

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Next Step Group, Inc.
Petitioner

v.

Deckers Outdoor Corporation
Patent Owner

Design Patent No. D927,161
Case No. 2024-_____

**Declaration of Donald Rhoads in Support of Petition
for *Inter Partes* Review of U.S. Design Patent No. D927,161**

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I, Donald Rhoads, declare as follows:

1. I am of counsel to Goldberg Cohen LLP who is representing Petitioner Next Step Group, Inc. (“Next Step”) in this proceeding. My registration number as a patent attorney for the United States Patent and Trademark Office is 34,705. I made this Declaration in support of the Petition.

2. Petitioner Next Step Exhibit 1001 is a true and correct copy of U.S. Design Patent No. D927,161, which I will refer to as the ’161 patent.

3. Petitioner Next Step Exhibit 1002 is true and correct images of the Emu Australia Stinger Micro boot, which has been for sale since at least 2016, and related information. These images were downloaded by me on January 4, 2024.

The first images (pages 1-6) were captured from the www.emuaustralia.com.au website: https://www.emuaustralia.com.au/shop-all-womens/stinger-micro/W10937.html?dwvar_W10937_colourName=CHESTNUT#start=25&sz=12

I made copies of each view of the boot (camel or chestnut color) shown on the website, and each time captured different sets of the reviews so that each of the pages together provides a full set of all of the reviews. The oldest reviews are eight years old, confirming the boot was on sale since at least 2016. This was also confirmed by a website listing for a black version of the boot that also had eight year old reviews (page 7).

4. The prior art status of the Emu Stinger Micro boot was further confirmed by accessing the Wayback Machine, which showed that the boot was on

sale on the Emu Australia websites before November 8, 2019, the filing of the application that led to the ‘161 patent. *See e.g.*, MPEP § 2128 II.E.; *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374-75, 2021 USPQ2d 867 (Fed. Cir. 2021). Thus, pages with the boots for sale from the www.emuaustralia.com.ca website were captured and attached to this exhibit for October 27, 2017 and November 11, 2017 (pages 8 and 9), demonstrating the boots were on sale and are prior art to the ‘161 patent.

5. Moreover, the amazon.com website was accessed at the same time and the pages offering the Emu boot for sale downloaded (pages 10-12): https://www.amazon.com/EMU-Australia-Womens-Stinger-Micro/dp/B00MCIDJWE/ref=sr_1_5?crid=RIXMQMV9FLVC&keywords=emu%2Bstinger%2Bmicro&qid=1706593049&sprefix=emu%2Bstinger%2Bmicro%2Caps%2C86&sr=8-5&th=1. That website says the Emu Stinger Micro boot was first offered for sale on that site in 2014 (“Date First Available: September 4, 2014; Manufacturer: EMU Australia”). Reviews for the boot on the first page from this website (page 10) alone go back before the filing date (“December 2, 2018”, “December 15, 2017”, “October 1, 2019”). Other reviews were copied and appended to the exhibit that went back to 2015 (pages 11-12).

6. Also attached is a true and correct copy of a December 14, 2010 press release (pages 13-15) from Emu Australia announcing a series of lawsuits filed by

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the Patent Owner against them and showing two predecessor boots to the Emu Stinger Micro that have the same styling (pages 14-15).

7. Petitioner Next Step Exhibit 1003 is a true and correct copy of Chinese Patent No. 304964897, which issued on December 28, 2018, and two other related documents. The original Chinese version of the patent is at pages 1-3, a copy of the version of the patent in the '161 patent file history is at pages 4-7, and a certified translation of the patent into English is at pages 8-10.

8. Petitioner Next Step Exhibit 1004 is a true and correct copy of the Patent Owner's webpage from www.theuggstore.com.au directed to the selling of the UGG Classic Ultra Mini product that I accessed on January 4, 2024:

<https://www.theuggstore.com.au/collections/women/products/womens-ultra-mini-ugg-boots?variant=42483635388578>

9. Petitioner Next Step Exhibit 1005 is true and correct copies of images of the UGG Classic Mini, which has been for sale since 2006, and the UGG Classic Mini II, which has been for sale since 2017, and related information. These images were downloaded by me on January 26, 2024. The first images (page 1) selling the UGG Classic Mini were captured from the Patent Owner's

www.ugg.com website: https://www.ugg.com/all-gender-footwear/classic-mini-boot/1002072.html?dwvar_1002072_color=CHE

10. The second set of images (page 2) selling the UGG Classic Mini II were captured from the same Patent Owner website: <https://www.ugg.com/all->

[gender-footwear/classic-mini-ii-boot/1016222.html?dwvar_1016222_color=BLK](https://www.ugg.com/ugc/classic-mini-ii-boot/1016222.html?dwvar_1016222_color=BLK)

and choosing chestnut color.

11. The prior art status of the UGG Classic Mini as on sale at least as early as August of 2006 and the UGG Classic Mini II at least as early as December of 2017 was admitted to in an Information Disclosure Statement filed by the '161 patent Applicant (pages 5-24) and it is also recorded on the face of the '161 patent (Exhibit 100, pages 1-2).

12. The Patent Owner and others have said that the difference between the Mini and the Mini II is not related to the outward appearance of the footwear upper. Instead, they say it relates to a new stain resistance and tread on the Mini II (page 3-4; true and correct copies of publications explaining the II versions and showing the Mini and Mini II on sale at least as early as July 14th and July 19th of 2016).

13. Petitioner Next Step Exhibit 1006 is true and correct images of the UGG Classic Short boot, which has been for sale since at least 2005. These images were downloaded by me on January 26, 2024. The first images (page 1) showing the sale of the UGG Classic short were captured from [www.amazon.com](https://www.amazon.com/UGG-Classical-Short-Sheepskin-Chestnut/dp/B000IN2UHA/ref=sr_1_3?crd=7KX9PHHQHMQ1&keywords=ugg%2Bclassic%2Bshort&qid=1706600541&srefix=ugg%2Bclassic%2Bshort%2Caps%2C72&sr=8-3&th=1):

[https://www.amazon.com/UGG-Classical-Short-Sheepskin-](https://www.amazon.com/UGG-Classical-Short-Sheepskin-Chestnut/dp/B000IN2UHA/ref=sr_1_3?crd=7KX9PHHQHMQ1&keywords=ugg%2Bclassic%2Bshort&qid=1706600541&srefix=ugg%2Bclassic%2Bshort%2Caps%2C72&sr=8-3&th=1)

[Chestnut/dp/B000IN2UHA/ref=sr_1_3?crd=7KX9PHHQHMQ1&keywords=ugg%2Bclassic%2Bshort&qid=1706600541&srefix=ugg%2Bclassic%2Bshort%2Caps%2C72&sr=8-3&th=1](https://www.amazon.com/UGG-Classical-Short-Sheepskin-Chestnut/dp/B000IN2UHA/ref=sr_1_3?crd=7KX9PHHQHMQ1&keywords=ugg%2Bclassic%2Bshort&qid=1706600541&srefix=ugg%2Bclassic%2Bshort%2Caps%2C72&sr=8-3&th=1)

14. The amazon website says the UGG Classic Short boots were manufactured by UGG and on sale on that site starting on October 4, 2005 (page 1) and there are reviews going back well before the '161 patent filing date. As with the UGG Classic Mini, there is an UGG Classic Short II version also. The Patent Owner and others have said that the difference between the Short and the Short II is not related to the outward appearance of the footwear upper. Instead, they say it relates to a new stain resistance and tread on the Short II (page 3-4; publications explaining the II versions and showing the Short and Short II on sale at least as early as July 14th and July 19th of 2016).

15. Petitioner Next Step Exhibit 1007 is a true and correct copy of United States Patent No. D768,974 to MacIntyre, which issued on October 18, 2016.

16. Petitioner Next Step Exhibit 1008 is a true and correct copy of United States Patent No. D790,186 to Chung, which issued on June 27, 2017.

17. Petitioner Next Step Exhibit 1009 is true and correct copies of images of the UGG Neumel Boot, which has been for sale since 2011, as alleged by the Patent Owner in Exhibit 1010 (¶24 (“In 2011, Deckers introduced the UGG Neumel boot ...”). These images were downloaded by me on January 26, 2024. The images (pages 1-6) showing the sale of the UGG Neumel Boot were captured from [www.amazon.com](https://www.amazon.com/UGG-Mens-Neumel-Chukka-Chestnut/dp/B019E4ERKG/ref=sr_1_2?crid=37CV7M9XOWR0D&keywords=U): https://www.amazon.com/UGG-Mens-Neumel-Chukka-Chestnut/dp/B019E4ERKG/ref=sr_1_2?crid=37CV7M9XOWR0D&keywords=U

GG+Men%27s+Neumel+Boot%2C+Chestnut%2C+06&qid=1706603215&sprefix=ugg+men%27s+neumel+boot%2C+chestnut%2C+06%2Caps%2C68&sr=8-2

18. These images state that the boots first went on sale on this site on December 15, 2015 and were manufactured by UGG (page 2). Several reviews appear on this same page that are dated before the ‘161 patent November 8, 2019 filing date, and thus this further confirms that the UGG Neumel Boot is prior art to the ‘161 patent (page 6).

19. Petitioner Next Step Exhibit 1010 is a true and correct copy of a Complaint filed in United States District Court by the Patent Owner against the Petitioner, *Deckers Outdoor Corp. v. Next Step Group, Inc.*, 2:23-cv-00578, filed January 25, 2023, in the Central District of California. The action was later transferred to the United States District Court for the Southern District of New York where it is now pending.

20. Petitioner Next Step Exhibit 1011 is a true and correct copy of the Expert Declaration of Lenny M. Holden.

21. Petitioner Next Step Exhibit 1012 is a true and correct copy of the curriculum vitae of Lenny M. Holden.

22. Petitioner Next Step Exhibit 1013 is a true and correct copy of the Expert Report and Declaration of Rosemary W. Wright.

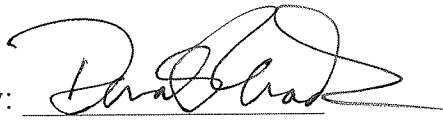
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23. Petitioner Next Step Exhibit 1014 is true and correct copies of images provided, authenticated, and described by Rosemary W. Wright in Exhibit 1013, also identified by numbering, AD001-AD032.

24. I declare that all statements made herein of my knowledge are true, that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: January 30, 2024

By: 
Donald Rhoads