UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOP GLORY TRADING GROUP INC. and

DP DREAM PAIRS INC.,

Petitioners,

v.

COLE HAAN LLC,

Patent Owner.

Case IPR2025-01395

Patent No. D768,969

DECLARATION OF GRANT DELGATTY IN SUPPORT OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. D768,969

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. BACKGROUND AND QUALIFICATIONS 4

III. LEGAL STANDARDS 9

A. MY UNDERSTANDING OF DESIGN PATENT SCOPE 9

B. MY UNDERSTANDING OF CLAIM CONSTRUCTION 10

C. MY UNDERSTANDING OF ANTICIPATION 11

D. MY UNDERSTANDING OF OBVIOUSNESS 11

IV. BACKGROUND OF the TECHNOLOGY 14

A. MIDSOLE DESIGN ..... **Error! Bookmark not defined.**

B. SECURING AN UPPER TO THE SOLE 14

V. THE '969 PATENT 18

A. OVERVIEW OF THE '969 PATENT 18

B. PROSECUTION HISTORY OF THE '969 PATENT 25

VI. DESIGNER OF ORDINARY SKILL IN THE ART 26

VII. ORDINARY OBSERVER 27

VIII. CLAIM CONSTRUCTION 28

IX. GROUNDS OF UNPATENTABILITY 34

A. SUMMARY OF OPINIONS 34

B. SPECIFIC GROUNDS FOR CHALLENGE 35

1. GROUND 1: The '969 patent is anticipated by C11947 37

a. Publication of C11947 37

b. Overview of C11947 40

c. Claim Chart 44

d. Overall Design 53

2. GROUND 2: The '969 Patent is Obvious Over C11947 55

3. GROUND 3: The '969 Patent is Anticipated By C12652 58

a. Publication of C12652 58

b. Overview of C12652 59

c. Claim Chart....62
4. GROUND 4: The ’969 Patent is Obvious Over C12652....71
5. GROUND 5: The ’969 Patent is Anticipated By Nike....74
a. Publication of Nike....74
b. Overview of Nike....75
c. Claim Chart....78
d. Overall Design....84
6. GROUND 6: The ’969 Patent is Obvious Over Nike....85
7. GROUNDS 7 & 8: The ’969 Patent is Obvious Over C11947 and Nike (Ground 7), and Over C12652 and Nike (Ground 8)....87
8. GROUND 9: The ’969 Patent is Obvious Over Skechers in view of Nike....94
a. Overview of Skechers....94
b. Analysis....97
X. SECONDARY CONSIDERATIONS....102
XI. CONCLUSION....103

I. INTRODUCTION

1. My name is Grant Delgatty and I am currently Associate Professor and Chair of Product Innovation at the University of Southern California Iovine and Young Academy. I have been retained on behalf of Top Glory Trading Group Inc., and DP Dream Pairs Inc. ("Petitioners" or "Top Glory"), to provide my opinions on certain issues related to U.S. Patent No. D768,969 ("the '969 patent") in connection with the above-captioned *inter partes* review ("IPR") proceeding. In particular, I have been asked to provide my insights, analysis, and opinions regarding whether the claimed design of the '969 patent is anticipated by and/or obvious over the prior art references identified below.

2. I understand that the '969 patent is titled "Shoe Midsole"; names Jack Boys as the inventor; and is currently assigned to Cole Haan LLC according to the USPTO. I have considered the '969 patent. I understand that the '969 patent has been provided as Ex. 1001.

3. I understand that the prosecution history of the '969 patent has been provided as Ex. 1002. I have considered this prosecution history, and I will refer to it as "the '969 Prosecution History."

4. I understand that the '969 patent was filed on October 13, 2015. For the purposes of rendering my opinions in this declaration, I have been

asked to consider this filing date as the earliest priority date for the claimed design.

5. My analysis and conclusions set forth in this declaration are based on my educational background and experiences in the field (*see* Section II). I am qualified to opine concerning what a designer of ordinary skill in the art would have known and understood during that time. Before October 13, 2015, my level of skill in the art was at least that of a designer of ordinary skill in the art. In relevant part, my analysis and conclusions herein are from the perspective of a designer of ordinary skill in the art as of October 13, 2015.

6. I am also qualified to opine concerning what an ordinary observer would have known and understood during that time. Before October 13, 2015, I had significant experience designing footwear for ordinary observers and purchasers of footwear, and I understand how these ordinary observers and purchasers viewed ornamental designs of footwear. In relevant part, my analysis and conclusions herein are from the perspective of an ordinary observer as of October 13, 2015.

7. As part of my independent analysis for this declaration, I have considered the following: the background knowledge/technologies that were commonly known to a designer of ordinary skill in the art and ordinary observers during the time before the earliest claimed priority date for the '969

patent; my own knowledge and experiences gained from my work experience in the field of the '969 patent and related disciplines; and my experience in working with others involved in this field and related disciplines.

8. I have considered the following non-exhaustive list of references in preparing my declaration.

9. I have been instructed to assume that each of these references qualifies as prior art as of the respective priority dates of the respective grounds in which they are used as discussed below.

- **Cole Haan C11947 ("C11947")**, published on February 20, 2014 and archived on March 3, 2014. I understand that a copy of this reference has been designated as Exhibit 1005 with evidence of its public accessibility at Exhibits 1004 and 1006-1009. Throughout my declaration, references to C11947 are to Exhibit 1005.

- **Cole Haan C12652 ("C12652")**, archived on June 13, 2014. I understand that a copy of this reference has been designated as Exhibit 1011, with evidence of its public accessibility at Exhibit 1010. Throughout my declaration, references to C12652 are to Exhibit 1011.

- **EUIPO Design Registration No. 002413161-0028 ("Nike") assigned** to Nike Innovate C.V., titled "Shoes," filed on February 26, 2014 and published on March 3, 2010. I understand that a copy of this reference has been designated as Exhibit 1012, with evidence of its public accessibility at Exhibits 1013-1015. Throughout my declaration, references to Nike are to Exhibit 1012.

- **Skechers Embolden Oxfords ("Skechers")**, published on July 10, 2013 and archived on July 14, 2013. I understand that a copy of this reference has been designated as Exhibit 1017, with evidence of its public accessibility at Exhibit 1016. Throughout my declaration, references to Skechers are to Exhibit 1017.

10. I understand that there is a pending district court litigation between Petitioners and Patent Owner ("New Jersey Case") involving the '969 patent.

11. I am being compensated by Top Glory at my standard hourly consulting rate of $400 per hour for my time on this matter. My compensation is not dependent on the outcome of this proceeding or any other proceeding between the parties.

12. In forming my opinions, I relied on the documents cited in this declaration and the documents identified in the attached Appendix B. These documents comprise patents, file/prosecution histories, printed publications, and other related documents. As discussed below, each document is a type that experts in my field would have reasonably relied upon when forming their opinions. Further, experts in my field would have had access to each document either through the applicable patent offices and/or well-known libraries, conferences, publications in the field, or the Internet. My opinions are also based upon my personal and professional experience.

II. BACKGROUND AND QUALIFICATIONS

13. A summary of my background and qualifications as a technical expert for this case is provided below. A complete listing of my qualifications and background are detailed in my curriculum vitae ("CV"), which is attached

hereto as Appendix A. The ’969 patent is in the field of footwear designs. As demonstrated by my CV and the below summary of my relevant experience, I would be considered by others to be an expert in the field of footwear design.

14. I have designed and developed shoes for more than 25 years and have extensive experience developing functional and aesthetic aspects of footwear, including midsole designs.

15. Early in my career, as an athletic footwear designer, I had the opportunity to be mentored and work directly under the tutelage of the legendary Bill Petersen, who worked as one of the first industrial designers at Nike and its prior name of Blue Ribbon Sports. Bill was originally given the task of developing the methodology by which Frank Rudy’s patented airbag technology could be commercialized into a viable midsole construction application for mass production. It was under Bill’s guidance where I first learned to apply principles in shoe construction methodologies of performance footwear and how to develop functional midsole technologies into an aesthetically pleasing, commercially viable design.

16. From 1996 to 1999, I worked as the only employee at E-West Designs, an athletic footwear design and development consulting firm started by Bill Petersen and ex-Nike Olympic trial runner, Mark Feig. At E-West Designs, I worked on many commissioned projects within the footwear

industry, including being credited for designing the PUMA CELL 5-0 basketball shoe. In addition, I worked on the Avia cantilever system, the first line of Shaquille O'Neal's basketball shoe company, DUNK.NET, an internal harness technology for Vans step-in snowboard boots, and many other shoe-related innovations.

17. In 1999, I became the in-house Director of Design for the DVS Shoe Company, which was a startup performance skate shoe company focused on developing cutting edge technologies to address the performance needs of professional skateboarders that could be incorporated into aesthetic designs that appealed to the skateboarding community. While at DVS, I developed many new performance technologies, including the Shock pad, Dual Lacing Technology, and the DIM (Drop In Midsole) system, which utilized an innovative over-lasted upper technology to allow for an insole containing an integrated combination airbag/impact pad cushioning technology to address heel bruising that the company's professional team riders were experiencing.

18. One footwear technology I invented was an innovative way to mechanically attach a shoe upper to a shoe sole without the use of adhesives or permanent stitching. *See, e.g.*, U.S. Patent. No. 8,307,570. We utilized this technology for the shoe brand I founded called Urshuz, whereby a series of small elastic loops were attached to the bottom perimeter edge of a shoe upper.

These loops were stretchable and designed to intersect with channels molded into the sidewall of the sole unit, and lock into undercut channels found in the outsole tread pattern. Having the upper affixed to the sole unit in this manner, allowed the uppers and the soles to be detachably attached, which provided multiple benefits to the user, such as being able to mix and match different custom colors and styles, replacing soles when they wore out, and allowing for the shoes to be 100% recyclable due to their ability to be separated into 'like' materials.

19. Throughout my entire career as a footwear designer, I have either been directly responsible for, or have overseen designers whom I managed, the aesthetic ornamental features of all aspects of shoes, including upper designs, midsole designs, and outsole designs. These designs have been attributed to many great successes in the industry and have accounted for well over 1,000 SKUs and millions of pairs sold.

20. Based on my experience and education, I believe that I am qualified to opine as to the knowledge and level of skill of a designer of ordinary skill in the art ("DOSITA") at the time of the alleged invention of the '969 patent (which I further describe below) and what such person(s) would have understood at that time, and the state of the art during that time. Based on my above-described experience in the field of footwear design, I believe

that I am qualified to be an expert with respect to the above-described area of the ’969 patent.

21. In my experience, an important component of shoe design is developing aesthetically pleasing products that will find broad acceptance with consumers, and commercial success for those who bring the shoes to market. Shoes with great and innovative functionalities can fail because they fail to appeal to consumer’s aesthetic preferences. Thus, the design process for shoes always entails aesthetic considerations.

22. To accomplish this foundational aspect of the design process, shoe designers such as myself are trained as keen observers of the consumers likely to purchase the shoes. Such observations may take place through formal and informal methodologies of consumer research that provide insight into what an ordinary customer wants to purchase, what drives those purchasing decisions, and the experiences involved in different purchasing scenarios. We use this information to inform how we can adapt our own designs to achieve consumer appeal.

23. Based on my experience with designing shoes for ordinary consumers, including developing an understanding of the knowledge and preferences of such ordinary consumers, I believe that I am qualified to opine as to the knowledge of an ordinary observer at the time of the alleged invention

of the ’969 patent (which I further describe below) and what such person(s) would have understood at that time, and the state of the art during that time. Based on my above-described experience in the field of footwear design, I believe that I am qualified to be an expert with respect to the above-described area of the ’969 patent.

III. LEGAL STANDARDS

24. I am not an attorney and offer no legal opinions, but in the course of my work, I have had experience studying and analyzing patents and patent claims from the perspective of an ordinary observer and a designer of ordinary skill in the art. I base my analysis on the legal guidelines provided to me as outlined below.

A. MY UNDERSTANDING OF DESIGN PATENT SCOPE

25. I understand that the sole claim of a design patent is set forth in the patent drawings and that the patent specification provides a description of the claimed invention. I understand that design patents have only one claim, which must refer to the ornamental design for the article, specifying the type of article, which is shown or described in the drawings of the patent.

26. For design patents, I understand that the scope of the patent is informed by the solid lines depicted in the figures of the patent in conjunction with the figure descriptions, and that stippled or dashed lines shown in the

drawings illustrate the environment of the design and do not form part of the claim. I understand that features of a claimed design that serve a functional purpose may be construed as narrowing the scope of the overall design claim in view of the functionality of those elements but may not be entirely disregarded.

B. MY UNDERSTANDING OF CLAIM CONSTRUCTION

27. I understand that in an *inter partes* review, a design claim should be construed in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art in view of the solid lines shown in the patent's figures, the description of those figures, and the prosecution history pertaining to the patent.

28. I understand that, while the preferable course for design patent claim construction is not to provide a detailed verbal description, using verbal or written guidance is beneficial in certain circumstances. I understand that using verbal or written guidance to describe a claimed design is often helpful to point out various features of the claimed design as they relate to the prior art. I understand that a design patent, unlike a utility patent, limits protection to the ornamental design of an article of manufacture. It is my experience that most articles and designs sold into the stream of commerce have some function or purpose. Where a design patent contains functional and ornamental

elements, I understand that the scope of the claimed design is limited to the ornamental aspects alone and does not extend to functional elements. I further understand that, where a design contains both functional and non-functional (i.e., ornamental) elements, the scope of the design claim must be construed to identify the non-functional aspects of the claimed design. I understand that using verbal or written guidance to describe a claimed design is helpful to outline the distinction between ornamental and functional elements of the claimed design.

C. MY UNDERSTANDING OF ANTICIPATION

29. I understand that a patent claim is invalid as "anticipated" if the claimed design and the prior art are substantially the same such that an ordinary observer, giving such attention as a purchaser usually gives, would be deceived into purchasing one design supposing it to be the other.

D. MY UNDERSTANDING OF OBVIOUSNESS

30. I understand that a patent is invalid as obvious if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious, before the effective date of the claimed invention, to a person of ordinary skill in the art. I further understand that the obviousness analysis assesses (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the

claimed invention and the prior art; and (4) secondary considerations nonobviousness (if present). For design patents, I understand that the ultimate obviousness inquiry asks whether the claimed design would have been obvious to a designer of ordinary skill in the art who designs articles of the type involved in the design patent at issue. I understand that the ordinary observer is not the same as the designer of ordinary skill in the art. For this Declaration, I consider the perspectives of both the ordinary observer (as described in Section VII, and paragraphs 6, 7, and 23) and designer of ordinary skill in the art (as described in Section VI, and paragraphs 5, 7, 20), in conducting my obviousness analysis. I state where I apply my analysis based on the ordinary observer, and where I apply my analysis based on the designer of ordinary skill in the art.

31. I have been informed that there are two criteria for determining whether prior art is analogous and thus can be considered prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the patentee's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the patentee is involved. I have also been informed that the field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a

given field. I have also been informed that a reference is reasonably pertinent if, even though it may be in a different field from that of the patentee's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to a patentee's attention in considering their problem.

32. I have also been advised that an analysis of whether a claimed invention would have been obvious should be considered in light of the scope and content of the prior art, the differences (if any) between the prior art and the claimed invention, and the level of ordinary skill in the pertinent art involved. I understand as well that a prior art reference should be viewed as a whole.

33. I have also been advised that in considering whether a claimed invention would have been obvious over a combination of prior art references, I may assess whether there are apparent reasons to combine known elements in the prior art in the manner claimed in view of interrelated teachings of multiple prior art references, the effects of demands known to the design community or present in the marketplace, and/or the background knowledge possessed by a person of ordinary skill in the art.

34. I further understand that, in making a determination as to whether the claimed invention would have been obvious to a person of ordinary skill,

the Board may consider certain objective factors if they are present, such as: commercial success of products practicing the claimed invention; long-felt but unsolved need; teaching away; unexpected results; copying; and praise by others in the field. These factors are generally referred to as "secondary considerations" or "objective indicia" of nonobviousness. I understand, however, that for such objective evidence to be relevant to the obviousness of a claim, there must be a causal relationship (called a "nexus") between the claim and the evidence, and that this nexus must be based on a novel element of the claim rather than something in the prior art. I also understand that even when they are present, secondary considerations may be unable to overcome primary evidence of obviousness (such as motivation to combine with predictable results) that is sufficiently strong.

IV. BACKGROUND OF THE TECHNOLOGY

A. MIDSOLE DESIGN

35. A midsole of a shoe is typically the part of a shoe found between the shoe upper and the outsole, and provides cushioning to the foot. The midsole can be produced using a variety of different materials and manufacturing methods such as injection molded EVA (IMEVA), compression molded EVA (CMEVA), molded Polyurethane (PU), die-cut EVA, etc. The midsole can be exposed and viewed from the side of a shoe, or

in some cases, it can be hidden from view and embedded within a rubber cup-sole wrapping up from the outsole around the perimeter of the sole unit.

36. In most cases with athletic shoes, there is a heel to toe drop that occurs, where the heel portion of the midsole is typically higher than the toe portion. The reason for this is to create a more comfortable positioning of the foot, as well as increased performance. The heel to toe drop is determined by the last in which the shoe upper was formed over and can vary in height and angle depending on what the manufacturer is wanting to achieve. For instance, a running shoe may have a greater heel to toe drop allowing there to be more cushioning in the heel area for heel strike, whereas a court shoe, such as basketball or tennis, may have less heel to toe drop, creating a shoe that has more ankle support on a flat surface.

37. In addition to the heel to toe drop, a shoe last may also have more ‘toe spring’, which translates to a midsole having a higher degree of curvature rising up in the toe area of the shoe. This also addresses different levels of performance an athletic shoe may have, where a shoe having more toe spring may allow the wearer to have more of a ‘rocking’ motion when using the shoe. As an example, a running shoe may have more toe spring, whereas a court shoe may have less toe spring for the same stability reasons as described above.

B. SECURING AN UPPER TO THE SOLE

38. When manufacturing shoes, there are a limited number of ways the shoe upper is secured to the shoe sole. For example, two common ways to secure a shoe upper to the shoe sole are to use either "slip lasting" or "Strobel lasting." Strobel lasting, also known as California lasting, is a common shoe construction for casual and athletic shoes. Once the upper is complete, a bottom material is added to "close" the bottom of the upper where the upper and the bottom material are bonded together along the perimeter of the bottom material.

39. Slip lasting is commonly used to make flexible and lightweight shoes for running or racing. With slip lasting, the upper materials are patterned to extend underfoot and meet in the middle of the shoe's last bottom, along which the upper sides are stitched together.

40. Welt construction is a high-quality method for attaching the sole of a shoe to the upper using a strip of material called a welt, which is then stitched to the upper and the sole of the shoe, forming a flange around the perimeter of the sole unit. The welt can be attached to either the top perimeter edge of an outsole or the midsole, and the shoe upper is then sewn to the welt.

41. In some cases, a shoe may be designed to have the appearance of a welt construction for aesthetic purposes, but may not, in fact, be an actual

welt construction. In this case, the welt may be a detail that is molded into the midsole or outsole and colored separately to have the appearance of being a different material.

42. Typically, shoe uppers are formed with a closed bottom, although it is possible for the upper to have an open bottom that is attached to the sole. When constructed with a closed bottom, whether by slip or Strobel lasting, an adhesive can be used across the entire base/bottom of sole region, thereby providing additional structural integrity between the upper and the sole. Also, stitching can be used around the perimeter lower edge of the upper for additionally securing the upper to the sole and providing different aesthetics.

43. Slip lasting or Strobel lasting were manufacturing methodologies created to increase the flexibility of an athletic shoe, however, traditional attachment systems which are less flexible, such as board lasting and Strobel stitching cup soles to an upper, were also common processes at the time of the invention in creating athletic shoes which characteristics didn't require as high of a level of flexibility.

V. THE ’969 PATENT

A. OVERVIEW OF THE ’969 PATENT

44. The ’969 patent is directed to a design for a midsole. I understand that the ‘969 patent was filed on October 13, 2015 as U.S. Pat. App. 29/542,318 (“the D’318-App”), and issued on October 18, 2016.

45. The ’969 patent has a single claim for the ornamental design for a shoe midsole. The ’969 patent provides 7 figures showing different views of its claimed design:

Figure	View
1	perspective view of a shoe midsole
2	lateral side elevational view
3	medial side elevational view
4	bottom plan view
5	top plan view
6	front elevational view
7	rear elevational view

Ex.1001, 1.

46. The ’969 patent states that “[t]he broken lines are for the purpose of illustrating environmental structure; the broken lines form no part of the claimed design.” Ex.1001, 1. The solid lines of Figures 1-7 are shown below alongside the corresponding patent figure.

The ’969 Patent Figure Solid and dashed (unclaimed) lines	The ’969 Patent Figure Solid lines only

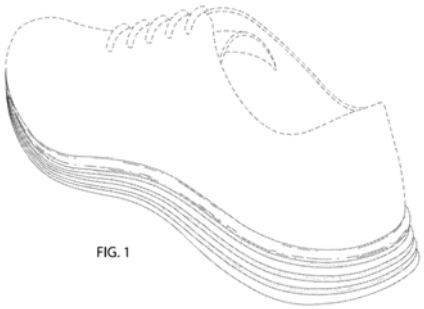


FIG. 1

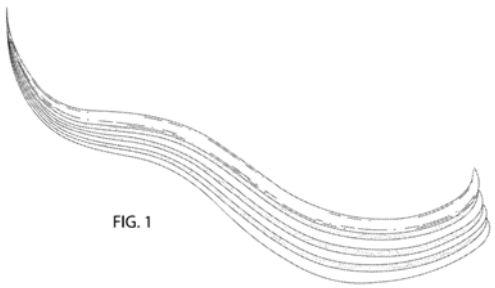


FIG. 1

FIG. 2

FIG. 2

FIG. 3

FIG. 3

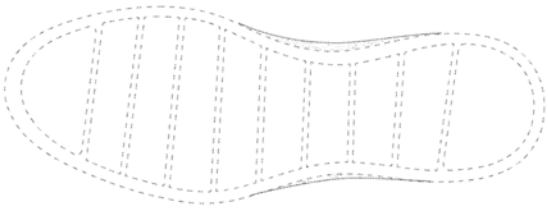


FIG. 4

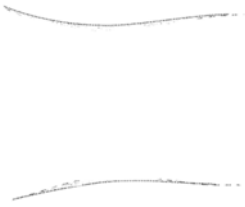


FIG. 4

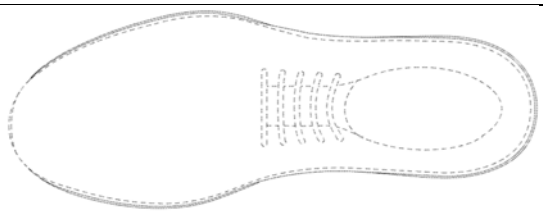


FIG. 5

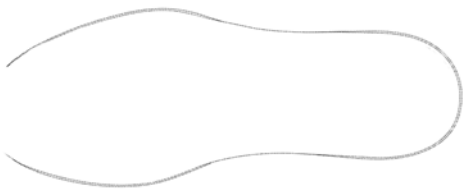
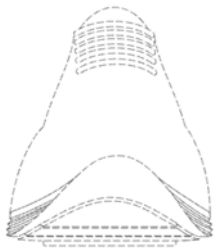
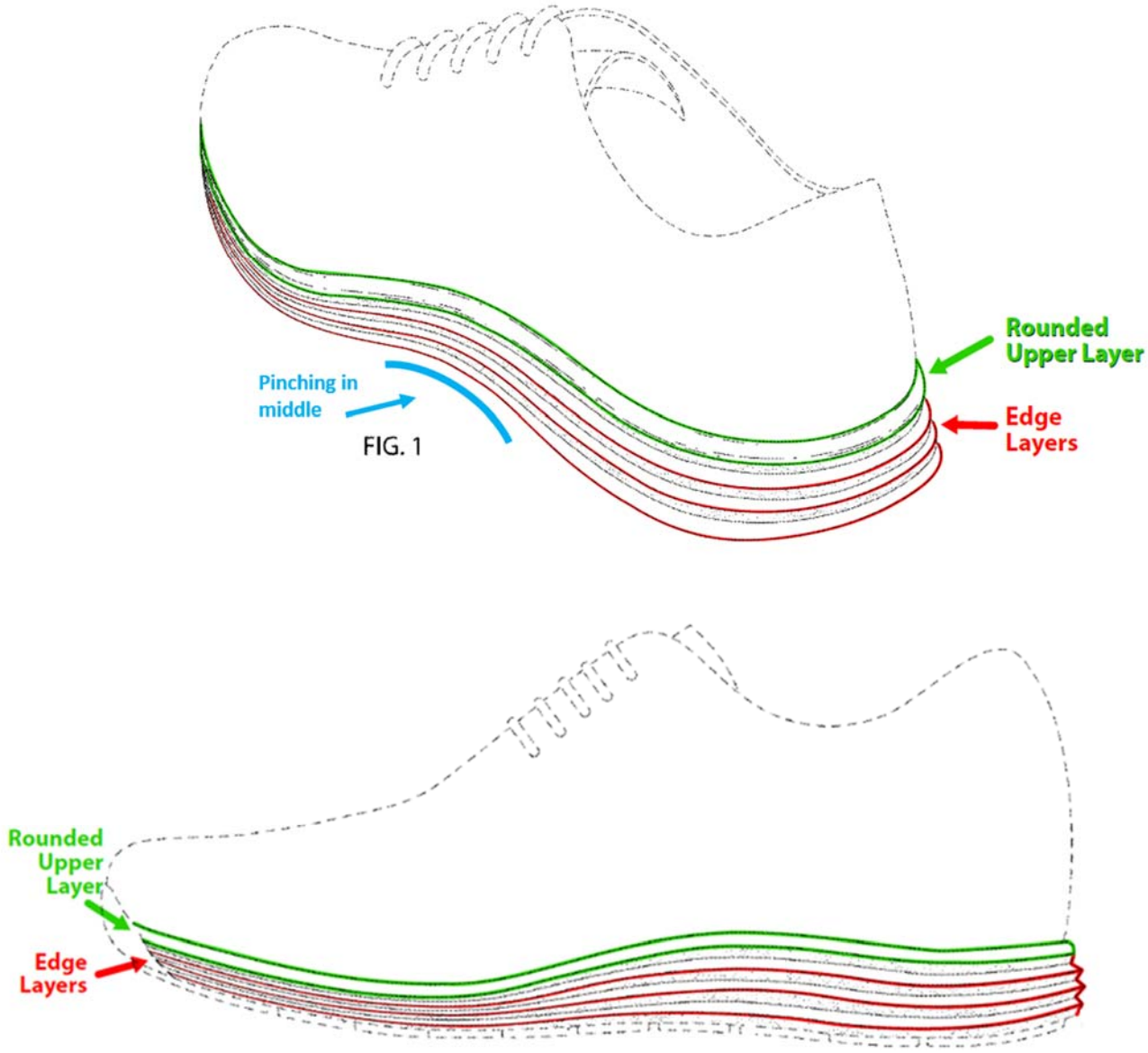


FIG. 5

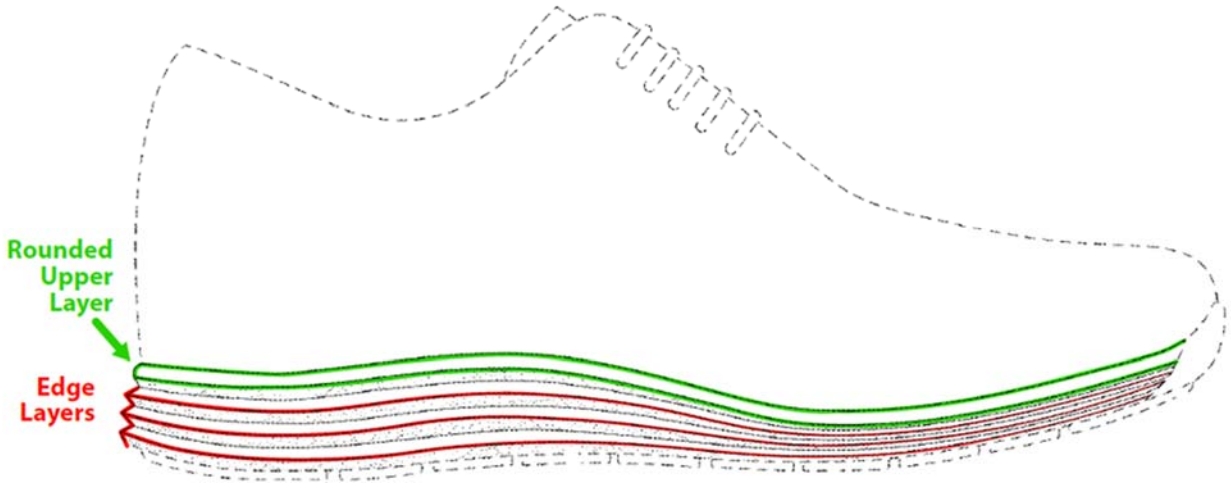
<table>
<tr>
<td> 
FIG. 6</td>
<td>
FIG. 6</td>
</tr>
<tr>
<td>
FIG. 7</td>
<td>
FIG. 7</td>
</tr>
</table>

47. The claimed portions of the seven figures of the ’969 patent together give an overall visual impression of a shoe midsole with ***three ridged edge layers*** resting atop a ***rounded upper layer***, both of which extend continuously from a ***generally linear heel section***, ***compressing and downwardly sloping in a mid section***, and ***compressed upwardly sloping towards the toe section***. Figs. 1 and 2. From the top plan view (or planar view) the midsole follows the shape of a natural foot arch, slightly ***pinching*** in the middle. Figs. 4-5.



The ’969 patent, Fig. 2.

48. Figure 3 is a medial side elevation view of the ’969 patent.



The ’969 patent, Fig. 3

49. Figure 6 is the front view, depicting ***three ridged edge layers*** under a ***rounded upper layer*** extending to a disclaimed toe portion.

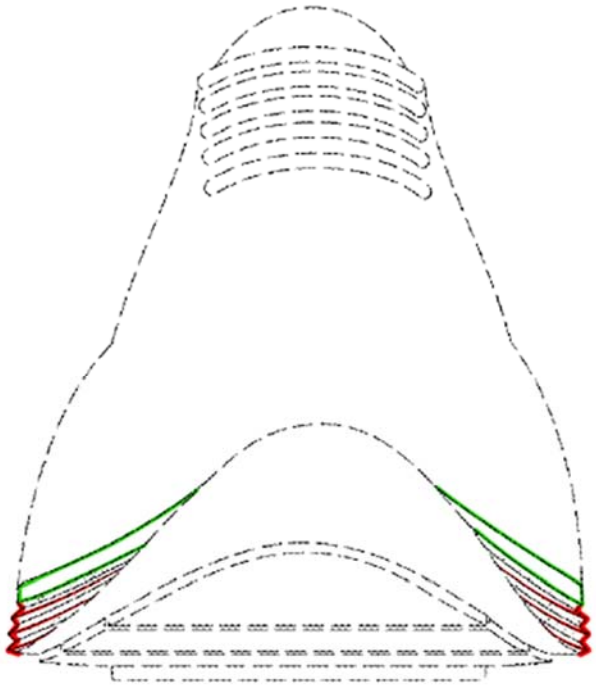


FIG. 6

Figure 7 depicts the rear view with the ***rounded upper layer*** and ***ridged edge layers***.

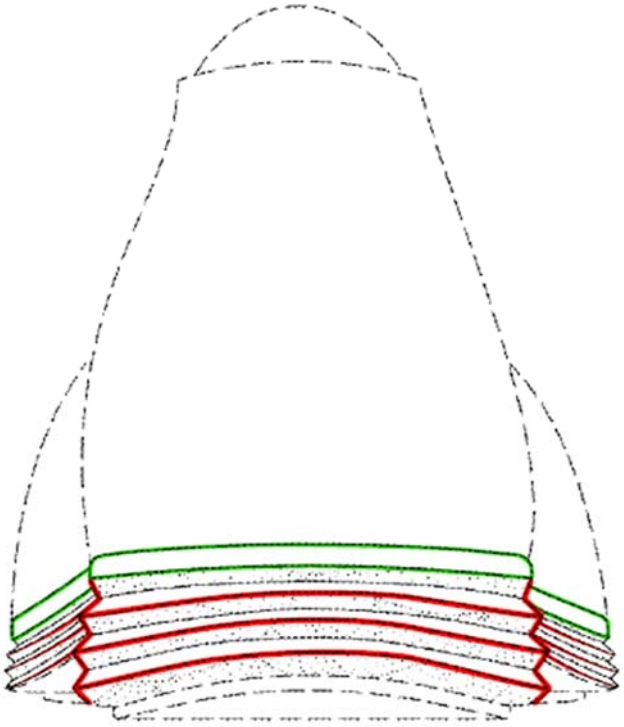


FIG. 7

’969 patent, Figs. 4-7

50. Figures 4-5 show a bottom and top of the claimed shoe, respectively. These figures illustrate that the shape of the ***ridged edge layers*** of the midsole slightly ***pinches*** in the middle, mimicking the natural shape of a foot.

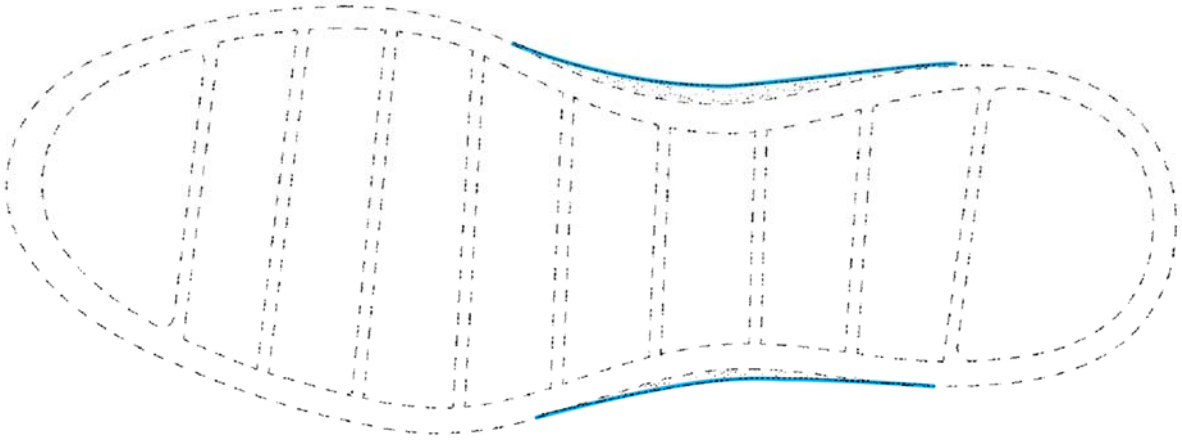


FIG. 4

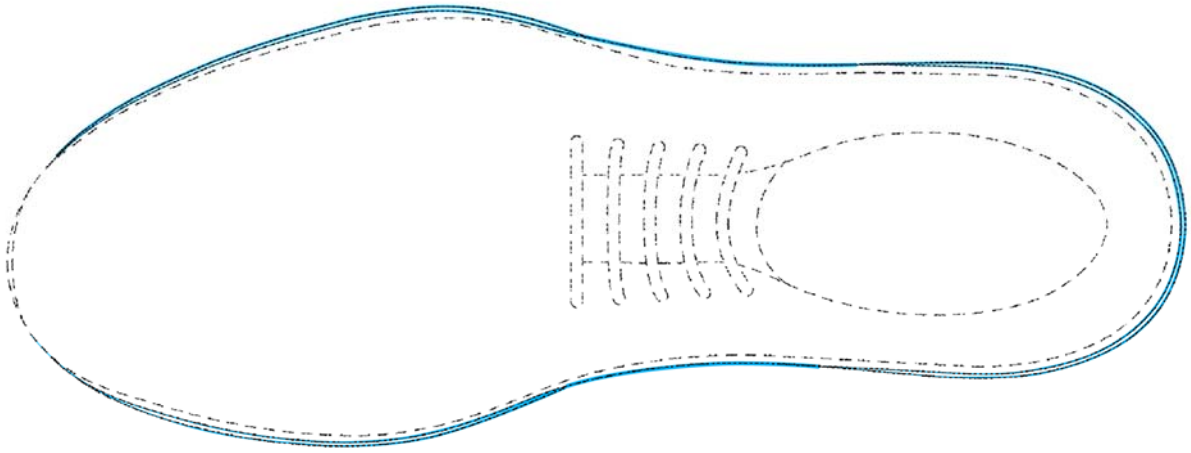


FIG. 5

The ’969 patent, Figs. 1-7

51. The ’969 patent’s figures, considered as a whole, create a wave-like design in a midsole. The wavey midsole follows the elevations and compressions of an anatomical foot, producing a flowy-looking, fluid-like midsole.

52. The midsole design shown in the ’969 patent was known prior to the ’969 patent. For example, C11947 discloses a design of a shoe midsole with all of the features of the ’969 patent.

(00:19:275)

B. PROSECUTION HISTORY OF THE ’969 PATENT

53. In formulating my opinions, I considered the contents of the prosecution history of the ’969 patent.

54. During prosecution of the D’318-App, which issued as the ’969 patent, the Examiner rejected claim 1 under 35 U.S.C. §§112(a)-(b), finding the claim indefinite and not enabled. Ex. 1002 at 48-54. The Examiner specifically found that original Figures 2-3 and 5-6 inconsistently depict which portions of the design are claimed in the toe area: the side-views depicted the toe area as claimed with a downward slope at the peak, but the front profile demonstrated the toe area was not claimed with a peak in the center. Ex. 1002 at 48-54. The Examiner additionally found that while Figures 2-3 and 6-7

demonstrate the ridged edges extend beyond the upper perimeter of the sole, this was not reflected in Figure 5. Ex. 1002 at 48-54.

55. In response, Applicant submitted replacement sheets for Figures 2-3 and 5-7, where Figures 2-3 were amended to clarify that "neither the toe region of the sole nor the bottom boundary line adjacent the stippled shaded region of the lowermost flute are claimed" and Figure 5 was amended to show "the outermost edges…extending beyond the perimeter of the upper." Ex. 1002 at 68-74. The claim was subsequently allowed on 7/21/2016. Ex. 1002 at 97-98.

VI. DESIGNER OF ORDINARY SKILL IN THE ART

56. In rendering the opinions set forth in this declaration, I was asked to consider the patent claim and the prior art through the eyes a designer of ordinary skill in the art at the time of the alleged invention. I understand that the factors considered in determining the ordinary level of skill in a field of art include the level of education and experience of persons working in the field; the types of problems encountered in the field, the teachings of the prior art, and the sophistication of the technology at the time of the alleged invention. I understand that a designer of ordinary skill in the art is not a specific real individual, but rather is a hypothetical individual having the qualities reflected by the factors above. I understand that a designer of ordinary skill in the art

would also have knowledge from the teachings of the prior art, including the art cited below.

57. Upon consideration of these factors, and based on my knowledge and experience in the field and my review of the ’969 patent and file/prosecution history, I believe that a designer having ordinary skill in the art in this matter would have had at least a bachelor’s degree in industrial design, or the equivalent thereof, or approximately two years of professional experience in designing shoes. Additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.

58. Based on my experiences, I have at least the skills of a designer having ordinary skill in the art as well as a good understanding of the capabilities of a designer having ordinary skill in the art. To be clear, all of my opinions in this declaration are from the perspective of one of ordinary skill in the art as I have defined it here during the relevant timeframe.

VII. ORDINARY OBSERVER

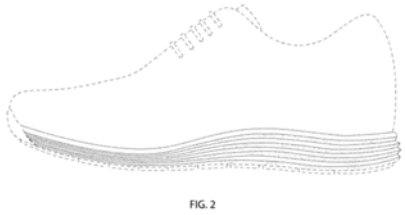
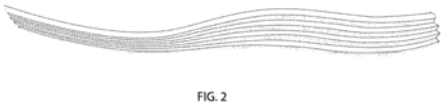
59. I understand that the ordinary observer is a consumer, or purchaser, considering a product in the ordinary course of business. For the ’969 patent, the ordinary observer is a retail consumer considering the purchase of shoes, because that is the person who compares the claimed design to other

shoe designs, makes the decision to purchase a shoe comprising the embodying design, and wears the shoe embodying the design. Although there are other potential observers of a shoe during the lifetime of a shoe (e.g., wholesalers, retailers, fashion critics), all are consequent to and flow from the retail shoe purchase and the actions of those other potential observers depend exclusively on the perspective of and decisions made by the retail shoe purchaser who wears the shoe.

VIII. CLAIM CONSTRUCTION

60. I understand that the claim in a design patent is defined by the drawings— and only the solid lines, as opposed to the broken or dashed lines. I understand that the claim of a design patent is construed to encompass the overall ornamental visual impression as a whole, as illustrated by the figures.

61. The sole claim of the ’969 patent reads: “[t]he ornamental design for a shoe midsole, as shown and described.” The description makes clear that “broken lines are for the purpose of illustrating environmental structure; the broken lines form no part of the claimed design.” ’969 patent, Description. Accordingly, I consider the sole claim of the ’969 patent as directed to the ornamental aspects of the design for a shoe midsole depicted in the figures in solid lines. Representative Figure 2 is shown without the dashed (unclaimed) lines, below:

Original Fig. 2	Fig. 2 with dashed lines (unclaimed) removed
	

62. The solid lines show that the ’969 patent design encompasses the following key features:

63. **Ridge Layers**: ***three vertically stacked, ridged-edged layers*** that extend continuously from a heel section till the toe section and beyond the lower perimeter of the shoe’s sole (Figs. 1-3,6-7);

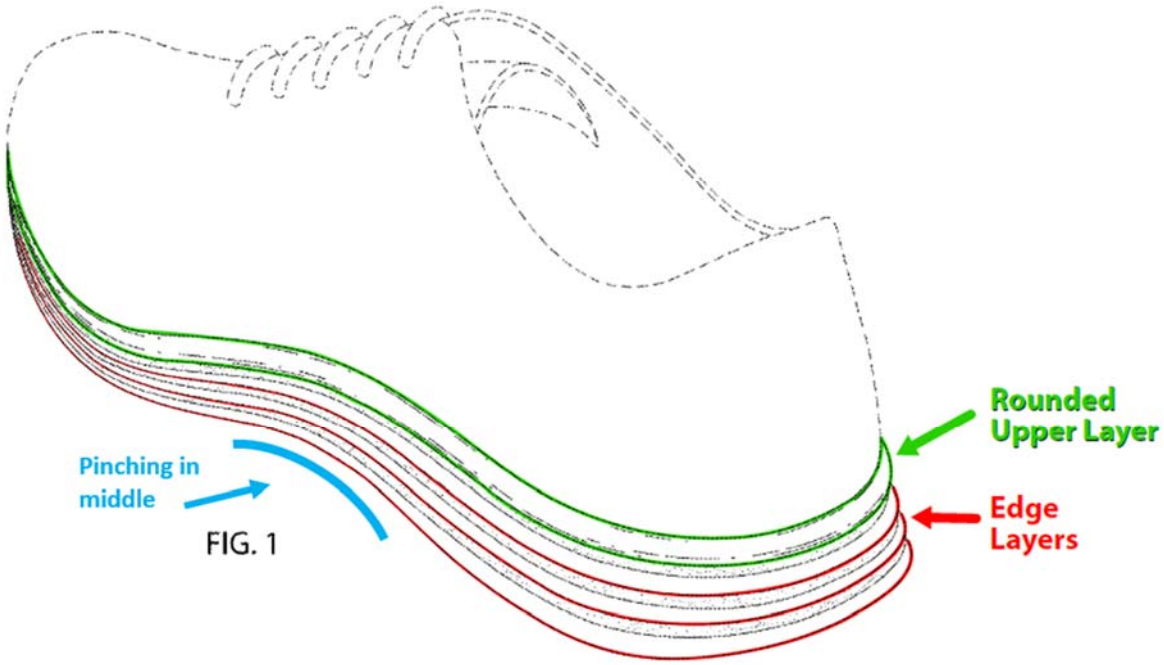
64. (2) **Compressions**: a ***generally linear heel section***, a ***downwardly sloped midsection in which the ridged edges are compressed*** (i.e., decrease in height), and ***an upwardly slope towards the toe section*** with compressed ***ridged edges*** (Figs. 1-3);

65. (3) **Rounded Upper Layer:** a ***rounded upper layer*** above the ridged edge layers (Figs. 2-3, 7); and

66. **Pinched Mid-Section:** a slightly ***pinched*** mid-section, and wider foot area, following the typical shape of a human foot (Figs. 4-5).

67. The claimed portions of the seven figures of the ’969 patent together give an overall visual impression of a soft, wave-like midsole design.

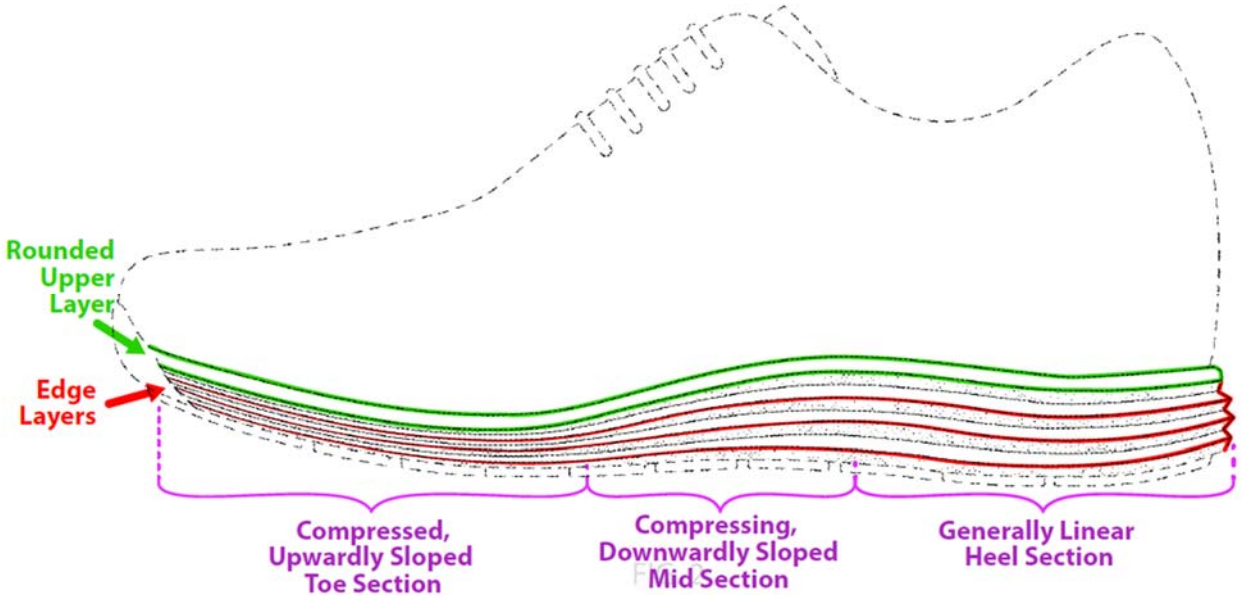
Specifically, the visual impression of a wavy midsole is a product of the ***rounded upper layer*** and ***three ridged edge layers*** that compress and slope as they run laterally along the side of the shoe's midsole, where the vertically stacked ***ridged edge layers*** slightly ***pinch*** in the mid section towards the arch of the foot, following the natural shape of a foot. Figure 1 illustrates the perspective view of the 969 patent. *See also* Fig. 5.



'969 patent, Fig. 1

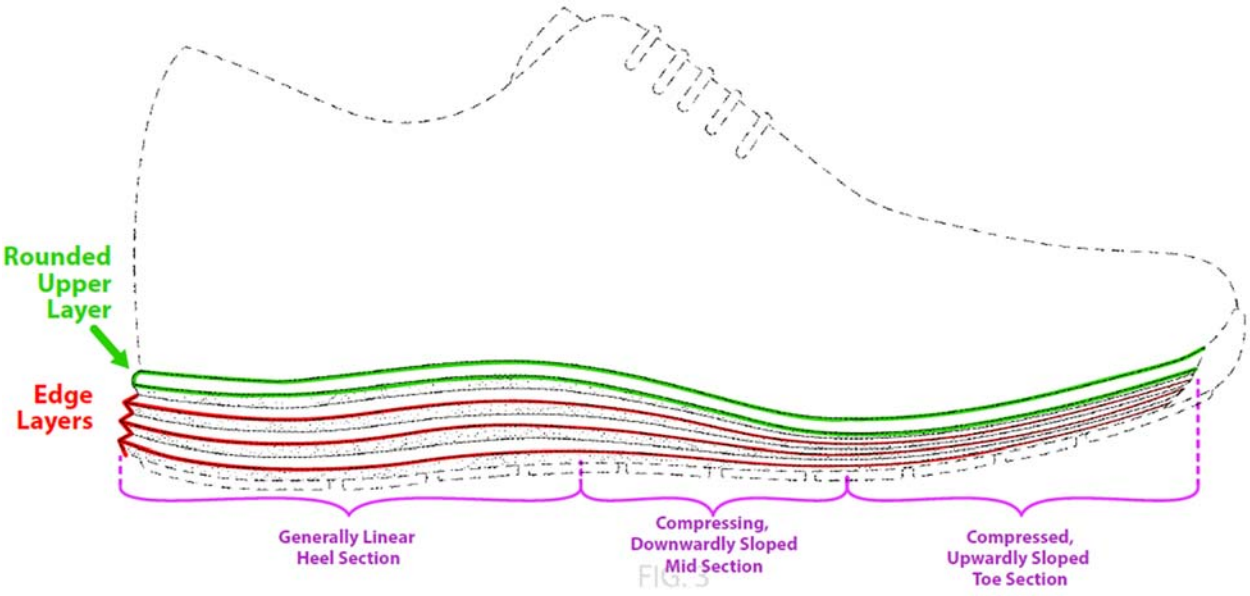
68. Figure 2 shows a lateral side view of the '969 patent's claimed design showing an ***upper layer*** that is more ***rounded*** than the ridged edge layers, and ***three ridged edge layers***, which extend continuously from a

generally linear heel section, ***compressing and downwardly sloping in a mid section***, and ***compressing and upwardly sloping towards a toe section***.



'969 patent, Fig. 2

69. Figure 3—a medial side elevation view of the '969 patent—depicts the same elements and design as Figure 2.



’969 patent, Fig. 3

70. The front view of the claimed design depicted in Figure 6 includes the same ***ridged edge layers*** and ***rounded upper layer*** extending to a disclaimed toe portion.

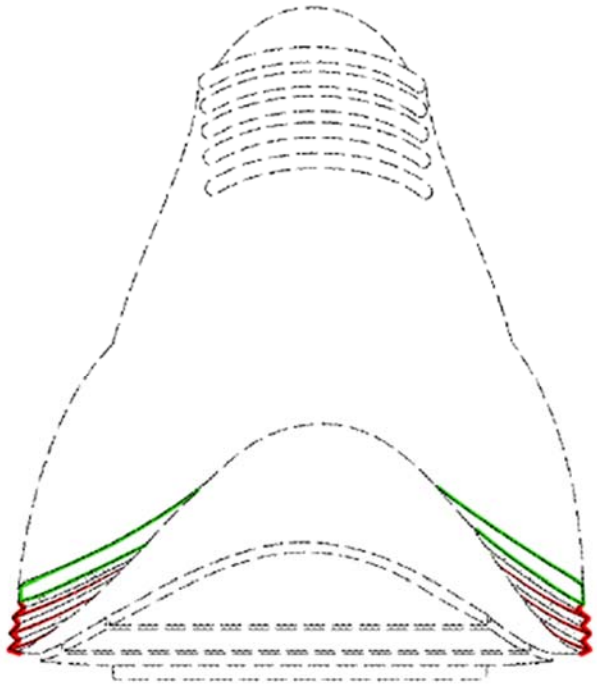


FIG. 6

71. The rear view of the claimed design depicted in Figure 7 includes the same ***ridged edge layers*** and ***rounded upper layer***.

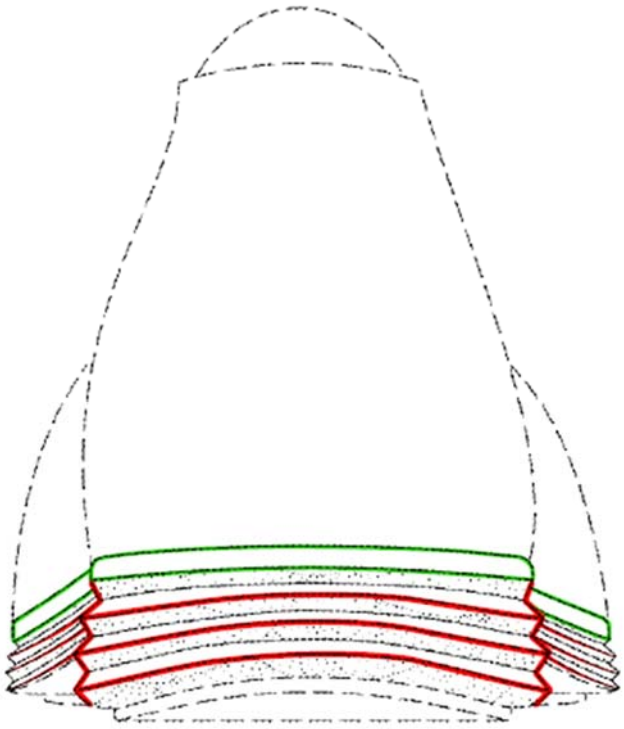


FIG. 7

’969 patent, Figs. 4-7

72. Figures 4-5 show a bottom and top of the claimed shoe, respectively. These figures illustrate the shape of midsole slightly ***pinched*** towards the middle, and wider towards the toes, closely resembling the shape of an anatomical foot.

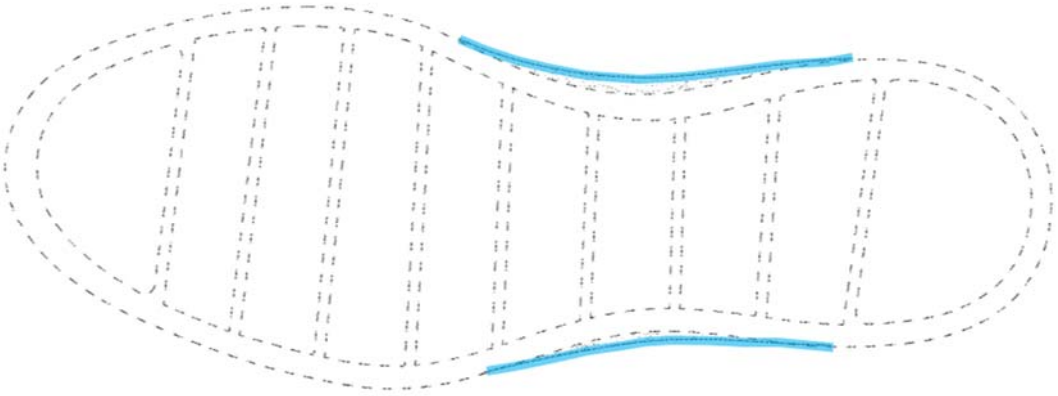


FIG. 4

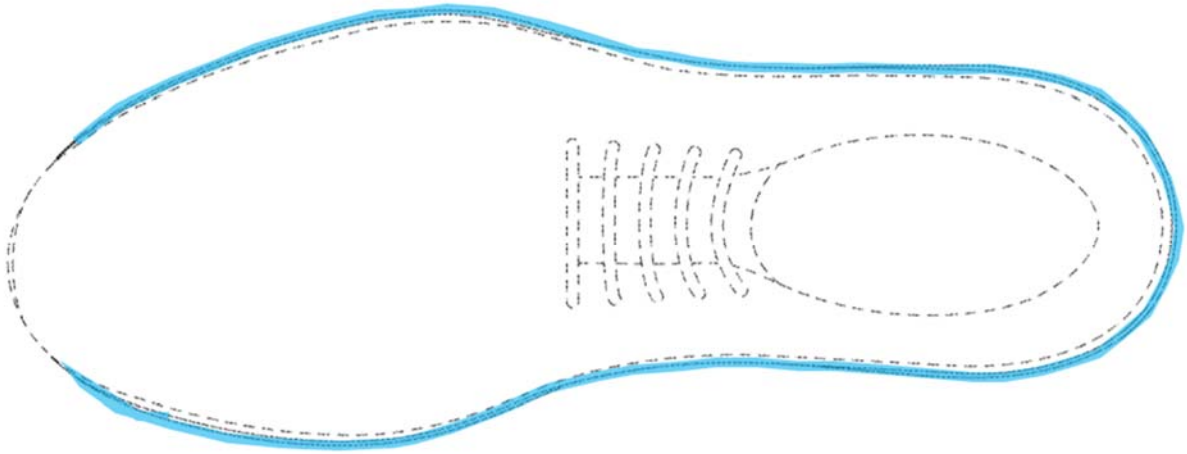


FIG. 5

’969 patent, Figs. 1-7

IX. GROUNDS OF UNPATENTABILITY

A. SUMMARY OF OPINIONS

73. As I explain above in Section V, the midsole design shown in the ’969 patent was well-known in the art.

B. SPECIFIC GROUNDS FOR CHALLENGE

74. In this section, I will explain why the teachings or combinations of teachings from the following references anticipate and/or render obvious each of the challenged design:

Name	Publication/Link	Additional Public Accessibility Support.	Date Published	Date Archived
Cole Haan C11947 ("C11947")	Ex. 1005; https://web.archive.org/web/20140303101313/https://www.youtube.com/watch?v=dSFaDo991Hk	Exs. 1004, 1006, 1007, 1008, 1009	February 20, 2014	March 3, 2014
Cole Haan C12652 ("C12652")	Ex. 1011; https://web.archive.org/web/20140708055052/http://www.colehaan.com/lunargrand-long-wingtip-chili-pepper/C12652.html?dwvar_C12652_color=Chili%20Pepper	Ex.1010	N/A	July 8, 2014
Nike, Design Application No. 002413161-0028 ("Nike")	Ex.1012	Exs. 1013. 1014, 1015	March 10, 2014	N/A
Skechers Embolden Oxfords ("Skechers")	Ex.1017; https://web.archive.org/web/20130714135257/https:/d	1016	July 10, 2013	July 14, 2013

	appered.com/2013/07/would-you-wear-it-lunargrands-emboldens/			

I have been instructed to assume that each of these references qualifies as prior art.

75. As I explain below, the Challenged Design is invalid based upon the following prior art grounds:

- **Ground 1:** The ’969 patent is anticipated by C11947
- **Ground 2:** The ’969 patent is obvious over C11947
- **Ground 3:** The ’969 patent is anticipated by C12652
- **Ground 4:** The ’969 patent is obvious over C12652
- **Ground 5:** The ’969 patent is anticipated by Nike
- **Ground 6:** The ’969 patent is obvious over Nike
- **Ground 7:** The ’969 patent is obvious over C11947 and Nike
- **Ground 8:** The ’969 patent is obvious over C12652 and Nike
- **Ground 9:** The ’969 patent is obvious over Skechers and Nike

76. As I explain above in Section IX, although the ’969 patent purports to have invented the midsole design shown in the ’969 patent, this design was well-known in the art.

1. GROUND 1: The ’969 patent is anticipated by C11947

a. Publication of C11947

77. C11947 (Ex. 1005) is a video that was publicly available on a YouTube webpage since at least March 3, 2014. Exs. 1004 (Internet Archive Declaration); 1006 (supplemental declaration showing “About” section of webpage expanded); 1007 (captured still images of Ex. 1005 at timestamps). The **C11947** video at Ex.1005 is authenticated at Ex.1004.B, Folder 002 (Ex.1004, Page 2). The March 3, 2014 Internet Archive capture of the YouTube website indicates that Ex. 1005 was posted to YouTube on February 20, 2014 and thus became available to the public as of that date, which is at least one year before the earliest priority date of the ’969 patent. Exs. 1004-1006. The latest archive date of the C11947 publication is March 3, 2014, which is more than one year before the earliest priority date of the ’969 patent. Ex. 1004, Page 4 (showing 20140303 date code), Page 5; Ex.1006, Page 4 (showing 20140303 date code), Page 5. The present-day YouTube page (Ex. 1018) shows the February 20, 2014 publication date, in addition to comments that are time stamped “11 years ago” as of July 23, 2025.

78. YouTube was a well-known, public (e.g., no access restrictions), searchable website without access restrictions and intended to reach a wide

audience. Indeed, in 2012 YouTube had "eight hundred million unique users a month, and generat[ed] more than three billion views a day. According to Nielsen, it drew eight times more video viewers last year [(2011] than Hulu…." Ex. 1024 (Seabrook, J., "Streaming Dreams," The New Yorker, Jan. 8, 2012), at 10. In November 2013, YouTube accounted for 18.69% of downstream traffic during peak periods in North America. Ex. 1023 (Reed, B., "Netflix and YouTube Make Up Majority of US Internet Traffic, New Report Shows," The Guardian (Nov. 11, 2013) https://www.theguardian.com/technology/2013/nov/11/netflix-youtube-dominate-us-internet-traffic (for online)). An ordinary observer would have independently known about the YouTube website and used it somewhat regularly for watching videos about many different topics, including shoes. A designer of ordinary skill in the art would have also independently known about YouTube as a common place for designers to source design ideas and influence. I have viewed shoe design videos on YouTube since at least 2013. And based on my experience with designing shoes for ordinary consumers, including developing an understanding of the knowledge and preferences of ordinary consumers, an ordinary observer would have been well aware of YouTube, and how to watch videos, including C11947, since at least 2013.

79. On the YouTube website, an interested member of the public, such as an ordinary observer or a designer of ordinary skill in the art, would have been able to locate C11947 on the website either by searching. Designers of ordinary skill in the art, members of the public, consumers, and ordinary observers used YouTube since at least 2013, and would have been able to easily search YouTube and find videos, including the C11947. An ordinary observer would have also been able to locate C11947 by receiving recommendations after watching other YouTube videos. For example, see Ex. 1009, showing the C11947 video in the recommended videos in the right panel. (GTFan712Productions, The White/Infrared Air Jordan 6 Retro, YouTube (Mar. 1, 2014), accessed through the WayBack Machine (C11947 in the recommended videos in the right panel)). Thus, an ordinary observer watching related shoe videos, like the one in Ex. 1009, would have come across C11947. Likewise, a designer of ordinary skill in the art would have come across C11947 while watching related shoe videos, like that shown in Ex. 1009, for design inspiration.

80. An ordinary observer and designer of ordinary skill in the art would have been able to find the video using other search engines as well. From my experience, Google is (and as of 2013 and 2014 was) one of the most commonly used search engines, and searching for videos using Google yields

many YouTube results. As of at least 2013, Google was a common place to search for design inspiration, look for shoes available on the market, and learn about newly available shoes. Thus, an ordinary observer and designer of ordinary skill in the art, searching for a shoe like the C11947, would have come across the video using Google as well.

81. As a result, the C11947 video had been watched 2,558 times on the YouTube website and received 102 likes before March 3, 2014, demonstrating that interested members of the public were able to locate and actually did access the reference prior to March 2014. Ex.1004, A.

82. Based on this evidence taken as a whole, the C11947 publication was publicly available by at least by March 3, 2014 and thus qualifies as a prior art printed publication, or as being otherwise available to the public. The Examiner never found, and Applicant never cited, the C11947 publication during prosecution.

b. Overview of C11947

83. The C11947 video discloses multiple views of a Cole Haan shoe, style "C11947," from various angles, with exemplary frames captured below:

Perspective View

(02:26:213)

(02:14:735)

(01:39:734)

Lateral Side Elevational View	Medial Side Elevational View
(00:19:275)	(01:37:960)
Bottom Plan View	

<table>
<tr><td colspan="2">
(00:54:821)</td><td colspan="2">
(01:23:563)</td></tr>
<tr><th colspan="4">Top Plan View</th></tr>
<tr><td colspan="4">
(00:42:760)</td></tr>
<tr><th colspan="2">Rear Elevational View</th><th colspan="2">Front Elevational View</th></tr>
<tr><td colspan="2">
(01:48:395)</td><td colspan="2">
(1:36:770)</td></tr>
</table>

Ex.1007.

84. C11947 discloses a design of a shoe midsole with all of the features of the ’969 patent:

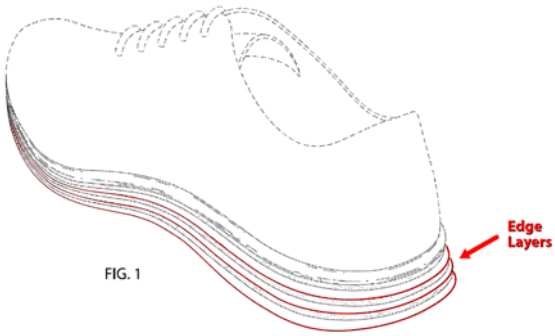
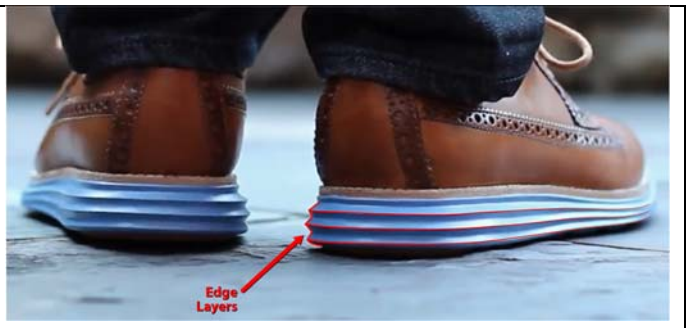
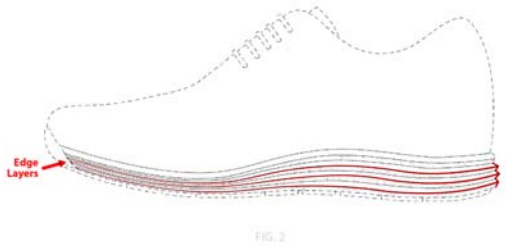
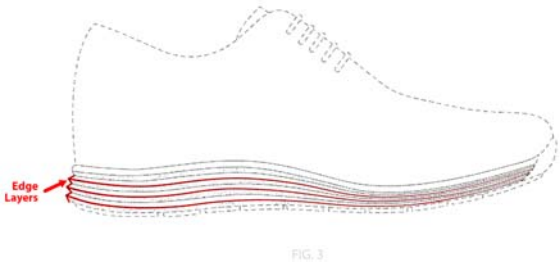
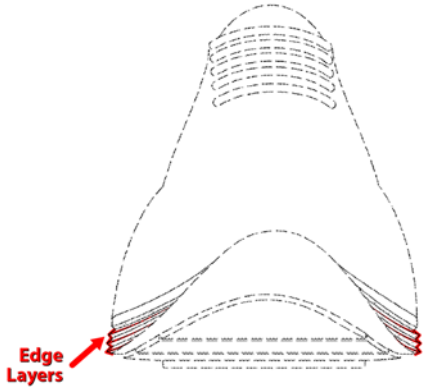
- ***Three vertically stacked ridged edge layers*** which extend continuously from the heel section to the toe section;
- A generally linear heel section, a downwardly sloped midsection in which the ridges are compressed (i.e., decrease in height), and an upwardly sloped toe section with compressed ridges;
- A ***rounded upper layer***, less sharply edged than the ***ridged edge layers*** below it;
- Slightly ***pinched*** mid-section of the sole, and wider front area, resembling a typical foot shape.

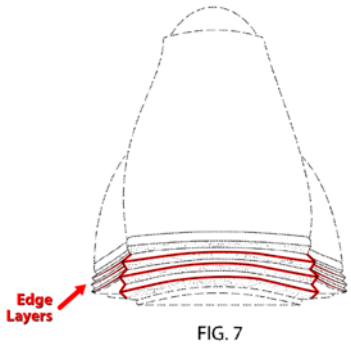
c. Claim Chart

(i) Ridge Layers: *Three Vertically Stacked, Ridged-Edged Layers* That Extend Continuously From A Heel Section Till The Toe Section (Figs 1-3, 6-7)

85. C11947 and the ’969 patent are substantially the same, in that both designs disclose ***three vertically stacked, ridged edge layers*** that extend continuously from the heel to the toe, as shown below in the side-by-side comparison:

The ’969 Patent	C11947

 FIG. 1	 (02:14:735)
 FIG. 2	 (00:19:275)
 FIG. 3	 (01:37:960)
 FIG. 6	 (1:36:770)

 FIG. 7	(01:48:395)

Exs.1001, 1007.

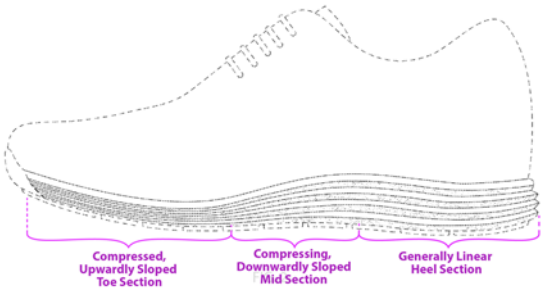
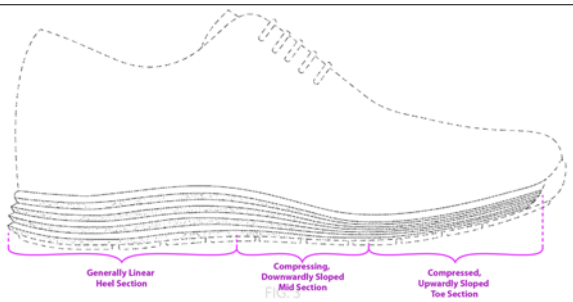
86. The ***three vertically stacked ridged edge layers*** of the '969 patent are substantially the same as the C11947 images above (with consideration to the different forms of media they are presented in). As shown above, C11947's midsole includes the same ***three ridged edge layers*** claimed in the '969 patent. Thus, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the two designs are substantially the same.

87. Thus, considering this feature, in conjunction with the other features discussed in this Declaration, C11947 and the '969 patent are substantially the same, and as a result, the '969 patent is anticipated by C11947.

(ii) Compressions: A *Generally Linear Heel Section*, A *Downward Sloped Midsection In Which The Ridged Edges Are Compressed* (i.e., decrease in height), And *An Upward Slope Towards the Toe Section* (Figs. 2-3)

88. The C11947 and the '969 patent are substantially the same in that both designs disclose three ridged edge layers which extend continuously from

a ***generally linear heel section***, ***compressing and downwardly sloping in a mid section***, and ***compressed upwardly sloping in a toe section***, as shown below in the side-by-side comparison:

The ’969 Patent	C11947
	(00:19:275)
	(01:37:960)

Exs.1001, 1007.

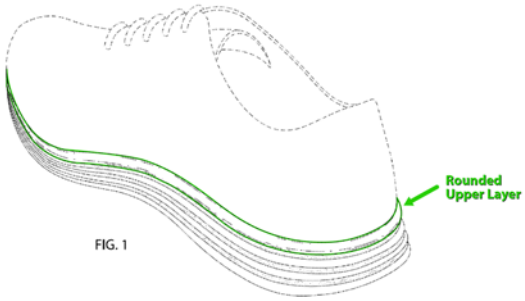
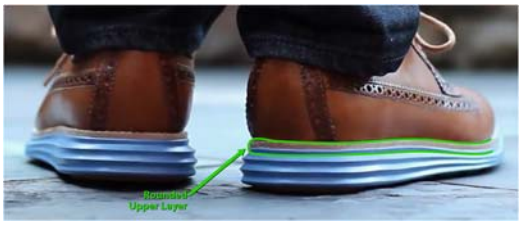
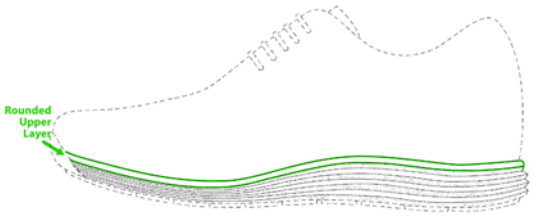
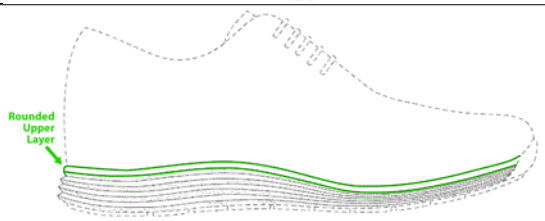
89. The ***compressions*** of the 969 patent are substantially the same as the C11947 images above (with consideration to the different forms of media they are presented in). As shown above, C11947’s midsole includes a heel section in which the layers are ***generally linear***, a mid section that is ***compressed and downward sloping,*** and ***a compressed upward slope towards the toe section.*** As a result of this similarity (and the other same features discussed) both designs present substantially the same wave-like pattern throughout the midsole. Thus, in the eye of an ordinary observer, giving such

attention as a purchaser usually gives, the two designs are substantially the same.

90. To the extent Patent Owner argues that the ’969 patent requires the ***compressing, downwardly sloped mid section*** to comprise a steeper downward slope, for the same reasons as stated in the above sectionIX.B.1.c(i), such a minor difference in sloping angle does not affect the design as a whole. The ’969 patent and C11947, considered as a whole, evoke the same wave pattern to the ordinary observer, with both midsoles compressing in the downwardly sloped mid section. A small variation in degree of compression is a minor difference that cannot prevent a finding of anticipation. Both designs encompass a shoe with ***three ridged edge layers***, which extend continuously from a ***generally linear heel section***, ***compressing and downwardly sloping in a mid section***, and ***compressed upwardly sloping in a toe section***. Thus, considering this feature, as well as the other features discussed in this Declaration, C11947 and the ’969 patent have the same overall visual impression and the two designs are substantially the same, and as a result, the ’969 patent is anticipated by C11947.

(iii) *Rounded Upper Layer* Above The Top Ridged Edge Layer (Figs. 1-3, 6-7)

91. The designs of C11947 and the ’969 patent are substantially the same in that both designs disclose a ***rounded upper layer*** above the top ridged edge layer, as shown below in the side-by-side comparison:

The ’969 Patent	C11947
 FIG. 1	(02:26:213)  (02:14:735)
 FIG. 2	(00:19:275)
 FIG. 3	(01:37:960)

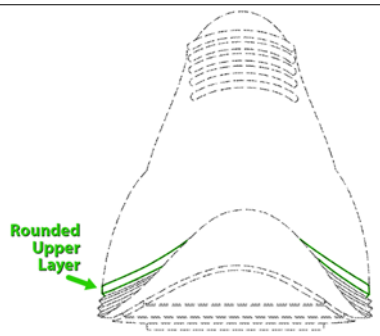


FIG. 6

(1:36:770)

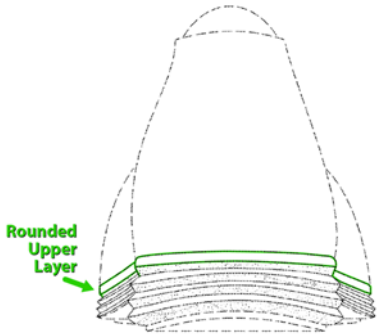


FIG. 7

(01:48:395)

Exs.1001, 1007.

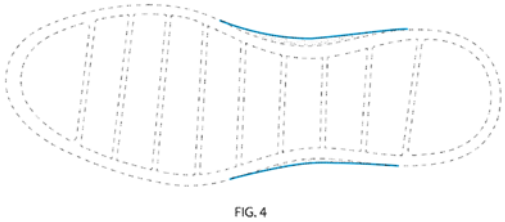
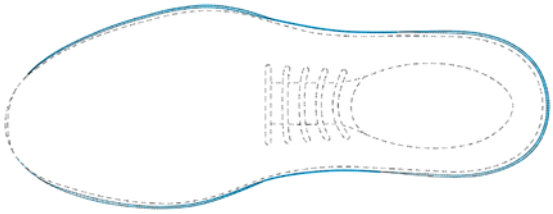
92. The ***rounded upper layer*** of the ’969 patent is substantially the same as the C11947 designs above (with consideration to the different forms of media in which they are depicted). As shown above, C11947’s midsole includes a top layer that is more rounded than the ridged edges of the ridged edge layers, substantially the same as the ’969 patent. I understand that in the New Jersey Case, Patent Owner has asserted that a shoe with a ***rounded upper layer*** similar to C11947 infringes the ’969 patent. Ex. 1018 (Complaint in NJ Case) at 27, 29, 31. Thus, under Patent Owner’s apparent interpretation of the ’969 patent’s scope, a shoe with a ***rounded upper layer*** similar to C11947 is substantially similar to the '969 patent. Further, to the extent that Patent Owner

argues that the rounded upper layer of the C11947 is insufficiently rounded, "in the eye of an ordinary observer, giving such attention as a purchaser usually gives," the layers appear substantially the same – the C11947 upper layer is more softly curved than the ridged edge layers, like the '969 patent. Further, any minor discontinuity in the rounded layer can be accounted for by leather welt between the upper and the midsole. An ordinary observer would view a shoe midsole from several feet away (not under high magnification) while considering a shoe for purchase, and any minor differences in the upper layer would be insubstantial from this viewpoint. Thus, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the two designs are substantially the same.

93. Thus, considering this feature, in conjunction with the other features discussed in this Declaration, C11947 and the '969 patent are substantially the same, and as a result, the '969 patent is anticipated by C11947.

(iv) Pinched Mid Section: A Slightly *Pinched* Mid-Section Following The Natural Shape Of An Anatomical Foot (Figs. 4-5)

94. The C11947 and '969 patent are substantially the same in that both designs disclose a slightly ***pinched*** mid-section following the natural shape of an anatomical foot, as shown below in the side-by-side comparison:

The ’969 Patent	C11947
	(00:54:821)
	(00:42:760)

Ex. 1001, 1007.

95. To the extent that Patent Owner argues that the bottom view (Figure 4) of the ’969 patent requires the midsole to overhang, over the bottom sole, the bottom sole is not claimed (as shown by the dashed lines). Even still, C11947 is the same in this design feature as well. As can be seen in the corresponding C11947 figure to the ’969 patent’s Figure 4, the C11947 midsole overhangs over the bottom sole that touches the ground (patterned area). In fact, this unclaimed bottom sole further emphasizes the similarities between the designs, and in particular the claimed midsole. The unclaimed bottom sole of the ’969 patent is visually similar to the C11947, in that it is segmented and has tracks.

96. Thus, considering this feature, in conjunction with the other features discussed in this document (as discussed below), C11947 and the ’969 patent are substantially the same, and as a result, the ’969 patent is anticipated by C11947.

d. Overall Design

97. The four features described above in C11947 come together as a whole to form substantially the same design as claimed in the ’969 patent. Both the ’969 patent and C11947 disclose a wave-like midsole design that compresses and slopes around the foot, and pinches at the midsection. An ordinary observer would have considered them to be substantially the same midsole, because, as illustrated by the images above, they appear substantially the same. The only difference in visual appearance between the ’969 patent and C11947 is due to the forms of media in which they are presented—the design in the C11947 is presented in a video of an actual product, while the design in the ’969 patent is illustrated in line drawings. Tellingly, the most visually apparent design features to the ordinary observer—the ***three ridged edge layers*** topped with a ***rounded upper layer***—are substantially the same in the C11947 and the ’969 patent midsoles. Figure 2 of the ’969 patent is representative:

The ’969 Patent	C11947

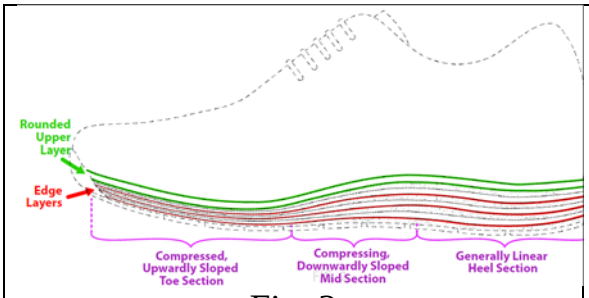
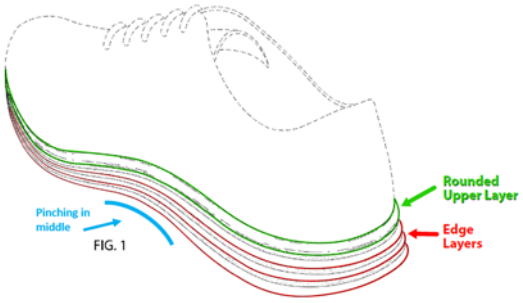
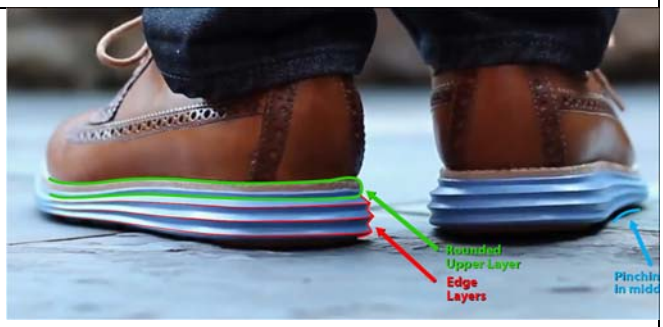


Fig. 2

(00:19:275)





(02:14:735)

Exs. 1001, 1007

98. To the extent that Patent Owner argues there are any minor variations (of which there are none), they do not preclude a finding of anticipation because the overall impression created—the wave-like pattern that results from the four features discussed above—remains equivalent between C11947 and the ’969 patent**.**

99. Any slight variations Patent Owner may allege would not change the overall visual impression created by C11947: a wave-like design on a midsole that is shaped like a typical foot.

100. Thus, considering the overall claimed midsole design of the ’969 patent and the overall midsole design of the C11947, an ordinary observer

would have been induced to purchase one supposing it to be the other. As a result, the ’969 patent is anticipated by C11947.

2. GROUND 2: The ’969 Patent is Obvious Over C11947

101. C11947 is so substantially the same as the claimed design that no secondary reference is necessary (*see* Ground 1).

102. However, to the extent Patent Owner argues that C11947 is materially different, the claim of the ’969 patent is obvious over C11947.

103. *Scope and content of the prior art:* C11947 is a suitable primary reference as it is visually similar to the ’969 patent (*see* Ground 1). C11947 was something in existence, and is visually similar to the ’969 patent. The scope and content of the C11947, considered with the knowledge of a designer of ordinary skill in the art (as defined in Section VI), is essentially identical to the ’969 patent: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched mid section. See Ground 1.

104. *Differences between the claimed invention and the prior art*: To the extent that Patent Owner argues that such features do not exist in the C11947, comparing the visual appearance of the ’969 patent with the prior art, from the perspective of a designer of ordinary skill in the art, the differences between the claimed midsole and C11947 are an overhanging midsole and a more rounded upper layer.

105. Overhanging Midsole: To the extent Patent Owner argues that Figure 4 depicting the bottom view of the ’969 patent requires an overhanging midsole, extending past the bottom of the sole, those proportions would have been obvious to the designer of ordinary skill in the art as they would have been purely functional, rather than ornamental. Making the midsole wider to result in an overhang would have been obvious to accommodate those with wider feet since, fit of a shoe (including the midsole) is key in comfort. *See., e.g.*, Ex. 1019, 7-8 (“An important factor for shoe comfort was the fit of the shoe.”) In fact, shoe companies offered wide-sizes well before the priority date of the ’969 patent: “New Balance is attempting to maintain its identity as a niche player by producing running shoes and extra-wide sizes while diversifying into children's, walking and cross-training shoes. This balancing act has increased sales for the company from $221 million in 1992 to a projected $450 million in 1996.” Ex. 1020, Abstract. Indeed, the length and width of a shoe midsole is dictated by the size and proportions of the foot, which is entirely functional in nature. Additionally, wider midsoles offer a greater lever arm to the ground reaction force, increasing angular displacement and pronation velocity. Ex. 1022, at 162 (“Firmer, wider midsoles offer a greater lever arm to the ground reaction force, increasing angular displacement and pronation velocity”). Thus, the width of the midsole is functional.

106. Even if that were not the case, however, a designer of ordinary skill in the art would have found changing the width of the midsole to be trivial. A designer of ordinary skill in the art would have had the common knowledge and skill to understand that any given shoe midsole could be easily modified to be wider or thinner depending on the foot and would have been motivated to vary the overall size of the midsole to suit the targeted consumer base. For example, as I described in the paragraph directly above, New Balance had expanded their product line to include "extra-wide sizes" to accommodate their target consumer base. Ex. 1020, Abstract.

107. More Rounded Upper Layer: To the extent Patent Owner argues that the '969 patent requires a more rounded upper layer, that would have been obvious to the designer of ordinary skill in the art as the C11947 suggests it on its own. C11947's upper layer is already rounded, appearing softer and less sharply ridged than the bottom three ridged layers, suggesting a rounder layer to a designer of ordinary skill in the art. As suggested by the already rounded appearance of the upper layer, a designer would have found it obvious to vary the level of curviness so that the upper layer is more curvier.

108. Even if that were not the case, however, a designer of ordinary skill in the art would have found softening the curve of the upper layer of the midsole to be trivial. A designer of ordinary skill in the art would have had the

common knowledge and skill to understand that the already rounder layer, as compared to the other, ridged layers, could be easily modified to be even rounder and would have been motivated to do so to create continuity in the meeting of the welt material with the rubber material. See my discussion at the Background of Technology, Section IV, discussing securing the upper to the sole.

109. *Level of skill in the art: See* Section VI.

110. *Secondary considerations: See* Section X.

111. Thus, a designer of ordinary skill in the art would have found the C11947 to be visually similar to the ’969 patent, depicting a flowy, wave-like design on a midsole. In view of the above, the claimed design is obvious in view of C11947.

3. GROUND 3: The ’969 Patent is Anticipated By C12652

a. Publication of C12652

112. C12652 (Ex.1010) is a webpage that was publicly available on www.colehaan.com since at least July 8, 2014. The latest archive date of the C12652 publication is July 8, 2014, which is more than one year before the earliest priority date of the ’969 patent. Ex.1010, Page 4 (containing URL date code 20140708), Page 5. Embedded within the C12652 webpage are high

resolution images, which appear at Ex.1010, Pages 867-878. The high-resolution images at Ex.1010, Pages 867-878 are reproduced as Ex.1011.

113. Colehaan.com was well-known, public (e.g., no access restrictions), searchable, and intended to reach a wide audience. Both an ordinary observer and a designer of ordinary skill in the art would have known about and readily located information on this website with reasonable diligence. Cole Haan was a popular shoe company at the time, as was its website. Further, shoe designers would have viewed other shoe websites to gain inspiration and keep their fashion knowledge up-to-date. Similarly, ordinary observers visited the well-known website in 2013 and 2014 to view available or soon-to-be available shoes. Based on this evidence taken as a whole, the C12652 publication was publicly available by at least July 8, 2014, or as being otherwise available to the public. The Examiner never found, and Applicant never cited, the **C12652** publication during prosecution.

b. Overview of C12652

114. The C12652 publication provides multiple images to show different views of the C12652 design: The **Cole Haan C12652** publication does not provide an unobstructed image of the medial side elevation view and an image of the bottom view. *See* Ex.1007.B.002-007. However, the images provided are enough for an ordinary observer to have understood the entire

product, much like the ordinary observer would have done in looking at limited images of products for sale online.

Perspective View
Lateral Side Elevational View
Top Plan View

Rear Elevational View

Front View

Ex.1011.

115. The C12652 publication discloses a design of a shoe midsole with all of the features of the 969 patent:

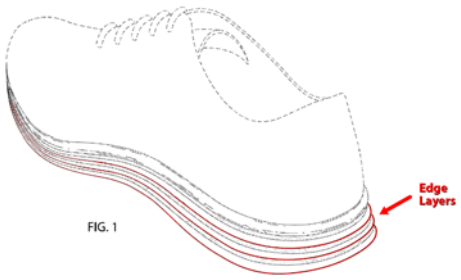
- ***Three vertically stacked ridged edge layers*** which extend continuously from the heel section to the toe section;
- A ***generally linear heel section***, ***a downwardly sloped midsection in which the ridges are compressed*** (i.e., decrease in height), and ***an upwardly sloped toe section with compressed ridges***.
- A ***rounded upper layer***; and
- Slightly ***pinched*** mid-section of the sole, and wider front area, resembling a typical foot shape.

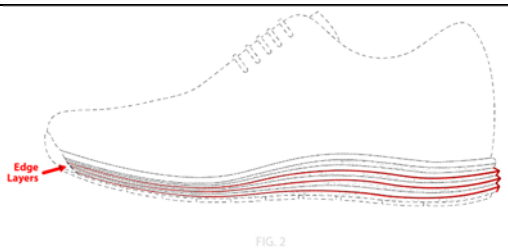
c. Claim Chart

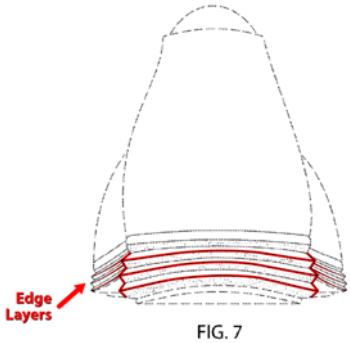
(i) Ridge Layers: *Three Vertically Stacked, Ridged-Edged Layers* That Extend Continuously From A Heel Section Till The Toe Section

116. The C12652 and the '969 patent are substantially the same in that both designs disclose ***three vertically stacked, ridged edge layers*** that extend continuously from the heel to the toe, as shown below in the side-by-side comparison:

The '969 Patent	C12652

<table>
<tr>
<td> 
</td>
<td>

Perspective View</td>
</tr>
<tr>
<td> 
</td>
<td>

Lateral Side Elevational View</td>
</tr>
<tr>
<td> 
</td>
<td>

Rear Elevational View</td>
</tr>
</table>

Exs.1001, 1011

117. The ***three vertically stacked ridged edge layers*** of the ’969 patent are substantially the same as the C12652 images above (with consideration to the different forms of media they are presented in). As shown above, C12652’s midsole includes the same ***three ridged edge layers*** claimed in the ’969 patent. Again, the sameness is further reinforced by the fact that both have exactly ***three*** ridged edge layers (and one rounded upper layer, discussed below). Thus, the ordinary observer, giving such attention as a purchaser usually gives a

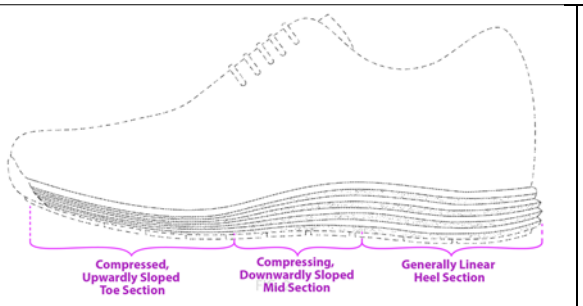
midsole, and familiar with the relevant prior art, would have been induced to purchase one supposing it to be the other.

118. I note that the C12652's perspective view is not identical to the angle of the '969 patent's perspective view. However, from the available perspectives, an ordinary observer would have recognized that all the design elements of the 969 patent are present in C12652, and the two shoe midsoles are substantially the same in their features, as well as their overall appearance. The available perspectives provide an ordinary observer, the ability to understand the C12652 design to be substantially the same midsole as the '969 patent (consistent with how an ordinary observer would have shopped online for shoes).

(ii) Compressions: A *Generally Linear Heel Section*, A *Downward Sloped Midsection In Which The Ridged Edges Are Compressed* (i.e., decrease in height), And *An Upward Slope Towards The Toe Section*

119. The C12652 and the '969 patent are substantially the same in that both designs disclose three ridged edge layers which extend continuously from a ***generally linear heel section***, ***compressing and downward sloping in the mid section***, and ***compressing and upward sloping towards a toe section***, as shown below in the side-by-side comparison:

The '969 Patent	**C12652**



Lateral Side Elevational View

Exs.1001, 1011.

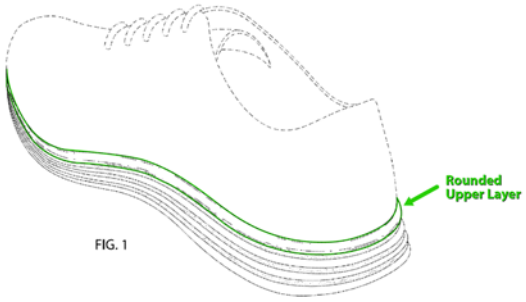
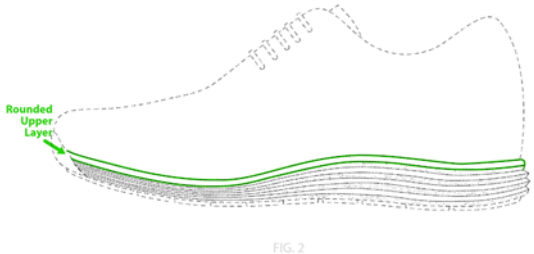
120. The ***compressions*** of the ’969 patent are substantially the same as the C12652 images above (with consideration to the different forms of media they are presented in). As shown above, C12652’s midsole includes a heel section in which the layers are ***generally linear***, a mid section that is ***compressed and downward sloping,*** and ***a compressed upward slope towards the toe section.*** As a result of this similarity (and the other substantially same features discussed) both designs present substantially the same wave-like pattern throughout the midsole. Thus, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the two designs are substantially the same.

121. To the extent Patent Owner argues that the ‘969 patent requires the ***compressing, downwardly sloped mid section*** to comprise a steeper downward slope, for the same reasons as stated in Ground 1:IX.B.1.c(i) IX.B.1.c(i)such a minor difference in sloping angle does not affect the design as a whole, and an ordinary observer would not have considered such a minor

difference, if noticed at all. *See* Ground 1. Thus, considering this feature, as well as the other features discussed in this Declaration, C12652 and the 969 patent present the same overall visual impression and the two designs are substantially the same, and as a result, the ’969 patent is anticipated by C12652.

(iii) A *Rounded Upper Layer* Above The Top Ridged Edge Layer

122. The C12652 and the ’969 patent are substantially the same in that both designs disclose a ***rounded upper layer***, as shown below in the side-by-side comparison:

The ’969 Patent	C11947
	 Perspective View
	 Lateral Side Elevational View

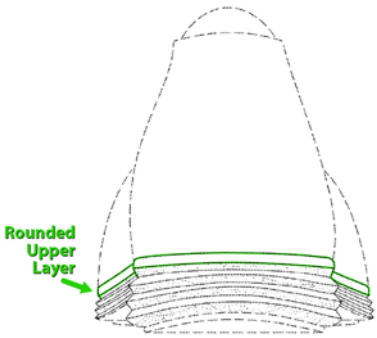
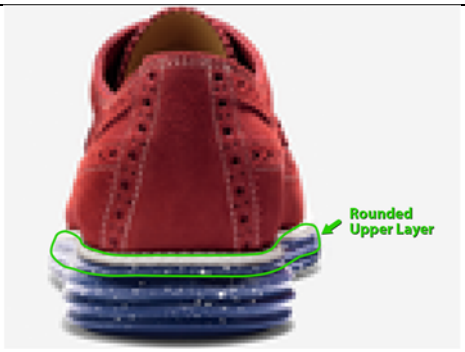


FIG. 7



Rear Elevational View

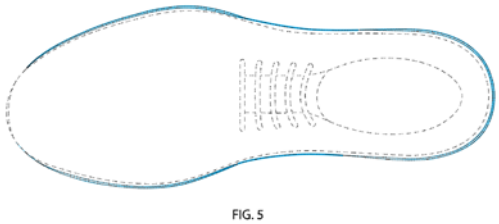
Exs.1001, 1011.

123. I understand that in the New Jersey Case, Patent Owner has asserted that a shoe with a ***rounded upper layer*** similar to C12652 infringes the ’969 patent. Ex. 1018 (Complaint in NJ Case) at 27, 29, 31. Under Patent Owner’s apparent interpretation of the ’969 patent scope, a shoe with a ***rounded upper layer*** similar to C12652 is substantially similar to the '969 patent. Further, to the extent that Patent Owner argues that the rounded upper layer of the C12652 is more squared than rounded, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the layers appear substantially the same – the C12652 upper layer is more softly curved than the ridged edge layers, like the ’969 patent. An ordinary observer would view a shoe midsole from several feet away (not under high magnification) while considering a shoe for purchase, and any minor differences in the upper layer would be insubstantial from this viewpoint. Thus, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the two designs are substantially the same.

124. Thus, considering this feature, in conjunction with the other features discussed in this Declaration, C12652 and the ’969 patent are substantially the same, and as a result, the ’969 patent is anticipated by C12652.

(iv) Pinched Mid Section: A Slightly *Pinched* Mid-Section Following The Natural Shape Of An Anatomical Foot

125. The C12652 and the ’969 patent are substantially the same in that both designs disclose a slightly ***pinched*** mid-section following the natural shape of an anatomical foot, as shown below in the side-by-side comparison:

The ’969 Patent	C11947
 FIG. 5	Top Plan View

Exs.1001, 1011.

126. To the extent that Patent Owner argues that the bottom view (Figure 4) of the ’969 patent requires the midsole to overhang, over the bottom sole, this would be irrelevant as the bottom sole is not claimed (as shown by the dashed lines). Even still, C12652 is substantially the same in view of this design feature as well. As can be seen in the corresponding C12652 figure to the ’969 patent’s Figure 5, the C12652 midsole overhangs over the bottom sole that touches the ground (patterned area). In fact, the substantial similarity of

this unclaimed feature further reinforces the substantial similarity of the two designs as a whole. The unclaimed bottom sole of the ’969 patent is visually similar to the C11947, with its segments.

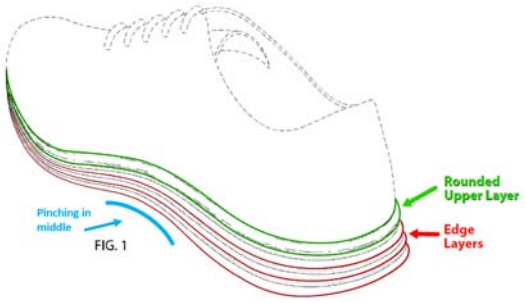
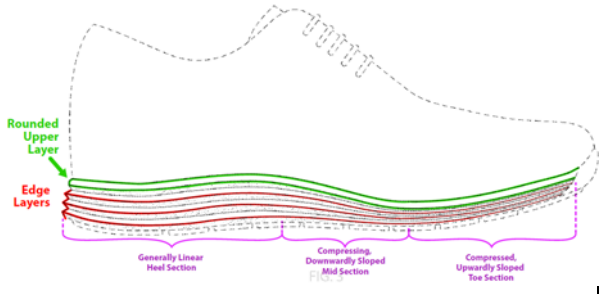
127. To the extent the ’969 patent requires the ridged edge layers to extend around the entire upper perimeter of the shoe’s sole, a designer of ordinary skill in the art would have understood that the angle of C12652’s top view inadvertently omits this protrusion from the shoe’s mid-section. Indeed, reference to the rear elevational view demonstrates the ridged edge layers extending around the entire upper perimeter of the shoe’s sole.

128. Thus, considering this feature, in conjunction with the other features discussed in this Declaration (as discussed below), C12652 and the ’969 patent are substantially the same, and as a result, the ’969 patent is anticipated by C12652.

(v) Overall Design

129. The four features described above in C12652 come together as a whole to form substantially the same design as claimed in the ’969 patent. The four features described above result in a wave-like midsole that compresses and slopes around, and pinches at the midsection. The ’969 patent and C12652 both depict this wave-like design. An ordinary observer would have considered

them to be substantially the same shoe midsole, because, as shown above and below, they appear substantially the same:

The ’969 Patent	Cole Haan C12652
	 Perspective View
	 Lateral Elevational View

Exs. 1001, 1011.

130. To the extent that Patent Owner argues there are any minor variations (of which there are none), they do not preclude a finding of anticipation because the overall impression created—the wave-like pattern that results from the four features discussed above—remains equivalent between C12652 and the ’969 patent**.**

131. Thus, considering the overall claimed midsole design of the ’969 patent and the overall midsole design of the C12652, an ordinary observer

would have been induced to purchase one supposing it was the other**.** As a result, the ’969 patent is anticipated by C12652.

4. GROUND 4: The ’969 Patent is Obvious Over C12652

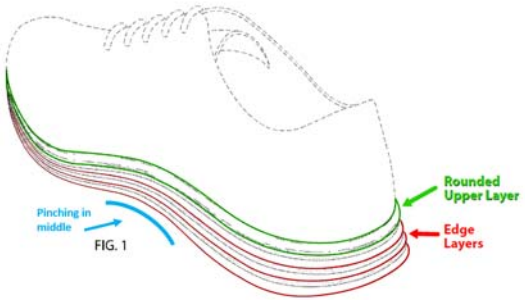
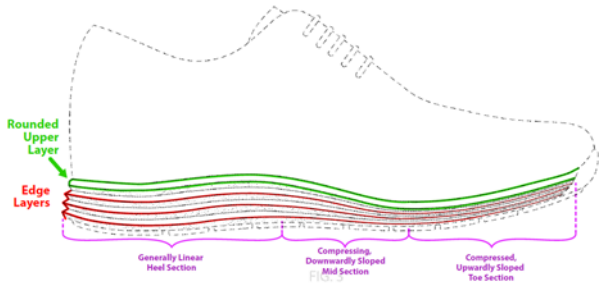
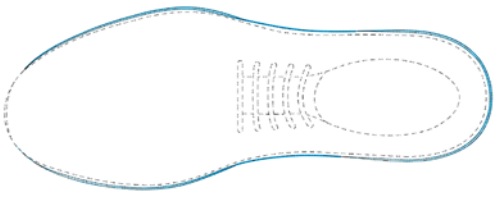
132. C12652 is so substantially the same as the claimed design that no secondary reference is necessary (*see* Ground 3).

133. However, to the extent Patent Owner argues that C12652 is materially different, the claim of the ’969 patent is obvious over C12652.

134. *Scope and content of the prior art:* C12652 is a suitable primary reference as it is visually similar to the ’969 patent (*see* Ground 3). C12652 was something in existence, and is visually similar to the 969 patent. The scope and content of the C12652, considered with the knowledge of a designer of ordinary skill in the art (as defined in Section VI) is the same as the ’969 patent: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched mid section. *See* Ground 3.

135. *Differences between the claimed invention and the prior art*: To the extent there are any differences between C12652 and the ’969 patent, C12652 itself readily suggests those differences to a designer of ordinary skill in the art because any differences are just in arrangement and proportioning of features. For instance, to the extent Patent Owner argues that the perspective view of C12652 does not present a clear image of the medial elevational side

view, a designer of ordinary skill in the art would have understood the design as a whole from the images available. The medial features of C12652 would have been obvious to a designer of ordinary skill in the art once having viewed the perspective view image. Similarly, the designer of ordinary skill in the art would have understood the bottom design of the C12652 using the top plan view, showing the same pinching in the midsection, and wider area near the toe region. A designer, with experience in design, would have understood the medial features having seen the perspective view.

The ’969 Patent	Cole Haan C12652
	 Perspective View
	 Lateral Elevational View
	 Top Plan View

Exs.1001, 1011.

136. Even if that were not the case, however, a designer of ordinary skill in the art would have found designing a midsole with the same design running from the lateral side to the medial side to be trivial. A designer of ordinary skill in the art would have had the common knowledge and skill to understand that any given midsole could be easily modified to continue the design on the lateral side to the medial side, for bi-lateral symmetry of design. Ex. 1029, page 2 ("It is usually considered that a symmetrical composition in clothing is this one which is based on reflection or bilateral symmetry, because of this type of symmetry in the human body."). In fact, such a symmetry would have been preferred in western culture. See, for example, Ex. 1028 ("Western preference for bi-lateral mirror reflection…"). Indeed, it would have been common knowledge for a designer to continue a design from one side of the shoe to the other, like most shoes, creating continuity.

137. To the extent Patent Owner argues that Figure 6 of the '969 patent requires an overhang of the midsole over the bottom sole, a designer of ordinary skill in the art would have found it obvious to make the midsole wider than the bottom sole in the mid-section. Indeed, this was a basic concept seen in other designs at the time. *See, e.g.*, Nike (Grounds 5-6). And as stated earlier, the overhang is functional.

138. *Level of skill in the art: See* Section VI.

139. *Secondary considerations*: See Section X

140. Thus, a designer of ordinary skill in the art would have understood C12652 to be visually similar to the ’969 patent, depicting a similar wave-like design. In view of the above, the claim is obvious in view of C12652.

5. GROUND 5: The ’969 Patent is Anticipated By Nike

a. Publication of Nike

141. Nike (Ex. 1012) is EUIPO Design Registration Application No. 002413161-0028, which was filed on February 26, 2014 and published on March 10, 2014, more than one year before the earliest priority date of the ’969 patent. Ex. 1012 at 3 (Nike) (field 45 indicating March 3, 2014 publication date). The EUIPO website Design View indicates that Nike published under Articles 48 and 50 EDR on March 3, 2014 in Section A.1 of Bulletin No. 2014/046. Ex. 1015. Bulletin No. 2014/046 bears a publication date of March 3, 2014 and contains the publication of **Nike**. Ex. 1013 at 1, 383-385. Embedded within the Design View webpage (Ex. 1015) are high-resolution images of the Nike design that are substantively identical to those in Ex. 1012, and these high-resolution images appear in Ex. 1014. The Examiner never found, and Applicant never cited, Nike during prosecution.

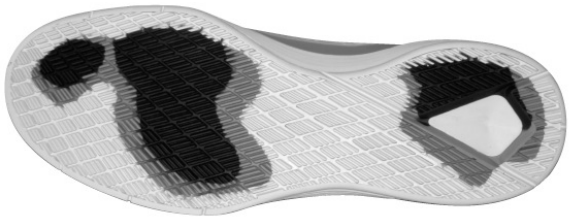
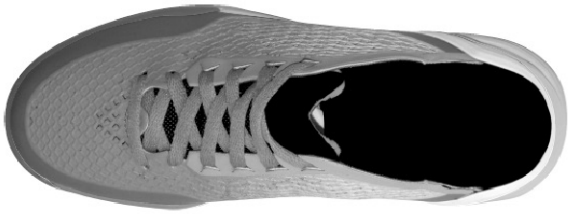
b. Overview of Nike

142. Nike discloses a shoe design. Nike provides seven figures showing different views of its design:

Figure	View
1	medial side elevational view
2	lateral side elevational view
3	rear elevational view
4	front elevational view
5	top plan view
6	bottom plan view
7	perspective view

Perspective View

Lateral Side Elevational View	Medial Side Elevational View

Bottom Plan View	**Top Plan View**
	
Front Elevational View	**Rear Elevational View**

Ex.1014

143. Nike discloses a design of a shoe midsole with all of the features of the ’969 patent:

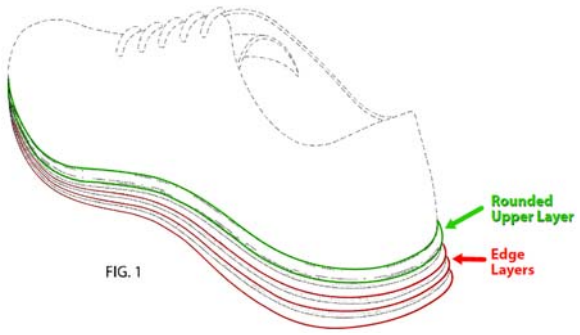
- ***Three ridged edge layers*** which extend continuously from the heel section to the toe section;
- Compressions: where the layered ridges form ***a generally linear heel section, a downwardly sloped midsection in which the ridges are compresse***d (i.e., decrease in height)***, and an upwardly sloped toe section with compressed*** ridges;
- ***A rounded upper layer***; and
- A slightly ***pinched*** midsection following the natural shape of the foot.

Ex.1012.

c. Claim Chart

(i) Ridge Layers: *Three Vertically Stacked, Ridged-Edged Layers* That Extend Continuously From A Heel Section Till The Toe Section (All Figs)

144. Nike and the '969 patent are substantially the same in that both designs have ***three vertically stacked, ridged edge layers*** that extend continuously from the heel to the toe, as shown below in the side-by-side comparison:

The '969 Patent	Nike
	

Exs.1001, 1012. Although the angle of Nike's perspective view is not identical to the angle of the '969 patent's perspective view, a designer of ordinary skill in the art would have been able to put together the full picture of the design with the images present. A designer would not have needed every single perspective to piece together the design: what is provided produces the overall design impression.

145. The ***three vertically stacked ridged edge layers*** of the '969 patent are substantially the same as the Nike images above (with consideration to the

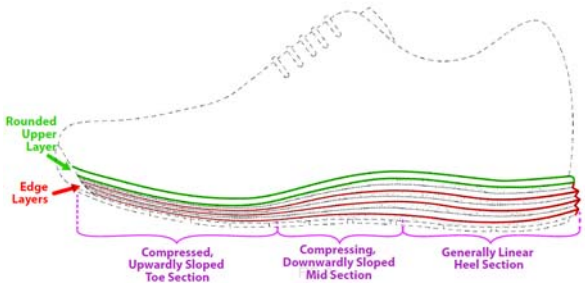
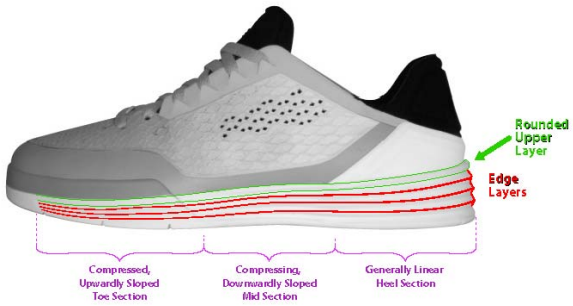
different forms of media they are presented in). As shown above, Nike's midsole includes ***three ridged edge layers*** claimed in the '969 patent. Again, the substantial sameness of the designs is further reinforced by the fact that both have exactly ***three*** ridged edge layers (and one rounded upper layer, discussed below). Thus, the ordinary observer, giving such attention as a purchaser usually gives a midsole, and familiar with the relevant prior art, would have been induced to purchase one supposing it to be the other.

146. While Nike's design has a difference in its layers, under Patent Owner's apparent interpretation, the difference is insubstantial. Nike's midsole layers ***extend outwards*** (abduct) near the toe area, on the medial side. As a result, there is a slight discontinuity, slanting towards the toe section. But, I understand that Patent Owner apparently interprets the scope of the '969 patent to include such discontinuities, as a product which Patent Owner accuses of infringing also contains such a discontinuity. Ex. 1018 (Complaint), 27, 29, 31. I understand that minor differences such as this do not prevent a finding of anticipation. Under Patent Owner's apparent interpretation, an ordinary observer would not consider this minor difference to be substantial in the overall design. Consideration of this feature, in conjunction with the other features discussed below, results in substantially the same design under Patent Owner's apparent interpretation. Additionally, an abduction of the midsole

would have been functionally appropriate to accommodate wider feet, and thus under Patent Owner's apparent interpretation an ordinary observer would have understood this minor difference as part of the functionality of the shoe, and not part of the design. *See* Ground 1

(ii) Compressions: A *Generally Linear Heel Section*, A *Downward Sloped Midsection In Which The Ridged Edges Are Compressed* (i.e., decrease in height), And *An Upward Slope Towards The Toe Section*

147. Nike and the '969 patent are substantially the same in that both designs disclose three ridged edge layers which extend continuously from a ***generally linear heel section***, ***compressing and downward sloping in the mid section***, and ***compressing and upward sloping towards a toe section***, as shown below in the side-by-side comparison:

The '969 Patent	Nike
	

Exs.1001, 1012

148. To the extent the '969 patent requires the ***compressing, downwardly sloped mid section*** to comprise a steeper downward slope, a

designer of ordinary skill in the art would have understood that the pitch of the sloped ***layers*** does not impact the overall visual impression (*see* Ground 1).

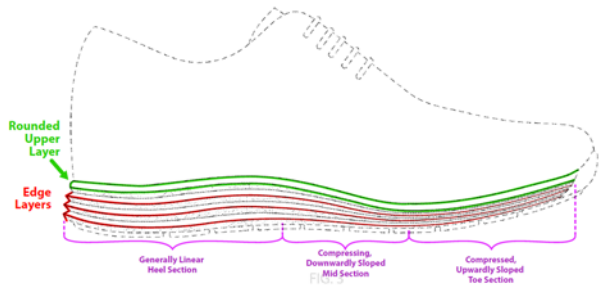
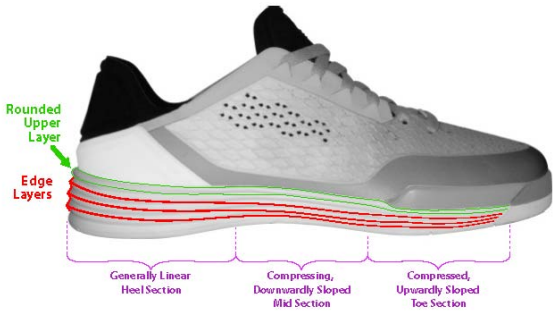
149. The ***compressions*** of the ’969 patent are substantially the same as Nike above (with consideration to the different forms of media in which they are presented). As shown above, Nike’s midsole includes a heel section in which the layers are ***generally linear***, a mid section that is ***compressed and downward sloping,*** and ***a compressed upward slope towards the toe section.*** As a result of this similarity (and the other substantially same features discussed), both designs present substantially the same wave-like pattern throughout the midsole. Thus, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the two designs are substantially the same.

150. To the extent Patent Owner argues that the ’969 patent requires the ***compressing, downwardly sloped mid section*** to comprise a steeper downward slope, for the same reasons as stated in Ground 1IX.B.1.c(i): such a minor difference in sloping angle does not affect the design as a whole, and an ordinary observer would not have considered such a minor difference, if noticed at all. Thus, considering this feature, as well as the other features discussed in this Declaration, Nike and the 969 patent have the same overall

visual impression and the two designs are substantially the same. As a result, the ’969 patent is anticipated by Nike.

(iii) *Rounded Upper Layer* Above The Top Ridged Edge Layer

151. Nike and the ’969 patent are substantially the same in that both designs disclose a ***rounded upper layer***, as shown below in the side-by-side comparison:

The ’969 Patent	Nike
	

Exs.1001, 1012.

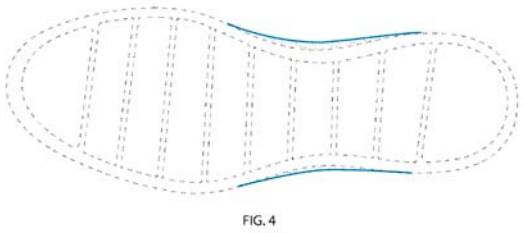
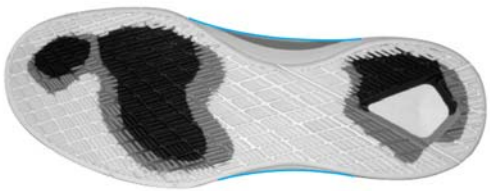
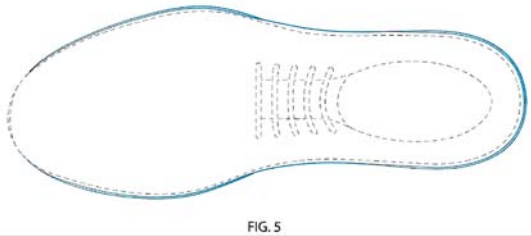
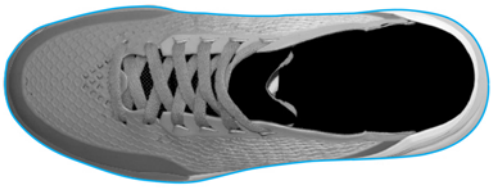
152. The ***rounded upper layer*** of the ’969 patent is substantially the same as the Nike images above (with consideration to the different forms of media in which they exist). As shown above, Nike’s midsole includes a top layer that is rounded, substantially the same as the ’969 patent. Thus, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the two designs are substantially the same. In fact, an ordinary observer would

have been even encouraged to think the ’969 patent was the Nike with attention to detail regarding the top layer.

153. Thus, considering this feature, in conjunction with the other features discussed in this Declaration, Nike and the ’969 patent are substantially the same, and as a result, the ’969 patent is anticipated by Nike.

(iv) Pinched Mid Section: A Slightly *Pinched* Mid-Section Following The Natural Shape Of An Anatomical Foot

154. Nike and the ’969 patent are substantially the same in that both designs disclose a slightly ***pinched*** mid-section following the natural shape of an anatomical foot, as shown below in the side-by-side comparison:

The ’969 Patent	Nike
	
	

Exs.1001, 1012.

155. To the extent that Patent Owner argues that the bottom view (Figure 4) of the ’969 patent requires the midsole to overhang, over the bottom sole, the bottom sole is not claimed (as shown by the dashed lines). Even still, Nike is the same with respect to this design feature as well. As can be seen in the figures above in Nike’s bottom view, the Nike midsole hangs over the bottom sole that touches the ground. The sides of the layers of the midsole can be seen overhanging the mid section.

156. Thus, considering this feature, in conjunction with the other features discussed in this Declaration (as discussed below), Nike and the ’969 patent are substantially the same, and as a result, the ’969 patent is anticipated by Nike.

d. Overall Design

157. The four features described above in Nike come together as a whole to form substantially the same design as claimed in the ’969 patent. Both the ’969 patent and Nike depict a wave-like midsole that compresses and slopes around, and pinches at the midsection. An ordinary observer would have considered them to be substantially the same midsole, because, as shown above, they appear substantially the same. More specifically, the most visually apparent design features to the ordinary observer—the ***three ridged edge***

layers topped with a ***rounded upper layer***—are substantially the same in the Nike and the ’969 patent midsoles, forming the wave-like design.

158. To the extent that Patent Owner argues there are any minor variations (such as the vertically slanted ridge etching through the layers of the midsole, on the medial side), they do not preclude a finding of anticipation because the overall impression created—the wave-like pattern that results from the four features discussed above—remains equivalent between Nike and the ’969 patent**.**

159. Thus, considering the overall claimed midsole design of the ’969 patent and the overall midsole design of Nike, an ordinary observer would have been induced to purchase one supposing it to be the other**.** As a result, the ’969 patent claim is anticipated by Nike.

6. GROUND 6: The ’969 Patent is Obvious Over Nike

160. Nike is so substantially the same as the claimed design that no secondary reference is necessary (*see* Ground 5).

161. However, to the extent Patent Owner argues that Nike is materially different, the claim of the ’969 patent is obvious over Nike.

162. *Scope and content of the prior art:* Nike is a suitable primary reference as it is visually similar to the ‘969 patent (*see* Ground 5). Nike was something in existence, and is visually similar to the ’969 patent. The scope

and content of Nike, considered with the knowledge of a designer of ordinary skill in the art (as defined in Section VI), is the same as the ’969 patent: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched mid section.

163. *Differences between the claimed invention and the prior art*: To the extent there are any differences between Nike and the claimed design, Nike itself readily suggests those differences to a designer of ordinary skill in the art. For instance, to the extent Patent Owner argues that the ’969 patent requires a slightly greater or smaller degree of sloping and curvature in the ridged edge and top layer, a designer of ordinary skill in the art would have found it obvious to ever so slightly vary the degree of sloping and resulting change of curvature of the layers of the midsole. Further, such small variations of curvature would have been obvious to the designer of ordinary skill in the art as they would have been purely functional, rather than ornamental, in order to accommodate different types of feet. For example, for a shoe with a curvier bottom sole, the midsole would have to match and thus be curvier, in order to fit atop the bottom sole. And such a curvier sole was already well-known. *See, e.g.* Exs. 1026 (EUIPO patent showing a curvy midsole); 1027 (Chinese patent showing a curvy midsole). Additionally, a designer of ordinary skill in the art would have understood that pairing the midsole with a shoe with a higher or lower heel

(internal or external) would have required the design to slope and curve more or less. As discussed above, this is to ensure that the midsole and bottom sole meet without gaps.

164. Even if that were not the case, however, a designer of ordinary skill in the art would have found slightly changing the sloping of the midsole to be trivial. A designer of ordinary skill in the art would have had the common knowledge and skill to understand that any given shoe midsole could be easily modified to be ever so slightly curvier or flatter, while still maintaining the same overall wave-like visual impression. For example, shoes with higher heels were well-known at the time, and such higher heels would, accordingly, have curvier soles.

165. *Level of skill in the art: See* Section VI.

166. *Secondary considerations: See* Section X.

167. Thus, a designer of ordinary skill in the art would have understood Nike to be visually similar to the ’969 patent, depicting a similar wave-like design. In view of the above, the claim is obvious in view of Nike.

7. GROUNDS 7 & 8: The ’969 Patent is Obvious Over C11947 and Nike (Ground 7), and Over C12652 and Nike (Ground 8)

168. To the extent that Patent Owner argues that Figure 4 of the ’969 patent requires an overhang of the midsection over the bottom sole, I understand that Petitioners submit that the claimed design is obvious without

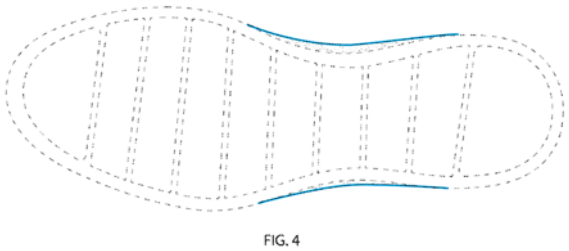
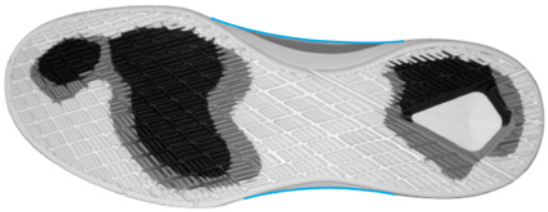
reference to a secondary reference (*see* Grounds 2 and 4). I understand that Petitioners also maintain that a mere sizing of the midsole in relation to the bottom sole is (1) not claimed because the bottom sole is disclaimed, and otherwise (2) not patentable because it is entirely functional in nature.

169. C11947 and C12652's midsoles each disclose substantially the same design claimed in the '969 patent: one consisting of the same four features described in claim construction, together, to create substantially the same overall wave-like, flowing design. Indeed, C11947 and C12652 are so similar to the claimed design that no secondary reference is necessary (*see* Grounds 1-4).

170. However, to the extent Patent Owner argues that C11947 or C12652 is materially different, the claim of the '969 patent is obvious over C11947 in view of Nike, and obvious over C12652 in view of Nike:

171. *Scope and content of the prior art:* C11947 and C12652 are suitable primary references as described in Grounds 2 and 4.

172. *Differences between the claimed invention and the prior art*: To the extent that Patent Owner argues that C11947 or C12652 does not disclose an overhang of the midsection over the bottom sole, Nike renders obvious an overhanging midsole visually similar to the claimed design. As shown below, Nike discloses a widened midsole relative to the bottom sole:

’969 patent	Nike
	

Exs.1001, 1012.

173. Nike’s overhanging mid-section, as shown in the bottom view, is substantially the same as the ’969 patent. Thus, to the extent Patent Owner argues that C11947 or C12652 lacks disclosure of an overhanging mid-section and thereby does not render the claimed design obvious (despite the aforementioned unclaimed portions, and obviousness as explained in Grounds 2 and 4), it further would have been obvious to implement an overhanging mid section of the midsole in view of Nike.

174. A designer of ordinary skill in the art would have found it obvious to vary the width of the midsection of the midsole in C11947 or C12652 in view of Nike because that would have been purely functional, rather than ornamental, as stated in Ground 6. See my discussion in Ground 6.

175. Further, a designer of ordinary skill in the art would have been aware of Nike and found it obvious to vary the width of the midsection of the midsoles in C11947 or C12652 in view of Nike**,** because the shoe manufacturer Nike was famous, and well-known for making shoes. Although an overhanging

midsole is a functional feature (*see* Ground 2), at a minimum, such an overhang would have been obvious to try because there are only three options regarding midsole size relative to sole, each of which are predictable: a midsole that is the (1) same size as the sole, (2) smaller than the sole, or (3) larger than the sole. Choosing a larger sole would advantageously hide the tread of the shoe, making the design of the midsole more apparent within the shoe. Designing the midsole of the shoe to have a width wider than the bottom sole to match the arching natural foot shape was a simple design choice that involved no more than a mere substitution of one known element for another (i.e., substituting one size of midsole for another). Implementing C11947's or C12652's midsole with Nike's overhang would have been beneficial in designing a midsole such that the design would be more prevalent in the overall shoe, and advantageously hides the tread on the sole and increases stability. This would have been a desirable option so that the wave-like design of the midsole could be more noticeable on the shoe, creating a sense of depth in the shoe. More surface area would be covered by the design. A designer of ordinary skill in the art would have been motivated to apply Nike's overhang to C11947's or C12652's midsole to create a design that stood out within the greater shoe, and thus more distinctive to the consumer. *See, e.g.*, Ex. 1021 ("If we can smell, see, hear, or decide something faster or with less effort, we will

prefer it over the more demanding alternative. This is summarized in the principle of maximum effect for minimum means…[A] visual pattern is pleasing to the eye when relatively simple design features reveal a wealth of information, such as in caricatures or impressionistic paintings.") With more surface area covered by the simple wave-like design, the visual pattern would be more pleasing, as a shoe that is providing maximum effect for minimal means.

176. Such a change would have been predictable and obvious. Indeed, there is nothing unpredictable or nonobvious about designing a midsole to overhang the bottom sole because such a change would increase the visibility of the design in the greater shoe.

177. Further, to the extent that Patent Owner argues that C11947 or C12652 does not have a ***rounded upper layer***, Nike renders obvious a ***rounded upper layer*** of a midsole visually similar to the claimed design, as shown in Ground 5. *See* Ground 5. Nike's ***rounded upper layer*** is substantially the same as the '969 patent. Thus, to the extent Patent Owner argues that C11947 alone or C12652 alone do not render the claimed design obvious due to differences in the upper layer, it would have been obvious to implement an even rounder top layer as disclosed by Nike when implementing the midsole of C11947 or C12652.

178. A designer of ordinary skill in the art would have found it obvious to smooth the upper layer of the midsole in C11947 or C12652 in view of Nike because the upper layers in C11947 and C12652 were already slightly rounded, and making either rounder would soften the meeting of the rubber and cork material, much like Nike's upper layer appears a cohesive part of the midsole.

179. Even if that were not the case, however, a designer of ordinary skill in the art would have been aware of Nike and found it obvious to vary the degree of rounding of the upper layer of the midsoles in C11947 or C12652 in view of Nike, at least because the shoe manufacturer Nike was famous, as described above.

180. Implementing the midsole of C11947 or C12652 with Nike's teaching of an even rounder ***upper layer*** would have beneficial in designing a midsole such that the upper layer met the ridged layers in a more cohesive appearance. This would have been a desirable option so that the wave-like design of the midsole was less interrupted, and more uniform. Furthermore, a designer of ordinary skill in the art would be motivated to modify C11947 or C12652 as taught by Nike by removing the leather welt and bonding the midsole directly to the upper to create a more continuous aesthetic, and doing so would also reduce a step in the manufacturing process, making the shoe less expensive to produce. The expense of shoe manufacturing is a consideration

in shoe design to the designer of ordinary skill in the art. In addition, a designer of ordinary skill in the art would have been motivated to apply Nike's teaching of an overhang to C11947's midsole or to C12652's midsole to create a design that was more cohesive.

181. Such a change would have been predictable and obvious because it is just a change in arrangement and proportioning of features. Indeed, there is nothing unpredictable or nonobvious about designing a midsole to have a more curvy upper layer because such a change would soften the meeting of different midsole materials, and thus make the overall design more cohesive.

182. The resulting midsoles would continue to have the ***three ridged edge layers, rounded upper layer, compressions,*** and ***pinching*** in middle as disclosed in C11947 and C12652, appropriately overhanging in the mid section. The resulting midsoles would have had the same overall visual appearance as the claimed midsole.

183. To the extent Patent Owner alleges there are any other differences when compared to the claimed design, C11947 or C12652, each in view of Nike, readily suggests those differences to a designer of ordinary skill in the art.

184. *Level of skill in the art: See* Section VI.

185. *Secondary considerations: See* Section X.

186. Thus, a designer of ordinary skill in the art would have understood the designs to be visually similar, depicting a similar wave-like design. In view of the above, the claim is obvious based on C11947 in view of Nike and C12652 in view of Nike.

8. GROUND 9: The ’969 Patent is Obvious Over Skechers in view of Nike

a. Publication of Skechers

187. Skechers (Ex. 1016) is a webpage that was publicly available on Dappered.com since at least July 14, 2013.. Further, the website indicates that the article was posted on 7/10/2013, at least one year before the earliest priority date of the ‘969 patent. The latest archive date of the Skechers publication is July 14, 2013, more than one year before the earliest priority date of the ‘969 patent. Ex.1016, Page 4 (containing URL date code 20130714), Page 5. Embedded within the Skechers webpage are high resolution images which appear at Ex.1016, Pages 176-179. The images at Ex.1016, Pages 176-179 are reproduced as Ex.1017.

188. Dappered.com was well-known, public (e.g., no access restrictions), searchable, and intended to reach a wide audience. A designer of ordinary skill in the art would have known about and readily located information on this website with reasonable diligence. Based on this evidence taken as a whole, the Skechers publication was publicly available by at least

July 14, 2013, or as being otherwise available to the public. The Examiner never found, and Applicant never cited, the Skechers publication during prosecution.

b. Overview of Skechers

189. The Skechers publication provides multiple images to show different views of the Skechers design:

Perspective View
Lateral Side Elevational View

Bottom Plan View

Front Elevational View

Ex.1017

190. The Skechers publication discloses a design of a shoe midsole with most of the features of the ‘969 patent:

- ***Three vertically stacked ridged edge layers*** which extend continuously from the heel section to the toe section;
- 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***; and
- A ***rounded upper layer***, more rounded than the ridged edge layers that it sits atop.

c. Analysis

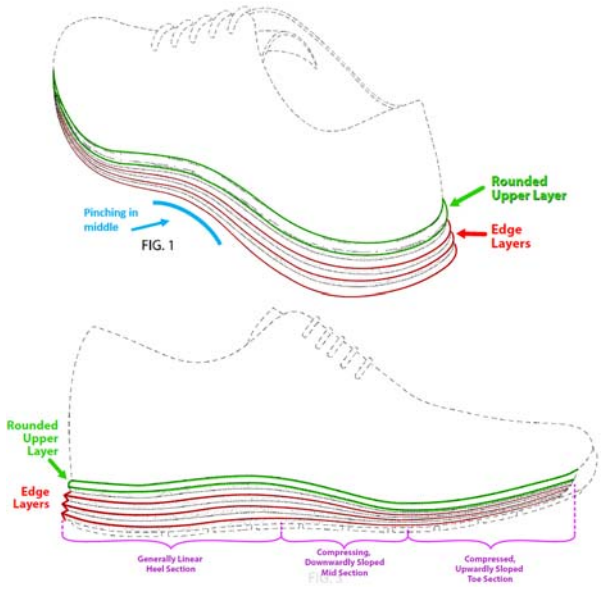
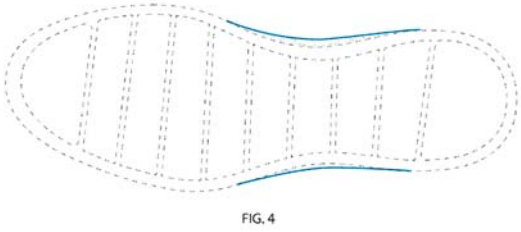
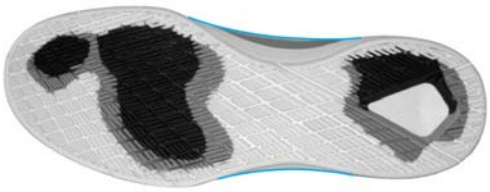
191. Skechers was something in existence, and is visually similar to the ’969 patent.

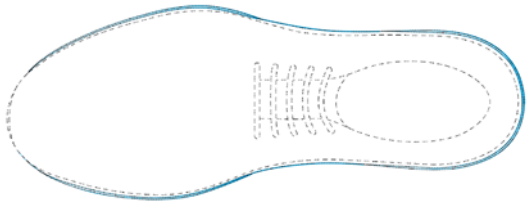
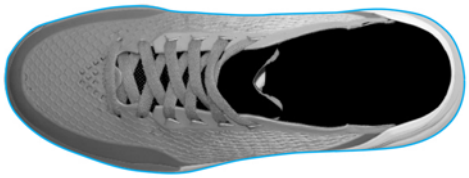
192. *Scope and content of the prior art:* Skechers is a suitable primary reference as it is visually similar to the ’969 patent (see images below). Skechers was something in existence, and is visually similar to the ’969 patent. The scope and content of the Skechers, considered with the knowledge of a designer of ordinary skill in the art (as defined in Section VI), is the same as the ’969 patent: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched mid section.

193. *Differences between the claimed invention and the prior art*: To the extent a secondary reference is needed to account for the absent explicit

image of the bottom sole of Skechers, and to the extent Patent Owner argues that Skechers' bottom view is not readily apparent to a designer of ordinary skill in the art given the other images, Nike's midsole renders obvious such a midsole bottom.

194. As shown below, **Skechers'** midsole consists of ***three ridged edge layers***, a ***rounded upper layer***, and a ***compression pattern*** substantially the same as the '969 patent.

The '969 Patent	**Skechers and Nike**
	 Skechers, Perspective View
	 Nike, Bottom View

 FIG. 5	 Nike, Top View

Exs.1001, 1012.

195. Thus, to the extent Patent Owner argues that Skechers does not render the claimed design obvious because of the lack of clear bottom view, it would have been obvious to implement a midsole with the Nike design depicted in the bottom view, substantially the same as the ‘969 patent. A designer of ordinary skill in the art would have been aware of Nike and found it obvious to implement the bottom of Nike’s midsole, pinching in the mid section, in view of Skechers, at least because Nike was an international brand known for making shoes. Although an overhanging midsole is purely functional (see Ground 2), at a minimum, implementing Nike’s bottom view design when implementing Skechers’ midsole would have been obvious to try, as Nike’s bottom sole follows the natural shape of an anatomical foot, the body part that will be making contact with the midsole. Designing the midsole of the shoe to follow the shape of a natural foot has a discrete number of known and predictable options which allow the overall shoe to go on said foot. Implementing the Skechers midsole with the bottom plane of Nike would have been beneficial in designing a shoe for an anatomical human foot. An overhang

would have been obvious to try because there are only three options regarding midsole size relative to sole, which are each predictable: a midsole that is the (1) same size as the sole, (2) smaller than the sole, or (3) larger than the sole. Choosing a larger sole would advantageously hide the tread of the shoe, making the design of the midsole more apparent within the shoe.

196. Such a change would have been predictable and obvious because it is just a change in arrangement and proportioning of features. Indeed, there is nothing unpredictable or nonobvious about a midsole that is wider towards the toe region, and pinches in the middle near the foot arch.

197. To the extent a secondary reference is needed because Patent Owner argues that Skechers' upper layer is not as rounded as the '969 patent, Nike's midsole renders obvious such a rounded upper layer of a midsole. As stated in Ground 5, Nike discloses a ***rounded upper layer***.

198. Thus, to the extent Patent Owner argues that Skechers does not render the claimed design obvious because of a less rounded upper layer, it would have been obvious to implement a midsole with the Nike design, resulting in substantially the same design as the '969 patent. A designer of ordinary skill in the art would have found it obvious to implement the rounded upper layer of Nike's midsole, in view of Skechers**,** at least because Nike was an international brand known for making shoes. At a minimum, implementing

Nike's upper layer design to Skechers' midsole would have been obvious, as Skechers' upper layer is already rounded to some degree. Designing the upper layer with a more pronounced rounding is beneficial in order to create a cohesive appearance in the different materials meeting at that point. Implementing Skechers midsole with the ***rounded upper layer*** of Nike would have been beneficial in creating a more cohesive design.

199. Such a change would have been predictable and obvious because it is just a change in arrangement and proportioning of features. Indeed, there is nothing unpredictable or nonobvious about varying the degree of rounding in a rounded upper layer of a midsole.

200. The resulting midsole would have the ***three ridged edge layers,*** a ***rounded upper layer***, and ***compressions*** of Skechers, with a more ***rounded upper layer*** as disclosed in Nike. The resulting midsole would have been the same overall visual appearance to the claimed midsole.

201. To the extent Patent Owner alleges there are any other differences when compared to the claimed design, Nike and Skechers readily suggest those differences to one of ordinary skill in the art, and any differences are just arrangement and proportioning of features.

202. *Level of skill in the art: See* Section VI.

203. *Secondary considerations: See* Section X.

204. Thus, a designer of ordinary skill in the art would have understood Skechers in view of Nike to be visually similar, depicting a similar wave-like design of a midsole, with the bottom shaped like an anatomical foot. In view of the above, the claim is obvious over Skechers in view of Nike.

205. Thus, Skechers in view of Nike render claim one obvious.

X. SECONDARY CONSIDERATIONS

206. There is no evidence in the ’969 patent’s prosecution history or elsewhere supporting any secondary considerations arguments, or evidence of nexus to any challenged Claim.

207. To the extent that Patent Owner contends that the accused products in the NJ Case are infringing and thus demonstrate commercial success, any such conclusory allegations would fail to provide any indication that the Claim is non-obvious. Such conclusory assertions would not demonstrate that Top Glory’s products infringe, let alone show any nexus between any alleged commercial success and the Claim, or that any alleged success is due to the allegedly claimed design instead of the many unclaimed features of the accused products.

208. To the extent Patent Owner asserts the existence of any secondary considerations in its responses, I reserve the right to address any such evidence.

XI. CONCLUSION

209. In summary, I have concluded that the claimed design is anticipated by and rendered obvious over the prior art references as I have discussed above. Specifically, in my opinion, for at least the reasons above, the claimed design of the ’969 patent is anticipated and obvious.

210. To the extent it is argued that any further disclosure is required for an element in the claimed design that I have identified as being disclosed, a person of ordinary skill in the art would certainly have found that element obvious to include based on the sample explicit disclosure or inherent disclosures and analysis I have identified above.

211. I reserve the right to supplement my opinions in the future to respond to any arguments that Patent Owner or its expert(s) may raise and to take into account new information as it becomes available to me.

212. In signing this declaration, I recognize that the declaration will be filed as evidence in a contested case before the Patent Trial and Appeal Board of the United States Patent and Trademark Office. I also recognize that I may be subject to cross-examination in the case and that cross-examination will take place within the United States. If cross-examination is required of me, I will appear for cross-examination within the United States during the time allotted for cross-examination.

213. I hereby declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

214. Executed this 9th day of September 2025, in Salt Lake City, Utah.

Grant Delgatty

APPENDIX A (CURRICULUM VITAE)

Grant Delgatty
3414 Fairesta Street
Glendale, CA 91214
g.delgatty@gmail.com
818.378.2736 I m

Curriculum Vitae

Experience:	Responsibilities / Achievements:
University of Southern California Iovine and Young Academy Chair of Product Innovation Associate Professor of Practice (Jan. 2018 - present)	- As department Chair, I helped develop and champion the curriculum for the IYA Master's of Product Innovation (MSPRIN) at the USC Jimmy Iovine and Andre (Dr Dre) Young Academy - Developed syllabi for Product Design I, II, and III (IYA undergrad) - Teach a range of courses including Designing Products 1, 2, and 3, Maker Studio, GX, Industry Practicum Residential - Developed syllabi and teach Foundation Studio and Creator Studio (MSPRIN) - Faculty lead on several industry and impact lab projects with clients including adidas, VW Audi, Samsung, Vans, imagination.org, Ellison Institute, NASA - Lead a team of students competing in an adidas international design competition against other universities - Our team took first place with the prize being an all expense paid team trip to adidas HQ in Herzogenaurach, Germany - Advisor for new building facility build-out
Urban626 LLC (URB-E) Co-founder / CCO Pasadena, CA (Apr. 2015 - Aug. 2018)	- Egological Inc. acquired by Urban626 LLC in 2015 - Shifted responsibilities from CEO to CCO to focus my efforts on new product R&D - Designed, developed and patented the URB-E Classic, URB-E Pro, URB-E Sport, URB-E Trailer, Eddy Portable Battery, URB-E Locking Rack, ECV (Electric Convenience Vehicle) - Designed and developed product packaging - Oversaw retail and office headquarter design - Inventor of 15 registered utility and design patents - More than 10,000 units sold in every US state and shipped to 40 countries worldwide
Egological Mobility Solutions Inc. (URB-E) Founder / CEO Pasadena, CA (Jan. 2013 - Apr. 2015)	- Founded URB-E personal electric folding vehicles to address 'last mile' transportation for urban commuting - Became the original electric scooter years prior to the global phenomenon of electric scooter share companies such as Bird and Lime - Responsible for inventing and designing the personal folding electric vehicle, URB-E - Created the most successful 'transportation device' crowd-funding campaign at the time on indiegogo.com, successfully raising $317,000 in pre-orders
ideapiphany LLC Co-founder / Solutionist Pasadena, CA (May 2011 - Apr. 2013)	- Co-founded this open innovation design firm - Business model was to develop game-changing innovations resulting in new ventures, licensing opportunities and discovering new technologies for commercialization - Responsible for inventing and designing a multitude of product innovations within multiple categories including footwear technology, household products, wind energy, health and wellness, furniture, lighting, sporting goods, and food preparation
Urshuz Inc. Founder / CCO Montreal, Canada (Pasadena office) (June. 2008 - May 2011)	- Founded this sustainable shoe company based on a revolutionary shoe technology I invented, of which the shoe upper and sole unit are attached with an elastic mechanical connection rather than the traditional method of bonding, allowing the consumer to customize their shoes at the retail level, as well as being able to recycle the soles - Responsible for inventing the concept, all product design, branding, and packaging - Granted utility patents in more than 30 countries

Experience (cont):	Responsibilities / Achievements:
ArtCenter College of Design Adjunct Instructor - Industrial Design Pasadena, CA (Sept. 2007 - Sept. 2018)	Courses taught include: - **Shoe Design** (4 years - ArtCenter at Night public programs) - developed curriculum to educate students in the entire process of designing and developing athletic footwear (topics covered: shoe design aesthetic, pattern making, last design, manufacturing, sole construction methodologies, cushioning technologies, material innovation, durability and abrasion resistance.) - **Product Design 8** (senior capstone project - taught for 21 semesters) - **Product Design 4** (4th term Product - deep dive into the consumer product design process with a heavy emphasis on human centered design methodology, prototyping, functionality and engineering) - **Product Design 1** (1st term Product - introductory course on the principles of product design and how to identify product opportunities within a specific product category) - **Mobility Design** (5th term Transportation - automotive corporation sponsored projects focused on alternative modalities of transportation) - **Unattended Retail Design** (5th - 7th term Environmental - course focused on designing the future of vending and AI activated retail environments) - **Rapid Problem Solving: The Art of Invention** (ArtCenter at Night public programs - developed the curriculum to educate students how to quickly identify problems and product opportunities, and create rapid solutions through ideation and low fidelity prototypes) - **TDS (Trans Disciplinary Studio)** - Co-taught several corporate sponsored TDS studio projects for companies including General Motors, Honda, Piaggio, Ford, Nestle, Purina, Boeing, Cailler, Johnson and Johnson, and the Nevada Gaming Counsel - **PACE International Design Competition** - lead faculty for three consecutive terms - competed with 18 other design schools around the world to create a last mile vehicle solution. Our team of 4 students took first place with the project titled CUBO
Vans, a VF Company Senior Director, Product Design Cypress, CA (Jan. 2001- Jan. 2008)	- Managed a team of 5 Designers, 6 Senior Designers, and 1 Design Director - Responsible for overseeing design for all nine product categories in the Vans portfolio including core, mainstream, lifestyle, girls, kids, snowboard boots, Syndicate, Agency branded bindings, and ProTec branded helmets and protective gear - Key influencer in overall brand identity and strategic thinking (i.e.- instrumental in determining the current Vans logo strategy, developing a new design concept for Vans retail, determining a new direction for the Vans trade show booth, working with sales to implement a 'channel of distribution' product / sales segmentation strategy, designing in-store p.o.p., and creating company growth opportunities by initiating new product categories) - Conceived, developed and designed a patented removable vamp technology - Helped grow yearly revenue from $200MM to $1B in 7 years
Podium Distribution Inc. **DVS / Lakai** Director of Design / Development Torrance, CA (Mar. 1998 - July 1999 - E-West) (July 1999 - Dec. 2000 - Podium)	- Original designer for this start-up performance skate shoe company - Responsible for overseeing design and development for two different shoe brands - Hired and managed a team of 6 footwear designers - Designed and developed many innovative technologies to address performance opportunities for professional skateboarders - innovations included DIMS (Drop In Midsole) sockliner embedded airbag cushioning technology, Shockpad - mechanically articulated shock absorption insert, DLS (Dual Lacing System) alternative protective lacing for abrasion resistance, and Duratec - reinforced toe cap durability protection - Helped conceptualize the brand identity / logo system for Lakai Footwear - Designed the interior space for the 120,000 sq/ft Podium Distribution headquarter offices - Conceptualized and design directed the Podium Distribution trade show booth - Helped grow yearly revenue from $0 to $70MM in 3 years

Experience (cont):	Responsibilities / Achievements:
E-West Design Inc. Footwear Designer Valley Village, CA (Oct. 1996 - July 1999)	- E-West was an R&D and sourcing design agency specializing in athletic footwear - Worked for and mentored by the infamous Bill Peterson, long time footwear designer and developer for Nike (originally Blue Ribbon Sports) whose accolades include designing and developing many innovative performance footwear technologies, including developing a commercially viable solution for the Nike Air airbag technology - Maintained the only employee design position of this consulting firm, with the last year being solely dedicated to DVS - Spent months overseas in Taiwan, Korea, and China working directly with factories to develop innovative manufacturing processes - Handled design projects for a number of different shoe companies including Puma, Avia, Tretorn, Vans, Converse, Perry Ellis, Nautica, 26 Red, Amp-Tek, Dunk.net, Spank, and DVS - Helped develop many technology innovations including an internal harness support system for Vans step-in snowboard boots, multiple cushioning technologies for DVS, a protective lacing system for the 26 Red Jason Ellis signature shoe, a removable weight system for AmpTek training shoes, and multiple variations of the Avia Cantilever System - Credited for winning the challenge between several design firms to design Puma's 50th anniversary basketball shoe, the "Cell Five-O"
Stuart Karten Design Designer Marina Del Rey, CA (May 1996 - Oct.1996)	- Worked on a range of design projects including furniture, computer accessory products, interior spatial design, children's toys, signage, and trade show display systems - Designed and fabricated custom desks, workstations, and a divider wall system for the studio that stayed in commission for more than 20 years prior to the studio eventually moving locations
K-Swiss Inc. Footwear Designer Chatsworth, CA (Dec.1995 - Apr.1996)	- Hired as an entry-level shoe designer upon graduation from ArtCenter where I began to learn the process of designing and developing performance athletic footwear - Developed my first commercially available product which performed quite well in the market - Left due to the position only being part-time
Design Works Designer Vancouver, Canada (June 1991- Aug.1992)	- Prior to attending ArtCenter College of Design, I worked as a graphics and signage designer for one of the largest and most reputable design agencies in Vancouver BC - Worked on three separate signage projects that received 1st, 2nd, and 3rd place out of hundreds of entries in a prestigious national signage design contest
M5 Design Group Design Intern Vancouver, Canada (May 1990 - Aug. 1990)	- Worked as a summer intern between my 2nd and 3rd year of college - Designed the logo / identity for the 1990 "Vancouver Golf Show"

Education:

Art Center College of Design, Pasadena, CA
Bachelor of Science, Industrial Design (1992-1995)

Capilano College, Vancouver, Canada
Diploma, Graphic Design and Illustration (1988-1991)

Patents Named Inventor:

- "Foldable electric vehicle" - U.S. Patent No. US9694868B2
- "Motorized scooter" - U.S. Patent No. USD746924S1
- "Foldable electric vehicle" - U.S. Patent No. US9873476B2
- "Motorized scooter" - U.S. Patent No. USD750711S1
- "Motorized scooter" - U.S. Patent No. USD827035S1
- "Attachment system for shoe uppers" - U.S. Patent No. US8307570B2
- "Convertible scooter" - U.S. Patent No. US10654541B2
- "Shoe with removable vamp" - U.S. Patent No. US20040194349A1
- "Portable and convertible rechargeable battery power supply" - U.S. Patent No. US10363829B2
- "Convertible Scooter and Handcart" - U.S. Patent No. US20180015978A1
- "Motorized scooter" - U.S. Patent No. USD832150S1
- "Portable rechargeable battery" - U.S. Patent No. USD820201S1
- "Portable elastic pill container" - U.S. Patent No. US20130206801A1
- "Compactible wagon" - U.S. Patent No. US20200031377A1
- "Electric convenience vehicle" - U.S. Patent No. USD842169S1
- "Compact electric convenience vehicle" - Worldwide Patent No. WO2019032566A1
- "Compactible Scooter with Tensioned Body" - U.S. Patent No. US20190202519A1
- "Vehicle systems and methods" - U.S. Patent No. US20210070339A1
- "Trottinette pliante" - Worldwide Patent No. WO2019033015A1

Expert Witness Experience:

- Nike, Inc. v. Skechers U.S.A., Inc., No. 2:17-cv-08509 (C.D. Cal. filed Jan. 04, 2016)
- Retained by counsel for Defendant Skechers U.S.A., Inc.
- Form of testimony: Declaration and depositions

- Nike, Inc. v. Skechers U.S.A., Inc., No. 2:19-cv-09230 (C.D. Cal. filed Oct. 28, 2019)
- Retained by counsel for Defendant Skechers U.S.A., Inc.
- Form of testimony: Declaration and depositions

- Skechers U.S.A., Inc. v. Nike Inc., No. IPR2021-0159 (P.T.A.B., filed Oct. 30, 2020)
- Retained by counsel for Petitioner Skechers U.S.A., Inc.
- Form of testimony: Declaration and depositions

- Skechers U.S.A., Inc. v. Nike Inc., No. IPR2021-0160 (P.T.A.B., filed Oct. 30, 2020)
- Retained by counsel for Petitioner Skechers U.S.A., Inc.
- Form of testimony: Declaration and depositions

- Crocs, Inc. v. Effervescent, Inc. et al., No. 1:06-cv-00605 (D. Colo. filed Apr. 3, 2006)
- Retained by counsel for Defendant Effervescent, Inc.
- Form of testimony: Depositions and expert reports

Awards / Recognition:

- TOR Rose Parade - Mayor's award, 2023
- TOR Rose Parade - Crown City Innovator award, 2022
- TOR Rose Parade - Bob Hope Humor award, 2020
- Pasadena Magazine - 'The Influential 50', 2020
- SoCalTech50 list of entrepreneurs to watch, 2015
- LA AutoMobility - (URB-E) Top ten automotive start-ups, 2016
- Edison Innovation Awards - Silver, 2016
- Core77 Design Awards - Notable mention, 2016
- SPARK Innovation Awards - Bronze, 2016
- 'The Today Show' - URB-E featured as 'One of the hottest gadgets coming from 2014 CES'
- TechCrunch - Best products of CES list, 2014
- The Verge - Best of CES (personal transportation), 2014, and again in 2017
- CleanTech Open (Nationwide clean-tech start-up competition), Semi-finalist, 2013
- PortTech Open - Winner, most innovative technology, 2013
- Footwear Plus - Actions Sports Design of the Year (Vans) - 2004, 2005, and 2007

Skills:

- Managing and mentoring designers to create fun and creative collaboration environments, while challenging them to achieve their greatest personal potential
- Creating desirable, feasible and viable product solutions by providing innovative and strategic design direction
- Identifying problems / market needs and creating rapid solutions to address opportunities
- Applying human centered design methodology to solving problems, prototype solutions, test and iterate
- Initiating and nurturing cross-departmental communication
- Computer skills (Adobe CS, Keynote, Excel, MS Word, PowerPoint, Shapr3D, Procreate, SolidWorks, Gravity Sketch, iMovie)
- Conceptual sketching, ideation and visual communication
- 3D modeling and physical fabrication in metal/welding, plastics, foam, fiberglass, clay, fabric/sewing, and wood
- Knowledgable in intellectual property protection strategies

Industry Recognition / Publications:

Innovation Magazine - 'Creating Business-Ready Designers', Winter 2022, pages 60 & 61

https://pasadenamag.com/feature/the-influential-50/

https://www.socaltech.com/announcing_the___4_socaltech___southern_california_s_ones_to_watch/s-0057749.html

https://www.youtube.com/watch?v=uJv2E2_GY8s

http://blogs.artcenter.edu/dottedline/tag/grant-delgatty/

https://iovine-young.usc.edu/people/faculty/Grant-Delgatty_42.html

https://www.youtube.com/watch?v=f2UipbWgFLE

https://techcrunch.com/tag/urb-e/

https://edisonawards.com/winners2016.php

https://www.today.com/tech/hot-gadgets-ces-sleep-system-personal-scooter-high-tech-toothbrush-2D11931589

https://www.businessinsider.com/million-dollar-idea-sneakers-that-come-in-two-interchangeable-parts-2011-3

https://www.complex.com/sneakers/2011/10/urshuz-fall-2011-footwear

https://www.thrillist.com/style/nation/urshuz_online-shops_sneakers_custom_shoes

https://www.prnewswire.com/news-releases/urshuz-your-shoes-your-creation-132909188.html

https://www.sneakerfiles.com/urshuz-interchangeable-shoes/

https://www.trendhunter.com/trends/customized-interchangeable-recycled-urshuzs

https://www.busyboo.com/2011/10/19/urshuz-shoes/

https://www.commarts.com/exhibit/urshuz-shoe-design

https://designtransmitter.wordpress.com/2012/09/22/urshuz-shoes/

https://lifehacker.com/urshuz-is-modular-footwear-that-can-change-from-a-shoe-5923212

http://www.soleredemption.com/urshuz-interchangeable-shoe/

http://shoenista.blogspot.com/2011/10/urshuz-new-eco-friendly-footwear-brand.html

http://environmentalroulette.blogspot.com/2011/06/urshuz-grant-delgatty.html

https://romerobrooks.wordpress.com/2011/09/07/urshuz/

https://lifeedited.com/modular-shoes-make-repair-a-breeze/

https://ecology.md/ru/page/urshuz-obuv-dlja-ljuboj-pogody-video

https://www.ecoticias.com/sostenibilidad/42888/Urshuz-el-calzado-convertiblea-brvbar

https://m.blog.naver.com/PostView.nhn?blogId=napluto&log-No=220639393657&proxyReferer=https:%2F%2Fwww.google.com%2F

APPENDIX B (LIST OF MATERIALS CONSIDERED)

Exhibit	**Description**
1001	U.S. Patent No. D768,969 (“D’969”)
1002	File/Prosecution History of U.S. Application No. 29/542,318 (“D’969FH”)
1004	First Mina Ching Declaration on C11947
1005	Folder 002 to Exhibit B of Ex.1004 (C11947 Video)
1006	Second Mina Ching Declaration on C11947
1007	Image Captures of Ex. 1005
1008	C11947 Screen Capture on July 23, 2025
1009	Recommended Videos on March 3, 2014, Wayback Machine capture
1010	Mina Ching Declaration on C12652
1011	Folders 002-007 to Exhibit B to Ex.1010 (C12652 Images)
1012	Nike EUIPO Design Registration Certificate No. 002413161-0028, Certified Copy
1013	Excerpt of EUIPO REUD Bulletin No. 2014/046, March 10, 2014, Pages 1-2, 383-385
1014	Nike EUIPO Design Registration Application No. 002413161-0028, large-scale images
1015	EUIPO Posting for Nike
1016	Mina Ching Declaration on Skechers
1017	Folders 002-003 to Exhibit B to Ex.1016 (Skechers Images)

1019	J.E. Miller, B.M. Nigg, W. Liu, D.J. Stefanyshyn & M.A. Nurse, Influence of Foot, Leg and Shoe Characteristics on Subjective Comfort, 21 Foot & Ankle Int'l 759, 759–67 (2000).
1020	Steve Gelsi, Striving for Balance, 37 Brandweek, no. 6, Feb. 5, 1996, 17, available on Gale Academic OneFile.
1021	Paul Hekkert, Design Aesthetics: Principles of Pleasure in Design, 48 Psychol. Sci. 157, 163 (2006).
1022	Martyn R. Shorten, Running Shoe Design: Protection and Performance, in *Marathon Medicine* 162, 162–63 (2000).
1023	Amanda Holpuch, Netflix and YouTube Make Up Majority of US Internet Traffic, New Report Shows, Guardian, Nov. 11, 2013.
1024	J. Seabrook, Streaming Dreams, New Yorker, Jan. 8, 2012.
1026	EUIPO Design Patent 002127563-0013
1027	Chinese Design Patent No. 201530359567
1028	Dorothy Koster Washburn & Donald Warren Crowe, *Symmetries of Culture: Theory and Practice of Plane Pattern Analysis* 33–34 (Univ. of Wash. Press 1988).
1029	Zlatina Kazlacheva, Symmetry in Nature and Symmetry in Fashion Design, Econ. Manag. Inf. Technol. EMIT, no. 1, 2013, 267-**276**.