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UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

COLE HAAN LLC Plaintiff, v. TOP GLORY TRADING GROUP INC. AND DP DREAM PAIRS INC. Defendants.	**CIVIL ACTION NO. 2:25-cv-00176-ES-SDA** **JURY TRIAL DEMANDED** **MEMORANDUM IN SUPPORT OF DEFENDANTS' MOTION TO DISMISS THE AMENDED COMPLAINT PURSUANT TO FED. R. CIV. P. 12(B)(6)** **MOTION DATE: APRIL 7, 2025**

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I. INTRODUCTION AND SUMMARY OF ARGUMENT

Defendants Top Glory Trading Group Inc. and DP Dream Pairs Inc. (collectively, "Top Glory") respectfully move pursuant to Fed. R. Civ. P. 12(b)(6) to dismiss Cole Haan LLC's ("Cole Haan") Amended Complaint for failure to state a claim. The Amended Complaint alleges that certain Top Glory shoes infringe three related utility patents (U.S. Patent Nos. 10,327,511 ("the '511 patent"), 10,443,163 ("the '163 patent"), and 11,041,262 ("the '262 patent") (collectively, the "Utility Patents")) and/or one design patent (U.S. Patent No. D768,969 (the "'969" or "Design" Patent)) (collectively, the "Asserted Patents"). But as explained herein, the Utility Patents are invalid over prior art cited during prosecution, and Cole Haan has failed to plausibly plead infringement of the Design Patent.

The Utility Patents are invalid because the applicant admitted during prosecution of the '511 patent that the pending claims were unpatentable over a prior art reference (U.S. Patent No. 7,347,011 (Ex. A[1]; "Dua") before the applicant amended the claims to include an *aesthetic feature*—the claimed wingtip pattern. The applicant relied upon similar aesthetic features to avoid Dua in claims of the related '163 and '262 patents. But in utility patents, aesthetic or ornamental features are not entitled to patentable weight. *In re Seid*, 161 F.2d 229, 231 (C.C.P.A. 1947); *see also Crocs, Inc. v. Polliwalks, Inc.*, No. IPR2014-00423, 2014 WL 4181937, at *6 (P.T.A.B. Aug. 20, 2014) (finding "terms relating to the ornamental design of the shoe do not need to be interpreted because the recitation of features that relate to 'ornamentation only and have no mechanical function whatsoever' cannot be relied upon for patentability of a claim in a utility patent application." (quoting *Seid*, 161 F.2d at 231)). Because the intrinsic record shows that the only

[1] Exhibits ("Ex. __") cited herein are exhibits to the Declaration of Yenis V. Argueta Guevara filed herewith.

claim limitations in the Utility Patents that are entitled to patentable weight are admittedly unpatentable over Dua, the Amended Complaint fails to state a claim for infringement of those invalid patents.

The Design Patent should also be dismissed because the Amended Complaint itself shows clear differences between the claimed design and the accused products, and different overall visual effects such that the designs are plainly dissimilar and no ordinary observer could determine that the Design Patent and the accused products are substantially the same.

Because the Utility Patents are invalid and because the Design Patent is not infringed, the Amended Complaint fails to state a claim for infringement and must be dismissed with prejudice.

II. STAGE OF THE PROCEEDINGS AND STATEMENT OF FACTS

On January 7, 2025, Cole Haan filed its Complaint accusing Top Glory of infringing the Asserted Patents. Dkt. 1 at ¶¶ 26-28. Cole Haan filed an Amended Complaint on January 30, 2025, to remove allegations regarding infringement of the '969 patent by Top Glory's KnitFlex Breeze+ shoe. *Compare* Dkt. 8 at ¶¶ 88-96 *with* Dkt. 1 at ¶¶ 88-96. The Top Glory products accused of infringement and the claims of the Asserted Patents identified in the Amended Complaint are summarized in the table below:

Asserted Patents	Asserted Claims	Accused Product
'511 patent	1, 21[2]	[MaxFlex SuiteCraft+] Men's Smart Casual Knit Oxford Shoe [KnitFlex Breeze+] Men's Mesh Wingtip Oxford Sneakers [KnitFlex SmartCraft-] Men's Lightweight Mesh Casual Oxfords
'163 patent	1[3]	
'262 patent	1[4]	[MaxFlex SuiteCraft+] Men's Smart Casual Knit Oxford Shoe [KnitFlex SmartCraft-] Men's Lightweight Mesh Casual Oxfords
'969 patent	N/A	[MaxFlex SuiteCraft] Men's Casual Wingtip Dress Sneakers [MaxFlex SuiteCraft-] Men's Business Casual Oxford Sneakers [MaxFlex SuiteCraft+] Men's Smart Casual Knit Oxford Shoes

[2] *Id.* at ¶ 39.
[3] *Id.* at ¶ 62.
[4] *Id.* at ¶ 74.

A. The Utility Patents

The Utility Patents are related and share a substantively identical specification[5] because the '262 patent is a continuation of the application that issued as the '163 patent, which is itself a continuation of the application that issued as the first-filed '511 patent. *See* Dkt. 8-3 ('262 patent) at 2 ("Related U.S. Application Data" section).

According to the common specification, the Utility Patents are directed to shoes having knit uppers and methods for making the same. Dkt. 8-1 ('511 patent) at 1:25-26, 2:24-25. The Utility Patents disclose a shoe 10 with a sole 12 and a knit upper 14 having a unitary, one-piece knit element 20. *Id.* at 3:46-58, Fig. 1. In other words, "various regions of the knitted element are formed together during the knitting process," e.g., by "seamlessly knitt[ing]" one region with an adjacent region. *Id.* at 6:4-17.

The knit element 20 includes "a wingtip pattern knit into the knit upper." *Id.* at Abstract, 3:46-58, 4:21-31, Fig. 1. The wingtip pattern 36 may be defined by "holes 42a, 42b of the lateral and medial lines of broguing 40a, 40b" that extend forward from their respective metatarsal regions 28a, 28b to the upper toe region 32. *Id.* at 4:30-60, 6:23-26, Fig. 5. The broguing 40a, 40b is "[p]referably" formed via "the knitting process as opposed to being formed by removal of material such as by cutting or punching." *Id.* at 4:57-60. In addition, or in the alternative, the knitted element 20 may include a wingtip pattern 38 that is formed at a boundary line 60 between a "first area, generally indicated at 52, of a first type of knit structure," such as a "more tightly knit" "jersey stitch knit," and "a second area, generally indicated at 54, of a second type of knit structure," such as a "pointelle stitch knit." *Id.* at 4:61-5:32, Fig. 5.

[5] Top Glory will refer to the '511 patent when describing the disclosure of the Asserted Patents. Because the Utility Patents share a common specification, that description is equally applicable to the other Utility Patents.

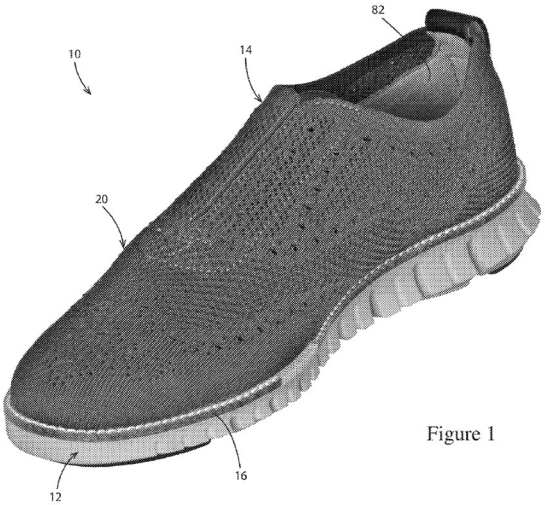

Figure 1

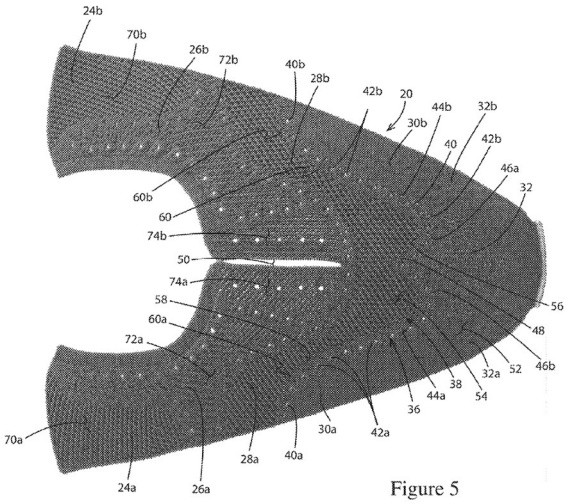

Figure 5

Notably, the Utility Patents do not identify any unconventional techniques associated with or advantages realized in the claimed invention. For example, the Utility Patents do not purport to require the use of any unconventional knitting techniques to form the claimed patterns in the knit upper during the knitting process or advantages associated with seamlessly knitting a shoe upper not already known in the prior art.

The ’511 patent was filed on July 8, 2016, and issued on June 25, 2019. Dkt. 8-1 at 2. Claim 1 of the ’511 patent recites a shoe comprising a knit upper and a sole secured to the knit upper, wherein the knit upper has a knit element formed of a unitary one-piece construction and comprising several regions, some of which are knitted with a wingtip pattern. In response to a prior art rejection during prosecution, the Applicant added the limitation:

> **the wingtip pattern comprising a medial line of broguing and a lateral line of broguing, the upper toe region, the upper lateral and medial ball regions, and the upper lateral and medial metatarsal regions collectively being knitted with the medial and lateral lines of broguing, the medial line of broguing comprising a wing-shaped curved line of holes having a medial side broguing portion extending forward from at least the upper medial metatarsal region to the upper toe region and a central broguing portion extending rearward from the upper toe region, the lateral line of broguing comprising a wing-shaped curved line of holes having a lateral side broguing portion extending forward from at least the upper lateral metatarsal region to the upper toe region and a central broguing portion extending rearward from the upper toe region, the**

> **rearwardly extending central broguing portion of the medial line of broguing converging toward the rearwardly extending central broguing portion of the lateral line of broguing**.

Prior to this amendment, the examiner had rejected the pending claims, including claims 2 and 22 (which ultimately issued as asserted claims 1 and 21, respectively), under 35 U.S.C. § 103 as being unpatentable over Dua alone or in view of U.S. Patent No. 2,312,078 ("Crannell"). Ex. B (October 5, 2018 Office Action), at 2-8.[6] In doing so, the Examiner relied upon Dua's teaching of a shoe 10 with an upper 30 that is formed from a seamlessly knitted textile element 40'' having a knitted design pattern 46'', 47'', 48'' created using "various stitches . . . for different areas," e.g., to create "broguing (perforations, 48'')," but conceded Dua did not (1) disclose "the specific design pattern," i.e., "*wingtip* design" recited in claim 2 or (2) specifically identify using the "jersey stitch knit and a pointelle stitch knit" recited in claim 22. *Id.* at 3-5 (citing Dua, Fig. 11) (emphasis in original).[7] Regarding claim 2, the examiner explained that it would have been "an obvious matter of design choice . . . to provide the broguing [in Dua]" or the wingtip configuration disclosed in Crannell "to optimize the aesthetic appeal of [] Dua's shoes." *Id.* at 4-5. Regarding claim 22, the examiner explained that, because Dua disclosed that "various stitches may be used for different areas (46, 47, 48) of the knitted element," it would have been obvious to "to choose from different knit stitches including jersey and pointelle in order to vary the texture, physical properties, or aesthetics of footwear within a single, unitary element of material." *Id.* at 5.

In response, the applicant incorporated then-pending independent claim 1 into dependent claim 2 (bolded limitations) and argued the patentability of the claim as amended. Ex. C (April 3,

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[6] As noted below, prosecution histories may be considered when deciding a motion to dismiss—even if they are not attached to the complaint—because they are part of the intrinsic record and are "public records" subject to judicial notice. *Genetic Techs. Ltd. v. Bristol-Myers Squibb Co.*, 72 F. Supp. 3d 521, 526 (D. Del. 2014).

[7] All emphasis added unless noted otherwise.

2019 Response and Amendment) at 11-16. While the applicant conceded that Dua disclosed "knitted design patterns [46'', 47'', 48''],'' the applicant argued those patterns "are isolated and segmented rather than the lines of broguing of claim 2 which extend from the lateral metatarsal region into the toe region and into the medial metatarsal region." *Id*. at 11. Therefore, according to the applicant, "Dua fails to disclose [] *a wingtip pattern*" including "lines of broguing *that extend throughout multiple regions of the shoe*" that are "seamlessly knit with and into the upper." *Id.*; *see also id.* at 12 ("Dua does not disclose a knit line of broguing extending in multiple seamlessly knit shoe regions."). As for Crannell, the applicant argued (1) the reference did not cure Dua's deficiencies—despite disclosing "a leather upper" with "perforation[s]" or "broguing" in a wingtip pattern—because Crannell did not disclose "a knitted line of broguing," *id.* at 12, (2) the examiner's rationale for combining the references was impermissible hindsight because the '511 patent was allegedly "the first to recognize the desirability of a knit upper *with the claimed pattern*," *id.* at 14, and (3) the claims were not obvious as an "aesthetic design change" because "the claimed *knit pattern* inherently has mechanical function." *Id.* at 15. With respect to then-pending claim 22, the applicant similarly argued that Dua failed to teach the "claimed configuration" despite disclosing "variations [sic] stitches." *Id.* at 16. That response was followed by a Notice of Allowance on April 23, 2019.

The '163 patent, which is a continuation of the '511 patent, was filed on May 13, 2019, and issued on October 15, 2019. Dkt. 8-2 ('163 patent) at 2. During prosecution, the examiner rejected the pending claims for nonstatutory double patenting in light of claims 1-23 of the '511 patent because "[a]lthough the claims at issue are not identical, they are not patentably distinct from each other." Ex. D (July 11, 2019 Non-Final Rejection) at 3. In response, the applicant filed a terminal disclaimer, which was followed by a Notice of Allowance on August 26, 2019.

The ’262 patent, which is a continuation of both the ’511 patent and ’163 patent, was filed on September 20, 2019, and issued on June 22, 2021. Dkt. 8-3 (’262 patent) at 2. During prosecution, the examiner rejected the pending claims for nonstatutory double patenting in light of claims 1-23 of the ’511 patent because “[a]lthough the claims at issue are not identical, they are not patentably distinct from each other.” Ex. E (October 15, 2020 Non-Final Rejection) at 3. In response, the applicant filed a terminal disclaimer, which was followed by a Notice of Allowance on February 5, 2021.

For purposes of this motion, and except as explained in the remainder of this paragraph, the patterns recited in claim 1 (i.e., broguing extending across regions of the upper and forming a wingtip pattern) and claim 21 (i.e., “a first area of a jersey stitch knit” in the “upper toe region” and “a second area of a pointelle stitch knit” in the “upper lateral and medial metatarsal regions”) of the ’511 patent are generally representative of those in the remaining Asserted Claims.[8] For example, claim 1 of the ’163 patent similarly recites a “wingtip pattern” defined by “line[s]” in the upper between “a first area of a first type of knit structure and a second area of a second type of knit structure.” ’163 patent, cl. 1. And claim 1 of the’262 patent likewise recites knitting a knitted upper toe region having “a first area of jersey stitch knit” and knitted upper metatarsal regions having “a second area of pointelle stitch knit” in which “a line of broguing adjacent the boundary line” is defined between the first area and second area. ’262 patent, cl. 1. These claim limitations will be referred to as the “Claimed Patterns” herein.

B. The ’969 Patent

The ’969 patent was filed on October 13, 2015, and issued on October 18, 2016. Dkt. 8-4

[8] The Amended Complaint appears to concede as much in so far as it consistently refers back to allegations made with respect to other Utility Patents when asserting infringement of the ’163 patent and ’262 patent. Dkt. 8 at ¶¶ 63-66, 75-77, 79-82.

('969 patent) at 2. Unlike the Utility Patents, the '969 patent is not directed to an entire shoe, but instead claims the ornamental design for a shoe *midsole*. *Id.* As shown in the figures, that claim (shown in solid lines) includes a midsole having layered ridges that (1) extend continuously from a heel section to a toe section, and (2) include at least three edged layers (i.e., layers with substantially similarly sized top and bottom surfaces that meet at a protruding edge) and a rounded upper layer, where the layered ridges form a generally linear heel section, a downwardly sloped midsection in which the ridges are compressed (i.e., decrease in height), and an upwardly sloped toe section with compressed ridges. *See* Fig. 3 (annotated). The upper and toe portion of the shoe, shown in broken lines, form no part of the claimed design. *Id.* at 2 ("The broken lines are for the purpose of illustrating environmental structure; the broken lines form no part of the claimed design.")

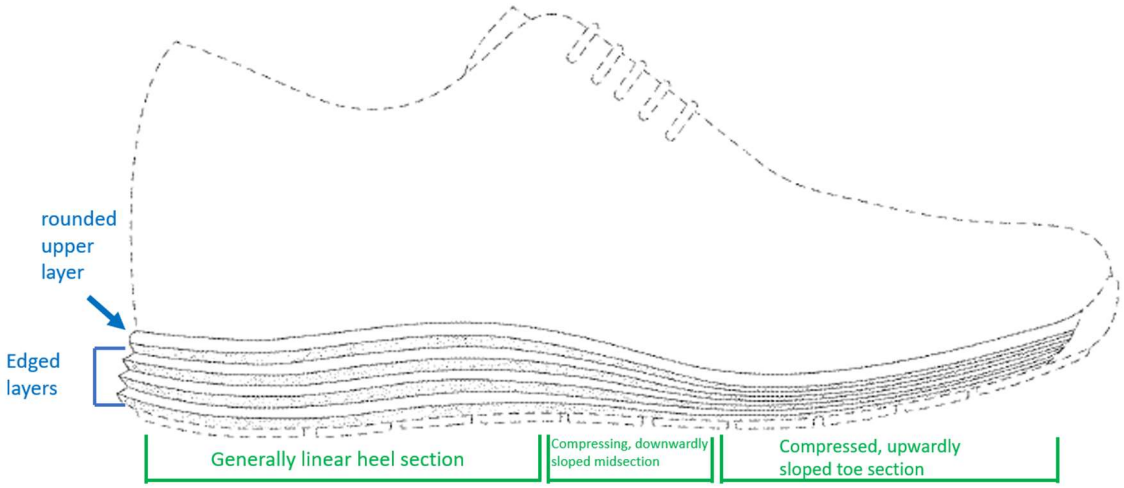


Fig. 3 (annotated)

III. LEGAL STANDARDS

A. Motion to Dismiss

A complaint must contain "a short and plain statement of the claim showing that the pleader

is entitled to relief." Fed. R. Civ. P. 8(a)(2).

> To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, "to state a claim to relief that is plausible on its face." A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.

Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (citations omitted). Allegations that "do not permit the court to infer more than the mere possibility of misconduct" are insufficient. *Id.* at 679. "Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice." *Id.* at 678 (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)). When plaintiff has "not nudged [its] claims across the line from conceivable to plausible, [its] complaint must be dismissed." *Twombly*, 550 U.S. at 570.

When deciding a motion to dismiss, courts in the Third Circuit "consider only the complaint, exhibits attached to the complaint, matters of public record, as well as undisputedly authentic documents if the complainant's claims are based upon these documents." *Mayer v. Belichick,* 605 F.3d 223, 230 (3d Cir. 2010). Thus, the court may "take judicial notice of the prosecution histories, which are 'public records.'" *Genetic Techs. Ltd.*, 72 F. Supp. 3d at 526 (citing *Hockerson-Halberstadt, Inc. v. Avia Grp. Int'l, Inc.*, 222 F.3d 951, 957 (Fed. Cir. 2000)); *see also UTTO Inc. v. Metrotech Corp.*, 119 F.4th 984, 993-94 (Fed. Cir. 2024) (explaining courts can consider "intrinsic evidence" like patent prosecution histories when deciding a motion to dismiss).

Typically, district courts adjudicating patent cases apply the law of the Federal Circuit. Where the motion to dismiss bears on an issue that "pertains to or is unique to patent law," district courts must look to the law of the Federal Circuit. *See, e.g.*, *Cent. Admixture Pharmacy Servs., Inc. v. Advanced Cardiac Sols., P.C.*, 482 F.3d 1347, 1356 (Fed. Cir. 2007) (quoting *Intel Corp. v. Commonwealth Sci. & Indus. Rsch. Org.*, 455 F.3d 1364, 1369 (Fed. Cir. 2006).

Dismissal is warranted when a patent owner alleges infringement of a patent claim that is invalid as a matter of law. *See, e.g.*, *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1349 (Fed. Cir. 2014) (dismissing claim for patent infringement under Rule 12(b)(6) where patent claims were invalid under 35 U.S.C. § 101). The Federal Circuit recently confirmed that district courts may resolve invalidity as a matter of law at the pleadings stage—even where limited claim construction is necessary. *UTTO*, 119 F.4th at 992-94 ("[T]here is no procedural error in . . . constru[ing] claims [on a motion to dismiss] without conducting a separate *Markman* claim-construction set of proceedings, much less without hearing extrinsic evidence or expert testimony."). For example, when "a claim's meaning [is] so clear on the only point that is ultimately material to deciding the dismissal motion" (e.g., where claims can be "construed based on intrinsic evidence alone"), it "is proper and routine" to construe the claims when "ruling on a motion" to dismiss. *Id.* at 994.

B. Patentability of Aesthetic Claim Limitations under 35 U.S.C. § 101

"Design and utility patents are based on different statutory provisions and involve different subject matter." *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939 (Fed. Cir. 1983). "Utility patents afford protection for the mechanical structure and function of an invention whereas design patent protection concerns the ornamental or aesthetic features of a design." *Id.* at 939 n. 13. "The scope of protection afforded by each type of patent is different." *Id.* at 939.

In utility patents, claim limitations reciting purely ornamental/aesthetic features are not entitled to patentable weight because those limitation are patent ineligible under 35 U.S.C. § 101. *In re Seid*, 161 F.2d at 231; *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1161-62 (Fed. Cir. 2018); *Crocs*, 2014 WL 4181937, at *6. Because design patents protect an "*ornamental* design for an article of manufacture," 35 U.S.C. 171(a), ornamental features are not properly the subject of utility patents and therefore afforded no patentable weight. *In re Seid*, 161 F.2d at 231

(finding claim limitations that "relate to ornamentation only" are not entitled to patentable weight because "the claims are not directed to a design but are structural claims").

As a question of law, patent ineligibility may be resolved at the pleading stage. *Content Extraction*, 776 F.3d at 1349.

C. Unpatentability of Claims That Require Amendment to Overcome Prior Art

Arguments and "amendment[s] to overcome a prior art rejection [during prosecution] evidences an admission that the claim was not patentable." *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1481 (Fed. Cir. 1998) (citations omitted). Statements made during prosecution are relevant to patents in the same family. *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1307 (Fed. Cir. 2007). Because "a member of the public is entitled to occupy the space abandoned by the patent applicant" via argument or amendment "to overcome prior art," a patentee is "precluded from recapturing what it earlier conceded." *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996 (Fed. Cir. 1993); *see also Hester*, 142 F.3d at 1482.

Likewise, "a patentee's representations to the PTO during the prosecution of its patent application about the scope of the prior art is a binding admission and should 'be accepted at face value' during subsequent litigation over the patent." *Procter & Gamble Co. v. Nabisco Brands, Inc.*, 711 F. Supp. 759, 770 (D. Del. 1989). Thus, where a patentee characterizes the disclosure of a reference during prosecution, the patentee cannot "assert a contrary position in this lawsuit." *Sherwin-Williams Co. v. PPG Indus., Inc.*, No. CV No. 17-1023, 2021 WL 211497, at *4 (W.D. Pa. Jan. 21, 2021).

D. Design Patent Infringement

Courts may "dismiss[] claims of design infringement on Rule 12(b)(6) motions where, as a matter of law, the court finds that no reasonable fact-finder could find infringement." *MSA*

Prods., Inc. v. Nifty Home Prods., Inc., 883 F. Supp. 2d 535, 540 (D.N.J. 2012) (collecting cases). The test for design patent infringement is known as the "ordinary observer" test and has been articulated as follows:

> [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (quoting *Gorham Co. v. White*, 81 U.S. 511, 528 (1871)). The application of the test involves a side-by-side comparison of the claimed design (i.e., drawings of the design patent) and the accused products. *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1304 (Fed. Cir. 2010). The claimed design includes solid lines and surface shading. Aspects of the drawings illustrated with broken lines are excluded from the scope of the patent and only provide context. *See Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001).

"Where the claimed and accused designs are 'sufficiently distinct' and 'plainly dissimilar,' the patentee fails to meet its burden of proving infringement as a matter of law." *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1335 (Fed. Cir. 2015) (quoting *Egyptian Goddess*, 543 F.3d at 678). For example, if the accused product contains "many non-trivial components [that] combine to create a different visual effect as a whole" than the claimed design, the claim should be dismissed. *Steven Madden, Ltd. v. Yves Saint Laurent*, No. 18-CV-7592 (VEC), 2019 WL 2023766, at *3-4 (S.D.N.Y. May 8, 2019) (dismissing design patent infringement claim alleging that defendant's sandal infringed patented shoe design).

IV. <u>ARGUMENT</u>

The claims of the Utility Patents are invalid because Cole Haan admitted during prosecution that all claim limitations entitled to patentable weight (i.e., non-aesthetic limitations)

are unpatentable over Dua. And because no ordinary observer could determine that the Design Patent and the accused products are substantially the same, Cole Haan has failed to plausibly plead infringement. Pursuant to Fed. R. Civ. P. 12(b)(6), the Amended Complaint should be dismissed with prejudice.

A. The Utility Patents Are Invalid As A Matter Of Law

The Asserted Claims are invalid over Dua.[9] As explained below, the aesthetic features Cole Haan relied upon during prosecution to overcome Dua are not entitled to patentable weight under § 101. And Cole Haan conceded during prosecution that the remaining claim limitations unpatentable over Dua. The Asserted Claims are invalid.

1. The Aesthetic Limitations Are Not Entitled To Patentable Weight

The Claimed Patterns (e.g., the wingtip/broguing/line designs and stich patterns) recited in the Asserted Claims are ornamental and aesthetic features that are not entitled to patentable weight as a matter of law. *In re Seid*, 161 F.2d at 231 (finding the "shape and arrangement" of a claimed device "relate to ornamentation only" and were not entitled to patentable weight); *see also In re Marco Guldenaar Holding B.V.*, 911 F.3d at 1161-62 (finding claimed markings on a die are patent-ineligible printed subject matter). In particular, the "wingtip pattern" including "a medial line of broguing and a lateral line of broguing" that include a "curved line of holes" "extending [] from the upper metatarsal [] region[s] to the upper toe region" and the "a first area of a jersey stitch knit" in the "upper toe region" and "a second area of a pointelle stitch knit" in the "upper lateral and medial metatarsal regions" relate to ornamentation such that they are patent ineligible and not entitled to patentable weight under § 101. *See Carman*, 724 F.2d at 939 ("Utility patents afford

[9] Dua, which was filed by Cole Haan's former corporate parent (Nike, Inc.) on March 3, 2004 and issued on March 25, 2008 (i.e., over 8 years prior to the earliest claimed priority date for the Asserted Utility Patents), qualifies as prior art under 35 U.S.C. § 102(a)(1).

protection for the mechanical structure and function of an invention whereas design patent protection concerns the ornamental or aesthetic features of a design."); *see also Crocs*, 2014 WL 4181937, at *6 (USPTO declining to construe "three dimensional animal or character figure" limitation for patent directed to shoe, because the limitation relates to an ornamental design that "cannot be relied upon for patentability of a claim in a utility patent application.").

The Claimed Patterns at issue here share many similarities with the limitations determined to have no patentable weight in *Seid*. 161 F.2d at 231. In *Seid*, the claim at issue was directed to an "advertising display device" and recited "an artificial display figure" that was adapted to fit on the neck of a bottle and which "represent[s] exteriorly a human" figure "including shoulders and arms" arranged so the arms "rest upon the sloping bottle portion just above the bottle shoulder." *Id.* at 229-30. The court explained that the limitations reciting the "shape and arrangement of the upper part of the body in [the claimed] figure, including the arrangement of the arms" "relate to ornamentation only" and thus cannot "properly be relied on" for patentability because the "appealed claims are not directed to a design." *Id* at 231. Similarly, the USPTO found that the limitation of a "three dimensional animal or character figure" on a shoe is not entitled to patentable weight. *Crocs*, 2014 WL 4181937, at *6. So too here. The claim limitations merely recite ornamental features in the form of patterns and configurations that are applied to a shoe rather than functional features. Indeed, this is highlighted by the fact that Cole Haan's U.S. Patent No. D905,386 (Ex. F), which claims priority to the '511 patent, claims the wingtip design and lines of broguing of the footwear. Thus, these ornamental Claimed Patterns in the Asserted Claims should not be entitled to patentable weight.

But even if the Claimed Patterns had some functional characteristics—despite those functional characteristics appearing nowhere in the specification or prosecution history—those

functional aspects are nonetheless disclosed in Dua.

2. Dua Renders the Remaining Limitations Unpatentable and the Claims are Invalid

The Utility Patents are invalid because Cole Haan admitted all claim limitations except the ornamental Claimed Patterns were unpatentable over Dua. But, as explained above, the ornamental features are not patent eligible under 35 U.S.C. § 101 and are therefore not entitled to patentable weight. Thus, the only claimed features entitled to patentable weight are admittedly unpatentable over Dua—and the claims of the Utility Patent are invalid.

The applicant conceded during prosecution of the ’511 patent that the limitations of the claims other than the ornamental features were unpatentable over Dua. *See Hester*, 142 F.3d at 1481 (“[A]mendment[s] to overcome a prior art rejection [during prosecution] evidences an admission that the claim was not patentable.”). In particular, the applicant admitted that Dua disclosed “a knitting operation in which a design is incorporated as the upper is knit,” where the design included “knitted design patterns [46’’, 47’’, 48’’]” that may include variations in stitch type. Ex. C at 11-13, 16; *see also Procter & Gamble*, 711 F. Supp. at 770 (“[A] patentee’s representations to the PTO during the prosecution of its patent application about the scope of the prior art is a binding admission and should ‘be accepted at face value’ during subsequent litigation over the patent.”). To overcome Dua, the applicant argued that Dua’s “knitted design patterns [46’’, 47’’, 48’’]” were not the specific ornamental features recited in the claims. The focus on the ornamental differences was unmistakable: “Dua fails to disclose [] *a wingtip pattern*”; “Dua does not disclose a knit *line of broguing extending in multiple* seamlessly *knit shoe regions*”; Dua’s knitted design patterns 46’’, 47’’, 48’’ “are *isolated and segmented* [unlike] the lines of broguing of claim 2”; Dua does not disclose “*lines of broguing that extend throughout multiple regions of the shoe.*” *Id*. at 11-16. Negating those features, which are not entitled to patentable weight, results

in claims that are admitted anticipated by Dua. *See Hester*, 142 F.3d at 148; *Procter & Gamble*, 711 F. Supp. at 770.

To be sure, Cole Haan correctly conceded that Dua disclosed the remaining limitations. Consistent with the examiner's rejection, Dua discloses "an article of footwear 10 and a method of manufacturing footwear 10." Dua, 4:24-27. The footwear 10 includes a sole structure 20 and an upper 30 that is "formed from a textile element 40" that "form[s] substantially all of the upper 30." *Id*., 4:40-51; *see also id.*, 5:18-34 (describing the various regions of the upper). The textile element 40 "is a single material element that is formed to exhibit a unitary (i.e., one-piece) construction." *Id*.. 5:38-41. That textile element 40 can be manufactured using circular knitting processes to create a "seamless" textile and/or to "vary the stiches within textile element 40 to produce various patterns, designs, or textures." *Id.*, 7:5-10, 7:29-40, 9:1-10.

In one example, Dua discloses a textile element 40'' that includes a "generally smooth" first texture 46'', a "rough" second texture 47'', and a third texture 48''. *Id.*, 9:36-54, Fig. 11. To "vary the texture, physical properties, or aesthetics of footwear 10 within a single, unitary element of material," the "different textures 46''-48'' are formed by [] varying the type of stich formed…at each location" or by "omitting stitches at specific locations" to form "apertures that extend through textile element 40'"" via the knitting process. *Id*. In other words, Dua discloses altering functional characteristics of the upper by using different patterns and stitch types at various locations in the upper. *Id.* (discussing varied physical properties like "degree of stretch," "wear resistance," and "air permeability").

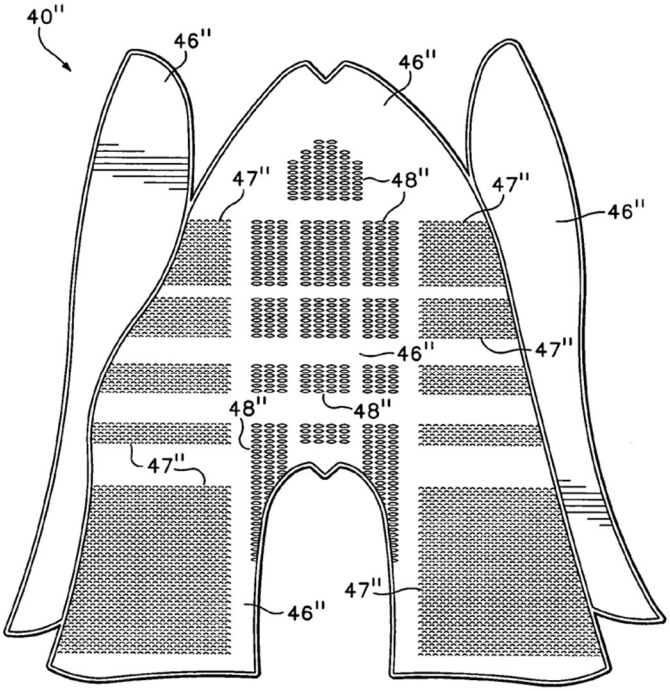


Figure 11

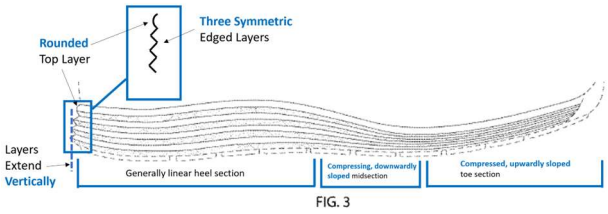
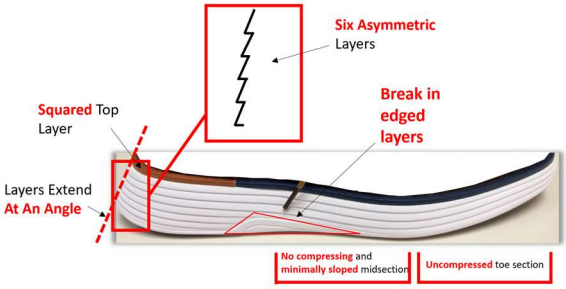
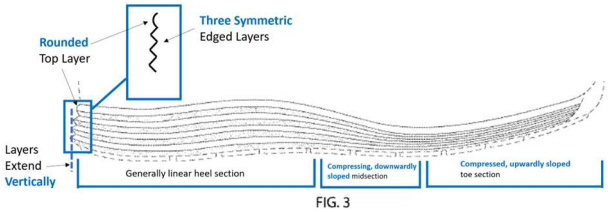
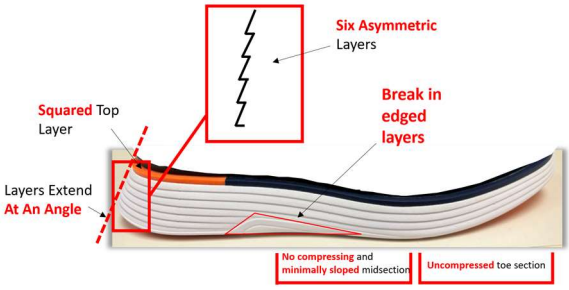
As is apparent from the foregoing description, the non-ornamental features of the claims are unpatentable over Dua. *See also* Ex. B at 2-9. Namely, Dua teaches footwear having a unitary one-piece knit upper having seamlessly knitted regions as recited in the claims. Dua, 5:38-41, Fig. 11. And Dua discloses knit structures (e.g., jersey stitch knit vs. pointelle) within the upper, and apertures formed during the knitting process by omitting stitches. *Id.*, 9:36-54, Fig. 11. Dua also teaches any alleged functionality involved in the Claimed Patterns. *Id.* Thus, every limitation of the Asserted Claims that is entitled to patentable weight is unpatentable over Dua, and the Asserted Claims are therefore invalid.

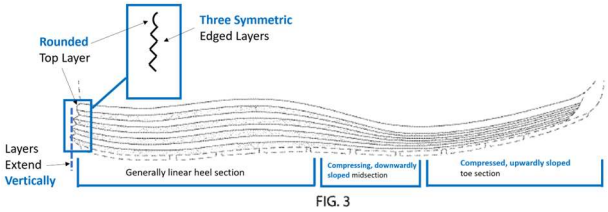
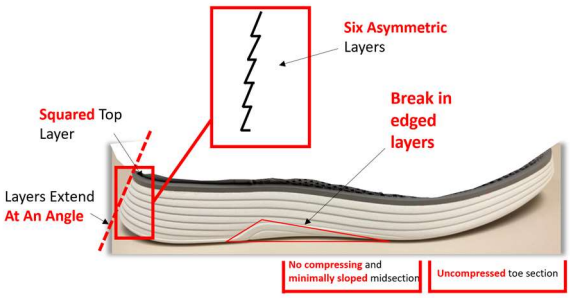
B. The Accused Products Do Not Infringe the Design Patent

The Amended Complaint itself shows that Top Glory's products do not infringe the Design Patent. The products accused of infringing this patent and claimed design are so plainly dissimilar to an ordinary observer that no reasonable fact finder could find infringement. *Steven Madden*,

2019 WL 2023766, at *3-4 (dismissing design patent infringement claim alleging that defendant's sandal infringed patented shoe design).

The Design Patent claims a design not for an entire shoe, but for a midsole having (1) a ***rounded*** top layer; (2) ***three*** edged layers (3) that extend ***continuously*** from a heel section to a toe section, (4) where the edged layers are ***vertically*** stacked and (5) ***symmetric*** (i.e., layers with substantially similarly sized top and bottom surfaces that meet at a protruding edge); (6) a ***downwardly sloped*** midsection in which the edged layers are ***compressed*** (i.e., decrease in height); and (7) an upwardly sloped toe section with ***compressed*** edged layers. The infringement inquiry thus requires comparing the patented design with the midsoles in the accused products to determine whether an ordinary observer would find them to be substantially similar in overall appearance. *See Egyptian Goddess*, 543 F.3d at 678. The table below shows a side-by-side comparison between the claimed midsole of the Design Patent and relevant portions of the accused products:

Design Patent Figure	Figures from Amended Complaint
 Design Patent, Fig. 3 (cropped; annotated)	**Accused [MaxFlex SuiteCraft] Men's Casual Wingtip Dress Sneakers**  Dkt. 8, 27 (cropped; annotated)
 Design Patent, Fig. 3 (cropped; annotated)	**Accused [MaxFlex SuiteCraft-] Men's Business Casual Oxford Sneakers**  Dkt. 8, 29 (cropped; annotated)

Design Patent Figure	Figures from Amended Complaint
 Design Patent, Fig. 3 (cropped; annotated)	**Accused [MaxFlex SuiteCraft+] Men's Smart Casual Knit Oxford Sneakers**  Dkt. 8, 31 (cropped; annotated)

This comparison shows that in contrast to the claimed design, ***none*** of the accused products includes the claimed (1) a ***rounded*** top layer; (2) ***three*** edged layers (3) that extend ***continuously*** from a heel section to a toe section, (4) where the edged layers are ***vertically*** stacked and (5) ***symmetric***; (6) a ***downwardly sloped*** and ***compressed*** midsection; or (7) a ***compressed*** toe section. Instead, the products include a (1) ***squared*** top layer, (2) ***six*** edged layers (3) that extend from a heel section to a toe section with a ***break*** in the midsection (i.e., are ***discontinuous***), (4) where the edged layers stacked ***at an angle*** and (5) ***asymmetric***, (6) a ***minimally sloped*** and ***uncompressed*** midsection, or (7) ***uncompressed*** toe section. When viewed as a whole—rather than focusing on individual differences—the visual effect is plainly dissimilar.

For example, an ordinary observer's eye is immediately drawn to the stark contrast between the accused products' broken, discontinuous, and uncompressed midsections and the claimed design's smooth, continuous midsection in which the layered edges converge into a tightly compressed toe section. And an ordinary observer would recognize the contrast between the accused products' six asymmetric layers, which are angled such that the midsole widens towards the floor, and the accused product's vertically oriented edged layers—which appear to jut out sharply. Thus, overall, the features of the accused products "combine to create a different visual effect as a whole" than the claimed design, rendering the accused products plainly dissimilar and

mandating dismissal of the infringement claim. *Steven Madden*, 2019 WL 2023766, at *3-4.

V. CONCLUSION

For the foregoing reasons, Top Glory respectfully requests that the Court dismiss with prejudice Cole Haan's infringement claims with respect to the Asserted Patents.

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