

SHOES BY FIREBUG LLC v. STRIDE RITE CHILDREN'S GROUP, LLC, Appeal Nos. 2019-1622 and 2019-1623 (Fed. Cir. June 25, 2020). Before Lourie, Moore, and O'Malley. Appealed from the Patent Trial and Appeal Board.

Background:

Stride Rite filed two *inter partes* review (IPR) petitions alleging that two of Firebug's patents, the '574 patent and '038 patent, were obvious over a combination of two references, Parker and Rosko. Firebug's patents are directed to internally illuminated footwear including light sources located between an interfacing layer and a light diffusing layer within the sole.

In the Final Written Decision in each IPR, the Board performed a claim construction of the preambles for the respective independent claims. The preambles both recited "[a]n internally illuminated textile footwear..." The Board found that the term "textile" in the preambles did not limit the scope of the claims to require any structure within the body of the claims to be formed of a textile material. The Board then held that Parker's light distribution system disclosed substantially all of the features of the independent claims of the patents, except for a plurality of illumination sources. The Board held that a skilled artisan would have found it obvious to replace Parker's optical fiber with Rosko's array of LEDs in a light diffuser, which would have rendered obvious the independent claims of the patents. Despite the claim construction, the Board noted that Rosko teaches using textile materials for footwear. Firebug appealed.

Issues/Holdings:

Did the Board err in finding that the term "textile footwear" in each preamble does not limit the scope of the claims? - Yes in part, but affirmed because the error was harmless.

Did the Board err in finding the claims obvious in view of the combination of Parker and Rosko? - No, affirmed.

Discussion:

First, the Federal Circuit agreed that the preamble of the '038 patent does not limit the scope of the independent claim because the body of the claim recites a structurally complete invention and does not rely on the preamble for the structure of a footwear. However, the Federal Circuit disagreed with the Board regarding the preamble of the '574 patent. The Federal Circuit found that the preamble of the '574 patent limits the scope of the independent claim because the body of the claim relies on the preamble for the antecedent basis of "footwear" and the term is essential to understanding the structure recited in the body of the claim. Further, the term "textile" would also limit the scope of the claim as defining the material of the footwear.

Second, the Federal Circuit affirmed the Board's finding of obviousness despite the Board's error in the claim construction of the '574 patent because the Board found that Rosko teaches using a textile as the material for footwear. The Federal Circuit also held that substantial evidence supported the Board's determination that a skilled artisan would have found it obvious to replace Parker's optical fiber with Rosko's array of LEDs in the light diffuser. The Federal Circuit agreed that Stride Rite's expert testimony supported the obviousness finding by stating that LEDs were well-known light sources and were known to increase durability of footwear.