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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* LYSANDRE FOLLET, GJERMUND HAUGBRO,  
JAMES MOLYNEUX, and PHIL WOODMAN

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Appeal 2019-003295  
Application 14/851,980  
Technology Center 1700

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Before CHRISTOPHER L. OGDEN, LILAN REN, and  
JANE E. INGLESE, *Administrative Patent Judges*.

INGLESE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> requests our review under 35 U.S.C. § 134(a) of the Examiner's decision to finally reject claims 1–24.<sup>2</sup> We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> We use the word “Appellant” to refer to the “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Nike, Inc. as the real party in interest. Appeal Brief filed October 23, 2018 (“Appeal Br.”) at 2.

<sup>2</sup> Final Office Action entered May 24, 2018 (“Final Act.”) at 1.

### CLAIMED SUBJECT MATTER

Appellant claims a method of manufacturing an article of footwear. Appeal Br. 4–6. Independent claims 1 and 20 illustrate the subject matter on appeal, and are reproduced below with emphasis added to highlight subject matter of particular relevance to the present appeal:

1. A method of manufacturing an article of footwear comprising:
  - providing a textile;
  - applying at least one of heat and pressure to the textile using a texturing device *to form a textured area of the textile that is spaced apart from a substantially smooth area of the textile*; and
  - forming at least part of an upper from the textile after applying the at least one of heat and pressure to the textile, the upper having a cavity configured to receive a foot and having the textured area extend continuously from a medial side of the upper to a lateral side of the upper across a forefoot region of the upper;
  - wherein forming at least part of the upper from the textile includes *providing the substantially smooth area of the textile with a smooth surface that defines a reference boundary of the upper*; and
  - wherein forming the textured area includes *forming a plurality of projection structures that form a gradient pattern and project outwardly from the reference boundary* and a plurality of recess structures that recess inwardly from the reference boundary, the plurality of recess structures including a first recess structure recessed inwardly from the reference boundary by a first height and a second recess structure recessed inwardly from the reference boundary by a second height, the plurality of projection structures including a first projection structure disposed between the first recess structure and the second recess structure and projecting outwardly from the reference boundary by a third height that is greater than the first height and the second height.

20. A method of manufacturing an article of footwear comprising:

knitting a knitted component of unitary knit construction, the knitted component including a knit element and a tensile element;

inlaying a first segment of the tensile element in a first area of the knit element, inlaying a second segment of the tensile element in a second area of the knit element, and disposing a third segment of the tensile element outside the knit element, the third segment extending between the first segment and the second segment;

inserting the knit element into a cavity of a texturing device;

applying at least one of heat and pressure to the knit element while in the cavity *to form a textured area adjacent to a substantially smooth area having a smooth surface that defines a reference plane of the knitted component, the textured area including a plurality of first projection structures that project from the reference plane in a first direction and a plurality of second projection structures that form a gradient pattern* and project from the reference plane in a second direction opposite the first direction, the plurality of first projection structures including a first projection structure projecting from the reference plane in the first direction by a first height and a second projection structure projecting from the reference plane in the first direction by a second height, the plurality of second projection structures including a third projection structure disposed between the first projection structure and the second projection structure and projecting from the reference plane in the second direction by a third height that is greater than the first height and the second height;

forming at least a portion of an upper from the knitted component, the textured area of the knitted component extending continuously from a medial side of the upper to a lateral side of the upper across a forefoot region of the upper, wherein the first area and the first segment are disposed proximate a throat of the upper, wherein the second area and the second segment are disposed proximate a sole attachment area

of the upper, and wherein the second projection structures extend into an inner void defined by the upper; and attaching the sole attachment area to a sole structure.

Appeal Br. 15, 18–19 (Claims Appendix) (emphasis added).

## REJECTIONS

The Examiner maintains the following rejections in the Examiner’s Answer entered January 22, 2019 (“Ans.”):

- I. Claims 1–5, 12–15, 17, and 19 under 35 U.S.C. § 103 as unpatentable over Davis<sup>3</sup> in view of Dua<sup>4</sup> and Arizumi;<sup>5</sup>
- II. Claim 6 under 35 U.S.C. § 103 as unpatentable over Davis in view of Dua, Arizumi, and Kirk;<sup>6</sup>
- III. Claims 7–11 and 23 under 35 U.S.C. § 103 as unpatentable over Davis in view of Dua, Arizumi, and Beye;<sup>7</sup>
- IV. Claim 16 under 35 U.S.C. § 103 as unpatentable over Davis in view of Dua, Arizumi, and Hasselkuss;<sup>8</sup>
- V. Claim 18 under 35 U.S.C. § 103 as unpatentable over Davis in view of Dua, Arizumi, and Dua II;<sup>9</sup> and
- VI. Claims 20–22 and 24 under 35 U.S.C. § 103 as unpatentable over Davis in view of Dua, Arizumi, and Beye.

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<sup>3</sup> Davis, US 6,299,962 B1, issued October 9, 2001.

<sup>4</sup> Dua, US 2010/0199520 A1, published August 12, 2010.

<sup>5</sup> Arizumi, US 2007/0256328 A1, published November 8, 2007.

<sup>6</sup> Kirk, US 2015/0052778 A1, published February 26, 2015.

<sup>7</sup> Beye, US 2014/0196314 A1, July 17, 2014.

<sup>8</sup> Hasselkuss, US 3,447,885, issued June 3, 1969.

<sup>9</sup> Dua, US 7,814,598 B2, October 19, 2010 (“Dua II”).

## FACTUAL FINDINGS AND ANALYSIS

Upon consideration of the evidence relied upon in this appeal and each of Appellant's contentions, we reverse the Examiner's rejections of claims 1–24 under 35 U.S.C. § 103 for reasons set forth in the Appeal and Reply Briefs, and below.

Claim 1 requires the recited method of manufacturing an article of footwear to comprise, in part, providing a textile having a substantially smooth area with a smooth surface that defines a reference boundary, and forming a textured area in the textile spaced apart from the substantially smooth area, by forming a plurality of projection structures in the textured area that project outwardly from the reference boundary and form a gradient pattern. Similarly, independent claim 20 requires the recited method of manufacturing an article of footwear to comprise, in part, forming a textured area in a knit element adjacent to a substantially smooth area of the element having a smooth surface defining a reference plane, and including a plurality of projection structures that form a gradient pattern in the textured area.

The Specification explains that a gradient pattern of projection structures may be created in a textile from which a footwear upper is created by forming projection structures in the textile having heights that vary gradually from a projection structure to an adjacent projection structure, such that, for example, a first projection structure has the greatest height, a second projection structure adjacent to the first projection structure has a slightly lower height than the first projection structure, a third projection structure adjacent to the second projection structure has a slightly lower height than the second projection structure, and a fourth projection structure

adjacent to the third projection structure has a slightly lower height than the third projection structure. Spec. ¶¶ 46, 68, 92; Figs. 4–6.

The Examiner finds that Davis discloses a method of manufacturing an article of footwear that comprises forming a textured area in a textile. Final Act. 2–3, 12. The Examiner finds that Davis, however, does not disclose producing a textured area spaced apart from a substantially smooth area of the textile that defines a reference boundary, and does not disclose that “the textured area includes a plurality of projection structures that project outwardly at varying distances from the reference boundary.” Final Act. 3, 12. The Examiner finds that Dua discloses a footwear upper formed from a textile having a substantially smooth area spaced apart from a textured area including a “plurality of projection structures and a plurality of recess structures in an alternating arrangement,” which provide “structural and aesthetic enhancements to the upper.” Final Act. 3–4, 12–13.

In view of these disclosures in Dua, the Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to have modified the method taught by Davis by forming a textured area spaced apart from a substantially smooth area of the textile, wherein the textured area includes a plurality of projection structures and a plurality of recess structures in an alternating arrangement . . . for the benefit of imparting different properties to different areas of the upper.” Final Act. 4, 13.

The Examiner finds that “Davis, as modified by Dua, does not explicitly teach recesses and projections having varied heights in the manner recited” in claims 1 and 20. Final Act. 5, 14. The Examiner finds, however, that “Arizumi teaches an article of footwear comprising a textured surface

having a plurality of recesses and projections wherein the heights of the recesses and projections are varied to change the flexibility of the footwear surface.” Final Act. 5, 14 (citing Arizumi ¶ 26). In view of this disclosure in Arizumi, the Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to have varied the heights of the recesses and projections [in the textile produced according to Davis’ method as modified by Dua] to optimize the flexibility and other performance factors for the specific article of footwear being produced.” Final Act. 5, 14 (citing Arizumi ¶¶ 15, 26).

A preponderance of the evidence relied upon in this appeal does not support the Examiner’s conclusion of obviousness, however, for reasons expressed by Appellant (Appeal Br. 7; Reply Br. 2) and discussed below.

We point out initially that when rejecting claims 1 and 20, the Examiner does not address the requirement set forth in both claims of forming a plurality of projection structures in a *gradient pattern*; consequently, the Examiner does not identify any disclosure in Davis, Dua, or Arizumi of projection structures that form a gradient pattern as recited in claims 1 and 20. Final Act. 2–5, 12–15. Nonetheless, the Examiner does address forming a gradient pattern when rejecting claim 13,<sup>10</sup> and in so doing, the Examiner determines that although Dua “does not explicitly teach forming a gradient pattern,” in view of Arizumi’s disclosure of varying the heights of recesses and projections in a textured surface in an article of footwear to change the flexibility of the footwear surface, “it would have

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<sup>10</sup> Claim 13 depends indirectly from claim 1 and recites that the plurality of projection structures diminish in height in a direction extending from the forefoot region toward the medial side and diminish in height in a direction extending from the forefoot region toward the lateral side.

been obvious to one of ordinary skill in the art before the effective filing date of the claimed invention to have varied the heights of the projection structures in any pattern to achieve a desired variation in the structural and aesthetic properties of the upper.” Final Act. 6.

The Examiner thus appears to determine that the recited gradient pattern would have been an obvious matter of design choice. But a “finding of ‘obvious design choice’ [is] precluded where the claimed structure and the function it performs are different from the prior art.” *In re Chu*, 66 F.3d 292, 299 Fed. Cir. 1995 (citing *In re Gal*, 980 F.2d 717 (Fed. Cir. 1992)).

The textured materials disclosed in Davis, Dua, and Arizumi have different structures and purposes than the plurality of projection structures that form a gradient pattern recited in claims 1 and 20. Davis discloses including “texture inserts” in an embossing mold to “achieve an endless variety of molding effects” in upper material used to form an article of footwear, while Dua discloses a non-woven textile incorporated into footwear that “may be formed to have a variety of non-planar or three-dimensional configurations,” such as a “waves that extend in two directions to impart an egg crate configuration.” Davis col. 6, ll. 24–27; col. 7, ll. 47–59; col. 8, ll. 7–17, 53–54; Dua ¶¶ 63, 167; Fig. 42C. Thus, neither Davis nor Dua discloses projection structures that form a gradient pattern as recited in claims 1 and 20.

Arizumi discloses a footwear upper including textured surface 40 formed of contoured structures 41 in which an alternating series of raised peaks 42 and troughs 43 extend in two orthogonal directions. Arizumi ¶¶ 19–20, 22; Figs. 4–9. Although Arizumi discloses that “the heights of the raised structures (e.g., the peaks 42) or, alternately or additionally, the

depths of the depressions (e.g., the troughs 43) between the raised structures may be varied in order to change the flexibility of the textured surface 40,” Arizumi does not disclose varying the heights of the peaks to form a gradient pattern as recited in claims 1 and 20. Arizumi ¶ 26.

As discussed above, the Examiner determines that it would have been obvious to vary the heights of the projections disclosed in Arizumi to optimize the flexibility of a textured area of a footwear upper produced according to Davis’ method as modified by Dua. Final Act. 5, 14. Appellant’s Specification explains, however, that forming a textured area in a footwear upper to include projection structures arranged in a gradient pattern serves different purposes and has different functions than increasing flexibility. Specifically, the Specification explains that a gradient pattern of projection structures allows a textured area to distribute forces and/or deform in a predetermined manner, such that taller projection structures deform readily when impacting a ball, and forces then distribute through the textured area so that gradually shorter projection structures resist deformation. Spec. ¶ 96. The Specification indicates that the gradient pattern also enhances the force dampening properties of the textured area, and allows water or other fluids to be channeled away from the upper in a predetermined manner. *Id.*

Because the gradient pattern of projection structures recited in claims 1 and 20 serves different purposes and has different functions than the raised structures disclosed in Arizumi relied on by the Examiner, forming such raised structures into a gradient pattern would not have been obvious absent a reason or suggestion stemming from the relied-upon disclosures in Davis, Duo, and/or Arizumi to form such a gradient pattern. *Gal*, 980 F.2d at 719

(holding that the claimed chip structure was not a matter of design choice over the prior art structure where applicant disclosed that the claimed structure achieved desired functions different from the prior art); *Chu*, 66 F.3d at 299 (holding that claimed structural feature was not a matter of design choice where there was no suggestion or teaching to modify the prior art to arrive at the claimed structural feature and applicant introduced evidence showing the benefits of the claimed structural feature).

The Examiner, however, does not provide reasoning supported by objective evidence explaining why the relied-upon disclosures in Davis, Duo, and Arizumi would have led one of ordinary skill in the art to modify the raised structures disclosed in Arizumi *to form a gradient pattern*, when including such raised structures in a textured area of a footwear upper produced according to Davis' method as modified by Dua. The Examiner's conclusory assertion that it would have been obvious to vary the heights of the projection structures disclosed in Arizumi in any pattern to achieve a desired variation in structural and aesthetic properties does not constitute the requisite reasoning necessary to establish prima facie obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

We, accordingly, do not sustain the Examiner's rejections of claims 1 and 20, and claims 2–19 and 21–24, which each depend from either claim 1 or claim 20, under 35 U.S.C. § 103.

CONCLUSION

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-5, 12-15, 17, 19	103	Davis, Dua, Arizumi		1-5, 12-15, 17, 19
6	103	Davis, Dua, Arizumi, Kirk		6
7-11, 23	103	Davis, Dua, Arizumi, Beye		7-11, 23
16	103	Davis, Dua, Arizumi, HasselKuss		16
18	103	Davis, Dua, Arizumi, Dua II		18
20-22, 24	103	Davis, Dua, Arizumi, Beye		20-22, 24
<b>Overall Outcome</b>				1-24

REVERSED