IN THE 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

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Cole Haan Infringement Letter to Top Glory, dated July 19, 2022
2002	Cole Haan – Top Glory Settlement Agreement, dated November 15, 2022
2003	Cole Haan – Top Glory Correspondence, dated September 8, 2023 to January 24, 2024
2004	Complaint for Patent Infringement against operators of wearbreeze.co, filed February 6, 2025
2005	Petitioners' Corporate Disclosure Statement, dated March 14, 2025
2006	Cole Haan's Opposition to Petitioners' Motion to Stay
2007	Bruno Marc sales webpage on Dream Pairs website, available at https://www.dreampairs.com/brand/bruno-marc
2008	Cole Haan's Product Patent webpage, available at https://www.colehaan.com/Patents.html
2009	Declaration of Thomas Linko, dated November 12, 2025
2010	Cole Haan's Product Patent webpage dated August 12, 2019 and Email Confirmation
2011	Cole Haan's Product Patent webpage dated December 16, 2019 and Email Confirmation
2012	Cole Haan's Product Patent webpage dated October 11, 2021 and Email Confirmation
2013	Julie Zerbo, *Protecting Fashion Designs: Not Only "What?" But "Who?"*, 6 Am. U. Bus. L. Rev. 595 (2017)
2014	Cole Haan's About Us webpage, available at https://www.colehaan.com/about-us

Exhibit No.	Description
2015	Lisa Wang, *The Copying of Independent Fashion Designers: Perils and Potential Remedies in a Post-Star Athletica World*, 75 Stan. L. Rev. 979 (2023)
2016	Petitioners' Invalidity Contentions served October 21, 2025
2017	Petitioners' Memorandum in Support of 12(b)(6) Motion to Dismiss
2018	PR Newswire's June 21, 2022, article announcing Miracle Miles Group's closing of Series A funding, available at https://www.prnewswire.com/news-releases/miracle-miles-group-inc-closes-100m-series-to-accelerate-growth-301571802.html
2019	U.S. Patent No. 10,333,768
2020	U.S. Patent No. 10,339,825
2021	U.S. Patent No. 10,475,737
2022	PR Newswire's August 30, 2024, article announcing Bruno Marc's Flex Oxford Collection Launch, available at https://www.prnewswire.com/news-releases/bruno-marc-launches-flex-oxford-collection-mens-oxfords-redefined-with-classic-elegance-and-sneaker-comfort-302234986.html
2023	Cole Haan's Opposition to Petitioners' Motion to Dismiss
2024	Petitioners' Reply in Support of 12(b)(6) Motion to Dismiss
2025	Judge Esther Salas 12(b)(6) Motion to Dismiss Pendency Statistics
2026	U.S. Patent No. 7,347,011 ("Dua'011")
2027	U.S. Patent No. 2,312,078 ("Cranell")
2028	Cole Haan's Men's Stitchlite webpage, available at https://www.colehaan.com/mens-stitchlite
2029	Bruno Marc's KnitFlex Sales webpage, available at https://www.brunomarc.com/search?keyword=knitflex

Exhibit No.	Description
2030	Bruno Marc's MaxFlex Sales webpage, available at https://www.brunomarc.com/search?keyword=maxflex
2031	Dream Pairs' KnitFlex Sales webpage, available at https://www.dreampairs.com/search?keyword=knitflex
2032	Dream Pairs' MaxFlex Sales webpage, available at https://www.dreampairs.com/search?keyword=maxflex
2033	Transcript of C11947 video; Auto-generated captions from YouTube
2034	WIPO Standard ST.9. April 2013 Amendment
2035	U.S. Patent No. D672,123

I. INTRODUCTION

The Board should deny institution of this *inter partes* review ("IPR") of the challenged claim of U.S. Design Patent No. D768,969 S ("D'969") because the Petition fails to demonstrate with a reasonable likelihood that the challenged claim is unpatentable with respect to any ground.

Top Glory Trading Group Inc. and DP Dream Pairs Inc. ("Petitioners") present an inaccurate, incomplete, and piecemeal interpretation of the claimed D'969 design and then, throughout each ground, attack their own self-serving interpretation rather than the design as a whole. D'969 claims a shoe midsole having an overall visual impression that is derived at least in part by its specific shape and unique aesthetics. Rather than addressing the overall visual impression of the claimed design as required under the law, Petitioners focus on generic design concepts in selective one-to-one feature comparisons. In crowded fields like shoe midsoles, where the ordinary observer would be keen on such differences, silence on the distinct visual differences between the claimed design and the asserted references is inappropriate and compels the Director to deny institution of the Petition. Even with Petitioners' selective one-to-one feature comparisons, the claimed design is still distinguishable from the asserted art and compels the Director to deny institution of the Petition.

II. THE D'969 PATENT

A. Overview of D'969

D'969 claims the ornamental design for a shoe midsole as shown in solid lines in Figures 1-7 of the patent. Figures 1 through 7, illustrating the perspective, lateral side elevational, medial side elevational, bottom plan, top plan, front elevational, and rear elevational views, are reproduced below for reference.

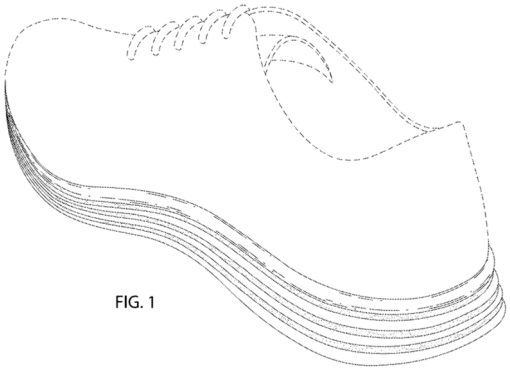


FIG. 1



FIG. 2



FIG. 3

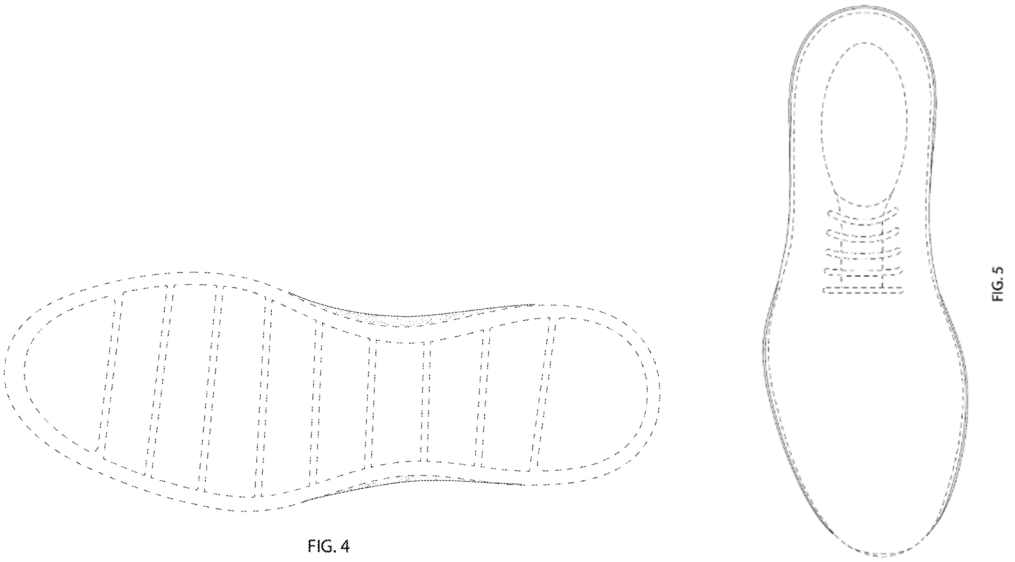


FIG. 4

FIG. 5

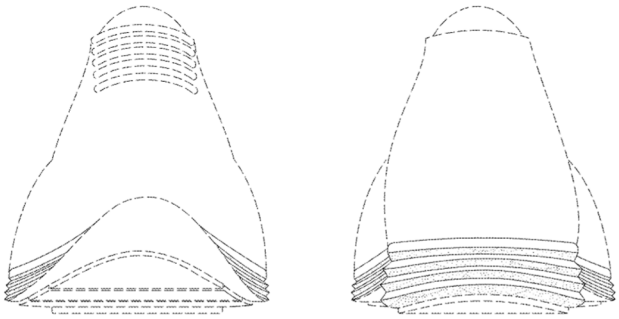


FIG. 6

FIG. 7

EX1001, FIGs 1-7.

B. Prosecution History of D'969

U.S. Patent Application No. 29/542,318 was filed on October 13, 2015, without a claim of priority to any earlier-filed application. EX1002 at 1-3 and 17-18. The Application as originally filed included six drawing sheets with seven total figures.

On March 1, 2016, the U.S. Patent and Trademark Office issued a non-final Office Action rejecting the sole claim of the Application under 35 U.S.C. §§ 112(a)

and (b). EX1002 at 48-54. Along with the rejections, the non-final Office Action stated that "[t]he references cited but not applied, are considered cumulative art related to the claimed design" and that "[f]urther consideration of the references relative to the claimed design will be made upon resolution of the rejection above." EX1002 at 53. The Office Action was accompanied by a PTO-892 form including six (6) total pages listing 69 references and an initialed copy of an Information Disclosure Statement ("IDS") filed on November 4, 2015. EX1002 at 55-63.

A response to the non-final Office Action was submitted on June 1, 2016, including amended Figures 2, 3, and 5-7. EX1002 at 68-79. A second IDS was submitted to the Office on July 19, 2016. EX1002 at 86-91.

The Examiner withdrew all rejections from the prior Office Action and mailed a Notice of Allowance on July 21, 2016. EX1002 at 97-104. A Corrected Notice of Allowability was mailed on August 1, 2016, in response to and including an initialed copy of the Information Disclosure Statement of July 19, 2016. EX1002 at 105-13.

The Application issued as D'969 on October 18, 2016. EX1002 at 120-21.

III. SUMMARY OF THE PETITION'S ASSERTED GROUNDS

The Petition includes nine separate asserted grounds for the challenged claim as summarized in the table below:

Ground	35 U.S.C	Reference(s)
1	§ 102	Cole Haan C11947 ("C11947")
2	§ 103	C11947
3	§ 102	Cole Haan C12652 ("C12652")
4	§ 103	C12652
5	§ 102	Nike, EUIPO Design Registration Application No. 002413161- 0028 ("Nike")
6	§ 103	Nike
7	§ 103	C11947, Nike
8	§ 103	C12652, Nike
9	§ 103	Skechers Embolden Oxfords ("Skechers"), Nike

IV. SUMMARY OF PETITIONER'S ASSERTED ART

A. C11947 (EX1005 to EX1009)

C11947 is a video that was allegedly available on YouTube since at least March 3, 2014, entitled "Quick Look: Cole Haan LunarGrand LongWing – Camello."[1] EX1006 at 5. A transcript of the video is included at Exhibit 2033. An exemplary still photo of C11947 is provided below:

[1] Patent Owner reserves the right to challenge the availability of C11947 as a printed publication within the meaning of 35 U.S.C. § 102.



EX1007 at 21, Capture at 02.26.213.

B. C12652 (EX1010 to EX1011)

C12652 is a webpage that was allegedly available on www.colehaan.com since at least Ju1y 8, 2014, for the LunarGrand Long Wingtip.[2] EX1010 at 5, 10. An exemplary photo of C12652 is provided below:



EX1011 at 12.

[2] Patent Owner reserves the right to challenge the availability of C12652 as a printed publication within the meaning of 35 U.S.C. § 102.

C. Nike (EX1012 to 1015)

Nike is a European Intellectual Property Organization Design Registration, Application No. 002413161, Design No. 002413161-0028, which was published on March 10, 2014.[3] EX1015 at 1. An exemplary photo of Nike is provided below:



EX1012 at 10.

D. Skechers (EX1016 to 1017)

Skechers is a webpage that was allegedly available on Dappered.com since at least July 10, 2013, entitled "Would you wear it? – Lunargrands / Emboldens."[4] EX1016 at 5. An exemplary photo of Skechers is provided below:

[3] Patent Owner reserves the right to challenge the availability of Nike as a printed publication within the meaning of 35 U.S.C. § 102.

[4] Patent Owner reserves the right to challenge the availability of Skechers as a printed publication within the meaning of 35 U.S.C. § 102.



Id.; EX1017 at 2.

V. LEGAL STANDARDS

A. Anticipation

The "ordinary observer" test, as outlined by the Supreme Court in *Gorham*, is the sole test for determining whether a claimed design is anticipated by a prior art reference. *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009) (Federal Circuit confirming "the same tests must be applied to infringement and anticipation, and our holding in *Egyptian Goddess* that the ordinary observer test is the sole test for infringement, we now conclude that the ordinary observer test must logically be the sole test for anticipation as well."); *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871). Anticipation of a design patent requires assessing whether the claimed design and the designs of the asserted prior art are "substantially the same" such that "their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other." *Door-*

Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1313-14 (Fed. Cir. 2001) (citing *Gorham*, 81 U.S. at 528).

The ordinary observer test requires the fact finder to consider all of the ornamental features illustrated in the figures of the challenged patent that are visible at any time in the "normal use" lifetime of the accused product, i.e., "from the completion of manufacture or assembly until the ultimate destruction, loss, or disappearance of the article." *Int'l Seaway*, 589 F.3d at 1241 (citations omitted). Further, the ordinary observer is one who would be familiar with the prior art. *See Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) ("When the differences between the claimed and accused designs are viewed in light of the prior art, the attention of the hypothetical ordinary observer may be drawn to those aspects of the claimed design that differ from the prior art.") (citing *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 681 (Fed. Cir. 2008) (*en banc*)).

Importantly, the ordinary observer test requires "consideration of the design ***as a whole***." *Int'l Seaway*, 589 F.3d at 1243 (emphasis added). The ordinary observer test requires the fact finder to "compar[e] ***similarities in overall designs***, not similarities of ornamental features in isolation." *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F. 3d 1312, 1335 (Fed. Cir. 2015) (emphasis added) (citing to *Richardson v. Stanley Works Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010); *Crocs*, 598 F.3d at 1303-1304). "An ***element-by-element comparison***, untethered from

application of the ordinary observer inquiry to the overall design, is ***procedural error***." *Id.* (emphases added) (citing to *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006)).

B. Obviousness

In *LKQ*, the Federal Circuit adopted the obviousness approach of utility patents as applicable for design patents providing "that the same conditions for patentability that apply to utility patents apply to design patents"—"a more flexible approach than the *Rosen-Durling* test[.]" *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 102 F.4th 1280, 1287 (Fed. Cir. 2024) (*en banc*). The obviousness inquiry asks "whether an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design 'to create the ***same overall visual appearance*** as the claimed design.'" *LKQ*, 102 F.4th at 1299 (emphasis added) (quoting *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021)).

"[T]he focus in a design patent obviousness inquiry should be on visual appearances rather than design concepts." *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 104 (Fed. Cir. 1996) (citing *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993)); *see also LKQ*, 102 F.4th at 1299 (reaffirming that "the [obviousness] inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features.") (citing *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir.

1996)) (internal citations omitted); *see also Campbell Soup*, 10 F.4th at 1275 (discussing whether "an ordinary designer would have modified the primary reference to create a design that has the same overall visual appearance as the claimed design.") (citing *Durling*, 101 F.3d at 103). It is legal error to compare "the visual impression of ***selected, separate features*** of the prior art designs to the [claimed] designs, rather than the visual impression of the designs as a whole." *In re Harvey*, 12 F.3d at 1065 (emphasis added). Furthermore, an analysis focused on assembling design concepts from the prior art in isolation to arrive at the claimed design is improper. *See Premier Gem Corp. v. Wing Yee Gems & Jewellery Ltd.*, IPR2016-00434, Paper 9 at 16-17 (P.T.A.B. July 5, 2016); *see also LKQ*, 102 F.4th at 1298.

C. Claim Construction

Design claims should be construed like claims in an infringement action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b). The scope of the claimed design is represented by the illustrations; verbal descriptions are not required. *Egyptian Goddess*, 543 F.3d at 679 (internal citations omitted). While a detailed verbal description may be "helpful to point out . . . various features of the claimed design as they relate to the . . . prior art," the verbal description must accurately capture the overall visual impression of the claimed design. *Id.* at 680; *cf. Vitro Packaging, LLC v. Saverglass, Inc.*, IPR2015-00947, Paper 13 at 5 (P.T.A.B. Sep. 29, 2015)

(explaining that petitioner's claim construction was inaccurate because "it focuses on general dimensions, ratios, and elements common to many bottles"). "[I]n deciding whether to attempt a verbal description of the claimed design, the [Director] should recognize the risks entailed in such a description, such as the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole." *Egyptian Goddess*, 543 F.3d at 679-80; *see also Crocs*, 598 F.3d at 1302-03 (stating that for design patents, "claim construction must be adapted to a pictorial setting" and warning of "the dangers of reliance on a detailed verbal claim construction.").

D. The Ordinary Observer

Patent Owner does not dispute the Petition's description of an ordinary observer in the art. Petition ("Pet.") at 20-21.

E. The Ordinary Designer

Patent Owner does not dispute Petition's description of a designer of ordinary skill in the art. Pet. at 23-24.

VI. PETITIONERS' IMPROPER CLAIM CONSTRUCTION OF THE D'969 PATENT WARRANTS DENIAL OF INSTITUTION

The Director should deny institution at least because of Petitioners' improper claim construction of D'969. Petitioners ignore, mischaracterize, and reduce numerous visually distinctive features of the claimed design in favor of selective

one-to-one comparisons of certain features of the claimed design and the asserted art, as discussed herein. This claim construction error permeates throughout each of Petitioners' grounds and therefore compels denial of the Petition.

Petitioners acknowledge the Federal Circuit's "preferable course" for constructing design patents does not involve "a detailed verbal description of the claimed design," and Patent Owner agrees. Pet. at 25. Petitioners further highlight that the Federal Circuit has recognized "it is 'helpful to point out…various features of the claimed design as they relate to the accused design and the prior art." Pet. at 25-26 (citing to *Egyptian Goddess*, 543 F.3d at 679-80). However, contrary to *Egyptian Goddess*, Petitioners "cross the line" and improperly provide a detailed verbal description of *their* characterization of the claimed design, which is precisely what *Egyptian Goddess* cautions against. *Egyptian Goddess*, 543 F.3d at 679-80.

In *Egyptian Goddess*, the Federal Circuit provides specific examples of appropriate verbal descriptions in context and notes, "[i]n a case such as this one, for example, there would be nothing wrong with the court pointing out to a jury that in the patented design only three sides have buffers attached, while in the accused product (and in the three-sided Nailco patent), all of the sides have buffers attached" and further explains "[i]t would similarly be permissible for the court to point out that, for example, although the Falley Buffer Block has four sides, it is not hollow,

unlike the design of the '389 patent, the Nailco patent, and the accused Swisa product." *Egyptian Goddess*, 543 F.3d at 680.

Here, contrary to *Egyptian Goddess*, Petitioners do not merely "point out" obvious features of the claimed design as compared to the prior art. Rather, they select four purportedly "key features" of D'969 and then attempt to verbally describe such alleged features over seven pages of the Petition. *See* Pet. 25-31. Not only do the Petitioners' self-imposed boundaries marking the purported "key features" skew the overall visual impression of the claimed design, but Petitioners also ignore the overall visual appearance of the claimed design, as required by the ordinary observer test. Despite initially asserting that "[t]he claimed portions of the seven figures of D'969 give an overall visual impression of a soft, wave-like midsole design,"[5] the rest of the Petition focuses exclusively on Petitioners' four purportedly "key features" of D'969:

> (1) **Ridge Layers**: ***three vertically stacked, ridged-edged layers*** extending continuously from a heel section till the toe section and beyond the lower perimeter of the shoe's sole (Figs. 1-3,6-7);
>
> (2) **Compressions**: a ***generally linear heel section***, a ***downwardly***

[5] Patent Owner does not adopt or otherwise concede to the Petition's overall visual description of D'969 as "a soft, wave-like midsole design."

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);

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

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

See id. at 25-26. Petitioners go even further, distorting and modifying the D'969 figures with these four selective "key features" in different colors:

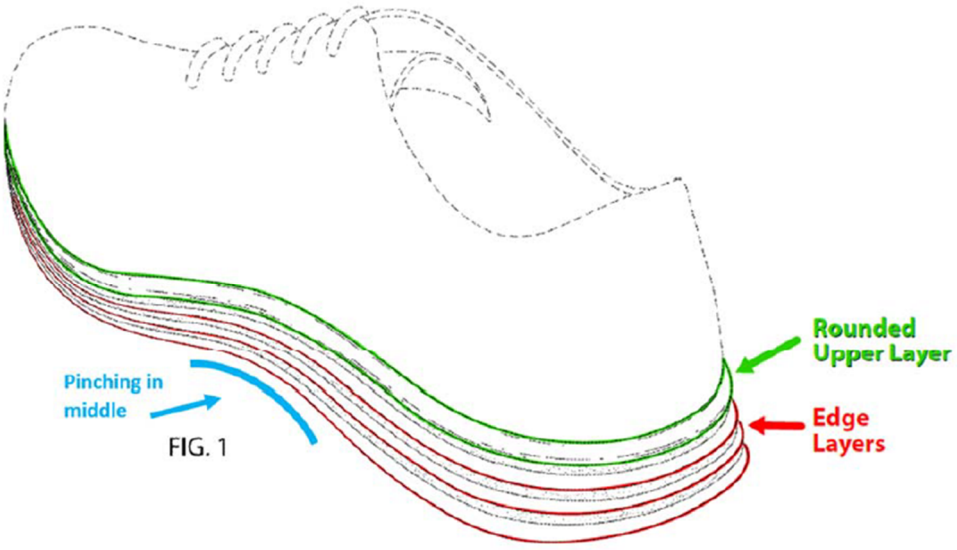
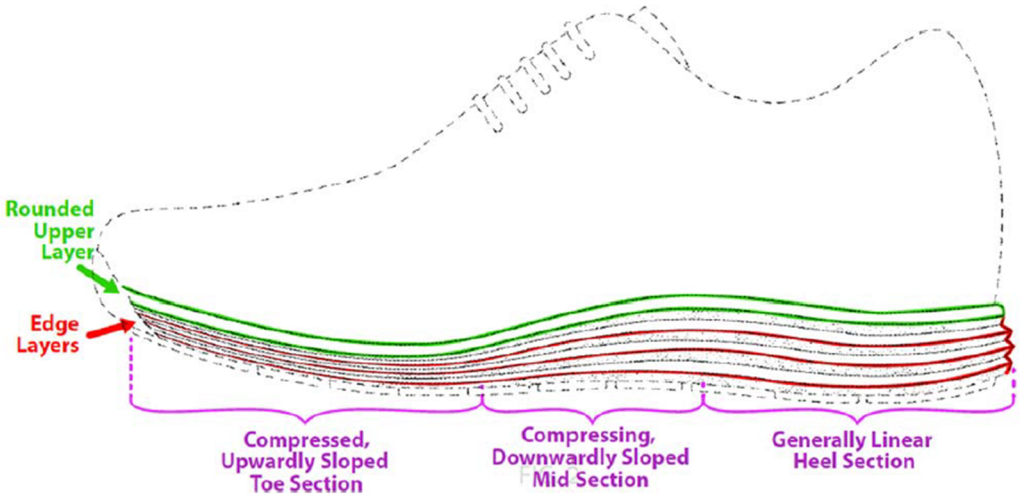


FIG. 1



Id. at 27-28 (citing EX1003, ¶¶ 67, 68).

By adding different color schemes and oversimplified verbal descriptions of isolated features, Petitioners attempt to segment the midsole into their four selective "key features" in isolation, rather than appreciating the design as a whole. For example, as shown in the annotated Figures 1 and 2 above, Petitioners divide the midsole into a green demarcation representing a "rounded upper layer" and in red

demarcations to represent "three ridged edge layers." In another example, as shown in the annotated Figure 2 above, Petitioners divide the midsole into three arbitrary, Petitioners-designated regions in purple color and inaccurately label such regions into self-serving verbal descriptions that do not align with the claimed subject matter.

But the presentation of Petitioners' four selective "key features" highlighted in different color schemes inappropriately creates a disjointed visual impression for the observer. And there is no basis for Petitioners' divisions or verbal descriptions either. For example, Petitioners' labeling of the midsole as having a "heel section" that is "*generally* linear" (*e.g.*, Pet. 1, 10) inherently evidences the unavailability of appropriate words to describe the midsole and imparts a suggestive curvature or lack thereof to a portion of the midsole, ignoring the overall visual impression of the midsole.

Petitioners' selective bracketing, arbitrary color demarcations, and inaccurate verbal descriptions skew the overall visual impression of the claimed design into Petitioners-selected subparts instead of evaluating the midsole as a cohesive unit as the ordinary observer should. They further ignore, mischaracterize, and downplay numerous visually distinctive features of the claimed design. As further described and highlighted below, this error permeates throughout Petitioners' grounds. Accordingly, the Petition is fundamentally flawed because the grounds fail to consider the overall visual appearance of the claimed design, and the Director should

deny institution of the Petition at least because of Petitioners' improper claim construction of the D'969 design.

VII. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY GROUND

The Director should further deny institution because Petitioners fail to demonstrate a reasonable likelihood that the challenged claim is anticipated by or would have been obvious in view of any of the asserted art, as discussed with respect to each ground below.

A. Petitioners fail to establish a reasonable likelihood that C11947 anticipates the claimed design. [Ground 1]

i. Petitioners' "key feature" approach improperly ignores differences in the overall visual impression of D'969.

Despite alleging that "C11947 discloses a design of a shoe midsole with ***all*** features of D'969," *see* Pet. at 39 (emphasis added), Petitioners do not compare the similarities of the overall designs as a whole, as required under the law. Instead, Petitioners advance only a limited element-by-element comparison of C11947 and the D'969 design. Specifically, Petitioners present four claim charts, one for each of four "key features"—(1) the "Ridge Layers," (2) "Compressions," (3) "Rounded Upper Layer," and the (4) "Pinched Mid-Section." Pet. at 39-47. Then, Petitioners, without support, equate the limited number of generically described "***key*** features" with "***all*** the features" of the claimed design. *See* Pet. at 47 ("The four features

(above) in C11947 come together as a whole as substantially the same claim in D'969.").

This analysis overlooks identifiable aspects of the claimed design whose appearance clearly differs between D'969 and C11947. "In satisfying the requirements of 37 C.F.R. § 42.104(b), a challenger of a design patent cannot simply ignore the differences in designs without discussing how those differences would impact the ordinary observer analysis, if at all." *Macsports, Inc. v. Idea Nuevo, Inc.*, IPR2018-01006, Paper 6 at 13 (P.T.A.B. Nov. 13, 2018). Such an error amounts to a failure to demonstrate a reasonable likelihood that Petitioners would prevail with respect to the challenged claim on this asserted ground. *See id*.

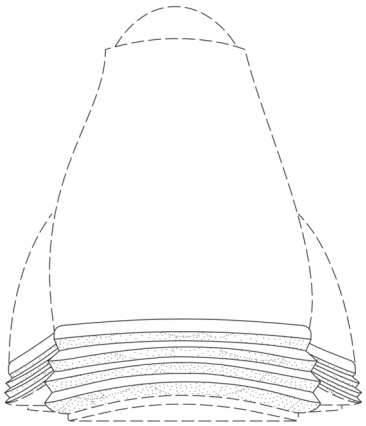
These readily identifiable differences between D'969 and C11947 are not "slight variations" or "minor differences" as in *International Seaway*, 589 F.3d at 1242-43, as Petitioners' suggest. Pet. at 48-49. Unlike in *International Seaway*, where the slight variation was in the "number and position of the circular holes" in shoes, the differences between the D'969 and C11947 designs are substantial and weigh heavily on the visual impression of the claimed D'969 design as a whole.

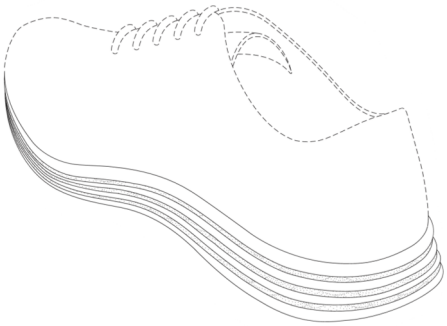
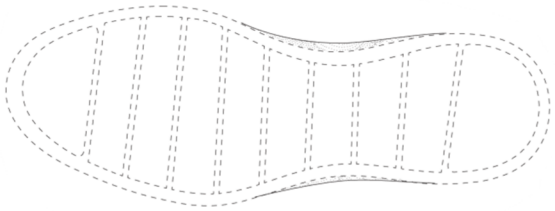
For example, as can be readily seen in at least each of the perspective and lateral views, reproduced below, the claimed D'969 design includes a midsole having a distinct profile around the perimeter of the midsole. Overall, the claimed D'969 design as a whole gives the visual appearance of a midsole that rises and falls

along the length of the shoe and around the heel. Indeed, the variations along the midsole present an overall visual appearance that is both elegant and sporty.

In contrast to the claimed D'969 design, the layers of C11947 form a noticeably flatter and more linear profile throughout the midsole generally and most notably in the heel section. This flatter heel section prevents the midsole of C11947 from showing noticeable variations around the heel.

A side-by-side comparison of the midsole of C11947 and the midsole claimed in D'969 highlight these representative differences, as is shown below:

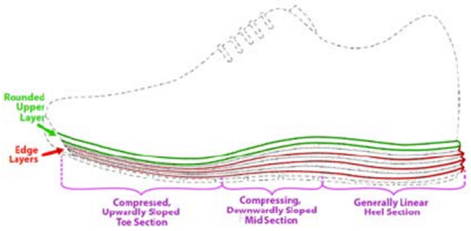
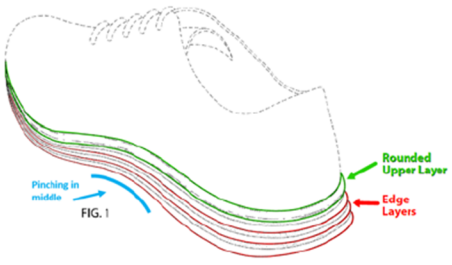
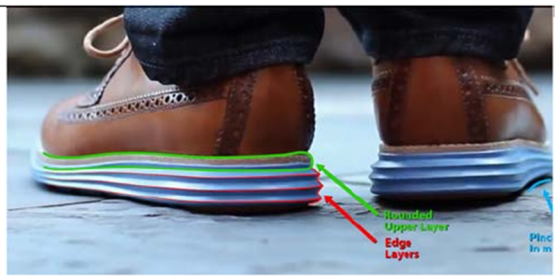
D'969	**C11947**
 D'969 FIG. 3	 EX1007 at 3 Segment of C11947 Capture at 00.19.275
 D'969 FIG. 7	 EX1007 at 17 Segment of C11947 Capture at 01.48.395

D'969	C11947
 D'969 FIG. 1	 EX1007 at 15 Segment of C11947 Capture at 01.39.734
 D'969 FIG. 4	 EX1007 at 7 Segment of C11947 Capture at 00.54.821

Even assuming that C11947 includes each and every of the isolated "key features" identified within the D'969 design (and it does not), the mere presence of these discrete features within C11947 is insufficient to conclude that the overall visual impression of the two designs is substantially the same. *Masimo Corp. v. Apple Inc.*, IPR2023-00831, Paper 9 at 28 (P.T.A.B. Nov. 21, 2023) (prior art disc shaped charger not basically the same as claimed hockey puck shaped design because of significant differences in diameter to height ratio of the two designs). Indeed, as is illustrated above, the overall visual impression of C11947 is different than the claimed design.

ii. Petitioners' "key features" approach is flawed because there are differences among these features.

Even under Petitioners' "key features" approach, this Ground also fails because Petitioners' allegation that the "rounded upper layer of D'969 is substantially the same as the C11947" is wrong. Pet. at 45. Petitioners assert that the ***welt*** of C11947 (i.e., the light brown portion stitched to the blue midsole) should be included as a part of the rounded upper layer of the midsole. Specifically, Petitioners' green annotations reflecting the "rounded upper layer" of the D'969 design includes both the thin uppermost blue ridge of C11947's midsole and the light brown welt attached thereto:

D'969	C11947
 Fig. 2	 (00:19:275)
	 (02:14:735)

Id. at 48.

However, the welt is not part of the claimed D'969 design, and Petitioners' inclusion of it here is improper. A design claim should be "limited to the particular article of manufacture identified in the claim[.]" *In re SurgiSil L.L.P.*, 14 F.4th 1380, 1381-82 (Fed. Cir. 2021) ("[W]e held that the claim at issue was limited to the particular article of manufacture identified in the claim, i.e., a chair." (citing *Curver Luxembourg, SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1336 (Fed. Cir. 2019))). The title, specification, and sole claim of D'969 recites explicitly "[t]he ornamental design for a shoe ***midsole***." *See* EX1001 (emphasis added).

The Petition even admits the welt is not part of the midsole: "the leather ***welt [is] between*** the upper and ***the midsole***." Pet. at 45 (emphasis added). Petitioners' expert, Mr. Delgatty makes a similar statement. EX1003, ¶ 92. He also admits that a "***[t]he 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." *Id.*, ¶ 40 (emphasis added). He further acknowledges that, in some cases, "a shoe may be designed to have the appearance of a welt construction for aesthetic purposes" and that "***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." *Id.*, ¶ 41 (emphasis added). Indeed, the audio transcript of the C11947 video refers directly to the light brown, stitched portion as a "welt." EX2033 at 1-2, corresponding to time stamp 0:31-0:40.

Here, the welt in C11947 is *not* a portion of the midsole, and Petitioners' inclusion of it within the scope of the claimed D'969 design is improper. Removing the welt from Petitioners' interpretation of C11947 onto the claimed D'969 design (which Petitioners have improperly included) further evidences differences between the claimed D'969 design and C11947:

D'969	**C11947**
 D'969 Figure 2 Solid lines only (Pet. at 9)	 Midsole only Segment of C11947 from EX1007 at 3, Capture at 00.19.275

iii. Petitioners fail to consider the above-differences in light of the prior art.

As shown in Patent Owner's Request for Discretionary Denial, filed on November 12, 2025, C11947 is substantially similar to the prior art of record in D'969, including USD742107 that was considered by the Examiner during prosecution of D'969. *See* Paper 10 at 7 (Table 1.0). C11947, and its comparison to D'969, must be viewed in the background of this prior art. *Int'l Seaway*, 589 F.3d at 1239-40.

Because C11947 and USD742107 (i.e., the prior art designs) are substantially similar to each other, the ordinary observer would have been keenly aware of the differences between D'969 and those prior art designs, including C11947, even if

those differences were small (and as set forth above, they are not). *See Int'l Seaway*, 589 F.3d at 1239-40 ("[W]hen the claimed design is close to the prior art designs**,** small differences between [the designs] are likely to be important to the eye of the hypothetical ordinary observer." (quoting *Egyptian Goddess*, 543 F.3d at 676)); *see also Egyptian Goddess*, 543 F.3d at 677 ("The context in which the claimed and accused designs are compared, i.e., the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison. Where the frame of reference consists of numerous similar prior art designs, those designs can highlight the distinctions between the claimed design and the accused design as viewed by the ordinary observer.").[6]

Here, Petitioners fail to consider and comment upon the similarities of C11947 to the prior art of record during prosecution, including USD742107, and fail to consider their impact on the frame of reference of the ordinary observer when

[6] Although *Egyptian Goddess* relates to the issue of infringement, it is also relevant to the issue of anticipation because the test for both infringement and anticipation are the same. *See Int'l Seaway*, 589 F.3d at 1239-40 (quoting *Egyptian Goddess*, 543 F.3d at 676, and noting that "the same tests must be applied to infringement and anticipation"); M.P.E.P. § 1504.02, *Novelty* (quoting *Int'l Seaway*, 589 F.3d at 1239-40, and *Egyptian Goddess*, 543 F.3d at 676).

considering the differences between D'969 and C11947. *See* Pet. at 16 (stating merely that C11947 was "not identified on an Information Disclosure Statement, considered (alone or in combination), or used as the basis for a rejection."). This failure to consider the prior art landscape is fatal to this Ground and the remaining grounds that rely on C11947.

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Considering the designs as a whole, and the substantial differences therebetween (the above of which are simply representative and exemplary differences), Petitioners fail to establish a reasonable likelihood that C11947 anticipates the claimed D'969 design. *See Next Step Grp., Inc. v. Deckers Outdoor Corp.*, IPR2024-00525, Paper 16 at 38-39 (P.T.A.B. Aug. 6, 2024) (finding that Petitioner failed to sufficiently show the asserted art was substantially the same as the claimed design by failing to adequately address differences or provide a sufficient showing that the differences were minor or trivial).

B. Petitioners fail to establish a reasonable likelihood that C11947 makes obvious the claimed design. [Ground 2]

Petitioners argue that C11947 "is so substantially similar as the claimed design that no secondary reference is necessary" and that "the claim of D'969 is obvious over C11947." Pet. at 49. Regarding the scope and content of the prior art (*Graham* factor one), Petitioners' expert argues that C11947 is "essentially identical to the

’969 patent” (EX1003, ¶ 103). However, as noted above with respect to Ground 1, this is not true.

Regarding differences between the prior art and claimed design (*Graham* factor two), Petitioners and their expert identify the only differences between the claimed design and C11947 as the “overhanging midsole and a more rounded upper layer.” *Id.* at 50 (citing EX1003, ¶ 104). However, there are other substantial differences in the overall visual appearances of C11947 and the claimed D’969 design that Petitioners fail to address, such as those discussed in Ground 1. Thus, modifying the midsole of C11947 as described in the Petition would not produce the midsole of D’969. Petitioners’ obviousness ground in view of C11947 fails for at least this reason. Moreover, Petitioners’ proposed modifications of C11947 to result in a “more rounded upper layer” and motivations for doing so are undermined by Petitioners’ improper interpretation and inclusion of the separate “welt” as part of the midsole, as discussed above.

Furthermore, the Petition improperly relies on its expert testimony to gap-fill the deficiencies in its single-reference obviousness argument. For example, with respect to the “more rounded upper layer” difference, Petitioners rely on Mr. Delgatty’s ***unsupported*** assertions that “a designer would have found it obvious to vary the level of curviness so that the upper layer is more curvier” and that “a designer of ordinary skill in the art would have found softening the curve of the

upper layer of the midsole to be trivial" and within "common knowledge and skill." EX1003, ¶¶ 107-108; Pet. at 51 (citing EX1003, ¶¶ 107-108). Indeed, Mr. Delgatty does not cite a single prior art reference to support these assertions. And even his "Background of the Technology" section to which he refers does not cite any supporting references either. EX1003, ¶¶ 35-43, 108.

The Board has consistently held that such "[t]estimony cannot take the place of disclosure in a prior art reference, when that disclosure is required as part of the unpatentability analysis." *Samsung Elecs. Co. Ltd. et al. v. Power2B, Inc.*, IPR2022-00325, Paper 36 at 49-50 (P.T.A.B. June 26, 2023); *see also Hesai Tech. Co. Ltd. et al v. Ouster, Inc.*, IPR2023-01458, Paper 8 at *14 (P.T.A.B. Mar. 28, 2024) (expert testimony to fill in a claim limitation missing from the cited prior art is an improper attempt to substitute testimony for disclosure in the prior art) (citing 2019 Trial Practice Guide); *Nichia Corp. v. Document Sec. Sys., Inc.*, IPR2018-01165, Paper 28 at **56-57 (P.T.A.B. Dec. 10, 2019) (expert testimony that a limitation missing from the prior art is insubstantial and would have been obvious to one of ordinary skill rejected as an improper attempt to substitute testimony for a disclosure in the prior art) (citing Trial Practice Guide update 2018).

By failing to accurately and comprehensively assess the scope and content of C11947 and the differences between the claimed design and C11947, Petitioners fail to present any modification of the asserted art that would arrive at the claimed

design. *Next Step Grp.*, IPR2024-00525, Paper 16 at 40 (finding obviousness arguments based on a reference unpersuasive where petitioner failed to address differences with the claim design raised under an anticipation theory based on the same reference). Therefore, Petitioners fail to establish with reasonable likelihood that the claimed design is obvious in view of C11947.

C. Petitioners fail to establish a reasonable likelihood that C12652 anticipates the claimed design. [Ground 3]

i. Petitioners' "key feature" approach improperly ignores differences in the overall visual impression of D'969.

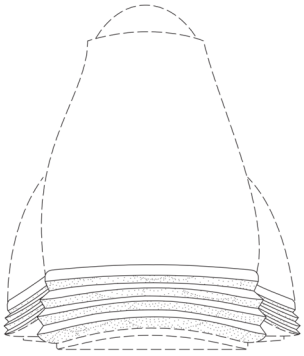
Despite alleging that the "C12652 publication discloses a shoe midsole design with ***all*** features of D'969," *see* Pet. at 55 (emphasis added), Petitioners again do not compare the similarities of the overall designs as a whole, as required under the law. Like with C11947, Petitioners advance an element-by-element comparison of the same four "key features"—(1) the "Ridge Layers," (2) the "Compressions," (3) the "Rounded Upper Layer" and (4) the "Pinched Midsection." Pet. at 62. But also like C11947, Petitioners' analysis overlooks identifiable aspects of the claimed design whose appearance clearly differs between D'969 and C12652. Again, as with C11947, these readily identifiable differences between D'969 and C12652 are not "slight variations" or "minor differences" as in *International Seaway*, 589 F.3d at 1243.

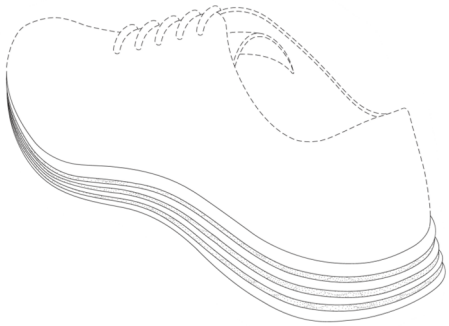
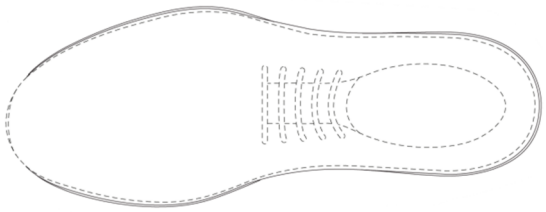
As shown in the table below, C12652 is substantially similar to C11947. Thus, for at least the same reasons as described above for C11947 in Grounds 1 and 2, C12652 has a noticeably different overall visual appearance than the D'969 design.

C11947	C12652
 EX1007 at 3 Segment of C11947 Capture at 00.19.275	 EX1011 at 2
 EX1007 at 17 Segment of C11947 Capture at 01.48.395	 EX1011 at 8
 EX1007 at 15 Segment of C11947 Capture at 01.39.734	 EX1011 at 12

C11947	C12652
 EX1007at 7 Segment of C11947 Capture at 00.54.821	 EX1011 at 10

Furthermore, like in C11947, the layers of C12652 are noticeably flatter and more linear throughout the midsole generally and most notably in the heel section by way of examples. These differences are highlighted in the side-by-side comparison below:

D'969	C12652
 D'969 FIG. 3	 EX1011 at 2
 D'969 FIG. 7	 EX1011 at 8

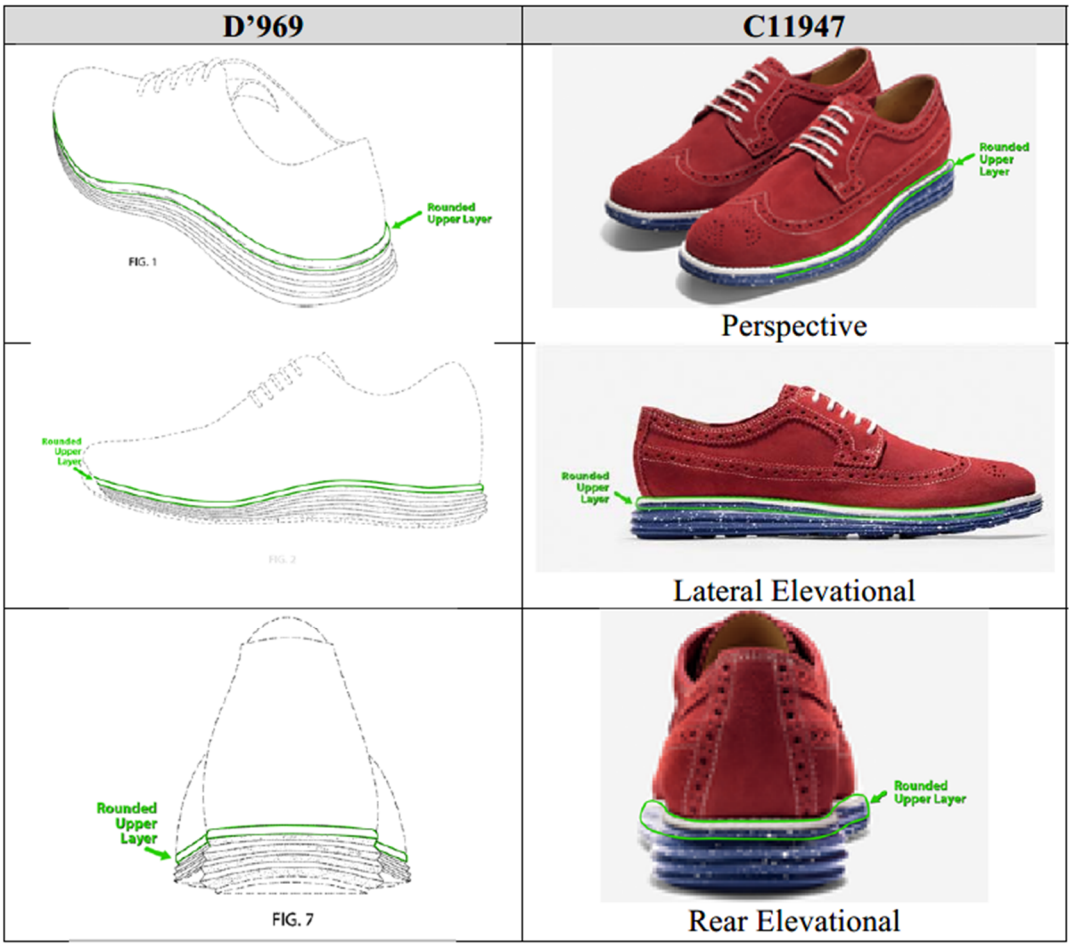
D'969	C12652
 D'969 FIG. 1	 EX1011 at 12
 D'969 FIG. 5	 EX1011 at 10

Once again, Petitioners' failure to consider these differences in overall visual impression amounts to a failure to demonstrate a reasonable likelihood that Petitioners would prevail with respect to the challenged claim on this asserted ground. *Macsports*, IPR2018-01006, Paper 6 at 13 ("In satisfying the requirements of 37 C.F.R. § 42.104(b), a challenger of a design patent cannot simply ignore the differences in designs without discussing how those differences would impact the ordinary observer analysis, if at all."). Even assuming that C12652 includes each and every of the isolated "key features" identified within the D'969 design (and it does not), the mere presence of these discrete features within C12652 is insufficient to

conclude that the overall visual impression of the two designs is substantially the same. *Masimo*, IPR2023-00831, Paper 9 at 28 (prior art disc shaped charger not basically the same as claimed hockey puck shaped design because of significant differences in diameter to height ratio of the two designs). Indeed, as is illustrated above, the overall visual impression of C12652 is different than the claimed design.

ii. Petitioners' "key features" approach is flawed because there are differences among these features.

Even under Petitioners' "key features" approach, this Ground also fails because Petitioners' allegation that both C12652 and D'969 "disclose a rounder upper layer" is wrong. As with C11947, Petitioners improperly include the separate welt (i.e., the white portion attached to the blue midsole) in interpreting C12652 on the claimed D'969 design:



Pet. at 59.

As explained above, it is factually improper to assert that the welt is part of the midsole, as Petitioners and their expert admit. *See supra* § VII.A. It is also legally improper because D'969 identifies only a midsole in its claim. *In re SurgiSil*, 14 F.4th at 1381-82. Removing the welt from Petitioners' interpretation of C12652 onto the claimed D'969 design (which Petitioners have improperly included) further evidences differences between the claimed D'969 design and C12652:

D’969	C12652
 D’969 Figure 3 Solid lines only Pet. at 9	 Midsole only Segment of C12652 EX1011 at 4

iii. Petitioners fail to consider the above-differences in light of the prior art.

As shown in Patent Owner’s Request for Discretionary Denial, filed on November 12, 2025, C12652 (like C11947 noted above) is substantially similar to the prior art of record in D’969, including USD742107 that was considered by the Examiner during prosecution of D’969. *See* Paper 10 at 8 (Table 2.0). C12652, and its comparison to D’969, must be viewed in the background of this prior art. *Int’l Seaway*, 589 F.3d at 1239-40.

Because C12652 and USD742107 (i.e., the prior art designs) are substantially similar to each other, the ordinary observer would have been keenly aware of the differences between D’969 and those prior art designs, including C12652, even if those differences were small (and as set forth above, they are not). *See Int’l Seaway*, 589 F.3d at 1239-40 (quoting *Egyptian Goddess*, 543 F.3d at 676) (“‘[W]hen the claimed design is close to the prior art designs**,** small differences between [the designs] are likely to be important to the eye of the hypothetical ordinary observer.’”); *see also Egyptian Goddess*, 543 F.3d at 677 (“The context in which the claimed and accused designs are compared, i.e., the background prior art, provides

such a frame of reference and is therefore often useful in the process of comparison. Where the frame of reference consists of numerous similar prior art designs, those designs can highlight the distinctions between the claimed design and the accused design as viewed by the ordinary observer.").

Here, Petitioners fail to consider and comment upon the similarities of C12652 to the prior art of record during prosecution, including USD742107, and their impact on the frame of reference of the ordinary observer when considering the differences between D'969 and C12652. *See* Pet. at 16 (stating merely that C12652 was "not identified on an Information Disclosure Statement, considered (alone or in combination), or used as the basis for a rejection."). This failure to consider the prior art landscape is fatal to this Ground and the remaining grounds that rely on C12625.

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Considering the designs as a whole, and the substantial differences therebetween the above of which are simply representative and exemplary differences), Petitioners fail to establish a reasonable likelihood that C12652 anticipates the claimed D'969 design. *See Next Step Grp.*, IPR2024-00525, Paper 16 at 38-39 (finding that Petitioner failed to sufficiently show the asserted art was substantially the same as the claimed design by failing to adequately address differences or providing sufficient showing that the differences were minor or trivial).

D. Petitioners fail to establish a reasonable likelihood that C12652 render obvious the claimed design. [Ground 4]

Petitioners argue that C12652 "is so substantially similar as the claimed design that no secondary reference is necessary" and that "the claim of D'969 is obvious over C12652." Pet. at 63. Regarding the scope and content of the prior art (*Graham* factor one), Petitioners' expert argues that C12652 is "the same as the '969 patent" (EX1003, ¶ 134). However, as noted above with respect to Ground 3, this is not true.

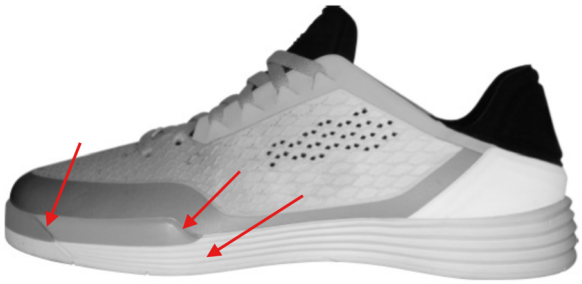
Regarding differences between the prior art and claimed design (*Graham* factor two), Petitioners and their expert identify the only differences between the claimed design and C12652 in its obviousness analysis as "the perspective view of C12652 does not present a clear image of the medial elevational side view," "the bottom design of C12652 using the top plan view, showing the same pinching in the midsection, and wider area near the toe region. Delgatty ¶135," and "an overhang of the midsole over the bottom sole" Pet. at 64-65 (citing EX1003, ¶135). However, there are other substantial differences in the overall visual appearances of C12652 and the claimed D'969 design that Petitioners fail to address, such as those discussed in Ground 3. Thus, modifying the midsole of C12652 as described in the Petition would not produce the midsole of D'969. Petitioners' obviousness ground in view of C12652 fails for at least this reason. Moreover, Petitioners again improperly interprets and includes the separate "welt" as part of the midsole, as discussed above.

Furthermore, the Petition improperly relies on its expert testimony to gap-fill the deficiencies in its single reference obviousness argument. For example, relying solely on Mr. Delgatty's testimony, Petitioner alleges that while C12652 does not include a clear medial elevational side view, "DOSITA would have understood the design as a whole from the images available." Pet. at 63 (citing EX1003 ¶ 135). Such hindsight and unsupported expert testimony about half of C12652's midsole ***could possibly*** look like cannot take the place of ***actual*** disclosure—of which there is none as discussed above. *See Samsung Elecs.*, IPR2022-00325, Paper 36 at 49-50; *see also LKQ Corp. and Keystone Auto. Indus., Inc. v. GM Glob. Tech. Operations LLC*, PGR2020-00055, Paper 33 at 43 (P.T.A.B Oct. 8, 2021) (finding estimations of design features not disclosed in the images not on par with an actual showing).

Petitioners' alternative theory that a "DOSITA would have found designing a midsole with the same design running from the lateral side to the medial side to be trivial" and "easily modified" based on "common knowledge and skill" to achieve "bi-lateral symmetry of design" is unsupported and belied by other references relied on by Petitioners. Pet. at 65 (citing EX1003, ¶ 136; EX1028; EX1029). Mr. Delgatty's testimony, on which Petitioners' alternative theory is based, relies on two references related to symmetry in design. EX1003, ¶ 136 (citing EX1028 and EX1029). But neither reference relates to shoes. *See* EX1028 at 7-8 (discussing "symmetry classifications" generally); EX1029 at 6 (discussing "Symmetry in

Collars"). Furthermore, the generic "bi-lateral" symmetry that these references discuss is already achieved by having bi-lateral symmetry across a pair of shoes (i.e., the right shoe is bilaterally symmetrical with the left shoe). Neither Petitioners nor Mr. Delgatty provide any reason why a DOSITA would have found it obvious for the lateral and the medial sides of C12652's midsole a single shoe to be bilaterally symmetrical.

Indeed, even the midsoles within the references relied upon in the Petition are not bi-laterally symmetrical within a single shoe. For example, the lateral view of Nike includes additional features not included on the medial side, as seen by the red arrows below.

Nike Lateral View	**Nike Medial View**
 Ex. 1012 at 4 (red arrow by Patent Owner)	 Ex. 1012 at 5 (red arrow by Patent Owner)

As such, Petitioners have failed to show that the ordinary designer would have been motivated to modify C12652 to arrive at the midsole design claimed in D'969.

By failing to accurately and comprehensively assess the scope and content of C12652 and the differences between the claimed design and C12652, Petitioners fail

to present any modification of C12652 that would arrive at the claimed design. *Next Step Grp.*, IPR2024-00525, Paper 16 at 40 (finding obviousness arguments based on a reference unpersuasive where petitioner failed to address differences with the claim design raised under an anticipation theory based on the same reference). Therefore, Petitioners fail to establish with reasonable likelihood that the claimed design is obvious in view of C12652.

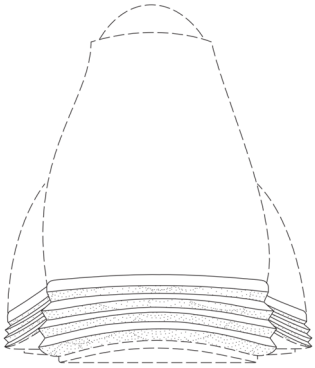
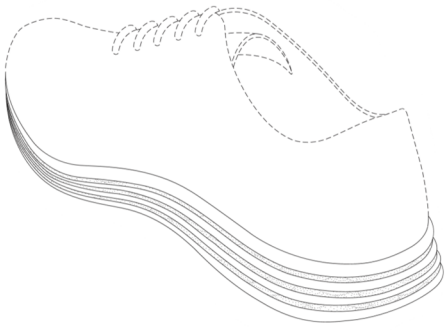
E. Petitioners fail to establish a reasonable likelihood that Nike anticipates that claimed design. [Ground 5]

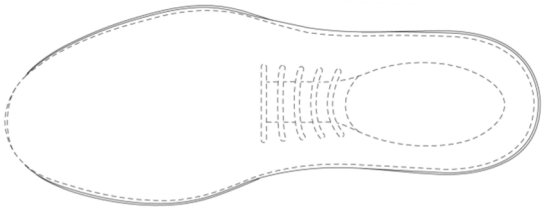
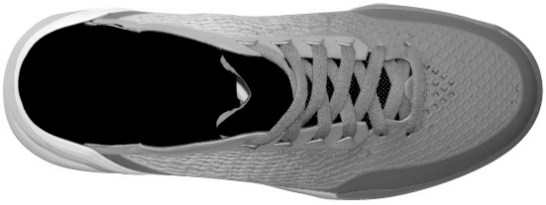
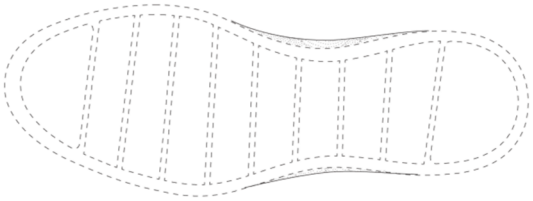
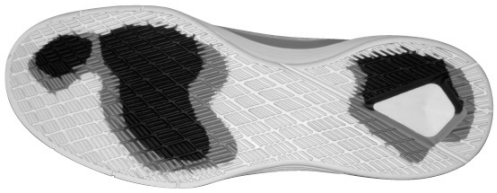
i. Petitioners' "key feature" approach improperly ignores differences in the overall visual impression of D'969.

Petitioners' theory of anticipation based on Nike fails to consider or address readily identifiable differences between Nike and the claimed D'969 design. Here, Petitioners allege that "Nike discloses a design of a shoe midsole with ***all*** features of D'969." Pet. at 68. But once again, as with respect to Grounds 1 and 3 noted above, Petitioners' argument improperly advances an element-by-element comparisons of only the same four "key features"—(1) the "Ridge Layers," (2) the "Compressions," (3) the "Rounded Upper Layer" and (4) the "Pinched Midsection." Pet. at 68-69.

However, as is illustrated below, the ***overall*** visual impression of Nike's midsole bears little resemblance to the claimed design. The differences between the claimed D'969 design and Nike are apparent even based on a cursory review. For

example, as highlighted in the lateral view, Nike's midsole is thickest at the heel and tapers and slopes consistently downward along the length towards the toe region, unlike the claimed design.

D'969	Nike
 D'969 FIG. 3	 EX1012 at 4
 D'969 FIG. 7	 EX1012 at 6
 D'969 FIG. 1	 EX1012 at 10

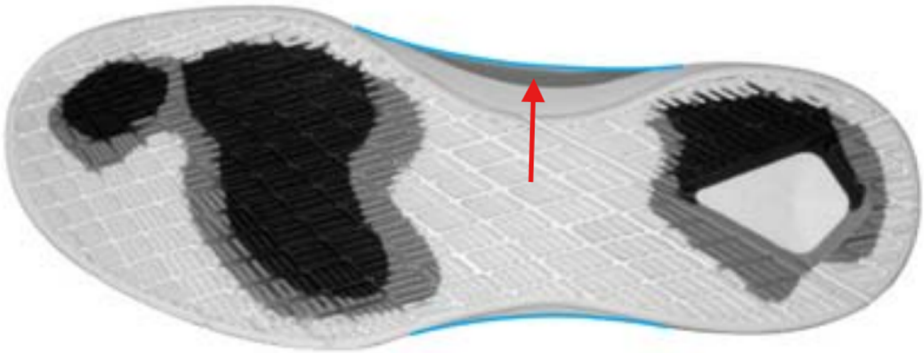
D'969	Nike
 D'969 FIG. 5	 EX1012 at 8
 D'969 FIG. 4	 EX1012 at 9

Even assuming that Nike includes each and every of the isolated "key features" identified within the D'969 design (and it does not), the mere presence of these discrete features within Nike is insufficient to conclude that the overall visual impression of the two designs is substantially the same. *Masimo*, IPR2023-00831, Paper 9 at 28 (prior art disc shaped charger not basically the same as claimed hockey puck shaped design because of significant differences in diameter to height ratio of the two designs).

ii. Petitioners' "key features" approach is flawed because there are differences among these features.

Even under Petitioners' "key features" approach, this Ground also fails because Petitioners mischaracterize the elements disclosed in Nike. First, with respect to the "pinched midsection" and "overhang," Petitioners misconstrue the

scope of Nike and highlighted a portion of the shoe upper. *See* Pet. at 74. Petitioners' annotated image traces a contour of Nike in blue capturing an area of darker grey.

Annotated Petition Image

Pet. at 73 (blue annotations by Petitioners, red arrow by Patent Owner)
Nike

Ex. 1012 at 5 (red arrow by Patent Owner)

Indeed, the darker grey area is a portion of the ***shoe upper*** that is attached to the top of the midsole and that extends along the mid-section prior to the heel region. It does not form any portion of the midsole. The area captured by the lower blue trace is

noticeably lighter grey, further highlighting how the captured area includes a portion of the midsole distinct from the scope of the D'969 design.

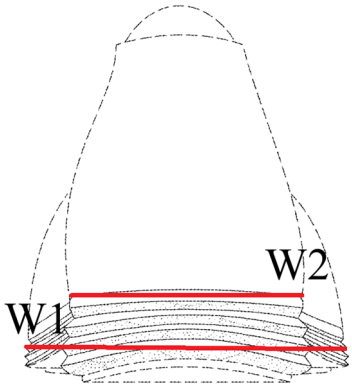
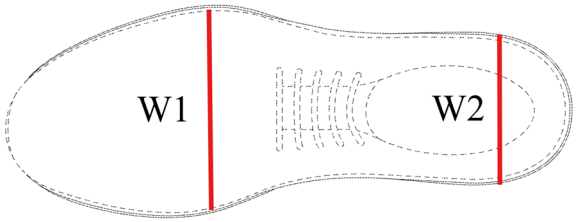
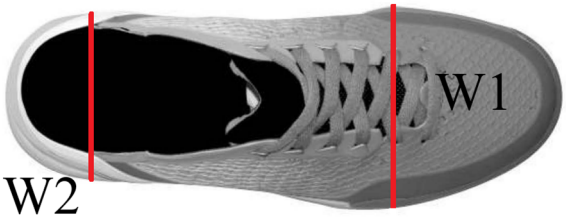
Second, the height dimension of the ridged edge layers of Nike are greater than the claimed D'969 design, and the topmost layer in Nike decreases in height from the heel to the toe region like the lower edge layers. Indeed, the height dimension of the "ridged edge layers" and the "rounded upper layer" decrease along the longitudinal direction of the Nike, almost vanishing in the toe region from the view of the ordinary observer as shown in the annotated table below, which is in contrast with the claimed D'969 design:

Nike

EX1012 at 4 (red arrows added by Patent Owner)

Third, the rear views of the D'969 and Nike designs highlight additional differences that are overlooked in the Petition. For example, in the rear view, the front box of shoe is not substantially visible and is blocked in the rear view by the

heel—in other words, the heel of the Nike midsole has a similar width as the ball of the foot area, as shown in the table below in comparing D'969 FIG. 7 with Nike (EX1012 at 6, 8), including the maximum width at the respective ball of the foot "W1," and the maximum width at the respective heel portions, "W2":

Annotated D'969	**Annotated Nike**
 D'969 FIG. 7	 Annotated EX1012 at 6
 D'969 FIG. 5	 Annotated EX1012 at 8

iii. Petitioners fail to consider the above-differences in light of the prior art.

As shown below and in Patent Owner's Request for Discretionary Denial, filed on November 12, 2025, Nike is substantially similar to the prior art of record in D'969, including USD713625S, USD713626S, USD672123S1, and USD680308S1, all of which were considered by the Examiner during prosecution

of D'969. *See* Paper 10 at 10-11 (Table 4.0); EX1002 at 31, 57-58, 62. Nike, and its comparison to D'969, must be viewed in the background of this prior art. *Int'l Seaway*, 589 F.3d at 1239-40.

Because Nike, USD713625S, USD713626S, USD672123S1, and USD680308S1 (i.e., the prior art designs) are substantially similar to each other, the ordinary observer would have been keenly aware of the differences between D'969 and those prior art designs, including Nike, even if those difference were small (and as set forth above, they are not). *See Int'l Seaway*, 589 F.3d at 1239-40 ("'[W]hen the claimed design is close to the prior art designs**,** small differences between [the designs] are likely to be important to the eye of the hypothetical ordinary observer.'") (quoting *Egyptian Goddess*, 543 F.3d at 676); *see also Egyptian Goddess,* 543 F.3d at 677 ("The context in which the claimed and accused designs are compared, i.e., the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison. Where the frame of reference consists of numerous similar prior art designs, those designs can highlight the distinctions between the claimed design and the accused design as viewed by the ordinary observer.").

Here, Petitioners fail to consider and comment upon the similarities of Nike to the prior art of record during prosecution, including USD713625S, USD713626S, USD672123S1, and USD680308S1, and their impact on the frame of reference of

the ordinary observer when considering the differences between D'969 and Nike. *See* Pet. at 16 (stating merely that Nike was "not identified on an Information Disclosure Statement, considered (alone or in combination), or used as the basis for a rejection."). This failure to consider the prior art landscape is fatal to this Ground and the remaining grounds that rely on Nike.

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Considering the designs as a whole, and the substantial differences therebetween (the above of which are simply representative and exemplary differences), Petitioners fail to establish a reasonable likelihood that Nike anticipates the claimed D'969 design. See *Next Step Grp.*, IPR2024-00525, Paper 16 at 38-39 (finding that Petitioner failed to sufficiently show the asserted art was substantially the same as the claimed design by failing to adequately address differences or providing sufficient showing that the differences were minor or trivial).

F. Petitioners fail to establish a reasonable likelihood that Nike renders obvious that claimed design. [Ground 6]

Petitioners argue that Nike "is so substantially similar as the claimed design that no secondary reference is necessary" and that "the claim of D'969 is obvious over Nike." Pet. at 76 (citing EX1003, ¶ 161). Regarding the scope and content of the prior art (*Graham* factor one), Petitioners' expert argues that Nike is "the same as the '969 patent" (EX1003, ¶ 162). However, as noted above with respect to Ground 5, this is not true.

Regarding differences between the prior art and claimed design (*Graham* factor two), Petitioners and their expert identify the only differences between the claimed design and Nike as "a slightly greater or smaller degree of sloping and curvature in the ridged edge and top layer" Pet. at 76. However, there are other substantial differences in the overall visual appearances of Nike and the claimed D'969 design that Petitioners fail to address, such as those discussed in Ground 5. Thus, modifying the midsole of Nike as described in the Petition would not produce the midsole of D'969. Petitioners' obviousness ground in view of Nike fails for at least this reason.

Moreover, Petitioners assertions that a "DOSITA 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" and that such modifications "are trivial" are not supported. *Id.* (citing EX1003, ¶¶ 163, 164). First, Petitioners downplay the extent of the difference in the sloping and changes of the curvature between the Nike and D'969 designs. Indeed, as has been highlighted above, the variations are far from slight. The modification proposed by Petitioners would require multiple substantial changes that would undermine the basic principles of the Nike design. *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App'x 755, 758 (Fed. Cir. 2015) ("combinations that change the basic principles under which the [prior art] was

designed to operate, . . . may fail to support a conclusion of obviousness.") (internal quotation marks and citations omitted).

Specifically, the ordinary observer would recognize that the Nike design lacks a "toe spring," which Petitioner's expert, Mr. Delgatty, describes as "a midsole having a higher degree of curvature rising up in the toe area of the shoe." EX1003, ¶ 37. Accordingly, based on Mr. Delgatty's assertions, the ordinary designer would understand the overall visual impression to be an athletic court shoe. *See id.* at ¶ 37 (noting "a court shoe may have less toe spring for the same stability reasons"). As such, modifying the Nike design to include a curvature in the toe region (i.e., adding "toe spring") would undermine the "stability" of Nike—an important consideration according to Petitioners' expert (*id.*)—and would functionally alter the Nike midsole. Thus, an ordinary designer in the art familiar with such differences would not modify the Nike court shoe to include a "toe spring" due to its impact on both the design and functionality of the resulting shoe as a whole. *See* EX1003, ¶161.

Second, the allegedly "trivial" nature of these modifications relies only on unsupported expert testimony. Mr. Delgatty does not support this conclusion with any objective evidence or explain why the particular curvature in D'969 would have been chosen by the ordinary designer. *See* EX1003, ¶ 164. The lack of any objective evidence or explanation undermines his assertion. *See A&A Glob. Imports, Inc. v. Lerman Container Corp.*, IPR2024-01138, Paper 7 at 28-29 (P.T.A.B. Jan. 22, 2025)

(finding arguments regarding modifying a jar's base to neck height proportions as minimal or obvious based on functional considerations unpersuasive in part because of no supporting objective evidence) (internal quotations omitted).

Third, Petitioners' reliance on *Monoflo* and *Door-Master*[7] to argue that modifications to arrive at variations in curvature would have been obvious "as they would have been purely functional, rather than ornamental" is misplaced. *See* Pet. at 76-77. In *Monoflo*, the claimed design and the prior art reference were considered "***virtually identical in design*** except for … (3) the claimed clip has an aperture in the outer half of the latch component of the clip," the inclusion of which the court held obvious "from a functional standpoint." *Monoflo*, 5 F.3d at 1505. However, in this instant case, the proposed modification amounts to more than the mere inclusion of a feature to a reference that is already "virtually identical" to the claimed design.

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[7] *Monoflo Int'l, Inc. v. Larand Int'l, Inc.*, Nos. 92-1487, 92-1494, 1993 WL 302130, *1 (Fed. Cir. Aug. 10, 1993) (which Petitioners cite as finding a difference from the claimed design to be "obvious, from a functional standpoint."); and *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312 (Fed. Cir. 2001) (which Petitioners cite as "only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection.") (internal quotation marks and citations omitted)).

Instead, as discussed above, Petitioners' modification to the toe spring requires altering the overall visual impression and the broad function of Nike. Indeed, negative impacts to the broad function of a claimed article, such as the addition of a toe spring which decreases shoe stability, cannot be overlooked for purposes of determining obviousness. *See* M.P.E.P. § 1504.03 *Nonobviousness* ("The prohibition against destroying the function of the design is inherent in the logic behind combining references to render a claimed invention obvious under 35 U.S.C. 103(a). If the proposed combination of the references so alters the primary reference that its broad function can no longer be carried out, the combination of the prior art would not have been obvious to a designer of ordinary skill in the art. It is permissible to modify the primary reference to the extent that the specific function of the article may be affected while the broad function is not affected."). Indeed, modifying the Nike design to include a "toe spring" would undermine the "stability" of Nike—an important consideration according to Petitioners' expert —and would functionally alter the Nike midsole. *See* EX1003, at ¶ 37.

Petitioners' reliance on *Door-Master's* quoted statement that "only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection" is irrelevant. The issue addressed in *Door-Master* was "construing the claimed design," not whether a claimed design is obvious based on

a motivation rooted in "functionality." *Door-Master*, 256 F.3d at 1312. Here, Petitioners do not dispute that the toe spring is part of the claimed design.

Finally, Petitioners' assertion that, "for a shoe with a curvier bottom sole, the midsole would have to match in order to fit atop the bottom sole" is irrelevant because the Petition does not establish that Nike has as "a curvier bottom sole" that even warrants a matching curvier midsole. Pet. at 77. Moreover, the purported support for Petitioners' assertion that "such a curvier sole was already well-known" (EX1026 and EX1027) is flawed. *See id.* (citing EX1026 and EX1027). Exhibit 1026 (EU Reg. Des. No. 002127563-0013 to Nike) is substantially the same as references considered by the Examiner during prosecution and found not to obviate the claimed D'969 design. Exhibit 1026 is shown below in comparison to USD672123S1, provided as Exhibit 2035, which is included on the face of D'969:

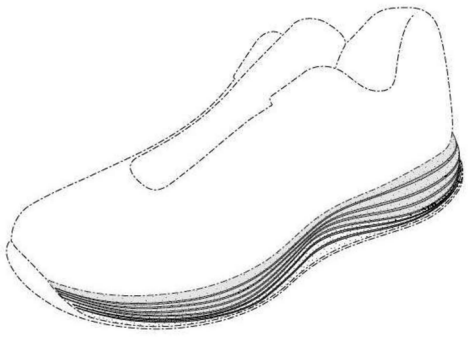
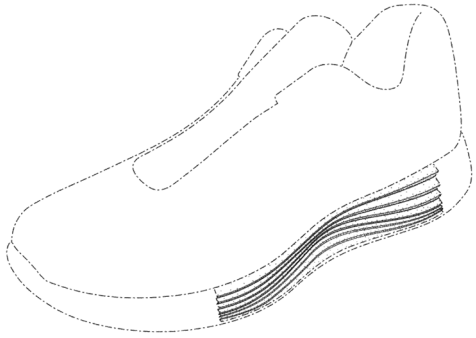
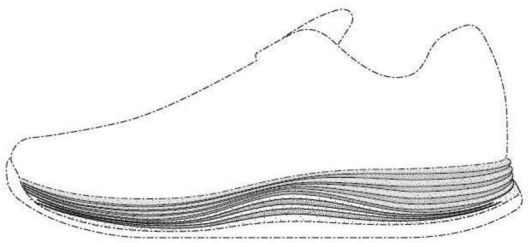
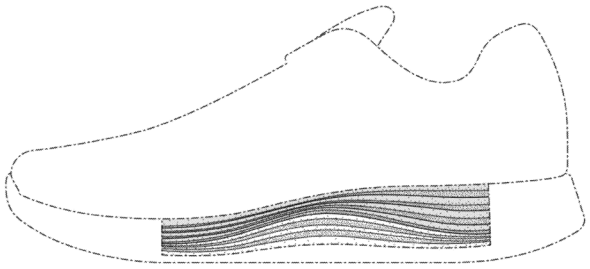
Exhibit 1026	**Exhibit 2035**
 EX1026 at 4	 EX2035 at 2

Exhibit 1026	Exhibit 2035
	
EX1026 at 5	EX2035 at 4

Even if Exhibit 1026 does disclose a "curvier sole," as alleged in the Petition, the Examiner did not find the D'969 design obvious in view of substantially the same "curvier sole," Exhibit 2035. Even under the more recent obviousness standard set forth in *LKQ*, the visual appearance of the "curvier midsole" of EX1026 is substantially different than D'969 such that the ordinary designer would have no motivation to modify the midsole of Nike to arrive at the claimed design.

Exhibit 1027 (CN Reg. No. 303545969) is not even available as prior art under either 35 U.S.C. §§102(a)(1) or 102(1)(2). The publication of Exhibit 1027 post-dates the October 13, 2015, filing date of D'969. Indeed, the face of Exhibit 1027 identifies the date of "2016.01.13," or January 13, 2016, in the INID Code 45 field. INID Code 45 corresponds to the "[d]ate of making available to the public by printing or similar process of a patent document on which grant has taken place on or before the said date," as described in Standard ST.9 in the Handbook on Industrial Property Information and Documentation published by the World Intellectual Property Organization. EX2033 at 7. Petitioners provide no arguments for why the

CN Reg. No. 303545969 should be treated as prior art under 35 USC § 102(a)(2) in support of the obviousness analysis based on the September 17, 2015, filing date in China, INID Code 22, "[d]ate(s) of filing the application(s)." EX2033 at 6.

According to Petitioners, any and all degrees of "curviness" would have been obvious based on the function of the midsole. *See* Pet. at 76. In the crowded field of shoe midsole design, this simply cannot be true. By failing to accurately assess the scope and content of the prior and the differences between the claimed design and the asserted art, Petitioners fail to present any modification of the asserted art that would arrive at the claimed design. *Next Step Grp.*, IPR2024-00525, Paper 16 at 40 (finding obviousness arguments based on a reference unpersuasive where petitioner failed to address differences with the claim design raised under an anticipation theory based on the same reference). Therefore, Petitioners fail to establish with reasonable likelihood that the claimed design is obvious in view of Nike.

G. Petitioners fail to establish a reasonable likelihood that C11947 or C12652 in view of Nike renders obvious the claimed design. [Grounds 7 & 8]

Petitioners present Grounds 7 and 8 to "the extent PO argues Figure 4 of D'969 requires an overhang of the midsection ***over the bottom sole***." Pet. at 78. Because the claimed design includes no such "bottom sole," Patent Owner makes no separate arguments for Grounds 7 and 8 at this time. However, the arguments with

respect to each of C11947, C12652, and Nike presented above apply equally to these grounds.

For at least the reasons described above, Petitioners fail to establish with reasonable likelihood that the claimed D'969 design is obvious based on C11947 or C12652 in view of Nike.

H. Petitioners fail to establish a reasonable likelihood that Skechers in view of Nike renders obvious the claimed design. [Ground 9]

i. Skechers is not a suitable primary reference under Graham Factor One.

Skechers is not a suitable primary reference because there are too many relevant aspects of Skechers' midsole that are not shown in the images included with the Petition. As highlighted below, Skechers (EX1016 and EX1017) includes a total of three views of a shoe—(1) a side perspective view showing the lateral portion and a partial toe region of a single midsole and a partial medial section of the toe region, (2) a close-up view of lateral view of the heel region of a single midsole, and (3) a zoomed-out perspective view of the medial portion of a single midsole in which the features of the midsole cannot be made out.

Skechers
 EX1016 at 5
 EX1016 at 6


Skechers

EX1016 at 5-6

Notably, however, Skechers does not show a shoe or midsole thereof from (1) the rear elevational view, (2) the medial side elevational view, (3) the top plan view, (4) the bottom plan view, or (5) the front elevational view. This lack of disclosure is fatal to this ground. *See LKQ*, PGR2020-00055, Paper 33 at 43 (finding arguments on anticipation and obviousness unpersuasive because too many aspects of the asserted art are not adequately disclosed in the images).

ii. Petitioners' "key feature" approach improperly ignores differences in the overall visual impression of D'969.

Even assuming Skechers is a suitable primary reference, a point which the Patent Owner does not concede, Skechers appears substantially similar to C11947 and C12652 and has, for at least the reasons described above, a noticeably different overall visual appearance than the D'969 design. Skechers, like C11947 and/or C12652, includes numerous differences to the claimed design that contribute to an overall visual impression that is not substantially the same. Indeed, EX1016 states that the Skechers midsole design is "very similar" to the Cole Haan LunarGrand, the same "LunarGrand" referenced in the title of the C11947 video:

NOTE: *The very similar Skechers "Embolden" are pictured here. The more expensive Cole Haan Lunargrand usually runs between $169 when on sale, to $248 full retail.*



The very squishy, very similar to the Lunargrand, sole of the Skechers Embolden

EX1016 at 5, 6; *see also* EX1006 at 5 (video entitled "Quick Look: Cole Haan LunarGrand LongWing - Camello"). Views comparing the similarities of C11947 and Skechers are provided below for reference.

C11947	Skechers
 EX1007 at 3 Segment of C11947 Capture at 00.19.275	 EX 1017 at 2

C11947	Skechers
 EX1007 at17 Segment of C11947 Capture at 01.48.395	 EX 1017 at 4
 EX1007 at 15 Segment of C11947 Capture at 01.39.734	 EX 1017 at 2

Once again, and as noted above, Petitioners advance an interpretation of the claimed design that focuses on self-selected "key features" and ignores the overall visual impression. Pet. at 86-87. Here, Petitioners, in reliance of their expert, allege that "Skechers publication discloses a design of a shoe midsole ***with most*** of the features of D'969." *Id.* at 86 (emphasis added). Such an allegation is not supported by Skechers. Skechers does not reasonably depict, describe, or otherwise suggest any feature of the midsole that extends along the medial side of the midsole or across the rear. Because Skechers does not even depict certain portions of the midsole, the

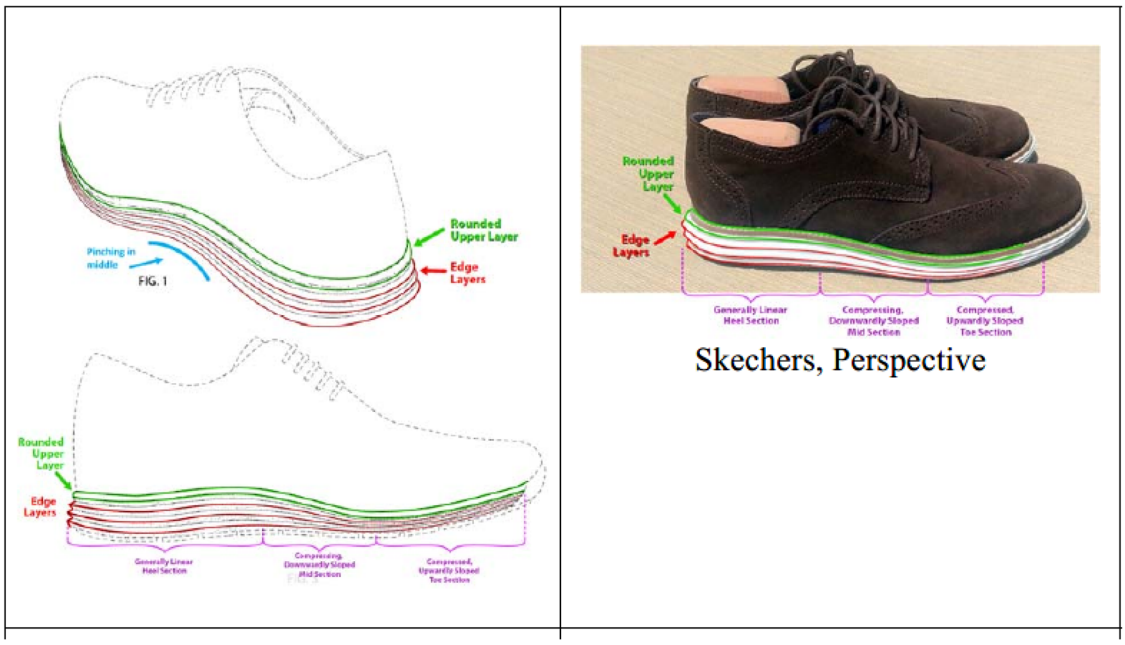
Director should not find "estimations of design features on par with an actual showing." *LKQ*, PGR2020-00055, Paper 33 at 43.

Petitioners appear to assert that any differences between the Skechers midsole and the claimed design exist only because of the "absent explicit image of the bottom sole of Skechers." Pet. at 87. But, even considering the available lateral view, the visual impression of midsole depicted in Skechers and the claimed design are different, and Petitioners fail to identify or address these differences from the perspective of the ordinary observer. Indeed, the overall visual appearance of the claimed design is noticeably different when comparing it to Skechers. As an example, and similar to C11947 and C12652, the layers of Skechers are noticeably flatter and more linear throughout the midsole generally and most notably in the heel section, as shown in the side-by-side comparison below:

D'969mk	**Skechers**
 D'969 FIG. 3	 EX 1017 at 2

iii. Petitioners' "key features" approach is flawed because there are differences among these features.

Even under Petitioners' "key features" approach, this Ground fails because Petitioners' allegation that both Skechers and D'969 "disclose a rounder upper layer" is wrong. *See* Pet. at 87. As with C11947 and C12652, Petitioners improperly include the separate welt (i.e., light brown portion attached to the white) in interpreting Skechers to meet the claimed D'969 design:



Id. at 88.

As explained above, it is factually improper to assert that the welt is part of the midsole, as Petitioners and their expert admit. *See supra* § VII.A. It is also legally improper because D'969 identifies only a midsole in its claim. *In re SurgiSil*, 14 F.4th at 1381-82. The removal of the welt from Petitioners' interpretation of Sketchers onto the claimed D'969 design (which Petitioners have improperly

included) further evidences differences between the claimed D'969 design and Sketchers.

Petitioners recognize that Skechers does not even include all of their own self-selected features and relies on Nike for those features. *See* Pet. at 88-91. However, as discussed above, Nike does not disclose those self-selected features either and thus cannot cure the deficiencies of Skechers. *See supra* § VII.E.ii. Furthermore, a DOSITA would not have been motivated to combine Skechers with Nike. First, the DOSITA would recognize Skechers as a dress sneaker, having a suede upper and a light brown leather welt attached to the white midsole. In contrast, as explained above, the DOSITA would understand Nike to be an athletic court shoe, which is a substantially different shoe—both aesthetically and functionally—having a mesh upper directly coupled to the midsole.

Additionally, Petitioners' arguments that (i) "[d]esigning 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" and (ii) "[i]mplementing Skechers midsole with the rounded upper layer of Nike would have been beneficial in creating a more cohesive design" is unsupported by any objective evidence and relies only on the unsupported testimony of Petitioners' expert. Pet. at 90 (citing Delgatty ¶198). The evidence on the record is inapposite to Petitioners' conclusion. Nike does not include a welt and furthermore the mesh upper is directly coupled to the midsole.

On the other hand, both C11947 and C12652 each include an intermediary welt to attach to an upper. Furthermore, the rounded upper layers of C11947 and C12652 do not have an upper layer remotely similar to D'969, as highlighted above. Indeed, Petitioners offer no reference with a distinctive, rounded upper layer (or any shaped upper layer) that is in "cohesive" connection with a welt to support their "cohesive" conclusions (i) and (ii) noted above. Thus, neither Petitioners nor their expert provide any reason a DOSITA would have been motivated to modify the welt of Skechers in view of the midsole of Nike.

Given the additional differences between the scope of the asserted art and the claimed design as depicted and described above and the lack of sufficient motivation to combine, Petitioners fail to adequately identify the differences between the asserted art and the claimed design as required by *Graham* factor two.

iv. Petitioners fail to consider the above-differences in light of the prior art.

As shown in Patent Owner's Request for Discretionary Denial, filed on November 12, 2025, Skechers (like C11947 and C12652 noted above) is substantially similar to the prior art of record in D'969, including USD742107 that was considered by the Examiner during prosecution of D'969. *See* Paper 10 at 11 (Table 5.0). Skechers, and its comparison to D'969, must be viewed in the background of this prior art. *Int'l Seaway*, 589 F.3d at 1239-40.

Because Skechers and USD742107 (i.e., the prior art designs) are substantially similar to each other, the ordinary observer would have been keenly aware of the differences between D'969 and those prior art designs, including Skechers, even if those differences were small (and as set forth above, they are not). *See Int'l Seaway*, 589 F.3d at 1239-40 ("[W]hen the claimed design is close to the prior art designs**,** small differences between [the designs] are likely to be important to the eye of the hypothetical ordinary observer." (quoting *Egyptian Goddess*, 543 F.3d at 676)); *see also Egyptian Goddess*, 543 F.3d at 677 ("The context in which the claimed and accused designs are compared, i.e., the background prior art, provides such a frame of reference and is therefore often useful in the process of comparison. Where the frame of reference consists of numerous similar prior art designs, those designs can highlight the distinctions between the claimed design and the accused design as viewed by the ordinary observer.").

Here, Petitioners fail to consider and comment upon the similarities of Skechers to the prior art of record during prosecution, including USD742107, and their impact on the frame of reference of the ordinary observer when considering the differences between D'969 and Skechers. *See* Pet. at 16 (stating merely that C12652 was "not identified on an Information Disclosure Statement, considered (alone or in combination), or used as the basis for a rejection."). This failure to consider the prior art landscape is fatal to this Ground.

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By failing to accurately assess the scope and content of the Skechers and the differences between the claimed design and Skechers, Petitioners fail to present any modification of Skechers by Nike that would arrive at the claimed design. *Next Step Grp.*, IPR2024-00525, Paper 16 at 40 (finding Petitioner's obviousness arguments were not persuasive because they failed to address differences between the overall appearance of the claimed design).

Therefore, Petitioners fail to establish with reasonable likelihood that the claimed design is obvious based on Skechers in view of Nike.

VIII. SECONDARY CONSIDERATIONS

Patent Owner does not believe any secondary considerations are necessary to show that Petitioners fail to establish with reasonable likelihood that the claimed design is unpatentable with respect to any ground. Nevertheless, Patent Owner reserves the right to later raise any secondary considerations in further filings here or in any jurisdiction with respect to D'969.

IX. CONCLUSION

The Petition fails to establish a reasonable likelihood that the challenged claim of D'969 is unpatentable in view of the cited art for at least the reasons noted above and, therefore, the Director should deny institution.

Dated: December 11, 2025

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count under §§ 42.24(a)(1) and 42.24(b)(1) for the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** totals 11,404 words based on the word count of the word-processing system used to prepare the paper, which is within the 14,000 word limit allotted by rule.

Dated: December 11, 2025

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CERTIFICATE OF SERVICE

In accordance with 37 CFR §§ 42.6(e), the undersigned certifies that on December 11, 2025, a complete and entire copy of this **PATENT OWNER'S PRELIMINARY RESPONSE** and all supporting exhibits were served on Petitioners via electronic mail to counsel for Petitioners at the following addresses:

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