a second area with a different construction from the first area, as well as flat-knitted textile elements having a first area having a first set of properties and a second area having a second set of properties that is different from the first set of properties, were well-known in the art at the time of the priority date of the '011 patent.

As set forth in the claim charts below, Nishida and Osamu anticipate or, at the very least, render obvious claims 44-46 of the '011 patent, alone or in combination with other prior art. Regarding various combinations of prior art, the '011 patent claims merely recite

the combination of "prior art elements according to known methods to yield predictable results" and/or the "[u]se of known technique[s] to improve similar devices (methods, or products) in the same way." *See* MPEP § 2143 (A, C). For example, a person of ordinary skill in the art would have understood that using flat-knitted textile elements having a unitary construction with a first area construction different from a second area construction, as well as flat-knitted textile elements having a first area having a first set of properties and a second area having a second set of properties that is different from the first set of properties was a well-known endeavor among those in the textile industry. (Frederick Dec. (Ex. 1001), ¶¶ 72, 91). The prior art unquestionably discloses the combination of the other recited elements of claim 44 in uppers for an article of footwear.

Moreover, one of ordinary skill in the art would have understood and expected the benefits of using (a) unitary, flat-knitted textile elements having two areas with different constructions, as well as (b) flat-knitted textile elements having a first area having a first set of properties and a second area having a second set of properties that is different from the first set of properties with such an upper, would provide the advantages of different properties in the shoe upper, such as breathability and elasticity, while increasing the efficiency of the manufacturing process. Specifically, the prior art references cited in Section VI.A above teach the construction of and/or process for constructing a knitted shoe upper. The common teachings of these prior art references show that it would have been obvious for a person of ordinary skill in the art to combine their teachings in designing a knitted shoe

upper to achieve the claimed features of the '011 patent. Thus, claims 44-46 of the '011 patent are not patentable in view of the above-noted references considered individually or in combination.

'011 Patent Claims	Description of Prior Art
44. An article of footwear comprising:	Grounds 1-2; 7; 12: **Nishida** discloses an article of footwear. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; FIG. 3. Grounds 18; 24; 29; 38: **Osamu** discloses an article of footwear. Frederick Dec. at ¶ 91; *see also* Osamu at Title; [0001]; [0007].
an upper incorporating a flat-knitted textile element, the flat-knitted textile element having a first area with a first unitary construction and a second area with a second unitary construction different from the first unitary construction,	Grounds 1-2: **Nishida** discloses an upper incorporating a knit textile element having first and second areas having constructions that are different. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 3:6-12; 3:15-26; 3:31-42; 4:12-18; FIGS. 2-3. A POSITA at the time of the priority date of the '011 patent would have understood Nishida's conventional knitting processes to include flat knitting. Frederick Dec. at ¶ 72. Grounds 7; 12: **Nishida** discloses an upper incorporating a knit textile element having first and second areas having constructions that are different. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 3:6-12; 3:15-26; 3:31-42; 4:12-18; FIGS. 2-3. Uppers incorporating textile elements formed by flat knitting were well-known in the art at the time of the priority date of the '011 patent. *See* Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate flat-knitted textile elements as disclosed by Whiting or Curley into Nishida's upper. Frederick Dec. at ¶ 72. *See* MPEP § 2143(A), (C). Ground 18: **Osamu** discloses an upper incorporating a woven textile element having first and second areas having constructions that are different. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]-[0012]; claim 1; FIGS. 1, 3. A POSITA at the time of the priority date of the '011 patent would have understood that the selection of flat knitting, a sub-type of weft knitting, is an

	obvious design choice or a selection from among a finite number of weft knitting techniques. Frederick Dec. at ¶ 91. Grounds 24; 29; 38: **Osamu** discloses an upper incorporating a woven textile element having first and second areas having constructions that are different. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]-[0012]; claim 1; FIGS. 1, 3. Woven and knitted textiles are both suitable for use in uppers and were well-known in the art at the time of the priority date of the '011 patent. *See* Nishida at 1:61-62; 1:67-68; 2:42-45; 3:6-10; 3:45-52; 3;66-68; 5:63-6:2; 6:23-25; Curley at p. 7, lines 32-33; p. 8, lines 7-9; p. 16, lines 5-8. Additionally, Nishida, Whiting, and Curley each disclose an upper incorporating a weft-knitted textile element. *See* Nishida at 3:6-12; Whiting at 2:39-56; Curley at p. 7, line 32-p. 8, line 25. It would have been obvious at the time of the priority date of the '011 patent to incorporate flat-knitted textile elements as disclosed by Nishida, Whiting, or Curley into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
the first area having a first set of properties, and the second area having a second set of properties that is different from the first set of properties to impart varying characteristics to the textile element; and	Grounds 1-2; 7; 12: **Nishida** discloses that the first and second areas may have different properties that impart varying properties to the textile element. Frederick Dec. at ¶ 72; *see also* Nishida at 3:15-4:18; 4:47-60; 5:41-45; 5:63-6:2; 6:4-41. Grounds 18; 24; 29; 38: **Osamu** discloses that the first and second areas may have different properties that impart varying properties to the textile element. Frederick Dec. at ¶ 91; *see also* Osamu at [0005]; [0007]; [0009]; claim 1; FIGS. 1, 3.
a sole structure secured to the upper.	Grounds 1-2; 7; 12: **Nishida** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 72; *see also* Nishida at Abstract; 4:39-46; FIG. 3. Grounds 18; 24; 29; 38: **Osamu** discloses that a sole structure may be secured to the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001], [0007], [0013], [0015].
45. The article of footwear recited in claim 44, wherein the first set	Grounds 1-2; 7; 12: **Nishida** discloses that the first and second areas may have different stitch configurations and/or yarn types. Frederick Dec.

of properties and the second set of properties are at least one of a stitch configuration and a yarn type.	at ¶ 72; *see also* Nishida at 3:15-26; 3:43-52; 5:63-6:2. Ground 18: **Osamu** discloses that the first and second areas may have different stitch configurations and/or yarn types. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]; [0009]. A POSITA at the time of the priority date of the '011 patent would have understood that varying stitch configurations and/or yarn types to impart different properties to two different areas is an obvious design choice or a selection from among a finite number of techniques to do so. Frederick Dec. at ¶ 91. Grounds 27-29: **Osamu** discloses that the first and second areas may have different stitch configurations and/or yarn types. Frederick Dec. at ¶ 91; *see also* Osamu at [0007]; [0009]. Uppers incorporating different stitch configurations and/or yarn types to impart varying properties to a textile element were well-known in the art at the time of the priority date of the '011 patent. *See* Glidden at p. 1, 2:33-44; McDonald at p. 1, 2:26-49; FIG. 1; Nishida at 3:15-26; 3:43-52; 5:41-45. It would have been obvious at the time of the priority date of the '011 patent to incorporate uppers with different stitch configurations and/or yard types as disclosed by Glidden, McDonald, or Nishida into Osamu's upper. Frederick Dec. at ¶ 91. *See* MPEP § 2143(A), (C).
46. The article of footwear recited in claim 44, wherein the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper.	Grounds 1-2; 7; 12: **Nishida** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 72; *see also* Nishida at 3:6-9; 3:66-4:1; FIG. 3. Grounds 18; 24; 29; 38: **Osamu** discloses that the textile element is one of an exterior layer, an intermediate layer, and an interior layer of the upper. Frederick Dec. at ¶ 91; *see also* Osamu at [0001]; [0005]; [0010]; claim 1.

VII. CONCLUSION

The prior art references identified in this Petition contain pertinent technological teachings, either explicitly or inherently disclosed, that were not previously considered in the manner presented herein or applied during original examination of the '011 patent. At least by virtue of disclosing the limitations that served as the basis for the allowance of the claims at issue, the references relied upon herein should be considered important in determining patentability. In sum, these references provide new, non-cumulative technological teachings not previously considered and relied upon on the record, and they establish a reasonable likelihood of success as to Petitioner's assertions that claims 1-46 of the '011 patent are not patent eligible pursuant to the grounds presented in this Petition. Accordingly, Petitioner respectfully requests institution of *inter partes* review for claims 1-46 of the '011 patent for each of the grounds presented herein.

Respectfully submitted,

Dated: Nov. 28, 2012

By: 
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.8(e) and 42.105(b), the undersigned certifies that on November 28, 2012, a complete and entire copy of this Petition for *Inter Partes* Review and all supporting exhibits were provided via Express Mail, costs prepaid, to the Patent Owner by serving the correspondence address of record as follows:

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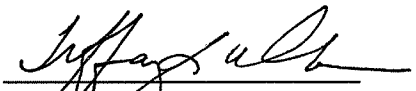
By: 
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