

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 RESPONSE
UNDER 37 C.F.R. § 42.120**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. LEGAL STANDARDS	4
A. Anticipation	4
B. Obviousness.....	5
C. Claim Construction.....	7
D. The Ordinary Observer.....	8
E. The Ordinary Designer	8
III. D’969 CLAIMS A VISUALLY DISTINCTIVE DESIGN FOR A SHOE MIDSOLE	8
IV. PETITIONERS’ IMPROPERLY CONSTRUE THE CLAIMED D’969 DESIGN.....	16
A. Petitioners’ Feature-By-Feature Comparisons Fail to Consider Overall Visual Appearance	16
B. Petitioners’ Claim Construction Mischaracterizes and Ignores Features that Contribute to D’969’s Overall Visual Impression	28
V. PETITIONERS’ EXPERT MISAPPLIES THE ORDINARY OBSERVER TEST	35
VI. PETITIONERS FAIL TO ESTABLISH THAT D’969 IS ANTICIPATED OR RENDERED OBVIOUS BY THE PRIOR ART	38
A. Ground 1: Petitioners Fail to Establish That C11947 Anticipates D’969.....	38
B. Ground 2: Petitioners Fail to Establish That C11947 Renders obvious D’969	49
C. Ground 3: Petitioners Fail to Establish That C12652 Anticipates D’969.....	53

D.	Ground 4: Petitioners Fail to Establish That C12652 Renders Obvious D’969	60
E.	Ground 5: Petitioners Fail to Establish That Nike Anticipates D’969	63
F.	Ground 6: Petitioners Fail to Establish That Nike Renders Obvious D’969	69
G.	Grounds 7 & 8: Petitioners Fail to Establish that C11947 or C12652 in View of Nike Renders Obvious D’969.....	74
H.	Ground 9: Petitioners Fail to Establish That Skechers in View of Nike Renders Obvious D’969	78
VII.	SECONDARY CONSIDERATIONS.....	87
VIII.	CONCLUSION	87

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>A&A Glob. Imports, Inc. v. Lerman Container Corp.</i> , IPR2024-01138, Paper 7 (P.T.A.B. Jan. 22, 2025)	37, 38
<i>Arashi Vision (U.S.) LLC (d/b/a Insta360) v. GoPro, Inc.</i> , IPR2024-01434, Paper 9 (P.T.A.B. Mar. 31, 2025)	<i>passim</i>
<i>Campbell Soup, Co. v. Gamon Plus, Inc.</i> , 10 F.4th 1268 (Fed. Cir. 2021)	5, 6
<i>Chongqing Qiulong Tech. Corp. Ltd. v. Tanli Power Tech. (Chongqing) Co., Ltd.</i> , No. 1:23-CV-00442-RP, 2025 WL 3484807 (W.D. Tex. Nov. 13, 2025)	41
<i>Crocs, Inc. v. Int’l Trade Comm’n</i> , 598 F.3d 1294 (Fed. Cir. 2010)	<i>passim</i>
<i>Curver Luxembourg, SARL v. Home Expressions Inc.</i> , 938 F.3d 1334 (Fed. Cir. 2019)	45, 46
<i>Door-Master Corp. v. Yorktowne, Inc.</i> , 256 F.3d 1308 (Fed. Cir. 2001)	4, 71
<i>Durling v. Spectrum Furniture Co., Inc.</i> , 101 F.3d 100 (Fed. Cir. 1996)	5, 6
<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i> , 543 F.3d 665 (Fed. Cir. 2008) (<i>en banc</i>)	<i>passim</i>
<i>Ethicon Endo-Surgery, Inc. v. Covidien, Inc.</i> , 796 F.3d 1312 (Fed. Cir. 2015)	4, 20
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	<i>passim</i>
<i>Hesai Tech. Co. Ltd. v. Ouster, Inc.</i> , IPR2023-01458, Paper 8 (P.T.A.B. Mar. 28, 2024)	33, 52
<i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984)	61

<i>In re Harvey</i> , 12 F.3d 1061 (Fed. Cir. 1993)	<i>passim</i>
<i>In re SurgiSil L.L.P.</i> , 14 F.4th 1380 (Fed. Cir. 2021)	45, 58
<i>Int’l Seaway Trading Corp. v. Walgreens Corp.</i> , 589 F.3d 1233 (Fed. Cir. 2009)	4, 5
<i>Lanard Toys Ltd. v. Dolgencorp LLC</i> , 958 F.3d 1337 (Fed. Cir. 2020)	5
<i>LKQ Corporation v. GM Global Technology Operations LLC</i> , 102 F.4th 1280 (Fed. Cir. 2024) (<i>en banc</i>)	<i>passim</i>
<i>Nichia Corp. v. Document Sec. Sys., Inc.</i> , IPR2018-01165, Paper 28 (P.T.A.B. Dec. 10, 2019)	34, 52
<i>Nike, Inc. v. Just Did It Enters.</i> , 6 F.3d 1225 (7th Cir. 1993)	75
<i>Premier Gem Corp. v. Wing Yee Gems & Jewellery Ltd.</i> , IPR2016-00434, Paper 9 (P.T.A.B. July 5, 2016)	7
<i>Samsung Elecs. Co., Ltd. v. Power2B Inc.</i> , IPR2022-00325, Paper 36 (P.T.A.B. June 26, 2023)	33, 52, 61
OTHER AUTHORITIES	
<i>Manual of Patent Examining Procedure</i> § 1503.01 (8th ed. 2006)	26
Trial Practice Guide (Aug. 2018).....	34
Consolidated Trial Practice Guide (Nov. 2019)	33

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, <i>Protecting Fashion Designs: Not Only “What?” But “Who?”</i> , 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, <i>The Copying of Independent Fashion Designers: Perils and Potential Remedies in a Post-Star Athletica World</i> , 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

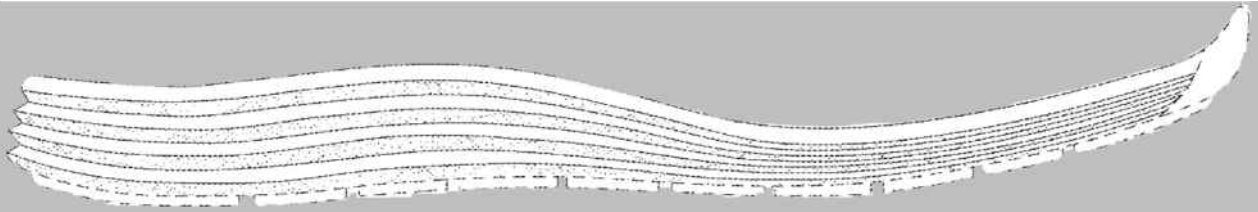
Exhibit No.	Description
2030	Bruno Marc's MaxFlex Sales webpage, available at https://www.brunomarc.com/search?keyword=maxflex
2031	Dream Pairs' KnitFlex Sales webpage, available at https://www.dreampairs.com/search?keyword=knitflex
2032	Dream Pairs' MaxFlex Sales webpage, available at https://www.dreampairs.com/search?keyword=maxflex
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
2036	Declaration of Lance Gordon Rake, dated May 19, 2026
2037	Transcript of Deposition of Grant Delgatty, dated May 7, 2026
2038	Yuketen Goodyear-Welt Construction, dated March 06, 2015, available at https://www.yuketen.com/journal/2015/3/6/08jwy5k4jcsol564hu4a0ihhn3fl0b
2039	U.S. Patent No. 8,336,229
2040	Well Dressed Dad, <i>The Guide to Goodyear Welted Shoe Soles</i> , available at https://welldresseddad.com/2014/11/16/the-guide-to-goodyear-welted-shoe-soles/
2041	U.S. Publication No. 2011/0099852A
2042	Interaction Design Foundation, The Gestalt Principles, available at https://www.interaction-design.org/literature/topics/gestalt-principles .
2043	The Bauhaus, 1919-1933, Timeline of Art History, THE MET, available at https://www.metmuseum.org/essays/the-bauhaus-1919-1933 .

Exhibit No.	Description
2044	Captain Creps, What Is Nike's Most Sold Sneaker?, available at https://captaincreps.com/nike-most-sold-sneaker/

I. INTRODUCTION

Petitioners Top Glory Trading Group Inc. and DP Dream Pairs Inc. (“Petitioners”) fail to meet their burden of establishing that U.S. Patent No. D768,969 (“D’969”) is anticipated or rendered obvious by the cited references by a preponderance of evidence. Petitioners misconstrue D’969 by offering a detailed verbal description that improperly dissects the claimed midsole into four discrete “key features.” Even worse, Petitioners systematically ignore D’969 and the prior art as a whole by using color-coded annotated figures that draw attention toward only these four “key features” and away from the overall appearance of the actual designs. Further compounding Petitioners’ erroneous feature-based construction, Petitioners ignore readily apparent differences between D’969 and the prior art or dismiss them as “slight” or “minor” without any explanation for why an ordinary observer would not have appreciated such differences, particularly in the crowded field of midsoles.

No words are necessary to compare D’969 to the prior art. The novelty of D’969’s wavy midsole relative to prior art is readily apparent to an ordinary observer:



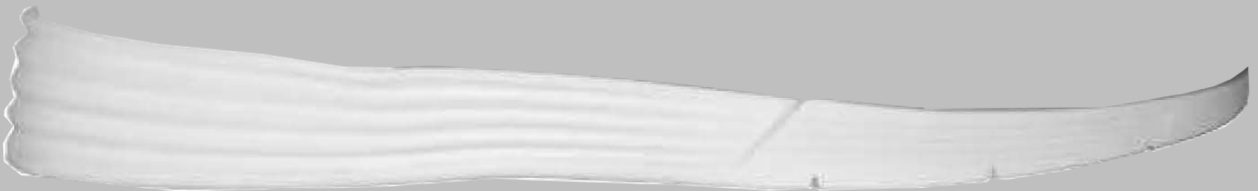
D'969 Midsole (EX1001)



C11947 (Midsole with Welt) (EX1005)



C12652 (Midsole with Welt) (EX1011)



Nike (EX1012)

EX2036, ¶121.¹ D’969’s undulating midsole conveys a unique, wavy overall visual impression that an ordinary observer would readily observe as not being substantially similar to the flatter, non-undulating prior art.

Moreover, Petitioners’ attempts to modify the prior art to create D’969’s unique design fall short. Petitioners have not identified any prior art design that is visually similar to the D’969, as required by the first *Graham* factor, and have ignored differences between D’969 and the prior art under the second *Graham* factor. Petitioners also fail to provide adequately supported reasons why a designer of ordinary skill in the art would have been motivated to modify the prior art to achieve D’969’s unique wavy appearance. For these reasons, the Board should find D’969 not unpatentable over the prior art.

¹ Skechers is not included because Petitioners fail to provide a comparable view to D’969. *Infra* §VI.H.i EX2036, ¶121. Although the welts of C11947 and C12562 are included consistent with Petitioners’ interpretation, Petitioners’ inclusion of the welts is improper for the reasons explained below. *Infra* §§VI.A.i, VI.C.i. As further explained below, D’969 is even more distinct from the prior art when the welts are properly excluded from consideration. *Id.*

II. LEGAL STANDARDS

A. Anticipation

The “ordinary observer” test 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). Anticipation requires assessing whether the claimed design and the prior art design 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).

The ordinary observer test requires “consideration of the design *as a whole*[.]”² *Int’l Seaway*, 589 F.3d at 1243, “comparing *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). “An *element-by-element comparison*, untethered from application of the ordinary observer inquiry to the overall design, is *procedural error*.” *Ethicon Endo-Surgery*, 796 F.3d at 1335.

The ordinary observer also test requires the fact finder to consider all of the ornamental features illustrated in the figures of the challenged patent that are visible

² Emphasis added throughout unless otherwise indicated.

at any time in the “normal use” lifetime. *Int’l Seaway*, 589 F.3d at 1241. 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*)). “[W]hen the claimed design is close to the prior art, small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer.” *Egyptian Goddess*, 543 F.3d at 676; *Lanard Toys Ltd. v. Dolgencorp LLC*, 958 F.3d 1337, 1341-43 (Fed. Cir. 2020).

B. Obviousness

In *LKQ Corporation v. GM Global Technology Operations LLC*, 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[.]” 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.’” *Id.* at 1299 (quoting *Campbell Soup, Co.*

v. Gamon Plus, Inc., 10 F.4th 1268, 1275 (Fed. Cir. 2021)). As highlighted by the Federal Circuit’s *en banc* decision in *LKQ*, design patent obviousness is evaluated under the framework set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), as adapted for design patents. Under this framework, the obviousness inquiry requires consideration of four *Graham* factors:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the design claimed in the patent at issue;
- (3) the level of ordinary skill in the pertinent art; and
- (4) any relevant secondary considerations, such as commercial success, industry praise, or evidence of copying.

LKQ, 102 F.4th at 1292.

The “inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features.” *Id.* at 1299; *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 v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 104 (Fed. Cir. 1996)). It is legal error to compare “the visual impression of ***selected, separate features*** of the prior art to the [claimed] designs, rather than the visual impression of the designs as a whole.” *In re Harvey*, 12 F.3d 1061, 1065 (Fed. Cir. 1993). Furthermore, an analysis focused on selectively chosen design features while deliberately ignoring others is improper. *See Arashi Vision (U.S.) LLC (d/b/a*

Insta360) v. GoPro, Inc., IPR2024-01434, Paper 9 at 25 (P.T.A.B. Mar. 31, 2025); *Premier Gem Corp. v. Wing Yee Gems & Jewellery Ltd.*, IPR2016-00434, Paper 9 at 16-17 (P.T.A.B. July 5, 2016).

C. Claim Construction

The scope of the claimed design is represented by the illustrations; verbal descriptions are not required. *Egyptian Goddess*, 543 F.3d at 679. 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. The Federal Circuit has recognized risks entailed in a verbal 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.”).

As discussed in Section IV below, Petitioners’ claim construction provides an inaccurate verbal description and does not provide an adequate accounting of the overall visual impression of D’969. Patent Owner does not provide a claim construction as the D’969 figures speak for themselves. Instead, Patent Owner

provides a description of D’969, which points out various features of the claimed midsole and its overall impression to aid in analysis relative to the prior art. *Infra* §III; EX2036, ¶¶92-98.

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., 23-24.

III. D’969 CLAIMS A VISUALLY DISTINCTIVE DESIGN FOR A SHOE MIDSOLE

D’969 claims the ornamental design for a shoe midsole as shown in solid lines in Figures 1-7, respectively illustrating the perspective, lateral side elevational, medial side elevational, bottom plan, top plan, front elevational, and rear elevational views:

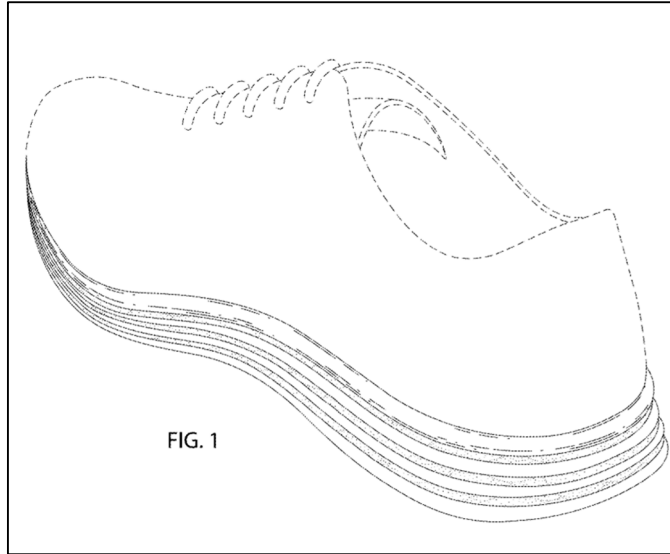


FIG. 1

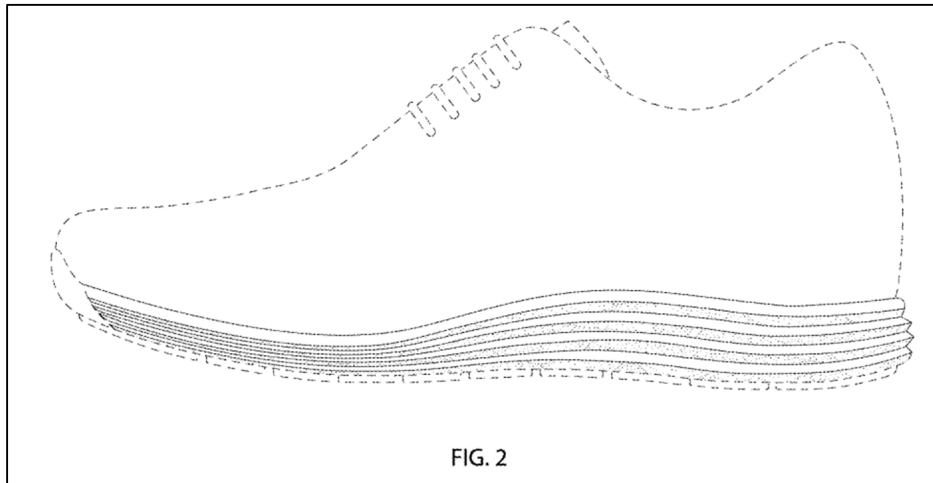


FIG. 2

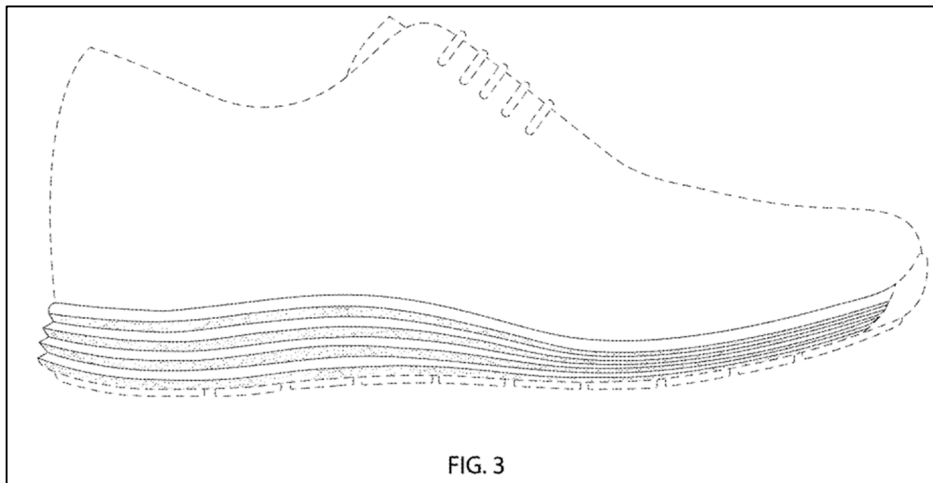
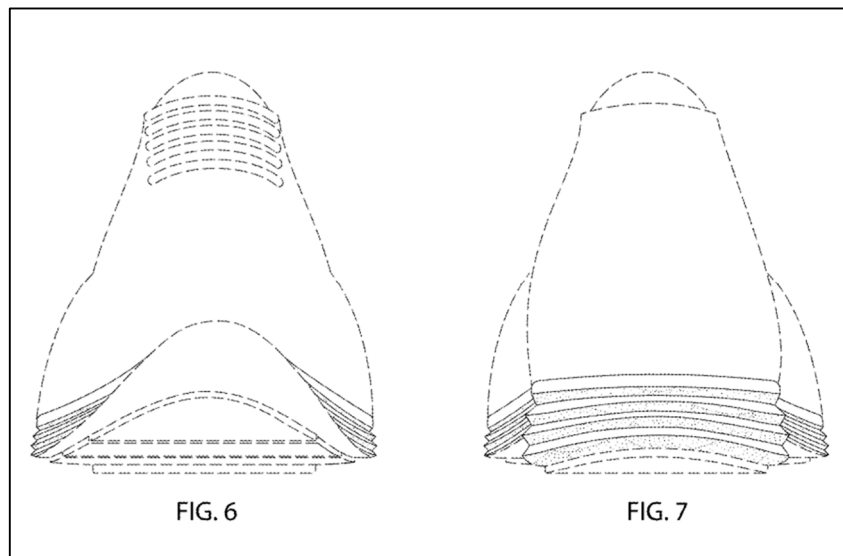
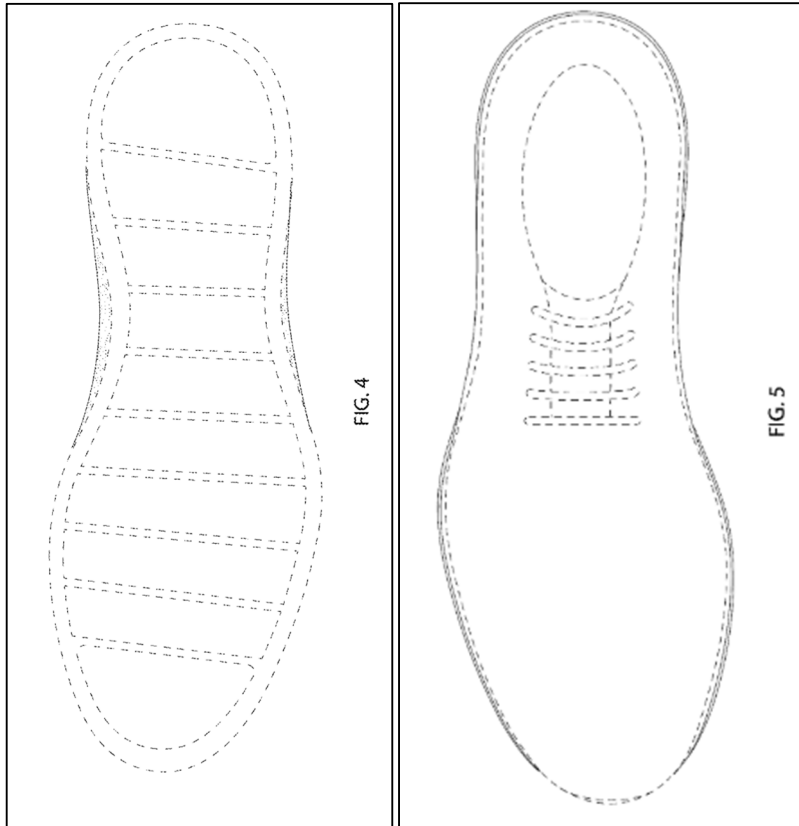


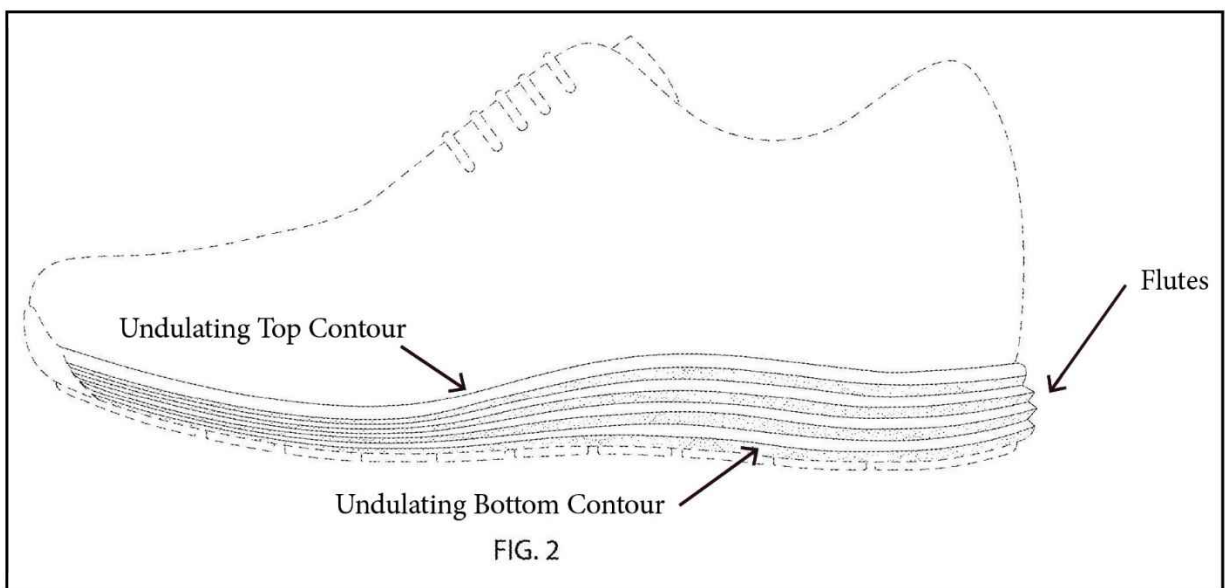
FIG. 3



EX1001, FIGS. 1-7.

The “wavy” overall visual appearance of D’969 is captured by rolling or undulating curves (i.e., peaks and valleys) along the top and bottom contours of the

monolithic midsole with four flutes having proportionally varying thickness extending along the length of the midsole and around the heel. EX2036, ¶78. The flutes vary in thickness between the contours, with the upper flute being less compacted and rounder as compared to the bottom flutes. *Id.* Representative FIG. 2 of the D’969 is annotated below that reflects this appearance:

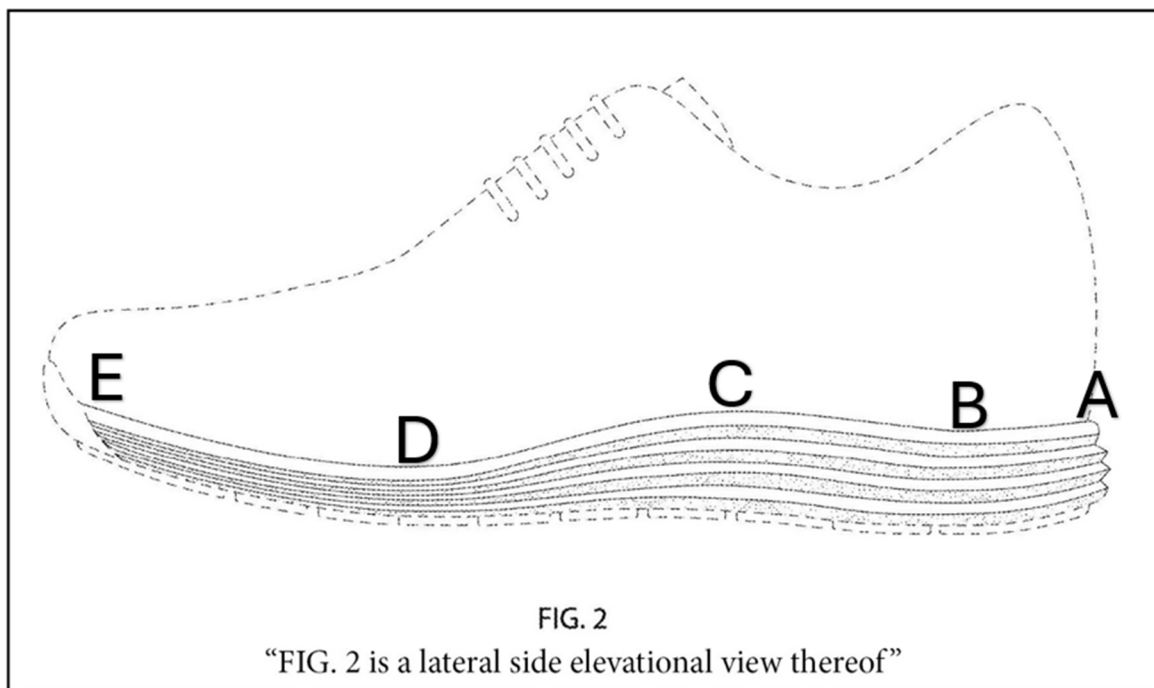


EX1001, FIG. 2 (annotated); EX2036, ¶79.

In considering the claimed design as a single, unified form (rather than a series of “sections” and “layers” as Petitioners’ expert Delgatty does), the top and bottom undulating contours along with the associated change in thickness between them define the silhouette of the midsole and are of the most prominent features. EX2036, ¶80. The overall visual appearance of the D’969 design does not depend on analyzing these curves or portions of the midsole in isolation. *Id.*, ¶81. Rather, the

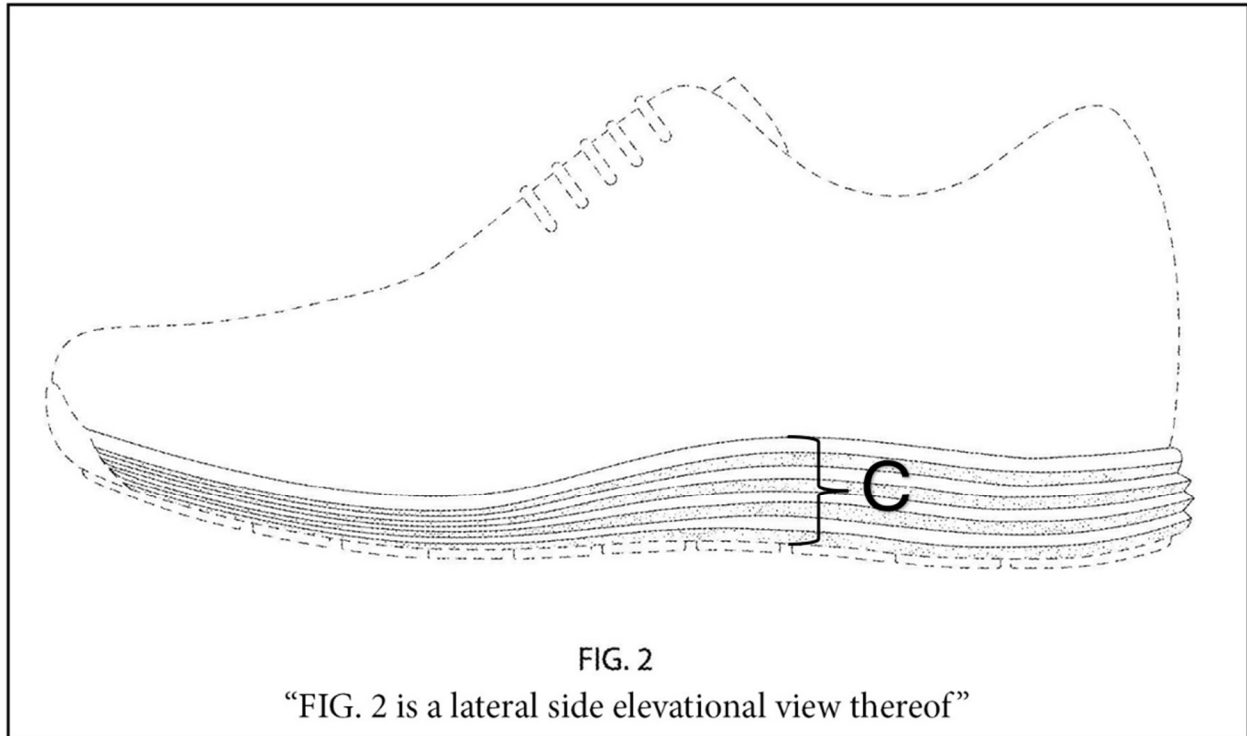
relative relationship and magnitude of the curves and how they interact are important considerations. *Id.*

The top contour of the midsole silhouette forms a flowing, undulating upper boundary. *Id.*, ¶82. As shown in annotated FIG. 2 below, from the rearmost point of the midsole at point A, the top contour slopes downward from the heel to a valley at point B, rises gradually through the midfoot to point C, and then descends toward the forefoot at the valley at point D before curving upward again towards the toe at point E. *Id.*



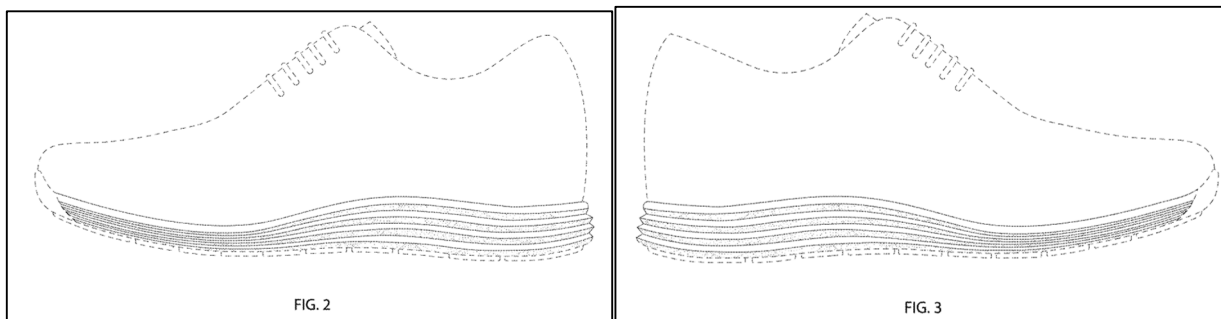
EX1001, FIG. 2 (annotated); EX2036, ¶82. The bottom contour follows a generally undulating path that is flatter but broadly corresponding to the curve of the top contour. EX2036, ¶82.

The height between the top and bottom contours (i.e., the thickness of the midsole) varies longitudinally throughout, with the thickest portion located at point C, which displays a visually appreciable high peak along the top contour of the midsole at the midfoot:



EX1001, FIG.2; EX2036, ¶83 (annotated). Moving away from point C towards the heel of the midsole, the midsole thickness is reduced. EX2036, ¶83. Going forward from point C, the descent or slope in the midsole is smooth but faster, reaching a considerably smaller thickness at the ball of the foot and toward the toe. *Id.*

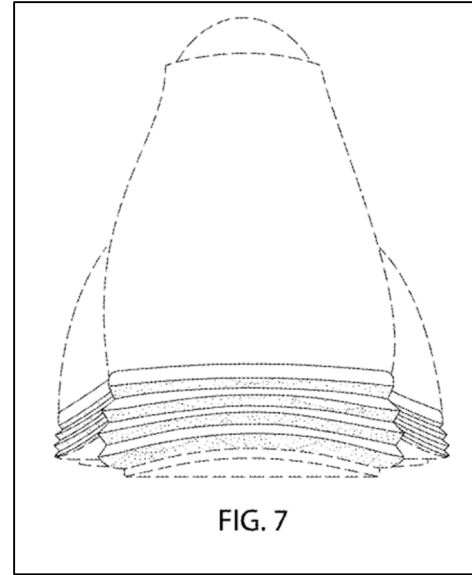
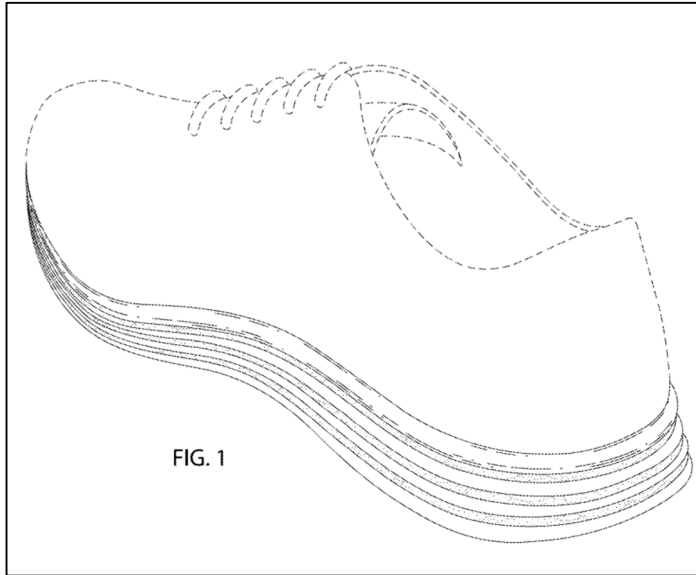
FIG. 3 displays mirrored curves in the medial side of the midsole as in the lateral side shown in FIG. 2:



EX1001, FIGS. 2-3.

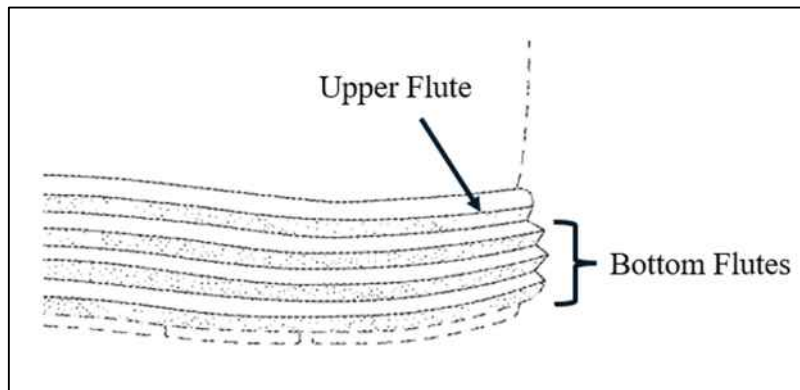
The thickness of each bottommost flute also varies along the longitudinal length of the midsole and varies proportionately to the overall thickness of the midsole at any given spot. EX2036, ¶85. More specifically, the thickness of each bottommost flute expands as the height of the midsole expands, and the thickness of each bottommost flute contracts as the thickness of the midsole reduces. Each of the three bottommost flutes have the same thickness as the other bottommost flutes at any given spot. *Id.* In contrast, the top portion of the upper flute remains at a consistent thickness throughout the length of the midsole. *Id.*

The flutes shown in the lateral and medial sides wrap around to the heel section, as seen in the perspective and rear elevational view of FIG. 1 and FIG. 7, respectively:



EX1001, FIGS. 1, 7.

Furthermore, as shown in the annotated excerpt from FIG. 2 below, the upper flute is also rounded relative to the more pointed bottom three flutes:



EX1001, FIG. 2 (excerpted and annotated); EX2036, ¶87. The rounded upper flute permits a smoother transition to the disclaimed upper portion of a shoe beyond the upper most flute—whether to a welt, a shoe upper, or otherwise. *Id.*

IV. PETITIONERS' IMPROPERLY CONSTRUE THE CLAIMED D'969 DESIGN

Even though Petitioners acknowledge the Federal Circuit's “‘preferable course’ for construing design patents will not involve ‘a detailed verbal description of the claimed design,’” Pet., 25, Petitioners do just that. And in doing so, Petitioners “cross the line” by providing a detailed verbal description of D’969 that narrowly focuses on four “key features” rather than the design as a whole. Petitioners then look for *only* those four “key features” in the prior art to reach conclusions that the prior art anticipate D’969 while ignoring other features that impact the overall visual impressions of D’969 and make it distinct from the prior art. This is precisely the risk that Federal Circuit cautioned against in *Egyptian Goddess*—“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. Unlike *Egyptian Goddess*, Petitioners’ characterizations of the four “key features” are inaccurate and meaningfully misconstrue D’969 to minimize its distinctiveness from the prior art.

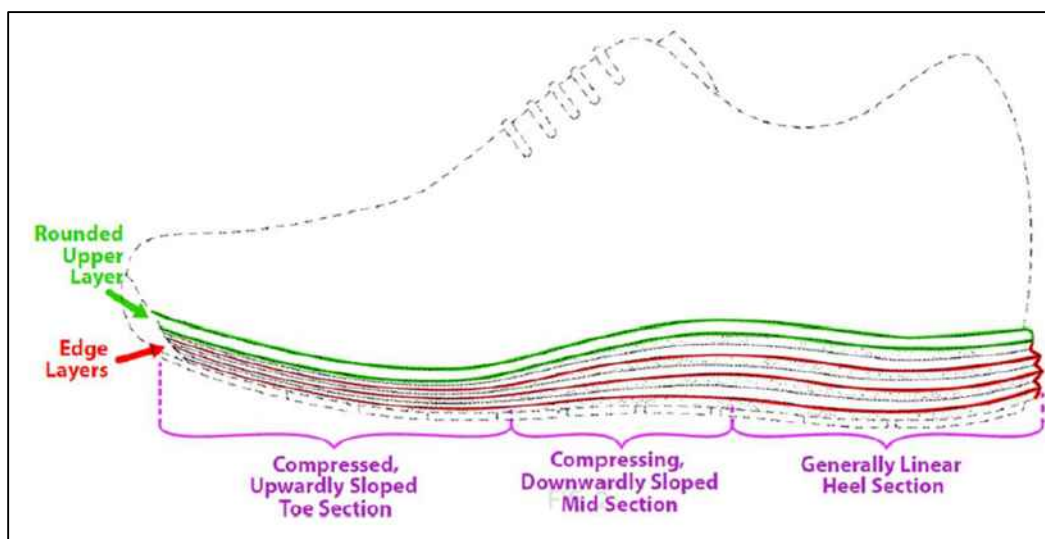
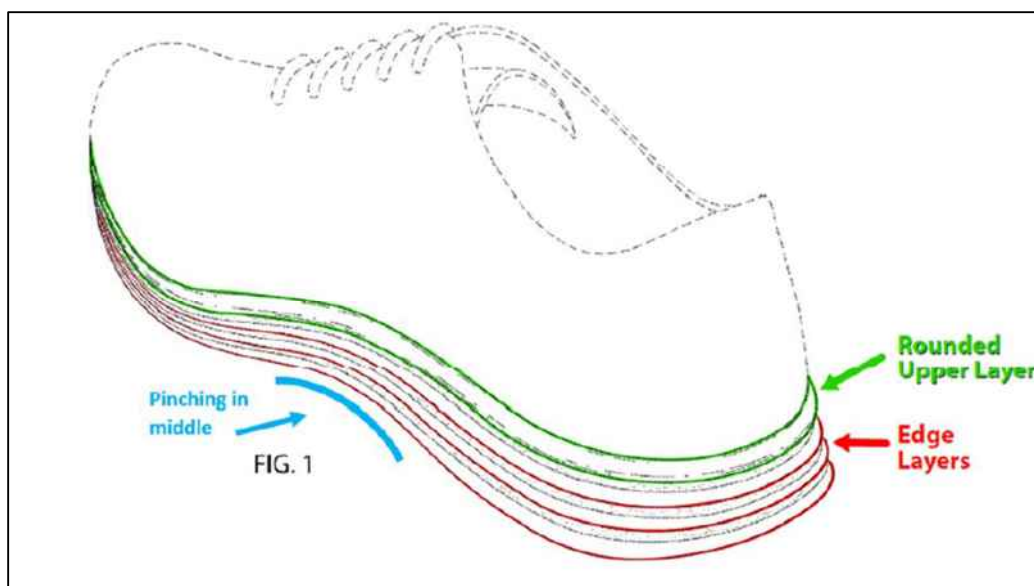
A. Petitioners’ Feature-By-Feature Comparisons Fail to Consider Overall Visual Appearance

The Petition focuses *exclusively* on four purportedly “key features” of D’969 that Delgatty provides in his claim construction:

- (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 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 Pet., 25-26 (quoting EX1003, ¶¶62-66). Delgatty admitted during his deposition that he was “breaking the midsole up into areas to focus on.” EX2037, 248:3-5; see also *id.*, 176:16-18 (stating the “overall visual impression that [the heel section] gives is that it’s generally linear”).

Petitioners do not merely “point out” obvious features of D’969 as compared to the prior art, such as a shape having three sides instead of four sides or being hollow instead of solid as in *Egyptian Goddess*. 543 F.3d at 680-81. Rather, Petitioners assign generic (and inaccurate, *infra*) verbal descriptions and self-imposed, color-coded boundaries that distort D’969 (and the prior art, *infra*) to make the designs appear more visually similar, EX2036, ¶¶92-93:



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

For example, Petitioners’ circumscription of the “rounded upper layer” in green and the “edge layers” in red creates an unnatural boundary differentiator, which would not be appreciable in comparing the native images with the patented figures. EX2036, ¶93. Petitioners also segment D’969 into three arbitrary sections bracketed by purple annotations, causing the otherwise seamless midsole to appear

disjointed, and then place those same annotations on the prior art to make them appear more similar, as shown below. *Id.* Demonstrating this, Delgatty modified where the annotations for the “Mid Section” should appear on D’969 during his deposition to be more similar to the annotations placed upon C11947:

I actually feel like the annotations on the ’969 patent could have been a little bit longer in that front section, to be honest....I do feel that...where it says compressingly downward [sic], the midsection of the annotated ’969 patent...there’s a pretty significant amount of distance between...the forward-most edge of the annotated midsection and where that lowest part of the dip is. So...I think you could actually take the annotations from the C11947 and translate them exactly over to the ’969 patent and they would actually line up better...as the annotation.

EX2037, 227:1-228:22. As Delgatty conceded during his deposition, color can impact an ordinary observer’s perception, EX2037, 7:2-14, 167:3-11, 261:16-21, and his color-coded feature-by-feature analysis does just that—it creates a disjointed visual impression that makes D’969 appear more similar to the prior art than the unannotated images themselves. EX2036, ¶93.

Petitioners’ selective breakdown of D’969 into four color-coded “key features” is procedural error because it improperly leads away from consideration of the design as a whole and fails to consider the overall visual impressions of D’969

and the prior art. *See Ethicon Endo-Surgery*, 796 F.3d at 1335 (“An element-by-element comparison, untethered from application of the ordinary observer inquiry to the overall design, is procedural error.”); *Crocs*, 598 F.3d at 1303 (“This case shows the dangers of reliance on a detailed verbal claim construction. The claim construction focused on particular features of the [] patent design and led the [fact finder] away from consideration of the design as a whole.”). This is fatal to all of Petitioners’ grounds.

Even Delgatty conceded that he “do[es]n’t know if the ordinary observer would, per se, break [a shoe] down into different components,” yet that is exactly what Petitioners do with the midsole. EX2037, 54:15-55:2. Indeed, the Federal Circuit has repeatedly confirmed that the hypothetical ordinary observer would not. *See, e.g., Ethicon Endo-Surgery*, 796 F.3d at 1335; *Crocs*, 598 F.3d at 1303. Patent Owner’s expert Rake agrees that neither an ordinary observer nor a DOSITA would do so. EX2036, ¶¶90-91.

Petitioners then proceed to look for **only** these four “key features” with side-by-side comparisons of color-coded images of D’969 and the prior art to arrive at their incorrect conclusion that D’969 is substantially similar (or visually similar for obviousness) to the prior art. Pet., 39-46, 55-62, 68-75; EX1003, ¶¶84-96, 115-128, 143-156; EX2036, ¶¶112-114. Delgatty confirmed his sole reliance on a feature-by-feature comparison during his deposition:

Q. In your analysis of Nike, you assess whether each of the same four key features that you identified for D969 are present, right?

A. Yes.

Q. And then you include claim charts that do...a feature-by-feature comparison between D969 and Nike, right?

A. Yes.

Q. And then based on that side-by-side or that feature-by-feature comparison...of those four key features, you conclude that Nike and D969 are substantially the same, and then as a result, D969 is anticipated by Nike, right?

A. I do state that it is anticipated, yes.

Q. Based on your comparison of those four key features?

A. Yes.

EX2037, 296:16-297:18; *see also id.* at 222:10-223:8, 289:1-290:3 (confirming an identical feature-by-feature analysis for C11947 and C12652).

Tellingly, Petitioners never present the prior art next to D'969 *without* annotations:

D'969

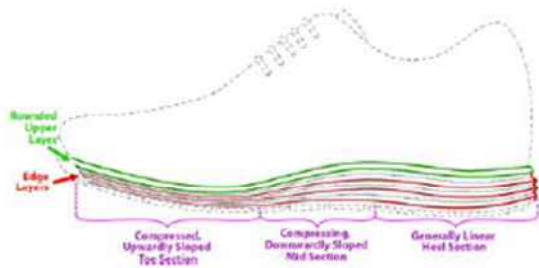


Fig. 2

C11947



(00:19:275)

D'969

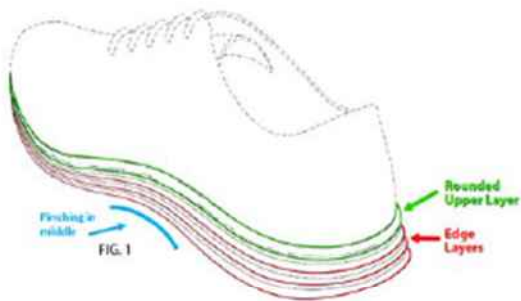


FIG. 1

Cole Haan C12652



Perspective

D'969

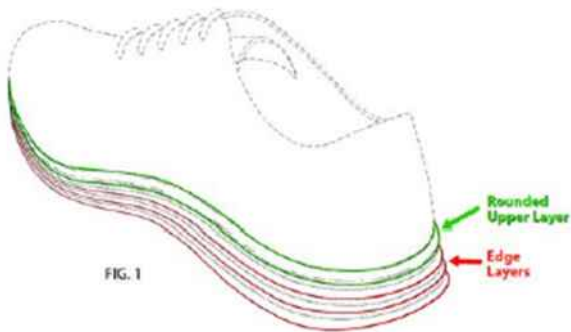
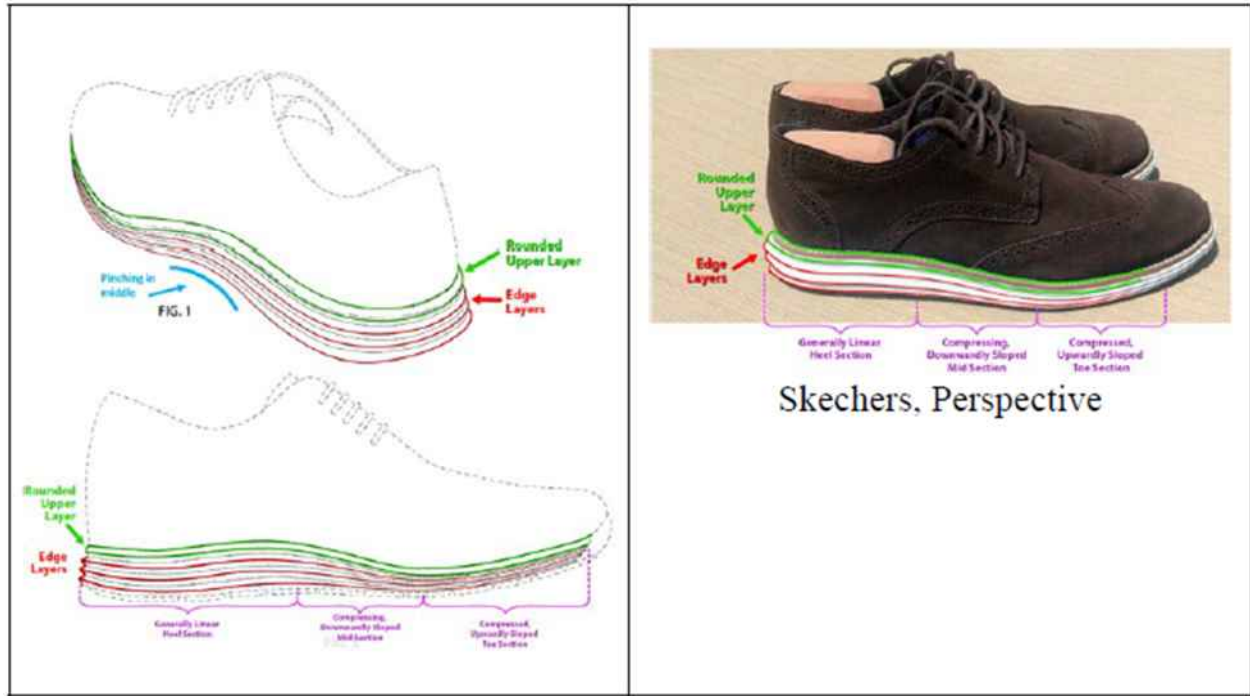


FIG. 1

Nike





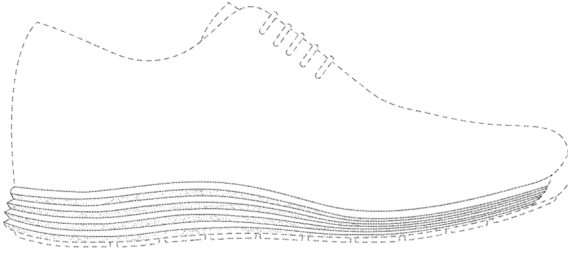
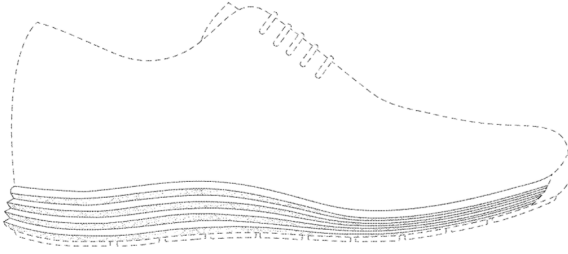
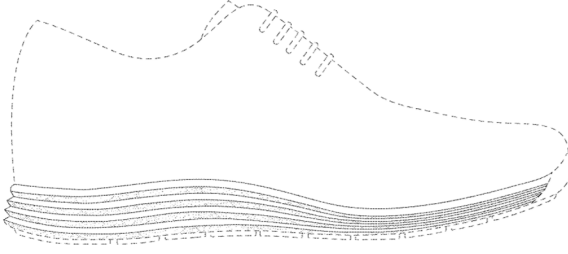
See, e.g., Pet., 48, 62, 87, 88. The added identical colored markings and labels across the different midsole designs immediately ties them together visually by creating a standardized pattern that the brain recognizes as a unified set, regardless of the actual design, and makes them appear more similar than they are. EX2036, ¶113.

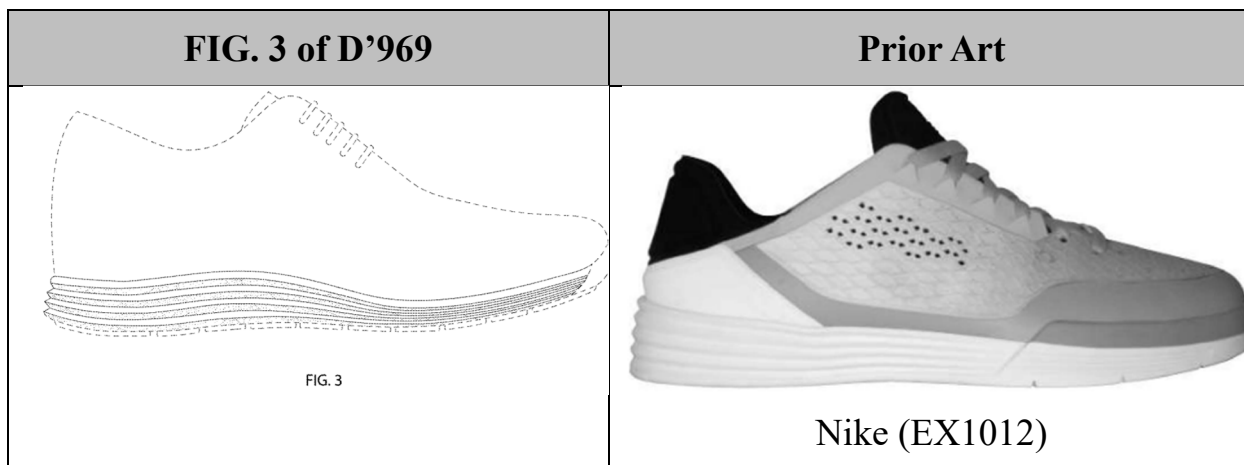
Petitioners’ myopic feature-by-feature analysis fails to consider the design as a whole. *Id.*, ¶114. Although Petitioners purport assign an “overall visual impression of a soft, wave-like midsole design” to D’969 (which is inaccurate, *infra*), they concede that purported “overall visual impression” is merely “a product” of their four “key features”:

The claimed portions of the seven figures of D’969 give an overall visual impression of a soft, wave-like midsole design. 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 layers* slightly *pinch* in the midsection towards the arch of the foot, following the shape of a foot. Figure 1 illustrates the perspective view. See also Fig. 5.

Pet., 26; EX2036, ¶¶94-97. Even Petitioners’ purported “Overall Design” sections are merely a recitation of these same “key features.” See Pet., 47, 63, 75 (“*The four features* described above in [the prior art design] *come together as a whole* to form substantially the same design as claimed in the ’969 patent.”) (“the overall impression created—the wave-like pattern *resulting from the four features discussed*”); EX2036, ¶¶115-119. Reducing D’969 into individual parts and then representing that those parts make up the design “as a whole” violates the law and the concept at the heart of the Gestalt principles of visual perception discussed by Rake—that the whole is greater than the sum of its parts. EX2036, ¶97. Moreover, Petitioners carefully selected “soft” and “wave-like” to describe D’969 rather than the more definitive “wavy” in another attempt to make D’969 design seem more like to the prior art, each of which has noticeably less movement through the length of the midsole. *Id.*, ¶95.

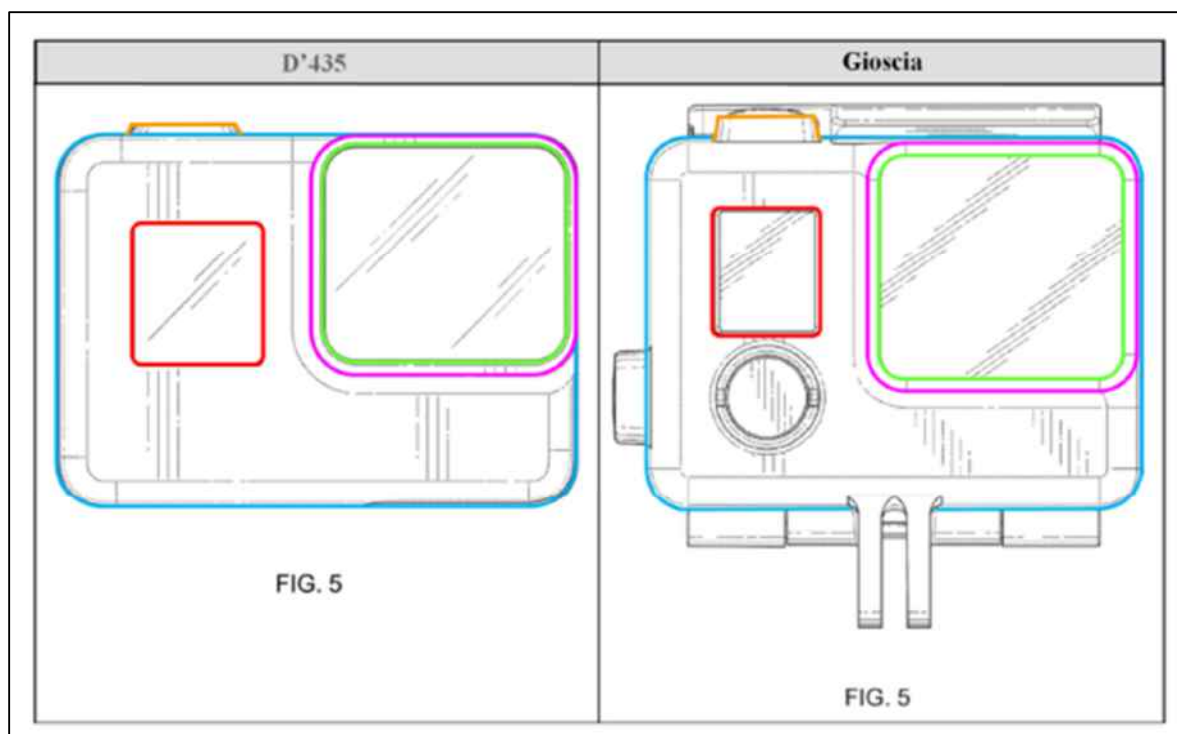
When the prior art is situated next to D'969 in their native forms (without annotation), D'969 and the prior art do ***not*** appear substantially similar and their differences are quite evident, as shown below:

FIG. 3 of D'969	Prior Art
 FIG. 3	 C11947 (EX1007)
 FIG. 3	 C12652 (EX1011)
 FIG. 3	 Skechers (EX1017)



EX2036, ¶¶120-121. Indeed, C11947, C12652, and Skechers resemble each other, making D'969's wavy overall appearance from repeated undulating curves stand out from this crowded field of prior art. EX2036, ¶120; EX1005; EX1016.

The Federal Circuit has recognized, “as a rule, the illustration *in the drawing views is its own best description.*” *Crocs*, 598 F.3d at 1302–03 (quoting M.P.E.P. §1503.01 (8th ed. 2006)). Petitioners’ skewed graphics and detailed verbal description, however, improperly distort both D'969 and the prior art and lead the ordinary observer away from their overall visual impression. In fact, in *Arashi Vision*, the Board declined to consider a petitioner’s colored annotated drawings when denying institution. *Arashi Vision*, IPR2024-01434, Paper 9 at 25. There, the petitioner, like Petitioners here, had color-coded annotations of several features of the claimed camera design with the asserted art, as shown below:



Id. at 24. The Board “d[id] not find Petitioner’s annotated figures to be particularly helpful in comparing the overall visual effect of the designs because they fail to take into account the overall visual impression of the design on which they are based” and thus declined to rely on the petitioner’s annotated figures in its analysis. *Id.* at 25. Like in *Arashi Vision*, the Board should give no weight to Petitioners’ detailed verbal description and annotated figures here and should evaluate D’969’s unannotated figures against the prior art using unannotated, viewpoint-matched,

side-by-side comparisons, which as discussed below demonstrate that D’969 is not substantially similar to the prior art.³

B. Petitioners’ Claim Construction Mischaracterizes and Ignores Features that Contribute to D’969’s Overall Visual Impression

Petitioners’ detailed verbal description of D’969’s “key features” do not accurately reflect D’969 and instead are more thinly-veiled attempts, like Petitioners’ annotations, to make D’969 appear more similar to the prior art.

i. Petitioners’ Use of “Layers” is Misleading

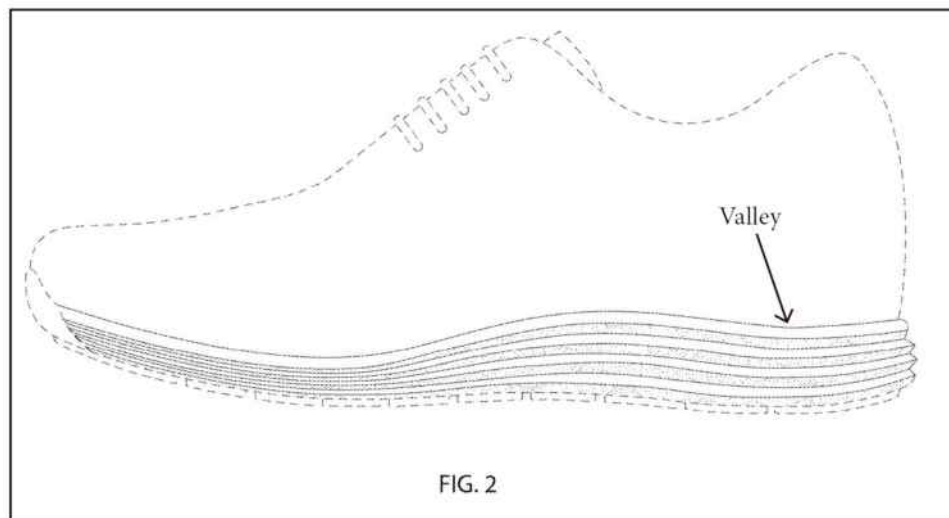
Petitioners’ verbal description of the “three ridged edge layers” and the “rounded upper layer” as “layers” ignores D’969’s prosecution history. During prosecution, Applicant repeatedly referred to the same features as “flutes.” EX1002, 69. But rather than adopting Applicant’s chosen verbal description, Delgatty testified that he “believe[s] that ‘ridged-edged layers’ is maybe *a little bit more descriptive* than what, you know, what a ‘flute’ is.” EX2037, 161:11-14. But that is precisely the problem. Delgatty’s replacement verbal descriptor “layer” inaccurately suggests D’969 consists of multiple layers “resting atop” one another rather than a single, monolithic component with protruding flutes, as actually depicted in D’969. EX2003, ¶47; EX2037, 147:16-148:21; EX2036, ¶100.

³ Viewpoint-matched comparisons are not always available for the prior art making a side-by-side comparison impossible. *Supra* §VI.B, I.

Petitioners’ use of “layers” also is another attempt to make D’969 seem more like C11947 and C12652 because Petitioners assert (incorrectly) that another layer in those designed that rests atop the midsole and is made from a different material—i.e., a welt—may be considered part of the midsole despite being a separate component. EX2036, ¶110; EX1003, ¶108 (describing “the meeting of the welt material with the rubber material[]”), ¶180 (“the leather welt”); *infra* §VI.A.ii.

ii. *Petitioners’ “Generally Linear Heel Section” Ignores the Obvious Valley in the Heel of the Midsole*

Petitioners’ characterization of the “heel section” as “generally linear” suggests a lack of curvature in this portion of the midsole. But that is not so. D’969 contains a noticeable valley within Petitioners’ “heel section”:



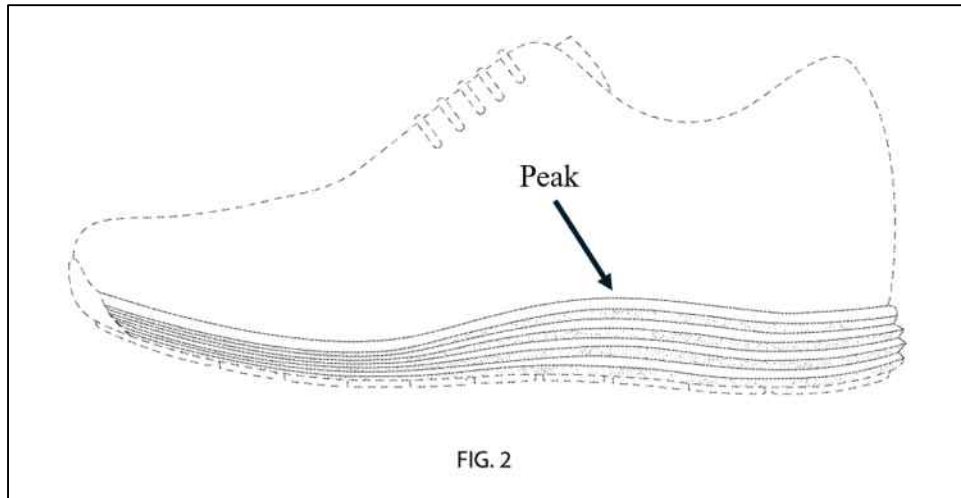
EX2036, ¶103. Even Delgatty readily admitted in his deposition that “[t]here is a slight amount of curvature” to the heel section. EX2037, 174:15-177:1. While Delgatty dismisses this curvature as “slight” and “minor” in isolation, *id.*, he fails to

account for the valley's contribution to the wavy overall visual impression along with the other undulating curves of the midsole.

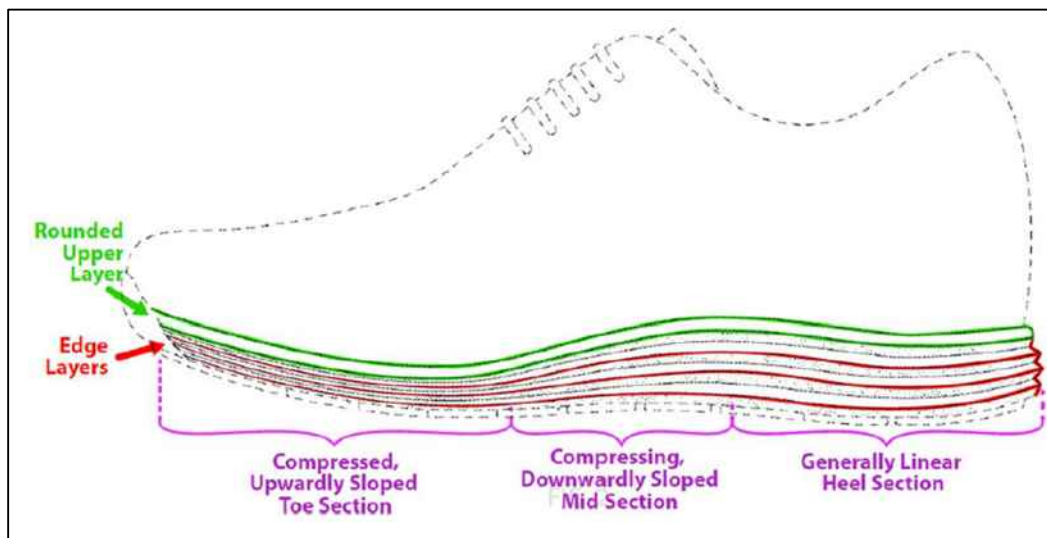
This valley contributes an undulation in the heel of the midsole that together with the more significant undulation in the rest of the midsole create rolling curves that contribute to the wavy overall visual impression. EX2036, ¶104. The valley is noticeable because the flutes also compress in thickness at this point as they move toward the heel. *Id.* Indeed, the valley contributes to D'969's overall distinctiveness because, as discussed below, no prior art exhibits a similar curvature or compression of the flutes, and they are indeed linear. *Id.*, ¶105. Petitioners' choice to described D'969's heel as "generally linear"—when it is clearly not—is yet another attempt to make D'969 seem more like the prior art. *Id.*, ¶102.

iii. Petitioners' Segmentation Obscures the Peak at the Midfoot

Petitioners' delineation of "a generally linear heel section" and "a downwardly sloped midsection in which the ridged edges are compressed (i.e., a decrease in height)" fails to acknowledge the prominent peak at the midfoot. This prominent peak is a visual created by the relationship of the curves of the contours with the varying thicknesses of the midsole along its length. EX2036, ¶107. In particular, it is defined by the valley in the heel along the top contour of the midsole, its crest or high point at the midfoot, and the valley in the forefoot formed as the thickness of the midsole sharply decreases in the center:



Id. Delgatty acknowledged the existence of this peak (or high point) in his deposition. EX2037, 237:3-18. However, Petitioners’ annotations segmenting the monolithic D’969 midsole into three sections places the peak at the intersection of the “heel section” and the “mid section”:

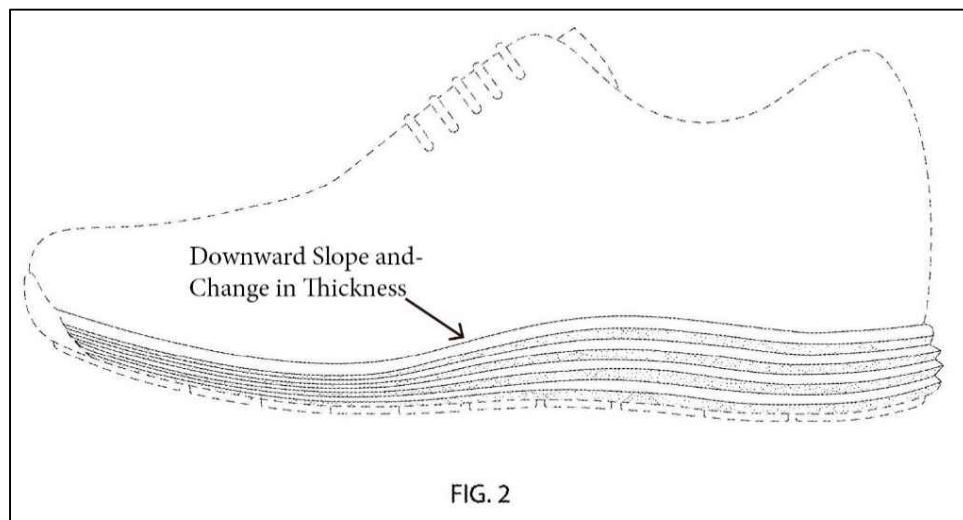


Pet., 27-28 (citing EX1003, ¶¶ 67, 68). This results in the peak not fitting into either section, and Petitioners ignore it entirely in their “key features” and subsequent feature-by-feature analysis. The peak, together with the undulating contours and

associated changes in thickness, both to the overall midsole and proportionally to the flutes, create rolling curves (like a wave) that contribute to the wavy overall visual impression. EX2036, ¶108. Indeed, this peak contributes to D’969’s overall distinctiveness because, as discussed below, no prior art exhibits a similar peak at the midfoot or otherwise. *Id.*

iv. Petitioners’ Do Not Address the Speed of the Central Slope

Petitioners’ characterization of “a downwardly sloped midsection in which the ridged edges are compressed” as “i.e., a decrease in height” fails to account for the speed of the top contour’s descent as it slopes downward in the center and the associated change in thickness of the midsole in the center due to a less significant change in the bottom contour:



EX2036, ¶109. These features are significant when compared to the prior art, and Petitioners’ failure to address the *extent* of the “decrease in height” and compression

of the flutes again shows their attempts to make D’969 seem more like the prior art. *Id.*, ¶110.

Delgatty acknowledged in his deposition that D’969 has a steeper slope than the prior art. EX2037, 229:15-230:2, 302:12-22. Yet, Petitioners and Delgatty characterize these differences as “minor.” *See, e.g.*, Pet., 42-43; EX1003, ¶90. Notably, neither the Petition nor Delgatty’s declaration provide any reasons for this opinion. Instead, they cite to portions of the Petition and Delgatty’s declaration, respectively, that contain no reasons whatsoever and are irrelevant to the subject matter. *See, e.g.*, Pet., 42-43; EX1003, ¶90; *see also* EX2037, 231:11-234:16.

When asked “but you don’t give any reasons for that statement, right?,” Delgatty responded, “I don’t know why I would. I mean,...that’s my opinion, so...I don’t necessarily give a reason why I would state that.” EX2037, 234:11-16. Delgatty’s unsupported, conclusory opinion is insufficient to meet Petitioners’ burden to establish substantial similarity between D’969 and the prior art. Indeed, the Board has consistently held that such expert “[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. v. Power2B Inc.*, IPR2022-00325, Paper 36 at 49-50 (P.T.A.B. June 26, 2023); *see also Hesai Tech. Co. Ltd. v. Ouster, Inc.*, IPR2023-01458, Paper 8, at 14-17 (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 Consolidated Trial Practice Guide (Nov. 2019)); *Nichia Corp. v. Document Sec. Sys., Inc.*, IPR2018-01165, Paper 28, at 58-59 (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 3 (Aug. 2018)).

Indeed, even if “minor” as Petitioners assert (and it is not), such a difference in slope would be more apparent to an ordinary observer in the crowded field of midsole design. EX2036, ¶111. When pressed on where he would draw the line at a difference in slope that would impact the overall visual impression, Delgatty provided an arbitrary response of “twice as high as it is now” “if this was a platform shoe for a woman.” EX2037, 243:16-244:6. But that ignores the reality that the D’969 and the prior art are not “a platform shoe for a woman.” *Id.* Even without dramatically doubling the heel height, the differences in the speed of the top contour’s downward slope and the associated change in thickness of the midsole impacts the overall visual impressions of D’969 and the prior art and is readily apparent, as shown below. EX2036, ¶111.

In *Arashi Vision*, the petitioner failed to address ***all*** differences between the claimed design (i.e. focusing on “the use of rectangular buttons” and ignoring “dimensions and corner curves of those buttons as well as their position on the body

of the camera”) and each asserted primary reference. IPR2024-01434, Paper 9 at 27-28. As in *Arashi Vision*, Petitioners “have selectively chosen certain design features [i.e., their four “key features”] to address while deliberately ignoring other design features,” including the valley in the heel, the peak at the midfoot, and the extent to which the top contour slopes downward at the middle and the associated change in thickness. *Id.* at 27-28. Here, too, “[t]his selective use of discrete design characteristics suggests that the analysis is driven by a hindsight reconstruction of the invention rather than the objective teachings of the references.” *Id.*

Petitioners do not provide an adequate understanding of the overall visual impression of D’969. Accordingly, Petitioners’ inaccurate verbal description and misleadingly annotated side-by-side comparisons between D’969 and the prior art should be disregarded when assessing whether D’969 is anticipated or rendered obvious by the prior art.

V. PETITIONERS’ EXPERT MISAPPLIES THE ORDINARY OBSERVER TEST

Federal Circuit precedent is clear that the ordinary observer test is to be applied “through the eyes of an observer familiar with the prior art.” *Egyptian Goddess*, 543 F.3d at 677; *see also id.* (“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.”). Petitioners’ expert Delgatty, however, ignores this fundamental requirement. For example, he

testified that “the ordinary observer...would have access to looking at thousands of shoes,” but he “do[es]n’t know if they would understand or know all of those shoes.” EX2037, 68:12-20. He further testified that he “believe[s] *a lot of ordinary observers would not even know what a midsole is* if you were to ask them.” *Id.*, 57:1-16. He also testified that “sneaker freaks that are really into shoes” “are probably *beyond that level of what an ordinary observer would be.*” *Id.*, 57:13-58:8. The hypothetical ordinary observer whose lens Delgatty is supposed to be applying, however, would necessarily understand shoes and know what a midsole is—but that is not the ordinary observer Delgatty considered when forming his opinions.

Furthermore, Delgatty acknowledged that the field of midsole design is crowded, testifying that “there’s thousands of shoes on the market at any given time” and that those thousands of shoes have different midsoles that are also available as part of the shoe. *Id.*, 67:20-68:11. However, he then testified that, “[i]n [his] experience, *ordinary observers are not keen eyes* and a lot of times would not understand very small, insignificant differences between one shoe to another.” *Id.*, 70:4-8. Again, this runs contrary to Federal Circuit precedent. The Federal Circuit has recognized that, “[w]hen the differences between the claimed and accused design 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.” *Egyptian Goddess*, 543 F.3d at 676. Yet, when Delgatty was asked whether he

believe that an ordinary observer’s eyes would be drawn toward what he considers a “minor” difference in downward slope between D’969 and C11947 in the mid-section (since he considers the toe section and heel section of D’969 and C11947 to be substantially similar), he testified that, “I don’t think they would necessarily be drawn to any one aspect of the design[,]” EX2037, 246:4-247:1—in direct contradiction to *Egyptian Goddess*.

This is critical because Delgatty either completely ignores differences between D’969 and the prior art or dismisses them as “slight” or “minor” without any explanation. *See, e.g., id.* at 174:19-175:11 (referring to the dip in the heel as “slight” and not “anything dramatic” but acknowledging that one would see it), 233:15-234:16 (admitting opinion that difference in sloping angle between C11947 and D’969 is “minor” was based solely on his own opinion without reasoning); EX1003, ¶92 (“minor discontinuity in the rounded layer can be accounted for by leather welt between the upper and the midsole[.]”), ¶121 (noting again a “minor difference in sloping angle does not affect the design as a whole[.]” and adding that “an ordinary observer would not have considered such a minor difference, it noticed at all”).

However, in crowded fields, such as shoe midsoles, “the differences in small details will have more weight than in less crowded arts.” *A&A Glob. Imports, Inc. v. Lerman Container Corp.*, IPR2024-01138, Paper 7 at 28 (P.T.A.B. Jan. 22, 2025).

Rake agrees that the field of shoe midsoles is a crowded field. EX2036, ¶51. Against this backdrop, an ordinary observer would have been attuned to even subtle differences between D’969 and the prior art and particularly the more noticeable differences in the undulating side profile that Delgatty cursorily dismisses.

Because Delgatty misapplies the ordinary observer test, his opinions and testimony applying that test should be disregarded.

VI. PETITIONERS FAIL TO ESTABLISH THAT D’969 IS ANTICIPATED OR RENDERED OBVIOUS BY THE PRIOR ART

A. Ground 1: Petitioners Fail to Establish That C11947 Anticipates D’969

i. Petitioners Fail to Establish That the Overall Visual Impressions of D’969 and C11947 are Substantially Similar

As discussed above, Petitioners’ assertion that C11947 anticipates D’969 is premised on a legally improper and factually inaccurate feature-by-feature comparison that does not account for the overall visual impressions of D’969 and C11947. *Supra* §§IV, V; Pet., 39-46. This failure is fatal to Ground 1.

Moreover, when viewed side-by-side, D’969 and C11947 appear significantly different in overall visual appearance:

D'969 (EX1001)

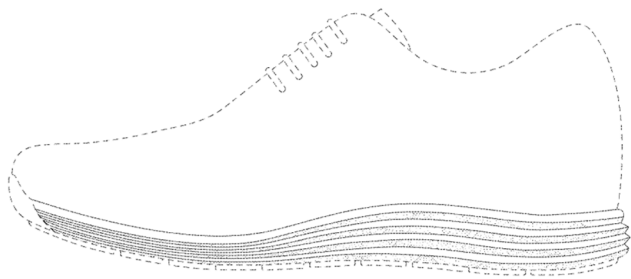


FIG. 2

FIG. 2

C11947 (EX1007)



p.3

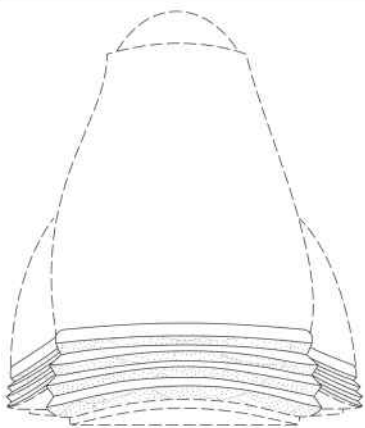


FIG. 7



p.17

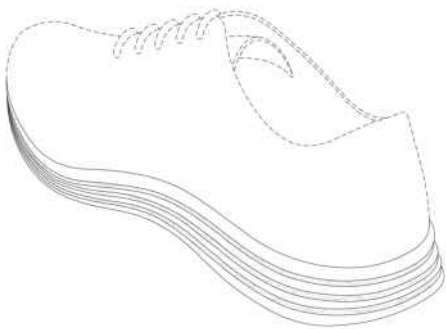


FIG. 1



p.15

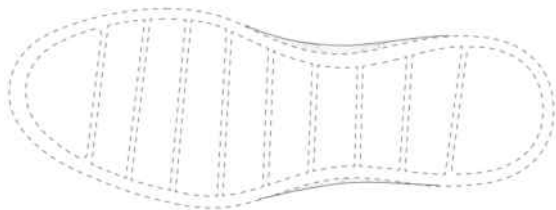
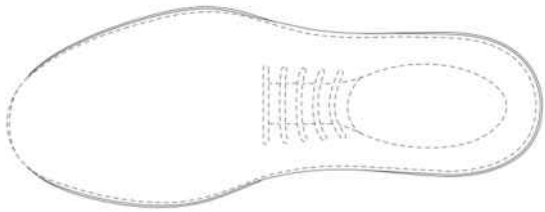
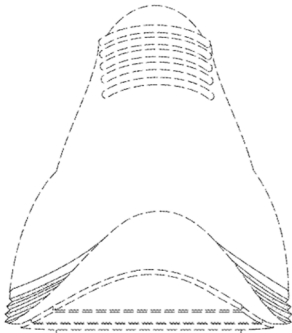


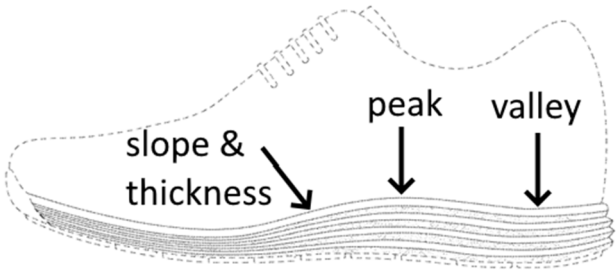
FIG. 4



p.7

D'969 (EX1001)	C11947 (EX1007)
 FIG. 5	 p.5
 FIG. 6	 p.11

EX2036, ¶125. As discussed above, the overall visual impression of D'969 is wavy. *Id.*, ¶¶78, 126. C11947 is much flatter as a whole, without a valley in the heel or a peak at the midfoot and with a slower downward slope and a more gradual change in thickness in the center of the midsole, as identified by the following annotations:

D'969	C11947
 FIG. 2	

Id., ¶127. Indeed, Delgatty confirmed in his deposition that the highest point in C11947 is “right around the heel area,” EX2037, 328:18-19—not at the midfoot as in D’969. He also confirmed that that downward slope is not as steep as D’969. *Id.*, 229:15-230:2. And he admitted that “it’s very difficult for [him] to tell...whether or not there is or is not...a slight curvature in that heel area” of C11947 and that he would “have to take some measurements and...do some further investigation” to be able to tell. *Id.*, 251:2-252:15.

The differences in overall visual impressions of D’969 and C11947 are noticeable in silhouettes of the midsoles (even including the improper welt, *infra* §VI.A.ii):

D’969	C11947
	C11947- Midsole + Welt 

EX2036, ¶130. As explained by Rake, under the Gestalt principle of Figure/Ground, an ordinary observer perceptually distinguishes the principal object from its surrounding background in order to reduce visual ambiguity, thereby emphasizing the significance of the overall silhouette in assessing design similarity and difference. *Id.*, ¶¶66-67, 130; *Chongqing Qiulong Tech. Corp. Ltd. v. Tanli Power Tech. (Chongqing) Co., Ltd.*, No. 1:23-CV-00442-RP, 2025 WL 3484807, at *4-5 (W.D. Tex. Nov. 13, 2025), *report and recommendation adopted*, 2025 WL 3478516

(W.D. Tex. Dec. 3, 2025) (finding Rake’s use of Figure/Ground more reliable than not for assessing how the ordinary observer will perceive shape, form, and color and declining to exclude his opinions).

ii. Differences Between D’969 and C11947 are Not “Minor” and Impact the Overall Visual Impression to an Ordinary Observer

Without identifying any “variations” between D’969 and C11947, Petitioners assert that any variations between D’969 and C11947 are “minor.” Pet., 48. That is not so. As shown above, C11947 has **no** valley at the heel and **no** peak at the midfoot, and thus **no** rolling or undulating curves along a top contour like D’969, which impacts the overall visual impression. Delgatty testified that the highest point on C11947 in the midsole along the top contour is above the “l” and “i” in the words “generally linear” in his annotations, not at the midfoot like D’969:



EX2037, 332:1-13. It is also readily apparent to an ordinary observer that this high point is not a peak because C11947 slopes downward consistently in the heel and

lacks a valley. EX2036, ¶128. Indeed, Delgatty conceded that, unlike the valley in D’969, he could not identify a valley in C11947 and that the heel section is “probably fairly similar in height” to his identified high point. EX2037, 251:2-252:21, 332:19-333:3. Yet, Petitioners do not acknowledge the “valley” and “peak” of D’969 at all, much less explain why their absence in C11947 is immaterial.

Furthermore, Petitioners provide no reasoning for their assertion that the difference in slope between C11947 and D’969 is “minor.” *Supra* §IV.B; Pet., 42-43 (The referenced section “I.A.1.a” does not exist.). C11947 appears to have a slow downward slope starting from the heel to the ball of the foot that then curves upward toward the toe, rather than a slope starting a midfoot like in D’969. EX2036, ¶128. Both experts agree that downward slope in the center of C11947 is not as steep (or fast) as D’969. EX2036, ¶129; EX2037, 229:15-230:2. To the extent Petitioners later argue that the slope of C11947 is functional and should be disregarded, that argument has been waived. It is also incorrect. *Infra* §VI.F.

Another glaring difference between D’969 and C11947 is the brown welt that Petitioners’ improperly include as part of C11947’s midsole.⁴ In Petitioners’

⁴ The audio transcript of the C11947 video refers directly to the brown, stitched portion as a “welt.” EX2033 at 1-2, corresponding to time stamp 0:31-0:40.

misleading annotations of C11947, Petitioners outline the brown leather welt as part of what they consider the “rounded upper layer” of the midsole:



Pet., 44; *see also* EX1003, ¶180 (referring to the “the leather welt” of C11947).

However, it is well-established that the welt, like that shown in C11947, is not part of a midsole. EX2036, ¶134. The term “welt” refers to the perimeter strip of material (often, leather) associated with the junction between the upper and the sole assembly, which includes the midsole. *Id.*, ¶58. The Petition similarly acknowledges that “the leather welt [is] *between the upper and the midsole.*” Pet., 45. Petitioners’

expert Delgatty likewise admits in his declaration that “[t]he welt can be attached to either the top perimeter edge of an outsole or *the midsole*[.]” See EX1003, ¶40. He further admits that the brown leather welt of C11947 is made of a different material than the blue rubber midsole. *Id.*, ¶108 (describing “the meeting of the welt material with the rubber material”), ¶180 (referring to the “the leather welt” of C11947); EX2037, 282:15-283:5.

During his deposition, Delgatty conceded that his declaration does not “specifically say[] that [the welt is] part of the sole of the shoe[.]” EX2037, 121:16-122:3. Nevertheless, he attempted to justify Petitioners’ improper inclusion of the welt as part of the midsole by testifying that the welt “can be attached to a midsole, and then that whole midsole, complete with the welt around it, would then be bonded to the bottom of [an] upper.” *Id.*, 106:1-18. This testimony, too, reflects that the welt is separate from the midsole. Indeed, while some designs use leather welts for aesthetic purposes rather than attachment purposes, the welt is still a separate part of the midsole just as in traditional welt construction, regardless of whether it is first bonded to the upper, midsole, or outsole. EX2036, ¶¶58-59.

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, 1382 (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))). Here, the title, specification, and sole claim of D’969 recites explicitly “[t]he ornamental design for a shoe **midsole**.” See EX1001. Because the welt of C11947 is a separate article made of separate material than the midsole, Petitioners’ inclusion of the welt in their analysis of C11947 compared to D’969 is legally improper.

Removing the welt from Petitioners’ interpretation of C11947 further evidences differences between D’969 and C11947:

FIG. 2 of D’969	C11947
 Claimed Midsole Only Pet., 9	 Midsole Only EX1007, 3

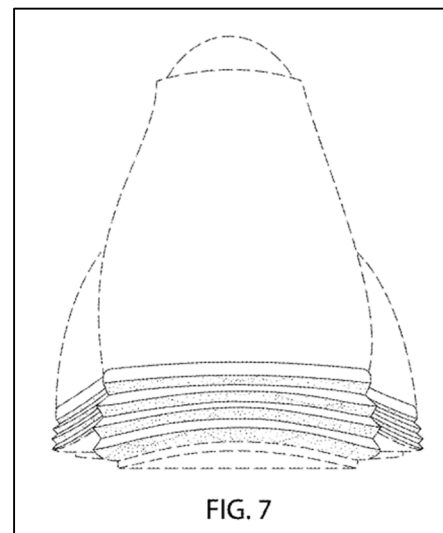
Ex. 2036, ¶134.

Even if the Board were to find that C11947’s welt should be considered when comparing C11947 to D’969, C11947 still does not include a “rounded upper layer” as Petitioners assert. First, from the top plan view in particular, the welt appears as a flat shelf of material with a vertical edge encircling the shoe:⁵

⁵ This is most accurately shown in the toe region due to the angle at which the shoe is resting on the ground. EX2036, ¶¶123, 137.

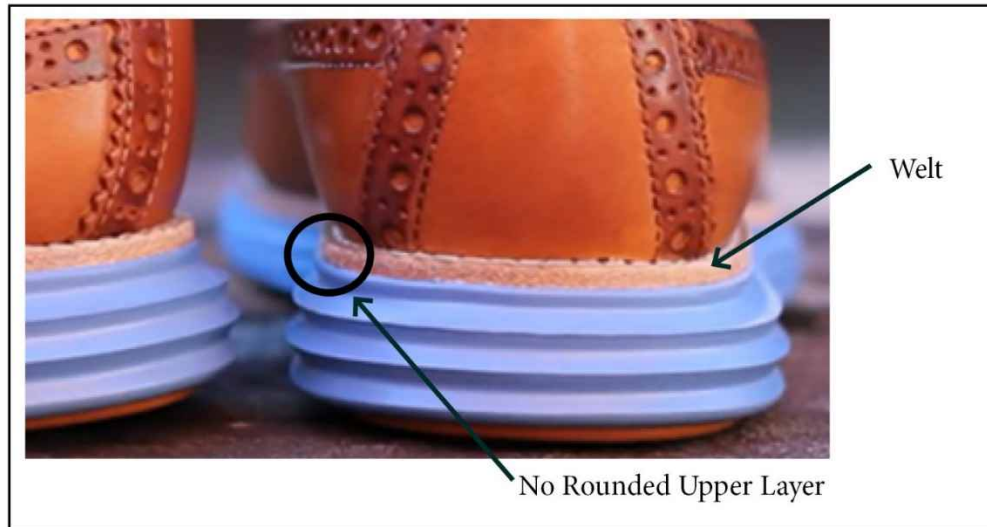


EX2036, ¶136. Indeed, when placed side-by-side without Petitioners’ deceptive annotations, the difference in the roundedness (or lack thereof) in upper layer of C11947 (as construed by the Petitioners) and the upper layer of D’969 is appreciable:



EX1005 at 1:11; EX1001, FIG. 7; EX2036, ¶138.

Second, arrangement of the welt with “the little sliver of blue at the top” that Delgatty “combined with...the brown welted edge” as the “rounder upper layer” presents a disjointed coupling between the midsole and the welt, as seen below:



EX2037, 256:11-18; EX2036, ¶136.

The transition between the leather welt and “blue sliver” of rubber is anything but rounded. EX2036, ¶136. Petitioners acknowledge this as a “minor discontinuity” but dismiss it, stating: “OB would view a midsole from several feet away (not under high magnification) while considering a shoe for purchase, and minor differences in the upper layer would be insubstantial from this viewpoint.” Pet., 45 (citing EX1003, ¶92). During his deposition, Delgatty explained “[t]he basis for this statement is that [his] opinion would be that an ordinary observer would view a shoe midsole from several feet away because that’s typically where...the head of a person as compared to the foot of a person would be, while considering a shoe for purchase.” EX2037, 59:11-60:7.

However, he later conceded that, as part of their purchasing decision, an ordinary observer in October 2015 could have picked up a shoe to look at it or

“perhaps might view it on a shelf at eye level,” and that in either of those instances, the shoe could be much closer to the ordinary observer than several feet away. *Id.*, 62:1-21. He also conceded that an ordinary observer in October 2015 could have purchased shoes online, that websites would have included pictures of shoes that are available for purchase, that he believes an ordinary observer would have had the ability to zoom in to view the details of the shoe more closely, and that, for an ordinary observer sitting at a computer to purchase shoes online, “[p]robably in most cases their head would be closer to the screen” than the distance between a typical person’s head and feet. *Id.*, 63:17-66:9; *see also* EX1005 (YouTube video showing C11947 has several magnified views). Thus, Delgatty’s opinion underlying Petitioners’ dismissal of the disjointed coupling between C11947’s midsole and welt as a “minor discontinuity” cannot be credited.

By failing to address these differences—(1) no valley, (2) no peak, (3) a slower downward slope with more gradual and smaller change in thickness, and (4) a difference in the uppermost flute, regardless of whether the welt is considered—Petitioners have failed to show that the overall visual appearance of D’969 and C11947 are substantially similar.

B. Ground 2: Petitioners Fail to Establish That C11947 Renders obvious D’969

For at least the reasons discussed above, Petitioners’ narrowly focused feature-by-feature analysis and misleading color-coded annotations fail to establish

that C11947 is visually similar in overall appearance to D’969 to a DOSITA, as required by *Graham* factor one. This is also fatal to Ground 2. *See In re Harvey*, 12 F.3d at 1065 (“[T]he Board erred in its determination of obviousness because it ***improperly compared*** the visual impressions of ***selected, separate features*** of prior art to claimed designs, ***rather than visual impression of designs as a whole.***”); *LKQ*, 102 F.4th at 1299 (“We reaffirm that the ‘inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features.’”); *Arashi Vision*, IPR2024-01434, Paper 9 at 27 (finding “Petitioner fails to sufficiently address how its asserted primary reference...is visually similar in overall appearance to the claimed design[]” because “the Petition improperly focuses on individual design concepts rather than overall visual appearance”).

As to *Graham* factor two, which requires “determining the differences between the prior art and the design claim at issue,” *LKQ*, 102 F.4th at 1298, there are substantial differences between D’969 and C11947 from the perspective of a DOSITA that contribute to overall visual appearance that Petitioners do not propose to modify, including the lack of a valley and peak and the slower downward slope with more gradual and smaller change in midsole thickness in the center. *Supra* §IV.A.ii. Thus, modifying C11947 as described in the Petition would not create the same overall appearance as D’969, EX2036, ¶128, and Ground 2 fails for this reason alone.

Even for the “more rounded upper layer” difference that Petitioners address, Petitioners’ purported reasons for modifying C11947 fall short of a “record-supported reason (*without hindsight*) that [a DOSTIA] would have modified the primary reference...to create the same overall appearance as the claimed design.” See *LKQ*, 102 F.4th at 1299. Petitioners improperly rely on their expert’s *unsupported* testimony to gap-fill the deficiencies in its single-reference obviousness argument. Pet., 51 (citing EX1003, ¶¶ 107-108). For example, Delgatty asserts that “the already rounded appearance of the upper layer” suggests that “a designer would have found it obvious to vary the level of curviness so that the upper layer is more curvier.” EX1003, ¶107. But as discussed above, the upper layer of C11947 is not rounded. Furthermore, the welt that Petitioners identify as the “upper layer” is intended to be distinct and stand out from the midsole, particularly in a shoe like the C11947 shoe where the welt is included to give the appearance of a traditional leather dress shoe upper. EX2036, ¶136. Rounding the welt—which is presumably Petitioners’ unstated but intended proposed modification—would have the opposite effect of the welt blending in more with the midsole and upper. *Id.*, ¶145.

Delgatty then opines *without support* that a DOSITA “would have found softening the curve of the upper layer of the midsole to be trivial” and within “common knowledge and skill” and “would have been motivated to do so to create

continuity in the meeting of the welt material with the rubber material.” EX1003, ¶108 (citing “Background of the Technology” section, which also does not cite any supporting references, *id.*, ¶¶ 35-43). Again, this “continuity” is counter to the same design objectives, and Petitioners do not identify any reason the existing “meeting of the welt material with the rubber material” on C11947 would have motivated such a change. EX2036, ¶146. Petitioners also fail to establish a reasonable expectation of success. Indeed, when asked how he, as a designer, would do so, Delgatty testified, “I would round it off, that’s it.” EX2037, 281:1-5. But Delgatty does not identify any prior art references to support the existence of such a rounded welt. Indeed, there is typically very little surface area available for stitching to the sole, so significant rounding of the outboard edge of the welt is not practical and would diminish the visual effect. EX2036, ¶145.

Instead, Petitioners’ proposed modification of C11947 to have a rounded uppermost flute like in D’969 is guided by D’969 and hindsight-driven. Moreover, the Board has consistently held that such unsupported expert “[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*, IPR2022-00325, Paper 36 at 49-50; *Hesai Tech.*, IPR2023-01458, Paper 8 at 17; *Nichia*, IPR2018-01165, Paper 28 at 58-59.

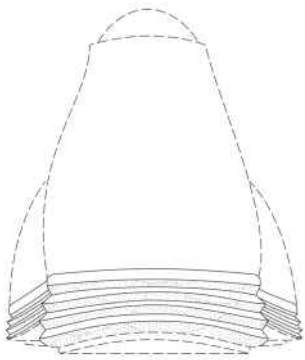
For the above reasons, Petitioners fail to establish that D’969 is obvious based on C11947 alone.

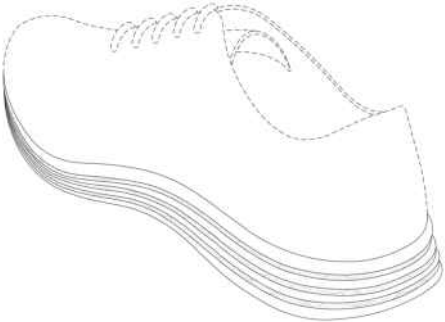
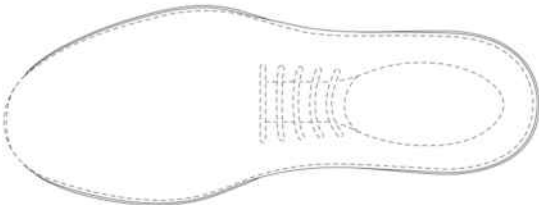
C. Ground 3: Petitioners Fail to Establish That C12652 Anticipates D’969

i. Petitioners Fail to Establish That the Overall Visual Impressions of D’969 and C12652 are Substantially Similar

As discussed above, Petitioners’ assertion that C12652 anticipates D’969 is premised on a legally improper and factually inaccurate feature-by-feature comparison that does not account for the overall visual impressions of D’969 and C12652. *Supra* §§IV, V; Pet., 55-63. This failure is fatal to Ground 3.

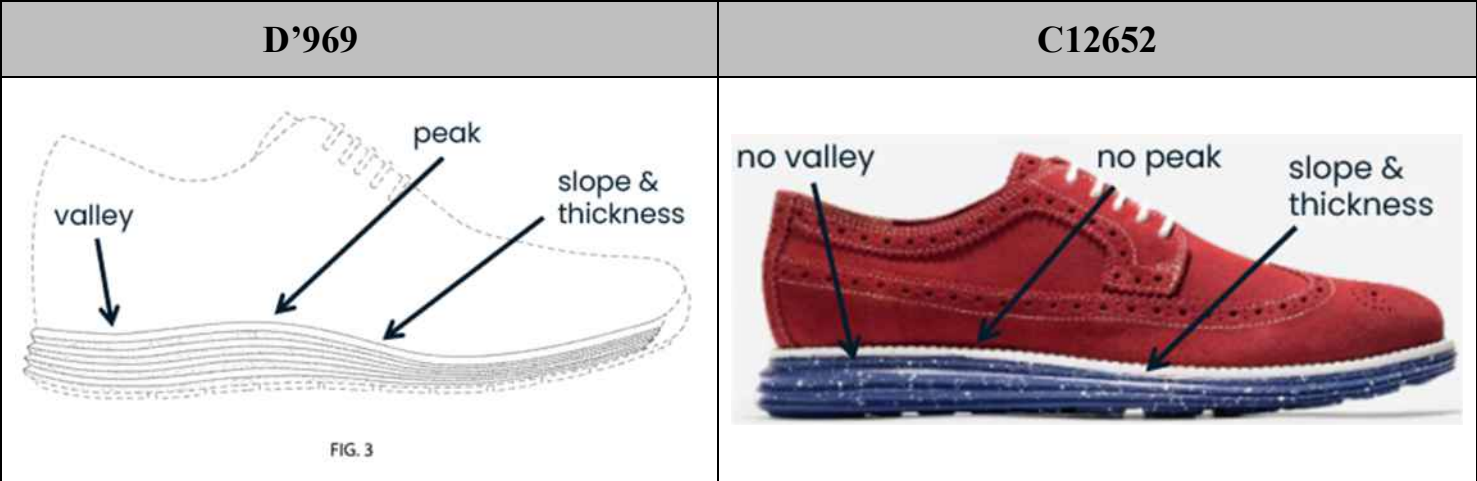
Despite not having all comparable drawings views, of the views available D’969 and C12652 appear significantly different in overall visual appearance:

D’969 (EX1001)	C12652 (EX1011)
 FIG. 3	 p.2
	 p.8

D'969 (EX1001)	C12652 (EX1011)
FIG. 7	
 FIG. 1	 p.12
 FIG. 5	 p.10

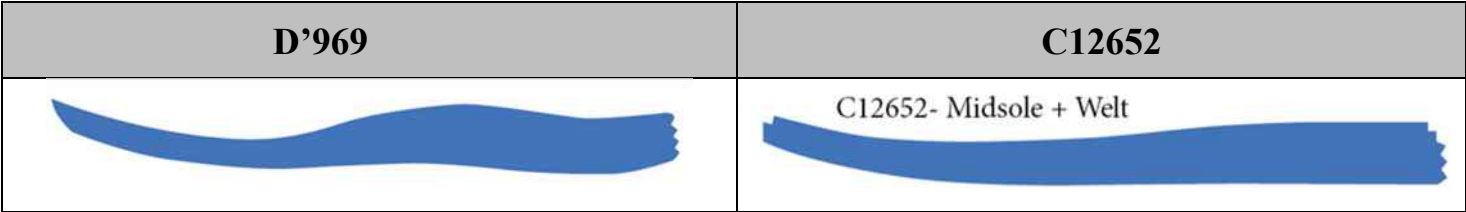
EX2036, ¶152.

As discussed above, the overall visual impression of D'969 is wavy. *Id.*, ¶¶78, 153. C12652 is much flatter as a whole, without a valley in the heel or a peak at the midfoot (but rather a plateau in the heel section) and with a slower downward slope and a more gradual and smaller change in thickness in the center of the midsole, as identified by the following annotations:



Id., ¶154.

The differences in overall visual impressions of D'969 and C12652 is noticeable in silhouettes of the midsoles (even with the improper welt, *supra* §VI.A.ii):



EX2036, ¶157.

ii. Differences Between D'969 and C12652 are Not “Minor” and Impact the Overall Visual Impression to an Ordinary Observer

Without actually identifying any “variations” between D'969 and C12652, Petitioners assert that any variations between D'969 and C12652 are “minor.” Pet., 63. That is not so. As shown above, C12652 has **no** valley at the heel and **no** peak at the midfoot, and thus **no** rolling or undulating curves along a top contour like D'969, which impacts the overall visual impression. Instead, C12652 appears to plateau

through the heel and then slowly slope downward to the ball of the foot. EX2036, ¶155. Indeed, Delgatty testified that the highest point on C12652 in the midsole along the top contour is above the “a” and “r” in the words “generally linear” in his annotations, not at the midfoot like D’969:



EX2037, 329:1-330:1. It is also readily apparent to an ordinary observer that this high point is not a peak because C12652 is horizontal in the heel and lacks a valley. EX2036, ¶155. Indeed, Delgatty acknowledged that from that point toward the heel the top contour only “slightly slopes downward” or is “nearly horizontal,” evidencing the lack of a valley in C12652. EX2037, 329:1-330:1. Yet, Petitioners do not acknowledge the “valley” and “peak” of D’969 at all, much less explain why their absence in C12652 is immaterial.

Furthermore, Petitioners provide no reasoning for their assertion that the difference in slope between C12652 and D’969 is “minor.” *Supra* §IV.B; Pet., 58-

59 (The referenced section “1I.A.1.a” does not exist.). Like C11947, C12562’s downward slope in the center is not as steep (or fast) as D’969. EX2036, ¶156. To the extent Petitioners later argue that the slope of C12652 is functional and should be disregarded, that argument has been waived. It is also incorrect as explained above for C11947. *Infra* §VI.F.

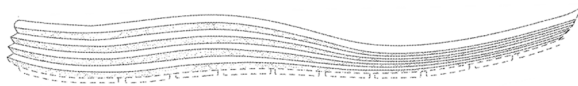
Another glaring difference between D’969 and C12652 is the white welt that Petitioners’ improperly include as part of C12652’s midsole. In Petitioners’ misleading annotations of C12652, Petitioners outline the white leather welt as part of what they consider the “Rounded Upper Layer” of the midsole:



Pet., 44; *see also* EX1003, ¶180 (referring to the “the leather welt” of C12652).

However, as discussed above, it is well-established that the welt, like that shown in C12652, is not part of a midsole. *Supra* §VI.A.ii; EX2036, ¶161. Even Delgatty admits that the white leather welt of C12652 is made of a different material than the blue rubber midsole. EX1003, ¶180 (referring to the “the leather welt” of C12652); EX2037, 282:15-283:5. Here, the title, specification, and sole claim of D’969 recites explicitly “[t]he ornamental design for a shoe *midsole*.” *See* EX1001. Because the welt of C12652 is a separate article made of separate material than the midsole, Petitioners’ inclusion of the welt in their analysis of C12652 compared to D’969 is legally improper. *In re SurgiSil*, 14 F.4th at 1382 (holding claim “limited to the particular article of manufacture identified in the claim, i.e., a chair.”).

Removing the welt from Petitioners’ interpretation of C12652 further evidences differences between D’969 and C12652:

FIG. 3 of D’969	C12652
 Claimed Midsole Only	 Midsole Only

EX2036, ¶161.

Even if the Board were to find that C12652’s welt should be considered when comparing C12652 to D’969, C12652 still does not include a “rounded upper layer” as Petitioners assert. The welt itself appears nearly vertical rather than rounded.

EX2036, ¶162. From the lateral elevation view in particular, the welt appears as a flat shelf of material encircling the shoe:⁶



EX2036, ¶162.

Petitioners implicitly acknowledge this difference between D’969 and C12652 by arguing, with respect to the “rounded upper layer,” that “OB would view a midsole from several feet away (not under high magnification) while considering a shoe for purchase, and minor differences in the upper layer would be insubstantial from this viewpoint.” Pet., 60 (citing EX1003, ¶123). However, as discussed above, Delgatty’s deposition calls into the question the credibility of his opinion underlying Petitioners’ argument. *Supra* §VI.A.ii.

⁶ The image quality of the remaining views of C12652 make it difficult to assess the design of C12652, particularly the welt that Petitioners assert to read on the uppermost flute of D’969. EX2036, ¶162.

By failing to address these differences—(1) no valley, (2) no peak, (3) a slower downward slope with more gradual and smaller change in thickness, and (4) a difference in the uppermost flute, regardless of whether the welt is considered—Petitioners have failed to show that the overall visual appearance of D’969 and C12652 are substantially similar.

D. Ground 4: Petitioners Fail to Establish That C12652 Renders Obvious D’969

For the reasons discussed above, Petitioners’ narrowly focused feature-by-feature analysis and misleading color-coded annotations fail to establish that C12652 is visually similar in overall appearance to D’969 to a DOSITA, as required by *Graham* factor one. This is fatal to Ground 4. *See In re Harvey*, 12 F.3d at 1065 ; *LKQ*, 102 F.4th at 1299; *Arashi Vision*, IPR2024-01434, Paper 9 at 27.

As to *Graham* factor two, there are substantial differences between D’969 and C12652 from the perspective of a DOSITA that contribute to overall visual appearance that Petitioners do not propose to modify, including the lack of a valley and peak, the slower downward slope with more gradual and smaller change in midsole thickness in the center, and a flat rounded upper layer. *Supra* §VI.C. Thus, modifying C12652 as described in the Petition would not create the same overall appearance as D’969, EX2036, ¶167, and Ground 4 fails for this reason alone.

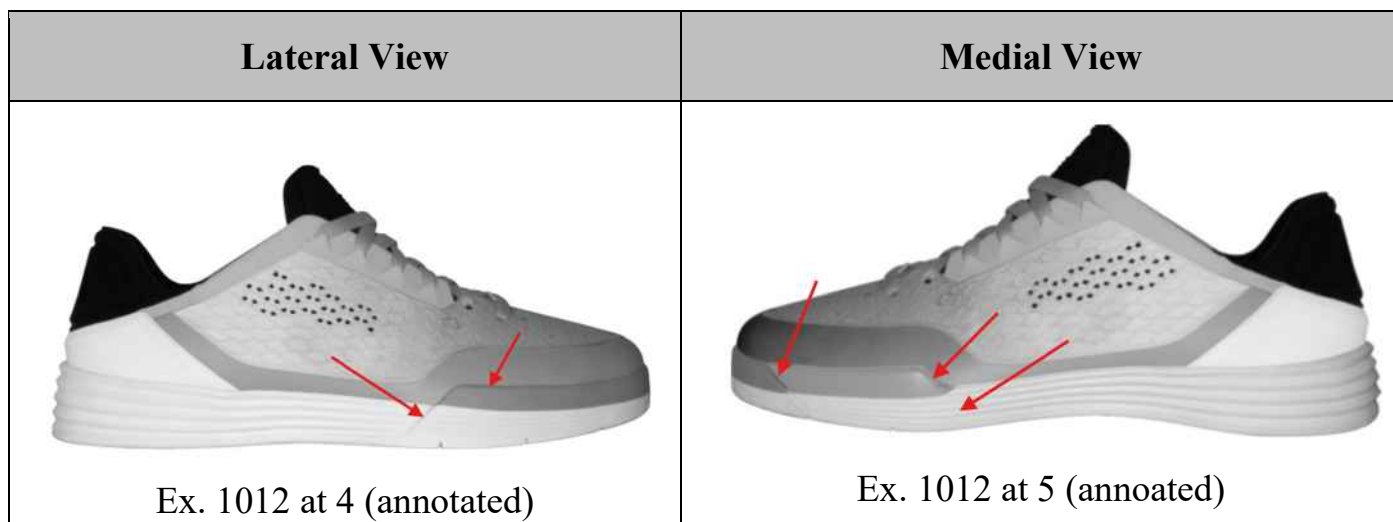
Petitioners’ relevant obviousness argument focuses on the incomplete or missing views of C12652. Pet., 63-65 (citing EX1003, ¶135). Petitioners assert,

based solely on Delgatty’s testimony that a “DOSITA would have understood the design as a whole from the images available.” Pet., 63 (citing EX1003, ¶135). Such hindsight and unsupported expert testimony about what half of C12652’s midsole *could possibly* look like cannot take the place of *actual disclosure*—of which there is none. See *Samsung*, IPR2022-00325, Paper 36 at 49-50; *LKQ*, 102 F.4th at 1299. Indeed, Delgatty conceded during his deposition that C12652 lacks an unobstructed medial-side view and admitted that the medial side could affect the overall visual impression. EX2037, 287:9-288:22, 294:6-295:9.

As an alternative theory, Petitioners assert that a “DOSITA would have had the common knowledge and skill to understand 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.” Pet., 65 (citing EX1028; EX1029; EX1003, ¶136). But this theory fails too because it is based on hindsight about what a DOSITA *could have* done rather than what a DOSITA *would have* been motivated to do. See *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (“The mere fact that the prior art *could be* so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). Indeed, the references on which Petitioners rely to support symmetry in design do not even relate to shoes. See EX1028, 7-8 (discussing “symmetry classifications” generally); EX1029, 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). Petitioners do not 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. EX2036, ¶169.

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:



EX1036, ¶168. As such, Petitioners fail to show that the ordinary designer would have been motivated to modify C12652 to arrive at the midsole design claimed in D'969.

For the above reasons, Petitioners fail to establish that D'969 is obvious based on C12652 alone.

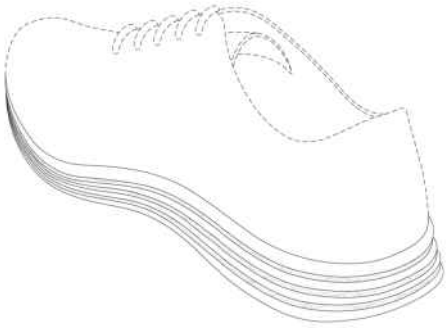
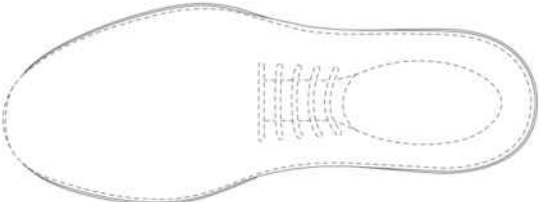
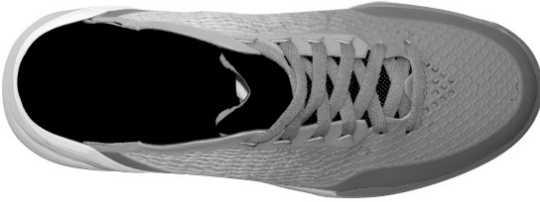
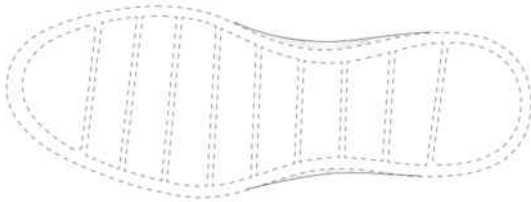
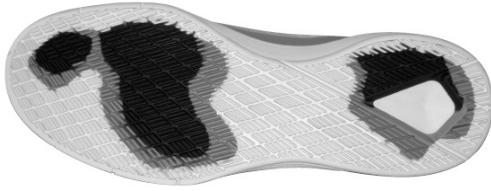
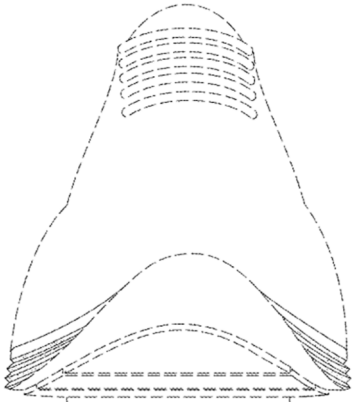
E. Ground 5: Petitioners Fail to Establish That Nike Anticipates D’969

i. Petitioners Fail to Establish That the Overall Visual Impressions of D’969 and Nike are Substantially Similar

As discussed above, Petitioners’ assertion that Nike anticipates D’969 is premised on a legally improper and factually inaccurate feature-by-feature comparison that does not account for the overall visual impressions of D’969 and Nike. *Supra* §§IV, V; Pet., 68-75. This failure is fatal to Ground 5.

When viewed side-by-side, D’969 and Nike appear significantly different in overall visual appearance:

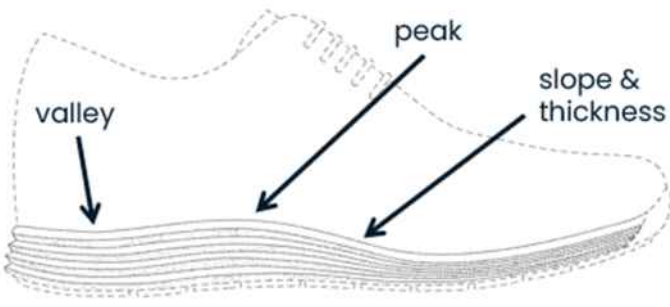
D’969 (EX1001)	Nike (EX1012)
 FIG. 3	 p.4
 FIG. 7	 p.6

D'969 (EX1001)	Nike (EX1012)
 FIG. 1	 p.10
 FIG. 5	 p.8
 FIG. 4	 p.9
 FIG. 6 FIG. 6	 p.7

D'969 (EX1001)	Nike (EX1012)
 FIG. 2	 p.5

EX2036, ¶174.

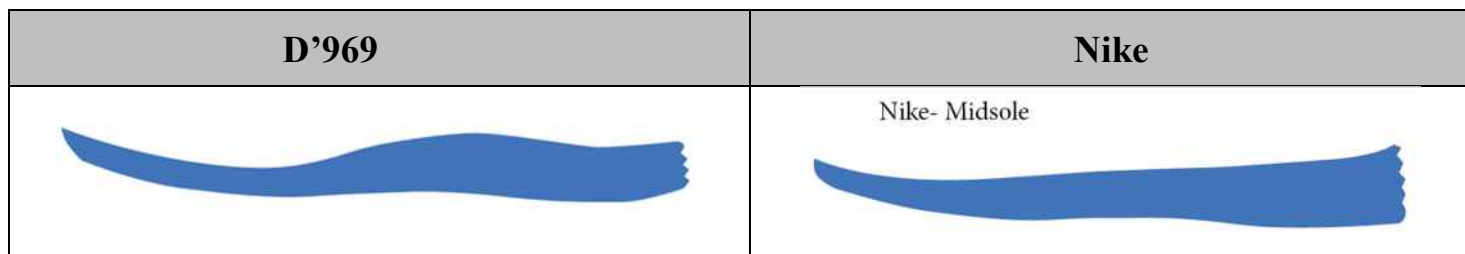
As discussed above, the overall visual impression of D'969 is wavy. *Id.*, ¶¶78, 175. In contrast, Nike is much flatter as a whole, without a valley in the heel or a peak at the midfoot and with a slower downward slope and a more gradual and smaller change in thickness in the center of the midsole, as identified by the following annotations:

D'969	Nike
 FIG. 3	

Id., ¶176. Delgatty testified that Nike has a “wave-like design” because it has “motion to it” but conceded “it’s more subtle” than D'969. EX2037, 303:1-10.

However, the “motion” to Nike is more wedge-like than “wave-like” with a downward slope starting from the heel and continuing to the ball of the foot, and Nike certainly does not have an undulating top contour like D’969. EX2036, ¶177.

The differences in overall visual impressions of D’969 and Nike is noticeable in silhouettes of the midsoles:



EX2036, ¶179.

ii. Differences Between D’969 and Nike are Not “Minor” and Impact the Overall Visual Impression to an Ordinary Observer

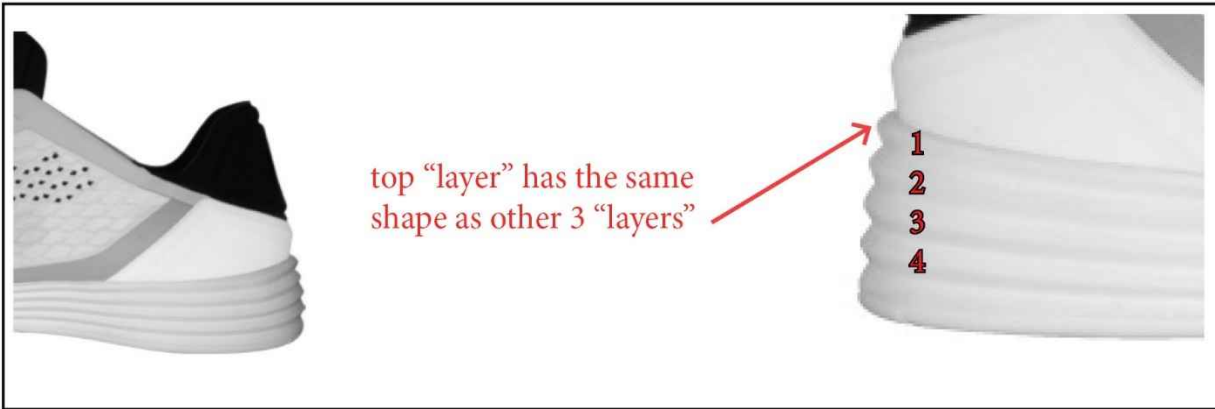
Petitioners assert that any variations between D’969 and Nike are “insubstantial” and “minor” between D’969 and Nike. Pet., 79-81. That is not so. As shown above, Nike has **no** valley at the heel and **no** peak at the midfoot, and thus **no** rolling or undulating curves along a top contour like D’969, which impacts the overall visual impression.

Delgatty conceded in his deposition that “[t]here’s a downward slope at the heel that curves to...a plateau area.” EX2037, 307:20-308:1. That is not the same as D’969’s downward slope from the heel to a valley that then rises gradually to a peak at the midfoot. EX2036, ¶¶176-177. Delgatty also confirmed that the highest point

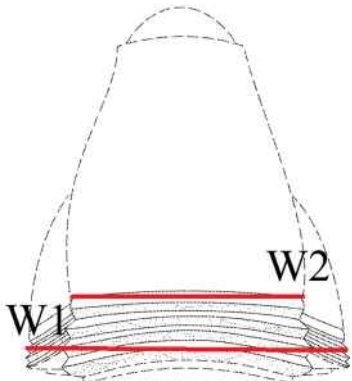
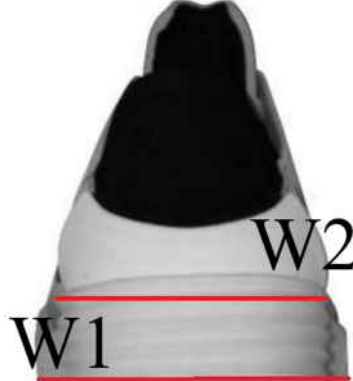
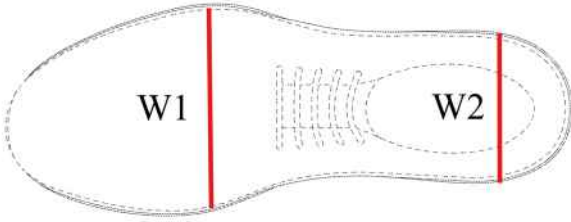
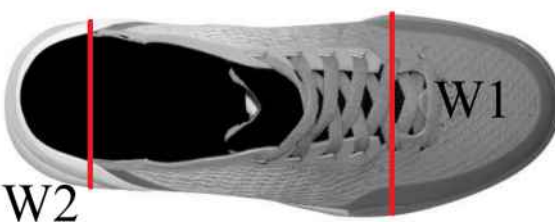
in the Nike midsole is “the back of the heel” and that “every other point upwards to the toe is lower than that point.” EX2037, 309:16-310:3. This is in stark contrast to where Delgatty acknowledged the high point is located in D’969—the peak in the midfoot area. *Id.* at 237:3-18. Yet, Petitioners do not acknowledge the “valley” and “peak” of D’969 at all, much less explain why their absence in Nike is immaterial.

Furthermore, Petitioners provide no reasoning for their assertion that the difference in slope between Nike and D’969 is “minor.” *Supra* §IV.B; Pet., 81-82 (The referenced section “IX.B.1.c(i)” does not provide any reasons or explanation.). Both experts agree that downward slope is not as steep (or fast) as D’969. EX2036, ¶178; EX2037, 308:13-309:9. Indeed, Delgatty admitted in his deposition that “the amount of sloping and curvature [] Nike...is not quite as overly present as the ’969 patent” and a “slighter slope” than the other prior art. EX2037, 302:12-18, 311:1-9. He then testified that he “do[es]n’t know if the ordinary observer would notice the overall impression being that much different” because “*[i]t depends on...how observant they are[,]*” *id.*, 309:10-15—yet another indication that Delgatty misapplies the ordinary observer test, as discussed above. *Supra* §V. To the extent Petitioners later argue that the slope of Nike is functional and should be disregarded, that argument is incorrect as explained above for C11947. *Supra* §VI.A.ii; EX2036, ¶188.

Additionally, unlike D’969 topmost flute, the upper “layer” of Nike is shaped exactly like the 3 three layers below it:



EX2036, ¶180. Moreover, FIG. 7 of D’969 shows that the claimed midsole is appreciably narrower in the heel than in the toe because the front box is visible from the rear view, which contributes to D’969’s wavy overall appearance. EX2036, ¶181. In the rear view of Nike, however, the front box is not substantially visible and is blocked in the rear view by the heel. *Id.* In other words, the heel of Nike has a similar width as the ball of the foot area, as shown in the table below in comparing D’969 with Nike 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 (EX1001)	Annotated Nike (EX1012)
 FIG. 7	 p.6
 FIG. 5	 p.8

Id., ¶181.

By failing to address these differences—(1) no valley, (2) no peak, (3) a slower downward slope with more gradual and smaller change in thickness, (4) a different topmost flute, and (5) an appreciably narrower heel than in the toe—Petitioners have failed to show that the overall visual appearance of D'969 and Nike are substantially similar.

F. Ground 6: Petitioners Fail to Establish That Nike Renders Obvious D'969

For the reasons discussed above, Petitioners' narrowly focused feature-by-feature analysis and misleading color-coded annotations fail to establish that Nike is

visually similar in overall appearance to D’969 to a DOSITA, as required by *Graham* factor one. This is fatal to Ground 6. *See In re Harvey*, 12 F.3d at 1065; *LKQ*, 102 F.4th at 1299; *Arashi Vision*, IPR2024-01434, Paper 9 at 27.

As to *Graham* factor two, there are substantial differences in the overall visual appearances of Nike and D’969 from the perspective of a DOSITA that Petitioners do not proposed to modify, such as the difference between the width in the heel compared to the width in the toe. *Supra* §VI.E.ii. Thus, modifying Nike as described in the Petition would not create the same overall appearance as D’969, EX2036, ¶181, and Ground 6 fails for this reason alone.

Even for the “degree of sloping and curvature in the ridged edge and top layer”—which Delgatty confirmed to be the “up and down” of the midsole in the midsection of the shoe, EX2037, 316:6-11; *see also id.*, 314:7-15—Petitioners do not provide any reason why a DOSITA would have been motivated to modify Nike that does not rely on hindsight. *See LKQ*, 102 F.4th at 1299 (requiring a “record-supported reason (without hindsight) that [a DOSTIA] would have modified the primary reference...to create the same overall appearance as the claimed design”). Petitioners dismiss the differences between D’969 and Nike as “ever so slight[,],” “functional,” “trivial,” and “within common knowledge and skill.” Pet., 76-77. But none of these provide a motivation for changing Nike’s flat overall appearance to include more prominently sloping and curvature as in D’969. Indeed, as discussed

above, the differences in slope and curvature between D’969 and Nike are far from slight. *Supra* §VI.E. And the fact that Nike is the only prior art for which Petitioners propose a modification to the slope and curvature also underscores the significant difference in slope and curvature between Nike and D’969.

Rather than identify a reference exhibiting slope and curvature similar to D’969, Petitioners rely on their expert’s unsupported assertions. For example, Delgatty asserts that “small variations of curvature would have been obvious to the DOSITA as they would have been purely functional, rather than ornamental, in order to accommodate different types of feet,” and Petitioners cite two cases, *Monoflo* and *Door-Master*, for support. EX1003, ¶163; Pet., 76-77. Neither case stands for the proposition that any “purely functional” modification would have automatically been obvious. Regardless, the external slope and curvature of a midsole at issue here is not purely functional. As Rake explains, visible midsole sidewalls (i.e., the exterior vertical perimeter surfaces of the midsole) often extend upward beyond the actual footbed or load-bearing platform, such that the shoe’s outward appearance may not accurately reflect the internal geometry or functional offset experienced by the wearer. EX2036, ¶188. In other words, while a midsole’s outward appearance may give an ordinary observer the impression that the shoe has more significant arch, for example, the actual footbed or load-bearing platform may be significantly flatter. *Id.*, ¶188. Thus, while the curvature of the *internal* footbed or load-bearing

platform of the midsole that accommodates the insole is functional (*i.e.*, providing support and cushion), the **external** curvature of the midsole at issue here, including the slope and curvature at the top contour of the midsole, is not “purely functional” because it does not necessarily align with the internal footbed or load-bearing platform or have a matching slope and curvature, and indeed, for D’969, it does not. *Id.*, ¶¶188-189. Indeed, a DOSITA would have understood that it was possible to “accommodate different types of feet” or include “a higher or lower heel,” as Petitioners assert, by modifying the curvature of the **internal footbed or load-bearing platform** of the midsole without modifying the external slope or curvature of the midsole at the external walls. *Id.*, ¶189.

Additionally, during his deposition, Delgatty contradicted his assertion that, “for a shoe with a curvier bottom sole, the midsole would have to match in order to fit atop the bottom sole,” on which Petitioners’ rely. Pet., 77 (citing EX1003, ¶163). Delgatty testified that the midsole would be made to fit the last (*i.e.*, the skeleton of the shoe during construction), a different component than the bottom sole, EX2037, 312:19-313:1; *see also id.*, 314:21-315:17 (“Someone might have a higher arched foot; and if you have a higher arched foot, you might have a last that accommodates for that, and thus, you would have a midsole that would also fit that last shape and you would have, you know, more curvature in that -- in that arched area.”). The last dictates the internal curvature of the internal footbed or load-bearing platform of the

midsole, but it does not dictate the slope or curvature of the midsole along its exterior, which could have sidewalls (i.e., the exterior vertical perimeter surfaces of the midsole) that extend upward beyond the internal footbed or load-bearing platform. EX2036, ¶188.

Furthermore, Petitioners’ assertions that “such a curvier sole was already well-known”⁷ and that a “DOSITA 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” are not relevant. Pet., 77. Petitioners do not propose to modify Nike’s midsole with a curvier sole or a higher or lower heel or provide any motivation for doing so. And Petitioners’ unsupported assertion that “any given midsole *could be easily modified* to be ever so slightly curvier or flatter” based on a DOSITA’s “common knowledge and skill” has no bearing on whether a DOSITA *would have been motivated* to make the proposed modification. Pet., 77.

⁷ Petitioners cite EX1026 and EX1027 to support this assertion. EX0126 is substantially the same a reference considered by the Examiner during prosecution and found not to obviate D’969. *See* EX2035. EX1027 does not qualify as prior art to D’969 because it is a foreign patent application with a publication date that post-dates D’969’s filing date.

Instead, Petitioners’ proposed modification of Nike to adjust the slope and curvature is nothing more than impermissible hindsight guided by D’969.

For the above reasons, Petitioners fail to establish that D’969 is obvious based on Nike alone.

G. Grounds 7 & 8: Petitioners Fail to Establish that C11947 or C12652 in View of Nike Renders Obvious D’969

As discussed above, Petitioners’ narrowly focused feature-by-feature analysis and misleading color-coded annotations fails to establish that C11947 and C12652 are visually similar in overall appearance to D’969 to a DOSITA, as required by *Graham* factor one. This is fatal to Grounds 7 and 8. *See In re Harvey*, 12 F.3d at 1065; *LKQ*, 102 F.4th at 1299; *Arashi Vision*, IPR2024-01434, Paper 9 at 27.

As to *Graham* factor two, Petitioners appear to present two alternative proposed modifications to C11947 and C12652 in view of Nike to purportedly arrive at a “rounded upper layer”—rounding the welt and removing the welt. Neither is premised on a “record-supported reason (without hindsight).” *See LKQ*, 102 F.4th at 1299. *First*, Petitioners assert that “making either [C11947 and C12652] rounder would soften the meeting of the rubber and welt material, much like Nike’s upper layer appears a cohesive part of the midsole,” which would have resulted in “a more cohesive appearance” and “would have been a desirable option to make the wave-like design of the midsole less interrupted.” Pet., 82. However, Petitioners do not explain how the purportedly “wave-like designs” of C11947 and C12652 would be

less interrupted by this proposed modification, and as discussed above, neither has a wave-like design. The proposed modification also fails for the same reason as Petitioners' identical proposed modification in view of C11947 alone. *Supra* §VI.B. The addition of Nike, having only a rubber midsole and no welt, does not provide motivation for rounding the welt to give "a more cohesive appearance" given both stylistic and construction differences. EX2036, ¶200.

Petitioners main "motivation" appears to be that "the shoe manufacturer Nike was famous."⁸ Pet., 82. However, by that logic, any feature in any shoe ever made by Nike would have been obvious to include in any other shoe. *See* EX2037, 276:18-20 ("I mean, hypothetically, I guess any designer could take anything from Nike and incorporate it into another shoe."). This could result in millions (if not more) possible combinations and is not a "record-supported reason (without hindsight)" that is required by *LKQ*, 102 F.4th at 1299. *See* EX2036, ¶198. Petitioners give no reason

⁸ To the extent Petitioners rely on *Nike, Inc. v. Just Did It Enterprises*, 6 F.3d 1225 (7th Cir. 1993) to provide a motivation to modify C11947 and C12652 (as opposed to just the fact that "a major sportswear company"), such reliance is misplaced. *Nike, Inc.* is a trademark case having nothing to do with whether a DOSITA would have been motivated to modify a particular shoe midsole based on a particular feature of a midsole of a particular Nike shoe.

why a DOSITA would have been motivated to appropriate one specific design detail from one specific model of Nike shoes to modify C11947 and C12652. *Id.*

Second, Petitioners assert that a DOSITA would have been motivated to “**remov[e] the leather welt** and bond[] the midsole directly to the upper to create a more continuous aesthetic,” and that “doing so would also reduce a step in the manufacturing process, making the shoe **less expensive to produce**” and “create a design that was more cohesive.” Pet., 82. But Delgatty directly contradicted this in his deposition. He stated that the reason for the attached welt in C11947 and C12652 (as opposed to a molded welt that is part of the midsole) was to make a “more expensive product”—“if your shoe is a higher price point shoe that you want to justify, you might add some features to the construction of the shoe...that make it, you know, a little bit **more expensive to produce**.” EX2037, 129:15-130:3, 132:9-16.

Moreover, a DOSITA would have recognized C11947 and C12652 as lifestyle shoes, having a leather or suede upper, respectively, and a leather welt between the upper and the midsole. EX2036, ¶200. As discussed above, the welt is intended to stand out and provide a distinctive appearance more similar to a traditional dress shoe, not to a “more cohesive” design. *Id.*; *supra* §V.B. In contrast, a DOSITA would have understood Nike to be an athletic court shoe having a mesh upper directly coupled to the midsole, which is a substantially different shoe—both aesthetically

and functionally. *Id.*, ¶200; EX2037, 273:1-10 (noting Nike is “probably a court shoe”). Petitioners fail to provide any reason why a DOSITA would have removed the welt that contributes to C11947 and C12652 “dress” appearance in favor of a more athletic appearance. EX2036, ¶200.

Petitioners also do not explain how simply “removing the leather welt and bonding the midsole directly to the upper” would create the same overall appearance as D’969. Indeed, it would not because the upper flute (or layer) of the modified C11947 and C12652 would be significantly thinner than the upper flute of D’969. EX2036, ¶201; *supra* §§VI.A.ii, VI.C.ii. Delgatty agreed that a DOSITA would have to “probably take that top layer of the EVA and increase it slightly” to make them more similar to D’969, but then also conceded that what is left on C11947’s and C12652’s midsoles after removing the welt “could probably still be attached to the upper,” thereby eliminating motivation to increasing its height. EX2037, 283:6-285:4.

Moreover, as discussed above, Nike does not supply the other missing features in C11947 and C12652 that contribute to D’969’s overall visual appearance, including the lack of a valley and peak and the slower downward slope with more gradual and smaller change in midsole thickness in the center. *Supra* §VI.E.ii; EX2036, ¶197. Petitioners do not assert otherwise in Grounds 7 and 8. Pet., 78-83. Thus, modifying C11947 and C12652 in view of Nike as described in the Petition

would not create the same overall appearance as D’969, and Grounds 7 and 8 fail for this reason alone.

For the above reasons, Petitioners fail to establish that D’969 is obvious based on C11947 in view of Nike or C12652 in view of Nike.

H. Ground 9: Petitioners Fail to Establish That Skechers in View of Nike Renders Obvious D’969

i. Skechers is Not a Suitable Primary Reference Under Graham Factor One

In applying *Graham* factor one, “a primary reference must be identified” and is generally the closest prior art design “that is most visually similar to the claimed design.” *LKQ*, 102 F.4th at 1294, 1298. Petitioners fail to establish that Skechers is “visually similar” to D’969 to a DOSITA for two main reasons. First, there are too many aspects of Skechers that are not adequately disclosed in the images submitted with the Petition. EX2036, ¶205. As shown below, Skechers (EX1016 and EX1017) includes a total of three views of a shoe—(1) a side top perspective view showing the lateral portion of a single midsole of a first shoe and a partial medial section of the toe of a second shoe, (2) a close-up view of a “lateral view” of the heel of a single midsole (which is not a true lateral view but rather an angled, perspective view), and (3) a zoomed-out top perspective view of the medial portion of a single midsole in which the features of the midsole cannot be made out (rendering this image of zero value):

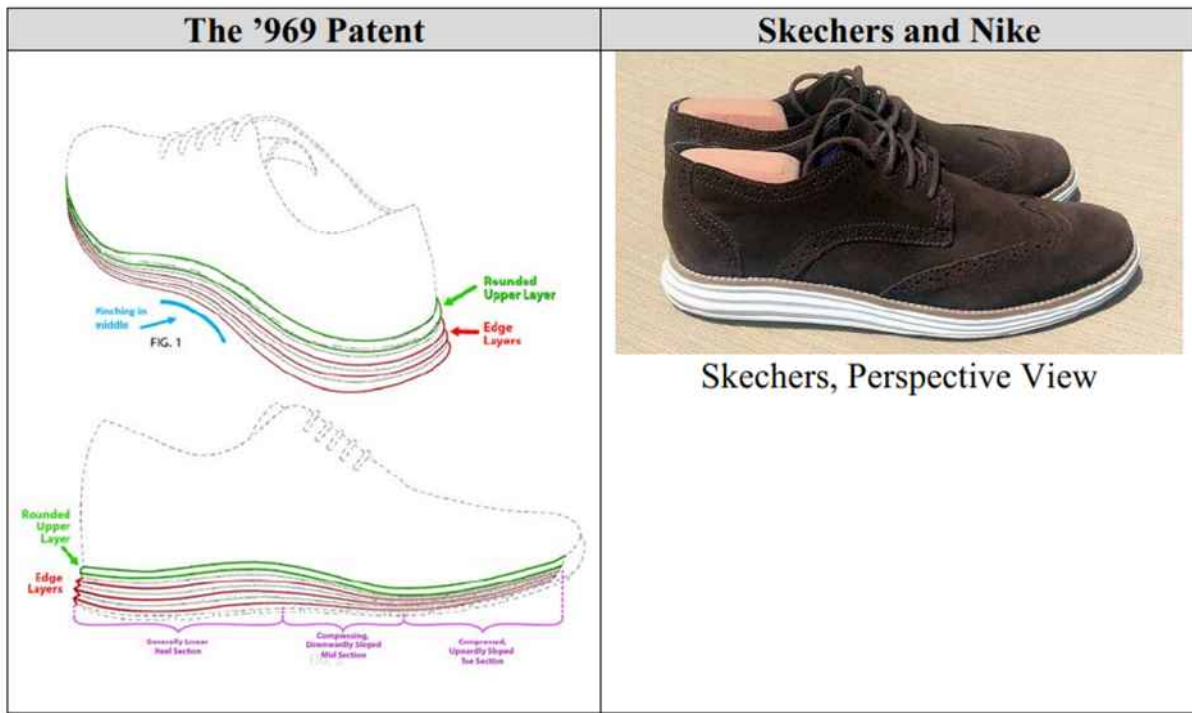


EX2036, ¶205. In fact, Skechers is *missing six of seven views* from D’969 that Delgatty testified would “help...inform whether or not there is...any similarities or differences,” EX2037, 215:12-21—(1) rear elevational view, (2) medial side

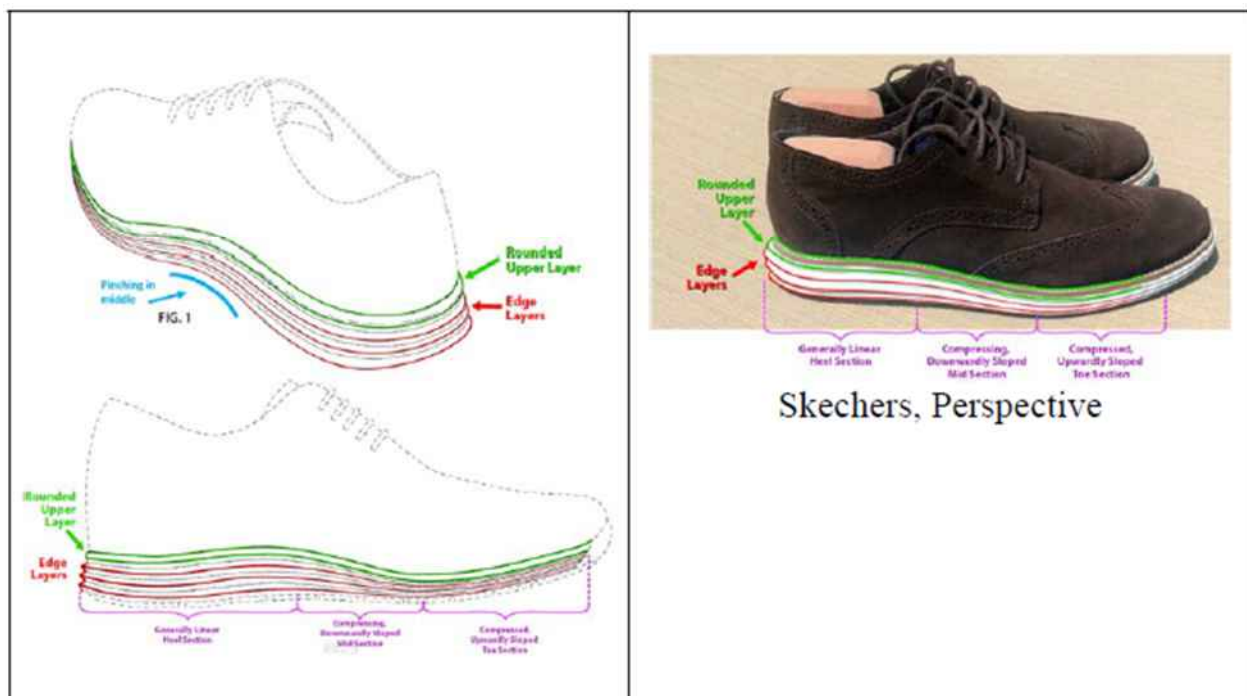
elevational view, (3) lateral side elevational view, (4) top plan view, (5) bottom plan view, and (6) front elevational view.⁹ It cannot be determined whether Skechers is visually similar to D’969 due to these missing views. EX2036, ¶¶206-211. This lack of disclosure is fatal to Ground 9.

Second, Petitioners’ assertion that Skechers is “visually similar” to D’969 is supported only by Delgatty’s conclusory statement that “Skechers is a suitable primary reference as it is visually similar to the ’969 patent (*see images below*).” Pet., 87 (citing EX1003, ¶192). Those “images below” in Delgatty’s declaration, however, do not explain how Sketchers reflects any of the “key features” on which Petitioners and Delgatty rely:

⁹ The Petition and Delgatty’s declaration purport to include other “views” of Skechers. Pet., 85-86; EX1003, ¶189. However, even Delgatty agreed that these “views” are not accurate. EX2037, 318:1-319:19. Moreover, the purported “Lateral Elevation View” and “Bottom Plan” do not appear anywhere in the exhibits included with the Petition.



EX1003, ¶194. Curiously, the Petition itself contains annotations on the image of Skechers:

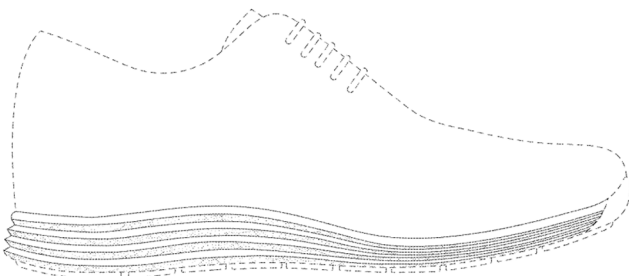


Pet., 88.

As with the other grounds, the Petitioners' image of Skechers reflects Petitioners narrowly focused feature-by-feature analysis and color-coded annotations that misleads one into believing Skechers is more "visually similar" to D'969 to a DOSITA than it is. EX, 2036, ¶208; *see also* Pet., 86-87. Here, too, Petitioners' consideration of selected features, rather than the visual impression of the designs as a whole, is improper and cannot support an obviousness finding. *See In re Harvey*, 12 F.3d at 1065; *LKQ*, 102 F.4th at 1299.

Despite not having all comparable views available, D'969 and Skechers still appear significantly different in overall visual appearance, as shown in the representative comparison below:¹⁰

¹⁰ These views are being used for comparison because they are the best available in the record. However, the images of Skechers are taken from a higher vantage point as compared to D'969, which skews the features of Skechers. EX2036, ¶¶210- 212.

D'969	Skechers (EX1017)
 FIG. 3	 Skechers, Perspective View 

EX2036, ¶212. As such, Petitioners fail to establish Skechers and D'969 are visually similar as required by *Graham* factor one.

ii. Petitioners' Do Not Adequately Assess Differences or Provide Sufficient Reasons to Modify Skechers in View Nike

Comparing the differences as required by *Graham* factor two, the overall visual appearance of D'969 is “wavy” as captured by rolling or undulating curves (i.e., peaks and valleys) along the top and bottom contours of the monolithic midsole with four flutes having proportionally varying thickness extending along the length of the midsole and around the heel. *Id.*, ¶213. Skechers is much flatter as a whole, without a valley in the heel or a peak at the midfoot and with a slower downward

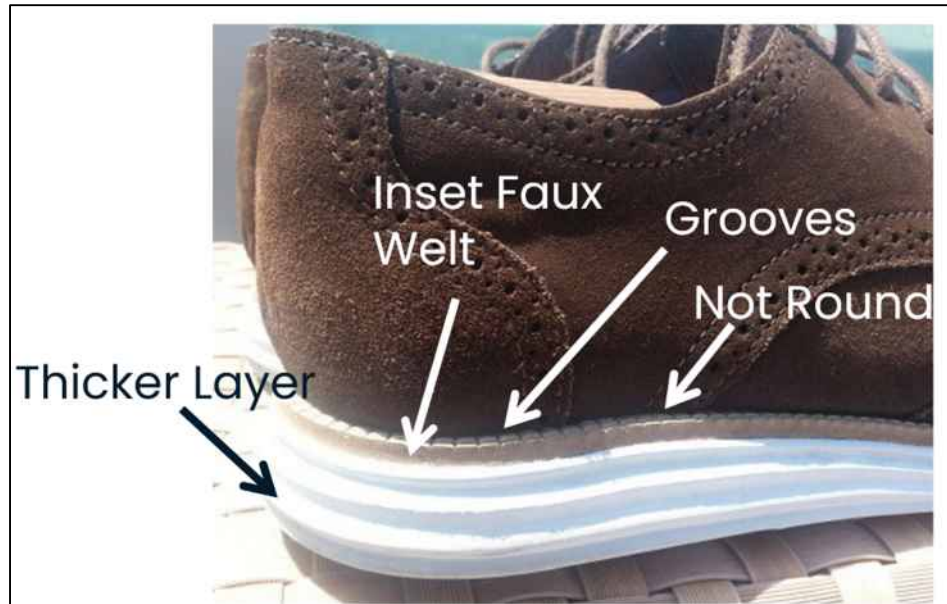
slope and a more gradual and smaller change in thickness in the center of the midsole, as identified by the annotations below:



Id., ¶213.

As shown above, Skechers has **no** valley at the heel and **no** peak at the midfoot, and thus **no** rolling or undulating curves along a top contour like D'969, which impacts the overall visual impression. Instead, Skechers appears to have a slow downward slope starting from the heel (either at the back of the heel or after plateau) to the ball of the foot that then curves upward toward the toe. *Id.*, ¶214.

As shown in the image below, there are other notable differences as well. For example, the second to bottom “ridged-edge layer” of Skechers appears thicker and rounder than the other layers within the heel as compared to the evenly sized flutes of D'969. *Id.*, ¶215. Additionally, although the images make it difficult to be sure, the light brown portion that Petitioners’ include within the “rounder upper layer” appears to be a faux “welt” made of the same material as the white midsole:



Id., ¶216.

This faux “welt” is intended to give the impression of a traditional welt that is constructed of a different material, as discussed with respect to C11947 and C12652 above. *Id.*, ¶217. To give that impression, the faux “welt” is flat and inset from the upper part of the white midsole, creating a disjointed appearance, and is a different color—all like the leather welt in C11947. *Id.* Furthermore, the faux “welt” has a series of grooves along the top surface, creating a scalloped pattern, which are intended to emulate stitching and give the faux “welt” the appearance of a real welt. *Id.* Delgatty acknowledged the repeated consecutive grooves and agreed the faux “welt” is “less rounded than the other examples” of prior art. EX2037, 324:13-325:14.

Due to their myopic feature-based interpretation of D’969, Petitioners fail to acknowledge several differences between D’969 and Skechers, including the

grooves and thicker layer. EX2036, ¶¶215-217; Pet., 85-91. As such, Petitioners do not provide any reason that an ordinary designer in the field of the article of manufacture would have modified Skechers in view of Nike to create the same overall appearance as D’969, as required by *LKQ*. EX2036, ¶219. Ground 9 fails for this reason.

The one difference noted above that Petitioners discuss is the “less rounded upper layer” of Skechers. Petitioners assertion that a “DOSITA 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[,]” Pet., 90, is not a “record-supported reason (without hindsight)” as discussed above. *Supra* §VI.G. Furthermore, a DOSITA would not have been motivated to make the faux “welt” of Skechers round “to create a cohesive appearance in the different materials meeting at that point,” as Petitioners suggests, Pet., 90, for stylistic reasons because, as discussed above, the faux “welt” was included to stand out. EX2036, ¶217. Once again, Petitioners purported motivations to modify are based on hindsight, and Petitioners fail to establish that a DOSITA would have been motivated to modify Skechers in view of Nike to create an uppermost flute like D’969.

For the above reasons, Petitioners fail to establish that D’969 is obvious based on Skechers in view of Nike.

VII. SECONDARY CONSIDERATIONS

Patent Owner does not believe any secondary considerations are necessary to show that D'969 is not unpatentable with respect to any ground.

VIII. CONCLUSION

For at least the foregoing reasons, Patent Owner requests that the Board finds the challenged claim not unpatentable.

Dated: May 19, 2026

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 RESPONSE** totals 13,984 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: May 19, 2026

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Cole Haan LLC

CERTIFICATE OF SERVICE

In accordance with 37 CFR §§ 42.6(e), the undersigned certifies that on May 19, 2026, a complete and entire copy of this **PATENT OWNER'S RESPONSE** and all supporting exhibits were served on Petitioners via electronic mail to counsel for Petitioners at the following addresses:

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Dated: May 19, 2026

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