

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

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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LIST OF PETITIONER’S EXHIBITS

<u>Exhibit</u>	<u>Description</u>
Ex. 1001	U.S. Design Patent D927,161 to Terras (“the ’161 patent”)
Ex. 1002	Emu Australia Stinger Micro boot (“Emu Stinger Micro Boot”)
Ex. 1003	Chinese Patent No. 304964897 (“CN’897”)
Ex. 1004	UGG Classic Ultra Mini
Ex. 1005	UGG Classic Mini boot
Ex. 1006	UGG Classic Short boot
Ex. 1007	U.S. Patent No. D768,974 to MacIntyre (“MacIntyre’974”)
Ex. 1008	U.S. Patent No. D790,186 to Chung (“Chung’186”)
Ex. 1009	UGG Neumel boot
Ex. 1010	Complaint in <i>Deckers Outdoor Corp. v. Next Step Group, Inc.</i>
Ex. 1011	Expert Declaration of Lenny M. Holden
Ex. 1012	Lenny M. Holden curriculum vitae
Ex. 1013	Expert Report and Declaration of Rosemary W. Wright
Ex. 1014	AD 001-A32 prior art examples cited in Exhibit 1013
Ex. 1015	Donald Rhoads Declaration
Ex. 1016	Supplemental Expert Declaration of Lenny M. Holden
Ex. 1017	Supplemental Expert Declaration of Rosemary W. Wright

Per the Panel's leave, Petitioner replies to the Patent Owner's Preliminary Response ("POPR") to: (1) align Petitioner's obviousness submissions with the new standards in *LKQ Corp. v. GM Global Technology Operations LLC*, 2024 U.S. App. LEXIS 12139 (Fed. Cir. May 21, 2024) (en banc);¹ and (2) identify where Petitioner submitted evidence that the prior art references are printed publications.

I. *LKQ* AND ITS FOUR FACTUAL INQUIRIES

A. The New *LKQ* Standard For Design Patent Obviousness

"The Director has instructed that Board decisions addressing obviousness in the design patent context must follow the *LKQ* decision." Paper 11 at 4. The decision was summarized in a Patent Office "Updated Guidance". Paper 11 n.2.

LKQ changed the standard to apply "a more flexible approach" than the original Petition and two experts (Exh. 1011 and 1013) applied. It overruled *Rosen-Durling* and "amounts to a restatement of *KSR* ... for design patent claims". Updated Guidance. To be sure, Petitioner's obviousness positions (Grounds 2 and 4-10 in the Petition) are still sound: *LKQ*'s broader standard only strengthens them.

Four factual inquiries must be made under *LKQ*: (1) the scope and content of the prior art, (2) differences between the prior art and the design as claimed at issue, (3) the level of ordinary skill in the art, and (4) secondary considerations may be relevant when evidence is presented. *Id.*; *LKQ*.

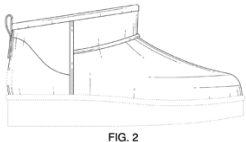
¹ Grounds 1 and 3 are pending and are to §102, so they are not supplemented here.

B. The Four Factual Inquiries Of The *LKQ* Standard Applied Here

Based on the decision (e.g. Paper 11 at 5), Petitioner continues to rely on its original submissions, while indicating *LKQ*'s effect. This confirms obviousness.

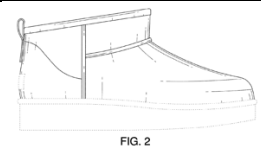
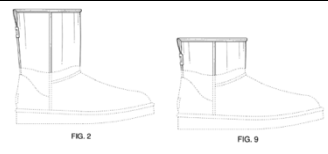
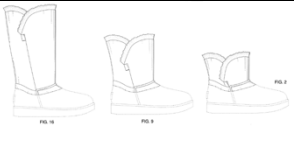
LKQ Factual Inquiry One: A primary reference must be identified. *LKQ* at *25-*31. The primary reference need only be “something in existence—not . . . something that might be brought into existence.” *Id.* The “more visually similar the primary reference is to the claimed design, the better positioned” will be the analysis to set forth a prima facie case of obviousness. *Id.* 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. *Id.*

For each of its Grounds, Petitioner applied a primary reference that was a virtually identical boot to the '161 patent design. Thus, each reference was an appropriate primary reference as “something in existence” in the same field as the '161 design under *LKG* (and under the previous standard also, which the Patent Owner did not challenge). This is illustrated by comparing '161 patent claim 1 Fig. 2 with the three primary references:

'161 Claim 1	Emu Stinger	CN'897	UGG Classic
			
	Grounds 2, 5	Grounds 4, 5, 10	Grounds 6-10
Exh. 1001	Exh. 1002	Exh. 1003	Exhs. 1005-1006

If the primary reference alone does not render the claimed design obvious, design elements from secondary prior art references may be considered. *E.g.*, *LKQ* at *26. 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. *Id.*

For each of its grounds relying on a secondary reference (i.e., Grounds 5 and 7-10), Petitioner applied a secondary reference that was either a virtually identical (MacIntyre’974) or highly similar boot to the ‘161 patent design. Thus, the secondary references are appropriately “something in existence” in the same field as the ‘161 design under *LKG* (and under the previous standard also, which the POPR did not challenge). This is illustrated by comparing ‘161 patent claim 1 Fig. 2 with those secondary references that are also not primary references:

‘161 Claim 1	MacIntyre’974	Chung’186	UGG Neumel
			
	Grounds 8-10	Grounds 8-10	Grounds 5,7,9-10
Exh. 1001	Exh. 1002	Exh. 1003	Exhs. 1005-1006

Ms. Wright identified further secondary references from printed publications (catalogs and journals) that were never addressed by the POPR. They were “in existence” in the same field as the patent. They show the well-known practice of varying shaft heights (leg lengths) in footwear lines. Exh. 1017 pg. 7 citing to Exh. 1014 (e.g., AD4, AD6, AD7, AD9, AD11, AD13, AD16, AD18, AD20, AD22).

LKQ Factual Inquiry Two: Next, the differences must be determined between the prior art and claimed design. *LKQ* at *31-*34. This approach does not use a threshold “similarity” requirement. *Id.* Instead, 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. *Id.*

This was done by Petitioner’s two experts from the perspective of the ordinary designer. The differences were few. Mr. Holden identified any differences for each reference in Exhs. 1011 and 1016, and Ms. Wright identified any for the Patent Owner’s UGG prior art references in Exhs. 1013 and 1017.

Mr. Holden and Ms. Wright determined that these differences fall into three categories: (1) the height of the leg, aka length of the shaft, and/or (2) overall proportions (e.g., different footwear sizes), and/or (3) whether the prior art had a pull tab, and if it did, was it the same or similar to the pull tab of the ‘161 patent. E.g., Exhs. 1016 ¶¶29-42, 54-57, 61, 63-65, 74-75; 1017 pgs. 10-18. Both experts concluded that these differences were trivial, a matter of well-known practice, predictable, and obvious to the ordinary designer, who has strong motivation to address them (e.g., to complete a consistent product line). *Id.*

LKQ 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. *LKQ* at *34. This was done by

Mr. Holden and Ms. Wright in their declarations. E.g., Exhs. 1016 ¶22-27; 1017 pgs. 9-10. The POPR did not challenge these findings.

LKQ Factual Inquiry Four: *LKQ* still takes secondary considerations into account, if evidence is present. *LKQ* at *34-*37. Here, Petitioner and its experts were not aware of any relevant evidence. Likewise, the POPR did not identify any. E.g., Exhs. 1016 ¶75; 1017 pg. 11. This law did not change (*LKQ* at *36: “We do not disturb our existing precedent regarding the application of secondary considerations”), and the POPR submitted no evidence, so this is not further addressed herein (and should not be first raised in a Sur-Reply).

II. *LKQ* AND EVALUATING OBVIOUSNESS HERE

After the first three factual inquiries, the analysis evaluates the obviousness or nonobviousness of the claimed design. *LKQ* at *34-36. If an ordinary designer would have been motivated to modify the prior art to create the same overall visual appearance as the claimed design, then the design is obvious barring convincing secondary indicia. *Id.* This inquiry must focus on the visual appearance of the claimed design as a whole and not on selected individual pieces. *Id.*

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. *Id.* Also, the motivation to combine these references need not come from the references. *Id.* But there must be some

evidence-supported reason (without impermissible hindsight) that an ordinary designer in the field 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. *Id.* 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. *Id.* Conversely, when the appearances are close (as here), this is easier to establish.

In assessing obviousness, relevant factors include an “ordinarily skilled designer’s experience, creativity,” “what market demands and industry customs exist” in the relevant field, and, “which ornamental features are commonplace in the relevant field.” *LKQ* at *35. *LKQ* notes that *KSR* “reiterated ‘the need for caution in granting a patent based on the combination of elements found in the prior art’ ... ‘[r]igid, preventative rules that deny factfinders recourse to common sense, . . . are neither necessary under our case law nor consistent with it.’” *Id.*

A. Overall Findings Regarding The ‘161 Patent Design Under *LKQ*

The POPR did not challenge the Petitioner’s proofs for Factual Inquiry Three and Four, i.e., the standard for an ordinary designer or the lack of any secondary considerations of nonobviousness for the claimed invention.

The POPR also did not challenge the Petitioner’s proofs for Factual Inquiry

One and Two, i.e., the relevancy and interpretation of the primary and secondary references. The primary references are from the same field of endeavor and are virtually identical to the ‘161 patent design. E.g., Exhs. 1016 (¶62, Section VI.A-I); 1017 (pgs. 6-7). Indeed, that which anticipates, renders obvious.

For each primary reference, Petitioner previously showed that any differences from the ‘161 patent design were within the common knowledge and motivation to address of the ordinary designer without the need for a secondary reference (i.e., Grounds 2, 4, 6). This included (1) the height of the leg, aka length of the shaft, and/or (2) overall proportions (e.g., different footwear sizes), and/or (3) whether the prior art had a pull tab, and if it did, was it the same or similar to the pull tab of the ‘161 patent claim. E.g., Exhs. 1016 ¶29-42, 54-57, 61, 63-65, 74-75; 1017 pgs. 10-18. Both experts also explained that the ‘161 patent design was dictated by the materials used – which determines the pattern, stitching and other aspects of the design. E.g., Exhs. 1016 ¶29-42; 1017 pgs. 13-15, 17-18. The POPR did not challenge any of these prior proofs, so it should not be introducing any new evidence on this in a Sur-Reply either.

The secondary references are also from the same field of endeavor and are virtually identical (MacIntyre’974) or very similar to the ‘161 design. Exhs. 1016 ¶62, Section IV.A-I; 1017 pgs. 7-8. They support the obviousness and motivation to make variations in shaft height (or leg length), a change in overall proportions, and

whether to add a particular pull tab. *Id.*; Exhs. 1016 ¶¶29-42, 54-57, 61, 63-65, 74-75; 1017 pgs. 10-18. The POPR also did not substantively challenge these proofs.

Instead, the POPR challenged (1) whether three prior art references were printed publications, (2) whether the Petition and experts examined the overall visual appearance of the claimed design, and (3) whether the Petition argued any new grounds for unpatentability not already considered by the Examiner.

As to (1), the printed publication status is addressed in Section III below.

As to (2), *LKQ* explicitly rejected the POPR argument (e.g., page 41) that the Petition and Mr. Holden were required to *describe* the overall visual appearance of the claimed design. If that were ever the law, it is not so now. *LKQ* at *39-*40 (error to require a party “to identify ‘the correct visual impression created by the patented design as a whole’ in its claim construction”).

Moreover, regardless of the POPR’s misrepresentations (pgs. 38-44) as to what the Petition (Section IX) and experts (Exhs. 1011, 1013) provided, this Reply and the experts (Exhs. 1016, 1017) explicitly follow *LKQ* and first evaluate the overall visual appearance of the ‘161 design and the prior art, comparing them using side-by-side charts. Only after that, in the alternative and in the interests of thoroughness, are design elements examined (including those identified by the Patent Owner for its alleged identical trade dress), and then two separate claim constructions are applied (i.e., with or without the tab on the back of the footwear).

All of these analyses come to the same obviousness conclusion under the *LKQ* framework – which is no surprise considering the virtually identical prior art.

As to (3), Petitioner’s obviousness grounds under *LKG* are new. First, the Petition examined the file history and showed no meaningful prosecution as to the prior art (e.g., no combinations of references were made, no prior art rejections were made, no requests for information were made, no questions were asked, etc.). Petition at 5-9. Second, Petitioner’s obviousness grounds each rely on (a) the knowledge of the ordinary designer relating to changes in shaft height, changes in proportions, and/or additions of pull tabs, or (b) secondary reference combinations, that were never provided to, made by, or suggested to the Examiner. And, importantly, the Examiner did not have the benefit of *LKQ*’s new legal approach.

B. Ground 2: Emu Stinger And Knowledge Of Ordinary Designer

The Emu Stinger Micro is from the same field and is virtually identical to the ‘161 patent claim, with the same overall visual appearance (Exh. 1016 ¶¶67-77):



If there are any perceived differences in proportion, they are slight, and it is

predictable and well-known to the ordinary designer at issue here to make the boot in different sizes and proportions. Exh. 1016 ¶¶73-76. If there are any perceived differences in the pull tabs, they are also slight. It is predictable that an ordinary designer would include a pull tab consistent with its own other short shaft footwear (see below re: Neumel). Exhs. 1016 ¶¶73, 54-57; 1017 pgs. 16-17; Section II.D.

C. Ground 4: CN’897 And Knowledge Of Ordinary Designer

CN’897 is from the same field and is virtually identical to the ‘161 claim. It provides the same overall appearance as the ‘161 design (Exh. 1016 ¶¶78-88):



If there are any perceived differences because of the pull tab of the ‘161 patent claim, they are slight. A designer would be motivated to add a pull tab to the CN’897, to assist in pulling on the boot. Under *LKQ*, this is a commonplace, very well-known feature in the art, and industry custom. It is predictable and well-known. Exhs. 1016 ¶¶84, 54-57; 1017 pgs. 16-17. A designer would also be especially motivated to add a pull tab consistent with other short shaft shoes in its own line (like its Neumel), as discussed immediately below. Also, that the CN’897

has two colors is irrelevant, since color is not claimed in the ‘161 patent. Other differences in the boots, if any, are very minor, and it is well-known to an ordinary designer to make a boot in different sizes and proportions (Exh. 1016 ¶¶84-87).

D. Ground 5: Emu Stinger Or CN’897 And The UGG Neumel

The Emu Stinger Micro and the CN’897 boots are virtually identical to the ‘161 patent claim, as shown above in Sections II.B and II.C (Grounds 2 and 4). The UGG Neumel is also from the same field as the ‘161 claim, and has an identical pull tab to that of the ‘161 patent, as shown below. E.g., Exh. 1016 ¶¶93, 54-57.

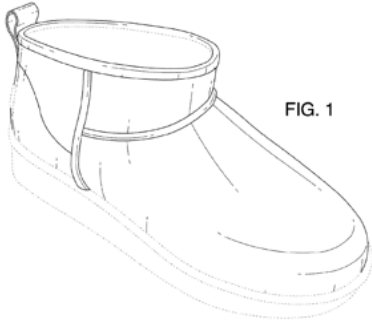


The Emu Stinger Micro, or the CN’897 boot, combined with the UGG Neumel, provides the same overall visual appearance as the ‘161 patent design. E.g., Exh. 1016 ¶¶89-98. Motivation to combine the references is found in the knowledge of the ordinary designer (e.g., Exh. 1016 ¶¶89-98). As noted, a designer would be motivated to add a pull tab to the CN’897, to assist in pulling on the boot. Under *LKQ*, this is a commonplace, very well-known feature in the art, and industry custom. A manufacturer like Patent Owner UGG would also be motivated

to include a pull tab which is consistent with its other long-used pull tabs in its short shaft boots, such as its UGG Neumel. E.g., Exh. 1016 ¶¶93-97. Knowing that a certain pull-tab configuration has worked for consumers for years, under *LKQ* it is common sense that it would be motivated to continue using it. If there are any perceived differences in proportion of the resulting boots, they are slight, and it is predictable and well-known to the ordinary designer at issue here to make the boot in different sizes and proportions. E.g., Exh. 1016 ¶¶92-97, 63-65.

E. Ground 6: UGG Classic And Knowledge Of Ordinary Designer

The UGG Classic Mini is from the same field of endeavor and is virtually identical to the ‘161 design (Exhs. 1016 ¶¶99-110; 1017 pgs. 6-8, 10-13, 17-18).

‘161 patent	UGG Classic Mini
 A line drawing of a boot, labeled FIG. 1. The boot has a pull tab on the back of the shaft. The drawing is a perspective view from the side.	 A photograph of a brown UGG Classic Mini boot. The boot is shown from a side profile, highlighting its short shaft and pull tab.

Basically, UGG’s patented ‘161 design is its UGG Classic Mini with a shorter shaft. But shortening the shaft is obvious – it is well known that some consumers prefer a shorter shaft (to the ankle), which makes it easier to remove the boot. Under *LKQ*, this is common sense. If there are any perceived differences in the pull tabs of the two boots, they are also slight and it is predictable and well-known to the ordinary designer at issue here to add or make the pull tabs of

different and consistent shapes (Exhs. 1016 ¶106, 54-57, 61, 63-65; 1017 pgs. 6-8, 10-13, 16-18). As noted above, this is a well-known feature to help pull the boot on. Any other perceived differences, if any, are slight, and it is predictable and well-known to the ordinary designer at issue here to make a boot in different sizes and proportions. Exhs. 1016 ¶102, 106-109; 1017 pgs. 6-8, 10-13.

F. Ground 7: UGG Classic Mini And UGG Neumel Boot

The UGG Classic Mini boot (Section II.E, Ground 6), with a shortened shaft, combined with the UGG Neumel pull tab (Section II.D, Ground 5), provides the same overall visual appearance as the ‘161 patent design and renders it obvious. E.g., Exhs. 1016 ¶111-124; 1017 pgs. 6-8, 10-13, 17-18. Motivation to combine the references is found in the knowledge of the ordinary designer here. E.g., Exhs. 1016 ¶116-119; 1017 pgs. 16-17. As noted above, a manufacturer like the Patent Owner would also be motivated to include a pull tab which is consistent with other long-used pull tabs in its line, as in its UGG Neumel. It is common sense to add a pull-tab configuration which worked for consumers for years to pull on the Patent Owner’s own other short shaft (Neumel) boot. If there are any perceived differences in proportion of the resulting boots, they are slight, and it is predictable and well-known to the ordinary designer at issue here to make the boot in different sizes and proportions. E.g., Exhs. 1016 ¶120-123, 63-65; 1017 pgs. 10-13.

G. Ground 8: UGG Classic And MacIntyre’974 And/Or Chung’186

The UGG Classic Mini boot (Section II.E, Ground 6), combined with the MacIntyre’974 and/or Chung’189 references, provides the same overall visual appearance as the ‘161 patent design and renders it obvious. E.g., Exh. 1016 ¶¶125-134. The MacIntyre’974 and/or Chung’189, each separately and together, teach and motivate an ordinary designer to make footwear with various shaft heights. Exh. 1016 ¶¶127-133. This is especially so since some consumers prefer shorter shaft heights, as in the ‘161 design. This is also shown by the plethora of such shoes on the market attesting to the popularity of such shorter heights, which are much easier to remove from the foot than higher shaft boots. If there are any perceived differences in proportion of the resulting boots, they are slight, and it is predictable and well-known to the ordinary designer at issue here to make the boot in different sizes and proportions. *Id.*; Exh. 1017 pgs. 10-13.

H. Ground 9: UGG Classic, MacIntyre/Chung, And UGG Neumel

The UGG Classic Mini boot, combined with the MacIntyre’974 and/or Chung’189 references, and the UGG Neumel (Sections II.E-II.G, Grounds 6-8), teach and motivate the ordinary designer to provide the shaft height and pull tab and thus the same overall visual appearance as the ‘161 patent design and render it obvious. E.g., *id.*; Exhs. 1016 ¶¶135-141; 1017 pgs. 6-8, 10-13, 16-18.

I. Ground 10: UGG Classic And CN’897 Alone Or With Others

The UGG Classic Mini (Sections II.E-H, Grounds 6-9) combined with

CN'897 (Sections II.C-D, Grounds 4 and 5), or vice versa, teach and motivate the ordinary designer to provide the same overall visual appearance as the '161 patent design and render it obvious. E.g., *id.*; Exh. 1016 ¶¶142-149. The knowledge of the ordinary designer here and/or the additional references, namely, MacIntyre'974, Chung'189, and/or UGG Neumel, can also be added to further teach and motivate the ordinary designer to provide the shaft height and pull tab and thus the same overall visual appearance as the '161 patent and render it obvious. *Id.*

III. THE CHALLENGED EXHIBITS ARE PRINTED PUBLICATIONS

The POPR argued that the Petition did not include printed publications for three prior art boots, namely the Emu Stinger Micro (Exh. 1002), and the Patent Owner's own UGG Classic Mini (Exh. 1005) and UGG Neumel (Exh. 1009). The POPR did not challenge the other prior art (e.g., Exhs. 1003, 1006-1008, 1014).

The Patent Owner wrongly alleges that printed publications were missing for these three boots. The website printouts provided by Petitioner for the boots, including from the Wayback Machine, qualify as printed publications. *See e.g.*, MPEP § 2128 II; *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374-75, 2021 USPQ2d 867 (Fed. Cir. 2021); Exh. 1015, ¶4. *See also, Hulu, LLC v. Sound View Innovations, LLC*, Case No. IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019) (Petitioner can submit additional evidence of printed publication availability later in the IPR if challenged). The Petition's "sales" references to Patent Owner's own

products (and those of its chief competitor, Emu) were not proffered to bizarrely eliminate the availability of evident “printed publication” documents. Rather, the sales were noted to highlight the public nature of publications promoting those products, and the lack of any possible colorable challenge to such by the Patent Owner if exercising its duty of candor and its knowledge of its own disclosures.

In particular, Exh. 1002 contains ample corroborated evidence of multiple prior art printed publications disclosing the **Emu Stinger Micro**. Exhibit 1002 pages 8-9 are printouts from an Emu website, www.emuaustralia.com.ca (retrieved using the Wayback Machine), for October 27 and November 11, 2017, that disclose the boot. Exh. 1015, ¶4. This is further corroborated by printouts from the Amazon website (www.amazon.com) on pages 10-12 of Exh. 1002 that evidence that the published listing there was provided as early as September 4, 2014. Written reviews for the boot, which are reliable business records, from 2015, 2017, 2018, and 2019, again show the published listing was available then. Exh. 1015, ¶5. Likewise, Exh. 1002 pages 1-7 are prior art printed publications of this boot from the website www.emuaustralia.com.au. Exh. 1015, ¶3. The oldest reviews are from 2016, establishing that the published listing was available then. Emu is the Patent Owner’s chief rival and Petitioner plans to prove Patent Owner copied its product.

Exhibit 1005 contains ample corroborated evidence of multiple prior art printed publications disclosing the **UGG Classic Mini**. Exhibit 1005 pgs. 5-24 and

Exh. 1001 pages 1-2 provide publications from the Zappos.com website. *Indeed, these are the Patent Owner's published listings on the site, and the Patent Owner did not contest availability in its challenge.* Exh. 1015, ¶4. The publications are dated as printed publications available at least on "4/28/2015" and "1/7/2020", which the Patent Owner admitted were prior art (Exh. 2004, ¶2) on the face of the '161 patent and in its file history. *Id.*; Exhs. 2001-2004, 2006, 2007. The printouts also include dated customer reviews showing the website listing was available in the prior art. *Id.* Exh. 1005 page 3 also provides Patent Owner's press release dated July 19, 2016, disclosing the "Classic II Mini, Classic II Short and Classic II Tall." Exhibit 1005 p.4 states it was "Posted by Englin's Fine Footwear on 14th Jul 2016", establishing it as a prior art printed publication. The UGG Classic Mini II is shown with other UGG Classic boots in a Chocolate color in this printed publication.

Exhibits 1009 and 1010 contain ample corroborated evidence of multiple prior art printed publications disclosing the **UGG Neumel**. The Amazon website (www.amazon.com) evidences that the published listing for the boot was as early as December 15, 2015. Exh. 1009, page 2. *This again is the Patent Owner's own published listing.* The Patent Owner knows of its own listing and has a duty of candor in any challenge. Written reviews, which are reliable business records, were also provided, showing the listing were public, printed, publications. *Id.* at 6; Exh. 1015, ¶17-18. This is corroborated by the Patent Owner's pleading: it has disclosed

its own boot since 2011 in marketing/trade publications. Ex. 1010, ¶23-35.

Again, the Patent Owner has a duty of candor. 37 C.F.R. §1.56. If it wishes to (disingenuously) challenge the printed publication status, it must also submit any contrary evidence in its records. *Id.* §1.56(b). This includes all evidence that its own UGG Classic Mini (Mini II and Short), and UGG Neumel, and its competitor's Emu Stinger Micro, were in prior art printed publications.

IV. CONCLUSION

“For over a half century, the [Supreme] Court has held that a patent for a combination which only unites old elements ... is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-16 (2007). There is abundant evidence of the “design incentives and market forces” (*id.* at 417) prompting “predictable variation[s]” (*id.*), of the prior art, all yielding the patented design. *Multiple* approaches yield the same results. It is not invention to shorten a shaft and/or add a (functional) pull tab – to apply elementary design variations well known for decades. This is a textbook case of obviousness.

Accordingly, the Petition should be granted and claim 1 canceled under, *inter alia*, the *LKQ* standard applied to the prior art, which are all printed publications.

Date: June 20, 2024

Respectfully submitted,

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

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing conforms with the page limits set forth by the Panel in its decision granting leave to file this Reply (and, at 4,259 words, is within the 5,600 word limit set by 37 CFR §42.24(c)(1)).

This PETITIONER’S REPLY TO PATENT OWNER’S PRELIMINARY RESPONSE also complies with the general format requirements of 37 C.F.R. §42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

Date: June 20, 2024

Respectfully submitted,

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

CERTIFICATE OF SERVICE

The undersigned certifies that on June 20, 2024, a copy of the foregoing
PETITIONER’S REPLY TO PATENT OWNER’S PRELIMINARY RESPONSE
and the associated exhibits 1016 and 1017 were served in their entireties upon the
following parties via electronic mail:

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Date: June 20, 2024

Respectfully submitted,

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