

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

PETITION FOR *INTER PARTES* REVIEW

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	MANDATORY NOTICES UNDER 37 C.F.R. §42.8.....	3
	A. Real Party-in-Interest	3
	B. Related Matters.....	3
	C. Lead and Back-Up Counsel.....	5
III.	FEES	6
IV.	REQUIREMENTS FOR IPR	6
	A. Grounds for Standing	6
	B. Identification of Challenge.....	6
	1. The Specific Art on Which the Challenge Is Based	6
	2. Statutory Grounds on Which the Challenge Is Based	8
V.	D’969 PATENT AND PROSECUTION HISTORY	8
	A. D’969.....	8
	B. Prosecution History of D’969	15
VI.	§325(d) AND §314(a) DISCRETION DOES NOT APPLY	16
	A. §325(d)	16
	B. §314(a).....	17
VII.	LEGAL STANDARD	19
	A. Anticipation	19
	1. Ordinary Observer.....	20
	B. Obviousness.....	21
VIII.	DOSITA.....	23
IX.	CLAIM CONSTRUCTION	24
X.	GROUND OF UNPATENTABILITY.....	31
	A. Ground 1: D’969 Is Anticipated By C11947	32
	1. Publication of C11947	32
	2. Overview of C11947	36

3.	Claim Chart	39
4.	Overall Design	47
B.	Ground 2: D’969 is Obvious Over C11947	49
C.	Ground 3: D’969 is Anticipated By C12652.....	52
1.	Publication of C12652	52
2.	Overview of C12652.....	53
3.	Claim Chart.....	56
4.	Overall Design	62
D.	Ground 4: D’969 is Obvious Over C12652	63
E.	Ground 5: D’969 is Anticipated By Nike	66
1.	Publication of Nike	66
2.	Overview of Nike.....	66
3.	Claim Chart.....	69
4.	Overall Design	75
F.	Ground 6: D’969 is Obvious Over Nike	76
G.	Grounds 7 & 8: D’969 is Obvious Over C11947 and Nike (Ground 7), and Over C12652 and Nike (Ground 8).....	78
H.	Ground 9: D’969 is Obvious Over Skechers in view of Nike	84
1.	Publication of Skechers.....	84
2.	Overview of Skechers	85
3.	Analysis.....	87
XI.	SECONDARY CONSIDERATIONS	91
XII.	CONCLUSION.....	92

EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent No. D768,969 (“D’969”)
1002	File History of U.S. Application No. 29/542,318 (“D’969FH”)
1003	Declaration of Mr. Grant Delgatty in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent. No. D768,969 (“DELGATTY”)
1004	First Mina Ching Declaration on C11947
1005	Folder 002 to Exhibit B of Ex.1004 (C11947 Video)
1006	Second Mina Ching Declaration on C11947
1007	Image Captures of Ex. 1005
1008	C11947 Screen Capture on July 23, 2025
1009	Recommended Videos on March 3, 2014, Wayback Machine capture
1010	Mina Ching Declaration on C12652
1011	Folders 002-007 to Exhibit B to Ex.1010 (C12652 Images)
1012	Nike EUIPO Design Registration Certificate No. 002413161-0028, Certified Copy
1013	Excerpt of EUIPO REUD Bulletin No. 2014/046, March 10, 2014, Pages 1-2, 383-385
1014	Nike EUIPO Design Registration Application No. 002413161-0028, large-scale images
1015	EUIPO Posting for Nike
1016	Mina Ching Declaration on Skechers
1017	Folders 002-003 to Exhibit B to Ex.1016 (Skechers Images)
1018	Complaint for Patent Infringement in <i>Cole Haan LLC v. Top Glory Trading Group Inc. et al.</i> , 2:25-cv-00176 (D.N.J.)

Exhibit No.	DESCRIPTION
1019	J.E. Miller, B.M. Nigg, W. Liu, D.J. Stefanyshyn & M.A. Nurse, Influence of Foot, Leg and Shoe Characteristics on Subjective Comfort, 21 <i>Foot & Ankle Int'l</i> 759, 759–67 (2000).
1020	Steve Gelsi, Striving for Balance, 37 <i>Brandweek</i> , no. 6, Feb. 5, 1996, 17, available on Gale Academic OneFile.
1021	Paul Hekkert, Design Aesthetics: Principles of Pleasure in Design, 48 <i>Psychol. Sci.</i> 157, 163 (2006).
1022	Martyn R. Shorten, Running Shoe Design: Protection and Performance, in <i>Marathon Medicine</i> 162, 162–63 (2000).
1023	Amanda Holpuch, Netflix and YouTube Make Up Majority of US Internet Traffic, New Report Shows, <i>Guardian</i> , Nov. 11, 2013.
1024	J. Seabrook, Streaming Dreams, <i>New Yorker</i> , Jan. 8, 2012.
1025	National Judicial Caseload Profile, 2024, overall and New Jersey
1026	EUIPO Design Patent 002127563-0013
1027	Chinese Design Patent No. 201530359567
1028	Dorothy Koster Washburn & Donald Warren Crowe, <i>Symmetries of Culture: Theory and Practice of Plane Pattern Analysis</i> 33–34 (Univ. of Wash. Press 1988).
1029	Zlatina Kazlacheva, Symmetry in Nature and Symmetry in Fashion Design, <i>Econ. Manag. Inf. Technol. EMIT</i> , no. 1, 2013, 267-276.

TABLE OF ABBREVIATIONS

Abbreviation	DESCRIPTION
D'969	U.S. Patent No. D768,969 (“D’969”) (Ex.1001)
D’969FH	File History of U.S. Application No. 29/542,318 (Ex.1002)
Claim / Challenged Claim	Claim 1 of D’969
DOSITA	Designer of Ordinary Skill in the Art
IPR	<i>Inter Partes</i> Review
OB	Ordinary Observer
Petitioners	Petitioners Top Glory Trading Group Inc. and DP Dream Pairs Inc. (collectively “Top Glory”)
PO	Patent Owner
POSITA	Person of Ordinary Skill in the Art
PTAB	Patent Trial and Appeal Board
SCOTUS	The Supreme Court of the United States of America
USPTO	United States Patent and Trademark Office

THE CHALLENGED CLAIM

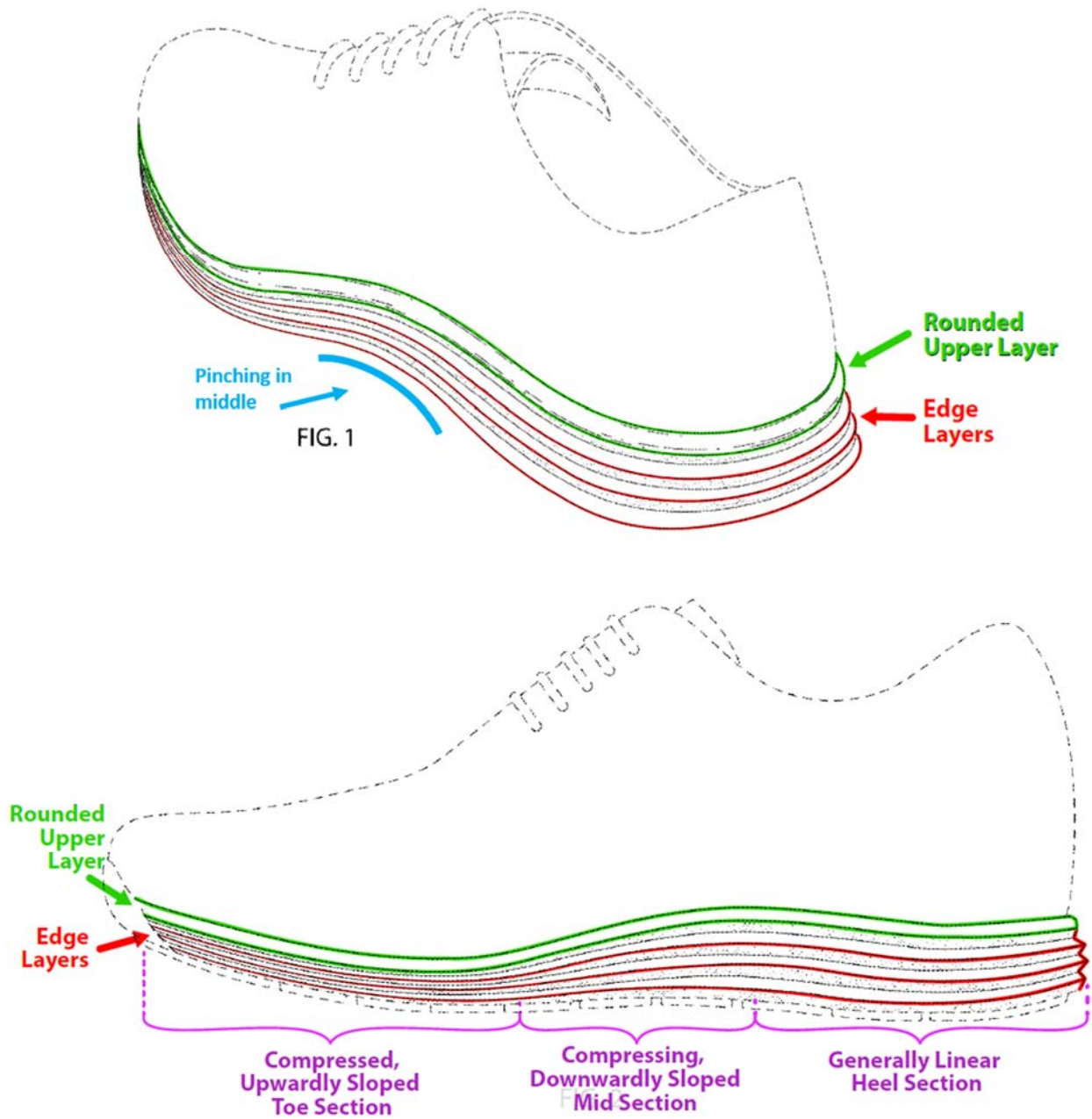
[1] The ornamental design for a shoe midsole, as shown and described.

Pursuant to §§311-319 and §42.1,¹ Top Glory Trading Group Inc. and DP Dream Pairs Inc. (collectively “Petitioners”) respectfully petition for IPR of claim 1 (“Claim”) of U.S. Patent No. D768,969 (Ex.1001, “D’969”). There is a reasonable likelihood—and it is highly likely—the challenged claim is unpatentable as explained herein. Petitioners request review of the Claim and judgment finding it unpatentable under §§102 and 103.

I. INTRODUCTION

D’969 claims “[t]he ornamental design for a shoe midsole, as shown and described.” Ex.1001. Figures 1 and 2 below are representative and disclose “a shoe midsole” with *three ridged edge layers*, extending continuously from a heel section to a toe section. The *three ridged edge layers* form a *generally linear heel section*, a *downwardly sloped midsection in which the ridged edges are compressed* (i.e., decrease in height), and an *upwardly sloped toe section with compressed ridged edges*. The *three ridged edge layers* are topped with a *rounded upper layer*. The midsole follows the natural shape of a foot, slightly *pinching* in the middle, and widening near the toe region. Delgatty ¶¶44-52.

¹ Section cites are to 35 U.S.C. or 37 C.F.R. as context indicates. All emphasis/annotations added unless noted. Citations herein are exemplary and not meant to be limiting.



D'969, Figs. 1-2; *see also* Figs. 4-5.

But to an ordinary observer, this design was substantially the same as already present in the field. To a DOSITA in the footwear field, this design for a shoe midsole was already known in the art. For example, publications disclosing Cole

Haan (assignee of D'969) shoes from 2013-14 (more than one year prior to D'969's earliest alleged priority date)—including **Cole Haan C11947**, **Cole Haan C12652**, and **Nike** (Cole Haan's former owner)—each anticipate and at minimum render obvious the Claim of D'969. The claimed midsole is also disclosed and at minimum rendered obvious by **Cole Haan C11947** in view of **Nike**, **Cole Haan C12652** in view of **Nike**, and **Skechers** in view of **Nike**. Delgatty ¶¶73-206.

Petitioners submit D'969 is unpatentable for the reasons set forth in this Petition, as supported by Mr. Grant Delgatty (Ex.1003). Accordingly, Petitioners request the Board institute trial and find the Claim unpatentable. Delgatty ¶¶1-214.

II. MANDATORY NOTICES UNDER 37 C.F.R. §42.8

A. Real Party-in-Interest

Petitioners and Miracle Miles Group, Inc. are real parties-in-interest. No other party had access to or control over the Petition, and no other party funded or participated in preparation of the Petition.

B. Related Matters

D'969 is the subject of the following co-pending civil action:

Cole Haan LLC v. Top Glory Trading Group Inc. et al., 2:25-cv-00176
(D.N.J.) (“NJ Case”).

U.S. Patent No. D768,969
Petition for *Inter Partes* Review

Petitioners have also filed petitions for IPR of utility patents which are also the subjects of the NJ Case: U.S. Patents 10,327,511 (IPR2025-01392), 10,443,163 (IPR2025-01393) and 11,041,262 (IPR2025-01394).

C. Lead and Back-Up Counsel

Lead Counsel	Backup Counsel
<p>James L. Davis, Jr. Reg. No. 57,325 ROPES & GRAY LLP 525 University Avenue, 8th Floor Palo Alto, CA 94301 Phone: +1-650-617-4000 Fax: +1-617-235-9492 james.l.davis@ropesgray.com</p> <p>TopGlory-ColeHaan-Ropes- IPR@ropesgray.com</p> <p>Mailing address for all PTAB correspondence: ROPES & GRAY LLP IPRM—Floor 43 Prudential Tower 800 Boylston Street Boston, Massachusetts 02199-3600</p>	<p>Matthew R. Shapiro Reg. No. 70,945 ROPES & GRAY LLP 1211 Avenue of the Americas New York, NY 10036-8704 Phone: +1-212-596-9000 Fax: +1-212-596-9090 matthew.shapiro@ropesgray.com</p> <p>Matthew Rizzolo Reg. No. 57,565 Colin Dunn Reg. No. 76,316 ROPES & GRAY LLP 2099 Pennsylvania Avenue, NW Washington, D.C. US 20006-6807 Phone: +1-202-508-4600 Fax: +1-202-508-4650 matthew.rizzolo@ropesgray.com colin.dunn@ropesgray.com</p> <p>James Mack Reg. No. 74,196 Nancy Attalla Reg. No. 81,978 ROPES & GRAY LLP 525 University Avenue, 8th Floor Palo Alto, CA 94303-2284 Phone: 650-617-4000 Fax: 617-235-9492 James.mack@ropesgray.com nancy.attalla@ropesgray.com</p>

Petitioners consent to electronic service of documents to the email addresses

identified above.

III. FEES

The undersigned authorizes the Office to charge the fee required by §42.15(a) and any additional fees due to Deposit Account No. 18-1945, under Order No. 119958-0002-651.

IV. REQUIREMENTS FOR IPR

A. Grounds for Standing

Pursuant to §42.104(a), Petitioners certify D’969 is available for IPR. Petitioners and any real parties-in-interest are not barred or estopped from requesting IPR challenging the Claim on the grounds identified herein.

B. Identification of Challenge

Pursuant to §§42.104(b) and (b)(1), Petitioners request IPR of the Claim and that the Board cancel the same as unpatentable.

1. The Specific Art on Which the Challenge Is Based

Petitioners rely upon the following art (Delgatty ¶¶73-206):

Name	Publication/ Link	Additional Public Accessibility Support	Date Published	Date Archived	Prior art under at least
Cole Haan C11947 (“C11947”)	Ex.1005; https://web.archive.org/web/20140303101313/https://www.youtu	Exs. 1004, 1006-1009	February 20, 2014	March 3, 2014	§102(b)

U.S. Patent No. D768,969
Petition for *Inter Partes* Review

	be.com/watch?v=dSFaDo991Hk				
Cole Haan C12652 (“C12652”)	Ex.1010; https://web.archive.org/web/20140708055052/http://www.colehaan.com/lunar-grand-long-wingtip-chili-pepper/C12652.html?dwar_C12652_color=Chili%20Pepper		N/A	July 8, 2014	§102(b)
Nike, EUIPO Design Registration Application No. 002413161-0028 (“Nike”)	Ex.1012	Exs.1013, 1015	March 10, 2014	N/A	§102(b)
Skechers Embolden Oxfords (“Skechers”)	Ex.1016; https://web.archive.org/web/20130714135257/https://dappered.com/2013/07/would-you-wear-it-lunargrands-emboldens/		July 10, 2013	July 14, 2013	§102(b)

Each of the above references is prior art to the Claim based on the October 13, 2015 filing date of App. No. 29/542,318 listed in D’969’s priority claim.

2. Statutory Grounds on Which the Challenge Is Based

Grounds	Claim	Basis	Reference(s)
1-2	1	§§102/103	C11947
3-4		§§102/103	C12652
5-6		§§102/103	Nike
7		§103	C11947, Nike
8		§103	C12652, Nike
9		§103	Skechers, Nike

V. D’969 PATENT AND PROSECUTION HISTORY

A. D’969

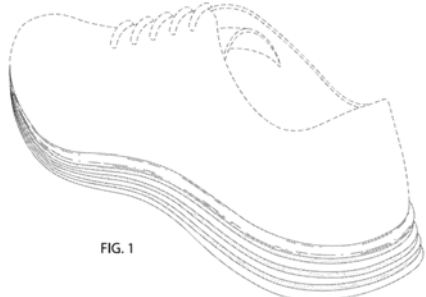
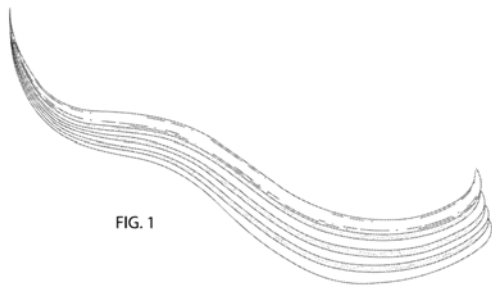




D’969 was filed on October 13, 2015 as U.S. Pat. App. 29/542,318 (“D’318-App”), and issued on October 18, 2016. D’969 has a single claim for “[t]he ornamental design for a shoe midsole, as shown and described.” Ex.1001, Claim.

D’969 provides 7 figures showing different views of its claimed design:

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

Ex.1001, 1. Delgatty ¶¶35-45.

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

D'969 Figure Solid and dashed (unclaimed) lines	D'969 Figure Solid lines only
 <p>FIG. 1</p>	 <p>FIG. 1</p>
 <p>FIG. 2</p>	 <p>FIG. 2</p>
 <p>FIG. 3</p>	 <p>FIG. 3</p>

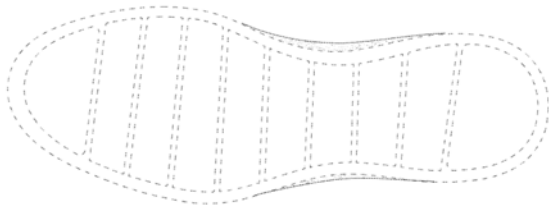


FIG. 4

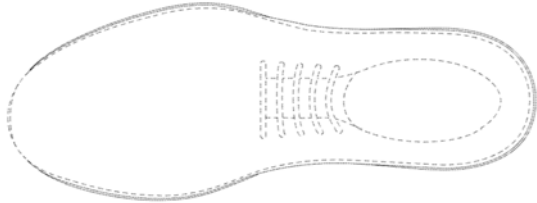


FIG. 5

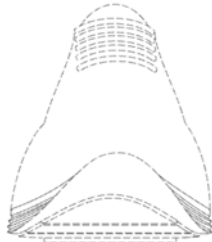


FIG. 6

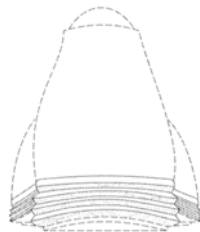


FIG. 7

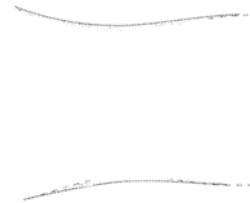


FIG. 4

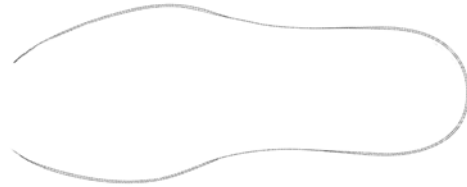


FIG. 5



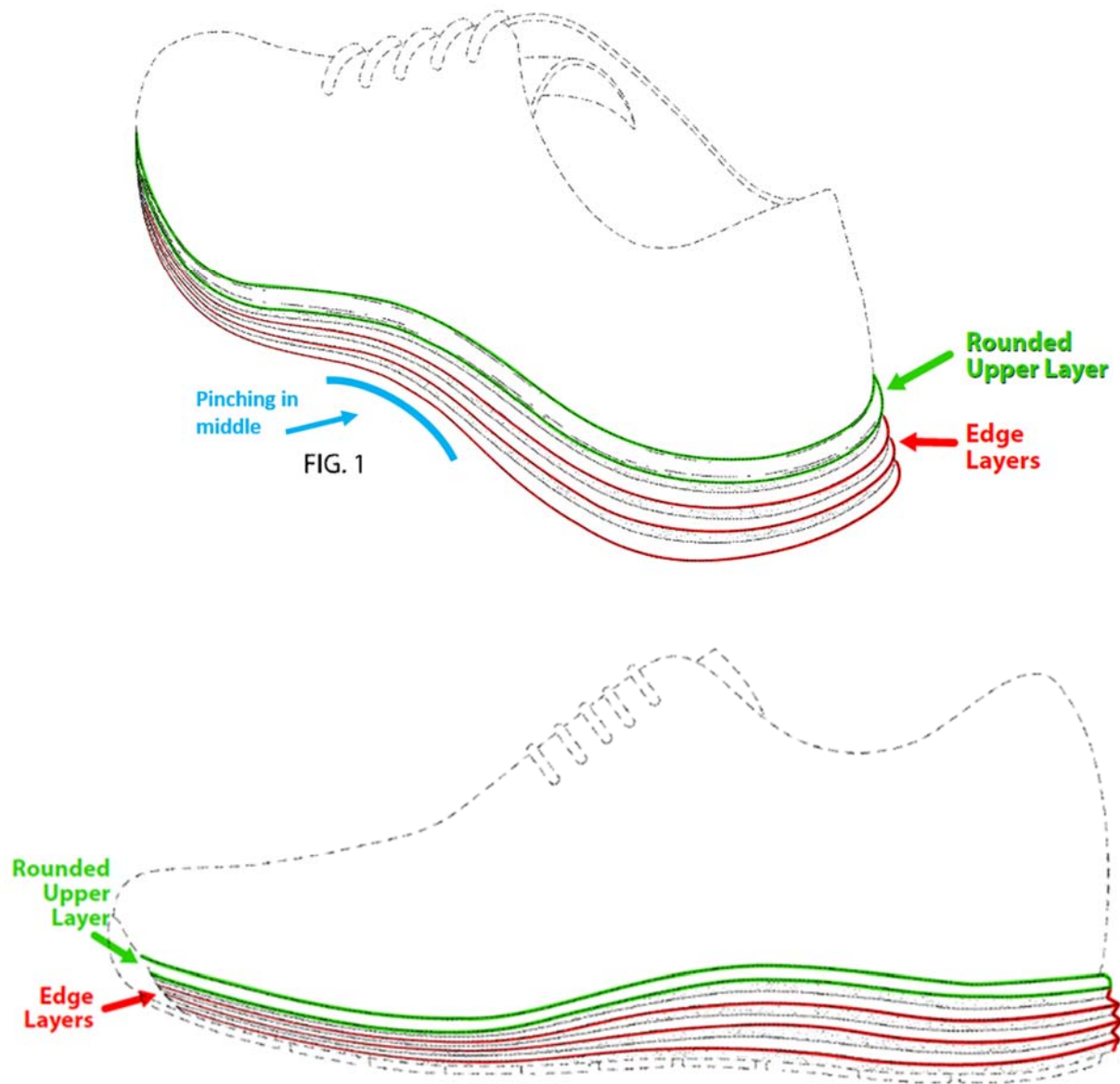
FIG. 6



FIG. 7

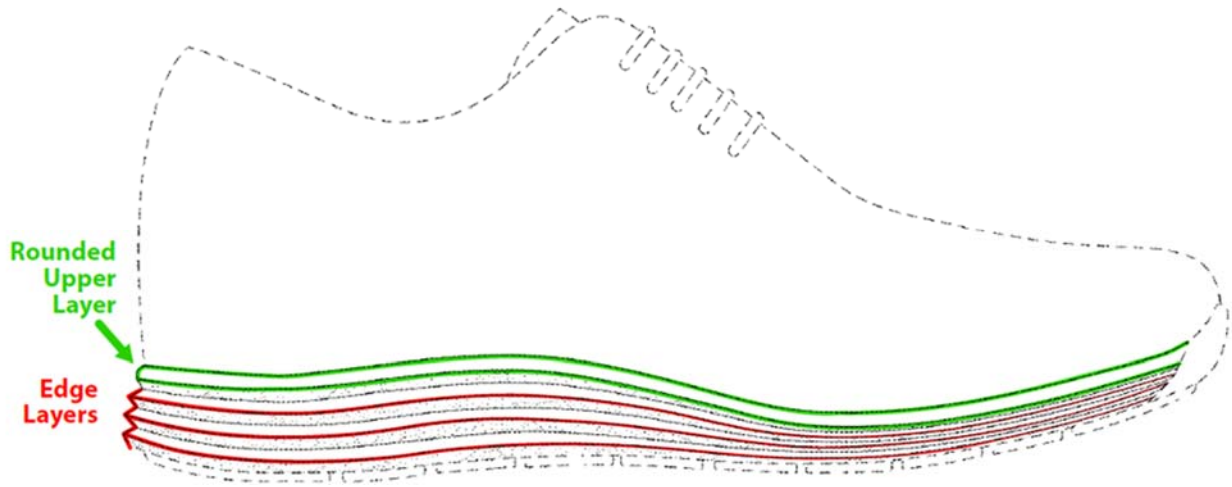
The claimed portions of the seven figures of D'969 together give an overall visual impression of a shoe midsole with *three ridged edge layers* resting atop a *rounded upper layer*, both of which extend continuously from a *generally linear heel section, compressing and downwardly sloping in a midsection*, and

compressed upwardly sloping towards the toe section. Figs. 1 and 2. From the top plan view (or planar view) the midsole follows the shape of a foot arch, slightly *pinching* in the middle. Figs. 4-5. Delgatty ¶47.



D'969, Fig. 2. Delgatty ¶¶47-.48

Figure 3 is a medial side elevation view of D'969.



D'969, Fig. 3. Delgatty ¶49.

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

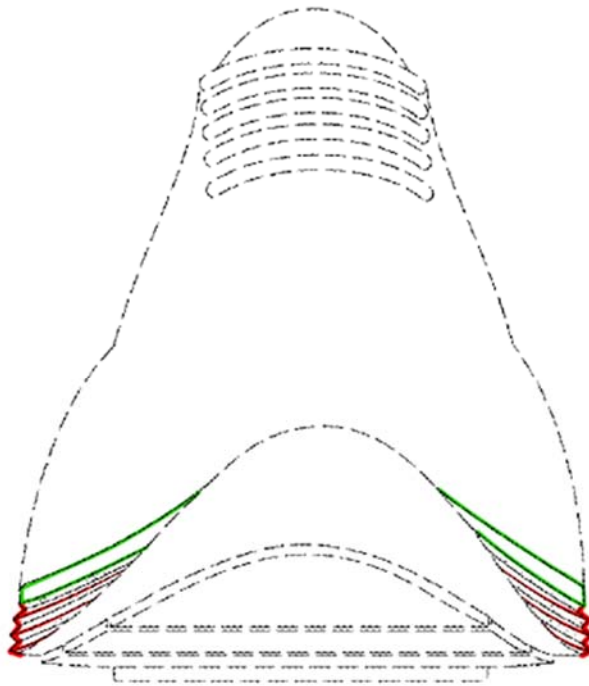


FIG. 6

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

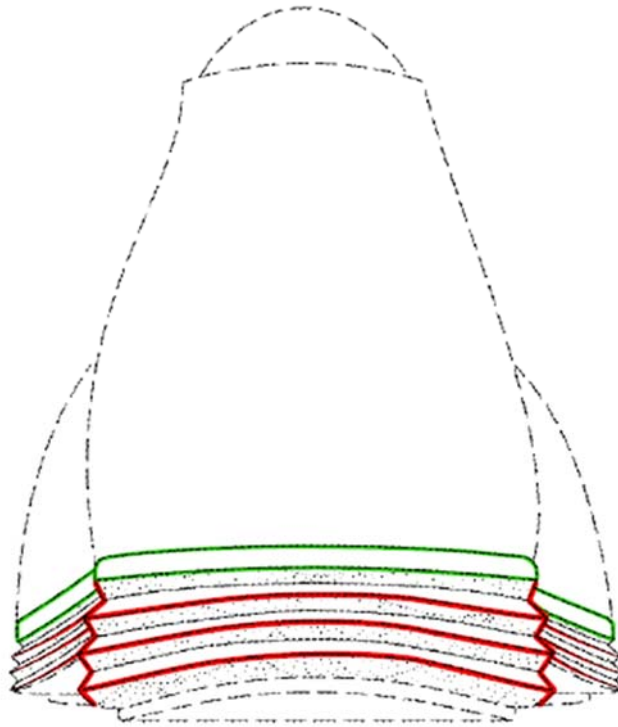


FIG. 7

D'969, Figs. 4-7. Delgatty ¶49.

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

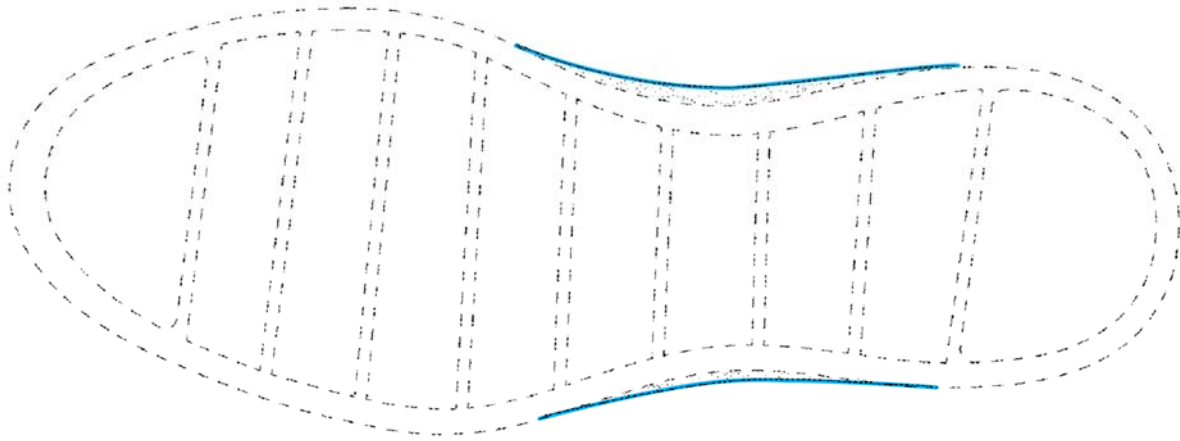


FIG. 4

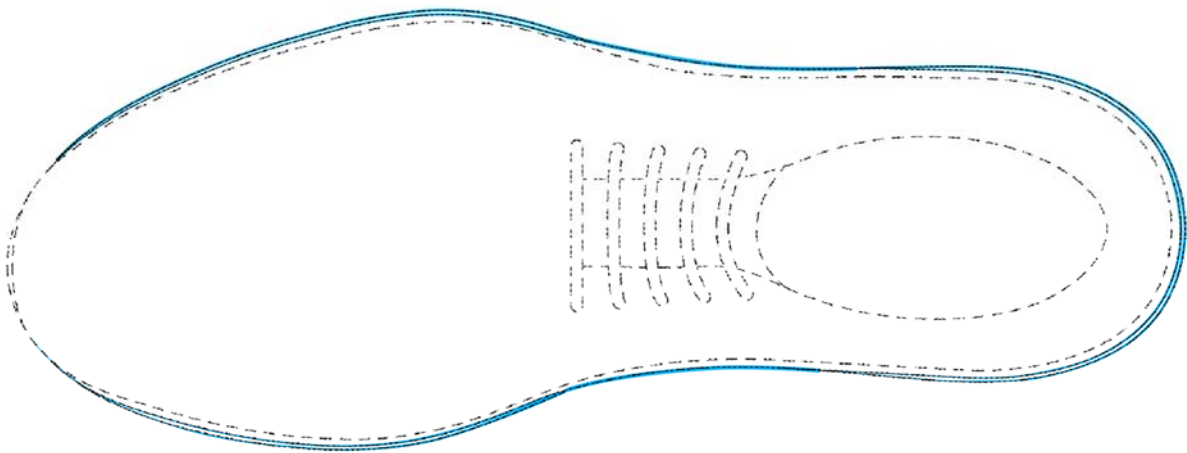


FIG. 5

D'969, Figs. 1-7. Delgatty ¶50.

D'969's figures, considered as a whole, create a wave-like design in a midsole. The wavy midsole follows the elevations and compressions of a foot, producing a flowy-looking, fluid-like midsole. Delgatty ¶¶51-52; *see also* ¶¶35-43.

B. Prosecution History of D'969

During prosecution of D'318-App, which issued as D'969, the Examiner rejected claim 1 under 35 U.S.C. §§112(a)-(b), finding the claim indefinite and not enabled. Ex.1002 (D'969FH) at 48-54. The Examiner found original Figures 2-3 and 5-6 inconsistently depict which portions of the design are claimed in the toe area: side-views depicted the toe area claimed with a downward slope at the peak, but front profile demonstrated the toe area was not claimed with a peak in the center. Ex.1002 at 49-53. The Examiner found that while Figures 2-3 and 6-7 demonstrate the ridged edges extend beyond the upper perimeter of the sole, this was not reflected in Figure 5. *Id.* Delgatty ¶¶53-54.

In response, Applicant submitted replacement sheets for Figures 2-3 and 5-7, where Figures 2-3 were amended to clarify that “neither the toe region of the sole nor the bottom boundary line adjacent the stippled shaded region of the lowermost flute are claimed” and Figure 5 was amended to show “the outermost edges...extending beyond the perimeter of the upper.”² *Id.*, at 68-74. The claim was

² This Petition takes no position as to whether this amendment constituted an addition of new matter, because the prior art presented herein is prior art to D'969 even under the purported effective filing date of October 13, 2015. Petitioners reserve the right to challenge the effective filing date of D'969 in another forum.

allowed on 7/21/2016. *Id.*, at 97-98. Delgatty ¶55.

VI. §325(d) AND §314(a) DISCRETION DOES NOT APPLY

A. §325(d)

Under the *Advanced Bionics* framework, there is no basis for discretionary denial under §325(d) as **the grounds raised by this Petition are not the same or substantially the same as the art and arguments raised during D’969’s prosecution.** *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Pap. 6, *8 (precedential). For example, **C11947, C12652, Nike, and Skechers** were never identified in an Information Disclosure Statement, considered (alone or in combination), or used as the basis for a rejection. *Sony v. MZ Audio Scis., LLC*, IPR2022-01544, Pap. 12 *7 (§325(d) discretion is improper where “Examiner did not consider the specific combination of references asserted.”). In fact, the Examiner never issued a rejection on any prior art grounds, neither §102 nor §103, during D’969’s prosecution. *See* §V.B.

Even if the art and arguments were substantially the same, the Examiner erred in a manner material to the patentability of the Claim. Because the “Examiner did not expressly consider” **C11947, Cole Haan C12652, Nike, or Skechers**, it is difficult, if not impossible to explain “why the Examiner allowed the claims” or “how the Examiner might have considered the arguments presented in the Petition.” *Bowtech, Inc. v. MCP IP, LLC*, IPR2019-00379, Pap. 14, *20 (not

exercising §325(d) discretion). If the Examiner had considered substantially the same art or arguments, it was error to allow the Claim because, *e.g.*, the Examiner failed to reject the Claim over references or combinations of references visually similar to D'969 and teaching a shoe design with a *rounded upper layer* and *ridged edge layers* compressing and sloping along different portions of the shoe's edge. *See* §§X.A-F.

B. §314(a)

The co-pending NJ Case also does not warrant the exercise of discretion under §314(a).

Factor 1 weighs in favor of institution. Petitioners intend to seek a stay of the NJ Case pending the outcome of this IPR, along with other IPRs related to the litigation dispute.

Factor 2 weighs in favor of institution. No trial date has been set. The median time to trial in the District of New Jersey is 60 months from the filing date of the Complaint (which was filed January 7, 2025). Exs.1018, 1025. Petitioners have been diligent in preparing and filing this petition.

Factor 3 weighs in favor of institution. The case is in its infancy, with a scheduling conference set for August 15, 2025, and no *Markman* or trial date has been set.

Factor 4 weighs strongly in favor of institution. Upon institution of this IPR

proceeding, Petitioners stipulate they will not pursue in the NJ Case the grounds of invalidity asserted in the IPR, or any other ground was raised or could have reasonably been raised in the IPR with respect to the Challenged Claim.

Factor 5 is neutral or weighs at most only slightly against institution. While Petitioners and PO are the same parties in the NJ Case, institution and a public trial record of the important invalidity grounds in the Petition will reduce issues for the public, including all parties besides Petitioners who currently are or may in the future be subject to litigation involving D'969.

Factor 6 weighs strongly in favor of institution. The Petition is strong and presents compelling unpatentability arguments overlooked during prosecution, *see* §X.A-F, and Cole Haan failed to disclose its own prior art during prosecution of D'969. D'969 issued in 2016, and it has not been asserted until PO filed the NJ case against Petitioners in 2025. Although PO corresponded with Petitioners about other Cole Haan patents as early as 2022, PO never mentioned D'969 or otherwise stated it believed D'969 was infringed until providing Petitioners with a draft complaint on October 31, 2024. Ex.1018 (Complaint) at 88-148 (prior correspondence lacks any mention of D'969). Accordingly, Petitioners had strong settled expectations PO had no intention or reason to assert D'969. Additionally, PO has not developed settled expectations. *Berkshire Hathaway Energy Co. et al. v. Birchtec Corp.*, IPR2025-00274, Paper 23 at 3 (PTAB July 2, 2025) (“[T]he challenged patents

issued in 2019 and 2020, such that [PO] has not developed strong settled expectations that favor discretionary denial.”).

Accordingly, the Board should not exercise its discretion to deny institution. §314(a).

VII. LEGAL STANDARD

A. Anticipation

When assessing a design patent challenge on anticipation, the pertinent question is whether the claimed and prior art “designs are substantially the same,” requiring consideration of whether “their resemblance is deceptive to the extent that it would induce OB, 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, 1312–13 (Fed. Cir. 2001) (citing *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871)). SCOTUS articulates the OB test as follows:

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

Gorham Co., 81 U.S. at 528. The OB is a person familiar with the prior art designs. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 675-678 (Fed. Cir. 2008). “[T]he ordinary observer test requires consideration of the design as a whole.” *Int’l Seaway Trading Corp. v. Walgreens Corp.* 589 F.3d 1233, 1243 (Fed. Cir. 2009)

(citation omitted). For purposes of comparison, the question is whether the claimed design and the prior art are substantially the same: “The mandated overall comparison is a comparison taking into account significant differences between the two designs ... minor differences cannot prevent a finding of anticipation.” *Id.*

1. Ordinary Observer

The “ordinary observer” (“OB”) is a consumer, or purchaser, considering a product in the ordinary course of business. *See Goodyear Tire & RubberCo. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998) (“[T]he focus is on the actual product that is presented for purchase, and the ordinary purchaser of that product.”). For D’969, OB is a retail consumer considering the purchase of shoes, who will compare the claimed design to other shoe designs, make the decision to purchase a shoe comprising the design, and wear the shoe. Delgatty ¶¶29, 59. Although other potential observers exist during the lifetime of a shoe (e.g., wholesalers, retailers, critics), all are consequent to and flow from the retail shoe purchase and the actions of those other potential observers depend exclusively on the perspective of and decisions made by the retail shoe purchaser. Delgatty ¶59; *see Hafco Foundry & Mach. Co.*, 2020 WL 1239842, *4–5 (Fed. Cir. Mar. 16, 2020); *Pac. Coast Marine. v. Malibu Boats, LLC*, Case No. 6:12-cv-00033, 2013 WL 12156465, at *6 (M.D. Fla. Jan. 4, 2013) (OB for a marine windshield design patent was the ordinary recreational boat buyer); *Ashley Furniture Indus. Inc. v. Lifestyle*

Enter. Inc., 574 F. Supp. 2d 920, 928 (W.D. Wis. 2008) (“the ordinary observer is the ultimate consumer, not the intermediary retail buyer”). Delgatty ¶59.

B. Obviousness

In finding the claim of a design patent obvious over the prior art, the central inquiry is “the visual impression of the claimed design *as a whole* and *not on selected individual features*.” See *LKQ Corp. v. GM Global Technology Operations LLC*, 102 F.4th 1280, 1299 (Fed. Cir. 2024) (en banc) (citing *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)). “Invalidity based on obviousness of a patented design is determined [based] on factual criteria similar to those that have been developed as analytical tools for reviewing the validity of a utility patent under §103, that is, on application of the Graham factors.” *LKQ*, 102 F.4th at 1295. According to *Graham*, the question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective evidence of obviousness or nonobviousness, i.e., secondary considerations (“the Graham factors”). See *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In “[a]pplying *Graham* factor one, the fact finder should consider the ‘scope and content of the prior art’ within the knowledge of an ordinary designer in the field of the design.” *LKQ*, 102 F.4th at 1295–96. In applying this factor, “the scope and

content of the prior art, a primary reference must be identified.” *LKQ*, 102 F.4th at 1298. The primary reference is generally the closest prior art most visually similar to the claimed design, but does not need to be “‘basically the same’ as the claimed design. Rather, the primary reference need only be ‘something in existence—not ... something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature.’” *Id.* “The primary reference will typically be in the same field of endeavor as the claimed ornamental design’s article of manufacture, but it need not be, so long as it is analogous art.” *Id.*

Graham factor two requires “determining the differences between the prior art designs and the design claim at issue,” to “compare the visual appearance of the claimed design with prior art designs, albeit from the perspective of an ordinary designer in the field of the article of manufacture.” *LKQ*, 102 F.4th at 1298.

Graham factor three requires “the level of ordinary skill in the pertinent art [must be] resolved.” *LKQ*, 102 F.4th at 1298–99 (brackets in original). In “the design patent context, ... ‘a person of ordinary skill in the art to which the invention pertains’ in §103 [means] that obviousness of a design patent claim is assessed from the viewpoint of an ordinary designer in the field to which the claimed design pertains.” *Id.* at 1299.

Graham factor four requires reflecting on any secondary considerations, such

as commercial success, industry praise, and copying. *Id.* at 1300.

There is a lack of clarity among courts as to whether the perspective of the OB is relevant to obviousness. *Compare Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d at 1240 (“For design patents, the role of one skilled in the art in the obviousness context lies only in determining whether to combine earlier references to arrive at a single piece of art for comparison with the potential design or to modify a single prior art reference. Once that piece of prior art has been constructed, obviousness, like anticipation, requires application of the ordinary observer test, not the view of one skilled in the art.”) *with High Point Design*, 730 F.3d at 1313–15 n.2 (“We do not believe our decision in *International Seaway* ... compels a contrary conclusion. The *International Seaway* court may in fact have had the ‘designer of ordinary skill’ standard in mind when it used the term ‘ordinary observer.’ In any event, the court could not rewrite precedent setting forth the designer of ordinary skill standard.”). In view of the lack of clarity, this Petition considers the perspectives of both the OB and DOSITA in conducting the obviousness inquiry.

VIII. DOSITA

On or before the claimed priority date of October 13, 2015, a DOSITA would have at least a bachelor’s degree in industrial design, or the equivalent thereof, or approximately two years of professional experience in designing shoes. Additional graduate education could substitute for professional experience, or significant

experience in the field could substitute for formal education. Delgatty ¶¶1-34, 56-58.³

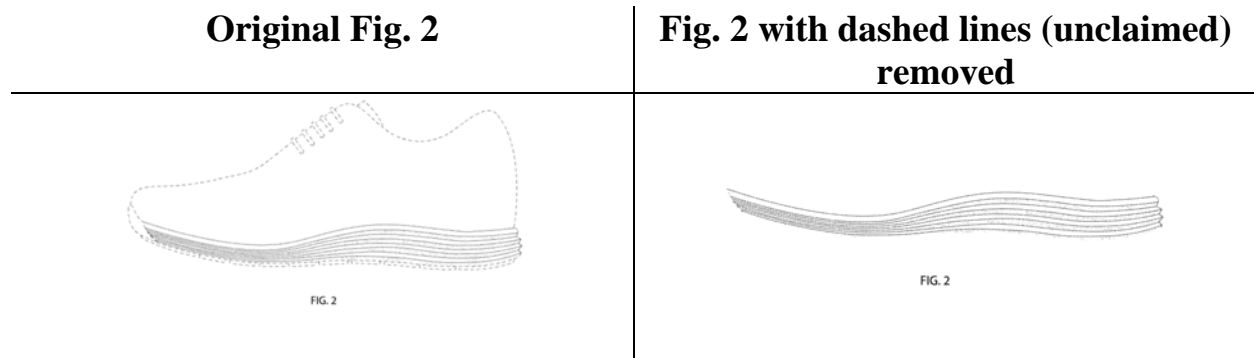
IX. CLAIM CONSTRUCTION

The claim in a design patent is defined by the drawings—and only the solid lines therein. *See, e.g., Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001) (finding specification explaining broken lines “form no part of the claimed design” was relevant to scope of the claim); 37 C.F.R. §1.152. The claim of a design patent is construed to encompass the overall ornamental visual impression as a whole, as illustrated by the figures. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1378 (Fed. Cir. 2002). “[A]s a rule, the illustration in the drawing views is its own best description.” *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1303 (Fed. Cir. 2010).

The sole claim of D’969 reads: “[t]he ornamental design for a shoe midsole, as shown and described.” The description makes clear that “broken lines are for the purpose of illustrating environmental structure; the broken lines form no part of the claimed design.” D’969, Description. Accordingly, Petitioners consider the sole

³ Note that DOSITA is not the same person as OB used in the “ordinary observer” test for anticipation of patent claims. *Next Step Group, Inc., v. Deckers Outdoor Corp.*, IPR2024-00525, Paper 16 at 31 (PTAB Aug. 6, 2024).

claim of D'969 as directed to the ornamental aspects of the design for a shoe midsole depicted in the figures in solid lines. Representative Figure 2 is shown without the dashed (unclaimed) lines:



Delgatty ¶¶60-61.

The Federal Circuit has explained the “preferable course” for construing design patents will not involve “a detailed verbal description of the claimed design,” while recognizing it is “helpful to point out...various features of the claimed design as they relate to the accused design and the prior art.” *Egyptian Goddess*, 543 F.3d at 679–680.

Here, as discussed below, the solid lines show D'969 design encompasses the following key features:

- (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*

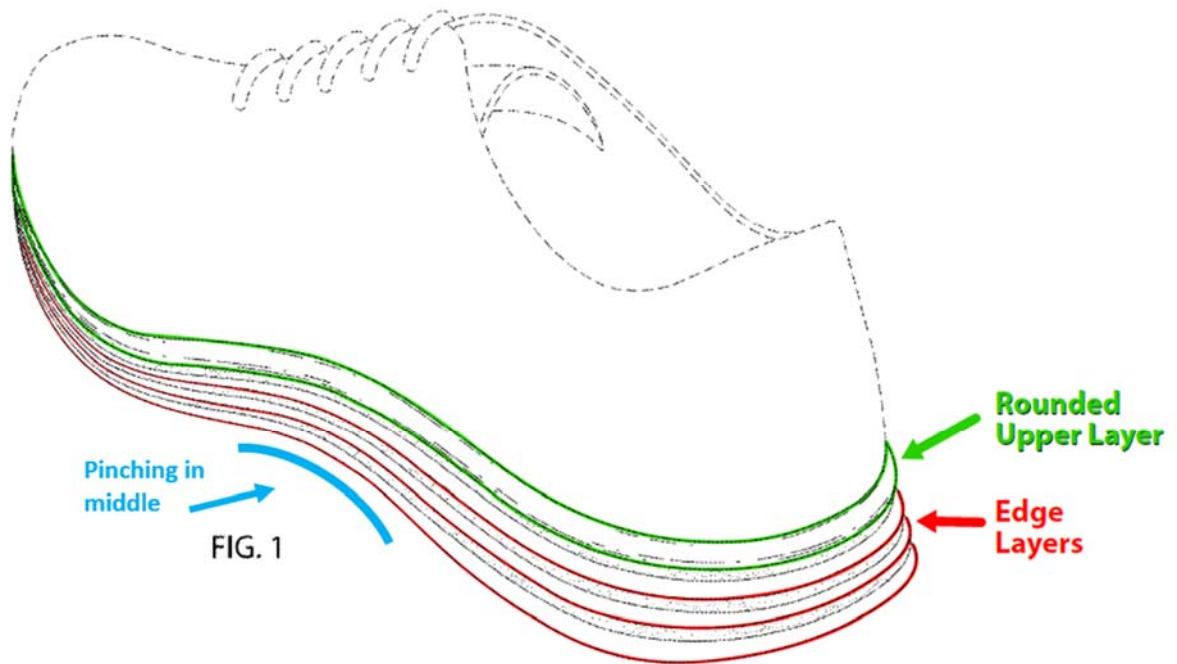
sloped midsection in which the ridged edges are compressed (i.e., decrease in height), and *an upwardly slope towards the toe section* with compressed *ridged edges* (Figs. 1-3);

(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).

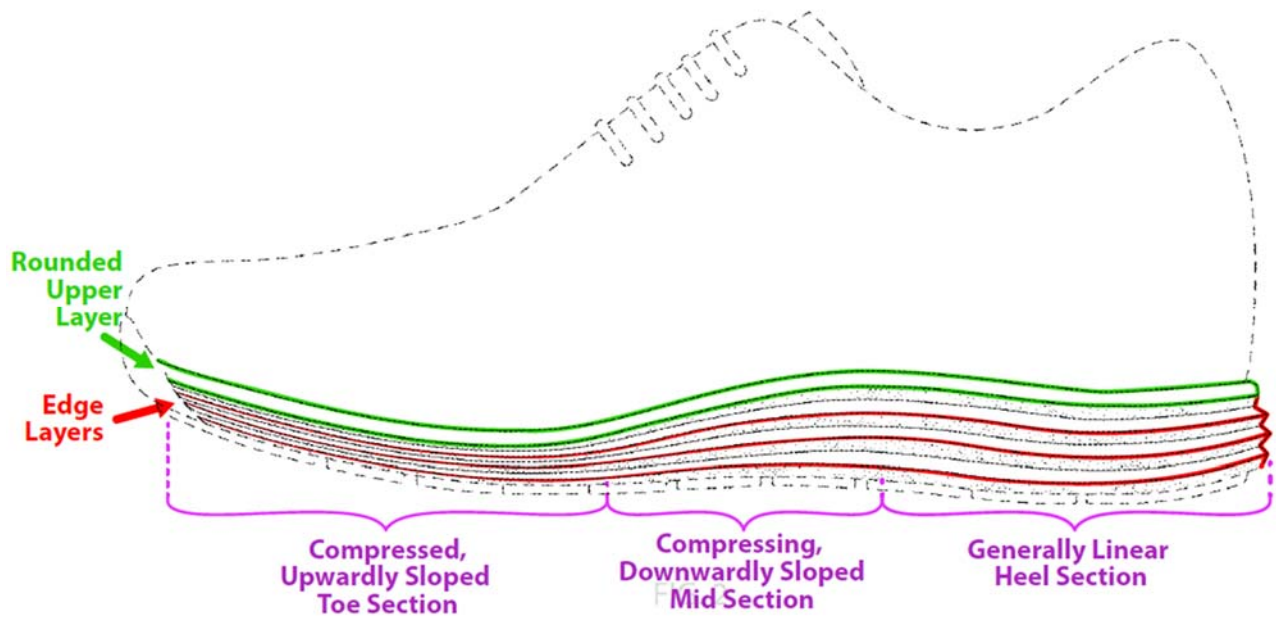
Delgatty ¶¶62-66.

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.



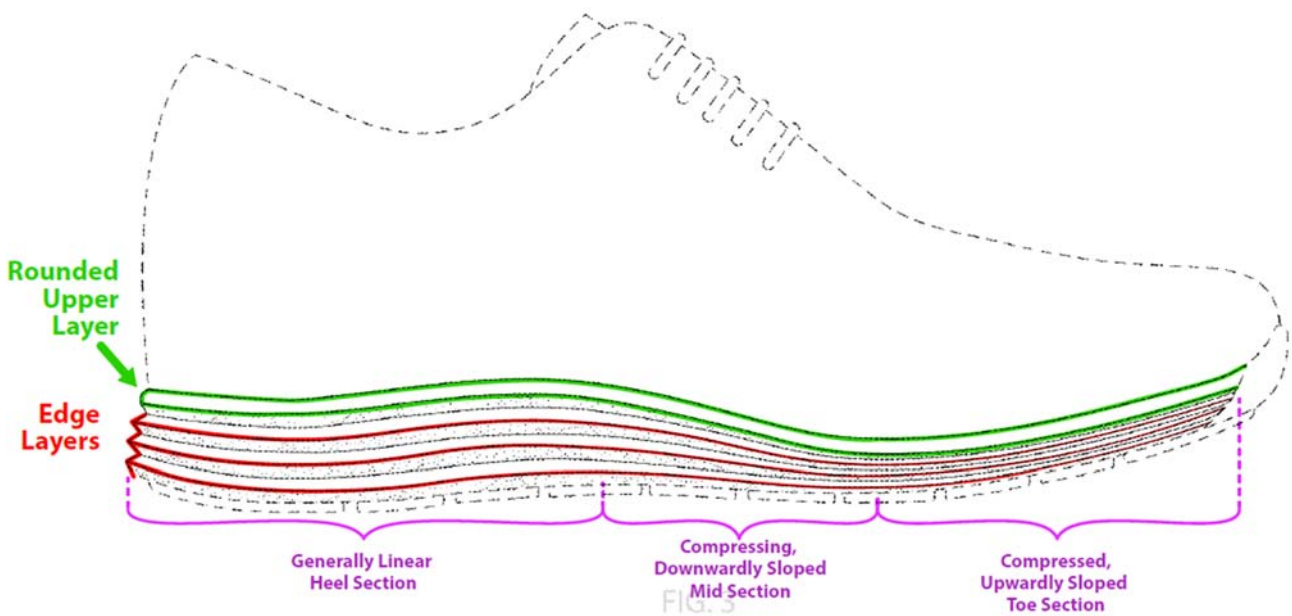
D'969, Fig. 1. Delgatty ¶67.

Figure 2 shows a lateral side of D'969 showing an *upper layer* that is more *rounded* than the ridged edge layers, and *three ridged edge layers*, which extend continuously from a *generally linear heel section, compressing and downwardly sloping in a midsection*, and *compressing and upwardly sloping towards a toe section*.



D'969, Fig. 2. Delgatty ¶68.

Figure 3— medial side elevation view—depicts the same design elements as Figure 2.



D'969, Fig. 3. Delgatty ¶69.

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

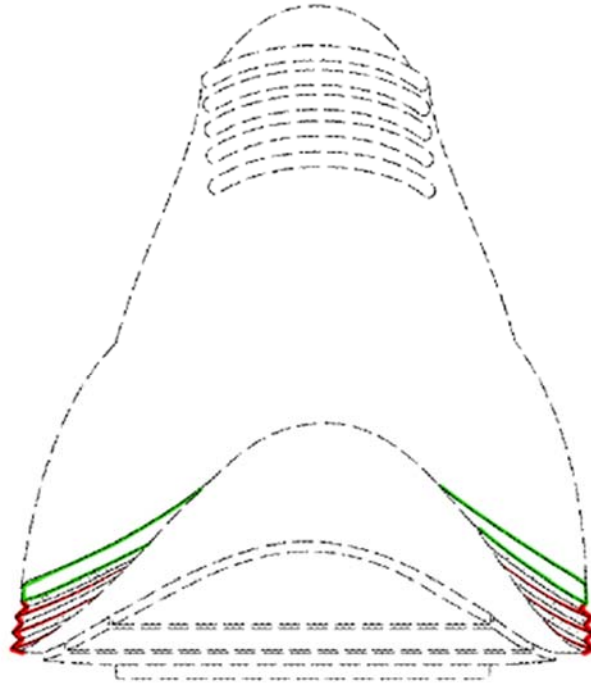


FIG. 6

Delgatty ¶70.

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

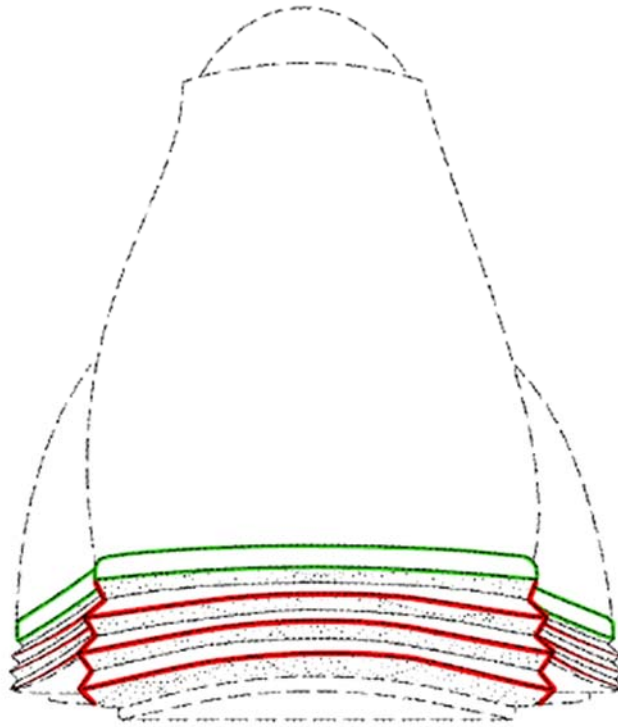


FIG. 7

D'969, Figs. 4-7. Delgatty ¶71.

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

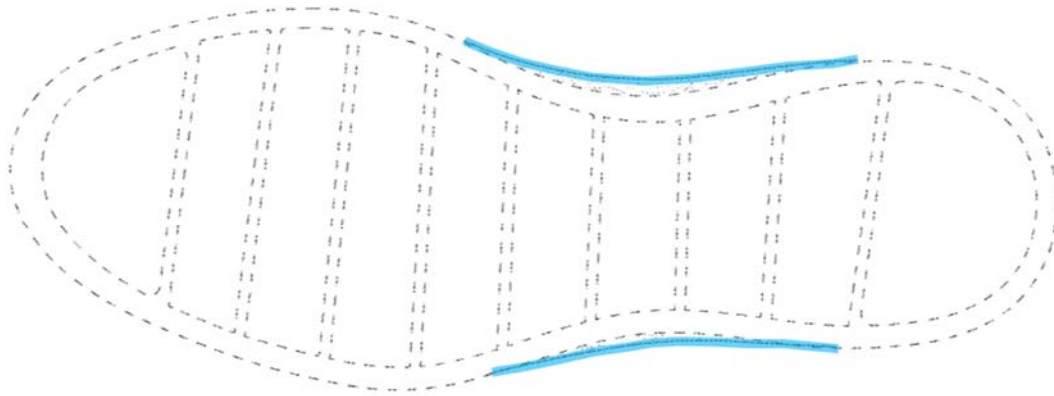


FIG. 4

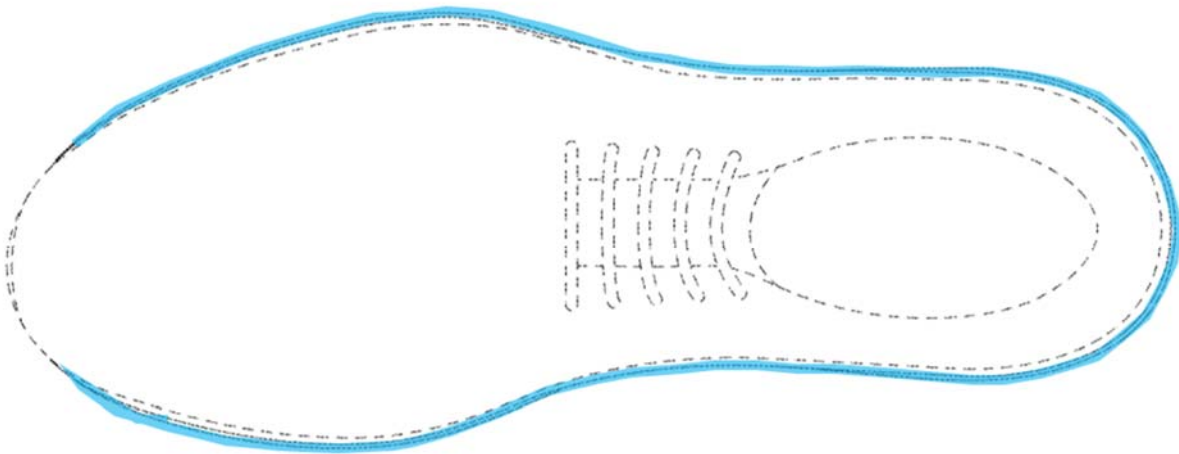


FIG. 5

D'969, Figs. 1-7. Delgatty ¶72.

X. GROUNDS OF UNPATENTABILITY

This Petition is supported by the Declaration of Grant Delgatty, which describes the prior art's scope and content at the time of D'969. Delgatty ¶¶1-214.

As demonstrated below, the visual impression of the claimed design is anticipated by and/or obvious in view of the prior art rendering D'969 unpatentable. Delgatty

¶¶73-76.

A. Ground 1: D’969 Is Anticipated By C11947

1. Publication of C11947

C11947 (Ex.1005) is a video that was publicly available on a YouTube webpage since at least March 3, 2014. Exs. 1004 (Internet Archive Declaration); 1006 (supplemental declaration showing “About” section of webpage expanded); 1007 (captured still images of Ex.1005 at timestamps). The C11947 video at Ex.1005 is authenticated at Ex.1004.B, Folder 002 (Ex.1004, Page 2). March 3, 2014 Internet Archive capture of the YouTube website showing the **C11947** publication indicates Ex.1005 was posted to YouTube and publicly available on February 20, 2014, more than one year before the earliest priority date of D’969. Exs.1004, Page 4 (showing 20140303 date code), Page 5. The present-day YouTube page (Ex.1018) shows the February 20, 2014 publication date, and comments time stamped “11 years ago” as of July 23, 2025. Delgatty ¶¶77-78.

Courts regularly find videos qualify as printed publications within the meaning of §102. *E.g., Jazz Pharms., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1352, 1356–60 (Fed. Cir. 2018) (affirming Board decision that documents and video on FDA web site qualify as printed publications); *Acco Brands Corp. v. Think Prods., Inc.*, IPR2015-01167, Paper 40 at 23 (PTAB Oct. 11, 2016) (a product video continuously available on the internet for about a year was a printed publication); *Ex*

parte Richard P. Mettke, No. 2008-0610, 2008 WL 4448201, at *6 (B.P.A.I. Sept. 30, 2008) (a video tape distributed at a trade show qualifies as a printed publication because “the key...is the ‘probability of dissemination’ rather than the form”).

YouTube was a well-known, public (e.g., no access restrictions), searchable website without access restrictions and intended to reach a wide audience. Indeed, in 2012 YouTube had “eight hundred million unique users a month, and generat[ed] more than three billion views a day. According to Nielsen, it drew eight times more video viewers last year [(2011)] than Hulu....” Ex.1024, 10. In November 2013, YouTube accounted for 18.69% of downstream traffic during peak periods in North America. “Netflix and YouTube Make Up Majority of US Internet Traffic.” Ex.1023. OB would have independently known about the YouTube website. Delgatty ¶78.

On the YouTube website, an interested member of the public, such as OB, would have been able to locate **C11947** on the website either by searching or receiving recommendations after watching other YouTube videos. *See, e.g.*, Ex.1009 (GTFan712Productions, The White/Infrared Air Jordan 6 Retro, YouTube (Mar. 1, 2014) accessed through the WayBack Machine (**C11947** in the recommended videos in the right panel); *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)); *HVLP02 LLC v. Oxygen Frog, LLC*, No. 4:16-cv-

00336, 2018 WL 11413543, at *1–2 (N.D. Fla. May 28, 2018) (a reasonable jury could find that a YouTube video qualified as a printed publication); *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1381 (Fed. Cir. 2012) (“[A] person of ordinary skill interested in [the relevant subject matter] would have been independently aware of [the website]” and “such an interested researcher would have found [the reference] using that website's own search functions and applying reasonable diligence.”); *see also Jazz Pharms., Inc. v. Amneal Pharms., LLC*, 895 F.3d 1347, 1355–56 (Fed. Cir. 2018)). Delgatty ¶79.

OB would have been able to find the video using other search engines as well. YouTube “grants the operators of public search engines permission to use spiders to copy material from the site for the sole purpose of and solely to the extent necessary for creating publicly available searchable indices of the materials.” *Lewis v. YouTube, LLC*, 244 Cal.App.4th 118, 122 (2015). Thus, OB searching for a shoe like **C11947** would have come across the video using Google as well. *Id.*; *See, e.g., Viacom Intern. Inc. v. Youtube Inc.*, 253 F.R.D. 256, 264 (2008) (“The Google Video website has its own video library, but searches for videos on it will also access YouTube videos.”). Delgatty ¶80.

As a result, the **C11947** video had been watched 2,558 times on the YouTube website and received 102 likes before March 3, 2014, demonstrating that interested

members of the public were able to locate and actually did access the reference prior to March 2014. Ex.1004,A.; Delgatty ¶81.

The Board has found YouTube videos qualify as printed publications. *E.g.*, *NxtGen Toys, LLC v. ZipString, LLC*, IPR2024-01213, Pap. 6, at *9-15 (PTAB Feb. 24, 2025) (YouTube video qualifies as printed publication based on video and expert testimony that a POSITA would regularly review videos on YouTube); *Cartessa Aesthetics, LLC v. Serendia, LLC*, IPR2022-00594, Paper 9 at 29–30, 42–44 (PTAB Aug. 12, 2022) (DeFranco, A.P.J., concurring) (a YouTube video qualifies as a printed publication so long as the video was publicly accessible); *see also* MPEP §2128(II)(F) (“Social media websites on the internet, such as YouTube ... can be a source of prior art, provided the public accessibility requirements .. are met.”); *see also id.* at §2128(II)(A) (“An electronic publication, including an online database or Internet publication (e.g., discussion group, forum, digital video, or social media post), is considered to be a ‘printed publication’ within the meaning of 35 U.S.C. 102(a)(1) ... provided the publication was accessible to persons concerned with the art to which the document relates.”). Here, Petitioners have presented additional evidence beyond the evidence presented in *NxtGen*, including a declaration from the Internet Archive, also called the Wayback Machine. MPEP §2128(II)(E) (“Publications obtained via the Wayback Machine® are prima facie deemed to be

publicly accessible at the date and time provided in the time stamp”). Delgatty ¶¶77-82.

Based on this evidence taken as a whole, the **C11947** publication was publicly available by at least by March 3, 2014, and thus qualifies as a prior art printed publication, or as being otherwise available to the public, under §102(b). The Examiner never found, and Applicant never cited, **C11947** during prosecution. Delgatty ¶82.

2. Overview of C11947

The **C11947** video discloses multiple views of a Cole Haan shoe, style “C11947,” from various angles, with exemplary frames below:





(02:14:735)



(01:39:734)

Lateral Side Elevational	Medial Side Elevational



(00:19:275)

(01:37:960)

Bottom Plan



(00:54:821)

(01:23:563)

Top Plan



(00:42:760)

Rear Elevational

Front Elevational



Ex.1007. **C11947** discloses a design of a shoe midsole with all features of D'969:

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

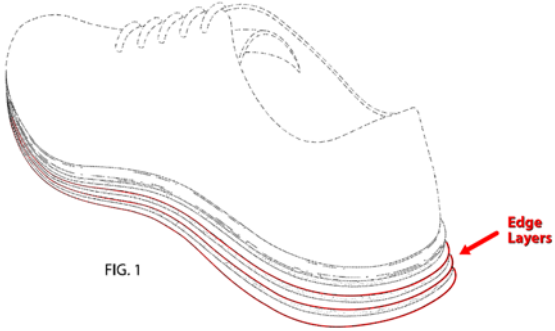

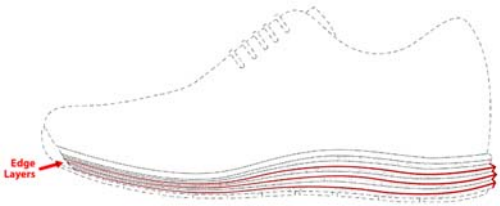

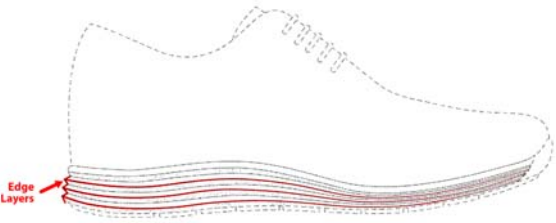

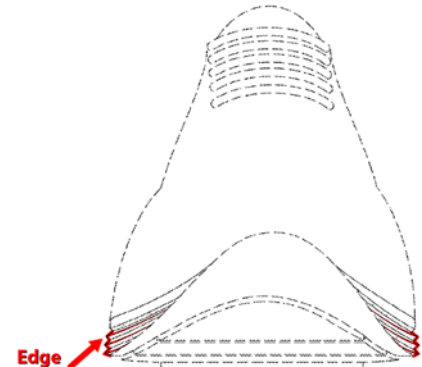

Delgatty ¶¶83-84.

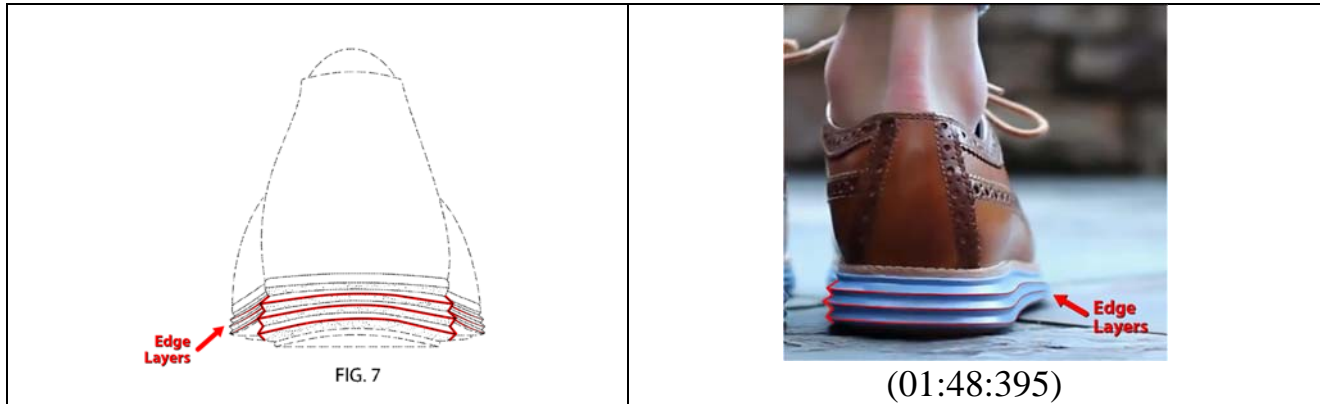
3. Claim Chart

a. Ridge Layers

C11947 and D'969 are substantially the same as both designs disclose *three*

vertically stacked, ridged edge layers extending continuously from heel to toe:

D'969	C11947
 <p>FIG. 1</p> <p>Edge Layers</p>	 <p>Edge Layers</p> <p>(02:14:735)</p>
 <p>Edge Layers</p> <p>FIG. 2</p>	 <p>Edge Layers</p> <p>(00:19:275)</p>
 <p>Edge Layers</p> <p>FIG. 3</p>	 <p>Edge Layers</p> <p>(01:37:960)</p>
 <p>Edge Layers</p> <p>FIG. 6</p>	 <p>Edge Layers</p> <p>(1:36:770)</p>



Exs.1001, 1007. Delgatty ¶85.

The *three vertically stacked ridged edge layers* of D’969 are substantially the same as **C11947** (with consideration to the different forms of media they are presented in). **C11947**’s midsole includes the same *three ridged edge layers* claimed in D’969. Thus, “in the eye of an [OB], giving such attention as a purchaser usually gives,” the two designs are substantially the same. *Gorham Co.*, 81 U.S. at 528. Delgatty ¶86.

In conjunction with other features discussed, **C11947** and D’969 are substantially the same, and as result, D’969 is anticipated by **C11947**. Delgatty ¶87.

b. Compressions

C11947 and D’969 are substantially the same as both designs disclose three ridged edge layers which extend continuously from a *generally linear heel section*, *compressing and downwardly sloping in a midsection*, and *compressed upwardly sloping in a toe section*:

D’969	C11947
-------	---------------



Exs.1001, 1007. Delgatty ¶88.

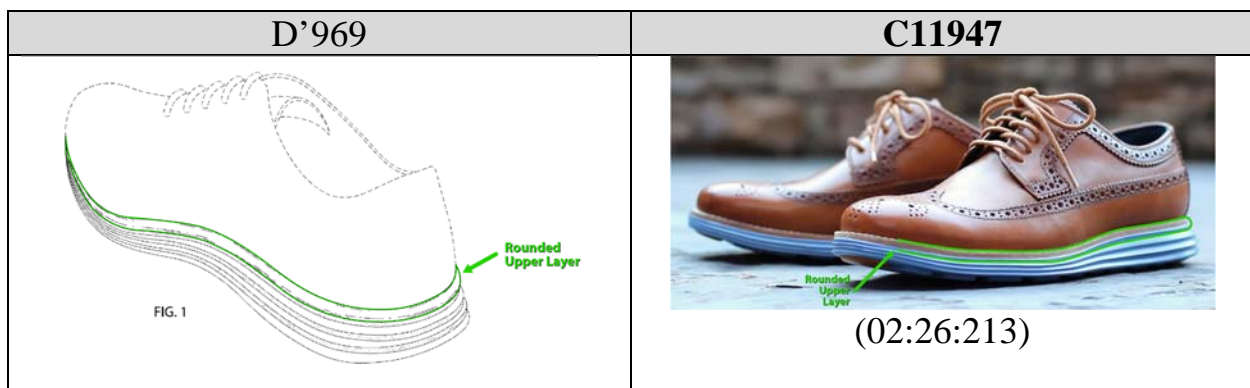
The *compressions* of D’969 are substantially the same as C11947 (with consideration to the different forms of media they are presented in). C11947’s midsole includes a heel section in which the layers are *generally linear*, a midsection that is *compressed and downward sloping*, and *a compressed upward slope towards the toe section*. As a result of this similarity (and the other same features discussed) both designs present substantially the same wave-like pattern throughout the midsole. Thus, “in the eye of an [OB], giving such attention as a purchaser usually gives,” the two designs are substantially the same. *Gorham Co.*, 81 U.S. at 528. Delgatty ¶89.

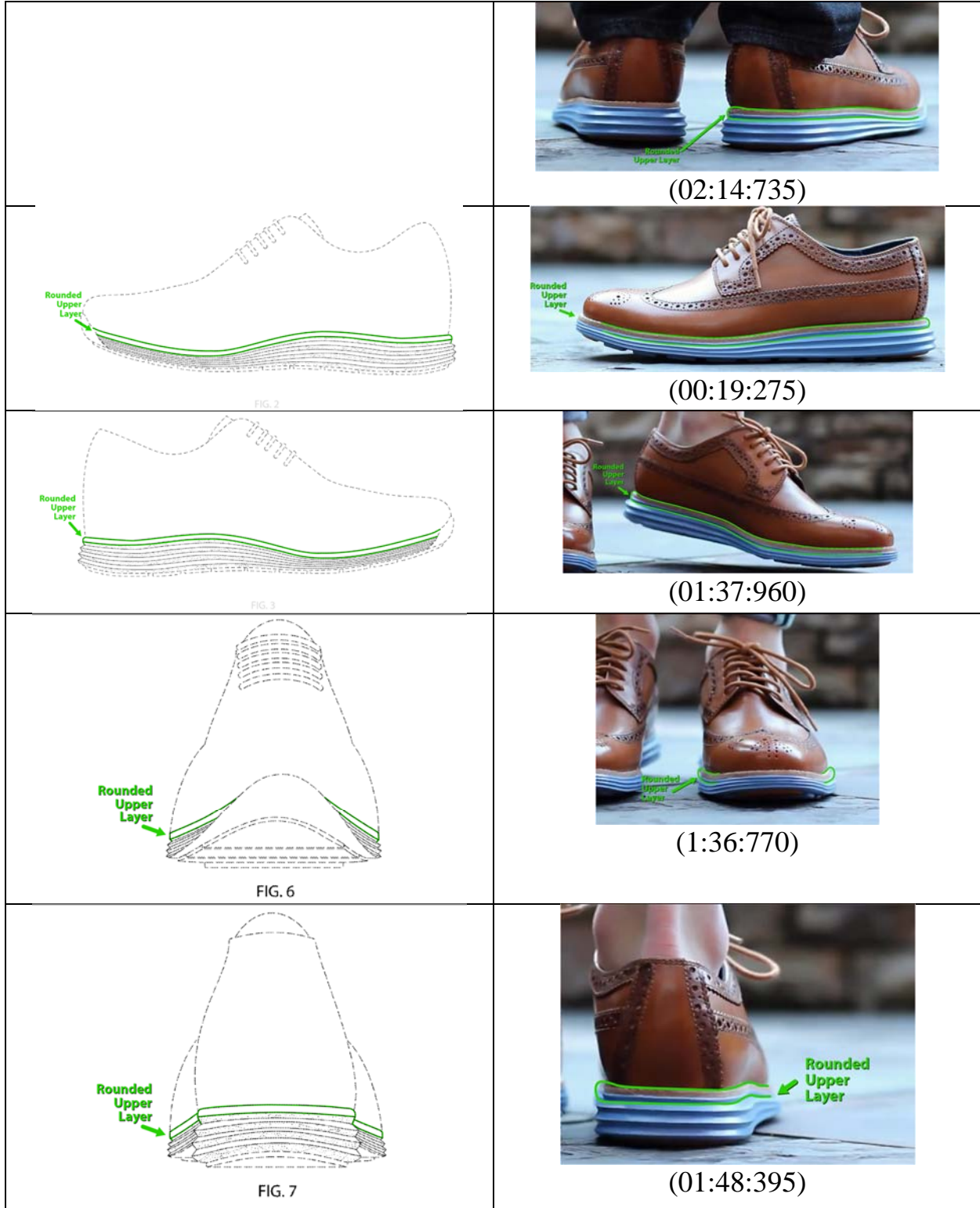
To the extent PO argues D’969 requires the *compressing, downwardly sloped midsection* to comprise a steeper downward slope, for the same reasons as stated

above I.A.1.a, such a minor difference in sloping angle does not affect the design as a whole. D'969 and C11947, considered as a whole, evoke the same wave pattern to the OB, with both midsoles compressing in the downwardly sloped midsection. A small variation in degree of compression is a minor difference that cannot prevent a finding of anticipation. Both designs encompass a shoe with *three ridged edge layers*, which extend continuously from a *generally linear heel section, compressing and downwardly sloping in a midsection, and compressed upwardly sloping in a toe section*. Considering this and the other features discussed, C11947 and D'969 have the same overall visual impression and the two designs are substantially the same, and as a result, D'969 is anticipated by C11947. Delgatty, ¶90.

c. Rounded Upper Layer

C11947 and D'969 are substantially the same as both designs disclose a *rounded upper layer* above the top ridged edge layer:





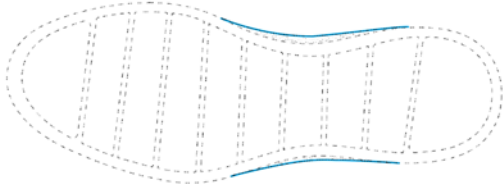

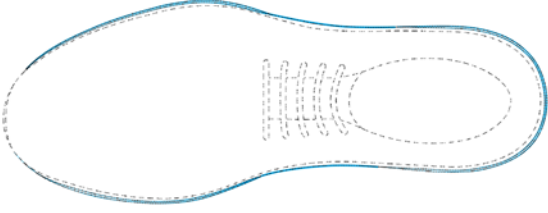

Exs.1001, 1007. Delgatty ¶91.

The *rounded upper layer* of D'969 is substantially the same as the **C11947** (with consideration to the different forms of media they are depicted). **C11947's** midsole includes a top layer that is more rounded than the ridged edges of the ridged edge layers, substantially the same as D'969. Under PO's apparent interpretation of D'969 scope, a shoe with a *rounded upper layer* similar to **C11947** is substantially similar to D'969. Ex.1018 (Complaint, NJ Case) at 27, 29, 31. To the extent PO argues the rounded upper layer of **C11947** is insufficiently rounded, "in the eye of an [OB], giving such attention as a purchaser usually gives," the layers appear substantially the same – **C11947** upper layer is more softly curved than the ridged edge layers, like D'969. Minor discontinuity in the rounded layer can be accounted for by the leather welt between the upper and the midsole. 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. Delgatty ¶92. Thus, "in the eye of an [OB], giving such attention as a purchaser usually gives," the two designs are substantially the same. *Gorham Co.*, 81 U.S. at 528. Delgatty ¶92.

In conjunction with the other features discussed, **C11947** and D'969 are substantially the same, and as a result, D'969 is anticipated by **C11947**. Delgatty ¶93.

d. Pinched Midsection

C11947 and D'969 are substantially the same as both disclose a slightly *pinched* mid-section following the shape of a foot:

D'969	C11947
 <p>FIG. 4</p>	 <p>(00:54:821)</p>
 <p>FIG. 5</p>	 <p>(00:42:760)</p>

Exs.1001, 1007. Delgatty ¶94.

To the extent PO argues the bottom view (Figure 4) of D'969 requires the midsole to overhang, over the bottom sole, the bottom sole is not claimed (dashed lines). Even still, **C11947** is the same in this design feature as well. As seen in the

C11947 figure corresponding to D'969's Figure 4, **C11947**'s midsole hangs over the bottom sole which touches the ground (patterned).⁴ Delgatty ¶95.

In conjunction with the other features discussed, **C11947** and D'969 are substantially the same, and as a result, D'969 is anticipated by **C11947**. Delgatty ¶96.

4. Overall Design

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

⁴ In fact, this unclaimed bottom sole emphasizes the similarities between the designs, and in particular the claimed midsole. The unclaimed bottom sole of **D'969** is visually similar to **C11947**, in that it is segmented and has tracks. Delgatty ¶95.

D'969

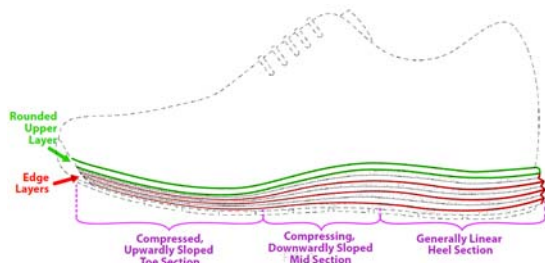
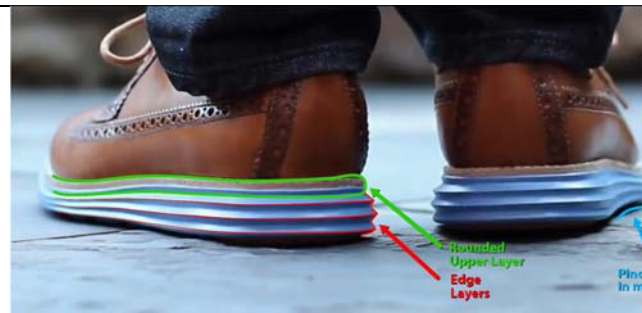
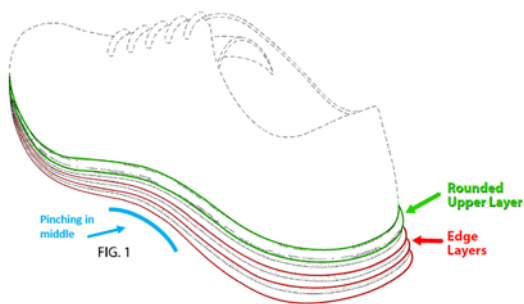


Fig. 2

C11947



(00:19:275)



(02:14:735)

Exs. 1001, 1007. Delgatty ¶97.

To the extent PO argues there are minor variations (of which there are none), they do not preclude a finding of anticipation because the overall impression created—the wave-like pattern resulting from the four features discussed above—remains equivalent between **C11947** and D'969. Delgatty ¶98.

Just like *International Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243 (Fed. Cir. 2009), where the court found slight variations in the “number and position of the circular holes” in shoes (clogs) did not preclude a finding of anticipation because the overall visual impression remained the same, here any slight

variations PO alleges between **C11947** and D'969 would not change the overall visual impression created by **C11947**. Delgatty ¶¶98-99.

Any minor differences do not affect the overall visual impression of **C11947**. As in *International Seaway*, here any slight variations PO may allege would not change the overall visual impression created by **C11947**: a wave-like design on a midsole shaped like a typical foot. 589 F.3d at 1243 (Fed. Cir. 2009); Delgatty ¶99.

Considering the overall claimed midsole design of D'969 and the overall midsole design of **C11947**, an OB would have been induced to purchase one supposing it to be the other. As a result, D'969 claim is anticipated by **C11947**. Delgatty ¶100.

B. Ground 2: D'969 is Obvious Over C11947

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

To the extent PO argues **C11947** is materially different, the claim of D'969 is obvious over **C11947**. Delgatty ¶102.

Graham one: **C11947** is a suitable primary reference as it is visually similar to D'969 (*see* Ground 1). **C11947** was “something in existence,” and is “visually similar” to D'969. *LKQ*, 102 F.4th at 1298. Delgatty ¶103. The scope and content of **C11947**, considered with the knowledge of a DOSITA (defined in VIII), is

essentially identical to D'969: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched midsection. *See* Ground 1; Delgatty ¶103.

Graham two: To the extent PO argues such features do not exist in **C11947**, comparing the visual appearance of D'969 with the prior art, from the perspective of DOSITA, the differences between the claimed midsole and **C11947** are an overhanging midsole and a more rounded upper layer. Delgatty ¶104.

Overhanging Midsole: To the extent PO argues Figure 4 (bottom view of D'969) requires an overhanging midsole, extending past the bottom of the sole, those proportions would have been obvious to a DOSITA as they would have been purely functional, rather than ornamental. *See Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505, 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be “obvious, from a functional standpoint”). Making the midsole wider to result in an overhang would have been obvious to accommodate those with wider feet since, fit of a shoe (including the midsole) is key in comfort. *See, e.g.*, Ex.1019, 7-8 (“An important factor for shoe comfort was the fit of the shoe.”). In fact, shoe companies offered wide-sizes well before the priority date of D'969: “New Balance is attempting to maintain its identity as a niche player by producing running shoes and extra-wide sizes.” Ex.1020, Abstract. Indeed, the length and width of a midsole is dictated by the size and proportions of the foot, which is entirely functional in nature. *See Door-Master*, 256 F.3d at 1312 (“only the non-functional

aspects of an ornamental design as shown in a patent are proper bases for design patent protection”) (internal quotations and citations omitted). “[W]ider midsoles offer a greater lever arm to the ground reaction force, increasing angular displacement and pronation velocity.” Ex.1022, pg162. Delgatty ¶105.

Even if that were not the case, DOSITA would have found changing the width of the midsole to be trivial. Delgatty ¶106. DOSITA would have had the common knowledge and skill to understand any given midsole could be easily modified to be wider or thinner depending on the foot and would have been motivated to vary the overall size of the midsole to suit the targeted consumer base. Delgatty ¶106.

More Rounded Upper Layer: To the extent PO argues D’969 requires a more rounded upper layer, that would have been obvious to the DOSITA as **C11947** suggests it on its own. **C11947**’s upper layer is already rounded, appearing softer and less sharply ridged than the bottom three ridged layers, suggesting a rounder layer to a DOSITA. Delgatty ¶107.

Even if that were not the case, DOSITA would have found softening the curve of the upper layer of the midsole to be trivial. Delgatty ¶108. DOSITA would have had the common knowledge and skill to understand the already rounder layer, as compared to the other, ridged layers, could be easily modified to be even rounder and would have been motivated to do so to create continuity in the meeting of the welt material with rubber material. Delgatty ¶108.

Graham three: See VIII. Delgatty ¶109.

Graham four: See XI. Delgatty ¶110.

DOSITA would have found **C11947** to be visually similar to D'969, depicting a flowy, wave-like design on a midsole. Thus, the claim is obvious in view of **C11947**. Delgatty ¶111.

C. Ground 3: D'969 is Anticipated By C12652

1. Publication of C12652

C12652 (Ex.1010) is a webpage that was publicly available on www.colehaan.com since at least July 8, 2014. The latest archive date of the **C12652** publication is July 8, 2014, which is more than one year before the earliest priority date of D'969. Ex.1010, Page 4 (containing URL date code 20140708), Page 5; Delgatty ¶112. Embedded within the C12652 webpage are high resolution images, which appear at Ex.1010, Pages 867-878. For ease of reference, the high-resolution images at Ex.1010, Pages 867-878 are reproduced as Ex.1011.

Colehaan.com was well-known, public (e.g., no access restrictions), searchable, and intended to reach a wide audience. DOSITA would have known about and readily located information on this website with reasonable diligence. *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1994 (Fed. Cir. 2008)). Based on this evidence taken as a whole, the **C12652** publication was

publicly available by at least July 8, 2014, qualifying as prior art at least under §102(b) as a printed publication, or as being otherwise available to the public. The Examiner never found, and Applicant never cited, **C12652** during prosecution. Delgatty ¶113.

2. Overview of C12652

C12652 provides multiple images of different views of **C12652**:⁵



⁵ **C12652** does not provide an image of the bottom view and unobstructed image of the medial side. Ex.1011. However, the images present are enough for OB to have understood the entire product, much like OB would have done in looking at limited images of products for sale online. Delgatty ¶114.



Top Plan



Rear Elevational



Ex.1011. Delgatty ¶114.

C12652 publication discloses a shoe midsole design with all features of D'969:

- *Three vertically stacked ridged edge layers* which extend continuously from heel to toe;
- *Generally linear heel section, a downwardly sloped midsection in which the ridges are compressed, and upwardly sloped toe section with compressed ridges.*
- *Rounded upper layer*; and

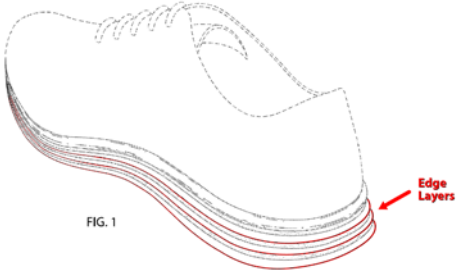
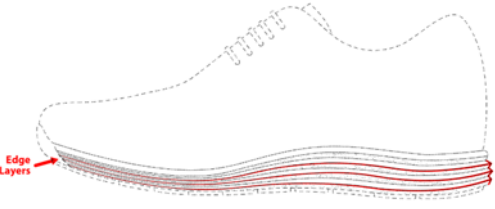

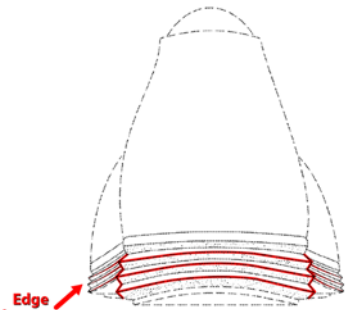
- Slightly *pinched* mid-section of the sole, and wider front area, resembling a typical foot shape.

Delgatty ¶115.

3. Claim Chart

a. Ridge Layers

C12652 and D'969 are substantially the same; both designs disclose *three vertically stacked, ridged edge layers* extending continuously from heel to toe:

D'969	C12652
 <p>FIG. 1</p>	 <p>Perspective</p>
 <p>FIG. 2</p>	 <p>Lateral Elevational</p>
 <p>FIG. 7</p>	 <p>Rear Elevational</p>

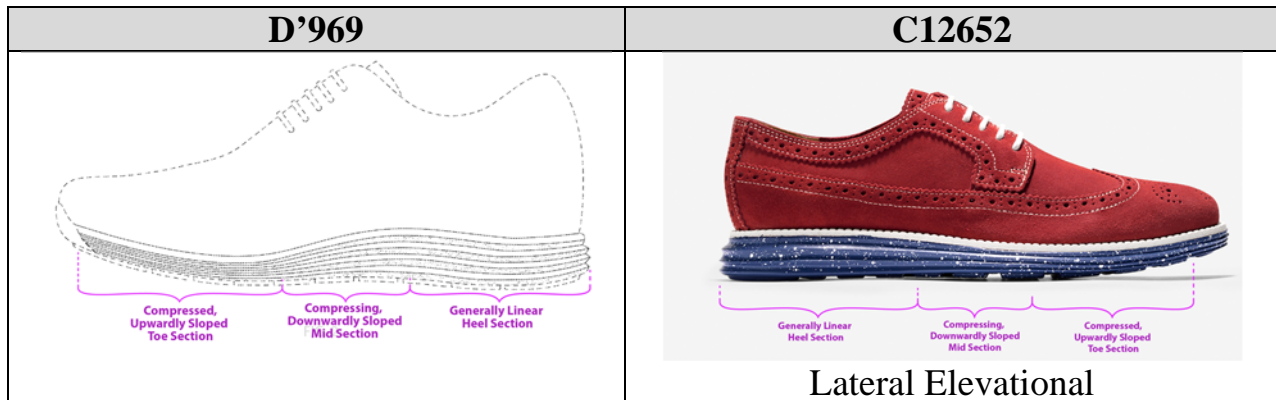
Exs.1001, 1011. Delgatty ¶116.

The *three vertically stacked ridged edge layers* of D'969 are substantially the same as **C12652** (with consideration to the different forms of media they are presented in). **C12652**'s midsole includes the same *three ridged edge layers* claimed in D'969. The sameness is reinforced by both having exactly *three* ridged edge layers (and one rounded upper layer, discussed below). Thus, the OB, giving such attention as a purchaser usually gives a midsole, and familiar with relevant prior art, would have been induced to purchase one supposing it to be the other. Delgatty ¶117.

C12652's perspective view is not identical to the angle of D'969's perspective view. However, from the available perspectives, OB would have recognized that all the design elements of D'969 are present in **C12652**, and the two midsoles are substantially the same in features and overall appearance. The available perspectives provide OB the ability to understand **C12652** to be substantially the same midsole as D'969 (consistent with the perspectives with which OB would have shopped online for shoes). Delgatty ¶118.

b. Compressions

C12652 and D'969 are substantially the same: both designs disclose three ridged edge layers which extend continuously from a *generally linear heel section*, *compressing and downward sloping in the midsection*, and *compressing and upward sloping towards a toe section*:



Exs.1001, 1011. Delgatty ¶119.

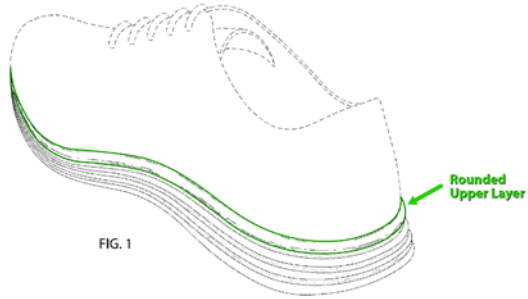

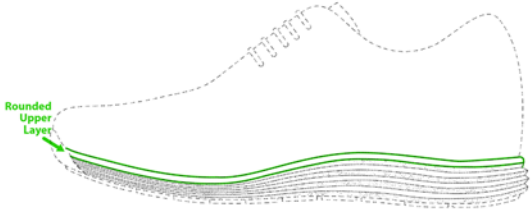

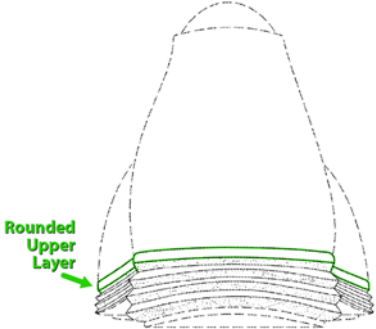

The *compressions* of D'969 are substantially the same as **C12652** (with consideration to the different forms of media they are presented in). **C12652's** midsole includes a heel section where the layers are *generally linear*, a midsection that is *compressed and downward sloping*, and *a compressed upward slope towards the toe section*. As a result of this similarity (and the other substantially same features discussed) both designs present substantially the same wave-like pattern throughout the midsole. Thus, “in the eye of an [OB], giving such attention as a purchaser usually gives,” the two designs are substantially the same. *Gorham Co.*, 81 U.S. at 528. Delgatty ¶120.

To the extent PO argues D'969 requires the *compressing, downwardly sloped midsection* to comprise a steeper downward slope, for the same reasons as stated in Ground 11.A.1.a, such a minor difference in sloping angle does not affect the design as a whole, and OB would not have considered such a minor difference, if noticed at all. *See* Ground 1. Considering this, and the other features discussed, **C12652** and

D'969 present the same overall visual impression and the two designs are substantially the same, and as a result, D'969 is anticipated by C12652. Delgatty ¶121.

c. Rounded Upper Layer

C12652 and D'969 are substantially the same: both designs disclose a *rounded upper layer*:

D'969	C11947
 <p>FIG. 1</p>	 <p>Perspective</p>
 <p>FIG. 2</p>	 <p>Lateral Elevational</p>
 <p>FIG. 7</p>	 <p>Rear Elevational</p>

Exs.1001, 1011. Delgatty ¶122.

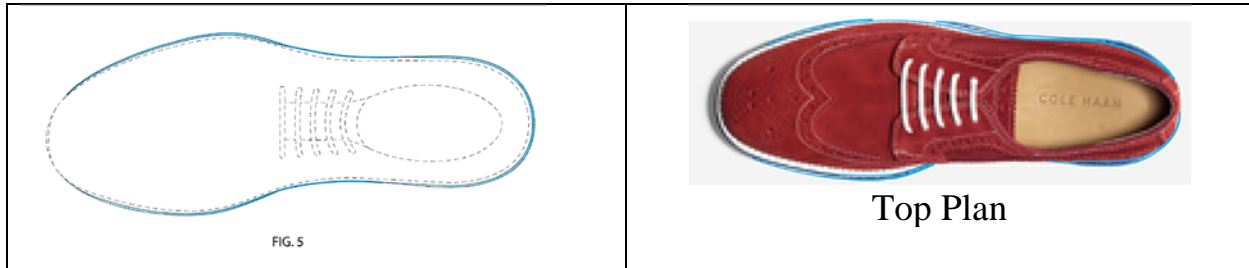
Under PO’s apparent interpretation of D’969 scope, a shoe with a **rounded upper layer** similar to **C12652** is substantially similar to D’969. Ex.1018 (Complaint in NJ Case) at 27, 29, 31. To the extent PO argues the rounded upper layer of **C12652** is more squared than rounded, “in the eye of an [OB], giving such attention as a purchaser usually gives,” the layers appear substantially the same – the **C12652** upper layer is more softly curved than the ridged edge layers, like D’969. 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. Delgatty ¶123. Thus, “in the eye of an [OB], giving such attention as a purchaser usually gives,” the two designs are substantially the same. *Gorham Co.*, 81 U.S. at 528. Delgatty ¶123.

In conjunction with the other features discussed, **C12652** and D’969 are substantially the same, and as a result, D’969 is anticipated by **C12652**. Delgatty ¶124.

d. Pinched Midsection

C12652 and D’969 are substantially the same: both designs disclose a slightly **pinched** mid-section following the shape of a foot:

D’969	C12652
-------	---------------



Exs.1001, 1011. Delgatty ¶125.

To the extent PO argues the bottom view (Figure 4) of D’969 requires the midsole to overhang over the bottom sole, this would be irrelevant as the bottom sole is not claimed (dashed lines). Still, **C12652** is substantially the same in view of this design feature. As seen in the corresponding **C12652** figure to D’969’s Figure 5, **C12652**’s midsole overhangs over the bottom sole that touches the ground (patterned area).⁶ Delgatty ¶126.

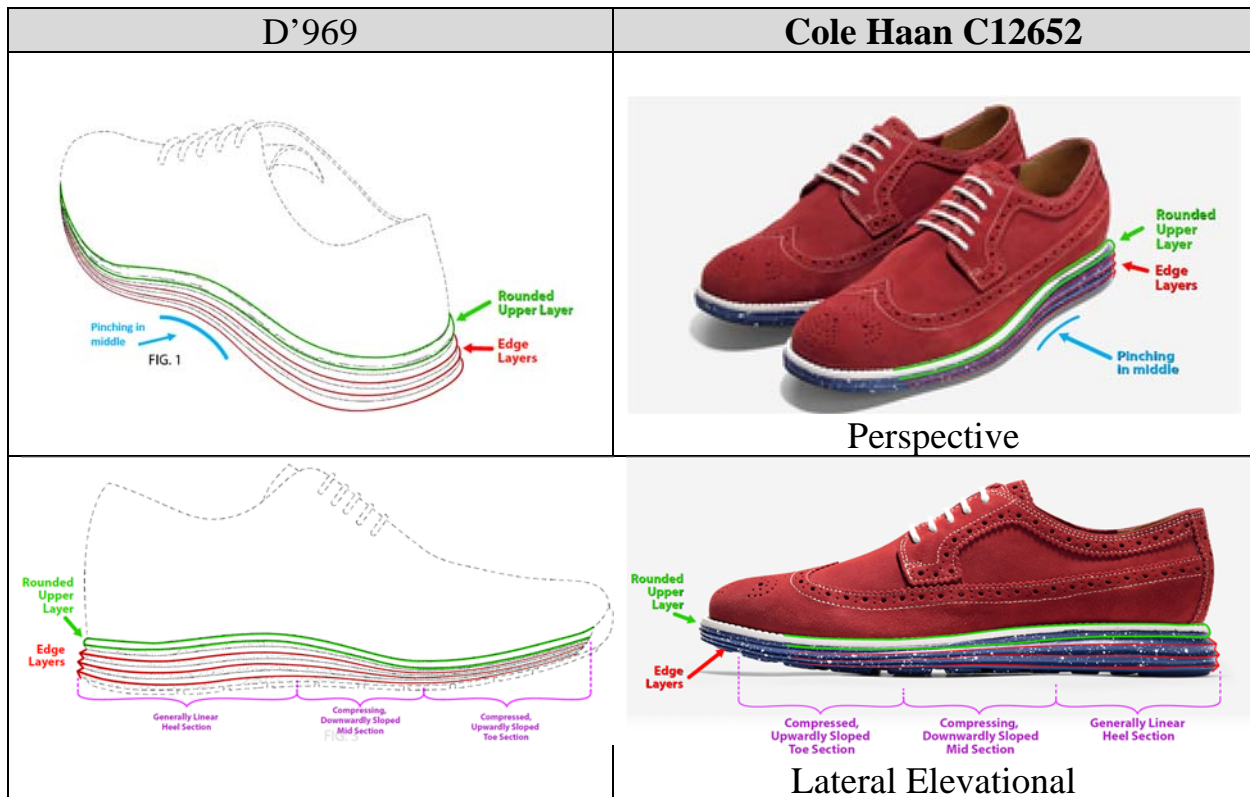
To the extent D’969 requires the ridged edge layers to extend around the entire upper perimeter of the shoe’s sole, DOSITA would have understood the angle of **C12652**’s top view inadvertently omits this protrusion from the shoe’s mid-section. Indeed, reference to the rear elevational view demonstrates the ridged edge layers extending around the entire upper perimeter of the shoe’s sole. Delgatty ¶127.

⁶ In fact, the substantial similarity of this unclaimed feature reinforces the substantial similarity of the two designs as a whole. The unclaimed bottom sole of D’969 is visually similar to **C12652**, with segments. Delgatty ¶126.

In conjunction with the other features discussed (below), **C12652** and D'969 are substantially the same, and as a result, D'969 is anticipated by **C12652**. Delgatty ¶128.

4. Overall Design

The four features described (above) in **C12652** come together as a whole as substantially the same design claimed in D'969. These features result in a wave-like midsole that compresses and slopes around, and pinches at the midsection. D'969 and **C12652** both depict this wave-like design. OB would have considered them to be substantially the same midsole, because they appear substantially the same:



Exs. 1001, 1011. Delgatty ¶129.

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

Thus, considering the overall claimed midsole design of D’969 and the overall midsole design of **C12652**, OB would have been induced to purchase one supposing it to be the other. As a result, D’969 claim is anticipated by **C12652**. Delgatty ¶131.

D. Ground 4: D’969 is Obvious Over C12652

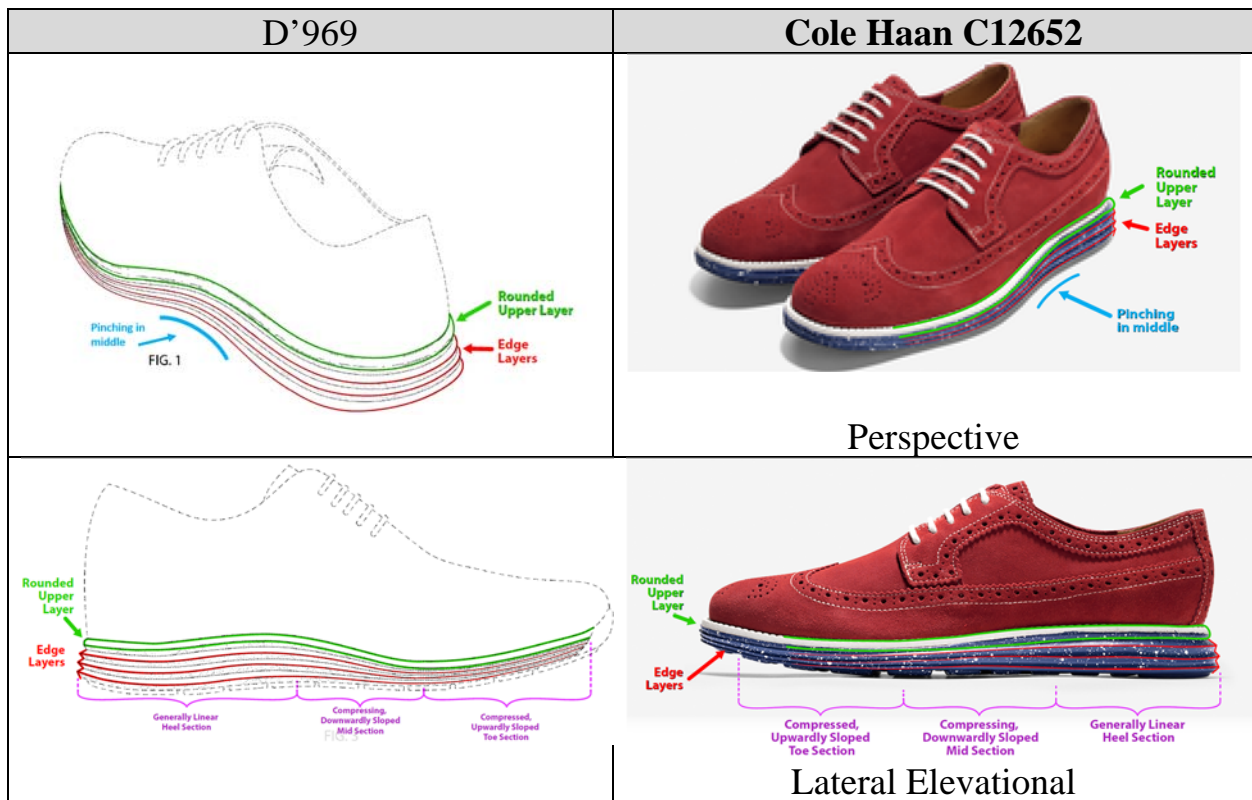
C12652 is so substantially the same as the claimed design that no secondary reference is necessary (*see* Ground 3). Delgatty ¶132.

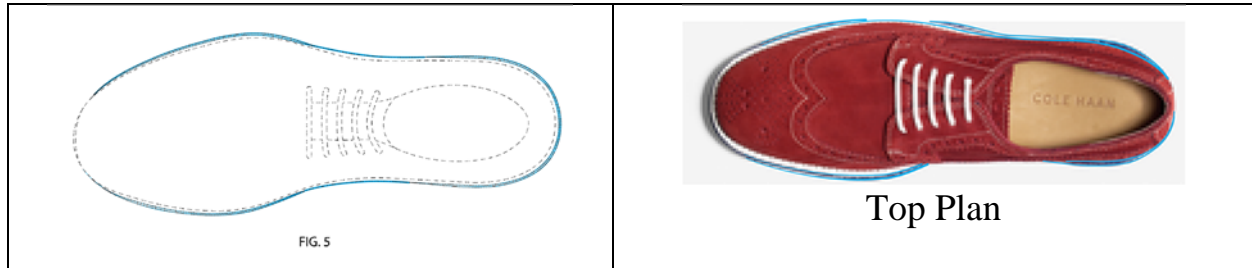
To the extent PO argues **C12652** is materially different, the claim of D’969 is obvious over **C12652**. Delgatty ¶133.

Graham one: **C12652** is a suitable primary reference as it is visually similar to D’969 (*see* Ground 3). **C12652** was “something in existence,” and is “visually similar” to D’969. *LKQ*, 102 F.4th at 1298. The scope and content of **C12652**, considered with the knowledge of DOSITA (defined in VIII), is the same as D’969: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched midsection. *See* Ground 3; Delgatty ¶134.

Graham two: To the extent there are any differences between **C12652** and D’969, **C12652** itself readily suggests those differences to a DOSITA. *See, e.g., In*

re Stevens, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For instance, to the extent PO argues the perspective view of **C12652** does not present a clear image of the medial elevational side view, DOSITA would have understood the design as a whole from the images available. Delgatty ¶135. The medial features of **C12652** would have been obvious to DOSITA once having viewed the perspective view image. Similarly, the DOSITA would have understood the bottom design of **C12652** using the top plan view, showing the same pinching in the midsection, and wider area near the toe region. Delgatty ¶135.





Exs.1001, 1011

Even if that were not the case, DOSITA would have found designing a midsole with the same design running from the lateral side to the medial side to be trivial. Delgatty ¶136. 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. Exs.1028, pg8 (“Western preference for bi-lateral mirror reflection...”); 1029, pg2 (“Symmetrical composition in clothing is this one which is based on reflection or bilateral symmetry, because of this type of symmetry in the human body.”) Delgatty ¶136.

To the extent PO argues Figure 6 of D’969 requires an overhang of the midsole over the bottom sole, DOSITA would have found it obvious to make the midsole wider than the bottom sole in the mid-section. Delgatty ¶137. This was a basic concept seen in other designs at the time. *See, e.g.*, Nike (Grounds 5-6).

Graham three: See VIII. Delgatty ¶138.

Graham four: See XI. Delgatty ¶139.

Thus, DOSITA would have understood **C12652** to be visually similar to D'969, depicting a similar wave-like design. Thus, the claim is obvious in view of **C12652**. Delgatty ¶140.

E. Ground 5: D'969 is Anticipated By Nike

1. Publication of Nike

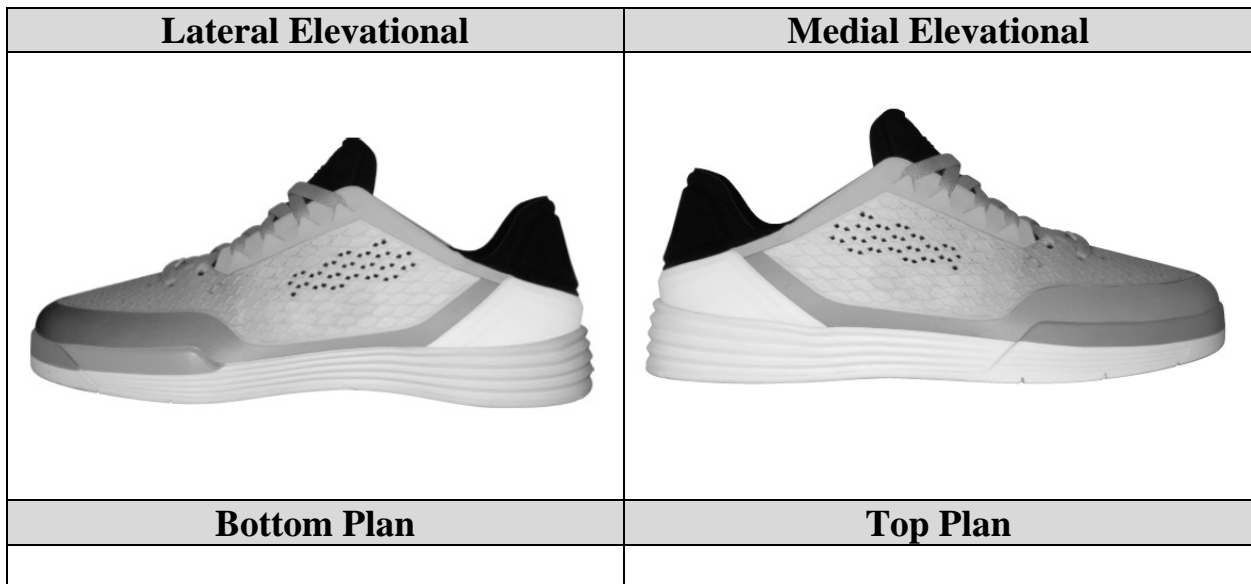
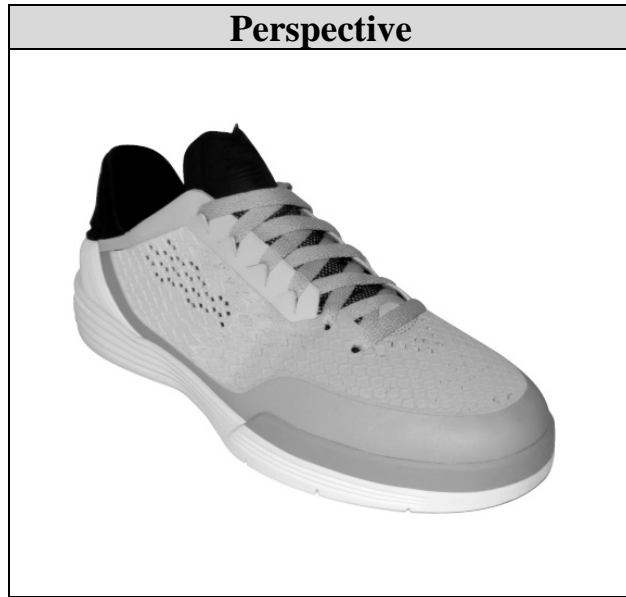
Nike (Ex.1012) is EUIPO Design Registration Application No. 002413161-0028, which was filed on February 26, 2014 and published on March 3, 2014, more than one year before the earliest priority date of D'969. Ex.1012 at 3 (**Nike**)(field 45 indicating March 3, 2014 publication date). The EUIPO website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

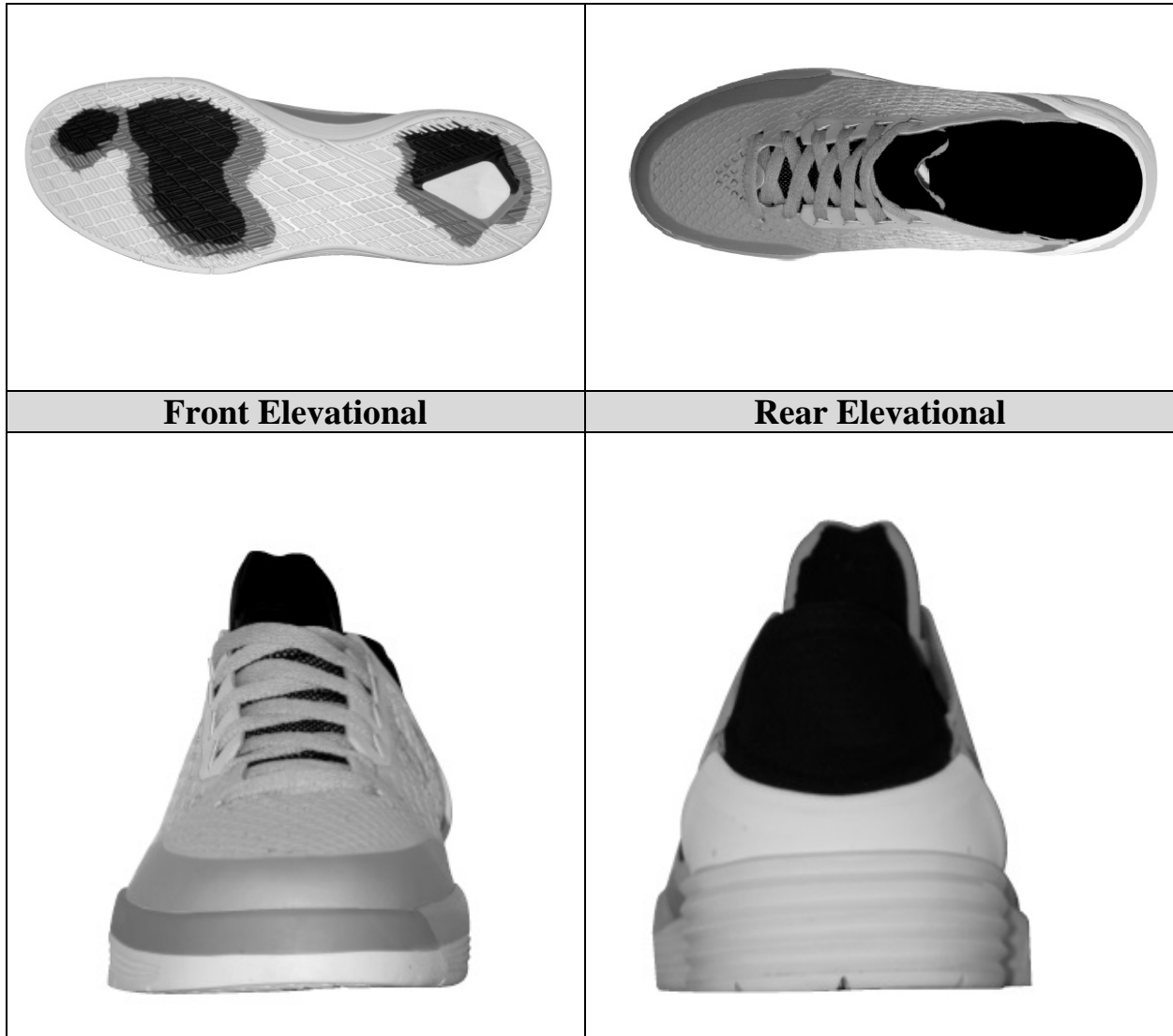
2. Overview of Nike

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

Figure	View
1	medial side elevational view

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





Ex.1014. Nike discloses a design of a shoe midsole with all features of D'969:

- **Three ridged edge layers** which extend continuously from heel to toe section;
- Compressions: where the layered ridges form *a generally linear heel section, downwardly sloped midsection in which the ridges are compressed, and upwardly sloped toe section with compressed* ridges;
- **A rounded upper layer**; and

- A slightly *pinched* midsection following the shape of the foot.

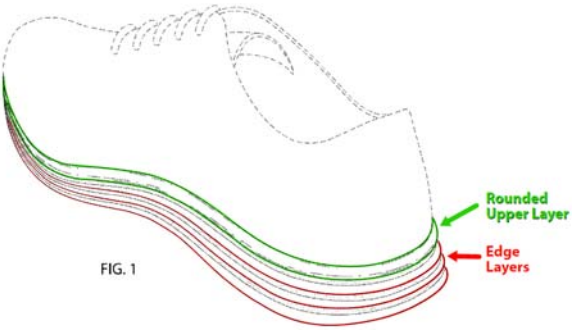



Ex.1012; Delgatty ¶¶142-143.

3. Claim Chart

a. Ridge Layers

Nike and D'969 are substantially the same: both designs have *three vertically stacked, ridged edge layers* extending continuously from heel to toe:

D'969	Nike
	

Exs.1001, 1012.⁷ Delgatty ¶144.

The ***three vertically stacked ridged edge layers*** of D'969 are substantially the same as **Nike** (with consideration to the different forms of media they are presented in). **Nike's** midsole includes the ***three ridged layers*** claimed in D'969. The substantial sameness of the designs is reinforced by both having exactly ***three*** ridged edge layers (and one rounded upper layer, discussed below). The OB, giving such attention as a purchaser usually gives a midsole, and familiar with relevant prior art, would have been induced to purchase one supposing it to be the other. Delgatty ¶145.

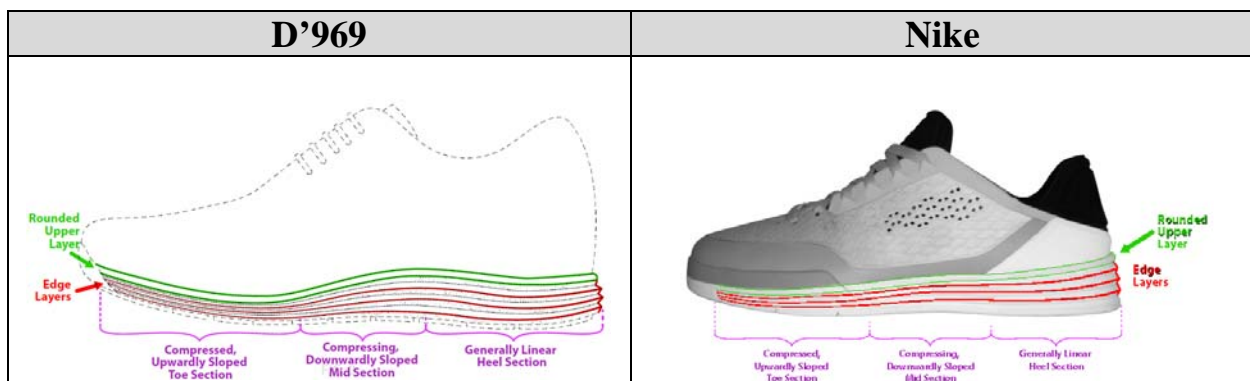
While **Nike's** design has a difference in its layers, under PO's apparent interpretation, the difference is insubstantial. **Nike's** midsole layers ***extend outwards*** (abduct) near the toe area, on the medial side. Resultantly, there is a slight discontinuity, slanting towards the toe section. But PO apparently interprets the scope of D'969 to include such discontinuities, as a product which PO accuses of infringing also contains such a discontinuity. Ex.1018 (Complaint), 27, 29, 31. Under PO's apparent interpretation, such a "minor difference[]" cannot prevent a finding of anticipation." *Int'l Seaway Trading Corp. v. Walgreens Corp.* 589 F.3d

⁷ Although the angle of **Nike's** perspective view is not identical to the angle of **D'969's** perspective view, DOSITA would have been able to understand the full design with the images present. Delgatty ¶144.

1233, 1243 (Fed. Cir. 2009) (citation omitted).⁸ Under PO's apparent interpretation, OB would not consider this minor difference to be substantial in the overall design. Consideration of this, in conjunction with the other features discussed below, results in substantially the same design under PO's apparent interpretation. An abduction of the midsole would have been functionally appropriate to accommodate wider feet, and thus under PO's apparent interpretation OB would have understood this minor difference as part of the functionality of the shoe, and not part of the design. *See* Ground 1; Delgatty ¶146.

b. Compressions

Nike and D'969 are substantially the same: both designs disclose three ridged edge layers which extend continuously from a *generally linear heel section*, *compressing and downward sloping in the midsection*, and *compressing and upward sloping towards a toe section*:



⁸ “[T]he ordinary observer test must logically be the sole test for anticipation as well.”

Id. at 1240.

Exs.1001, 1012. To the extent D’969 requires the *compressing, downwardly sloped midsection* to comprise a steeper downward slope, DOSITA would have understood the pitch of the sloped *layers* does not impact the overall visual impression (see Ground 1). Delgatty ¶¶147-148.

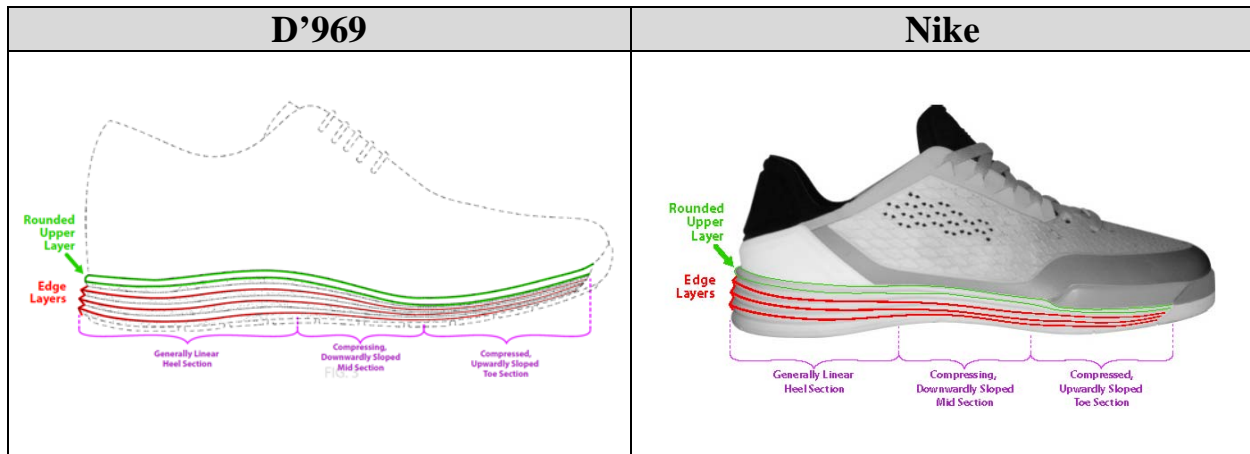
The *compressions* of D’969 are substantially the same as **Nike** (with consideration to the different forms of media they are presented). **Nike**’s midsole includes a heel section in which the layers are *generally linear*, a midsection that is *compressed and downward sloping*, and *a compressed upward slope towards the toe section*. As a result of this similarity (and the other substantially same features discussed), both designs present substantially the same wave-like pattern throughout the midsole. Thus, “in the eye of an [OB], giving such attention as a purchaser usually gives,” the two designs are substantially the same. *Gorham Co.*, 81 U.S. at 528. Delgatty ¶149.

To the extent PO argues D’969 requires the *compressing, downwardly sloped midsection* to comprise a steeper downward slope, for the same reasons as stated in Ground 11.A.1.a: such a minor difference in sloping angle does not affect the design as a whole, and OB would not have considered such a minor difference, if noticed at all. See Ground 1. Considering this and the other features discussed, **Nike** and D’969 have the same overall visual impression and the two designs are substantially the same. As a result, D’969 is anticipated by Nike. Delgatty ¶150.

c. Rounded Upper Layer

Nike and D'969 are substantially the same: both designs disclose a *rounded*

upper layer:



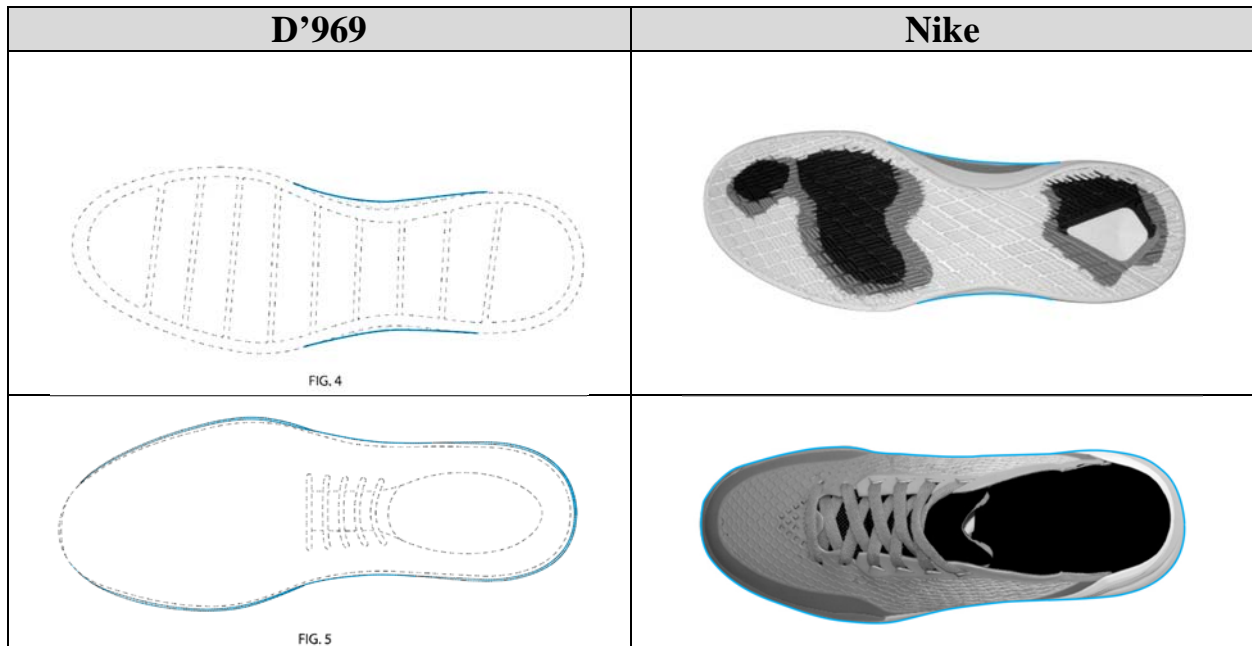
Exs.1001, 1012. Delgatty ¶151.

The *rounded upper layer* of D'969 is substantially the same as **Nike** (with consideration to the different forms of media they exist). **Nike's** midsole includes a top layer that is rounded, substantially the same as D'969. Thus, “in the eye of an [OB], giving such attention as a purchaser usually gives,” the two designs are substantially the same. *Gorham Co.*, 81 U.S. at 528. In fact, OB would have been even encouraged to think D'969 was **Nike** with attention to detail regarding the top layer. Delgatty ¶152.

Thus, considering this, in conjunction with the other features discussed, **Nike** and D'969 are substantially the same, and as a result, D'969 is anticipated by **Nike**. Delgatty ¶153.

d. Pinched Midsection

Nike and D'969 are substantially the same: both designs disclose a slightly *pinched* mid-section following the shape of a foot:



Exs.1001, 1012. Delgatty ¶154.

To the extent PO argues the bottom view (Figure 4) of D'969 requires the midsole to overhang, over the bottom sole, the bottom sole is not claimed (dashed lines). Even still, **Nike** is the same with respect to this design feature as well. As can be seen in the images of **Nike's** bottom, the **Nike** midsole hangs over the bottom sole that touches the ground. The sides of the layers of the midsole can be seen overhanging the midsection. Delgatty ¶155.

In conjunction with the other features discussed (below), **Nike** and D'969 are substantially the same, and as a result, D'969 is anticipated by **Nike**. Delgatty ¶156.

4. Overall Design

The four features described above in **Nike** come together as a whole as substantially the same design claimed in D'969. Both D'969 and **Nike** depict a wave-like midsole that compresses and slopes around, and pinches at the midsection. OB would have considered them to be substantially the same midsole, because they appear substantially the same. More specifically, the most visually apparent design features to the OB—the *three ridged edge layers* topped with a *rounded upper layer*—are substantially the same in the **Nike** and D'969 midsoles, forming the wave-like design. Delgatty ¶157.

To the extent PO argues there are minor variations (such as the vertically slanted ridge etching through the layers of the midsole, on the medial side), they do not preclude a finding of anticipation because the overall impression created—the wave-like pattern resulting from the four features discussed—remains equivalent between **Nike** and D'969. Delgatty ¶158.

Considering the overall claimed midsole design of D'969 and the overall midsole design of **Nike**, OB would have been induced to purchase one supposing it to be the other. As a result, D'969 claim is anticipated by **Nike**. Delgatty ¶159.

F. Ground 6: D'969 is Obvious Over Nike

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

To the extent PO argues **Nike** is materially different, the claim of D'969 is obvious over **Nike**. Delgatty ¶161.

Graham one: **Nike** is a suitable primary reference as it is visually similar to D'969 (*see* Ground 5). **Nike** was “something in existence,” and is “visually similar” to D'969. *LKQ*, 102 F.4th at 1298. Delgatty ¶162. The scope and content of **Nike**, considered with the knowledge of DOSITA (defined in VIII), is the same as D'969: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched midsection. *See* Ground 5; Delgatty ¶162.

Graham two: To the extent there are any differences between **Nike** and the claimed design, **Nike** itself readily suggests those differences to DOSITA. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). For instance, to the extent PO argues D'969 requires a slightly greater or smaller degree of sloping and curvature in the ridged edge and top layer, DOSITA would have found it obvious to ever so slightly vary the degree of sloping and resulting change of curvature of the layers of the midsole. Delgatty ¶163. Such 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. *See Monoflo Intern., Inc. v. Larand Intern., Inc.*, 5 F.3d 1505, 1505 (Fed. Cir. 1993) (nonprecedential) (finding a difference from the claimed design to be “obvious, from a functional standpoint.”); *see also Door-Master*, 256 F.3d at 1312 (“only the non-functional aspects of an ornamental design as shown in a patent are proper bases for design patent protection”) (internal quotations and citations omitted). For example, for a shoe with a curvier bottom sole, the midsole would have to match in order to fit atop the bottom sole. And such a curvier sole was already well-known. *E.g.* Exs.1026;1027. Delgatty ¶163. 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. Delgatty ¶163.

Notwithstanding the above, DOSITA would have found slightly changing the sloping of the midsole to be trivial. Delgatty ¶164. DOSITA would have had the common knowledge and skill to understand that any given midsole could be easily modified to be ever so slightly curvier or flatter, while still maintaining the same overall wave-like visual impression. Delgatty ¶164.

Graham three: See VIII. Delgatty ¶165.

Graham four: See XI. Delgatty ¶166.

DOSITA would have understood **Nike** to be visually similar to D'969, depicting a similar wave-like design. Thus, the claim is obvious in view of **Nike**.
Delgatty ¶167.

G. Grounds 7 & 8: D'969 is Obvious Over C11947 and Nike (Ground 7), and Over C12652 and Nike (Ground 8)

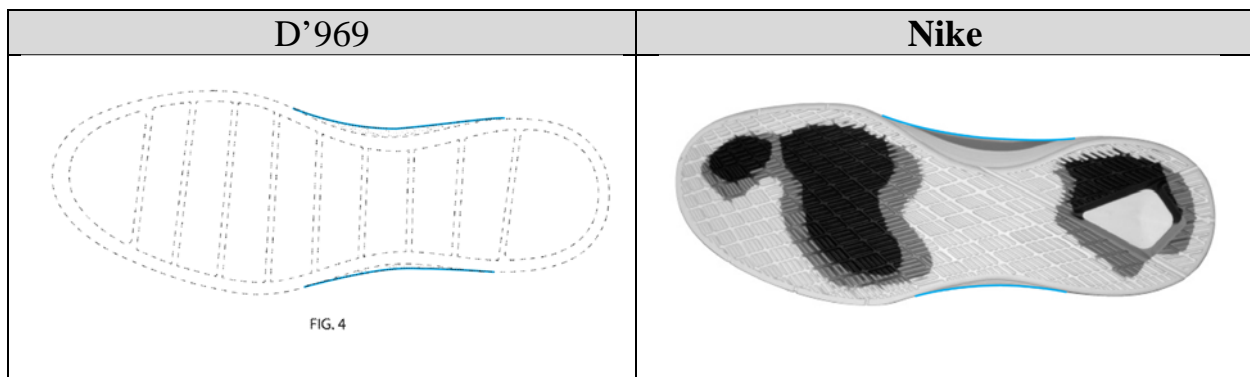
To the extent PO argues Figure 4 of D'969 requires an overhang of the midsection over the bottom sole, Petitioners submit the claimed design is obvious without reference to a secondary reference (*see* Grounds 2 and 4). A mere sizing of midsole in relation to bottom sole is (1) not claimed because the bottom sole is disclaimed, and otherwise (2) not patentable because it's entirely functional in nature. *Monoflo*, 5 F.3d 1505; *Door-Master*, 256 F.3d at 1312. Delgatty ¶168.

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

To the extent PO argues **C11947** or **C12652** is materially different, the claim of D'969 are obvious over **C11947** in view of **Nike**, and obvious over **C12652** in view of **Nike**:

Graham one: **C11947** and **C12652** are suitable primary references as described in Grounds 2 and 4. Delgatty ¶¶170-171.

Graham two: To the extent PO argues **C11947** or **C12652** does not disclose an overhang of the midsection over the bottom sole, **Nike** renders obvious an overhanging midsole visually similar to the claimed design. **Nike** discloses a widened midsole relative to the bottom sole:



Exs.1001, 1012. Delgatty ¶172.

Nike's overhanging mid-section (bottom view) is substantially the same as D'969. To the extent PO argues **C11947** or **C12652** lacks disclosure of an overhanging mid-section and thereby does not render the claimed design obvious (despite the aforementioned unclaimed portions, and obviousness as explained in Grounds 2 and 4), it further would have been obvious to implement an overhanging midsection of the midsole in view of **Nike**. Delgatty ¶173.

DOSITA would have found it obvious to vary the width of the midsection of the midsole in **C11947** or **C12652** in view of **Nike** because that would have been

purely functional, rather than ornamental, as stated in Ground 6. Ground 6; Delgatty ¶174.

DOSITA would have been aware of **Nike** and found it obvious to vary the width of the midsection of the midsoles in **C11947** or **C12652** in view of **Nike** because the shoe manufacturer Nike was famous, and well-known for making shoes. *See, e.g., Nike, Inc. v. Just Did It Enters*, 6 F.3d 1225, 1226 (7th Cir. 1993) (“Nike..., now known to nearly every athlete and sports fan in the world.”). Notwithstanding the prior statements that an overhanging midsole is purely functional (*see* Ground 2) at minimum an overhang would have been obvious to try because there are only three options regarding midsole size relative to sole, which are each predictable: a midsole that is the (1) same size as the sole, (2) smaller than the sole, or (3) larger than the sole. Choosing a larger sole would advantageously hide the tread of the shoe, making the design of the midsole more apparent within the shoe. Designing the midsole of the shoe to have a width wider than the bottom sole to match the arching natural foot shape was a simple design choice involving no more than mere substitution of one known element for another (i.e., substituting one size of midsole for another). Implementing **C11947**’s or **C12652**’s midsole with **Nike**’s overhang would have been beneficial in designing a midsole such that the design would be more prevalent in the overall shoe, and advantageously hides the tread on the sole and increases stability. This would have been desirable so the wave-like design of

the midsole could be more noticeable on the shoe, creating a sense of depth in the shoe. More surface area would be covered by the design. DOSITA would have been motivated to apply **Nike's** overhang to **C11947's** or **C12652's** midsole to create a design that stood out within the greater shoe, and thus more distinctive to the consumer. *See, e.g.*, Ex.1021 (“If we can smell, see, hear, or decide something faster or with less effort, we will prefer it over the more demanding alternative”). Delgatty ¶175.

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). There is nothing unpredictable or nonobvious about designing a midsole to overhang the bottom sole because this change would increase the visibility of the design in the greater shoe. Delgatty ¶176.

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

DOSITA would have found it obvious to smooth the upper layer of the midsole in **C11947** or **C12652** in view of **Nike** because the upper layers in **C11947** and **C12652** were already slightly rounded, and making either rounder would soften the meeting of the rubber and welt material, much like **Nike's** upper layer appears a cohesive part of the midsole. Delgatty ¶178.

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

Implementing the midsole of **C11947** or **C12652** with **Nike's** teaching of an even rounder *upper layer* would have been beneficial in designing a midsole such that the upper layer met the ridged layers in a more cohesive appearance. This would have been a desirable option to make the wave-like design of the midsole less interrupted and more uniform. DOSITA would have been motivated to apply **Nike's** teaching of an overhang to **C11947's** midsole or to **C12652's** midsole to create a design that was more cohesive. Furthermore, DOSITA would be motivated to modify **C11947** or **C12652** as taught by Nike by removing the leather welt and bonding the midsole directly to the upper to create a more continuous aesthetic, and doing so would also reduce a step in the manufacturing process, making the shoe less expensive to produce. Delgatty ¶¶21, 180.

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). There is nothing unpredictable or nonobvious about designing a midsole to have a more curvy upper layer because such a change would soften the meeting of different midsole materials, and thus make the overall design more cohesive. Delgatty ¶181.

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

To the extent PO alleges there are any other differences when compared to the claimed design, **C11947** or **C12652**, each in view of **Nike**, readily suggests those differences to DOSITA. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). Delgatty ¶183.

Graham three: See VIII. Delgatty ¶184.

Graham four: See XI. Delgatty ¶185.

DOSITA would have understood the designs to be visually similar, depicting a wave-like design. Thus, the claim is obvious under §103 based on **C11947** in view of **Nike** and **C12652** in view of **Nike**. Delgatty ¶186.

H. Ground 9: D'969 is Obvious Over Skechers in view of Nike

1. Publication of Skechers

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

Dappered.com was well-known, public (e.g., no access restrictions), searchable, and intended to reach a wide audience. DOSITA would have known about and readily located information on this website with reasonable diligence. *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1994 (Fed. Cir. 2008)). Based on this evidence taken as a whole, **Skechers** was publicly available by at least July 14, 2013, qualifying as prior art at least under §§102-103

as a printed publication, or as otherwise available to the public. The Examiner never found, and Applicant never cited, **Skechers** during prosecution. Delgatty ¶188.

2. Overview of Skechers

The **Skechers** publication provides images of different views of the design:





Ex.1017. The **Skechers** publication discloses a design of a shoe midsole with most of the features of D'969:

- ***Three vertically stacked ridged edge layers*** which extend continuously from heel to toe section;
- A ***generally linear heel section, a downwardly sloped midsection in which the ridges are compressed, an upwardly sloped toe section with compressed ridges***; and

- A *rounded upper layer*, more rounded than the ridged edge layers that it sits atop.

Delgatty ¶¶189-190.

3. Analysis

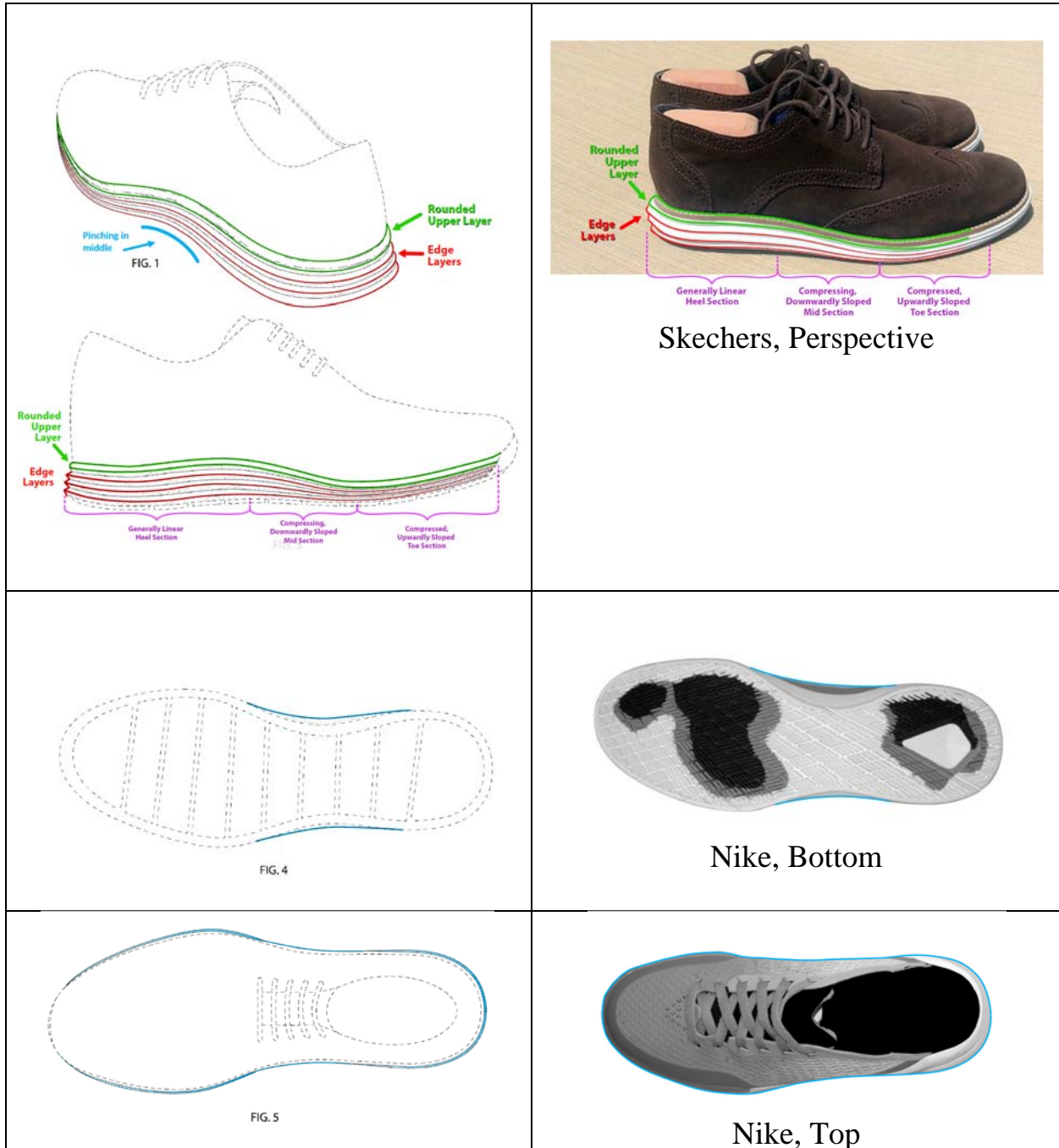
Skechers was “something in existence,” and is “visually similar” to D’969. *LKQ*, 102 F.4th at 1298. Delgatty ¶191.

Graham one: **Skechers** is a suitable primary reference as it is visually similar to D’969. **Skechers** was “something in existence,” and is “visually similar” to D’969. *LKQ*, 102 F.4th at 1298. Delgatty ¶192. The scope and content of the **Skechers**, considered with the knowledge of DOSITA (defined VIII), is the same as D’969: a shoe midsole with ridge layers, compressions, a rounded upper layer, and a pinched midsection. Delgatty ¶192.

Graham two: To the extent a secondary reference is needed to account for the absent explicit image of the bottom sole of **Skechers**, and to the extent PO argues **Skechers**’ bottom view is not readily apparent to DOSITA given the other images, **Nike**’s midsole renders obvious such a midsole bottom. Delgatty ¶193.

Skechers’ midsole consists of *three ridged edge layers*, a *rounded upper layer*, and a *compression pattern* substantially the same as D’969:

D’969	Skechers and Nike
-------	--------------------------



Exs.1001, 1012. Delgatty ¶194.

To the extent PO argues **Skechers** does not render the claimed design obvious because of the lack of clear bottom view, it would have been obvious to implement a midsole with the **Nike** design depicted in the bottom view, substantially the same

as D'969. DOSITA would have been aware of **Nike** and found it obvious to implement the bottom of **Nike's** midsole, pinching in the midsection, in view of **Skechers**, at least because Nike was an international brand known for making shoes. *See, e.g., Nike, Inc.*, 6 F.3d, at 1226. Notwithstanding the prior statements that an overhanging midsole is purely functional (see Ground 2) at a minimum, implementing **Nike's** bottom view design when implementing **Skechers'** midsole would have been obvious to try, as **Nike's** bottom sole follows the shape of a foot, the body part that will be making contact with the midsole. Designing the midsole of the shoe to follow the shape of a foot has a discrete number of known and predictable options which allow the overall shoe to go on said foot. Implementing the **Skechers** midsole with the bottom plane of **Nike** would have been beneficial in designing a shoe for a foot. An overhang would be obvious to try because there are only three options regarding midsole size relative to sole, which are each predictable: a midsole that is the (1) same size as the sole, (2) smaller than the sole, or (3) larger than the sole. Choosing a larger sole would advantageously hide the tread of the shoe, making the design of the midsole more apparent within the shoe. Delgatty ¶195.

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). There is

nothing unpredictable or nonobvious about a midsole that is wider towards the toe region, and pinches in the middle near the arch. Delgatty ¶196.

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

To the extent PO argues **Skechers** does not render the claimed design obvious because of a less rounded upper layer, it would have been obvious to implement a midsole with the **Nike** design, resulting in substantially the same design as D'969. 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. *See, e.g., Nike, Inc.*, 6 F.3d, at 1226. At a minimum, implementing **Nike's** upper layer design to **Skechers'** midsole would have been obvious, as **Skechers'** upper layer is already rounded to some degree. Designing the upper layer with a more pronounced rounding is beneficial in order to create a cohesive appearance in the different materials meeting at that point. Implementing **Skechers** midsole with the *rounded upper layer* of **Nike** would have been beneficial in creating a more cohesive design. Delgatty ¶198.

Such a change would have been predictable and obvious. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement

and proportioning are no more patentable in one case than in the other”). Indeed, there is nothing unpredictable or nonobvious about varying the degree of rounding in a rounded upper layer of a midsole. Delgatty ¶199.

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

To the extent PO alleges there are any other differences when compared to the claimed design, **Nike** and **Skechers** readily suggest those differences to one of ordinary skill in the art. *See, e.g., In re Stevens*, 173 F.2d 1015, 1019 (C.C.P.A. 1949) (“obvious changes in arrangement and proportioning are no more patentable in one case than in the other”). Delgatty ¶201.

Graham three: See VIII. Delgatty ¶202.

Graham four: See XI. Delgatty ¶203.

DOSITA would have understood **Skechers** in view of **Nike** to be visually similar, depicting a similar wave-like design of a midsole, with the bottom shaped like a foot. Thus, the claim is obvious over **Skechers** in view of **Nike**. Delgatty ¶204.

Skechers in view of **Nike** renders claim 1 obvious. Delgatty ¶205.

XI. SECONDARY CONSIDERATIONS

There is no evidence in D’969’s prosecution history or elsewhere supporting

any secondary considerations arguments, or nexus to any challenged Claim. *See generally* D'969FH; Delgatty ¶206.

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

To the extent PO asserts the existence of any secondary considerations in its responses, Petitioners reserve the right to address any such evidence. Delgatty ¶208.

XII. CONCLUSION

Substantial, new, and noncumulative technical teachings have been presented for the Challenged Claim, which is anticipated and rendered obvious for the reasons set forth above. Delgatty, ¶¶209-214. There is a reasonable likelihood Petitioners will prevail as to the Claim. IPR of claim 1 of D'969 is accordingly requested.

Dated: September 9, 2025

Respectfully submitted,

By: /James L. Davis, Jr /
Name: James L. Davis, Jr.
Registration No. 57,325

U.S. Patent No. D768,969
Petition for *Inter Partes* Review

ROPES & GRAY LLP

Lead Counsel for Petitioners

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(a) and (d), the undersigned hereby certify that the Petition For *Inter Partes* Review complies with the type-volume limitation of 37 C.F.R. §42.24(a)(i) because, exclusive of the exempted portions, it contains 13,984 words as counted by the word processing program used to prepare the paper.

Dated: September 9, 2025

Respectfully submitted,

By: /James L. Davis, Jr./
Name: James L. Davis, Jr.
Registration No. 57,325
ROPES & GRAY LLP

Lead Counsel for Petitioners

CERTIFICATE OF SERVICE

I hereby certify that on September 9, 2025, I caused a true and correct copy of the foregoing Petition for *Inter Partes* Review of U.S. Patent No. D768,969 and supporting exhibits to be served via Federal Express on the Patent Owner at the following correspondence address of record as listed on Patent Center:

Thompson Coburn LLP
One US Bank Plaza
Suite 3500
St. Louis, MO 63101
United States

A courtesy copy was also sent via electronic mail to Patent Owner's litigation counsel at the following addresses:

Norman, Alan H. anorman@thompsoncoburn.com
Braunel, Matthew A. mbraunel@thompsoncoburn.com
Moussavi, Sartouk H. SMoussavi@thompsoncoburn.com
Weidner, Alex D. AWeidner@thompsoncoburn.com
'Gooby, Steven F.' steven.gooby@ansalaw.com

Dated: September 9, 2025

By: /James L. Davis, Jr./
Name: James L. Davis, Jr.
Registration No. 57,325
Lead Counsel for Petitioners