

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-_____

PETITION FOR *INTER PARTES* REVIEW

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Inter Partes Review
U.S. Design Patent No. D927,161

INDEX OF EXHIBITS¹

<u>Exhibit</u>	<u>Description</u>
Ex. 1001	U.S. Design Patent D927,161 to Terras (“the ’161 patent”)
Ex. 1002	Emu Australia Stinger Micro boot (“Emu Stinger Micro Boot”)
Ex. 1003	Chinese Patent No. 304964897 (“CN’897”)
Ex. 1004	UGG Classic Ultra Mini Boot
Ex. 1005	UGG Classic Mini Boot
Ex. 1006	UGG Classic Short Boot
Ex. 1007	U.S. Patent No. D768,974 to MacIntyre (“MacIntyre’974”)
Ex. 1008	U.S. Patent No. D790,186 to Chung (“Chung’186”)
Ex. 1009	UGG Neumel Boot
Ex. 1010	Complaint in <i>Deckers Outdoor Corp. v. Next Step Group, Inc.</i>
Ex. 1011	Expert Declaration of Lenny M. Holden
Ex. 1012	Lenny M. Holden curriculum vitae
Ex. 1013	Expert Report and Declaration of Rosemary W. Wright
Ex. 1014	AD 001-AD 032 prior art examples cited in Exhibit 1013

¹ These exhibits are further addressed by the Holden (Exhibit 1011), Wright (Exhibit 1013), and Rhoads (Exhibit 1015) Declarations submitted herewith.

Ex. 1015	Donald Rhoads Declaration
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Next Step Group, Inc. respectfully requests institution of an IPR and cancellation of the design claimed in the '161 patent (Exhibit 1001).

I. PRELIMINARY STATEMENT

The challenged design was filed as an application on November 8, 2019 and it purports to claim an ornamental design for a footwear upper. Exhibit 1001. That design uses the same design that was **sold** by another as the Emu Stinger Micro Boot in 2016 (Exhibit 1002) and **issued** in a foreign patent eight months before the application for the '161 patent application was filed (i.e., CN'897 issued on December 28, 2018, Exhibit 1003).

The '161 patent design is also nothing more than a “slightly lower ankle” version of the Patent Owner’s prior art design from 2006, the UGG Classic Mini boot (Exhibit 1005), which changed the shaft height to make the boot easier to slip on. This is exactly how the Patent Owner markets the design: “Offering a similar design to our ultra classic mini ugg boots styles, The Ultra Mini Ugg Boots [design of the '161 patent] have a slightly lower ankle to make it easier for you to slip on.” Exhibit 1004. To offer the same design with different functional upper heights (e.g., heights of the ankle portion or shaft) is obvious under §103. Indeed, it was well known and practiced in the prior art by others with these same types of boots. E.g., Exhibits 1007, 1008, 1014 (each exhibit disclosing different heights as the same

patentable invention or as part of footwear product lines); Holden Decl. ¶¶ 72-74 (Exhibit 1011); Wright Decl. p. 23-25, 27-31 (Exhibit 1013).

In sum, properly viewed in the context of the prior art, the '161 patent design is nothing more than a previously patented design. It also constitutes a slight and obvious functional change to another prior art design (i.e., the UGG Classic Mini) from more than a decade earlier. Thus, the Patent Owner has no basis to lay claim to the resulting “design” as new or non-obvious, and the '161 patent claim is unpatentable. Declarations from two independent experts are being submitted herewith. Exhibits 1011, 1013.

II. THE '161 PATENT

The '161 patent claims the “ornamental design for a footwear upper, as shown and described.” Exhibit 1001. The footwear upper includes an upper portion of the boot, while the lower portion of the boot (e.g., the sole) is shown with broken lines. The '161 patent states that the “broken lines in Figs. 1-7 represent portions of the footwear that form no part of the claimed design.” Figures 2 and 3 of the '161 patent are below:

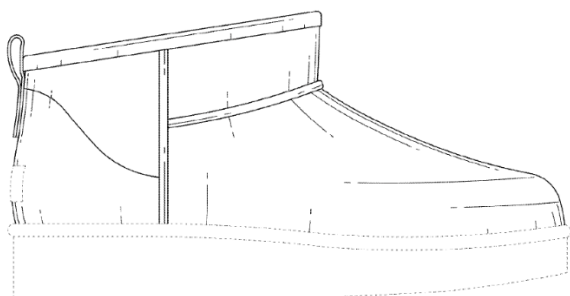


FIG. 2

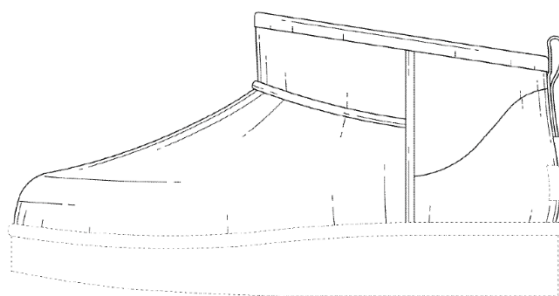


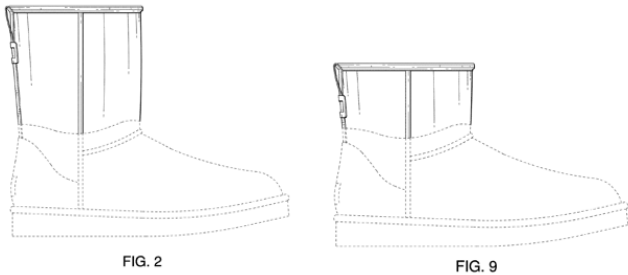
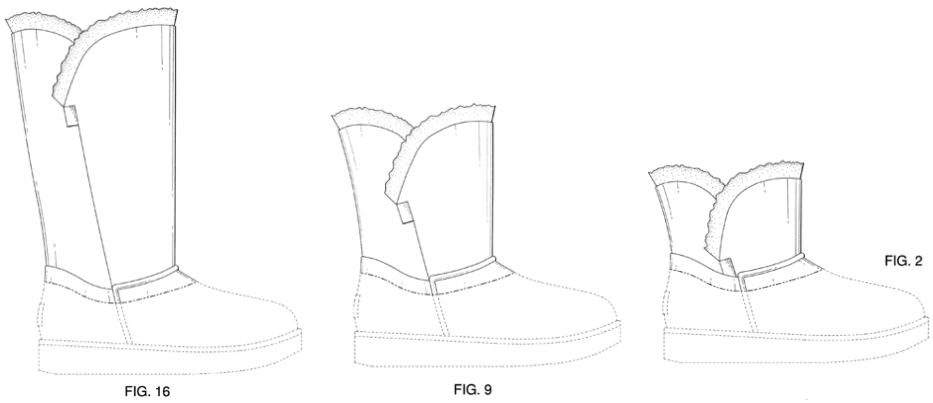
FIG. 3

III. STATEMENT OF RELIEF REQUESTED

Claim 1 of the '161 patent is unpatentable and should be cancelled in view of the following prior art and grounds.

A. Prior Art References

Index of Specific Prior Art References	
Ref. 1	Emu Stinger Micro Boot, sold since 2016, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1002). Rhoads Decl. ¶ 3-6 (Exhibit 1015). 
Ref. 2	CN'897, issued December 28, 2018, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1003). Rhoads Decl. ¶ 7.  后视图 主视图

Ref. 3	UGG Classic Mini boot, on sale since 2006, is prior art under 35 U.S.C. § 102(a)(1) (Exhibits 1005; 1001 (pages 1-2)). Rhoads Decl. ¶ 9-12. 
Ref. 4	MacIntyre'974, issued October 18, 2016, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1007). Rhoads Decl. ¶ 15. 
Ref. 5	Chung'186, issued June 17, 2017, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1008). Rhoads Decl. ¶ 16. 

Ref. 6	UGG Neumel Boot, on sale since 2011, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1009, 1010 (¶24)). Rhoads Decl. ¶¶ 17-18. 
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B. The Prior Art Not of Record in the File History

The Examiner made no prior art rejections during the prosecution of the ‘161 patent and never referred to any individual prior art reference in an Office Action. There was also no Examiner’s Statement of Reasons for Allowance that characterized the prior art of record. Only Section 112 rejections were made. However, the Examiner cited several references in a PTO-892 form and the Applicant cited two in an Information Disclosure Statement, as identified on the face of the ‘161 patent (Exhibit 1001).

As cited in this petition, Ref 1 (the Emu Stinger Micro Boot) and Ref 6 (the UGG Neumel Boot) were not cited on the face of the ‘161 patent or in the file history. This is new prior art for the Board to consider. The Emu Stinger Micro is from one of the Patent Owner’s principal competitors, Emu Australia, whom the Patent Owner sued, among other times, in December of 2010 (Exhibit 1002, p. 13-15). The UGG Neumel Boot is from the Patent Owner itself. It is difficult to

imagine any scenario where the Patent Owner, and specifically the Applicant, was not aware of these references while drafting and prosecuting the '161 patent.

In addition, Petitioner contends that there is significant evidence that Ref. 2 (CN'897) and Ref. 3 (the UGG Classic Mini) were not considered fully by the Examiner and are effectively new references for the Board to consider.

As to Ref. 2, the Examiner identified CN'897, as prior art, as indicated on the face of the '161 patent and in the file history, and a copy of portions of CN'897 are in the file history. However, the images in the file history are so poor that the reference is not fairly represented for purposes of design patent prosecution, as this comparison shows (Exhibit 1003 contains a copy of the patent and the version in the file history (shown in the lower image)):

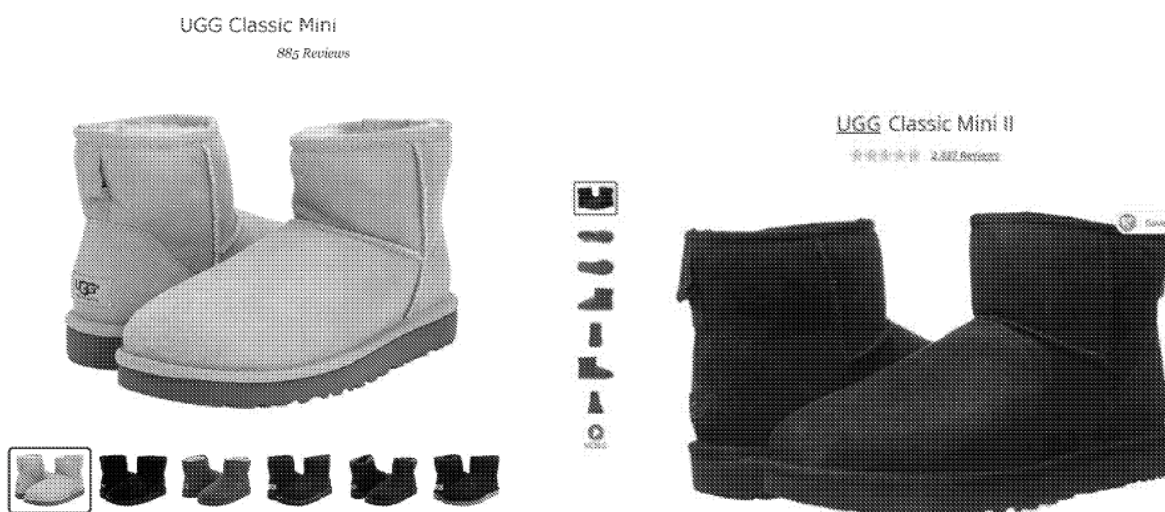


主视图



In particular, the yellow line in CN'897, which tracks a similar line in the '161 patent design, is not observable in the file history copy. The Examiner made no rejections based on CN'897.

Additional instances of poor images are the only two prior art references cited and provided by the Applicant. The Applicant identified Ref. 3, the UGG Classic Mini and the UGG Classic Mini II, as prior art on sale since 2006 and 2017 in an Information Disclosure Statement (January 14, 2020; Exhibit 1005, pages 5-24). *These are the Patent Owner's own products.* However, the images provided by the Applicant are from a Zappos website – not the Patent Owner's website, which also sold the boots, and which has several additional views of the products.) The images that Applicant supplied are remarkably so poor that this prior art also cannot be considered fairly represented for design patent prosecution (Exhibit 1005 also contains copies of the non-patent literature retrieved by Petitioner from the file history), and no rejections were made by the Examiner using them:



Certain of the rear boot lines in particular cannot be observed in the images supplied by the Applicant in the file history. They also appear to show an exaggerated vamp (the front of the boot). However, the UGG Classic Mini II image

(on the right) does show a sloping top line (like the ‘161 patent design), which is not as visible in other images of the product.

Of the references relied on in this petition, the Emu Stinger Micro Boot and the UGG Neumel Boot were not considered in any form. The Patent Owner’s UGG Neumel Boot, which provides a pull tab **identical** to the pull tab of the ‘161 patent claim, is not referred to in any way on the face of the ‘161 patent or in the file history. If the Examiner believed that the ‘161 patent pull tab in the patent figures was a non-functional element, and that this design was not in the prior art, it may explain why the Examiner made no prior art rejections.

Indeed, **none** of the combinations of references relied on in this petition (i.e., Grounds 5 and 7-10, below), or grounds based on a single reference (i.e., Grounds 1-4 and 6, below), regarding the pull tab or otherwise, were made or even referred to in the prosecution history of the ‘161 patent.

C. Grounds of Unpatentability

As explained further in Sections V.B. and V.C. below on claim construction, this petition proposes alternative constructions for the pull tab on the back of the footwear upper: (1) the first based on the construction that the pull tab is purely functional and thus not properly considered as part of the ornamental design; and (2) the second based on the Patent Owner’s anticipated construction in which the claimed design encompasses an allegedly ornamental, non-functional, pull tab of

the figures. Regardless of the construction adopted, the claim of the '161 patent is unpatentable based on the grounds identified in the table below, which also identifies the proposed construction used for each ground.

Ground	Index of Grounds of Unpatentability	Claim Construction
1	Emu Stinger Micro anticipates the claim of the '161 patent under 35 U.S.C. § 102	Pull Tab Functional
2	Emu Stinger Micro renders the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
3	CN'897 anticipates the claim of the '161 patent under 35 U.S.C. § 102	Pull Tab Functional
4	CN'897 renders the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
5	Emu Stinger Micro or CN'897 in combination with UGG Neumel Boot render obvious the claim of the '161 patent under 35 U.S.C. § 103	Pull Tab Ornamental
6	UGG Classic Mini renders the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
7	UGG Classic Mini and UGG Neumel Boot render the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Ornamental
8	UGG Classic Mini, and MacIntyre'974 and/or Chung'186, render the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
9	UGG Classic Mini, and MacIntyre'974 and/or Chung'186, in combination with UGG Neumel	Pull Tab Ornamental

	Boot render the claim of the ‘161 patent obvious under 35 U.S.C. § 103	
10	UGG Classic Mini and CN’897, together alone or in combination with the other references, render the claim of the ‘161 patent obvious under 35 U.S.C. § 103	Pull Tab Ornamental or Functional

None of these ten grounds of unpatentability were applied by the Examiner during the prosecution of the ‘161 patent. The only rejections that were made in the prosecution did not concern the prior art (i.e., they were based on 35 U.S.C. § 112). There is little evidence from the prosecution history that confirms that the Examiner appreciated the substance of these prior art references (especially in light of the poor images of CN’897 and the UGG Classic Mini prior art references, addressed above), alone or in combination, or these specific grounds of unpatentability.

IV. DISCRETIONARY DENIAL IS NOT WARRANTED

Discretionary denial under 35 U.S.C. § 314(a) is not warranted in this case because the *Fintiv* factors do not favor denial. *See Apple v. Fintiv*, IPR202000019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). The *Fintiv* factors include: (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the

defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits.

The first factor is neutral because neither party has requested a stay² in the parallel district court litigation. *See, e.g., Samsung Elecs. Co. Ltd. v. Staton Techiya LLC*, IPR 2022-01078, Paper 10 at 13 (PTAB Dec. 29, 2022) (finding the first factor neutral where no stay had been granted).

The second factor weighs against discretionary denial. No trial date has been scheduled in the action. The Patent Office's Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation at 8-9 (June 21, 2022) ("Interim Procedure") states that this factor should be analyzed in light of the median time to trial for civil actions. According to the most recent statistics (June 30, 2022), the median time from filing to trial for civil cases in the Southern District of New York is 47.0 months, up more than two months from the previous year. U.S. District Courts – Federal Court Management Statistics – Profiles – September 30, 2023, *available at*:

https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0930.2023.pdf

This 47-month period establishes an expected trial date in December 2026 for the parallel district court litigation, which was filed in January of 2023 (in California, and transferred to New York, which indicates even more than 47

² Petitioner intends to seek a stay once *inter partes* review is instituted.

months is likely). This is far longer than the projected statutory deadline for a final written decision. Accordingly, this factor weighs against discretionary denial. *See, e.g., Apple v. Jawbone Innovations, LLC*, IPR2022-01084, Paper 9 at 17 (PTAB Dec. 16, 2022) (finding factor 2 to “weigh[] against discretionary denial” where the trial date was “around the same time or after” the projected final written decision).

The third factor strongly weighs against denial. As of the filing of this petition, not much substantively has transpired in the district court litigation. An answer was filed in July of 2023. Only very limited discovery, concerning a mediation, scheduled for January 31, 2024, has taken place. Nor have any substantive motions been filed. Nor has any claim construction taken place. Thus, petitioner submits this factor weighs against discretionary denial.

As to the fourth factor, Petitioner stipulates that, unless the Board denies or later vacates institution, it will not pursue invalidity in the district court based on any of the specific prior art grounds asserted in the petition that are addressed by the Board (i.e., in a final written decision on the merits). This stipulation prevents overlap because it requires the grounds asserted in the parallel proceedings to be mutually exclusive. *See* Interim Procedure at 7-8. As the Board in *Apple* found, such a stipulation mitigates to some degree the concerns of duplicative efforts and weighs marginally against discretionary denial. *Apple v. Jawbone Innovations, LLC*, IPR2022-01084, Paper 9 at 19-20 (discussing *identical* stipulation).

Factor 5 is neutral or at worst slightly favors denial. It is not disputed that the parties here are the same. The Board has found this factor neutral in similar circumstances. *See, e.g., Protect Animals with Satellites, LLC v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11 at 17 (PTAB Mar. 4, 2022) (finding the 5th factor neutral despite identical parties, based on the trial date).

Factor 6 overwhelmingly weighs against denying institution. As demonstrated throughout this petition, the merits are compellingly strong. New prior art not considered before, and combinations of prior art, are grounds for finding unpatentability. Petitioner has demonstrated a more than reasonable likelihood of success. Indeed, the design patent at issue in this case is exceedingly simple in nature. Given the rudimentary nature of the challenged design and the resulting limited issues for review, it should not be difficult to observe that the merits of the petition are strong. Accordingly, the Board should grant institution here because “there is compelling evidence of unpatentability.” Interim Procedure at 5; *see also* Interim Procedure at 3-4 (noting the desire to “give third parties a quick, inexpensive, and reliable alternative to district court litigation to resolve questions of patent validity”) (citations omitted).

In view of the foregoing factors, Petitioner submits that discretionary denial is not warranted in this case.

V. CLAIM CONSTRUCTION

A. The Solid Lines Define the Scope

The scope of the ‘161 patent is defined by the solid lines in Figures 1-7 — as opposed to the broken or dashed lines. *See, e.g., Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001); 37 C.F.R. § 1.152; MPEP § 1503.02, Subsection III.

Although the Federal Circuit has recognized the “difficulties entailed in trying to describe a design in words” and has stated that the “preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design,” it has also recognized that it may be “helpful to point out . . . various features of the claimed design as they relate to the accused design and the prior art.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679-80 (Fed. Cir. 2008). Accordingly, Petitioner construes the claim based on the solid lines of the ‘161 patent along with limited verbal descriptions of certain features relevant to the prior art.

The specification of the ‘161 patent states that the patent claims the “ornamental design for a footwear upper, as shown and described.” ‘161 patent, claim 1. The description of the figures notes that “[t]he broken line in FIGS. 1-7 represent portions of the footwear that form no part of the claimed design.” ‘161 patent, description. Fig. 2 of the ‘161 patent is reproduced below.

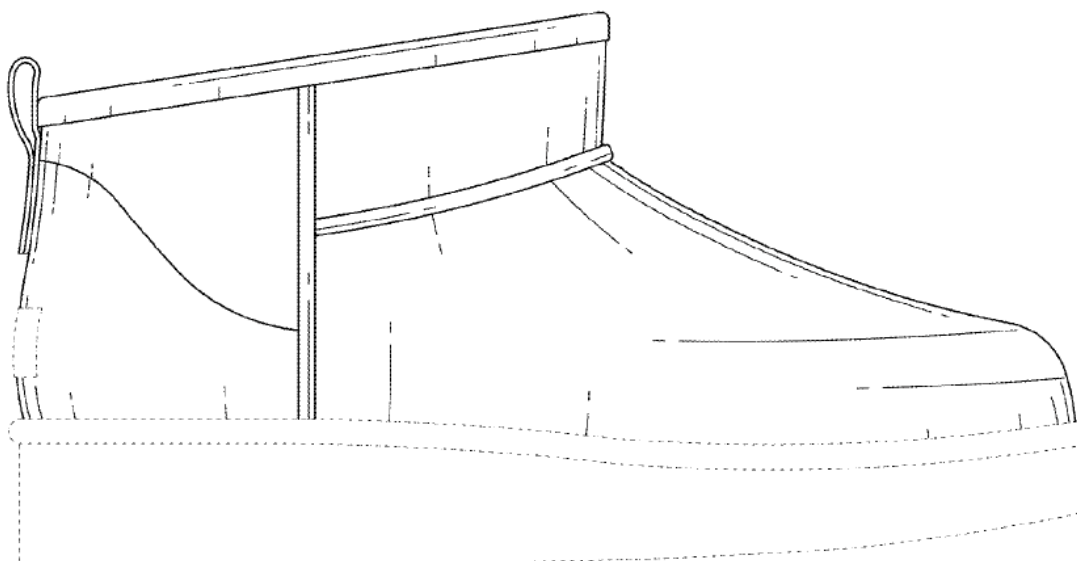


FIG. 2

As shown in Fig. 2, the claimed design does not include the bottom portion of the footwear. Nor does the claimed design include anything attached to or contained within the interior of the footwear.

B. The Patent Owner's Positions on Non-Functional Elements

At this stage of the proceeding, a verbal construction may not be necessary to describe the overall ornamental nature of the '161 patent claim as the figures interpreted with their solid and broken lines provide a description of the design. However, such a verbal construction is not prohibited and it may be helpful, especially in this case because the Patent Owner took great effort to describe what it contends are its position on the non-functional elements of the design. *See, e.g., Egyptian Goddess*, 543 F.3d at 679-680.

The Patent Owner contends that the ‘161 patent covers its “UGG Classic Ultra Mini” design. E.g., Exhibit 1010 (¶69). Importantly, the Patent Owner also contends that the same design is also covered by a “UGG Classic Ultra Mini Trade Dress”. E.g., Exhibit 1010 (¶37-39). Specifically, the Patent Owner has identified (¶37) what it contends are the “non-functional elements” of this design:

37. In 2018,³ Deckers introduced the UGG® Classic Ultra Mini, marketed and featuring the design elements protected under the “Classic Ultra Mini Trade Dress.” The Classic Ultra Mini Trade Dress is unique and inherently distinctive, and comprised of the following non-functional elements:

- a. An ankle-high boot;
- b. Classic suede boot styling;
- c. An exaggerated, raised and exposed circular stitch pattern;
- d. Exposed tufting;
- e. A raised and rounded vamp;
- [f. A suede heel overlay on the boots exterior;]
- g. Fabric binding along the top of the boot [and along the sole];
- [h. A thick, flat sole;] and
- i. A top line that is higher in the front and lower in the back.

Thus, the Patent Owner has necessarily described what it contends is the claimed subject matter of the ‘161 patent design and identified the (allegedly) “non-functional elements” with items a. through e., part of g., and i. in the Patent

³ The patent owner amended the date to now read 2020. However, in at least one other lawsuit asserting the same trade dress and ‘161 patent, the patent owner has not amended the date. *Deckers Outdoor Corp. v. Primark US Corp*, 1:23-cv-10233 (D. Mass. January 30, 2023), Dkt. 1 (¶20).

Owner's list. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Labs. Inc.*, IPR 2020-00086, Paper 8 at 18-22 (PTAB Apr. 27, 2020). The only exception to the applicability of this list is the lower portions of the '161 claimed footwear upper that are identified by broken lines in the '161 patent figures (i.e., items f., part of g. and h. in the Patent Owner's list), which are not part of the patent claim because they are drawn with broken lines (as addressed above). It should be noted that the Patent Owner impliedly recognizes the functionality (i.e., non-ornamentality) of the pull tab and does not list the pull tab as a non-functional element in its trade dress claim.

Accordingly, for purposes of this petition, Petitioner adopts as one alternative construction for purposes of analysis of the prior art the Patent Owner's own construction of the claimed '161 patent design to cover items a. through e., part of g., and i. in the Patent Owner's list of (allegedly) non-functional elements of the design.⁴

C. Alternative Constructions for the Pull Tab

The '161 patent shows a pull tab above the heel in figures 1-3, and 5-7. This is obviously not ornamentation but instead is a functional element that is used to

⁴ Petitioner reserves the right to proffer different positions concerning the Patent Owner's trade dress allegations and patent claim construction positions in different contexts and/or in the future as these proceeding progress.

pull the footwear on to the foot, an important function and part of the Patent Owner's marketing message. E.g., Exhibit 1004; *see also* Exhibits 1011 (Holden Decl. (¶ 64-67)), 1013 (Wright Decl. (p. 25-27)). Hence, neither the Patent Owner's description of the allegedly non-functional elements of the trade dress for the design (addressed above), nor the Petitioner, contend in the first instance that the pull tab is a non-functional element of the '161 patent design. In this regard, a Patent Owner's statements before a federal court on the scope of a design may be cited here and considered by the Board pursuant to 35 U.S.C. §§ 301(a)(2) and (d). Such statements may be considered to determine the proper meaning of patent claims. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Labs. Inc.*, IPR 2020-00086, Paper 8 at 18-22 (PTAB Apr. 27, 2020).

Furthermore, while there are other pull tabs possible (e.g., Exhibit 1007, MacIntyre'974), the type of pull tab shown in the '161 patent figures is the kind that is generally used in shorter shaft, lower ankle height footwear to make it easier to pull up and put the boot on the foot (e.g., Exhibit 1009, the UGG Neumel Boot). It is also securely attached for actual use, countering that it is ornamental. Any other pull tab (e.g., not at the top of the footwear as in the UGG Neumel Boot) would not be as efficient and hence is not an acceptable alternative. E.g., Exhibits 1011 (Decl. (¶ 64-67)), 1013 (Wright Decl. (p. 25-27)).

Nevertheless, it is anticipated that the Patent Owner will attempt to avoid anticipation by the CN'897 reference, which does not disclose a pull tab, or other asserted references, for which the pull tab may not look exactly the same. If the Patent Owner contends that a pull tab should be construed to be a non-functional element, the claim is still invalid over the prior art, including Exhibit 1009, the UGG Neumel Boot from 2011 (and still sold today), which is another ankle height boot (e.g., Exhibit 1010, ¶24 (UGG Neumel Boot trade dress description by the Patent Owner, where the pull tab is again not described as a non-functional element)). The UGG Neumel Boot uses the same pull tab as the '161 patent claim.

Accordingly, Petitioner proposes alternative claim constructions for the pull tab. First, Petitioner proposes to construe the '161 patent design to encompass footwear uppers with or without a pull tab because it is purely functional and not part of an ornamental design.⁵ Grounds 1-4, 6, 8 and 10 address this construction.

⁵ Petitioner provides these alternative constructions only for purposes of this proceeding and reserves the right to advocate different constructions. *See General Electric Co. v. Vestas Wind Sys. A/S*, IPR2018-00928, Paper 9 at 14-16 (PTAB Nov. 5, 2018) (“[T]he rule does not prohibit a petitioner from submitting more than one construction, including one that it believes is incorrect, such as a patent owner’s expected construction”).

Second, in the alternative Petitioner proposes to construe the ‘161 patent design to cover footwear uppers with a pull tab as part of an ornamental design. Grounds 5, 7, 9 and 10 address this construction. Where Petitioner expects the Patent Owner to advance a certain construction that differs from Petitioner’s construction, presentation of alternative constructions has been approved by the Board. *See, e.g., Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc.*, IPR 2020-00921, Paper 13 at 44 (PTAB Aug. 5, 2021) (recognizing that petitioners are often required to anticipate arguments that may be advanced by the patent owner in a preliminary response resulting in their arguing in the alternative); *10X Genomics*, IPR 2020-00086, Paper 8 at 22 (“The regulatory history accompanying 37 C.F.R. § 42.104(b)(3) expressly contemplates that a petitioner may rely on alternative claim constructions.”).

D. The ‘161 Patent Design is Purely Functional

This petition is focused on applying the prior art to the claim of the ‘161 patent. However, both the Petitioner, and each of the two experts retained on its behalf, came to the independent conclusion after studying the design that the entire subject matter of the claim of the ‘161 patent (including the pull tab) is functional, not ornamental, and the design is purely functional, dictated by the function, including the height of the shaft, the pattern used to make the footwear upper, and the stitching used to put the material cut in the pattern together. E.g., Exhibits 1011

(Holden Decl. (¶¶ 39-54, 64-67)), 1013 (Wright Decl. (p. 25-31)); *see e.g., Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016) (“a design patent cannot claim a purely functional design—a design patent is invalid if its overall appearance is ‘dictated by’ its function”). Alternative designs would cost more, be more uncomfortable, fall apart and not hold together, and would thus not be commercially viable. *Id.* The evidence shows that there is nothing ornamental about the design left to render the claim patentable for a design patent to be valid. If the Board has the power to do so, it should declare the ‘161 patent invalid for being directed to a purely functional design.

However, for purposes of this petition, in light of the fact that the prior art is on point regardless of the issue of functionality, the Petitioner assumes (with its two experts) that there are ornamental aspects of the ‘161 patent design in order to apply the prior art. Thus, this petition should not be construed to waive Petitioner’s functionality defense in any manner whatsoever. Petitioner reserves the right to pursue such defense in litigation if the Board feels it does not have the power to address it (e.g., as part of claim construction in this proceeding).

VI. APPLICABLE LEGAL STANDARDS

A. Anticipation Under 35 U.S.C. § 102

The ordinary observer test is the “the sole test for anticipation.” *Int’l*

Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1240 (Fed. Cir. 2009).

This test asks whether an ordinary observer, familiar with the prior art, would be deceived into believing that the prior art reference and the claimed design are the same. *Egyptian Goddess*, 543 F.3d at 675, 681. The “ordinary observer” is one of ordinary acuteness who is a principal purchaser of the underlying articles with the claimed design. *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1337 (Fed. Cir. 2015) (citations omitted).

B. Obviousness Under 35 U.S.C. § 103

“For design patents, the ultimate inquiry for obviousness is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F.3d 1379, 1383 (Fed. Cir. 2020). “Obviousness is a question of law based on underlying factual questions [including] ‘(1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness.’” *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014). (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

To determine whether a design patent is obvious, the Federal Circuit applies a two-part test. First, before prior art can be combined, there must exist a

“‘primary reference,’ i.e., a single reference that creates ‘basically the same visual impression’ as the claimed design.” *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, at 1275 (Fed. Cir. 2021) (citing *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). To be “basically the same,” the designs cannot have substantial differences in their overall visual appearances or require major modifications. *Id.* (citing *Spigen Korea Co. v. Ultraproof, Inc.*, 955 F.3d 1379, 1383 (Fed. Cir. 2020)).

Second, after identifying the primary reference, secondary references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d, 1326, 1331 (Fed. Cir. 2014). The secondary references must be “so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Id.* (internal quotations and brackets omitted).

Alternatively or additionally, Petitioner asserts that the ‘161 design patent is invalid for obviousness under the standards in the Supreme Court’s *KSR* decision. It reserves all rights associated therewith, pending a ruling by the en banc Federal Circuit on the applicability of *KSR* to design patents. *LKQ Corp. v. GM Glob. Tech. Operations LLC*, No. 2021-2348, 2023 U.S. App. LEXIS 1412, at *2 (Fed.

Cir. Jan. 20, 2023), *vacated and reh'g granted, LKQ Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383 (Fed. Cir. 2023) (en banc).

VII. DESIGNER OF ORDINARY SKILL

Petitioner submits that a designer of ordinary skill at the time would have been someone with a bachelor's degree in design or an equivalent field, or two years of practical experience designing footwear. Such persons are often members of a development team that have input into the design of footwear. Exhibits 1011 (Holden Decl. (¶ 31-36)), 1013 (Wright Decl. (p. 21)). A higher level of skill is likely not warranted given the simple nature of the footwear in issue. *Id.*

VIII. OVERVIEW OF THE PRIOR ART

A. The Emu Stinger Micro Boot (Exhibit 1002)

The Emu Stinger Micro Boot has been sold since 2016, by one of the Patent Owner's biggest competitors, Emu Australia, at least three years before the application that led to the '161 patent was filed on November 8, 2019. The Patent Owner and Emu Australia have been involved in several lawsuits, each brought by the Patent Owner, according to Emu Australia. Exhibit 1002, pages 13-15. The boot was sold on the Amazon website (which has verified purchaser reviews from the entire time period), and Emu's own website, among others, since 2016. It is thus prior art under at least 35 U.S.C. § 102(a)(1). Images of the boot include the following:



B. CN'897 (Exhibit 1003)

CN'897 is a Chinese utility patent that issued on December 28, 2018, before the '161 patent application was filed on November 8, 2019.

The CN'897 patent is owned by Guangdong Camel Fashion Co. Ltd. of Foshan, China and there is no record known to the Petitioner that the owner is related to the Patent Owner or that CN'897 is related to knowledge of the '161 patent subject matter. The Patent Owner currently contends in this action that the subject matter of the '161 patent was not disclosed until 2020 (Exhibit 1010, corrected). CN'897 is thus prior art under at least 35 U.S.C. § 102(a)(1) and no exceptions of 35 U.S.C. § 102(b) apply.

CN'897 discloses a “Snow Boot” design in seven figures:



主视图



俯视图



后视图



仰视图



左视图



立体图



右视图

C. UGG Classic Mini (Exhibit 1005)

The UGG Classic Mini is a boot sold continuously by the Patent Owner since 2006. An admission was made to that effect in an Information Disclosure Statement in the prosecution history of the '161 patent, which is reflected on the face of the patent. Exhibit 1001, pages 1-2; Exhibit 1005, pages 5-24. Its upper portion is believed to have never been the subject matter of a design patent, and it is a cut down version of the still older and taller UGG Classic Short boot. The UGG Classic Mini II is the same outward design that is stain resistant and has an outsole with more traction: no changes were made to the overall visual impression of the footwear upper. Exhibit 1005, pages 3-4; Exhibit 1006. This boot from the Patent Owner is prior art under at least 35 U.S.C. § 102(a)(1). Different views of the UGG Classic Mini appear as follows:

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D. MacIntyre'974 (Exhibit 1007)

MacIntyre'974 is a U.S. design patent that issued on October 18, 2016. It is owned by the Patent Owner. MacIntyre'974 is prior art under at least 35 U.S.C. § 102(a)(1).

MacIntyre'974 discloses two embodiments of a footwear upper design and 14 figures. The two embodiments differ in the height of their shaft portions yet they are the same allegedly patentable invention. In addition, although set out in broken lines, the MacIntyre'974 used the exact same stitch lines as the '161 patent design, the UGG Classic Short (Exhibit 1006), and the UGG Classic Mini (Exhibit 1005), at the very least suggesting its combination with the other references cited in this petition:

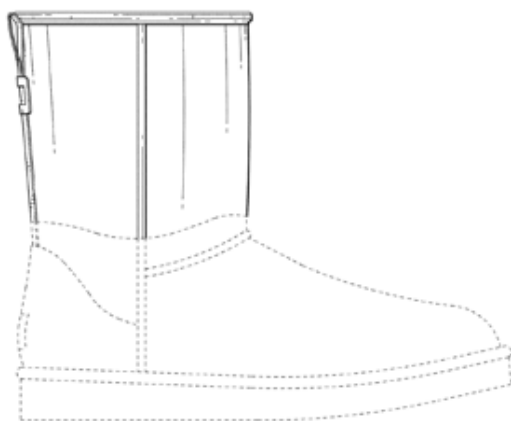


FIG. 2

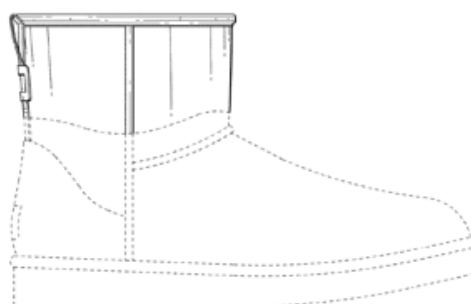


FIG. 9

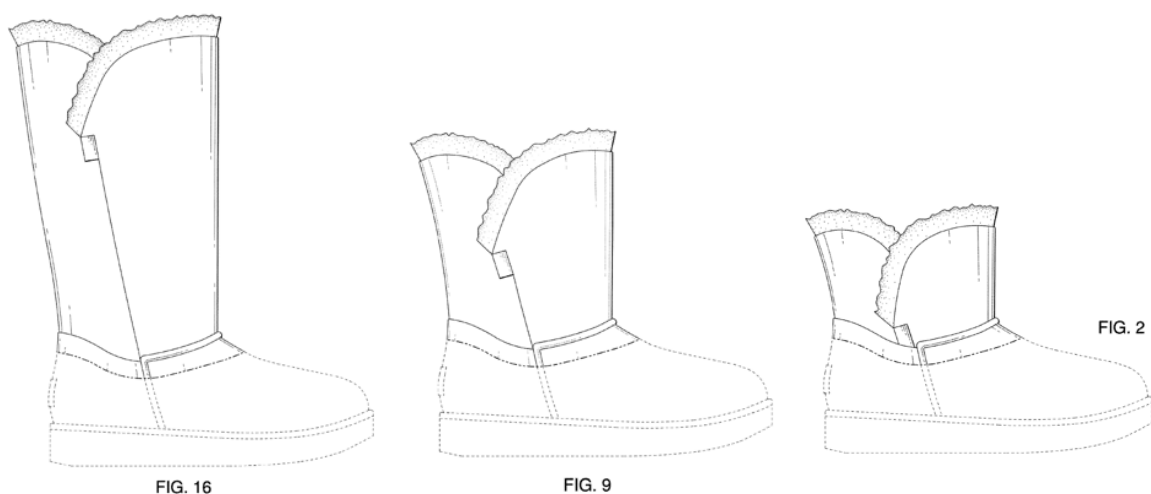
These two figures designs were plainly issued in one patent, instead of maintaining a restriction requirement to separate the designs into two patents. This

demonstrates that varying the shaft height is not a separate invention. Varying the shaft height does not render a design patentably distinct.

E. Chung'187 (Exhibit 1008)

Chung'187 is a U.S. design patent that issued on June 17, 2017. It is owned by the Patent Owner. Chung'187 is prior art under at least 35 U.S.C. § 102(a)(1).

Chung'187 discloses three embodiments of a footwear upper design and 21 figures. The three embodiments differ in the height of their shaft portions yet they are the same allegedly patentable invention:



This again confirms that varying the shaft height does not render a design patentably distinct.

F. UGG Neumel Boot (Exhibit 1009)

The UGG Neumel Boot is a well-known boot sold continuously by the Patent Owner since 2011. E.g., Exhibit 1010 (¶24). Its upper portion is believed to have never been the subject matter of a design patent. It is prior art under at least

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35 U.S.C. § 102(a)(1). Different views of the UGG Neumel Boot appear as follows:

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G. Additional References Concerning Shaft Height (Exhibit 1014)

The MacIntyre'974 (Exhibit 1007) and Chung'186 (Exhibit 1008) both relate to the obviousness (e.g., knowledge and practice) of applying the same design to footwear of different shaft heights. E.g., Exhibits 1011 (Holden Decl. (¶ 72-74)), 1013 (Wright Decl. (p. 23-25, 27-31)). Exhibit 1014 illustrates more evidence of this knowledge and practice in pages AD01-AD032 (or pages 1-32), which is specifically applied by Rosemary W. Wright in her expert declaration (Exhibit 1013 (p. 23-25, 27-31)).

IX. THE '161 PATENT IS UNPATENTABLE OVER THE PRIOR ART

The anticipation and obviousness of the '161 patent claim are addressed below with respect to the prior art and the eight asserted grounds. For obviousness in particular, (1) the scope and content of the prior art; (2) the level of ordinary skill in the art (addressed above and with respect to the particular grounds); (3) the differences between the claimed invention and the prior art; and (4) objective evidence of non-obviousness, are each addressed herein.

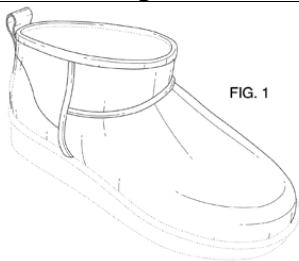
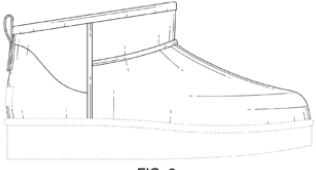
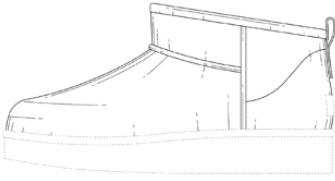
Motivation to combine any references is also addressed, and is provided by the knowledge of the ordinary designer of skill to make footwear to fit different needs (e.g., slipper-like, inside use needs versus protective, outside use needs; a product line with different shaft heights; ease of taking off and putting on boots; using a pull tab to make a boot easier to take off) and the references themselves,

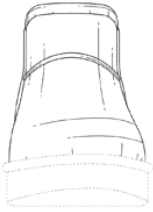
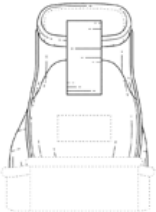
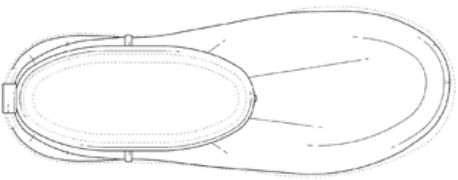
which are all highly related boots like the ‘161 patent claim subject matter. E.g., Exhibits 1011 (Holden Decl. (¶ 72-74)), 1013 (Wright Decl. (p. 23-25, 27-31)).

No objective evidence of non-obviousness is known to Petitioner or has been provided by the Patent Owner. E.g., Exhibit 1011 (Holden Decl. (¶ 71)).

A. Ground 1: Anticipation Under § 102 by Emu Stinger Micro

The Emu Stinger Micro (Exhibit 1002) disclosed the same overall visual impression as the ‘161 patent claimed design under the claim construction where the pull tab is functional. Exhibit 1011 (Holden Decl. ¶ 75-82). As a result, the claim is anticipated by the Emu Stinger Micro.

View	‘161 patent	Emu Australia Stinger Micro
1	 FIG. 1	
2	 FIG. 2	
3	 FIG. 3	

4	 FIG. 4	
5	 FIG. 5	
6	 FIG. 6	
7	 FIG. 7	

As shown above, the Emu Boot has the same footwear upper as that claimed in the '161 patent: that is, the footwear upper is the same, as the lower portion is not claimed in the '161 patent and is set out with broken lines therein. Indeed, the Emu Boot has each of the relevant (allegedly) non-functional elements identified by the Patent Owner (Exhibit 1010 (¶ 37-39)), namely, a. An ankle-high boot (Views 1-5); b. Classic suede boot styling (Views 1-5); c. An exaggerated, raised and exposed circular stitch pattern (Views 1-5); d. Exposed tufting (View 5-6); e. A

raised and rounded vamp (Views 1-4); g. Fabric binding along the top of the boot [and along the sole] (Views 1-6); and i. A top line that in some views appears to be slightly higher in the front and lower in the back (Views 2 and 5; the UGG Classic Mini II submitted in the file history). Holden Decl. at ¶ 79.

In view of the above, an ordinary observer familiar with the relevant prior art, including the prior art references cited in this petition, would be deceived into believing that the Emu Stinger Micro Boot, taken as a whole, is the design claimed in the ‘161 patent. To the extent there are any minor variations, they do not preclude a finding of anticipation because the overall impression created of two ankle high boots with all of the ornamental features remains equivalent between the Emu Boot and the ‘161 patent. For example, while the Emu footwear upper may have a slightly less sloped top line, a person of ordinary skill would likely not regard this as a difference in “design” because the overall impression created by the footwear upper would remain the same. Exhibit 1011 (Holden Decl. ¶ 75-82).

Like *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243 (Fed. Cir. 2009), where the court agreed that slight variations in the “number and position of the circular holes” in shoes (e.g., Croc shoes) did not preclude a finding of anticipation because the overall visual impression remained the same, here any slight variations the Patent Owner may allege would not change

the overall visual impression created by the Emu Stinger Micro Boot: that of simply the same footwear upper design.

In *International Seaway*, the Federal Circuit considered the design of shoes (e.g., Croc shoes) with holes as part of the design. While that case specifically addressed the differing number and position of holes in two shoe design and found the difference would not have precluded a finding of anticipation, the result would have been the same had the case addressed differences in shoe size or outside textures instead. That is, a longer or shorter shoe design (appropriate for people with bigger/longer or smaller/shorter feet) or outside textures would also not have precluded anticipation so long as the overall visual impression remained the same between shoe designs. The same is true here: a longer or shorter size or outside textures of an ornamental feature does not preclude a finding of anticipation because the overall visual impression remains the same. *Id.*

B. Ground 2: Obviousness Under § 103 Over Emu Stinger Micro

In view of the common knowledge of a designer having ordinary skill in the art, where the pull tab is functional, the claim is obvious under 35 U.S.C. § 103 over the Emu Stinger Micro Boot (Exhibit 1002). Exhibit 1011 (Holden Decl. ¶ 83-88).

The Emu Stinger Micro is a suitable primary reference because its “design characteristics [] are basically the same as the claimed design.” *Durling*, 101 F.3d

at 103. The Emu footwear upper has the same design claimed in the ‘161 patent. Indeed, the Emu Stinger Micro is so similar to the claimed design that no secondary reference is necessary.

To the extent there are any differences (under the Patent Owner’s construction or otherwise) between the Emu Boot and the claimed design, the Emu Boot itself readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For instance, to the extent the Patent Owner argues that the proportions of the footwear upper (i.e., the overall height and proportions) differ between the Emu Stinger Micro Boot and the claimed design, those proportions would have been obvious because they are purely functional, rather than ornamental in nature. *See Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be “obvious, from a functional standpoint.”). Indeed, the length and width of the portions of the footwear upper is dictated by the size and proportions of the desired boot, which is entirely functional in nature. *See Door-Master*, 256 F.3d at 1312 (“only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection”) (internal quotations and citations omitted).

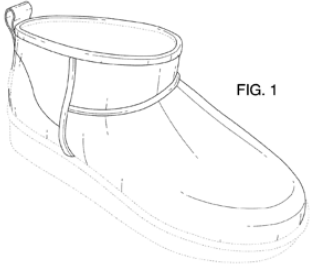
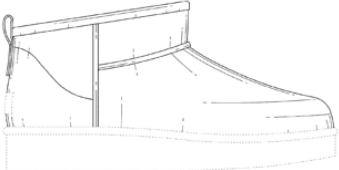
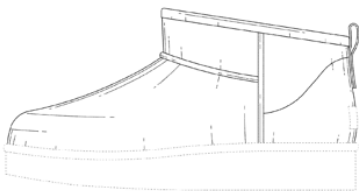
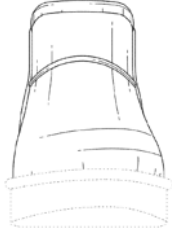
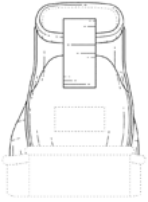
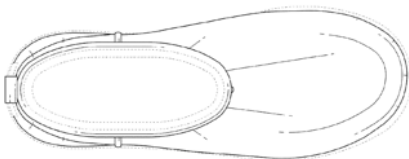
Even if that were not the case, however, a designer of ordinary skill would have found changing the overall length/width of the footwear upper to be trivially obvious. A designer with ordinary skill in the art would have had the common knowledge and skill to understand that any given footwear upper could be easily modified to be longer or shorter depending on the application (e.g., the length of the user's foot, or an easily removed slipper-like indoor use versus footwear for outside and poor weather conditions) and would have been motivated to vary the overall size of the footwear upper to suit the particular application. For example, a shaft is easily changed to be taller or shorter and footwear made more easy or more difficult to be removed from the foot while retaining the same design characteristics as the original boot design. Exhibit 1011 (Holden Decl. ¶ 83-88).

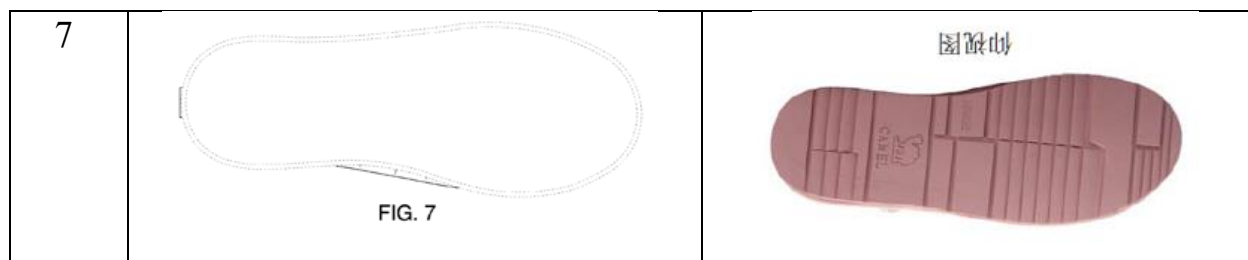
In view of the above, the claim is obvious under 35 U.S.C. § 103 based on the Emu Stinger Micro Boot.

C. Ground 3: Anticipation Under § 102 by CN'897

CN'897 (Exhibit 1003) disclosed the same overall visual impression as the '161 patent claimed design under the claim construction where the pull tab is functional. Exhibit 1011 (Holden Decl. ¶ 89-96). As a result, the claim is anticipated by CN'897. This table compares the '161 patent figures to CN'897:

Inter Partes Review of U.S. Design Patent No. D927,161

View	'161 patent	CN'897
1	 FIG. 1	 立体图
2	 FIG. 2	 后视图
3	 FIG. 3	 主视图
4	 FIG. 4	 左视图
5	 FIG. 5	 右视图
6	 FIG. 6	 俯视图



As shown above, CN'897 has the same footwear upper as that claimed in the '161 patent: that is, the footwear upper is the same, as the lower portion is not claimed in the '161 patent and is set out with broken lines therein. Indeed, CN'897 has each of the relevant (allegedly) non-functional elements identified by the Patent Owner (Exhibit 1010 (§§37-39)), namely, a. An ankle-high boot (Views 1-5); b. Classic suede boot styling (Views 1-5); c. An exaggerated, raised and exposed circular stitch pattern (Views 1-5); d. Exposed tufting (View 5-6); e. A raised and rounded vamp (Views 1-4); g. Fabric binding along the top of the boot [and along the sole] (Views 1-6); and i. A top line that is higher in the front and lower in the back (Views 1-3, 5). Holden Decl. at ¶ 93.

In view of the above, an ordinary observer familiar with the relevant prior art, including the prior art references cited in this petition, would be deceived into believing that CN'897, taken as a whole, is the design claimed in the '161 patent. To the extent there are any minor variations, they do not preclude a finding of anticipation because the overall impression created of two ankle high boots with all of the same ornamental features remains equivalent between CN'897 and the '161 patent. For example, while the CN'897 footwear upper may have some different

textures on the sides, a person of ordinary skill would likely not regard this as a difference in “design” because the overall impression created by the footwear upper would remain the same. Exhibit 1011 (Holden Decl. ¶ 89-96).

Like *International Seaway* (589 F.3d at 1243), where the court agreed that slight variations in the “number and position of the circular holes” in shoes (e.g., Croc shoes) did not preclude a finding of anticipation because the overall visual impression remained the same, here any slight variations the Patent Owner may allege would not change the overall visual impression created by CN’897: that of simply the same footwear upper design.

In *International Seaway*, the Federal Circuit considered the design of shoes (e.g., Croc shoes) with holes as part of the design. While that case specifically addressed the differing number and position of holes in two shoe design and found the difference would not have precluded a finding of anticipation, the result would have been the same had the case addressed differences in shoe size or outside textures instead. That is, a longer or shorter shoe design (appropriate for people with bigger/longer or smaller/shorter feet) or outside textures would also not have precluded anticipation so long as the overall visual impression remained the same between shoe designs. The same is true here: a longer or shorter size or outside textures of an ornamental feature does not preclude a finding of anticipation because the overall visual impression remains the same. *Id.*

D. Ground 4: Obviousness Under § 103 Over CN'897

In view of the common knowledge of a designer having ordinary skill in the art, where the pull tab is functional, the claim is obvious under 35 U.S.C. § 103 over CN'897 (Exhibit 1003). Exhibit 1011 (Holden Decl. ¶¶ 97-101).

CN'897 is a suitable primary reference because its “design characteristics [] are basically the same as the claimed design.” *Durling*, 101 F.3d at 103. CN'897's footwear upper has the same design claimed in the '161 patent. Indeed, CN'897 is so similar to the claimed design that no secondary reference is necessary.

To the extent there are any differences (under the Patent Owner's construction or otherwise) between CN'897 and the claimed design, CN'897 itself readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For instance, to the extent the Patent Owner argues that the proportions of the footwear upper (i.e., the overall height and proportions) differ between CN'897 and the claimed design, those proportions would have been obvious because they are purely functional, rather than ornamental in nature. *See Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be “obvious, from a functional standpoint.”). Indeed, the length and width of the portions of the footwear upper is dictated by the

size and proportions of the desired boot and user's, which is entirely functional in nature. *See Door-Master*, 256 F.3d at 1312 (“only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection”) (internal quotations and citations omitted). Exhibit 1011 (Holden Decl. ¶¶ 97-101).

Even if that were not the case, however, a designer of ordinary skill would have found changing the overall length/width of the footwear upper to be trivially obvious. A designer with ordinary skill in the art would have had the common knowledge and skill to understand that any given footwear upper could be easily modified to be longer or shorter depending on the application (e.g., the length of the user's foot, or an easily removed slipper-like indoor use versus footwear for outside and poor weather conditions) and would have been motivated to vary the overall size of the footwear upper to suit the particular application. For example, a shaft is easily changed to be taller or shorter and footwear made more easy or more difficult to be removed from the foot while retaining the same design characteristics as the original boot design. *Id.*

In view of the above, the claim is obvious under 35 U.S.C. § 103 based on CN'897.

E. Ground 5: Obviousness Under § 103 Over Emu Stinger Micro or CN'897, in Combination with the UGG Neumel Boot

Under the Patent Owner's anticipated construction, the claimed design is obvious over the Emu Stinger Micro Boot or CN'897, in combination with the UGG Neumel Boot (Exhibit 1009). Exhibit 1011 (Holden Decl. ¶¶ 102-110).

As explained in Section B above, the Emu Stinger Micro Boot is a suitable primary reference because it has the same design characteristics: that of a footwear upper with all of the (allegedly) non-functional elements of the '161 patent design. As explained in Section D above, CN'897 also is a suitable primary reference because it has the same design characteristics: that of a footwear upper with all of the (allegedly) non-functional elements of the '161 patent design.

To the extent the Patent Owner argues that the pull tab of the '161 patent claim is ornamental and not functional and it differs from either the Emu Stinger Micro Boot or CN'897, Petitioner submits that the claimed design is obvious with reference to the UGG Neumel Boot secondary reference.

The UGG Neumel Boot renders obvious a footwear upper with the same pull tab. The UGG Neumel Boot has the same pull tab as the '161 patent claim:

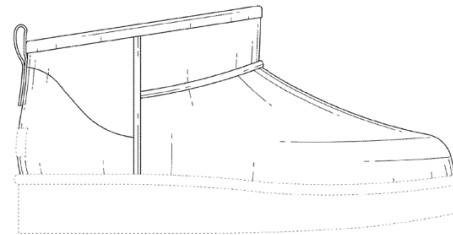


FIG. 2

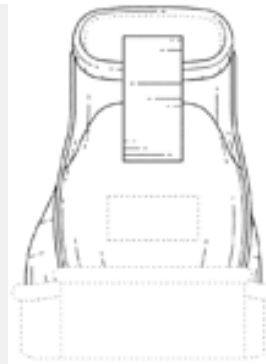


FIG. 5

The UGG Neumel Boot has similar length/width proportions (e.g., ankle height) and the same pull tab disclosed in the claimed design. See '161 patent, Figs. 2 and 5. The UGG Neumel Boot's pull tab is *literally identical* to the '161 patent pull tab. Thus, to the extent the Patent Owner argues that the Emu Stinger Micro Boot or CN'897 does not render the claimed design obvious (see previous Sections B and D) because the Emu Boot or CN'897 lacks a pull tab, it would have been obvious to implement a footwear upper like the Emu Boot or CN'897 discloses with the pull tab of the UGG Neumel Boot. Exhibit 1011 (Holden Decl. ¶¶ 102-110).

A designer of ordinary skill would have found it obvious to add such a pull tab from a commercial product on the market since 2011 to the Emu Boot or CN'897 design because it would have made it easier to put on and remove the footwear from the foot. Such a desire is well known in the art concerning boots. At a minimum, adding such a pull tab from the same, ankle-high footwear would have been obvious to try. Designing the footwear upper of the '161 patent with a pull tab that matched the pull tab of the UGG Neumel Boot was a simple design choice that involved no more than a mere substitution of one known element for another (i.e., substituting a heel with no pull tab for one with a pull tab). Implementing the Emu Boot's or CN'897's footwear upper with the pull tab of the UGG Neumel Boot would have beneficially and obviously created a footwear upper that would be easier to put on and take off the foot. This would have been a desirable option so that the resulting footwear upper would be easier to use. *Id.*

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) ("obvious changes in arrangement and proportioning are no more patentable in one case than in the other"). Indeed, there is nothing unpredictable or nonobvious about adding a pull tab to a boot back, heel portion.

The UGG Neumel Boot reference is "so related to the primary reference" as to suggest the application of its pull tab feature to the Emu Boot or CN'897

because each of the references are footwear uppers of the same ankle height. Each reference relates to boots. A designer of ordinary skill would have immediately recognized that features from one footwear upper, whether ornamental or functional, could easily be applied to the other.

The resulting footwear upper would continue to have the (allegedly) non-functional elements disclosed in the Emu Boot or CN'897. Under the Patent Owner's anticipated construction, which encompasses a non-functional pull tab, the resulting footwear upper would be identical to the claimed footwear upper.

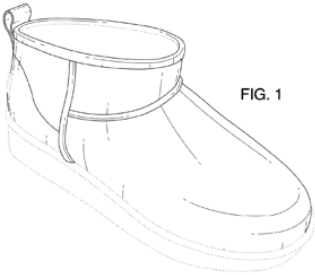
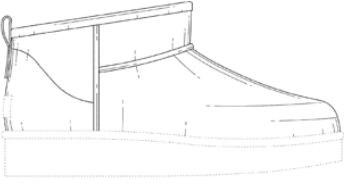
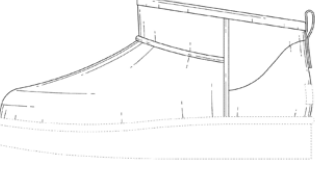
To the extent the Patent Owner alleges there are any other differences when compared to the claimed design, the Emu Boot, CN'897, and the UGG Neumel Boot readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) ("obvious changes in arrangement and proportioning are no more patentable in one case than in the other").

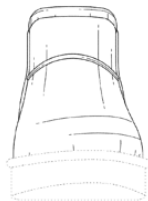
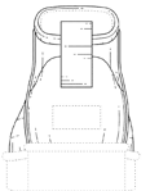
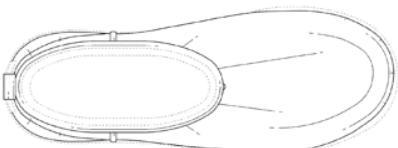
F. Ground 6: Obviousness Under § 103 Over the UGG Classic Mini

The UGG Classic Mini (Exhibit 1005) discloses the same overall visual impression as the claimed design. Exhibit 1011 (Holden Decl. ¶¶ 111-121). Thus, the UGG Classic Mini and the common knowledge of a designer having ordinary skill in the art renders obvious (if not anticipates) the claimed design. The main differences are in the height of the shaft, where the '161 patent design has a

“slightly lower ankle” to make it easy to take off and put on (Exhibit 1004) and thus the UGG Classic Mini has a “slightly higher” shaft. Exhibits 1011 (Holden Decl. ¶ 111-121); 1013 (Wright Decl. at p. 23-25, 27-31).

The UGG Classic Mini and the UGG Classic Mini II have the same outer design and differ in only stain resistance and tread (which are not relevant to patentability of the ‘161 Patent design). Exhibit 1005. The Patent Owner represented in an Information Disclosure Statement (Exhibit 1005) reflected on the face of the ‘161 patent that the two products have been for sale since 2006 and 2017, and thus they are prior art under 35 U.S.C. §102(a)(1). A comparison of the ‘161 patent figures with the UGG Classic Mini outer design follows:

View	‘161 patent	UGG Classic Mini
1	 FIG. 1	
2	 FIG. 2	
3	 FIG. 3	

4	 FIG. 4	
5	 FIG. 5	
6	 FIG. 6	
7	 FIG. 7	

An ordinary observer, familiar with the relevant prior art, including those cited in this petition, would be deceived into believing the UGG Classic Mini design is the same design claimed in the '161 patent. To the extent there are any minor variations, those would not preclude a finding of obviousness (or even anticipation) because the overall visual impression remains the same — that of a footwear upper with certain (allegedly) non-functional elements. *See, e.g., Int'l Seaway Trading*, 589 F.3d at 1243. In other words, there are no substantial differences between the UGG Classic Mini and the claimed design. Exhibits 1011 (Holden Decl. ¶ 111-121); 1013 (Wright Decl. p. 23-25, 27-31).

As shown above, the UGG Classic Mini has the same footwear upper design as that claimed in the ‘161 patent: that is, the footwear upper is the same, as the lower portion is not claimed in the ‘161 patent and is set out with broken lines. Indeed, the UGG Classic Mini has each of the relevant (allegedly) non-functional elements identified by the Patent Owner (Exhibit 1010 (¶¶37-39)), namely, a. An ankle-high boot (Views 1-5); b. Classic suede boot styling (Views 1-5); c. An exaggerated, raised and exposed circular stitch pattern (Views 1-5); d. Exposed tufting (View 5-6); e. A raised and rounded vamp (Views 1-4); g. Fabric binding along the top of the boot [and along the sole] (Views 1-6); and i. A top line that in some views appears to be higher in the front and lower in the back (Views 2 and 5; *see also* the image of the Mini II submitted in the file history (Exhibit 1005, page 11), which appears to have a sloped top line). Holden Decl. at ¶ 116.

The UGG Classic Mini is a suitable primary reference because its “design characteristics [] are basically the same as the claimed design.” *Durling*, 101 F.3d at 103. The UGG Classic Mini’s footwear upper has the same design claimed in the ‘161 patent. It is also the same design as the UGG Classic Short (Exhibit 1006), and is merely a continuum in that product line. Indeed, the UGG Classic Mini is so similar to the claimed design that no secondary reference is necessary. Exhibits 1011 (Holden Decl. ¶ 111-121); 1013 (Wright Decl. p. 23-25, 27-31).

To the extent there are any differences (under the Patent Owner's construction or otherwise) between the UGG Classic Mini and the claimed design, the UGG Classic Mini itself readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) ("obvious changes in arrangement and proportioning are no more patentable in one case than in the other"). For instance, to the extent the Patent Owner argues that the proportions of the footwear upper (i.e., the overall height and proportions) differ between the UGG Classic Mini and the claimed design, those proportions would have been obvious because they are purely functional (e.g., relating to putting on and removing the boot, how much of the ankle is covered), rather than ornamental in nature. *See Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be "obvious, from a functional standpoint."). Indeed, the length and width of the portions of the footwear upper is dictated by the size and proportions of the desired boot, which is entirely functional in nature. *See Door-Master*, 256 F.3d at 1312 ("only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection") (internal quotations and citations omitted). *Id.*

Even if that were not the case, however, a designer of ordinary skill would have found changing the overall length/width of the footwear upper to be trivially

obvious. A designer with ordinary skill in the art would have had the common knowledge and skill to understand that any given footwear upper could be easily modified to be longer or shorter depending on the application (e.g., the length of the user's foot, or an easily removed slipper-like indoor use versus footwear for outside and poor weather conditions) and would have been motivated to vary the overall size of the footwear upper to suit the particular application. For example, a shaft is easily changed to be taller or shorter and footwear made more easy or more difficult to be removed from the foot while retaining the same design characteristics as the original boot design. Some consumers may prefer a higher shaft (e.g. to wear in the snow), while others may prefer a shorter shaft (e.g., for non-snow conditions). In practice, footwear designers apply the same designs to different shaft heights as part of their product lines. *Id.*

In view of the above, the claim is obvious under 35 U.S.C. § 103 based on the UGG Classic Mini.

G. Ground 7: Obviousness Under § 103 Over the UGG Classic Mini and the UGG Neumel Boot

Under the Patent Owner's anticipated construction, the claimed design is obvious over the UGG Classic Mini and the UGG Neumel Boot (Exhibit 1009). While the UGG Classic Mini has a pull tab, it is not identical to the pull tab of the '161 patent claim. If that feature is construed to be non-functional, then these

grounds apply to render the claim obvious. Exhibits 1011 (Holden Decl. ¶ 122-134); 1013 (Wright Decl. p. 23-25, 27-31).

As explained in the previous section, the UGG Classic Mini is a suitable primary reference because it has the same design characteristics: that of a footwear upper with all of the (allegedly) non-functional elements of the ‘161 patent design.

To the extent the Patent Owner argues that the pull tab of the ‘161 patent claim is ornamental and not functional and it differs from the one on the UGG Classic Mini, Petitioner submits that the claimed design is obvious with reference to the UGG Neumel Boot secondary reference.

The UGG Neumel Boot renders obvious a footwear upper with the same pull tab. The UGG Neumel Boot (images on the left) has the same pull tab as the ‘161 patent claim (figures on the right):

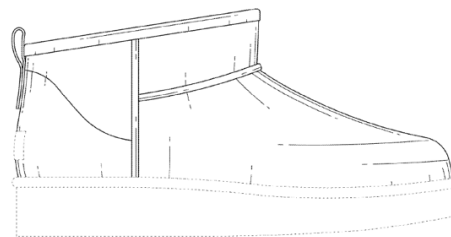


FIG. 2



The UGG Neumel Boot has same length/width proportions (i.e., ankle height) and the same pull tab disclosed in the claimed design. See '161 patent, Figs. 2 and 5. The UGG Neumel Boot's pull tab is *literally identical* to the '161 patent pull tab. Thus, to the extent the Patent Owner argues that UGG Classic Mini does not render the claimed design obvious (see previous section) because the UGG Classic Mini lacks the identical pull tab, it would have been obvious to implement a footwear upper like the UGG Classic Mini discloses with the pull tab of the UGG Neumel Boot. Exhibits 1011 (Holden Decl. ¶ 122-134); 1013 (Wright Decl. p. 23-25, 27-31).

A designer of ordinary skill would have found it obvious to add/substitute such a pull tab from a commercial product on the market since 2011 to the UGG Classic Mini design because it would have made it easier to put on and remove the footwear from the foot with a pull tab situated at the top of the boot. Such a desire is well known in the art concerning boots. At a minimum, adding such a pull tab from the same, ankle-high footwear would have been obvious to try. Designing the

footwear upper of the UGG Classic Mini with a pull tab that matched the pull tab of the UGG Neumel Boot was a simple design choice that involved no more than a mere substitution of one known element for another (i.e., substituting one pull tab for another). Implementing the UGG Classic Mini's footwear upper with the pull tab of the UGG Neumel Boot would have beneficially and obviously created a footwear upper that would be easier to put on and take off the foot. This would have been a desirable option so that the resulting footwear upper would be easier to use. *Id.*

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d at 1019 (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). Indeed, there is nothing unpredictable or nonobvious about adding or substituting a pull tab to a boot back, heel portion.

The UGG Neumel Boot reference is “so related to the primary reference” as to suggest the application of its pull tab feature to the UGG Classic Mini because both references are footwear uppers of the same ankle height. Both references relate to boots. A designer of ordinary skill would have immediately recognized that features from one footwear upper, whether ornamental or functional, could easily be applied to the other. *Id.*

The resulting footwear upper would continue to have the (allegedly) non-functional elements disclosed in the UGG Classic Mini. Under the Patent Owner's anticipated construction, which encompasses a non-functional pull tab, the resulting footwear upper would be identical to the claimed footwear upper.

To the extent the Patent Owner alleges there are any other differences when compared to the claimed design, the UGG Classic Mini and the UGG Neumel Boot readily suggests those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) ("obvious changes in arrangement and proportioning are no more patentable in one case than in the other").

Differences in proportions also would have been obvious because they are purely functional, rather than ornamental in nature. *See Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be "obvious, from a functional standpoint."). Indeed, the length and width of the footwear upper is entirely dictated by the size and proportions of the desired boot and its use, which is entirely functional in nature. *See Door-Master*, 256 F.3d at 1312 ("only the nonfunctional aspects of an ornamental design as shown in a patent are proper bases for design patent protection") (internal quotations and citations omitted). *Id.*

With these variations in mind, an ordinary designer would have found any alleged proportional differences between the UGG Classic Mini and the claimed design to be obvious. A designer with ordinary skill in the art would have had the common knowledge and skill to understand that any given footwear upper design could be easily modified to be longer or shorter depending on the application and would have been motivated to make such modifications. A longer shaft footwear upper is easily designed to have a shorter shaft while retaining the same design characteristics as the original. Here, changing the overall length and width of a footwear upper, while retaining the same design characteristics, would have been trivially obvious to an ordinary designer. Exhibits 1011 (Holden Decl. ¶ 122-134); 1013 (Wright Decl. p. 23-25, 27-31).

The UGG Classic Mini (and the UGG Classic Short) not only suggests that (1) the overall shape of the footwear upper could be easily varied, but also suggests that (2) the length of the shaft could vary from footwear upper to footwear upper. A designer of ordinary skill would have found it obvious to vary the relative length of the shaft to arrive at lengths/widths similar to the claimed design based on considerations such as (1) ease of putting the boots on and taking them off, and (2) ankle coverage and support. At a minimum, changing the relative length of the shafts would have been obvious to try in view of the varied designs in the prior art. *Id.*

To the extent there are any other differences between the UGG Classic Mini and the claimed design, they are exceedingly minor. Any other difference is *de minimus* and not sufficient to justify a finding that the claimed design is patentable under § 103. *Id.*

In view of the above, the claim is obvious under 35 U.S.C. § 103 based on the UGG Classic Mini and the UGG Neumel Boot.

H. Ground 8: Obviousness Under § 103 Over the UGG Classic Mini and MacIntyre’974 and/or Chung’186

The claimed design is obvious over the UGG Classic Mini and MacIntyre’974 (Exhibit 1007) and/or Chung’186 (Exhibit 1008) if the pull tab of the ‘161 patent claim is construed to be functional. Exhibits 1011 (Holden Decl. ¶¶ 135-143); 1013 (Wright Decl. p. 23-25, 27-31).

As explained in previous sections (i.e., Grounds 6 and 7), the UGG Classic Mini is a suitable primary reference because it has the same design characteristics as that of the ‘161 patent claim. To the extent the Patent Owner argues that the overall proportions (e.g., length/width, shaft length) of the footwear uppers differ between the UGG Classic Mini and the claimed design, Petitioner submits (*see* previous section Ground 6) that the claimed design is obvious without reference to a secondary reference. Petitioner also maintains that a mere variation of the overall proportions is not patentable because it is entirely functional in nature and how the

boot will be taken off and put on. *Monoflo*, 5 F.3d 1505; *Door-Master*, 256 F.3d at 1312. *Id.*

Regardless, however, MacIntyre’974 and Chung’186 each independently teach that it is the same alleged patentable invention to change the shaft length and the overall height among embodiments and to still obtain the same overall impression of the design. MacIntyre’974 teaches two different shaft lengths while Chung’186 teaches three. Thus, to the extent the Patent Owner argues that the UGG Classic Mini does not render the claimed design obvious because the UGG Classic Mini has a footwear upper with a slightly different length/width or shaft length, it would have been obvious to implement a footwear upper with varying length/widths and shaft lengths in view of MacIntyre’974 and/or Chung’186. Exhibits 1011 (Holden Decl. ¶ 72-74, 135-143); 1013 (Wright Decl. p. 23-25, 27-31).

A designer of ordinary skill would have found it obvious to vary the length and width and shaft length of the design of the UGG Classic Mini in view of MacIntyre’974 and/or Chung’186 at least because such was known to be done by these references from UGG, a popular, well-known footwear provider that is owned by the Patent Owner. At a minimum, such a proportional change would have been obvious to try. *Id.*

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). Indeed, there is nothing unpredictable or nonobvious about designing a shaft length to be shorter to allow for footwear to more easily be removed or put on the foot and/or as part of a product line. *Id.*

The MacIntyre’974 and Chung’186 are “so related to the primary reference” as to suggest varying the dimensions of the UGG Classic Mini. Each of the references relates to footwear uppers and features from such, whether ornamental or not, would have been readily applicable to the other by a designer of ordinary skill.

To the extent Patent Owner alleges there are any other differences when compared to the claimed design, the UGG Classic Mini, MacIntyre’974 and Chung’186 readily suggest those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For example, any differences in the proportioning of the footwear uppers is readily suggested by MacIntyre’976 and Chung’186. As discussed in the preceding sections, a designer of ordinary skill would have known that the shaft lengths could be dimensioned in any way to achieve the same overall desired boot

and would have found it obvious to vary the shaft lengths to arrive at proportions similar to the claimed design based on considerations such as (1) ease of taking off and putting on the boots, and (2) the amount of ankle to cover. Any other differences, to the extent there are any, are *de minimus* and not sufficient to justify a finding that the claimed design is patentable under § 103.

I. Ground 9: Obviousness Under § 103 Over the UGG Classic Mini, MacIntyre’974 and/or Chung’186, and the UGG Neumel Boot

If the pull tab of the ‘161 patent claim is construed to be non-functional, then for the reasons set forth above for Grounds 7 and 8 above, the ‘161 patent claim is obvious over the UGG Classic Mini, MacIntyre’974 and/or Chung’186, and the UGG Neumel Boot. Exhibits 1011 (Holden Decl. ¶ 144-149); 1013 (Wright Decl. p. 23-25, 27-31).

Each of these references is directed to footwear uppers that are boots and it would be obvious to combine their features, or at least obvious to try, for the reasons set forth for Grounds 7 and 8 above. Together they provide the shaft length, proportions, and pull tab of the ‘161 patent. In particular, the UGG Neumel Boot provides the identical pull tab of the ‘161 patent claim to make the boot easier to put on and take off and together they render the claim obvious. *Id.*

J. Ground 10: Obviousness Under § 103 Over the UGG Classic Mini and CN’897

Using the UGG Classic Mini as a suitable primary reference as explained above because its “design characteristics [] are basically the same as the claimed

design” (*Durling*, 101 F.3d at 103), combined with CN’897 with its design that is also basically the same as the claimed design, provides the approximate shaft length of the ‘161 patent claim and renders that claim obvious. The same holds true if CN’897 is used as the primary reference because it too has the same design characteristics, as addressed above. Exhibit 1011 (Holden Decl. ¶ 150-156).

These references are directed to the same footwear uppers that each have the same (allegedly) non-functional elements as the ‘161 patent claim, as set forth above, making them appropriate and obvious to combine (or at least obvious to try). Strong motivation comes from making the boot easier to put on and take off and to build product lines with different shaft lengths and the same design. If the pull tab is construed to be non-functional, then the UGG Neumel Boot can be combined with these references, which are all directed to the same footwear upper subject matter, to render the ‘161 patent claim obvious. *Id.*

In addition, these two references can be combined with the knowledge of a designer of ordinary skill to make changes in shaft height to serve particular needs and build out product lines (Exhibits 1007, 1008, 1014; Exhibits 1011 (Holden Decl. ¶ 72-74, 150-156); 1013 (Wright Decl. p. 23-25, 27-31)) with and without pull tabs (Exhibit 1009).

K. The Teachings of *KSR*

Application of the Supreme Court’s teachings in *KSR* only further confirms the obviousness of the ‘161 Patent design. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727 (2007). Although *KSR* was a utility patent case, the en banc Federal Circuit is considering whether it applies to design patents as well. *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 71 F.4th 1383 (Fed. Cir. 2023) (en banc).

KSR teaches that “When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 550 U.S. at 417, 127 S. Ct. at 1740. These principles are directly applicable to each of the grounds of unpatentability set forth above; including, for example, varying the shaft height, or adding a pull tab.

Likewise, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge

possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418, 127 S. Ct. at 1740-41. The prior art and expert testimony both show that the demands known to the design community, and present in the marketplace, make the features of the ‘161 Patent obvious.⁶

Indeed, “in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420, 127 S. Ct. at 1742. The ‘161 Patent here, at best, addresses “a known problem for which there was an obvious solution encompassed by the patent’s claims” (*KSR*, 550 U.S. at 420, 127 S. Ct. at 1742), by making trivial variations to the prior art to adjust shaft height, add a pull tab, and so forth. Legally, this is not “invention.” On

⁶ “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.” *KSR*, 550 U.S. at 421, 127 S. Ct. at 1742.

the contrary, “[g]ranting patent protection to advances that would occur in the ordinary course without real innovation retards progress.” *KSR*, 550 U.S. at 419, 127 S. Ct. at 1741.

X. MANDATORY NOTICES

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

The Petitioners and real parties-in-interest are Next Step Group, Inc. The Patent Owner is the real party-in-interest concerning the ‘161 patent according to its admissions in its Complaint (Exhibit 1010).

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

A search of relevant records shows that the Patent Owner has asserted the ‘161 patent in cases captioned as follows:

Deckers Outdoor Corporation v. Walmart, Inc. and Does 1-10, 2:23-cv-00575 (C.D. CA. January 25, 2023).

Deckers Outdoor Corp. v. Primark US Corp, 1:23-cv-10233 (D. Mass. January 30, 2023).

Deckers Outdoor Corporation v. The Partnerships And Unincorporated Associations Identified On Schedule “A”, 1:23-cv-16072 (E.D. Ill. November 17, 2023).

Deckers Outdoor Corporation v. The Partnerships And Unincorporated Associations Identified On Schedule “A”, 1:24-cv-00008 (E.D. Ill. January 2, 2024).

Deckers Outdoor Corporation v. The Partnerships And Unincorporated Associations Identified On Schedule “A”, 1:24-cv-00372 (E.D. Ill. January 16, 2024).

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

A power of attorney with designation of counsel is filed herewith. Lead and Back-Up Counsel are as follows:

Lead Counsel	Back-Up Counsel
Morris E. Cohen (Reg. No. 39947) GOLDBERG COHEN LLP 1350 Avenue of the Americas, 3rd Floor New York, New York 10019 (646) 380-2087 (phone – main) (646) 380-2084 (phone – direct) (646) 514-2123 (fax) MCohen@GoldbergCohen.com	Lee A. Goldberg (Reg. No. 38894) GOLDBERG COHEN LLP 1350 Avenue of the Americas, 3rd Floor New York, New York 10019 (646) 380-2087 (phone – main) (646) 380-2084 (phone – direct) (646) 514-2123 (fax) LGoldberg@GoldbergCohen.com

D. Service Information Under 37 C.F.R. § 42.8(b)(4)

Please address all correspondence to lead and back-up counsel at the addresses shown above. Petitioner consents to electronic service by email.

XI. GROUNDS FOR STANDING

Petitioner certifies the ‘161 patent is available for IPR and that Petitioner is not barred or estopped from requesting IPR of the ‘161 patent challenging the claim on the grounds in this petition. This petition is being filed within the one-year deadline in which to file a petition from the January 31, 2023 date of the

service of the Patent Owner's complaint of patent infringement of the '161 patent (Exhibit 1010).

XII. CONCLUSION

Petitioner requests IPR and cancellation of claim 1 of the '161 patent because it is unpatentable based on the foregoing grounds.

Date: January 30, 2024

Respectfully submitted,

By: /Morris E. Cohen/
Morris E. Cohen
Lead Counsel

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(a)(1)(i), the undersigned hereby certifies that the foregoing PETITION FOR *INTER PARTES* REVIEW OF U.S. DESIGN PATENT NO. D927,161 contains 12,791 words, excluding parts of the Petition exempted under § 42.24(a), as measured by the word-processing system used to prepare this paper.

Date: January 30, 2024

Respectfully submitted,

By: /Morris E. Cohen/
Morris E. Cohen
Lead Counsel

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on January 30, 2024, a copy of the foregoing PETITION FOR *INTER PARTES* REVIEW OF U.S. DESIGN PATENT NO. D927,161, and Petitioner's Exhibits 1001-1015, were served according to an agreement of the parties (including to the correspondence address of record indicated in the Patent Office's Patent Center system for U.S. Design Patent No. D927,161, which is Greer, Burns & Crain, Ltd., 300 S. Wacker Dr., Suite 2500, Chicago, IL 60606, UNITED STATES), by email (with consent) to the Patent Owner's litigation counsel of record:

Brent A. Blakely
bblakely@blakelylawgroup.com
Jamie J. Fountain
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Date: January 30, 2024

Respectfully submitted,

By: /Morris E. Cohen/
Morris E. Cohen
Lead Counsel