

Supplemental Declaration of Rosemary W. Wright

My January 30th Declaration

I prepared the “Expert Report and Declaration of Rosemary W. Wright”, dated January 30, 2024, previously, which I will refer to as my “January 30th Declaration”. The January 30th Declaration concluded, among other things, that the ‘161 patent was obvious over prior art designs. That is the same conclusion I draw here, under a new standard of obviousness addressed below. The January 30th Declaration has additional opinions, background and qualifications that have not changed.

Legal Standards Of Obviousness Of Design Patents

I have been informed that since my January 30th Declaration, a new legal standard of obviousness applied to design patents has been issued by the United States Court of Appeals for the Federal Circuit in a case entitled *LKQ Corp. v. GM Global Technology Operations LLC*, No. 2021-2348 (Fed. Cir. May 21, 2024), which I will refer to as the *LKQ* case. I have also been informed that on May 22, 2024, the United States Patent and Trademark Office issued a Memorandum that discusses the application of the *LKQ* case, 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”, which I will refer to as the *LKQ* Guidance. I was provided copies of the *LKQ* case, and the *LKQ* Guidance, and I read them.

I am providing this supplemental declaration to apply my expertise in footwear design to the prior art I discussed in my January 30th Declaration and the ‘161 patent in light of the *LKQ* case and the *LKQ* Guidance. While I became familiar with the *LKQ* case and the *LKQ* Guidance by reading them, I am not an attorney, and my understanding of them was provided to me and is repeated below. The opinions expressed, and reasoning applied by me, are those of an experienced consultant in footwear design viewing the relevant questions from the relevant perspectives (e.g., designer of ordinary skill in the art.)

Regarding whether a design is obvious or non-obvious, I have been informed that the following legal principles apply to the analysis of patentability pursuant to 35 U.S.C. § 103, 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.”

I have been told 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.

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.

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.

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.

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.

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.

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.

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.

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 impression of the claimed design as a whole and not on selected individual pieces.

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.

My Evaluation Of The ‘161 Patent Design Under The LKQ Guidelines

Factual Inquiries One And Two And The Primary And Secondary

References: As with my January 30th Declaration, I have determined that the UGG Classic Mini is an appropriate primary reference here because it is in the same field of endeavor of footwear and boots in particular. The UGG Classic Mini is something that is in existence (e.g., not something that might be brought in existence by combining features from prior art). It is also visually very similar (e.g., it has the same general shape, look, material, and seams (please see the section below comparing the UGG Range and how they are made)) and, for the same reasons, it creates basically the same visual impression as the ‘161 design. The same is true for the UGG Classic short. They only differ from the ‘161 design in the height of the leg. These two UGG Classic references are provided in the Next Step Petition and its exhibits (printed publications from

websites and press releases in Exhibits 1005 and 1006), which I reviewed, as I stated in my January 30th Declaration. They would both qualify as primary references in my view.

Then, after identifying a primary reference, a secondary reference from the same field of endeavor or that is analogous may be used to provide design elements to modify the primary reference to create a design that has the same overall visual appearance as the claimed design. The secondary reference must be of the same field of endeavor or that is analogous art to the patented design. It is not required that the secondary reference 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. In my opinion, the footwear shown in AD 001 – AD32 (Exhibit 1014) are from prior art printed publications from the same field of endeavor (footwear) that are appropriate secondary references here.

Please refer to Prior Art, AD004, AD006, AD007, AD009, AD11, AD13, AD16, AD18, AD20, AD22. Exhibit 1014. These references show footwear that are the same or very similar but which differ in having different heights of the leg, showing that varying the heights of the leg of footwear is a common and well-known practice.

You will note that most of these examples are from catalogues, or shoe trade journals from the USA. I have many other examples from all era's of this standard practice up to the present date and worldwide that support my opinion on the practice of varying the leg heights of footwear (like the remaining pages of Exhibit 1014).

I have also been told that a secondary reference is sometimes not necessary, and that the modification to the primary reference can come from the skill, knowledge, and creativity of an ordinary designer. In my opinion, the '161 design is obvious over the primary references (e.g., the UGG Classic Mini) alone, or in light of the secondary references (i.e., the footwear shown in AD 001 – AD32; Exhibit 1014), as explained further below.

Another secondary reference would be the UGG Neumel boot, which is also from the same field of endeavor (e.g., outdoor footwear), and it has a rear pull tab that is the same or very similar to the one shown in the '161 patent design.

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). This date also serves to identify appropriate primary and secondary

references as “prior art” to the ‘161 patent (i.e., they were printed publications before the November 8, 2019 date).

Factual Inquiry Three And The Level Of Ordinary Skill: In this instance, I have been informed that 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. I am informed that this 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.

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

My opinions on obviousness are based on this level of skill. 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).

Knowledge And Motivations Of Designers/Sales Executives: It is perfectly normal and predicted / expected practice that a normal designer, including the designer of ordinary skill in the art here, will realise that by keeping the same design but by altering the height of the boot leg, more categories and uses for the same design of footwear can be created -- This results in increased sales. (That is one of the designer's main functions – i.e., to increase sales)

There are also advantages of economy because parts of the expensive tooling up, i.e., knives, dies, etc. to produce the shoe / boot will be used for more than one product.

The additional categories will result in the shoe / boot being utilised for indoor wear as a slide or slipper or outside wear as a low boot or as an extreme condition use as a high leg boot.

There is even a fourth advantage in that a high leg boot can be rolled over showing the fur to facilitate fashion.

By adapting a design to have several heights whilst keeping the same look it creates several advantages:

- 1) Create other categories and uses for the design.
- 2) Economy of production.
- 3) Increased sales.
- 4) Can facilitate fashion.

This is normal predicted and expected of any designer.

Factual Inquiry Four And Secondary Considerations As Indicia of

Obviousness Or Nonobviousness: I am unaware of any commercial success, skepticism regarding the design, failures of others to solve a long-standing problem, or any other reason why the ordinary designer of skill in the art would not follow industry practice and make a variation of an UGG Classic boot with a lower leg height. Any success would be more likely attributable to the UGG Classic line marketing than the '161 patent design.

My Evaluating Of Obviousness In Light Of The Four Factors: Having read the paperwork and considered the four factual inquiries set forth above, and knowing the '161 patent design and the UGG Classic Mini Boot, I believe that the '161 patent design is merely a lower version of UGG boots which were already in existence. They both provide the same visual appearance when

placed side by side. I will explain this further below, after setting forth the claim construction I applied to the '161 patent design.

Claim Construction: 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.

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.

Throughout this supplemental 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.

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

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.

Obviousness Of The ‘161 Patent Design: It is my view that the 161 design, if patented, would be an unsafe decision. My reasoning here is that there is nothing new in a design that has only a different height of leg but overall the same visual appearance. This is especially pertinent in the footwear industry worldwide when the practice of producing different heights on the same design, i.e., high tops, mid height and low top footwear with the same design is not only very common but historic practice and accepted as such by the market. Exhibit 1014. In my opinion Design Patent No. D927,161 is therefore obvious in light of the prior art and the Standards provided to me which are referred to herein.

General Shoe Making Knowledge Supports My Obviousness Opinion

Having studied the UGG Classic Range, including the Classic Short Boot and Classic Mini Boot compared with the Classic Ultra Mini Boot, including those in my archive, I felt that it may be helpful to make some general comments I have regarding the product.

Much of the look of the very successful UGG Range is the result of technical restrictions in using wool on sheep skin as the material the footwear is made of. The look of the design is the result of the steps / actions taken to remedy or overcome / resolve technical restrictions rather than a design creative decision or plan.

- 1) The inverted closed seams which are whipped are used because unlike ordinary leather the wool on the back makes the skiving process impossible. The reason for skiving is for comfort and to eliminate bulky uncomfortable seams in the boot. Skiving is where part of the edge of the leather is cut away to reduce the thickness. This cannot be done with wool attached. This results in the use of inverted closed seams. Ie protruding outwards rather than inwards.
- 2) The skived edge on leather is rubbed down to flatten the seam -- again this not possible due to technical restrictions. That is why the inverted closed seam is whipped to improve its appearance.
- 3) The outside counter is cut from suede without the fur on the back. The boot needs a stiffener to retain the shape of the finished boot, otherwise it would concertina down when the foot went into the boot and would look unattractive and shapeless. As the boot cannot have a lining because of the wool/fur the stiffener is inserted between the outside counter and the sueded side of the sheepskin. Again, the stiffener is made of a heat activated material so

impossible in contact with fur. There is no rigidity in the boot except that caused by the outside counter and the stiffener inserted between the two sueded surfaces.

4) The upper cannot use most methods of lasting because cement lasting etc which uses adhesive is not technically possible. That is why the wide binding is above the sole and on the lasting line to finish the upper neatly and to keep the adhesive away from the fur and to give a clean bond between upper and sole.

5) Last Shape -- A comment claimed in the paperwork about the rounded appearance. This has a purely technical reason for this look. A leather without thick wool on the flesh side would be lasted down to the last or mould and take on the features in a precise way. It is impossible for sheepskin with wool on to do this because of the thickness of the raw material. It also has a bridging effect from the highpoint of the toe to the instep. It is unlikely that the boots are heat set which is normal in leather shoes / boots; this helps to keep the shape of the last.

6) A toe puff which helps to keep the shape of the toe of the last and add more rigidity and shape retention to the shoe or boot is impossible because of the fur. The sheepskin boot cannot have a toe puff because it is a process which applies by heat plus pressure a thermoplastic toe puff to the toe. This is not possible on sheepskin with the wool on the inside of the footwear.

The restrictions on the technical issues when producing footwear from wool on sheepskin is what really designs the footwear and creative design flair is restricted. That is the reason that many sheepskin boots produced certainly in the 1930's to the present date have a similar look. Refer to AD001, AD002 and note the O'Neil catalogue from the year 2000. Exhibit 1014. This catalogue came from the USA.

The UGG Neumel Boot Supports My Obviousness Opinion

In my opinion the Neumel Boot (Exhibit 1009) apart from its UGG branding and the fact of it being produced in "wool on sheepskin", the style is a totally basic standard Chuka or Desert Boot. The standard desert boot often produced in suede has been made for much of the 20th Century and is very traditional and Classic.

It often has a back strap or pull tab which is not particularly needed but is just a classic traditional and predictable look on that style.

The reason the tab pull is not a necessity is that the entry of the foot into the ankle Neumel Boot is by the front Gibson lacing which when unlaced facilitates easy entry of the foot into the boot. The reason wearers could use the pull tab is if they do not unlace the Gibson facings so restricting the entry of the foot at the front.

I believe that many examples of prior art on the Neumel Boot could be found well before the Neumel Boot was first produced by UGG.

Conclusion

My conclusion on the D927,161 patent is that there is nothing creative or different in the product and in my view it is merely an entirely predictable step for a designer to take to provide the same visual appearance as the prior art. It is the same as previous UGG boots (e.g., the UGG Classic Mini and UGG Classic Short) but made lower in height. I also have reservations for others of the Classic Range for similar reasons. In my opinion Design Patent No. D927,161 is obvious over the prior art I have referred to herein.

Other brands of boots on the market have a similar appearance and this is often because of technical constraints in the production of footwear made from wool on sheepskin. Certainly the seams are usually inverted closed seams facing outwards. Some of the boots using lap seams are made from a thinner material with the wool on -- lambskin. This is a more expensive raw material because it is obviously smaller in size.

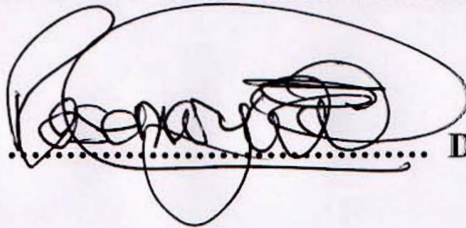
It is possible to use a clipped sheepskin but that again is more expensive. Some brands of boots can be made of suede leather without the wool on and

separately lined in sheepskin or synthetic fur. This then allows more traditional shoe making practices and machinery, allows more creativity for the designer.

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 are made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of the Title 18 of the United States Code.

Signed

A handwritten signature in black ink, appearing to be "V. S. ...", written over a dotted line.

Dated

June 15th 2024