IN THE UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

COLE HAAN LLC, Plaintiff, v. TOP GLORY TRADING GROUP INC. AND DP DREAM PAIRS INC., Defendants.	Case No. 2:25-cv-00176-ES-SDA

PLAINTIFF COLE HAAN LLC'S OPPOSITION TO DEFENDANTS' MOTION TO DISMISS

ANSA ASSUNCAO LLP
(A Pennsylvania Limited Liability Partnership)
100 Matawan Road, Suite 410
Matawan, New Jersey 07747
T: (732) 993-9850
F: (732) 993-9851

THOMPSON COBURN LLP
One US Bank Plaza
St. Louis, Missouri 63101
T: (314) 552-6000
F: (314) 552-7000

Attorneys for Plaintiff Cole Haan LLC

TABLE OF CONTENTS

TABLE OF AUTHORITIES iii
LEGAL STANDARD 2
I. Motion to Dismiss Under Rule 12(b)(6) 2
II. Patent Invalidity Generally 3
ARGUMENT 4
I. Defendants Have Not Established That The Utility Patents Are Invalid (Nor Can They) 5
a. Defendants' failure to identify a statutory ground for invalidity merits dismissal. 5
b. Defendants have not met their burden of establishing invalidity under 35 U.S.C. § 101. 6
i. Defendants' attempt to apply § 101 to a portion of the claim, as opposed to a claim in its entirety, is legally erroneous. 8
c. Defendants have not met their burden of establishing invalidity under 35 U.S.C. § 102. 15
i. Defendants mischaracterize the prosecution history. 16
ii. Defendants have not established anticipation of claim 1 of the '511 patent. 21
iii. Defendants have not established anticipation of the remaining claims of the utility patents. 22
II. Cole Haan Plausibly Asserted Infringement of the '969 patent. 22
CONCLUSION 27

TABLE OF AUTHORITIES

Page(s)

Cases

Alice Corp. Pty. Ltd. v. CLS Bank Int'l,
573 U.S. 208 (2014).....7

Amazon.com, Inc. v. Barnesandnoble.com, Inc.,
239 F.3d 1343 (Fed. Cir. 2001) 16, 22

Ashcroft v. Iqbal,
556 U.S. 662 (2009).....2

Barefoot Architect, Inc. v. Bunge,
632 F.3d 822 (3d Cir. 2011) 2

Bell Atl. Corp. v. Twombly,
550 U.S. 544 (2007).....2

Braun Inc. v. Dynamics Corp. of Am.,
975 F.2d 815 (Fed. Cir. 1992) 23

Cellspin Soft, Inc. v. Fitbit, Inc.,
927 F.3d 1306 (Fed. Cir. 2019) 3

Ex Parte Albert Chen,
No. APPEAL 2014-007259, 2016 WL 4255084 (P.T.A.B. Aug. 10, 2016) 10

Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc., 942 F.3d 1119 (Fed. Cir. 2019) 24

Connell v. Sears, Roebuck & Co.,
722 F.2d 1542 (Fed. Cir. 1983) 15

Crocs, Inc. v. ITC,
598 F.3d 1294 (Fed. Cir. 2010) 23, 24, 25, 26

Crocs, Inc. v. Polliwalks, Inc.,
No. IPR2014-00423, 2014 WL 4181937 (P.T.A.B. Aug. 20, 2014)..8, 11, 12, 13

Crocs, Inc. v. Polliwalks, Inc.,
No. IPR2014-00424, 2014 WL 7323628 (P.T.A.B. Dec. 16, 2014) 13

Cuozzo Speed Techs. v. Com. for Intell. Prop.,
579 U.S. 261 (2016).....12

Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) 23, 24, 25, 26

Five Star Gourmet Foods, Inc. v. Ready Pac Foods, Inc.,
No. 5:18-cv-2436 DDP, 2019 WL 1260634 (C.D. Cal. Mar. 18,
2019) 24

Gorham v. White,
81 U.S. 511 (1871).....23

Hester Indus., Inc. v. Stein, Inc.,
142 F.3d 1472 (Fed. Cir. 1998) 19, 20

Hill-Rom Servs., Inc. v. Stryker Corp.,
755 F.3d 1367 (Fed. Cir. 2014) 20

Ex parte Hilton,
148 USPQ 356 (Bd. App. 1965).....19

Intervet America, Inc. v. Kee–Vet Labs., Inc.,
887 F.2d 1050 (Fed. Cir. 1989) 4

Lanard Toys Ltd. v. Dolgencorp LLC,
958 F.3d 1337 (Fed. Cir. 2020) 22

In re Marco Guldenaar Holding B.V.,
911 F.3d 1157 (Fed. Cir. 2018) 8, 14, 15

McRO, Inc. v. Bandai Namco Games Am. Inc.,
837 F.3d 1299 (Fed. Cir. 2016) 7

Mentor Corp. v. Coloplast, Inc.,
998 F.2d 992 (Fed. Cir. 1993) 19, 20

Microsoft Corp. v. I4I Ltd. P'ship,
564 U.S. 91 (2011).....3

Microsoft Corp. v. Multi-Tech Sys., Inc.,
357 F.3d 1340 (Fed. Cir. 2004) 19, 20

NetMoneyIN, Inc. v. VeriSign, Inc.,
545 F.3d 1359 (Fed. Cir. 2008) 15

In re Nordt Dev. Co., LLC,
881 F.3d 1371 (Fed. Cir. 2018) 22

OddzOn Prods. v. Just Toys,
122 F.3d 1396 (Fed. Cir. 1997) 23

Ortho Pharm. Corp. v. Smith,
959 F.2d 936 (Fed. Cir. 1992) 3

Pannu v. Storz Instruments, Inc.,
258 F.3d 1366 (Fed. Cir. 2001) 20

Payless Shoesource, Inc. v. Reebok Int'l, Ltd.,
998 F.2d 985 (Fed. Cir. 1993) 23

Phillips v. Cnty. of Allegheny,
515 F.3d 224 (3d Cir. 2008) 2

PlaSmart, Inc. v. Kappos,
482 F. App'x 568 (Fed. Cir. 2012).....9

Procter & Gamble Co. v. Nabisco Brands, Inc.,
711 F. Supp. 759 (D. Del. 1989).....19, 20

Revell v. Port Auth.,
598 F.3d 128 (3d Cir. 2010) 3

In re Rockefeller Ctr. Properties, Inc. Sec. Litig.,
311 F.3d 198 (3d Cir. 2002) 3

Salem Steel N.A. LLC v. KLT Automative & Tubular Prods. Ltd.,
No. CV 12-3619 (JLL), 2013 WL 12291653 (D.N.J. Dec. 2, 2013) 6

In re Seid,
161 F.2d 229 (C.C.P.A. 1947).....8, 9, 10

Sherwin-Williams Co. v. PPG Indus., Inc.,
No. CV No. 17-1023, 2021 WL 211497 (W.D. Pa. Jan. 21, 2021).....20

simplehuman, LLC v. iTouchless Housewares & Prods., Inc.,
No. 19-CV-02701-HSG, 2019 WL 5963245 (N.D. Cal. Nov. 13, 2019) 24

SRI Int'l v. Matsushita Elec. Corp. of Am.,
775 F.2d 1107 (Fed. Cir. 1985) 16

Telebrands Corp. v. Tinnus Enterprises, LLC,
2017 WL 2130371 (P.T.A.B. May 5, 2017).....12

Therasense, Inc. v. Becton, Dickinson & Co.,
593 F.3d 1325 (Fed. Cir. 2010) 15

Verizon Servs. Corp. v. Vonage Holdings Corp.,
503 F.3d 1295 (Fed. Cir. 2007) 19, 20

Virnetx, Inc. v. Cisco Sys., Inc.,
767 F.3d 1308 (Fed. Cir. 2014) 3

Wahl Clipper Corporation v. Conair Corp.,
No. CV 23-114-JCG, 2023 WL 7298939 (D. Del. Nov. 6, 2023) 26

Statutes

35 U.S.C. § 101 .....*passim*

35 U.S.C. § 102 .....*passim*

35 U.S.C. § 103 .....1, 6, 17, 18

35 U.S.C. § 112 .....1, 17, 18

35 U.S.C. § 251 20

35 U.S.C. § 282 3

Other Authorities

Fed. R. Civ. P. 12(b)(6).....2

Manual of Patent Examining Procedure 19, 24

Defendants Top Glory Trading Group Inc. and DP Dream Pairs Inc.'s ("Defendants") motion to dismiss summarily asserts that the three utility patents asserted by Cole Haan in this case – comprising 64 claims in total – are invalid. Yet neither the notice of motion, nor the memorandum in support, nor the proposed order identify the basis for Defendants' assertion of invalidity. The cases cited by Defendants, which confusingly address an array of issues including subject matter eligibility, anticipation, noninfringement, and reissue applications, also do not provide any indication of the basis for Defendants' motion.

Instead, Defendants appear to assert a novel theory of invalidity where they apply one statutory ground to only a portion of a claim and another statutory ground as to other portions to create a veritable Frankenstein's monster of invalidity. This approach is not grounded in the patent statutes (35 U.S.C. §§ 100 et seq.) and is unsupported by caselaw. The patent statutes, Supreme Court, and Federal Circuit all are clear that each ground of invalidity – subject matter eligibility (§ 101), anticipation (§ 102), obviousness (§ 103), or written description, enablement, and indefiniteness (§ 112) – has its own distinct test that must be applied to a claim in its entirety. And any ground of invalidity must be proved by clear and convincing evidence – a high burden that Defendants have not met here.

Finally, with respect to design patent infringement, Defendants summarily assert that the '969 patent and the Accused Products are plainly dissimilar but

proceed to engage in a detailed analysis of minor differences between the designs. This too is contrary to established precedent, which requires analysis of the design as a whole. Additionally, the assertions regarding the minor differences create questions of fact regarding whether the alleged differences would be perceived by an ordinary observer and, if so, whether the differences are sufficient to render the Accused Products distinct from the '969 patent in the eyes of an ordinary observer. Thus, Defendants' motion should also be denied as to Cole Haan's design patent claim.

LEGAL STANDARD

I. Motion to Dismiss Under Rule 12(b)(6)

When deciding a motion to dismiss a claim pursuant to Fed. R. Civ. P. 12(b)(6), the court limits its review to the face of the complaint. *Barefoot Architect, Inc. v. Bunge*, 632 F.3d 822, 835 (3d Cir. 2011). The court must accept as true all well-pleaded factual allegations and must construe them in the light most favorable to the nonmoving party. *Phillips v. Cnty. of Allegheny*, 515 F.3d 224, 228 (3d Cir. 2008). In other words, a complaint is sufficient if it contains enough factual matter, accepted as true, to "state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009); *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). The Court also accepts as true all reasonable inferences emanating from the allegations and views those facts and inferences in the light most favorable to the

nonmoving party. *See Revell v. Port Auth.*, 598 F.3d 128, 134 (3d Cir. 2010). "The inquiry is not whether plaintiffs will ultimately prevail in a trial on the merits, but whether they should be afforded an opportunity to offer evidence in support of their claims." *In re Rockefeller Ctr. Properties, Inc. Sec. Litig.*, 311 F.3d 198, 215 (3d Cir. 2002).

II. Patent Invalidity Generally

An issued patent is "presumed valid." 35 U.S.C. § 282(a). This presumption "requires an invalidity defense to be proved by clear and convincing evidence." *Microsoft Corp. v. I4I Ltd. P'ship*, 564 U.S. 91, 95 (2011); *see also Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1319 (Fed. Cir. 2019) (citing *I4I* as support for the position that § 282's "presumption reflects the fact that the Patent and Trademark Office has already examined whether the patent satisfies 'the prerequisites for issuance of a patent,' including § 101."); *Virnetx, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1323 (Fed. Cir. 2014) (applying presumption to invalidity defense under § 102).

Invalidity of a patent must be established on a claim-by-claim basis. *See, e.g., Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 942 (Fed. Cir. 1992) (concluding that all grounds of invalidity must be evaluated against individual claims, as required by the plain language of 35 U.S.C. § 282). Thus, while a patentee need only establish infringement by a single claim for a patent to be infringed, to prevail on a motion to

dismiss for invalidity, the patent challenger must establish that all asserted claims are invalid. *See, e.g., Intervet America, Inc. v. Kee–Vet Labs., Inc.,* 887 F.2d 1050, 1055 (Fed. Cir. 1989) ("A patent is infringed if a single claim is infringed.").

ARGUMENT

Defendants ask the Court to dismiss the complaint in its entirety with prejudice, which would require the Court to find every claim of every patent to be either invalid or not infringed. In its motion, Defendants do not make any noninfringement arguments as to the utility patents. Thus, to dismiss Cole Haan's complaint with respect to the three utility patents, the Court would have to find every claim of each of the three patents – 64 claims in total – invalid by clear and convincing evidence.[1] Notably, and as explained below, in the entirety of Defendants' motion, they make invalidity arguments (albeit flawed) as to only one of the 64 claims.[2] Moreover, Defendants' arguments regarding that one claim have

---

[1] In Cole Haan's complaint, Cole Haan identified the infringement of "one or more claims" of each of the '511, '163, and '262 patents. *See* ECF No. 8 at ¶¶ 26, 27. Defendants' motion appears to suggest that Cole Haan is asserting only claims 1 and 21 of the '511 patent, claim 1 of the '163 patent, and claim 1 of the '262 patent. That is incorrect. At this stage of the case, Cole Haan need not identify every asserted claim; that happens at the Infringement Contentions stage of the case. *See* L. Pat. R. 3.1 (requiring disclosure of asserted claims not later than 14 days after the initial Scheduling Conference).

[2] Although Defendants mention claim 21 of the '511 patent, they do not make invalidity arguments as to that claim. Defendants assert that claims 1 and 21 of the

no basis in law. As explained below, Defendants do not even properly identify a statutory basis of invalidity, let alone prove invalidity under any statutory basis.

I. Defendants Have Not Established That The Utility Patents Are Invalid (Nor Can They).

a. Defendants' failure to identify a statutory ground for invalidity merits dismissal.

While the majority of Defendants' Motion ostensibly concerns the validity of Cole Haan's utility patents, remarkably, Defendants' Motion never identifies the statutory grounds on which it seeks to invalidate Cole Haan's patents. Invalidity of a patent claim may be based on one of several independent statutory grounds: 35 U.S.C. §§ 101 (lack of subject matter eligibility), 102 (lack of novelty), 103 (obviousness), 112 (indefiniteness/non-enablement/lack of written description). Each of these independent statutory grounds has distinct tests which Defendants must meet by clear and convincing evidence. Defendants' Motion seems to cobble together different grounds for invalidity, employing a novel hybrid analysis that fails to meet any statutory ground for invalidity. Indeed, rather than apply a specific statutory ground to every limitation of a claim as a whole, as required by Federal

---

'511 patent are "generally representative" of the rest of the claims; Defendants are incorrect. *See* ECF No. 25-1 at 7. Defendants do not explain which claims that claims 1 and 21 are representative of and, more fundamentally, a representative claim analysis is inappropriate for invalidity under §§ 102 and 103. And, as explained below, the claims are not invalid under § 101 because they are not directed to patent ineligible subject matter.

Circuit precedent, Defendants instead seemingly apply § 101 to certain limitations and § 102 to other limitations of the patent claim. This is improper because it necessarily fails to meet the grounds for either statutory basis.

Defendants' lack of a specific legal basis for its invalidity arguments is glaring. Indeed, in the entirety of Defendants' Motion, Defendants refer to: (a) "§ 101" merely a handful of times, and even in so doing, never assert that any claim is invalid under § 101 (*see generally* ECF No. 25-1); (b) "§ 102" and/or "anticipate[]" only a single time each (*id.* at 13 n.9, 16); and (c) "§ 103" and/or "obvious" a handful of times (but only in reference to the prosecution history of the '511 patent and not as a specified ground for invalidity in this case). *Id.* at 5. Defendants' hybrid theory of invalidity is supported by neither statute nor caselaw.

Defendants' failure to set forth a proper statutory basis for its invalidity arguments is a fatal flaw to its Motion that by itself warrants denial. *See Salem Steel N.A. LLC v. KLT Automative & Tubular Prods. Ltd.*, No. CV 12-3619 (JLL), 2013 WL 12291653, at *1 (D.N.J. Dec. 2, 2013) ("It is not the Court's responsibility to determine [what provision] is applicable to Defendant[s'] arguments and to then apply the corresponding legal standard.").

b. Defendants have not met their burden of establishing invalidity under 35 U.S.C. § 101.

Defendants have failed to prove invalidity for lack of patent eligible subject matter under 35 U.S.C. § 101. Patent eligible subject matter includes "any new and

useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. The Supreme Court has excluded from protection laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014). Under *Alice*, the Supreme Court mandated a two-part subject matter eligibility test under § 101 (the "*Alice* test"). 573 U.S. at 217-18. The *Alice* test requires, at step one, that the Court determine whether the patent is directed to a law of nature, natural phenomena, or abstract idea. *Id.* In applying the *Alice* test, the patent claims must be considered "in their entirety." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016). If the claims are not directed to an abstract idea, "the inquiry ends." *Id.* If, however, the patent is directed to an abstract idea, then the Court proceeds to step two, and analyzes the claims "as a whole" to determine whether elements of the invention either individually or as an ordered combination, demonstrate an "inventive concept" that transforms the abstract idea into a patentable invention. *Alice*, 573 U.S. at 217-18; *McRO*, 837 F.3d at 1312.

Here, it is readily apparent that the patent claims are directed to patent eligible subject matter and are not invalid under § 101. Each claim is directed either to a shoe or a method of making a shoe. *See generally* ECF Nos. 8-1, 8-2, and 8-3. A shoe is an article of manufacture and is certainly not a law of nature, natural phenomena, or abstract idea. Likewise, methods of manufacturing an article of footwear or an upper

for an article of footwear are processes, and are also not laws of nature, natural phenomena, or abstract ideas. No claim is directed to an abstract idea, and Defendants do not contend otherwise. Thus, Defendants cannot meet their burden of establishing any of the claims, let alone all of the claims, are invalid under § 101.

i. Defendants' attempt to apply § 101 to a portion of the claim, as opposed to a claim in its entirety, is legally erroneous.

Defendants never engaged in a § 101 analysis as to the entirety of any single patent claim. Rather, Defendants apparently cite § 101 for a different, incorrect proposition. That is, Defendants contend § 101 can be applied to merely a portion of a claim, and not, as required by the Supreme Court in *Alice*, the claim in its entirety. *See* ECF No. 25-1 at 13-15. In support of this incorrect theory, Defendants cite three cases: (1) *Application of Seid*, 161 F.2d 229, 231 (C.C.P.A. 1947); (2) *Crocs, Inc. v. Polliwalks, Inc.*, No. IPR2014-00423, 2014 WL 4181937, at *6 (P.T.A.B. Aug. 20, 2014); and (3) *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1161-62 (Fed. Cir. 2018). None of these cases supports Defendants' claim; nor do they supplant the Supreme Court's decision in *Alice* or its progeny. In fact, two of the three cases never even mention § 101.

1. *Application of Seid* is irrelevant as to a § 101 analysis and does not stand for the proposition defendants cite.

Decided in 1947 and predating the codification of the 1952 Patent Act, *Application of Seid* involved a patent applicant's appeal from the Board of Appeals

to the United States Court of Customs and Patent Appeals (CCPA) (the precursors to the Patent Trial and Appeal Board (PTAB) and the Federal Circuit, respectively). 161 F.2d at 229. The claims pertained to an advertising display device, and the examiner rejected the claims as obvious in view of several prior art references. *Id.* On appeal, "[t]he issue presented [was] whether the proposed combination of references [was] an obvious one or one involving invention." *Id.* at 231. Thus, the CCPA's analysis was focused on obviousness and not subject matter eligibility. *Id.* With respect to obviousness, the applicant argued that certain limitations of the claims rendered the claim patentable over the prior art, including limitations regarding the particular shape and arrangement of the upper part of the body of the display device. The CCPA disagreed, finding all limitations were collectively disclosed by the prior art references. *Id.* The CCPA therefore affirmed the Board's (and examiner's) obviousness rejection. *Id.*

Application of Seid has not been substantively addressed or examined by the Federal Circuit, which has cited the case exactly once for a different proposition. *See PlaSmart, Inc. v. Kappos*, 482 F. App'x 568, 573 (Fed. Cir. 2012) (citing *Application of Seid* concerning the interpretation of prior art). Thus, while *Application of Seid* continues to be cited in administrative proceedings, it is unclear whether, or to what extent, it survives enactment of the 1952 Act. Further, to the extent *Application of Seid* concerned patent eligible subject matter under § 101 – as Defendants apparently

contend – it was implicitly overruled by the Supreme Court in *Alice*, if not by some earlier case.

Moreover, *Application of Seid* does not stand for the broad proposition proposed by Defendants because the basis for the decision was not on patent eligibility but instead on obviousness. This is supported not only by *Application of Seid* itself, but also by subsequent PTAB decisions. For example, the PTAB in *Ex Parte Albert Chen* considered an examiner's arguments citing *Application of Seid* regarding the alleged unpatentability of ornamentality and found the citation inapplicable, stating:

> The Examiner's citation is not on point. In *Seid*, the allegedly novel features [were] shown in the prior art. *In re Seid*, 161 F.2d at 231 ("[t]hat concept, however, is old in the patent to Kirchner et al., wherein the cardboard figure representing the upper half of the human body conceals the bottle neck and is supported thereon, while the body of the bottle represents the lower half of the human display figure"). Here, the Examiner provides no example of any item having "a plurality of evenly-spaced rounded bumps protruding from said one edge" as evidence that the claimed shape was known in the art. Appeal Br. 28.

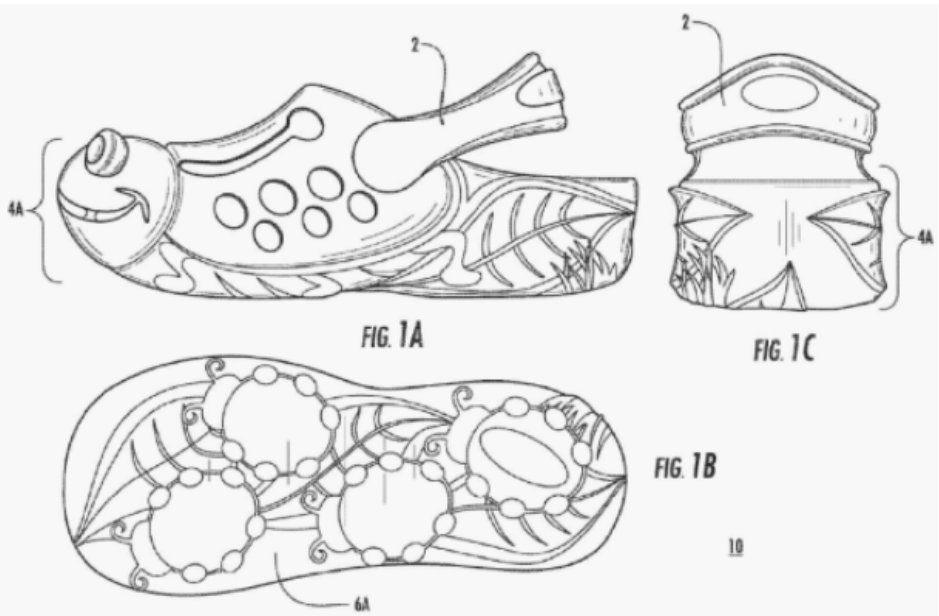
No. APPEAL 2014-007259, 2016 WL 4255084, at *2 (P.T.A.B. Aug. 10, 2016). In other words, *Application of Seid* held that the prior art disclosed each and every limitation of the appealed claims and the claims were therefore obvious; it did not grant a blanket license to ignore claim limitations. Further, because *Application of Seid's* basis was obviousness and each and every limitation was disclosed by the prior art of record, any discussion regarding ornamentality or any suggested

prohibition on ornamental limitations is mere *dicta* and not binding precedent.

Thus, *Application of Seid* simply does not support Defendants' arguments and does not permit Defendants to ignore limitations.

2. *Crocs, Inc.* is likewise irrelevant as to § 101.

In addition to not being binding on this Court, *Crocs, Inc.* relies on *Application of Seid* for its holding, and is therefore equally irrelevant for the reasons noted above. *See Crocs, Inc.*, 2014 WL 4181937, at *6 (citing *Application of Seid* in support of its conclusion regarding ornamentality). The decision is also factually distinguishable. In *Crocs, Inc.*, the PTAB elected to institute *inter partes* review of a patent relating to a one-piece molded shoe with an imprinted three-dimensional animal or character, such as that shown below:



Id. at *2. Claim 1, which the Board found illustrative of the claimed subject matter, recited:

> 1. A shoe that comprises:
>
> a. a sole that includes a bottom surface; and
>
> b. an upper having sides extending from the sole and a toe portion, wherein the sides and the toe portion comprise an outer surface that comprises a series of projections and recesses that form a three-dimensional animal or character figure with one or more features;
>
> wherein the sole, and the upper which includes the sides, toe portion and the three-dimensional animal or character figure having the one or more features are a single piece substantially formed from a molded material.

Id. The Board construed several terms, including "a series of projections and recesses," but declined to construe "a three-dimensional animal or character figure" on the basis of ornamentation and cited *Application of Seid* in support of its decision to do so. *Id.* at *4-6.

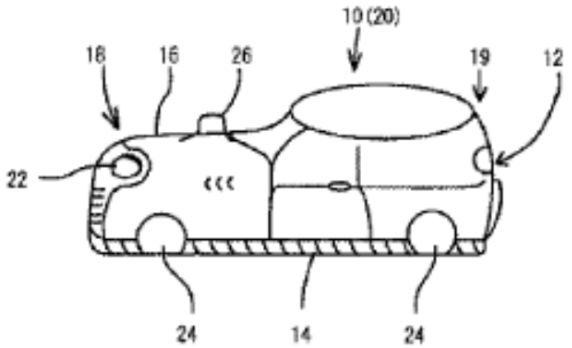
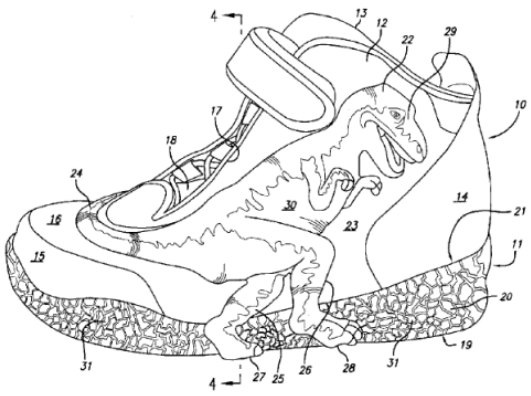
Crocs, Inc. does not support Defendants' argument for several additional reasons. First, it concerned a PTAB's decision regarding whether to institute an *inter partes* review.[3] At that stage of the proceedings, the PTAB did not have the

---

[3] *Inter partes* review may be instituted (which is separate from a final written decision) where the patent challenger raises "a substantial new question of patentability" and shows a reasonable likelihood that the challenger would prevail. *See Cuozzo Speed Techs. v. Com. for Intell. Prop.*, 579 U.S. 261, 268 (2016). This is a lower standard than the clear and convincing standard that must be proven to invalidate a patent even in an IPR. *See Telebrands Corp. v. Tinnus Enterprises, LLC*, 2017 WL 2130371, at *2 (P.T.A.B. May 5, 2017) (indicating PTAB employs a "more likely than not" standard which is lower than both the district court's substantial question of validity standard and the clear and convincing standard). Institution decisions are not reviewable. *Cuozzo Speed Techs.*, 579 U.S. at 283.

benefit of the patent owner's expert declaration and was making an interim decision. Accordingly, the PTAB was free to revisit the issue following development of the factual record and may well have reached a different conclusion in its final written decision. No final written decision was reached, however, as the parties settled and the matter was terminated. *See Crocs, Inc. v. Polliwalks, Inc.*, No. IPR2014-00424, 2014 WL 7323628, at *1 (P.T.A.B. Dec. 16, 2014).

Second, similar to *Application of Seid*, the ultimate grounds for the decision rested on obviousness rather than subject matter eligibility. For example, with respect to the limitation requiring a three-dimensional animal or character figure on a shoe upper, the prior art certainly included such disclosure. In the petition seeking institution of *inter partes* review, the petitioner cited prior art disclosing such a feature, including Japanese Publication No. 2006-43114 ("Ishizawa") and U.S. Pat. No. 6,957,504 ("Morris"), shown below:

	
Ishizawa	**Morris**

Crocs, Inc., 2014 WL 4181937, at *9, *13. The Morris prior art reference disclosed

a three-dimensional animal (e.g., a dinosaur) and Ishizawa disclosed a shoe body molded to be a character, animal, or vehicle form. In other words, the prior art before the Board disclosed all of the limitations of claim 1. Thus, the Board's decision to not construe one of the limitations was unnecessary for the obviousness inquiry and, much like the extraneous language in *Application of Seid*, constitutes *dicta*. And because the parties settled the case, that initial determination of an ALJ panel would not even be binding on the owner of the patent at issue in that case. It is even less relevant in the present case. Accordingly, *Crocs, Inc.* also does not address or support Defendants' erroneous assertion that claim limitations can be ignored in an invalidity analysis.

3. *In re Marco Guldenaar Holding B.V.* is highly distinguishable.

Finally, *In re Marco Guldenaar Holding B.V.* – the only case Defendants cite in support of their § 101 argument that actually discusses § 101 – is highly distinguishable. The case involved an appeal of the PTAB's decision in an *ex parte* appeal of a patent application. *In re Marco Guldenaar Holding B.V.*, 911 F.3d at 1158. The appealed claims were directed to a method of playing a dice game that involved dice having certain markings, and the appellant identified the primary novelty as being the markings, or lack thereof, on the dice. *Id.* at 1159. The Federal Circuit, applying the *Alice/Mayo* test, analyzed the claim in its entirety and affirmed the examiner's rejection. *Id.* With respect to step one, the Federal Circuit found that

a method of conducting a wagering game was an abstract idea. *Id.* at 1160. With respect to step two, the applicant argued that the markings on the dice were not conventional and amounted to significantly more than the abstract idea. *Id.* at 1161. The Federal Circuit disagreed, holding that nothing in the claims contained an inventive concept sufficient to transform the claimed abstract idea into a patent eligible invention. *Id.* at 1160-61. The Federal Circuit did not rely on *Application of Seid* or ornamentality, but instead on the traditional § 101 concepts underpinning the printed matter doctrine, which is inapplicable here. Thus, *In re Marco Guldenaar Holding B.V.* is simply irrelevant to this case.

c. Defendants have not met their burden of establishing invalidity under 35 U.S.C. § 102.

To anticipate under 35 U.S.C. § 102, a single prior-art reference "must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *NetMoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). "The requirement that the prior art elements themselves be arranged as in the claim means that claims cannot be treated . . . as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 1332 (Fed. Cir. 2010) (internal quotation marks omitted). The claims define the exclusive rights

conferred by a patent, and the validity and infringement of those rights must be evaluated on a claim-by-claim basis. S*ee, e.g., Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc).

Defendants' anticipation arguments fail for a myriad of reasons. Defendants have failed to identify any prior art reference that discloses every limitation of even one claim in the three utility patents. With respect to claim 1 of the '511 patent, Defendants incorrectly assert that a limitation should be ignored. As discussed above, *Application of Seid* does not stand for the proposition that claim limitations can be ignored. Further, ignoring claim limitations is contrary to a myriad of Federal Circuit cases addressing invalidity. Defendants also falsely assert that Cole Haan has admitted that all remaining limitations are anticipated by Dua. To be clear, Cole Haan made no such admission. As discussed below, the prosecution history does not reflect an admission or disavowal by Cole Haan. Accordingly, Defendants' arguments regarding claim 1 fail. Defendants cannot establish invalidity by clear and convincing evidence and their arguments should be rejected in their entirety.

i. Defendants mischaracterize the prosecution history.

Defendants mischaracterize the prosecution history of the '511 patent, and then rely upon those mischaracterizations to assert that Cole Haan somehow "admitted during prosecution that all claim limitations entitled to patentable weight

(i.e., non-aesthetic limitations) are unpatentable over Dua." ECF No. 25-1 at 12-13. Cole Haan has made no such admission. Defendants' arguments are materially incorrect because they are predicated on an inaccurate analysis of the prosecution history. Further, as set forth in greater detail below, Defendants' legal arguments are also unsupported by the cited caselaw.

During prosecution of the application that became the '511 patent, the claims were not amended, as Defendants assert, to overcome a prior art rejection. Rather, the only claim amendment made was to overcome an indefiniteness rejection. During prosecution, the examiner issued a non-final office action dated October 5, 2018. *See generally* ECF No. 25-4. The examiner rejected claim 1 based on 35 U.S.C. § 112(b) as allegedly indefinite because "[t]he phrase 'wingtip design' has no clear and definite meaning as to the specific structure being claimed." *Id.* The examiner also rejected claims 1-7 and 16-22 under 35 U.S.C. § 103 as allegedly obvious over U.S. Pat. No. 7,347,011 ("Dua") in view of U.S. Pat. No. 2,312,078 ("Crannell") and also rejected claims 8-15, 23, and 24 under § 103 as allegedly obvious over Dua in view of Crannell and further in view of U.S. Pat. No. 6,910,288 ("Dua II"). *Id.*

Cole Haan submitted a response to the October 5, 2018 office action on April 3, 2019. *See generally* ECF No. 25-5. Solely to overcome a rejection of claim 1 based on indefiniteness, claim 1 was cancelled and claim 2 was amended to

"incorporate subject matter of claim 1" and place it in independent form. *Id.* at 10. In other words, claim 2 was merely re-written to be in independent form; the scope of claim 2 was not altered. The purpose of the amendment was not to distinguish over the examiner's proposed combination of Dua and Crannell, but instead as a means to overcome the § 112 rejection via amendment in a manner that would be least disruptive to the claims as a whole. As compared to claim 1, claim 2 contained additional, structural limitations regarding the wingtip pattern that were sufficient to render the term definite, which is evidenced by the fact that the examiner had not rejected claim 2 under § 112. *See* ECF No. 25-4. As such, the amendment was made to overcome the § 112 rejection made by the examiner and not, as Defendants incorrectly assert, to overcome the § 103 rejection. Thus, no amendment was made for purposes of overcoming the prior art.

With respect to the rejection of claim 2 based on the combination of Dua and Crannell, Cole Haan explained that the references, whether considered individually or in combination, did not disclose or suggest all limitations of claim 2 for multiple, independent reasons. ECF No. 25-5 at 10-16. This included arguments that: (1) Dua/Crannell failed to disclose (a) seamlessly knitted regions which (b) formed the claimed wingtip pattern; (2) a person of ordinary skill would not combine Dua and Crannell; (3) the examiner's proposed combination was based on impermissible hindsight; (4) the examiner's alleged rationale of aesthetic design choice was not a

sufficient rationale to combine the references; and (5) the examiner's other alleged rationale of optimization was not a sufficient rationale to combine the references. *Id.* In its argument rebutting the examiner's allegations regarding aesthetic design choice, Cole Haan made clear that the application was not a case "in which 'matters relating to ornamentation . . . have no mechanical function," but instead was more similar to cases where the shape was important because it results in a product distinct from the reference product. *See id.* at 15 (citing MPEP § 2144.04; *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965)). In response to Cole Haan's arguments, the examiner allowed the application on April 23, 2019. Because the claims were not amended to overcome prior art, and because Cole Haan did not admit that any claim was unpatentable over Dua, Defendants' asserted legal theory fails. Moreover, independent claims 18, 21, and 22 of the '511 patent were not amended at all during prosecution of the application.

Defendants cite the following cases allegedly in support of the position that Cole Haan's amendments during prosecution constitute an admission that Dua anticipates nearly every limitation of claim 1 of the '511 patent: *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998), *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340 (Fed. Cir. 2004), *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295 (Fed. Cir. 2007), *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993), *Procter & Gamble Co. v. Nabisco Brands, Inc.*, 711 F. Supp.

759 (D. Del. 1989), and *Sherwin-Williams Co. v. PPG Indus., Inc.*, No. CV No. 17-1023, 2021 WL 211497 (W.D. Pa. Jan. 21, 2021). *See* ECF No. 25-1 at 11. But none of the cases are relevant here. *Hester* and *Mentor* both dealt with the recapture rule for reissue applications. *Hester*, 142 F.3d at 1474 ("At issue in this case are two reissue patents"); *Mentor*, 998 F.2d at 994 (addressing broadening reissue). When a patent is reissued, the original patent is surrendered and the applicant can seek reissue of an amended application. 35 U.S.C. § 251. To prevent applicants from using the process to improperly expand their patent rights, the rule prevents the applicant from regaining matter surrendered during the original prosecution process. *See Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370 (Fed. Cir. 2001). No reissue application is at issue here, so the recapture rule does not apply.

Similarly, *Microsoft*, *Verizon*, *Procter & Gamble*, and *Sherwin-Williams* all address instances where the applicant disavowed claim scope. *See Microsoft*, 357 F.3d at 1349-50; *Verizon*, 503 F.3d at 1306 (finding "clear disavowal has occurred"); *Procter & Gamble*, 711 F. Supp. at 770; *Sherwin-Williams*, 2021 WL 211497, at *4. "Disavowal requires that the specification or prosecution history make clear that the invention does not include a particular feature, . . . or is clearly limited to a particular form of the invention. *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372 (Fed. Cir. 2014) (cleaned up). As set forth above, the prosecution history does not support disavowal, so the cases are also irrelevant.

ii. Defendants have not established anticipation of claim 1 of the ’511 patent.

Defendants assert that “the wingtip/broguing/line designs and stich (sic) patterns” of claim 1 constitute “ornamental and aesthetic features not entitled to patentable weight.” ECF No. 25-1 at 10. Although that is not the test for the reasons discussed above, Defendants’ attempted characterization blatantly ignores structural limitations. Defendants seem to assert that all of the following limitations of claim 1 should be ignored:

> the upper toe region, the upper lateral and medial ball regions, and the upper lateral and medial metatarsal regions collectively being knitted with the wingtip pattern during the knitting process, 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.

ECF No. 8-1 at claim 1. Such limitations are in no way purely ornamental, as they require multiple regions to be seamlessly knitted, and to be collectively knitted with lines of broguing to form a wingtip pattern. *Id.* These limitations are structural

limitations which cannot be ignored. *See In re Nordt Dev. Co., LLC*, 881 F.3d 1371, 1375 (Fed. Cir. 2018) ("[T]he claim term at issue here is structural and should have been afforded weight when assessing patentability."). Defendants can only establish anticipation if they can point to a prior art reference disclosing each and every limitation of claim 1, including the limitation above. Defendants have not done so, and their motion therefore fails.

iii. Defendants have not established anticipation of the remaining claims of the utility patents.

While Defendants summarily assert that all 64 claims of the utility patents are invalid, they do not analyze or even mention the limitations of the other independent claims nor the dependent claims as required by Federal Circuit precedent. *See Amazon.com*, 239 F.3d at 1351 (validity analyses must be performed on a claim-by-claim basis). Because Defendants have failed to establish that each and every limitation of each claim of the utility patents is present in a single prior art reference, Defendants' motion should be denied.

II. Cole Haan Plausibly Asserted Infringement of the '969 patent.

Determining whether a design patent has been infringed is a two-part test; first, the court construes the claim to determine its meaning and scope, and second, the fact finder compares the properly construed claim to the accused design. *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337, 1341 (Fed. Cir. 2020).

Once construed, the standard for determining design patent infringement is

whether "in the eye of an ordinary observer, giving such attention as a purchaser usually gives . . . the resemblance [between two designs] is such as to deceive such an observer, inducing him to purchase one supposing it to be the other." *Gorham v. White*, 81 U.S. 511, 528 (1871). The standard articulated in *Gorham* has come to be "referred to as the 'ordinary observer' test." *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc). "The ordinary observer test applies to the patented design in its entirety, as it is claimed." *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1302 (Fed. Cir. 2010) (citing *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992)).

"[M]inor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement." *Id.* (quoting *Payless Shoesource, Inc. v. Reebok Int'l, Ltd.*, 998 F.2d 985, 991 (Fed. Cir. 1993)). "The comparison step of the infringement analysis requires the fact-finder to determine whether the patented design as a whole is substantially similar in appearance to the accused design. The patented and accused designs do not have to be identical in order for design patent infringement to be found." *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).

Courts generally need not conduct an elaborate claim construction analysis for design patents because the court should construe design patents as they are shown in the patent drawings. "[A] design [patent] is better represented by an illustration

'than it could be by any description and a description would probably not be intelligible without the illustration.'" *Egyptian Goddess, Inc.*, 543 F.3d at 679; *Crocs*, 598 F.3d at 1302 ("This case shows the dangers of reliance on a detailed verbal claim construction. The claim construction focused on particular features of the [Asserted] design and led the administrative judge and the Commission away from consideration of the design as a whole."); *see also* Manual of Patent Examining Procedure (MPEP) § 1503.01 (9th ed. 2015) ("[A]s a rule the illustration in the drawing is its own best description.").

Design patent infringement is a question of fact. *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119, 1129 (Fed. Cir. 2019). Because of this, "dismissal is generally inappropriate unless 'the claimed design and accused product are so plainly dissimilar that it is implausible that an ordinary observer would confuse them.'" *simplehuman, LLC v. iTouchless Housewares & Prods., Inc.*, No. 19-CV-02701-HSG, 2019 WL 5963245, at *2 (N.D. Cal. Nov. 13, 2019) (quoting *Five Star Gourmet Foods, Inc. v. Ready Pac Foods, Inc.*, No. 5:18-cv-2436 DDP (KKx), 2019 WL 1260634, at *3 (C.D. Cal. Mar. 18, 2019)).

Despite asserting the '969 patent is plainly dissimilar from the Accused Products, Defendants do not look to the design as a whole but instead focus on minor details to attempt to rebut Cole Haan's infringement claim. *See* ECF No. 25-1 at 18-19. Such an analysis contravenes established Federal Circuit precedent and should

be rejected. In *Egyptian Goddess*, the Federal Circuit cautioned against verbal claim constructions, stating "the preferable course ordinarily will be for a district court not to attempt to 'construe' a design patent claim by providing a detailed verbal description of the claimed design." 543 F.3d at 679. The Federal Circuit reiterated this admonition in *Crocs*, reversing the International Trade Commission's (ITC's) finding of non-infringement because the ITC focused too closely on minor differences and ignored the design as a whole. The Federal Circuit, upon analyzing the design as a whole, concluded that, despite minor differences between the patent design and the Accused Products, the similarity supported a finding of infringement. 598 F.3d at 1303-04. The Federal Circuit explained that:

> Without a view to the design as a whole, the Commission used minor differences between the patented design and the accused products to prevent a finding of infringement. In other words, the concentration on small differences in isolation distracted from the overall impression of the claimed ornamental features.

Defendants urge the Court to make the same mistake as the ITC did in *Crocs* – to focus on minor differences between the '969 patent and the Accused Products, while ignoring overall similarity. ECF No. 25-1 at 18. For example Defendants allege that the '969 patent requires:

> 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.

Id. But this is precisely the type of verbal construction that the Federal Circuit has repeatedly warned against as it emphasizes minor differences that do not distract from the overall impression of patented design over similarity between the '969 patent as a whole and the Accused Products. *Egyptian Goddess, Inc.*, 543 F.3d at 679; *Crocs*, 598 F.3d at 1302. Once the products are compared side-by-side as a whole, it is apparent that the products are substantially similar. *See* ECF No. 8 at Count IV (showing side-by-side comparisons of the '969 patent and the Accused Products).

Additionally, Defendants' reliance on alleged differences between the '969 patent and the Accused Products creates a factual question regarding whether the differences are sufficient to render the Accused Products distinct from the '969 patent. *See Wahl Clipper Corporation v. Conair Corp.*, No. CV 23-114-JCG, 2023 WL 7298939, at *3 (D. Del. Nov. 6, 2023), *report and recommendation adopted sub nom. Wahl Clipper Corp. v. Conair Corp. & Conair LLC*, No. 123CV00114JCGLDH, 2024 WL 474437 (D. Del. Jan. 16, 2024) (denying motion to dismiss because the accused product was not plainly dissimilar from the asserted patent, and therefore "[w]hether the differences in the symmetry of the handle and/or the curvature of the top edge are sufficient to render them distinct in the eyes of an ordinary observer presents an issue of fact . . . .").

Accordingly, Defendants' motion should be denied and Cole Haan's claim based on the '969 patent should be permitted to proceed.

CONCLUSION

Defendants' Motion never identifies the statutory grounds on which it seeks to invalidate Cole Haan's patents. This failure alone warrants denial of the Motion as to each of the three utility patents. The Motion as to the utility patents should also be denied because Defendants did not establish invalidity under any statutory ground, including under § 101 or § 102. Similarly, because Cole Haan plausibly pled infringement of the '969 patent by Defendants, and because Defendants failed to establish plain dissimilarity between the '969 patent and the Accused Products, the Motion should be denied as to the '969 patent. For these reasons, and as set forth above, Cole Haan respectfully requests that the Court deny Defendants' Motion in its entirety.

Dated: April 7, 2025

Respectfully submitted,

/s/ Steven F. Gooby

Steven F. Gooby
ANSA ASSUNCAO, LLP
100 Matawan Road, Suite 410
Matawan, New Jersey 07747
Tel: (732) 993-9850
Fax: (732) 993-9851
steven.gooby@ansalaw.com

THOMPSON COBURN LLP
Alan H. Norman (*pro hac vice*)
Matthew A. Braunel (*pro hac vice*)

Sartouk H. Moussavi (*pro hac vice*)
Alex D. Weidner (*pro hac vice*)
One US Bank Plaza
St. Louis, MO 63101
Tel: (314) 552-6000
Fax: (314) 552-7000
anorman@thompsoncoburn.com
mbraunel@thompsoncoburn.com
smoussavi@thompsoncoburn.com
aweidner@thompsoncoburn.com

Attorneys for Plaintiff Cole Haan LLC

CERTIFICATE OF SERVICE

I hereby certify that on April 7, 2025, I caused the foregoing to be electronically filed with the Clerk of the Court using CM/ECF, which will send notification of such filing to all registered participants.

/s/ Steven F. Gooby