

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. 2024-00525

Supplemental Declaration of Expert Lenny M. Holden

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I, Lenny M. Holden, declare as follows:

I. The Scope Of This Supplement And The New Obviousness Standard

1. I prepared the January 29, 2024 “Declaration of Expert Lenny M. Holden in Support of a Petition for *Inter Partes* Review of U.S. Design Patent No. D927,161” (“January 29th Declaration”). I understand it was designated as Exhibit 1011, with my CV designated as Exhibit 1012, in this proceeding.

2. I have been asked to supplement my opinions set forth in my January 29th Declaration regarding a new standard of obviousness that came out after my January 29th Declaration by applying the new standard to the same prior art I applied in my January 29th Declaration.

3. In light of this new obviousness standard, I prepared this supplement only on the issue of obviousness of the ‘161 patent (Grounds 2 and 4-10 from my January 29th Declaration) and I do not supplement, but still rely on, the other information and opinions set forth in my CV (Exhibit 1012) and January 29th Declaration (Exhibit 1011), such as my background and qualifications, the functionality of the ‘161 patent design, and the anticipation of the ‘161 patent design (Grounds 1 and 3), among other things.

4. In forming my opinions, I have reviewed and considered any material that is referred to in this declaration, including the following non-exhaustive list of materials:

- The '161 patent (which I have been told is Exhibit 1001 to the petition).
- The Emu Australia Stinger Micro product, as shown in its sales literature (which I have been told is Exhibit 1002 to the petition).
- Chinese Patent No. 304964897 (“CN’897”) and copies of translations, including one from the ‘161 patent file history (which I have been told is Exhibit 1003 to the petition).
- A January 2, 2024 print-out from the website www.theuggstore.com.au for the “UGG Classic Ultra Mini” product (which I have been told is Exhibit 1004 to the petition), which I can confirm is representative of the product because I purchased an UGG Classic Ultra Mini and examined it closely.
- The UGG Classic Mini and UGG Classic Mini II products, as shown in their sales literature (which I have been told is Exhibit 1005 to the petition), which I can confirm is representative of the products because I purchased an UGG Classic Mini and examined it closely.
- The UGG Classic Short product, as shown in its sales literature (which I have been told is Exhibit 1006 to the petition).
- U.S. Design Patent No. D768,974 to MacIntyre (“MacIntyre’974”) (which I have been told is Exhibit 1007 to the petition).

- U.S. Design Patent No. D790,186 to Chung (“Chung’186”) (which I have been told is Exhibit 1008 to the petition).
- The UGG Neumel Boot, as shown in its sales literature (which I have been told is Exhibit 1009 to the petition).
- The Complaint (and correction) in *Deckers Outdoor Corporation v. Next Step Group, Inc.*, 2:23-cv-00578 (C.D. California) (which I have been told is Exhibit 1010 to the petition).
- My curriculum vitae (which I have been told is Exhibit 1012 to the petition)

5. I have been asked to assume that Exhibits 1002, 1003, 1005, 1006, 1007, 1008, 1009, and specifically, the Emu Australia Stringer Micro (Exhibit 1002), the CN’897 Snow Boot (Exhibit 1003), the UGG Classic Mini (Exhibit 1005), the UGG Classic Mini II (Exhibit 1005), the UGG Classic Short (Exhibit 1006), the MacIntyre’974 Footwear Upper (Exhibit 1007), the Chung’186 Footwear Upper (Exhibit 1008), and the UGG Neumel Boot (Exhibit 1009) each qualify as prior art to the ’161 patent in printed publications.

II. The Obviousness Legal Standards From The LKQ Case And Guidance

6. I am not a lawyer. Rather, I am a footwear professional and base my analysis on the legal guidelines provided to me as outlined below. However, the opinions expressed, and reasoning applied are those of an experienced footwear professional viewing the relevant questions from the relevant perspectives (e.g.,

product manager, designer, or member of a development team that includes those of ordinary skill in the art.)

7. I have been informed that a new legal standard of obviousness applied to design patents has been issued by the United States Court of Appeals for the Federal Circuit. This new standard is in a case entitled *LKQ Corp. v. GM Global Technology Operations LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024) (“*LKQ case*”).

8. I have also been informed that on May 22, 2024, the United States Patent and Trademark Office issued a document that discusses the application of the *LKQ case*. The document is entitled “Updated Guidance and Examination Instructions for Making a Determination of Obviousness in Designs in Light of *LKQ Corp. v. GM Global Technology Operations LLC*” (“*LKQ Guidance*”).

9. I read the *LKQ case* and the *LKQ Guidance* and became familiar with them. However, as stated above, I am not an attorney and my opinions and reasoning expressed herein are based on (a) those of an experienced consultant in footwear design viewing the relevant questions from the relevant perspectives (e.g., product manager, designer, or member of a development team that includes those of ordinary skill in the art), (b) the description of the new standard that was provided to me and which is provided below.

10. I have been informed that the following legal principles apply to the analysis of patentability pursuant to 35 U.S.C. § 103 concerning obviousness, a

patent law provision that reads: “A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.”

11. I have been informed that in an *Inter Partes* review proceeding, patent claims may be deemed unpatentable if it is shown by a preponderance of the evidence that they were rendered obvious by one or more prior art patents or publications.

12. I have been informed that obviousness is a determination of law based on underlying determinations of fact. I have been informed that there are four factual inquiries I should make in evaluating obviousness and that this is stated in the *LKQ* Guidelines.

13. **Factual Inquiry One:** A primary reference must be identified. The primary reference is analyzed in terms of its visual similarity to the claimed design, but this primary reference need not be “basically the same” as the claimed design. Rather, the primary reference need only be “something in existence—not . . . something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would

require modification of every individual feature.” The “more visually similar the primary reference is to the claimed design, the better positioned” will be the analysis to set forth a *prima facie* case of obviousness.

14. The primary reference will typically be in the same field of endeavor as the claimed ornamental design’s article of manufacture, but it need not be, so long as it is analogous art. It is often the case that the primary reference alone does not render the claimed design obvious, and design elements from secondary prior art references may be considered. As with the primary reference, an analysis must also determine whether a secondary prior art reference is from the same field of endeavor or is analogous.

15. As the Federal Circuit did not define how to determine whether a prior art design outside the field of endeavor of the article of manufacture is analogous, the analysis should consider the degree to which an ordinarily skilled designer would be motivated to consider other fields.

16. **Factual Inquiry Two:** After considering the scope and content of the prior art, the differences between the prior art designs and the design claim at issue must be determined. This approach does not use a threshold “similarity” requirement. Instead, when determining differences between the prior art and the design at issue, the analysis must compare the visual appearance of the claimed design with prior art designs from the perspective of an ordinary designer in the field of the article of manufacture.

17. **Factual Inquiry Three:** In determining the level of ordinary skill in the art, the analysis should consider the knowledge of a designer of ordinary skill who designs articles of the type being examined.

18. **Factual Inquiry Four:** In addition, whenever present, the analysis should continue to consider secondary considerations as indicia of obviousness or nonobviousness. These considerations can include commercial success attributable to the design, skepticism regarding the design, failures of others to solve a long-standing problem, or unexpected results, among others.

19. **Evaluating Obviousness:** After ascertaining the scope and content of the prior art, the knowledge of an ordinary designer in the relevant field, and the differences between the prior art and the claimed design, the analysis must evaluate the obviousness or nonobviousness of the claimed design. If an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design to create the same overall visual appearance as the claimed design, then the claimed design is obvious barring convincing secondary indicia of nonobviousness. This inquiry must focus on the visual appearance of the claimed design as a whole and not on selected individual pieces.

20. The primary and secondary references need not be “so related” that features in one would suggest application of those features in the other, but they must both be analogous art to the patented design. Also, the motivation to combine these references need not come from the references themselves. But there must be

some evidence-supported reason (without impermissible hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design. The analysis should consider that, generally, the more different the overall appearances of the primary reference versus the secondary reference(s), the more difficult it will be to establish a motivation to alter the primary prior art design in light of the secondary one and set forth a *prima facie* case of obviousness.

21. I have been told that the relevant time for considering whether a claim would have been obvious to an ordinary designer is at the time of the alleged design, which I have been told to assume was shortly before the design patent application leading to the '161 patent was filed (shortly before November 8, 2019).

III. Factual Inquiry Three: Level And Designer Of Ordinary Skill

22. Factual Inquiry Three from the *LKQ* Guidance is the level of ordinary skill. I have been asked to articulate or write down a definition for the level of skill of a hypothetical ordinary designer who works alone or with others on the designs of articles of the type involved here (footwear). In my experience, this is often a person working in a footwear development team, as I have done over a number of years for different footwear companies.

23. In this instance, based on my experience in the field, the designer of ordinary skill in the art would be a person who has a bachelor's degree in design or

an equivalent field or alternatively two years of practical experience designing footwear alone or as part of a development team. My opinion on the level of skill for an ordinary designer is a level of skill and not rigidly defined. A combination of education and experience can lead to the same level of skill, where a deficiency in one area (such as education) can be compensated for additional experience in the other (such as more work experience). In footwear design in and around 2019 in particular, much design was done in a development team, where different individuals provide their experience and knowledge to different aspects of the design, and they may come from diverse educational backgrounds. For instance, someone without a bachelors in footwear design might be able to satisfy the level of skill if they had a little more than two years of practical design experience, including that of working on a footwear development team and participating in the various aspects of product development.

24. I note that the level of skill I have articulated is relatively low, and I believe this is appropriate given the relatively simple nature of the boot design at issue.

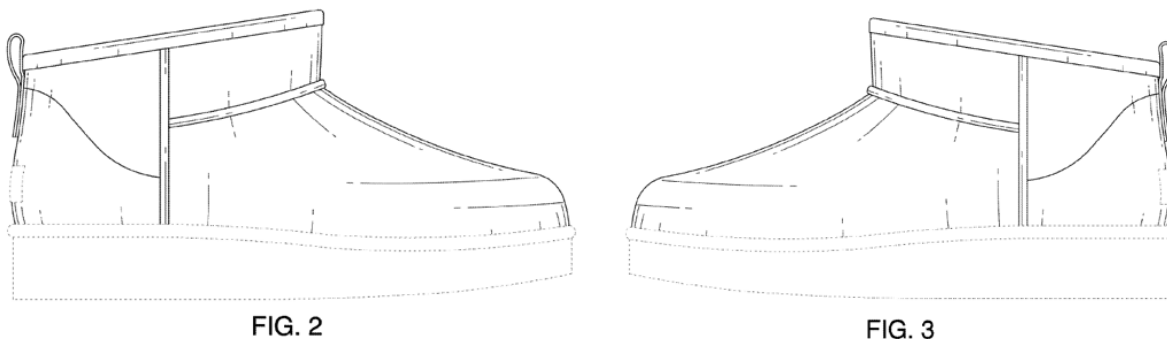
25. I further understand that this designer of ordinary skill is a hypothetical person that is presumed to know the relevant prior art.

26. My opinions below on obviousness are based on this level of skill.

27. I believe I would meet and exceed this definition now and at the time the application for the '161 patent was filed (November 8, 2019).

IV. Overview Of The ‘161 Patent Design As It Relates To The *LKQ* Case

28. The ‘161 patent claims the “ornamental design for a footwear upper, as shown and described.” 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:



29. As is my “standard operating procedure”, which I referred to in my January 29th Declaration, I review and cut open exemplars of products in question. I purchased the Mens Classic Ultra Mini (Exhibit 1004), which the Patent Owner says embodies the ‘161 patent design (Exhibit 1010 ¶69), and the prior art Mens Classic Mini (Exhibit 1005), both in size USA 11 from Amazon.com.

30. My first general observation was that both shoes, like the ‘161 patent figures, have four main pattern features:

Vamp

Forward facing collar

Reward facing collar

Heel Counter

(both shoes and the '161 patent figures have a stitched down pull tab
(stitched to make it strong), which is used to pull the footwear on and off)



31. These pattern pieces are significant because they are logically determined (i.e., functionally determined) from a cutting, stitching, fitting, and most importantly cost perspective.

32. Cost perspective: These boots cannot practically be made from one piece of material, such as the suede that is used in the two UGG boots I purchased.

The seams shown on the boot are required to join several pieces of material together to form the boot. It would be too wasteful and cost prohibitive to use a single large pattern piece. There would be a considerable and unacceptable amount of cutting of material (i.e., suede with shearling backing for these UGG boots) resulting in a tremendous amount of loss to cut such a large pattern. Any reasonable, commercial product development team under these circumstances would break up the pattern into separate parts to be stitched together as much as possible.

33. Fitting perspective: To give the vamp a shape to fit a foot shape (based on the “Last”, which represents the brand’s customers’ basic foot shape) is to have the one-piece smooth vamp. If you were to cut the pattern of the vamp down the middle (for example), the inner fit would be influenced by the inner seam that could cause discomfort. Other seams in other places on the foot should also be avoided so as not to cause discomfort.

34. When you “break” the pattern using this kind of material, a significant seam will be created, simply due to the overall thickness of the material for the boot, i.e., suede with shearling lining for the two UGG boots I examined.

35. The heel counter is non-lined suede because this piece is meant to be flat and is integral to increase the heel fitting effectiveness.

36. Stitching: Typically, the goals are to have the pattern pieces to be combined have strength enough to last the life of the shoe, “hide” the seam, and cover the raw edges of the cut pattern pieces.

37. There are several common ways for attaching pattern pieces together without a raw edge:

Fold and stitch - Folding the edges of the pattern pieces and back stitching them, so the seam is facing the interior.

Binding tape - Piecing the two raw edges of the pattern pieces, covering the edges with binding tape and stitching down the tape through both pieces.



38. There are variations to these themes, including the example of the UGG boots I have examined, where the material dictates the stitching.



39. This method is to take the two pieces, skive the edge so there is no lining at the edge and reduce the thickness of the edges, and reverse the fold and stitch so the seam is on the outside of the boot. They then finish this off with a cross stitch (or zig zag stitch), which increases the strength of this intersection, and also makes the outlook more “finished” and intentional.



40. Also a point that is very important to make is to do this method of pattern attachment, it is almost impossible to stitch a drastically curved pattern piece. The heel of the UGG boots has a different stitch because the heel does not use the same suede/shearling as the rest of the boot.



41. So the logical conclusion is that this pattern used on both UGG boots is dictated by the cost perspective (split pattern pieces to decrease cutting loss) and the stitching perspective (to join the materials used and if they had chosen to have this type of seam inside facing, or on other parts of the boot, the result would likely cause discomfort to the consumer).

42. All of these decisions are very purposeful and in my opinion are predictable, well-known, and functional, from the viewpoint of a footwear professional I defined above. While I used purchased products to illustrate the

points I made above with photographs, the same conclusions would be drawn from the '161 patent figures by the person of ordinary skill in the art identified above and knowledge of the materials and methods used for such designs.

V. Claim Construction To Apply To The *LKQ* Standard

43. I have been told that the scope of a design patent is defined by the solid lines in the figures, as opposed to the broken lines. I can see that the '161 patent confirms this understanding as it includes statements specifically pointing out that the broken lines in the figures are not included in the scope of the claimed design.

44. I have been informed that in the analysis of design patents, detailed verbal descriptions are not usually preferred. I'm told that in some instances though, it can still be helpful to point out certain features of the claimed design that would be apparent to the designer of ordinary skill or the ordinary observer as they relate to the design and the prior art.

45. Throughout this declaration, I rely primary on the solid lines in the figures of the '161 patent for the scope of the claimed design. Nonetheless, because this declaration is in written form, at times I have resorted to words to describe certain features of the claimed design and the prior art. However, I also rely on the overall visual appearance of the claimed design and the prior art and put them side by side to facilitate the comparison.

A. The ‘161 Patent Claims A Footwear Upper

46. Based on my review of the ‘161 patent figures, including their solid lines, I understand the claimed design to be a footwear upper.

47. My understanding is that the ‘161 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 shows a side view of the design:

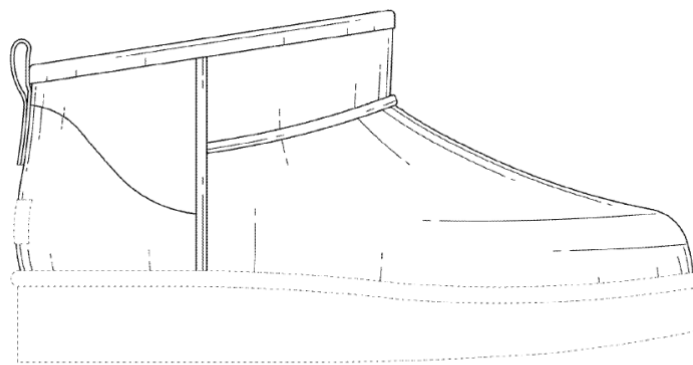


FIG. 2

48. In my analysis, after addressing the LKQ case standards described herein, I first examined the ‘161 patent claim and the prior art for their overall visual appearance to a designer of ordinary skill. In doing that, I determined that the overall visual appearance of the Emu Stinger Micro, the CN’897 Snow Boot, and the UGG Classic Mini, were virtually identical to the ‘161 patent claims.

49. I also then examined the prior art for the design features that a designer of ordinary skill would notice. One feature of this design shown in Figure

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2 is stitching that in part looks like a tree, with one portion going straight up with a low, thin branch going to the left, and a thick, higher branch going to the right in this figure. I will refer to this as the “tree stitch design”. The opposite side of the footwear has the inverse “tree”, as shown by the same “tree” in Figure 3 of the ‘161 patent.

50. It is also my understanding that, as shown in Fig. 2 above, the claimed design does not include the bottom portion of the footwear (e.g., the sole) because it is depicted with broken lines. The claimed design also does not include anything attached to or contained within the interior of the footwear.

B. Application Of The Patent Owner’s Trade Dress Description

51. I was also asked to do a separate analysis of the prior art using the Patent Owner’s trade dress description for the elements of the design of the footwear upper that is set forth in the Patent Owner’s Complaint at paragraphs 37-39 (Exhibit 1010). I am informed that in the Complaint, the Patent Owner claims that both the ‘161 patent and the “UGG Classic Ultra Mini trade dress” cover the UGG Classic Ultra Mini product. I was asked to compare parts a. through e., part of g., and i., which are the parts not relating to the bottom of the shoe, from that description, with the Emu Australia Stinger Micro, the CN’897 Snow Boot, and the UGG Classic Mini in particular. These parts of the description are:

- 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;
- g. Fabric binding along the top of the boot;
- and
- i. A top line that is higher in the front and lower in the back.

52. I note that part b. states “Classic suede boot styling.” “Classic suede boot styling” would lead one to assume that “classic” in this context refers to and means that the ‘161 patent product known as the “UGG Classic Ultra Mini” uses a “common” style from the past. This would include the styling of the prior art I examined, including the Emu Australia Stinger Micro, the CN’897 Snow Boot, the UGG Classic Mini, and the UGG Classic Short, among other footwear. They all use the same “classic suede boot styling.” I looked up several definitions of the word “classic” and the definitions appeared to be generally consistent across different dictionaries over time. One such definition was:

Dictionary

Definitions from [Oxford Languages](#) · [Learn more](#)



clas·sic

/ˈklasɪk/

adjective

1. judged over a period of time to be of the highest quality and outstanding of its kind.
"a classic novel"

Similar: definitive authoritative outstanding of the highest quality first-rate ▼

2. remarkably and instructively typical.
"Hamlet is the classic example of a tragedy"

Similar: typical archetypal quintessential vintage model representative ▼

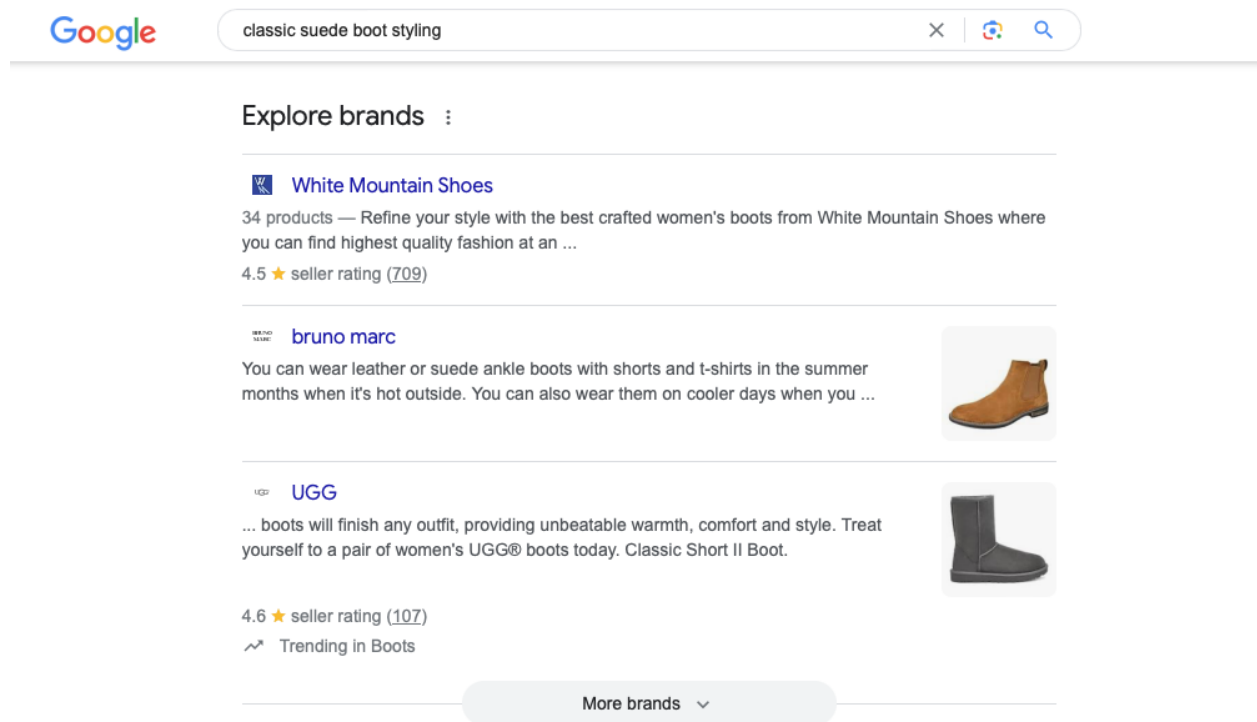
noun

1. a work of art of recognized and established value.
"his books have become classics"

Similar: definitive example model epitome paradigm exemplar prototype ▼

2. a school subject that involves the study of ancient Greek and Latin literature, philosophy, and history.
"an honors degree in Classics"

If you google search “Classic suede boot styling”, the UGG Classic Short prior art boot (Exhibit 1006) is the third hit under “Explore brands.” This is supportive of my obviousness opinions set forth below: the ‘161 patent design is “classic” and is thus the same styling as used in the prior art UGG Classic Short, UGG Classic Mini (Exhibit 1005), etc.



C. Two Constructions For The Footwear Upper

53. In my analysis of the obviousness of the '161 patent design, I came to the conclusion that the patent is directed to a purely functional design and is therefore unpatentable, as I described in my January 29th Declaration, which I contend is correct. For this supplemental declaration, however, I have been asked to set this opinion aside, and assume that there are ornamentation aspects to the design.

54. In particular, in my opinions below, I was asked to use two alternative understandings of the footwear upper in the '161 patent. These two alternative understandings concern the functionality or ornamentation of the pull tab shown on the back of the footwear upper of the '161 patent figures.

(1) The first is where the pull tab is functional and not ornamentation and thus it is not part of the design to consider with respect to the prior art.

(2) The second is where the pull tab is not functional and is ornamentation and thus it is part of the design to consider with respect to the prior art.

55. More specifically, the ‘161 patent figures show a pull tab above the heel in Figures 1-3, and 5-7. In my opinion, as I described in my January 29th Declaration (Section VII), such a pull tab that is stitched down to make it useful, is not ornamentation because it is a functional element that is used to pull the footwear on to the foot. The advertisement for the UGG Classic Ultra Mini, which I understand the Patent Owner says is covered by the ‘161 patent, says that ease of putting on the boot is an important function. E.g., Exhibit 1003 (“Offering a similar design to our ultra classic mini ugg boots styles, The Ultra Mini Ugg Boots have a slightly lower ankle to make it easier for you to slip on. Expertly made to last, these ugg boots are fantastic for those who may struggle with pulling on other styles and are looking for comfort and durability.”)

56. In my experience, the pull tab used in the ‘161 patent is the most efficient one of many that are available to use with such a design. The pull tab shown in the ‘161 patent comes up over the back of the shoe so it can be pulled upwards to pull the shoe on, making it the most efficient way to pull the boot on to the foot. Other pull tabs are possible, like the one used on the MacIntyre’974, but they would not be as efficient for the ‘161 patent design in putting on the boot and

thus they are less favorable alternatives to the ‘161 patent pull tab. My first construction takes this functional aspect of the pull tab into consideration. I use this first construction for Grounds 2, 4 and 6, discussed below.

57. However, if I am incorrect or another construction is used, and the pull tab is ornamentation, or it should otherwise be used in the claim construction when evaluating the prior art, then I use that pull tab as part of the alternative, second construction. I use this second construction for Grounds 5, 7 and 9, discussed below. I note, however, that in light of the above discussion, making changes to a pull tab is predictable and well-known to the ordinary designer here for reasons of ornamentation or otherwise.

VI. Obviousness Of The ‘161 Patent Design In Light Of The *LKQ* Case

A. General Application Of The New *LKQ* Standard

58. I assumed the ‘161 patent design was not purely functional when I applied the prior art. I compared the ‘161 patent design side by side with the prior art to compare their overall visual appearances, something I understand cannot always be adequately described in words (addressed by the *LKQ* case at *39-*40). I also compared the ‘161 patent design and its trade dress description provided by the Patent Owner side by side with the prior art to compare their overall visual appearances. I also applied the two claim constructions I identified above depending on whether the pull tab was functional or not.

59. I provide my opinions regarding the obviousness of the ‘161 patent claim below with respect to the prior art and the particular eight obviousness Grounds (i.e., 2, 4-10) I applied in my January 29th Declaration.

60. For obviousness in particular, as described above, I applied (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, which were each identified as a “Factual Inquiry” in the *LKQ* Guidelines, described above in Section II.

61. In my opinions, motivation to combine any references is also addressed, and in my opinion is provided by (a) the materials used in the boot footwear (described above in Section IV), and (b) the knowledge and motivation of the ordinary designer, whether in a team or not, to make footwear to fit different needs and with varying shaft height and/or with pull tabs (e.g., slipper-like, inside use needs versus protective, outside use needs; varying ankle coverage; ease of taking off and putting on boots; a common design change to enlarge a product line and fulfill customer’s preferences (e.g., ¶63-65, above)) and the references I apply themselves, which all disclose highly related boots like the ‘161 patent claim subject matter. See also the section immediately below on Factual Inquiry Three.

62. For **Factual Inquiry One and Two**, each of the prior art references (primary and secondary) that I apply are from the same field of endeavor as the

‘161 patent design (e.g., same type of footwear). They differ in only minor ways from the ‘161 patent design, if at all, which I identify below.

63. For **Factual Inquiry Three**, the level and designer of ordinary skill in the art, I described this in Section III above. I also address the knowledge of those involved in the designs emanating from development teams from 2019 (and before and after), and I also want to bring up a common point in boot design: It is common and considered necessary in companies with multiple boot designs and variations to refer to “shaft height”. This is typically included in the “Design Brief/Product Brief/Marketing Brief”, to instruct the development Team in the differentiation from the other boots in the collection or in the marketplace. Shaft height is a term used in all types of boot development including womens fashion, mens and womens western wear boots, even in the fishing world for wading and other outdoor applications.



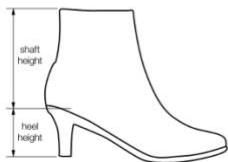
<https://www.pinterest.com/pin/looking-pretty--487303622176208864/>

Size Chart

Euro	US
36	5.5/6
37	6.5/7
38	7.5/8
39	8.5/9
40	9.5/10
41	10.5
42	11

Heel and Boot Shaft Measurements

The graphic below shows where the heel height and boot shaft height are measured. Measurements shown on this site are taken from size 37 shoes. Heel and shaft sizes will vary with the size of the shoe (a size 41 shoe will have a larger heel and boot shaft size than the size shown on the product page which is taken from a size 37 shoe).



<https://www.buenofootwear.com/popup-sizechart>

<https://dingo1969.com/products/primrose-leather-bootie-brown?variant=39772284321901>

Shaft Length is commonly communicated to the sales team after boots are finished and ready to sell into the marketplace.

64. Another important concept to understand is the “industry standard” that existed in November of 2019 and now for the timeline and process of the development of a footwear product line. An example of this process used in general, which may be elongated or abbreviated depending on personnel or timelines per particular goals of the companies/brand, is provided below:

- Marketing produces a Marketing Brief that has been reviewed by Sales. Finances, the Executive Teams for the purpose of passing these product and market goals to achieve financial goals.
- From this Document (s) a Product/Design Brief is developed to give the Development Team a more specific idea to work off to work on specific designs, colors, materials to build the product that will eventually be produced to make up the “Product Line” for the season.
- Design then begins the process of actual design of the line. The Product Development Team works directly with designs to vet the ability to hit specific price/margin targets. When the initial designs are produced the different teams and members meet to review the proposed “line” and then from there on additional iterations are done by team members to match commentary.

- The Development Team develops a “Tech Package” to be passed onto the Factories to produce pull overs of the various designs, search requested materials and colors, and to produce prototypes of new designs.
- Without having to detail all future steps, generally the following steps happen:
 - Pattern pull overs are prepared and reviewed by the team members to aesthetically assure the design goal is achieved.
 - When pull overs are completed a development spec is developed to describe the sample requested.
 - Samples are made by the Factory and then sent to headquarters. At this point the different teams gather to review and comment about the initial sample. From there, iterations are made and remade until the product goal is achieved.
 - When the final samples are assembled (with updates made), a larger group including members of the various team and more front line Sales Managers and specific team members are added to give broader feedback.
 - This “line” is then taken out to meet with International and Domestic Customers to get feedback.
- From here there are still iterations, additions, and subtractions as the move is made toward a “go to Market” strategy.

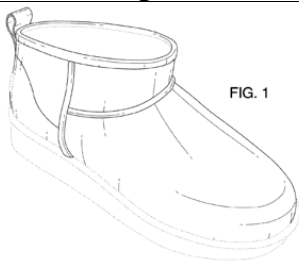
65. One of these aspects that these teams will consider with respect to product lines, is shaft height, particularly with boots. Thus, there is now, and was in 2019 and before, definite and strong motivation to take a design and vary the shaft height in every given product line.

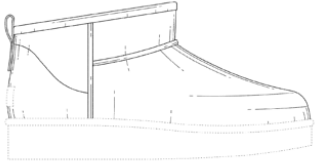
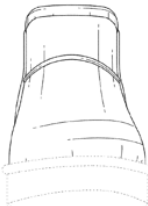
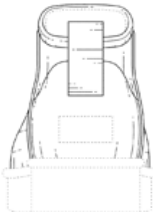
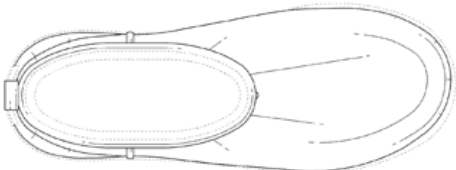
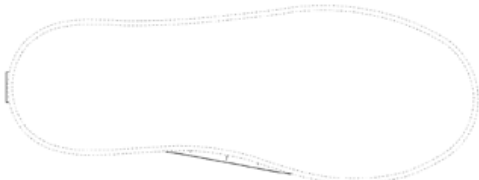
66. For **Factual Inquiry Four**, I am aware of no objective evidence of non-obviousness to apply to the analysis, and to my knowledge, none has been identified by the Patent Owner.

B. Ground 2—The Claim Is Obvious Under § 103 Over The Emu Australia Stinger Micro And The *LKQ* Standard

67. In my opinion, based on the first construction where the claimed design encompasses footwear uppers with and without pull tabs, the claimed design is obvious in view of the Emu Australia Stinger Micro and the common knowledge of a designer having ordinary skill in the art.

68. I have included images from the ‘161 patent and the Emu Australia Stinger Micro below.

View	‘161 patent	Emu Australia Stinger Micro
1		

2	 FIG. 2	
3	 FIG. 3	
4	 FIG. 4	
5	 FIG. 5	
6	 FIG. 6	
7	 FIG. 7	

69. In my opinion, the two footwear uppers have the same overall visual appearance and design. The Emu Australia Stinger Micro has the same overall visual appearance as that claimed in the '161 patent. To render this opinion, I

focus on the visual impression of the claimed design as a whole, and not on selected individual pieces: these two designs are virtually identical.

70. I note also that if I look at the design elements of the boots, I come to the same conclusion. For example, it is apparent that they have the same tree stitch design on the side. The lower portion of the '161 patent design is not claimed in the '161 patent and is set out with broken lines therein. This enlarged figure shows the Emu Australia Stinger Micro tree stitching design more clearly:



71. The Emu Australia Stinger Micro also has each of the relevant elements identified by the Patent Owner (Exhibit 1010 (§§37-39)) that I was asked to examine as a separate analysis. These include: 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. However, a top line that is higher in the front and lower in the back is difficult to see (shown to be slight to not existent in Views 2 and 5).

72. As noted above in the “Legal Standards” section, I have been informed that obviousness requires a “primary” reference that is from the same field of endeavor as the ‘161 patent design. The Emu Australia Stinger Micro is from the same field of endeavor and creates the same visual appearance under the first construction.

73. As also noted in the “Legal Standards” section, I am to ascertain the differences between the prior art (the Emu Australia Stinger Micro) and the claimed design. But under the first construction where the claimed design encompasses footwear uppers without pull tabs, the designs are practically the same. There are almost no differences. Even if the pull tabs were perceived to be important and different, their differences are slight and predictable and it is well-known to the ordinary designer here to alter the prior art pull tab to look like the ‘161 design (see ¶¶54-57 above).

74. The only possible difference between the Emu Australia Stinger Micro footwear upper and the claimed footwear upper that I can see (under the first construction) is the overall proportions of the footwear upper. As I have noted, my understanding is that purely predictable, well-known, and functional

considerations, like the overall size of the footwear upper (which are expected to come in different sizes), are not nonobvious or “ornamental” in nature and therefore not available for design patent protection. Even if somehow, nobody had ever thought of making a footwear upper of a similar proportion, such a feature is purely predictable, well-known, and functional because it is controlled by the desire to expand a product line and have a footwear upper of that size/proportion (e.g., to make it easier to take off or put on, to make it slipper like for easy inside use, to make in different sizes).

75. Even if that were not the case, however, varying the overall size of a footwear upper would have been obvious to an ordinary designer, including a member of a development Team. A member of a development Team 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 and retain the same overall impression as the original footwear upper. And, an ordinary designer would have been motivated to vary the overall size of the footwear upper to suit different applications (e.g., where ease of removal/putting on is important such as in inside use versus outside use). In my opinion, making such small changes to the overall proportions such as is the case here, would easily be within the purview of the ordinary designer thereby rendering the proportions to be the same. In short, an ordinary designer would have found it obvious to change a footwear upper’s proportions by 2019.

76. Moreover, I note that the design elements of the ‘161 patent design relate to the pattern and stitching that are used, as dictated by the material used, which I have described above in Section IV and in Section VII of my January 29th Declaration on functionality. For these additional reasons, any designer of skill in the art would recognize and follow these constraints placed on the footwear upper by the materials used to make the boot and the resulting pattern and stitching and thus the ‘161 patent is obvious for these reasons also.

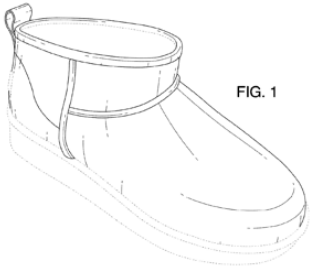
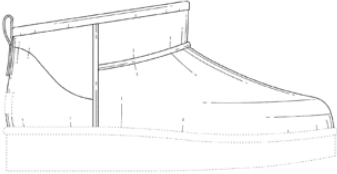
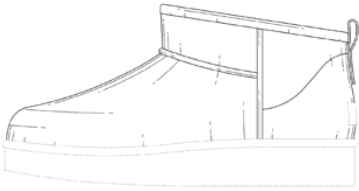
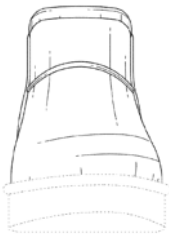
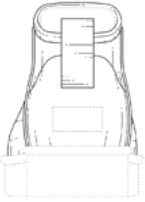
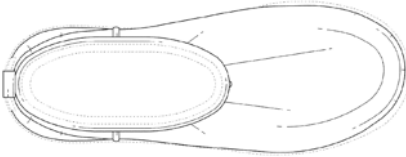
77. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this Section VI.B and in Sections III and VI.A above, in my opinion the ‘161 patent is obvious over the Emu Australia Stinger Micro.

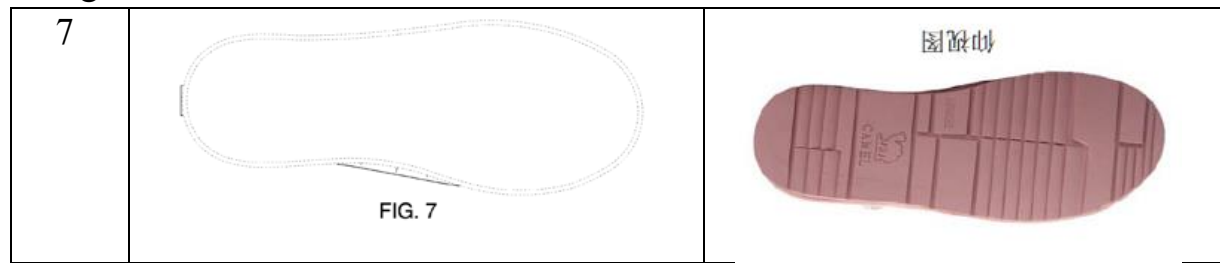
C. Ground 4 —The Claim Is Obvious Under § 103 Over CN’897 And The *LKQ* Standard

78. In my opinion, based on the first construction where the claimed design encompasses footwear uppers with and without pull tabs, the claimed design is obvious in view of CN’897 and the common knowledge of a designer having ordinary skill in the art.

79. I have included images from the ‘161 patent and CN’897 below.

View	‘161 patent	CN’897
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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



80. In my opinion, the two footwear uppers have the same overall visual appearance and design. CN'897 has the same overall visual appearance as that claimed in the '161 patent. To render this opinion, I focus on the visual impression or appearance of the claimed design as a whole, and not on selected individual pieces: these two designs are virtually identical.

81. I note also that if I look at the design elements of the boots, I come to the same conclusion. For example, CN'897 has the same tree stitch design on the side, especially when the yellow line is seen as the thin, left branch of the tree. The lower portion of the '161 patent design is not claimed in the '161 patent and is set out with broken lines therein. This enlarged figure shows the CN'897 tree stitching design (noting the yellow line) more clearly:



82. CN’897 also has each of the relevant elements identified by the Patent Owner (Exhibit 1010 (§§37-39)) that I was asked to examine as a separate analysis. These include: 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 (shown in Views 1-3, 5 and in other pictures more or less pronounced).

83. As noted above in the “Legal Standards” section, I have been informed that obviousness requires a “primary” reference that is from the same field of endeavor as the ‘161 patent design. CN’897 is from the same field of

endeavor and it creates the same overall visual appearance under the first construction.

84. As also noted in the “Legal Standards” section, I am to ascertain the differences between the prior art (CN’897) and the claimed design. But under the first construction where the claimed design encompasses footwear uppers without pull tabs, the designs are practically the same. There are almost no differences. Even if the pull tabs were perceived to be important and different, their differences are slight and predictable and it is well-known to the ordinary designer here to alter the prior art pull tab to look like the ‘161 design (see ¶¶54-57 above).

85. The only possible difference between CN’897’s footwear upper and the claimed footwear upper that I can see (under the first construction) is the overall proportions of the footwear upper. As I have noted, my understanding is that purely predictable, well-known, and functional considerations, like the overall size of the footwear upper (which are expected to come in different sizes), are not nonobvious or “ornamental” in nature and therefore not available for design patent protection. Even if somehow, nobody had ever thought of making a footwear upper of a similar proportion, such a feature is purely predictable, well-known and functional because it is controlled by the desire to expand a product line and have a footwear upper of that size/proportion (e.g., to make it easier to take off or put on, to make it slipper like for easy inside use, to make in different sizes).

86. Even if that were not the case, however, varying the overall size of a footwear upper would have been obvious to an ordinary designer, including a member of a development Team. A member of a development Team 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 and retain the same overall impression as the original footwear upper. And, an ordinary designer would have been motivated to vary the overall size of the footwear upper to suit different applications (e.g., where ease of removal/putting on is important such as in inside use versus outside use). In my opinion, making such small changes to the overall proportions such as is the case here, would easily be within the purview of the ordinary designer thereby rendering the proportions to be the same. In short, an ordinary designer would have found it obvious to change a footwear upper's proportions by 2019.

87. Moreover, I note that the design elements of the '161 patent design relate to the pattern and stitching that are used, as dictated by the material used, which I have described above in Section IV and in Section VII of my January 29th Declaration on functionality. For these additional reasons, any designer of skill in the art would recognize and follow these constraints placed on the footwear upper by the materials used to make the boot and the resulting pattern and stitching and thus the '161 patent is obvious for these reasons also.

88. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this Section VI.C and Sections III and VI.A above, in my opinion the ‘161 patent is obvious over CN’897.

D. Ground 5 — Obviousness Under § 103 Over The Emu Australia Stinger Micro Or CN’897, And The UGG Neumel Boot, Using The *LKQ* Standard

89. In my opinion, based on the second construction where the claimed design encompasses footwear uppers with pull tabs, the claimed design is also obvious in view of the Emu Australia Stinger Micro or CN’897, either one combined with the UGG Neumel Boot.

90. The Emu Australia Stinger Micro is a suitable footwear upper primary reference, as I noted in a previous section (i.e., Section IV.B). The Emu Australia Stinger Micro has the same overall visual appearance as the claimed design. I also noted that it is a similarly shaped boot with similar shaped and sized stitching, etc., as the design claimed by the ‘161 patent.

91. Likewise, CN’897 is a suitable footwear upper primary reference, as I noted in the previous section (i.e., Section IV.C). CN’897 has the same overall visual appearance as the claimed design. I also noted that it is a similarly shaped boot with similar shaped and sized stitching, etc., as the design claimed by the ‘161 patent.

92. As I explained in the previous sections (Sections IV.B and IV.C), the only potential difference I can see (under the first construction) between the Emu Australia Stinger Micro or CN'897 and the claimed design relates to the overall proportions of the footwear upper. I explained that these do not create significant differences to visual appearance. I also explained that even if this was a difference, a designer of ordinary skill would have found it trivially obvious to vary the length and width of a given footwear upper design to suit different applications.

93. Under the second construction, however, which requires a pull tab in the prior art, the '161 patent would have been obvious to an ordinary designer over the Emu Australia Stinger Micro or CN'897, either one in view of the UGG Neumel Boot. The UGG Neumel Boot is an appropriate secondary reference under the *LKQ* standard and it is from the same field of endeavor (e.g., boot-like footwear). The pull tab of the UGG Neumel Boot is shown as follows, compared to the pull tab of the '161 patent, which is identical:

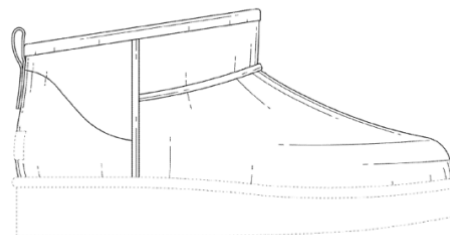
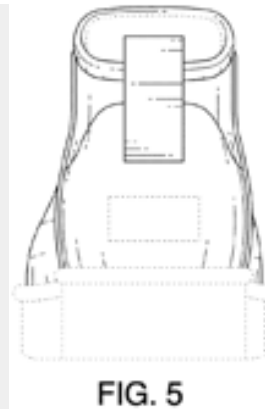


FIG. 2



94. In my opinion, it would have been obvious to implement the Emu Australia Stinger Micro or CN'897 with the efficient and advantageous pull tab of the UGG Neumel Boot to make it easier to put on and take off. In view of the UGG Neumel Boot, a footwear upper from the Patent Owner, a relatively popular, well-known footwear maker (which is true of all of the prior art applied by me herein except for CN'897), it would have been obvious to implement the footwear upper in the Emu Australia Stinger Micro or CN'897 with this pull tab. A designer of ordinary skill would have recognized that usefulness of the pull tab of the Neumel Boot as an example of a desirable and appropriate feature for a boot. Implementing the Emu Australia Stinger Micro'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 pull on and take off. At a minimum, it would have been obvious to try to implement the Emu Australia Stinger Micro or CN'897 with such a pull tab.

95. In my opinion, implementing the Emu Australia Stinger Micro or CN'897 with the pull tab of the Neumel Boot would have led to predictable results,

because there is nothing surprising or unexpected that would result from simply adding a pull tab to footwear. This is especially the case for modifying the Emu Australia Stinger Micro or CN'897, which involves adding the pull tab of the 2011 UGG Neumel Boot from more than a decade ago.

96. I have been informed (see “Legal Standards” section) that the secondary reference, here the UGG Neumel Boot, no longer needs to 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. However, it is my opinion that the UGG Neumel Boot and the Emu Australia Stinger Micro or CN'897 could not be much more related, as they each relate to footwear uppers, including boot-like, ankle-high footwear uppers. A designer of ordinary skill would have thus immediately recognized that features, ornamental or not, from one reference could be easily applied to the other.

97. In view of the UGG Neumel Boot, it would have been obvious to modify the Emu Australia Stinger Micro's or CN'897's footwear upper to have a particular pull tab. Any differences between the resulting footwear upper and the claimed design of the '161 patent, if they exist at all, would not appear significant to the designer of ordinary skill.

98. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this

Section VI.D and in Sections III and VI.A-C above, in my opinion the '161 patent

is obvious over the Emu Australia Stinger Micro or CN'897 and the UGG Neumel Boot.

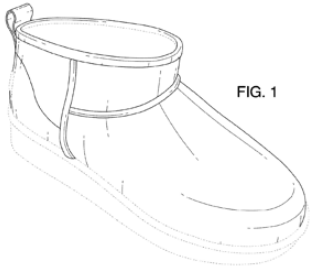
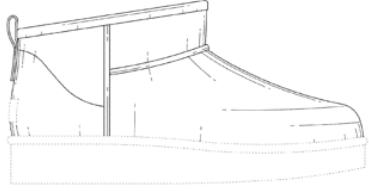
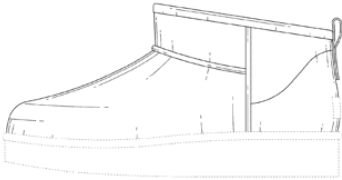
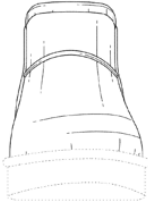
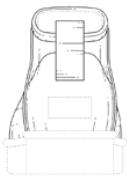
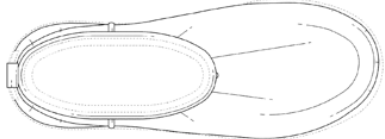
E. Ground 6— Obviousness Under § 103 By The UGG Classic Boots And The *LKQ* Standard

99. In my opinion the claimed design is obvious over the UGG Classic Mini and the UGG Classic Mini II, which have the same overall visual appearance as they are virtually identical (e.g., outer design), and the common knowledge of a designer having ordinary skill in the art, under the first construction (i.e., where the pull tab is not an ornamental design feature). I also note that the UGG Classic Mini has the same tree stitch design on the side as the '161 patent design.

100. The face of the '161 patent's lists of references states that the UGG Classic Mini has been for sale since 2006 and the UGG Classic Mini II has been for sale since 2017, citing websites, and thus I have been asked to consider them as both disclosed in prior art printed publications. Exhibit 1001. In addition, I understand that the differences between the UGG Classic Mini and the UGG Classic Mini II do not relate to their outer design features relevant to the '161 patent, but instead are based on making the Mini II stain resistant and the tread more aggressive, neither of which are part of the '161 patent design. Exhibit 1005.

101. A comparison of the '161 patent figures with the UGG Classic Mini design follows:

View	'161 patent	UGG Classic Mini
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1	 FIG. 1	
2	 FIG. 2	
3	 FIG. 3	
4	 FIG. 4	
5	 FIG. 5	
6	 FIG. 6	
7	 FIG. 7	

102. In my view, the UGG Classic Mini has the same overall visual appearance as the design claimed in the ‘161 patent. In my opinion, to the extent there are any minor variations, those would not preclude a finding of obviousness (or even anticipation) because the overall visual appearance remains the same — that of a footwear upper with what I am assuming are non-functional elements. Thus, there are no substantial differences in the overall visual appearance between the UGG Classic Mini and the ‘161 patent claimed design.

103. As shown above, the UGG Classic Mini has substantially the same overall visual appearance and 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.

104. I was also asked whether the UGG Classic Mini has each of the relevant elements identified by the Patent Owner (Exhibit 1010 (¶37-39)). In my opinion it does. It has 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).

105. As noted above in the “Legal Standards” section, In my opinion, the UGG Classic Mini is a suitable primary reference because is from the same field

of endeavor as the ‘161 patent (e.g., footwear) and its design characteristics are basically the same as the ‘161 claimed design. The UGG Classic Mini’s footwear upper has the same design claimed in the ‘161 patent.

106. In my view, to the extent there are any differences between the UGG Classic Mini and the ‘161 patent claimed design, the UGG Classic Mini itself readily suggests those differences to one of ordinary skill in the art. For example, to the extent the proportions of the footwear upper (i.e., the overall height and proportions) or the pull tab differ between the UGG Classic Mini and the claimed design, those proportions would have been obvious because they are purely predictable, well-known and functional. They relate to putting on and removing the boot, and how much of the ankle is covered, and the particular size of the boot, rather than anything nonobvious or ornamental in nature.

107. Furthermore, 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 predictable, well-known and functional in nature. Footwear is built around, or onto, the “Last” that represents their brand customers basic foot shape.

108. Moreover, in my view, regardless of whether the differences are purely functional, a designer of ordinary skill would have found changing the overall length/width of the footwear upper to be trivially obvious. A member of a development Team 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. For example, they would have made the boot shorter to make it more an easily removed and slipper-like for indoor use rather than longer 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. In my view, a shaft height is easily changed to be taller or shorter and footwear made more easy or more difficult to be removed while retaining the same design characteristics as the original boot design. As I described above, there is strong motivation to make such changes concerning the development of product lines.

109. In my opinion, this same analysis applies to the UGG Classic Short. Exhibit 1006, Exhibit 1005 (page 4, from July 14, 2016). It has the same overall visual appearance as the '161 patent design. It also has all of the same design features as the '161 patent and the UGG Classic Mini and UGG Classic Mini II. The only difference is the UGG Classic Short has a higher shaft height than the others, but as I explained above, that is an obvious, predictable feature, and not ornamentation. Thus, the '161 patent is also unpatentable over the UGG Classic Short. Indeed, the UGG Classic Short and the UGG Classic Mini both being in the prior art, would make a shorter height boot, such as the '161 patent design, obvious, and part of a well-known continuum and pattern in boot design (see Exhibit 1005, page 4, from July 14, 2016, showing several UGG Classic Boots

with varying shaft height). As I explained above in the beginning of this section, varying the shaft height is an obvious variation to a product line.

110. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this Section VI.E and in Sections III and VI.A above, in my opinion the ‘161 patent is obvious over the UGG Classic Boots (Mini, Mini II, Short).

F. Ground 7— Obviousness Under § 103 Over The UGG Classic Boots And The UGG Neumel Boot Using The *LKQ* Standard

111. In my opinion, based on the second construction where the pull tab is ornamental and non-functional or is otherwise required, the claimed design is obvious over the UGG Classic Mini in view of the UGG Neumel Boot.

112. The UGG Classic Mini is an appropriate primary reference for the reasons set forth above in the “Legal Standards” section, namely because it is from the same field of endeavor as the ‘161 claimed design, e.g., a footwear upper with the same overall visual appearance. It also has similar non-functional elements.

113. As also noted in the “Legal Standards” section, I am to ascertain the differences between the prior art UGG Classic Mini and the claimed design. Here there are almost no differences. The pull tab and certain proportions of the UGG Classic Mini are slightly different from the claimed design. The proportion differences are addressed in the previous section.

114. The UGG Neumel Boot is an appropriate secondary reference because it is also from the same field of endeavor as the '161 patent design and its design is very similar to the UGG Classic Mini in being a boot of ankle-height, having a pull tab and other similar features. Thus, in my opinion, the UGG Classic Mini and the UGG Neumel Boot render 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):

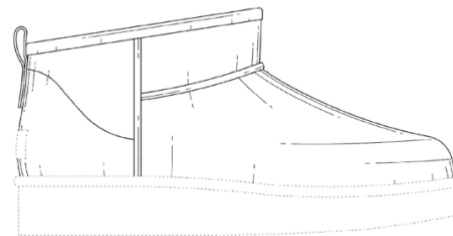


FIG. 2

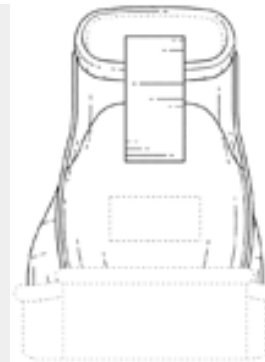


FIG. 5

115. As shown above, in my view the UGG Neumel Boot has certain of the same length/width proportions (i.e., ankle height) and the same pull tab disclosed in the claimed design, including Figures 2 and 5 of the '161 patent. In fact, the UGG Neumel Boot's pull tab appears to be identical to the '161 patent

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 (see ¶54-57).

116. In my opinion, a designer of ordinary skill would have found it obvious to add/substitute such a pull tab from a commercial product on the market 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 to make boots easier to put on and take off is well known in the art concerning boots. In my view, adding such a pull tab from the same, ankle-high footwear would at least have been obvious to try.

117. In my view, 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. 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 pull on and take off the foot. This would have been a desirable option so that the resulting footwear upper would be easier to use.

118. In my opinion, such a change would have been predictable and obvious. There is nothing unpredictable or nonobvious about adding or substituting a pull tab to the heel of a boot.

119. It is also my opinion that the UGG Neumel Boot is so related to the UCC Classic Mini 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. The resulting footwear upper would continue to have the non-functional elements of the UGG Classic Mini.

120. As I indicated above, to the extent 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. In my view, differences in proportions also would have been obvious because they are purely predictable, well-known and functional, rather than ornamental in nature. In particular, the length and width of the footwear upper is entirely dictated by the size and proportions of the desired boot and its use (e.g., ease of taking off for inside, more slipper like use), which is predictable, well-known and functional in nature.

121. Thus, in my opinion, an ordinary designer would have found that any proportional difference between the UGG Classic Mini and the claimed design was obvious. They also 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.

122. The UGG Classic Mini not only suggests that the overall shape of the footwear upper could be easily varied, but also suggests that the length of the shaft could vary from footwear upper to footwear upper. In my view, 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 ease of putting the boots on and taking them off, and 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.

123. 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*.

124. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this Section VI.F and in Sections III and VI.A and E above, in my opinion the ‘161 patent is obvious over the UGG Classic Mini and the UGG Neumel Boot.

G. Ground 8—Obviousness Under § 103 Over The UGG Classic Boots And MacIntyre’974 And/Or Chung’186 Using The *LKQ* Standard

125. In my opinion, the claimed design is obvious over the UGG Classic Mini and MacIntyre’974 and/or Chung’186 under the first construction (i.e., if the pull tab of the ‘161 patent claim is construed to be functional).

126. As I explained in the previous two sections (i.e., Grounds 6 and 7), the UGG Classic Mini is a suitable primary reference because it is from the same field of endeavor as the ‘161 patent design. It also provides the same overall visual appearance. It also has the same design characteristics as that of the ‘161 patent claim.

127. To the extent the overall proportions (e.g., length/width, shaft length) of the footwear uppers differ between the UGG Classic Mini and the claimed design, the claimed design is obvious without reference to a secondary reference (Ground 6). In my view, a mere variation of the overall proportions is not patentable because it is a regular practice to do so and functional in nature, including in how the boot will be taken off and pulled on.

128. My opinion concerning these proportions is supported by the MacIntyre’974 and Chung’186 references. They each independently teach 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 (with a stitch pattern shown in dotted lines that is identical to the ‘161 patent design) while Chung’186 teaches three. Thus, it was well known

in the art to implement a footwear upper with varying length/widths and shaft lengths in view of MacIntyre'974 and/or Chung'186.

129. In my opinion, 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. At a minimum, such a proportional change would have been obvious to try.

130. Furthermore, in my view such a change would have been predictable and obvious. There is nothing unpredictable or nonobvious about designing a shaft length to be shorter to allow for footwear to more easily be removed or pulled onto the foot.

131. In my opinion, the MacIntyre'974 and Chung'186 patents are so highly related to the primary reference (the UGG Classic Mini) as to suggest varying the dimensions of the UGG Classic Mini. Each of the references relates to footwear uppers (boots) and features from such, whether ornamental or not, would have been readily applicable to the other by a designer of ordinary skill.

132. To the extent 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. For example, any

differences in the proportioning of the footwear uppers is readily suggested by MacIntyre'974 and Chung'186.

133. Furthermore, 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 ease of taking off and pulling on the boots, and the amount of ankle to cover, height of the pattern. Any other differences, to the extent there are any, are *de minimus*.

134. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this Section VI.G and in Sections III and VI.A, E and F above, in my opinion the '161 patent is obvious over the UGG Classic Mini and MacIntyre'974 and/or Chung'186.

H. Ground 9 – Obviousness Under § 103 Over The UGG Classic Boot, MacIntyre'974 And/Or Chung'186, And The UGG Neumel Boot Using The *LKQ* Standard

135. In my opinion, under the second construction (requiring the pull tab), the '161 patent claim is obvious over the UGG Classic Mini, MacIntyre'974 and/or Chung'186, and the UGG Neumel Boot. The reasons for this opinion are the same as for Grounds 5 and 7 above. The secondary references here provide any

differences in proportions or pull tabs between the UGG Classic Mini as the primary reference and the ‘161 patent claim.

136. Each of these references is directed to footwear uppers that are boots and it would be obvious to combine them, or at least obvious to try, for the reasons set forth for Grounds 5 and 7 above.

137. The UGG Classic Mini is an appropriate primary reference it is from the same field of endeavor as the ‘161 patent claim design, and it creates the same overall visual appearance, as I addressed above in Section VI.E-G.

138. The other three references are appropriate secondary references also because they are also from the same field of endeavor as the ‘161 patent claim design. See Sections VI.F and VI.G. Each prior art design even suggests the application of its features in each other (e.g., change the shaft length, add a pull tab).

139. Thus, the MacIntyre’974 and/or the Chung’186 patents teach one to vary the shaft length proportion of the UGG Classic Mini while still maintaining the footwear upper design.

140. The UGG Neumel Boot provides the identical pull tab of the ‘161 patent claim to make the boot (especially a lower topline boot) easier to pull on and take off (as I addressed above) and thus the references render the claim obvious.

141. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this

Section VI.H and in Sections III and VI.A and E-G above, in my opinion the ‘161 patent is obvious over the UGG Classic Mini and MacIntyre’974 and/or Chung’186 and the UGG Neumel Boot.

I. Ground 10 — Obviousness Under § 103 Over The UGG Classic Boot And CN’897 And The Other References Using The *LKQ* Standard

142. In my opinion, the claimed design is obvious over the UGG Classic Mini in view of CN’897 and the common knowledge of a designer having ordinary skill in the art. This reasoning also applies with CN’897 as the primary reference, and the UGG Classic Mini as the secondary reference.

143. In my view, both references (i.e., the UGG Classic Mini and CN’897) have the same overall visual appearance as the ‘161 patent claimed design and can be appropriate primary references as I addressed above in Sections VI.C and VI.E. With these similarities, both are proper secondary references also as they are from the same field of endeavor and are so related to one another that they suggest the application of their ornamental features to one another.

144. The only differences I can see are slight and are the overall proportions of the footwear upper. When looking at common design elements, they both have very similar tree stitch design, as addressed above. As I also explained above, any differences are minor and difficult to notice. Without specifically looking for a difference, it would be easy to miss.

145. Nonetheless, I believe I can see upon very close inspection that the UGG Classic Mini has a collar height that may be slightly longer, while the CN’897 is slightly lower. As I noted in the previous section, my understanding is that purely predictable, long-in-practice, and functional considerations, like the overall proportions of the shaft created by a footwear upper, are not nonobvious or “ornamental” in nature and therefore not available for design patent protection.

146. Even if that were not the case, however, varying the overall proportions of a footwear upper would have been obvious to an ordinary designer. 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—while retaining the same overall design. And an ordinary designer would have been motivated to modify the proportions of a footwear upper design to suit various applications. For example, a long footwear upper (e.g., used in certain weather conditions) is easily shortened while retaining the same design, to serve applications typically involving shorter footwear uppers (e.g., used indoors like a slipper). In my opinion, changing the overall length and width of a footwear upper borders on the trivial.

147. On the other hand, the design elements of the lines of the ‘161 patent appear to be almost identical to those of CN’897 and any differences insignificant. However, the UGG Classic Mini has the identical lines on the side of the boot as the ‘161 patent, and they could be applied to make changes to CN’897 and make it

also perfectly identical to the '161 patent. This would be a trivial exercise and thus obvious in my opinion.

148. Finally, 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 and field of endeavor, to render the '161 patent claim obvious under either the first or second construction.

149. In light of the four factual inquiries and evaluation of obviousness set out in the *LKQ* case and the *LKQ* Guidance, which I have applied above in this Section VI.I and in Sections III and VI.A and E-H above, in my opinion the '161 patent is obvious over the UGG Classic Mini and CN'897, or CN'897 and UGG Classic Mini, and, if necessary under the construction that is applied, the UGG Neumel Boot.

VII. Conclusion

150. This supplemental declaration is intended to address the new obvious standards set forth in the *LKQ* case, while still retaining the opinions, findings and observations and other subject matter in my January 29th Declaration.

151. The '161 patent design is obvious under the *LKQ* standard based on the grounds set forth above (i.e., Grounds 2 and 4-10).

152. My January 29th Declaration sets forth additional grounds for unpatentability of the '161 patent claim based on functionality, anticipation and

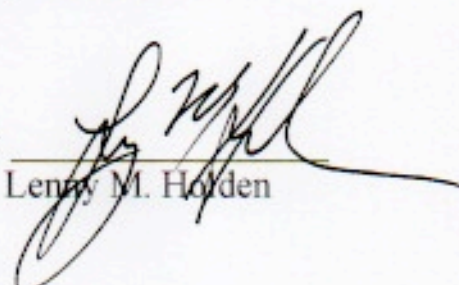
obviousness (under the previous standard) that are not addressed in this supplement.

153. In signing this declaration, I understand that the declaration will be filed as evidence in a contested proceeding before the Patent Trial and Appeal Board of the United States Patent and Trademark Office. I hereby acknowledge that I could be subject to cross-examination in this proceeding and that cross examination will take place within the United States of America. If cross examination is required of me, I will appear for cross-examination within the United States during the time allotted for cross examination.

VIII. Declaration

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: June 19, 2024

By: 

Lenny M. Holden