

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEXT STEP GROUP, INC.,
Petitioner,

v.

DECKERS OUTDOOR CORPORATION,
Patent Owner.

IPR2024-00525
Patent D927,161 S

Before KEN B. BARRETT, JOSIAH C. COCKS, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner, Next Step Group, Inc. (“Petitioner”), filed a Petition (Paper 3, “Pet.”) requesting *inter partes* review of U.S. Patent No. D927,161 S (“the ’161 patent,” Ex. 1001). Patent Owner, Deckers Outdoor Corporation (“Patent Owner”) filed a Preliminary Response (Paper 10, “Prelim. Resp.”).

On May 21, 2014, the Federal Circuit issued its en banc decision in *LKQ Corp. v. GM Global Tech. Operations LLC*, No. 21-2348 (Fed. Cir. May 21, 2024) (en banc). Petitioner requested authorization to file a reply to address the *LKQ* decision as well as to respond to Patent Owner’s argument that the Petition improperly relies on prior sales, not printed publications. *See* Ex. 3001, 1–2. With our authorization, Petitioner filed a Preliminary Reply (Paper 13, “Reply”) to address these issues and Patent Owner filed a Preliminary Sur-Reply (Paper 14, “Sur-Reply”).

We have authority under 35 U.S.C. § 314, which provides that *inter partes* review may not be instituted unless the information presented in the Petition shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

After considering the Parties’ papers and the evidence of record, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to the one claim challenged in the Petition. Thus, we do not institute an *inter partes* review.

A. Real Parties-in-Interest

Petitioner identifies itself, Next Step Group, Inc., as the only real party-in-interest. Pet. 67. Patent Owner identifies itself, Deckers Outdoor Corporation, as the only real party-in-interest. Paper 5, 1.

B. Related Matters

Petitioner identifies the following cases as related matters: *Deckers Outdoor Corporation v. Walmart, Inc. and Does 1-10*, 2:23-cv-00575 (C.D. Cal. January 25, 2023); *Deckers Outdoor Corp. v. Primark US Corp.*, 1:23-cv-10233 (D. Mass. January 30, 2023); *Deckers Outdoor Corporation v. The Partnerships and Unincorporated Associations Identified on Schedule “A”*, 1:23-cv-16072 (N.D. Ill. November 17, 2023); *Deckers Outdoor Corporation v. The Partnerships and Unincorporated Associations Identified on Schedule “A”*, 1:24-cv-00008 (N.D. Ill. Jan. 2, 2024); and *Deckers Outdoor Corporation v. The Partnerships and Unincorporated Associations Identified on Schedule “A”*, 1:24-cv-00371 (N.D. Ill. January 16, 2024). Pet. 67–68.

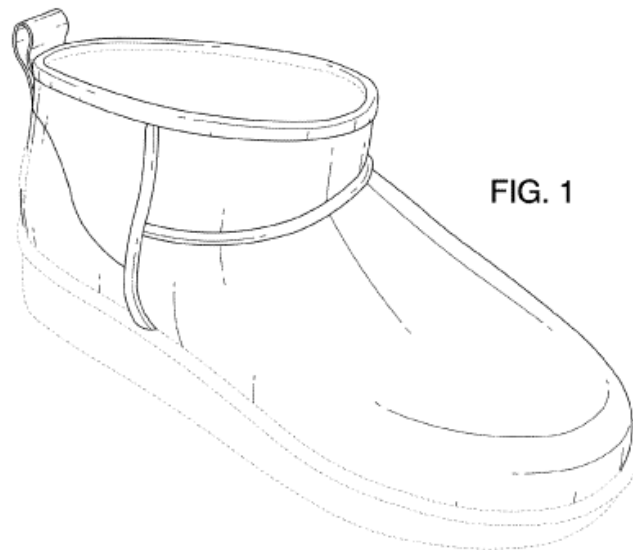
Although not identified as a related matter, the Petition cites to a complaint filed in the Central District of California by Patent Owner against Petitioner. *See, e.g.*, Pet. 5, 17, 20, 26, 31, 36, 41, 52, 67, 69 (citing to Ex. 1010); *see also* Ex. 1010 (Complaint in *Deckers Outdoor Corp. v. Next Step Group, a New York Corporation and Does 1–10*, 2:23-cv-00578 (C.D. Cal. Jan 25, 2023)).

Patent Owner identifies a patent litigation in the Southern District of New York patent litigation between the Parties as a related matter: *Deckers Outdoor Corporation v. Next Step Group, Inc. and Does 1-10*, 1:23-cv-02545 (S.D.N.Y. Jan. 25, 2023). Paper 5, 1.- Additionally, Patent Owner identifies the following as related matters: *Deckers Outdoor Corporation v.*

Last Brand, Inc. and Does 1-10, 3:23-cv-04850 (N.D. Cal. June 12, 2023); *Deckers Outdoor Corporation v. Costco Wholesale Corporation and Does 1-10*, 2:23-cv-09855 (C.D. Cal. Nov. 20, 2023); *Deckers Outdoor Corp. v. Primark US Corp.*, 1:23-cv-10233 (D. Mass. Jan. 30, 2023). Paper 5, 1 & n.1.

C. The '161 Patent (Ex. 1001) and Claim

The '161 patent, titled "Footwear Upper," issued August 10, 2021 from an application filed November 8, 2019. Ex. 1001, codes (22), (45), (54). The claim is directed to "[t]he ornamental design for a footwear upper, as shown and described." *Id.* at code (57). The drawings depict a footwear with certain unclaimed aspects of the footwear illustrated by broken lines. *See id.* (stating "[t]he broken lines in FIGS. 1–7 represent portions of the footwear that form no part of the claimed design"). The '161 patent includes seven figures, which we reproduce below.



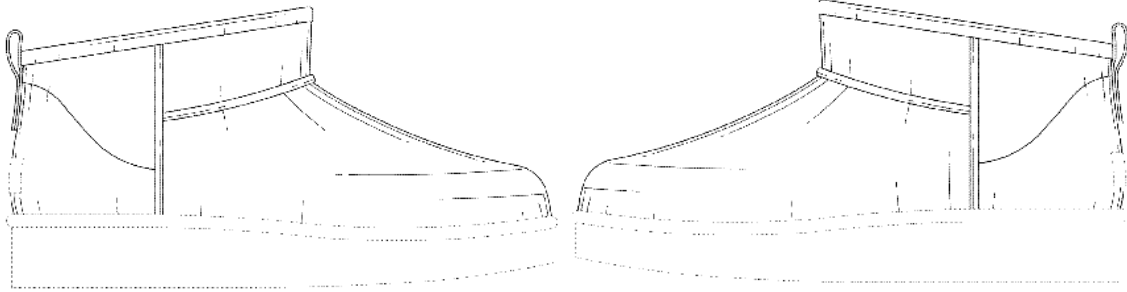


FIG. 2

FIG. 3

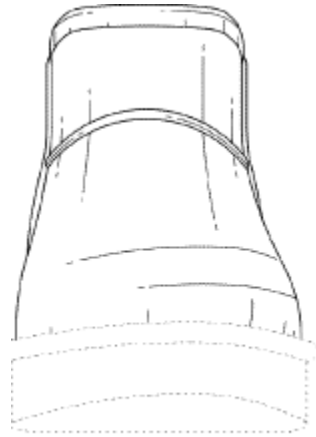


FIG. 4

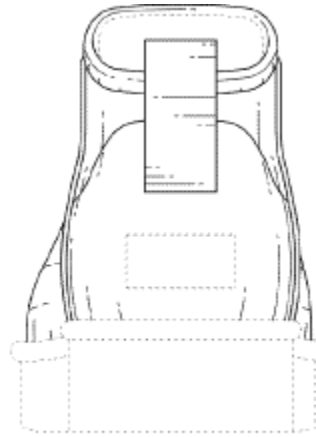


FIG. 5

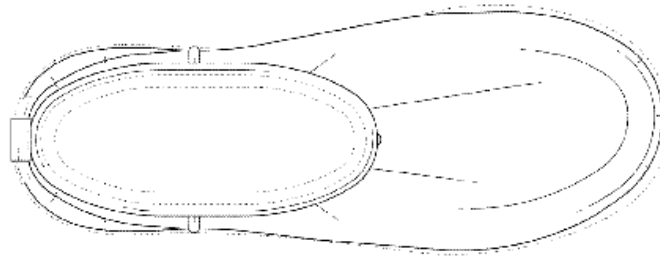


FIG. 6



FIG. 7




Figures 1–7 depict, respectively, the following view of the claimed design for a footwear upper: (1) a front perspective view, (2) a side elevational


view, (3) an opposite side elevational view, (4) a front elevational view, (5) a rear elevational view, (6) a top plan view, and (7) a bottom plan view.

Ex. 1001, Description.

D. The Asserted Prior Art

Petitioner identifies its asserted Prior Art References as follows:

Index of Specific Prior Art References	
Ref. 1	<p>Emu Stinger Micro Boot, sold since 2016, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1002). Rhoads Decl. ¶¶ 3-6 (Exhibit 1015).</p> 
Ref. 2	<p>CN'897, issued December 28, 2018, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1003). Rhoads Decl. ¶ 7.</p> 
Ref. 3	<p>UGG Classic Mini boot, on sale since 2006, is prior art under 35 U.S.C. § 102(a)(1) (Exhibits 1005; 1001 (pages 1-2)). Rhoads Decl. ¶ 9-12.</p> 
Ref. 4	<p>MacIntyre'974, issued October 18, 2016, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1007). Rhoads Decl. ¶ 15.</p>

	 <p>FIG. 2</p> <p>FIG. 9</p>
Ref. 5	<p>Chung'186, issued June 17, 2017, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1008). Rhoads Decl. ¶ 16.</p>  <p>FIG. 16</p> <p>FIG. 9</p> <p>FIG. 2</p>
Ref. 6	<p>UGG Neumel Boot, on sale since 2011, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1009, 1010 (¶24)). Rhoads Decl. ¶ 17-18.</p> 

Pet. 3-5.

E. The Asserted Grounds of Unpatentability

Petitioner presents the following table as identifying Petitioner's ten¹ asserted grounds and the proposed claim construction for each ground. Pet. 10–11.

Ground	Index of Grounds of Unpatentability	Claim Construction
1	Emu Stinger Micro anticipates the claim of the '161 patent under 35 U.S.C. § 102	Pull Tab Functional
2	Emu Stinger Micro renders the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
3	CN'897 anticipates the claim of the '161 patent under 35 U.S.C. § 102	Pull Tab Functional
4	CN'897 renders the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
5	Emu Stinger Micro or CN'897 in combination with UGG Neumel Boot render obvious the claim of the '161 patent under 35 U.S.C. § 103	Pull Tab Ornamental
6	UGG Classic Mini renders the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
7	UGG Classic Mini and UGG Neumel Boot render the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Ornamental

¹ Patent Owner asserts that there are fifteen asserted grounds. *See* Prelim. Resp. 2, 6–7. We agree that Petitioner has identified grounds set forth in the alternative as a single ground. For convenience, however, we refer to the grounds in this Decision as identified by Petitioner.

8	UGG Classic Mini, and MacIntyre'974 and/or Chung' 186, render the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Functional
9	UGG Classic Mini, and MacIntyre'974 and/or Chung' 186, in combination with UGG Neumel Boot render the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Ornamental
10	UGG Classic Mini and CN'897, together alone or in combination with the other references, render the claim of the '161 patent obvious under 35 U.S.C. § 103	Pull Tab Ornamental or Functional

F. Testimonial evidence

In support of its unpatentability arguments, Petitioner relies on the declarations of Lenny M. Holden (Ex. 1011 (original Declaration); Ex. 1016 (Supplemental Declaration)) and Rosemary W. Wright (Ex. 1013 (original Declaration); Ex. 1017 (Supplemental Declaration)). To support its arguments that the asserted art qualify as printed publications, Petitioner relies on the Declaration of Donald Rhoads (Ex. 1015). Patent Owner relies on the declaration of Jim Gandy (Ex. 2009).

II. ANALYSIS

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged

claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 171(a). These requirements include that the design be novel and nonobvious. 35 U.S.C. §§ 102, 103; *see also* 35 U.S.C. § 171(b) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

A. Whether the Asserted Art Qualifies as Printed Publications?

Under 35 U.S.C. § 311(b), a petitioner in an *inter partes* review may request to cancel a claim as unpatentable “only on the basis of prior art consisting of patents or printed publications.” The “burden is on the petitioner to identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent, and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (PTAB Dec. 20, 2019) (precedential); *see also, e.g., Symantec Corp. v. Trustees of Columbia Univ.*, Case No. IPR2015-00371, Paper 13, 5, 9 (PTAB June 17, 2015) (denying institution where the Petition failed to include discussion or cite to evidence sufficient to show that the asserted reference was a prior art printed publication).

Whether a reference qualifies as a “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public. *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018). The key

inquiry is whether the reference was made “sufficiently accessible to the public interested in the art” before the effective filing date. *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009). While indexing is not required to show that a work is publicly accessible, “some evidence that a person of ordinary skill could have reasonably found the website and then found the reference [(e.g., the specific webpage)] on that website is critical.” *Samsung Elecs. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019). It is not sufficient that a webpage simply existed on the critical date. *See Acceleration Bay*, 908 F.3d at 772–74 (affirming Board decision that a reference uploaded to a website was not a printed publication under § 102).

Patent Owner asserts that Petitioner improperly relies on *prior sales* of the Emu Stinger Micro Boot (Ex. 1002), UGG Classic Mini (Ex. 1005), and UGG Neumel Boot (Ex. 1009; Ex. 1010) and has failed to show that these asserted references qualify as *printed publications*. *See* Prelim. Resp. 10–17. We address each of these references in turn.

1. *UGG Neumel Boot (Ex. 1009; Ex. 1010)*

a) *Petitioner’s Assertions*

Petitioner states that the “UGG Neumel Boot, on sale since 2011, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1009, 1010 (¶24)). Rhoads Dec. ¶ 17–18.” Pet. 5; *see also* Pet. 31–32 (“The UGG Neumel Boot is a well-known boot sold continuously by the Patent Owner since 2011. . . . It is prior art under at least 35 U.S.C. § 102(a)(1).”).

Mr. Rhoads testifies that “Exhibit 1009 is true and correct copies of images of the UGG Neumel Boot, which has been for sale since 2011, as alleged by the Patent Owner in Exhibit 1010, ¶24 (‘In 2011, Deckers introduced the UGG Neumel boot . . .’).” Ex. 1015 ¶ 17.

Mr. Rhode further testifies that:

These images were downloaded by me on January 26, 2024. The images (pages 1–6) showing the sale of the UGG Neumel Boot were captured from www.amazon.com:
https://www.amazon.com/UGG-Mens-Neumel-Chukka-Chestnut/dp/B019E4ERKG/ref=sr_1_2?crid=37CV7M9XOWR0D&keywords=UGG+Men%27s+Neumel+Boot%2C+Chestnut%2C+06&qid=1706603215&prefix=ugg+men%27s+neumel+boot%2C+chestnut%2C+06%2Caps%2C68&sr=8-2.

Id. Mr. Rhoads further states that these “images state that the boots first went on sale on this site on December 15, 2015 and were manufactured by UGG (page 2). Several reviews appear on this same page that are dated before the ’161 patent November 8, 2019 filing date, and thus this further confirms that the UGG Neumel Boot is prior art to the ’161 patent (page 6).” *Id.* ¶ 18.

Mr. Rhoads states that Exhibit 1010 is a copy of a complaint filed by Patent Owner against Petitioner, *Deckers Outdoor Corp. v. Next Step Group, Inc.*, 2-23-cv-00578, in the Central District of California. Ex. 1015 ¶ 19 (also noting that the California action was later transferred to the Southern District of New York, where it is now pending).

In its Reply, Petitioner states that the “Petition’s sales references to Patent Owner’s own products (and those of its chief competitor, Emu) were not proffered to bizarrely eliminate the availability of evident ‘printed publication’ documents.” Reply 15–16. Rather, “the sales were noted to highlight the public nature of publications promoting those products.” *Id.* at 16.

Petitioner goes on to state that:

Exhibits 1009 and 1010 contain ample corroborated evidence of multiple prior art printed publications disclosing the UGG Neumel. The Amazon website (www.amazon.com) evidences that the published listing for the boot was as early as December 15, 2015. Exh. 1009, page 2. *This again is the Patent*

Owner's own published listing. The Patent Owner knows of its own listing and has a duty of candor in any challenge. Written reviews, which are reliable business records, were also provided, showing the listing were public, printed, publications. *Id.* at 6; Exh. 1015, ¶¶17-18. This is corroborated by the Patent Owner's pleading: it has disclosed its own boot since 2011 in marketing/trade publications. Ex. 1010, ¶¶23–35.

Reply 17–18.

b) *Analysis*

Petitioner has not shown that any of the material contained in either Exhibits 1009 or 1010 constitutes printed publication prior art to the '161 patent.

We begin with Exhibit 1010, which is a copy of a complaint filed July 25, 2023, which is after the critical date of November 9, 2019. *See* Ex. 1010; Ex. 1001, code (22). Because the complaint itself is dated after the critical date, the complaint itself does not constitute prior art. We acknowledge that the complaint states that the UGG Neumel boot was introduced in 2011 and that UGG Neumel boots have been featured in “advertising,” “promotional materials,” and “trade publications.” *See, e.g.,* Ex. 1010 ¶ 27. Neither Exhibit 1010 nor the Petition, however, identifies, let alone provides a copy of a single example of any such materials. Thus, even if there are marketing and/or trade publications from 2011 that depict the UGG Neumel boot and that would qualify as printed publications, Exhibit 1010 does not provide any such materials. As such, Exhibit 1010 itself does not qualify as printed publication prior art. And, without the marketing or trade publications in the record before us, there is no purported prior art printed publication for which Exhibit 1010 corroborates a publication date.

As to Exhibit 1009, Mr. Rhoads testifies that the images of this exhibit “state that the boots first went on sale on this site on December 15, 2015.”

Ex. 1015 ¶ 18; *see also* Ex. 1009, 2 (stating “Date First Available: December 15, 2015”). The date that a product was listed as first available on a website, however, is not sufficient evidence that the content of the listing, including the photographs depicted therein, were published at that time. *See Ex parte Basulto*, Appeal 2020-00129, 2021 WL 1264902, at *2 (PTAB Apr. 2, 2021) (stating “the date [a] product was listed on Amazon.com is not compelling evidence that the content of [the] listing itself as shown in the document, and the photographs relied on within it were published at that time”). Selling products online is dynamic. *Id.* Product listings may be updated and photographs of the products may change. *Id.* While a statement on a commercial website as to when a product was “first available” might constitute evidence as to when the product was first offered for sale, such a statement is not sufficient evidence that the listing itself, or any photograph depicted therein, has not changed over time. *See Ex parte Zhang*, Appeal 2021-000087, 2021 WL 633718 at *3 (PTAB Feb. 16, 2021) (stating “while the [webpage] date indicates that the product information was last updated on [date], there is no additional evidence to corroborate that the picture was publicly accessible on that date”).

We have also reviewed the customer reviews that Petitioner asserts show “the listing were [sic] public, printed publications.” Reply 17 (citing Ex. 1009, 6; Ex. 1015 ¶ 17–18. None of the reviews dated prior to the critical date of November 8, 2019, however, contain any images of the UGG Neumel Boot. *See* Ex. 1009, 6). Thus, Petitioner does not provide sufficient evidence that any of the images on pages 1–9 of Exhibit 1009 were available on the website prior to the critical date.

Petitioner asserts that “if [Patent Owner] wishes to (disingenuously) challenge the printed publication status” that the duty of candor set forth in

37 C.F.R. § 1.56(b) requires Patent Owner to submit “all evidence that its own UGG Classic Mini (Mini II and Short), and UGG Neumel, and its competitor’s Emu Stinger Micro, were in prior art printed publications.” Reply 18 (citing 37 C.F.R. § 1.56).

We disagree with Petitioner. As our Trial Rules explain, PTAB proceedings, “not being applications for patents, are not subject to § 1.56.” Rules of Practice for Trials Before the Patent Trial and Appeal Board, 77 Fed. Reg. 48612, 48638 (Aug. 14, 2012). Thus, contrary to Petitioner’s assertion, Rule 56 does not require Patent Owner to submit “all evidence” that its products are disclosed in prior art printed publications. Patent Owner’s assertion that Petitioner failed to show that the *particular references* Petitioner relies upon qualify as printed publication prior art does not obligate Patent Owner to identify *other material* that may qualify as printed publication prior art. It is Petitioner’s burden to provide evidence sufficient to establish a reasonable likelihood that the asserted references qualifies as printed publications. *See Hulu*, IPR2018-01039, Paper 29 at 16.

Thus, for the foregoing reasons, Petitioner has not demonstrated a reasonable likelihood that the UGG Neumel Boot (Ex. 1009, 1010) qualifies as a printed publication prior art to the ’161 patent. In any event, for the reasons set forth below, we determine that Petitioner’s proposed grounds involving the UGG Neumel Boot are inadequate to establish the unpatentability of the challenged claim.

2. *Emu Stinger Micro Boot (Ex. 1002)*

a) *Petitioner’s Assertions*

In its listing of prior art references, Petitioner states that the “Emu Stinger Micro Boot, sold since 2016, is prior art under 35 U.S.C. § 102(a)(1) (Exhibit 1002).” Pet. 3 (citing Ex. 1015 ¶¶ 3–6). The Petition also states:

The Emu Stinger Micro Boot has been sold since 2016 The boot was sold on the Amazon website (which has verified purchaser reviews from the entire time period), and Emu’s own website, among others, since 2016. It is thus prior art under at least 35 U.S.C. § 102(a)(1).

Pet. 25. Mr. Rhoads testifies that “Exhibit 1002 is true and correct images of the Emu Australia Stinger Micro boot, which has been for sale since at least 2016, and related information. These images were downloaded by me on January 4, 2024.” Ex. 1015 ¶ 3.

Exhibit 1002 is a compilation of at least six different documents, which Mr. Rhoads describes as follows:

- pages 1–6 were captured from the www.emuaustralia.com.au website and that the “oldest reviews are eight years old, confirming [that] the boot was on sale since at least 2016.” *Id.*
- page 7 is “a website listing for a black version of the boot that also had eight year old reviews (page 7).”² *Id.*
- pages 8 and 9 are pages of the Emu Australia website accessed from the Wayback Machine for October 27, 2017 and November 11, 2017 that show that the boot was on sale on the Emu Australia websites before November 8, 2019. *Id.* ¶ 4.
- pages 10–12 are printouts from www.amazon.com, which states that the “Emu Stinger Micro boot was first offered for sale on that site in 2014” and that reviews for the boot on page 10 go back to before the filing date and that “[o]ther reviews were copied and appended to the exhibit that went back to 2015 (pages 11–12).” *Id.* ¶ 5.

² The Reply states that page 7 is from the www.emuaustralia.com.au website.

- pages 13–15 of Exhibit 1002 is a copy of a December 2010 press release from Emu Australia announcing a series of lawsuits filed by the Patent Owner and showing two predecessor boots to the Emu Stinger Micro that have the same styling. *Id.* ¶ 6.

In its Reply, Petitioner further states that:

Exh. 1002 contains ample corroborated evidence of multiple prior art printed publications disclosing the Emu Stinger Micro. Exhibit 1002 pages 8-9 are printouts from an Emu website, www.emuaustralia.com.ca (retrieved using the Wayback Machine), for October 27 and November 11, 2017, that disclose the boot. Exh. 1015, ¶4. This is further corroborated by print outs from the Amazon website (www.amazon.com) on pages 10–12 of Exh. 1002 that evidence that the published listing there was provided as early as September 4, 2014. Written reviews for the boot, which are reliable business records, from 2015, 2017, 2018, and 2019, again show the published listing was available then. Ex. 1015, ¶5. Likewise, Exh. 1002 pages 1–7 are prior art printed publications of this boot from the website www.emuaustralia.com.au. Exh. 1015, ¶3. The oldest reviews are from 2015, establishing that the published listing was available then. Exh. 1015, ¶5.

Reply 16.

b) Analysis

Petitioner has not sufficiently demonstrated that any of the images of the Emu Stinger Micro Boot in Exhibit 1002 that are relied upon in the Petition to show unpatentability qualifies as printed publication prior art to the '161 patent.

The images that Petitioner relies upon in its Petition are found on pages 1–6 of Exhibit 1002, which Petitioner asserts are webpages from emuaustralia.com.au printed in January 2024. *Compare* Pet. 35–36, *with* Ex. 1002; *see also* Ex. 1015 ¶ 3. Similarly, pages 7, 10–12 are also webpages that were printed in January 2024. *See* Pet. 1015 ¶¶ 3, 5.

Petitioner has not sufficiently shown that any of these pages were publicly accessible before the critical date. As noted above, webpages are dynamic; product listings may be updated; and photographs of the products on the website may change over time. As such, a print out of a webpage from 2024 does not provide sufficient evidence of what was publicly available on the website years earlier prior to the critical date.

We have also considered Petitioner’s argument that “[w]ritten reviews for the boot, which are reliable business records, from 2015, 2017, 2018, and 2019, again show [that] the published listing was available then.” Reply 16 (citing Ex. 1015 ¶ 5); *see also* Ex 1015 ¶ 3 (stating that the oldest customer reviews “are eight years old, confirming the boot was on sale since at least 2016”). None of these reviews, however, depict an image of the Emu Stinger Micro Boot. While reviews of the Emu Stinger Micro Boot dated before the critical date might be evidence that the Emu Stinger Micro boot was on sale prior to the critical date, the reviews do not provide sufficient evidence that the *images displayed on the website in 2024* were publicly available prior to the critical date. Thus, Petitioner does not provide sufficient evidence that any of the images of the Emu Stinger Micro Boot that it relies upon in its unpatentability arguments were available on the webpage prior to the critical date. *See* 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

Pages 13–15, which are asserted to be press releases issued before the critical date discussing a law suit brought by Patent Owner against Emu, do

not contain any images of the Emu Stinger Micro Boot, let alone any images that are cited in the Petition.

Pages 8 and 9 of Exhibit 1002 are asserted to be print outs from the Wayback Machine of pages from the www.emuaustralia.com.ca website dated October 27, 2017 and November 11, 2017, respectively. Ex. 1015 ¶ 4. Even if pages 8 and 9 of Exhibit 1002 were publicly accessible before the critical date, the images contained on these pages were not relied upon in the Petition. *Compare* Pet. 35–36 with Ex. 1002, 8–9. Moreover, the images on pages 8 and 9 differ from the images on the remaining pages of Ex. 1002. *Compare* Ex. 1002, 8–9 with Ex. 1002, 1–7, 10–15. We further note that pages 8 and 9 are from a different website (www.emuaustralia.com.ca) than pages 1–7, which are from www.emuaustralia.com.au. Thus, these pages from the Wayback Machine do not support a finding that any of the other pages of Exhibit 1002 were publicly available before the critical date.

Nevertheless, even if the Emu Stinger Micro Boot (Ex. 1002) does qualify as a printed publication, including all of its contained pages, for reason laid out below, we determine that Petitioner’s proposed grounds that rely on the Emu Stinger Micro Boot are deficient in establishing the unpatentability of the challenged claim.

3. *UGG Classic Mini (Ex. 1005)*

a) *Petitioner’s Assertions*

In its listing of prior art references, Petitioner states that the “UGG Classic Mini boot, on sale since 2006, is prior art under 35 U.S.C. § 102(a)(1) (Exhibits 1005; 1001 (pages 1-2).” Pet. 4 (citing Ex. 1015 ¶¶ 9–12). The Petition also states:

The UGG Classic Mini is a boot sold continuously by the Patent Owner since 2006. An admission was made to that effect

in an Information Disclosure Statement in the prosecution history of the '161 patent, which is reflected on the face of the patent. Exhibit 1001, pages 1-2; Exhibit 1005, pages 5-24. Its upper portion is believed to have never been the subject matter of a design patent, and it is a cut down version of the still older and taller UGG Classic Short boot. The UGG Classic Mini II is the same outward design that is stain resistant and has an outsole with more traction: no changes were made to the overall visual impression of the footwear upper. Exhibit 1005, pages 3-4; Exhibit 1006.

Pet. 28. Mr. Rhoads testifies that “Exhibit 1005 is true and correct copies of images of the UGG Classic Mini, which has been for sale since 2006, and the UGG Classic Mini II, which has been for sale since 2017, and related information. These images were downloaded by me on January 26, 2024.” Ex. 1015 ¶ 9.

Exhibit 1005 is a compilation of at least seven different documents, which Mr. Rhoads describes as follows:

- “The first images (page 1) selling the UGG Classic Mini, were captured from the Patent Owner’s www.ugg.com website: https://www.ugg.com/all-gender-footwear/classic-miniboot/1002072.html?dwvar_1002072_color=CHE” Ex. 1015 ¶ 9.
- “The second set of images (page 2) selling the UGG Classic Mini II were captured from the same Patent Owner website: https://www.ugg.com/all-gender-footwear/classic-mini-ii-boot/1016222.html?dwvar_1016222_color=BLK and choosing chestnut color.” Ex. 1015 ¶ 10.
- Pages 3–4 are “true and correct copies of publications explaining the II versions and showing the Mini and Mini II on sale at least as early as July 14th and July 19th 2016.” Ex. 1015 ¶ 12.
- Pages 5–24 is an “Information Disclosure Statement filed by the '161 patent Applicant” in which the “prior art status of the UGG Classic Mini as on sale at least as early as August of 2006 and the UGG Classic Mini II at least as early as December 2017 was admitted to.” Ex. 1015 ¶ 11 (citing Ex. 100[1], pages 1–2).

In its Reply, Petitioner states that:

Exhibit 1005 contains ample corroborated evidence of multiple prior art printed publications disclosing the UGG Classic Mini. Exhibit 1005 pgs. 5-24 and Exh. 1001 pages 1-2 provide publications from the Zappos.com website. Indeed, these are the Patent Owner's published listings on the site, and the Patent Owner did not contest availability in its challenge. Ex. 1015 ¶ 4. The publications are dated as printed publications available at least on '4/28/2015' and '1/7/2020', which the Patent Owner admitted were prior art (Exh. 2004, ¶2) on the face of the '161 patent and in its file history.

Reply 16–17 (emphasis omitted).

b) Analysis

Petitioner has not sufficiently demonstrated that any of the images of the UGG Classic Mini in Exhibit 1005 that it relies upon to support its unpatentability arguments constitutes printed publication prior art to the '161 patent.

The images that Petitioner relies upon in its Petition appear to be from pages 1–2 of Exhibit 1005, which Petitioner asserts are webpages from www.ugg.com printed in January 2024. *Compare* Pet. 50–51 *with* Ex. 1005, 1 (depicting Men's Classic Mini Boot), 2 (depicting Women's Classic Mini II Boot); *but see* Pet. 50 (view 5 of UGG Classic Mini having superimposed writing not found in any of the images in Ex. 1005). Petitioner has not sufficiently shown that pages 1–2 of Exhibit 1005 were publicly accessible before the critical date for reasons similar to those discussed above. A 2024 webpage print out itself does not provide sufficient evidence of what was publicly available on the website years earlier.

As to pages 3–4, which Petitioner asserts are publications showing the Mini and Mini II on sale in 2016, we note that page 4, contains only a single

image of the side view of the UGG Classic Mini II that is not cited to in the Petition, and page 3 does not contain any images of the UGG Classic Mini (or Mini II) at all. Thus, neither page 3 nor 4 provides an image that Petitioner relies upon in its unpatentability arguments. Additionally, both pages 3 and 4 bear a copyright date of 2024, thus casting doubt on whether these pages were publicly available prior to the critical date. *See, e.g.*, Ex. 1005, 4 (stating “All prices are in USD. © 2024 Englin’s Fine Footwear”).

Petitioner asserts that pages 5–24 of Exhibit 1005 contain images “from a Zappos website” that were provided to the Examiner by the Applicant during prosecution of the ’161 patent in connection with an Information Disclosure Statement. *See* Pet. 8. Petitioner asserts that Patent Owner admitted that these pages were prior art on the face of the ’161 patent and in its file history. Reply 16 (citing Ex. 2004 ¶ 2; Exhs. 2001–2004, 2006, 2007).

Patent Owner’s statements on the Information Disclosure form, however, relate to whether the UGG Classic Mini and UGG Classic Mini II were “[o]n sale or in public use” before the critical date, not whether the material submitted to the Office constitute printed publication prior art. Ex. 1005, 6. We also note that, while pages 7–10 do bear a date of “4/28/2015” in the upper left hand corner, thus providing some indicia of reliability that these pages were printed and publicly available before the critical date, pages 11–22 bear a date of “1/7/2020,” which is after the critical date.

Even if we were to determine that pages 5–24 of Exhibit 1005 qualify as prior art, Petitioner does not rely upon these pages in its Petition. Indeed, only pages 7, 10, and 11 contain images of an UGG Classic Mini or UGG

Classic Mini II boot and Petitioner expressly states that these images “are remarkably so poor that this prior art also cannot be considered fairly represented for design patent prosecution.” Pet. 8.

As with the exhibits discussed above, even if UGG Classic Mini (Ex. 1005) does qualify as a prior art printed publication, including all of its contained pages, for the reasons discussed below, Petitioner’s proposed grounds based on that document are inadequate to establish the unpatentability of the challenged claim.

B. Designer of Ordinary Skill in the Art

Petitioner submits that a designer of ordinary skill at the time would have been someone with a bachelor’s degree in design or an equivalent field, or two years of practical experience designing footwear. Pet. 25. Petitioner asserts that such persons are often members of a development team that have input into the design of footwear. Pet. 25 (citing Ex. 1011 ¶¶ 31–36; Ex. 1013, 21). Patent Owner does not dispute this definition. *See generally* Prelim. Resp.; PO Sur-reply.

In light of the record before us, and for purposes of this Decision, we adopt Petitioner’s uncontested proposal regarding a designer of ordinary skill in the art.

C. Claim Construction

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b). With regard to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed

by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Id.* at 679–80; *cf. High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to the district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

1. Petitioner’s Contentions

Petitioner provides a number of claim constructions, with alternative constructions subsumed within. *See* Pet. 16–21. Petitioner explains that all of these constructions are based on the solid lines of the ’161 patent along with limited verbal descriptions of certain features relevant to the prior art. Pet. 16; *see also* Pet. 15–16 (stating that scope of the patent is not defined by broken or dashed lines and that the design does not include the “bottom portion of the footwear” nor “anything attached to or contained within the interior of the footwear”).

First, Petitioner asserts that the ’161 patent should be construed as encompassing only the non-functional design elements that are protected under the “UGG Classic Ultra Mini Trade Dress” that were identified by Patent Owner in the California Litigation in Exhibit 1010, namely:

- a. An ankle-high boot;
- b. Classic suede boot styling;
- c. An exaggerated, raised and exposed circular stitch pattern;
- d. Exposed tufting;
- e. A raised and rounded vamp;
- g. Fabric binding along the top of the boot; and
- i. A top line that is higher in the front and lower in the back.³

³ Petitioner omits, from the list of purported non-functional elements of the claimed design, the trade dress elements that apply to the portions of the

Pet. 17–18 (citing Ex. 1010 ¶37); *see also* Pet. 17 (stating that Patent Owner contends the ’161 patent covers its UGG Classic Ultra Mini design and citing Ex. 1010 ¶ 69).

Subsumed within this construction, Petitioner proposes two alternative constructions for the pull tab shown in the ’161 patent figures. In the first pull tab construction (applied in grounds 1–4, 6, 8, and 10⁴), Petitioner asserts that the pull tab should be construed as a non-functional element and not part of the claimed ornamental design. *See* Pet. 20 (construing the ’161 patent design “to encompass footwear uppers with or without a pull tab because it is purely functional and not part of an ornamental design”). In Petitioner’s alternative pull tab construction, which is applied in Grounds 5, 7, 9, and 10, Petitioner asserts that the design should be construed to “cover footwear uppers with a pull tab as part of an ornamental design.” Pet. 20–21.

Additionally, Petitioner alternatively asserts that “the entire subject matter of the ’161 patent claim (including the pull tab) is functional, not ornamental, and the claimed design is purely functional, dictated by the function, including the height of the shaft, the pattern used to make the footwear upper, and the stitching used to put the material cut in the pattern together. Pet. 21–22 (citing Ex. 1011 ¶¶ 39–54; Ex. 1013, 25–31). Petitioner asserts that alternative designs “would cost more, be more uncomfortable, fall apart and not hold together, and would thus not be

footwear represented by the dashed lines. Pet. 17–18 (inserting brackets for certain items, and identifying “items a. through e., part of g., and i.” as the purported non-functional elements).

⁴ Ground 10 applies both of Petitioner’s alternative constructions regarding the pull tab. *See* Pet. 11, 63–64.

commercially viable.” Pet. 22. Petitioner thus concludes that “[i]f the Board has the power to do so, it should declare the ’161 patent invalid for being directed to a purely functional design.”⁵ Pet. 22.

2. *Patent Owner’s Contentions*

Patent Owner responds that how it chose to describe its trade dress has no bearing on the construction of the claim of a design patent. Prelim. Resp. 33 (stating that trade dress and design patent have “very different scopes”). Patent Owner further asserts that even if the pull tab of the patent design serves a functional purpose, the tab cannot be ignored when assessing claim scope *Id.* at 35 (citing *Apple v. Samsung*, 786 F.3d 983, 998–99 (Fed. Cir. 2015)). Patent Owner also asserts that Petitioner fails to consider the overall visual appearance of the claimed design. Prelim. Resp. 36–43.

3. *Discussion*

A design patent only protects the novel, ornamental features of the patented design. *Oddzon Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997). However, so long as the design is not primarily functional, the design claim is not invalid even if certain elements have functional purposes. *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016). That is because a design patent’s claim protects an article of manufacture, which necessarily serves a utilitarian purpose. *Id.* Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional

⁵ We also decline Petitioner’s invitation to consider the ’161 patent unpatentable for being directed to a functional design. Pet. 22. Under 35 U.S.C. § 311(b), a petitioner in an *inter partes* review may request to cancel a claim only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

aspects of the design shown in the patent. *Id.* Thus, while certain elements of a device may be functional, their functionality does not preclude those elements from having protectable ornamentation. *Id.* at 1321 (stating that “in no case did we entirely eliminate a structural element from the claimed ornamental design, even though that element also served a functional purpose”).

In determining whether a claimed design is primarily functional, the functionality of the article itself must not be confused with the functionality of the design of the article. *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015). In determining whether a claimed design is dictated by its function, and therefore impermissibly functional, courts look to the “availability of alternative designs as an important—if not dispositive—factor in evaluating the legal functionality of a claimed design. *Id.* at 1329–30. If there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. *Id.* at 1330. In other words, if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional. *Id.*

Here, the pull-tab does serve a useful purpose as it can be used to pull the footwear onto the foot. Based on the evidence presented, however, we disagree with Petitioner that the pull tab is primarily functional and should be removed entirely from the construction of the claimed design.

Petitioner presents a number of arguments to support its position that the pull tab is functional, not ornamental. Petitioner asserts that the pull tab is “obviously not ornamentation but instead is a functional element that is used to pull the footwear on to the foot, an important function and part of the Patent Owner’s marketing message.” Pet. 18–19 (citing Ex. 1011 ¶¶ 64–67;

Ex. 1013, 25–27). Petitioner further states that while other pull tabs are possible, the type of pull tab shown in the '161 patent “is the kind that is generally used in shorter shaft, lower ankle height footwear to make it easier to pull up and put the boot on the foot.” Pet. 19 (citing Ex. 1009, the UGG Neumel Boot). Petitioner further asserts that the pull tab is “securely attached for actual use, countering that it is ornamental” and that “[a]ny other pull tab (e.g., not at the top of the footwear as in the UGG Neumel Boot) would not be as efficient and hence not an acceptable alternative.” *Id.* (citing Ex. 1011 ¶¶ 64–67; Ex. 1013, 25–27).

We are not persuaded by these arguments. The “marketing material” relied on by Petition, as discussed by Mr. Holden, merely states that Ultra Mini Ugg Boots “have a slightly lower ankle to make it easier for you to slip on,” that the UGG boots are “fantastic” for those who “may struggle with pulling on other styles,” and the boots “are fantastic for those who may struggle with pulling on other styles and are looking for more comfort and durability.” *See* Ex. 1011 ¶ 66 (citing Ex. 1003). None of the marketing material cited by Petitioner even mentions a pull tab.

Nor does the present record support Petitioner’s contentions that, while other pull tabs are possible, the type of pull tab shown in the '161 patent “is the kind that is generally used in shorter shaft, lower ankle height footwear to make it easier to pull up and put the boot on the foot” and that “[a]ny other pull tab (e.g., not at the top of the footwear as in the UGG Neumel Boot) would not be as efficient and hence is not an acceptable alternative”. Pet. 19. Other than the UGG Neumel Boot (Ex. 1009), Petitioner does not cite to any examples of shorter shaft, lower ankle height footwear having the pull tab shown in the '161 patent. Even Ms. Wright acknowledges that it “is traditional especially in men’s shoes, to have a *back*

strap or pull tab and this has been the case for most of the 20th Century up to the present date.” Ex. 1013, 27. Ms. Wright does not assert that it is traditional to use the particular pull tab illustrated in the ’161 patent.

Given the alternative pull tabs available, and Petitioner’s failure to persuasively explain why the particular pull tab depicted in the ’161 patent is more preferable than any other pull tab, Petitioner has not sufficiently shown that the pull tab is functional and not ornamental and should not be considered as part of the ornamental design. *See, e.g., LA Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (“When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.”).

Petitioner’s argument that because the pull tab is “securely attached” (Pet. 19) or “stitched down” (Ex. 1011 ¶ 66), the pull tab is functional and not ornamental is not persuasive because the pull tab shown in the ’161 patent is not “stitched down” as there are no stitches depicted on the pull tab of the ’161 patent.

Finally, we are not persuaded by Petitioner’s argument that Patent Owner’s listing in a Complaint for Trade Dress Infringement of non-functional elements that comprise the Classic Ultra Mini Trade Dress is sufficient reason to exclude the pull tab from the claimed design. Pet. 17–18 (citing Ex. 1010 ¶ 37). Petitioner has not sufficiently shown that statements by Patent Owner to describe its trade dress of one of its products necessarily apply to the construction of a design patent claim, a different intellectual property right.

Given Petitioner’s failure to adequately explain why alternative pull tab arrangements are not acceptable, based on the present record, we

disagree with Petitioner that the pull tab depicted in the '161 patent is functional so as to be excluded from the claimed design.

We also disagree with Petitioner's argument that the '161 patent claim is entirely functional because the design is "dictated by the function" including the height of the shaft, the pattern used to make the footwear upper, and the stitching used to put the material cut in the pattern together. Pet. 21–22. Petitioner's argument that any alternative design to that shown in the '161 patent would cost more, be more uncomfortable, fall apart, and would not be commercially viable is not persuasive on the present record as it does not adequately address alternative designs. *See* Pet. 21–22; Ex. 1011 ¶¶ 39–54, 64–67; Ex. 1013, 25–31.

Thus, based on the present record, we disagree with Petitioner that the pull tab, or the entire design, depicted in the '161 patent is primarily functional so as to be excluded from the claimed design.

We construe the claim to be the ornamental design of the footwear upper, as illustrated in Figures 1–7, except that the broken lines do not form part of the claimed design.

D. Principles of Law

1. Anticipation

When assessing a design patent challenge based on anticipation, we assess whether the claimed and prior art "designs are substantially the same," which requires consideration of whether "their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other." *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312–13 (Fed. Cir. 2001) (citing *Gorham Mfg. Co. v. White*,

81 U.S. 511, 528 (1871)). The Supreme Court articulates the ordinary observer 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. It is important to keep in mind for designs that the “ordinary observer” is not the same as a person of ordinary skill in the art. The ordinary observer is quite often a consumer, or purchaser, considering a product in the ordinary course of business. *See Goodyear Tire & Rubber Co. 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.”). In *Egyptian Goddess*, the Federal Circuit explained that the ordinary observer is also a person familiar with the prior art designs. *Egyptian Goddess*, 543 F.3d at 675–78.

For purposes of determining anticipation, it is necessary to compare the overall claimed design to the prior art under the ordinary observer standard. *Int’l Seaway Trading Corp. v. Walgreens Corp.* 589 F.3d 1233, 1243 (Fed. Cir. 2009) (“[T]he ordinary observer test requires consideration of the design as a whole.” (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.*

2. *Obviousness*

The Federal Circuit recently issued an *en banc* decision that involves the standards for assessing nonobviousness of design patents under 35 U.S.C. § 103. *LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2014) (*en banc*).⁶ In *LKQ*, The Federal Circuit stated that “the *Rosen-Durling* test requirements—that (1) the primary reference be ‘basically the same’ as the challenged design claim; and (2) any secondary references be ‘so related’ to the primary reference that features in one would suggest application of those features to the other—are improperly rigid.” *LKQ*, 102 F.4th at 1293; *see also In re Rosen*, 673 F.2d 388 (CCPA 1982); *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996). Instead, the Court held that “[i]nvalidity 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

⁶ In May 2024, the U.S. Patent and Trademark Office (USPTO) published updated guidance on examination instructions for assessing nonobviousness of design patents. *See Updated Guidance and Examination Instructions for Making a Determination of Obviousness in Designs in Light of LKQ Corp. v. GM Global Technology Operations LLC*, available at https://www.uspto.gov/sites/default/files/documents/updated_obviousness_determination_designs_22may2024.pdf (May 22, 2024) (“2024 Updated Guidance”). The Director has instructed that Board decisions addressing obviousness in the design patent context must follow the *LKQ* decision. *See 2024 Updated Guidance*, 3.

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 *LKQ*, the Federal Circuit provided guidance as to how to apply the *Graham* factors in assessing nonobviousness of design patents. The Court stated that, 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 that is 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.* According to the Federal Circuit, “[t]he 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.*

As to *Graham* factor two, which requires “determining the differences between the prior art designs and the design claim at issue,” the Federal Circuit explains that we are 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.

Under *Graham* factor three, “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.

Finally, in applying *Graham* factor four, we assess any secondary considerations, such as commercial success, industry praise, and copying⁷. *Id.* at 1300.

We analyze the asserted grounds with the above-noted principles in mind.

E. Emu Stinger Micro Boot (Anticipation - Ground 1)

Petitioner asserts that the claimed design of the ’161 patent is anticipated by the Emu Stinger Boot (Ex. 1002). Pet. 35–38. Petitioner provides the following chart comparing the EMU Stinger Micro and the ’161

⁷ The present record does not contain any arguments directed to secondary considerations.

design.

View	'161 patent	Emu Australia Stinger Micro
1	 <p data-bbox="690 378 730 399">FIG. 1</p>	
2	 <p data-bbox="600 693 641 714">FIG. 2</p>	
3	 <p data-bbox="600 882 641 903">FIG. 3</p>	



Pet. 35–36. The Petition asserts that the Emu Boot “has the same footwear upper as that claimed in the ’161 patent.” Pet. 36. The Petition contends that the Emu Boot has each of the relevant non-functional elements identified by Patent Owner in its complaint asserting trade dress infringement, namely:

1. An ankle-high boot (views 1–5);
2. Classic suede boot styling (views 1–5);
3. An exaggerated, raised and exposed circular stitch pattern (views 1–5);
4. Exposed tufting (views 5–6);
5. A raised and rounded vamp (views 1–4);
6. fabric binding along the top of the boot; and

7. A top line that in some views appears to be slightly higher in the front and lower in the back (views 2 and 5).

Pet. 36 (citing Ex. 1010 ¶ 79). Petitioner asserts that any minor variations do not preclude a finding of anticipation because the “overall impression of the ankle high boots with all of the ornamental features remains equivalent” to an ordinary observer. Pet. 37.

Petitioner’s arguments are not persuasive. First, the images of the Emu Stinger Micro Boot that Petitioner relies upon are from pages 1–6 of Exhibit 1002, which as noted above, Petitioner has not sufficiently shown to constitute a printed publication prior art. Thus, Petitioner’s arguments are based on images in a reference that does not qualify as prior art to the claimed design. The images found on pages 8 and 9 of Exhibit 1002 are not the same images as those relied upon in the Petition. *Compare* Ex. 1002, 8–9, *with* Pet. 35–36. Thus, for at least this reason, Petitioner fails to demonstrate a reasonable likelihood that it would prevail in showing the ’161 patent is anticipated by the Emu Stinger Boot.

Second, even if we were to consider any of these images of the Emu Stinger Micro Boot depicted in Exhibit 1002, Petitioner’s arguments are not persuasive because the arguments fail to adequately address differences between the claimed design and the prior art as viewed by an ordinary observer. *See Door-Master Corp.*, 256 F.3d at 1313 (stating for anticipation to be found, the claimed design and the prior art design must be substantially the same).

For example, the Figures of the ’161 patent depict (1) a stitch pattern design that includes a wavy line on the back heel of the boot (*see* Figs. 1–3, 5), (2) a pull tab that extends over the top part of the back of the boot and

down below the “wavy line” on the back of the boot (Figs. 1–3, 5), (3) a top opening for insertion of the foot that appears to constitute more than 50% of the length of the boot (Figs. 2, 3, 6), and (4) a backward sloping top line. Petitioner does not address the differences between (1) the stitch pattern (2) the pull tab, or (3) the size of the opening for the foot at all in its anticipation argument. *See* Pet. 35–38.

As to the backward sloping top line of the footwear depicted in the ’161 patent (*see* Figs. 2, 3, 5), Petitioner states that “while the Emu footwear upper may have a slightly less sloped top line, a person of ordinary skill would likely not regard this as a difference in ‘design’ because the overall impression created by the footwear upper would remain the same.” Pet. 37 (citing Ex. 1011 ¶¶ 75–82).

This argument is not persuasive for a number of reasons. First, the Emu footwear appears to have a straight top line, not a line that is “slightly less sloped” as asserted by Petitioner. Pet. 37. Indeed, Mr. Holden admits that a “top line that is higher in the front and lower in the back is difficult to see (shown to be slight to not existent in Views 2 and 5). Ex. 1010 ¶ 79. To the extent Mr. Holden testifies that the Emu footwear has a slanted top line, such testimony is not credible. *See* Ex. 1011 ¶ 81 (stating that Stinger footwear “may have some different proportions on the top (less slanted)”). Additionally, Mr. Holden’s assertions that any differences between the ’161 design and the Emu Stinger boot, including a difference in overall proportion, would not be regarded as a difference in design because the overall impression created by the footwear would remain the same is conclusory and unsupported. *See* Ex. 1011 ¶¶ 81–82.

By failing to adequately address these differences, or provide any persuasive argument that these differences are minor or trivial, Petitioner

fails to sufficiently show that the Emu Stinger Micro Boot is substantially the same as the '161 patent claimed design. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that claimed design is anticipated by the Emu Stinger Micro Boot.

F. Emu Stinger Micro (Obviousness – Ground 2)

In Ground 2, the Petition states that if *the pull tab is not considered* to be part of the claimed design, then the '161 patent claim would have been obvious over the Emu Stinger Micro Boot. Pet. 38–40. Petitioner repeats its contentions set forth in Ground 1 that the Emu Stinger boot has the same design claimed in the '161 patent and further asserts that any differences, such as “the overall height and proportions,” between the Stinger boot and the claimed design “would have been obvious because they are purely functional, rather than ornamental in nature.” Pet. 39. Petitioner also asserts that even if not functional, that “changing the overall length/width of the footwear upper to be trivially obvious” because a designer would “understand that any given footwear upper could be easily modified to be longer or shorter depending on the application (e.g., the length of the user’s foot, or an easily removed slipper-like indoor use versus footwear for outside and poor weather conditions).” Pet. 40. Petitioner further asserts that a designer of ordinary skill would have been motivated to vary the overall size of the footwear upper to suit the particular application, for example by changing the shaft to be taller or shorter and making the footwear easier or more difficult to be removed from the foot while retaining the same design characteristics of the original boot design. Pet. 40 (citing Ex. 1011 ¶¶ 83–88); *see also* Reply 9–10 (stating that it is predictable and well-known to the ordinary designer to make the boot in different sizes and proportions (citing Ex. 1016 ¶¶ 73–76)).

Petitioner's arguments are not persuasive because they fail to address the differences between the overall appearance of the claimed design and the Emu Stinger Micro Boot identified above, including the wavy line on the back heel of the boot, the ratio of the length of the foot opening to the length of the boot, the pull tab, and the sloping top line. As such, the arguments set forth in the Petition fail to sufficiently compare the visual appearance of the claimed design with the prior art designs from the perspective of an ordinary designer in the field of footwear uppers.

In the Reply Brief, Petitioner adds that if there are any perceived differences in the pull tab of the Emu Stinger Boot and the '161 patent claim, that any differences are slight and that it is "predictable that an ordinary designer would include a pull tab consistent with its own other short shaft footwear (*see* below re: Neumel)." Reply 9–10 (citing Ex. 1016 ¶¶ 54–57, 73; Ex. 1017, 16–17; Reply 11–12). We note that this is a new argument as Petitioner explicitly stated Ground 2 is based upon the pull tab not being part of the claim construction. *See, e.g.*, Pet. 10, 38–40. Even if we were to consider this argument, however, it is still not persuasive as it is based upon the pull tab of the UGG Neumel Boot depicted in Exhibit 1009, which as we state above, does not qualify as printed publication prior art, and because Petitioner fails to address the remaining differences between the Emu Stinger Boot and the '161 patent claim.

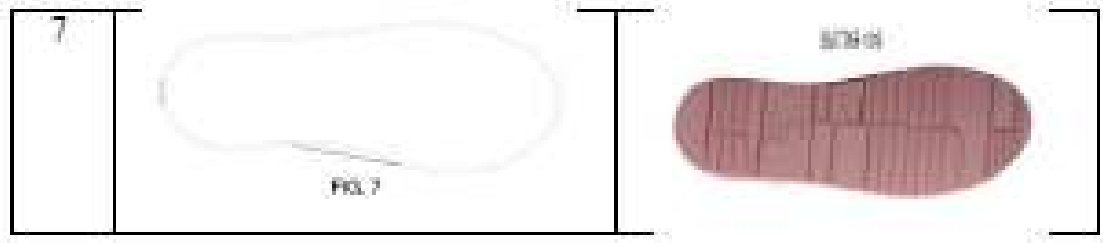
Accordingly, Petitioner fails to demonstrate a reasonable likelihood that claimed design is would have been obvious over the Emu Stinger Micro Boot.

G. CN'897 (Anticipation - Ground 3)

Petitioner asserts that under a claim construction where the pull tab is functional, the claimed design of the '161 patent is anticipated by the

CN'897 (Ex. 1003). Pet. 40–45 (citing Ex. 1011 ¶¶ 89–96). Petitioner provides the following chart comparing the footwear depicted in CN'897 and the '161 design:

View	'161 patent	CN'897
1		
2		
3		
4		
5		
6		



Pet. 41–42. Petitioner asserts CN’897 has the same footwear upper as that claimed in the ’161 patent and has each of the relevant non-functional elements identified by Patent Owner, namely:

1. An ankle high boot (views 1-5);
2. Classic suede boot styling (views 1-5)
3. An exaggerated, raised and exposed circular stitch pattern (views 1-5)
4. Exposed tufting (views 5-6)
5. A raised and rounded vamp (views 1-4)
6. Fabric binding along the top of the boot (views 1-6)
7. A top line that is higher in the front and lower in the back (views 1-3, 5).

Pet. 42 (citing Ex. 1011 ¶ 93). Petitioner asserts that to the extent there are any minor variations, such as “different textures on the sides,” they do not preclude a finding of anticipation because the overall impression created of two ankle high boots with all of the same features remains equivalent between CN’897 and ’161 patent. Pet. 42–43.

Petitioner’s arguments are not persuasive because they fail persuasively to address differences between the claimed design and CN’897. For example, as shown in views 2 and 3, the profile of the back of the footwear shown in the ’161 patent is generally vertical while the upper portion of the back of the footwear of CN’897 juts backwards, thus creating an angled profile of the back of the footwear. Additionally, as shown in views 2, 3, and 6, the top opening of the footwear of the ’161 patent appears

to constitute more than 50% of the length of the boot in contrast to the opening depicted in CN'897. Additionally, the '161 patent has a single wavy line on the back portion of the footwear and that extends from a relatively high point at the rear of the footwear to a relatively low point near the middle of the side of the footwear. CN'897 has two "lines" on the back portion of the boot, both of which are noticeably different than the very pronounced wavy line of the claimed design. The first line is at the junction of the upper back portion of the boot composed of a sheepskin appearing material and the lower portion of the boot composed on an apparent pink suede material. This line appears to "meet up" with a line on the front of the boot that separates the lower vamp of the boot from the top portion of the front of the boot. The second line, which is yellow, is located beneath the first upper line. Additionally, the '161 patent depicts a pull tab while CN'897 does not.

By failing to persuasively address these differences, or provide any persuasive argument that these differences are minor or trivial, Petitioner fails to sufficiently show that footwear of CN'897 is substantially the same as the '161 patent claimed design. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that claimed design is anticipated by CN'897.

H. CN'897 (Obviousness - Ground 4)

In Ground 4, the Petition states that if the pull tab is functional, and thus not *considered* to be part of the claimed design, then the '161 patent claim would have been obvious over CN'897. Pet. 44–45. Petitioner asserts that to the extent there are any differences between CN'897 and the claimed design, such as the overall height and proportions, those proportions would have been obvious because they are purely functional, rather than

ornamental in nature. Pet. 44. Petitioner also asserts that even if not functional, that “changing the overall length/width of the footwear upper to be trivially obvious” because a designer would “understand that any given footwear upper could be easily modified to be longer or shorter depending on the application (e.g., the length of the user’s foot, or an easily removed slipper-like indoor use versus footwear for outside and poor weather conditions).” Pet. 45. Petitioner further asserts that a designer of ordinary skill would have been motivated to vary the overall size of the footwear upper to suit the particular application, for example by changing the shaft to be taller or shorter and making the footwear easier or more difficult to be removed from the foot while retaining the same design characteristics of the original boot design. Pet. 45 (citing Ex. 1011 ¶¶ 97–101).

Petitioner’s arguments are not persuasive because they fail to address the differences between the overall appearance of the claimed design and CN’897 identified above — including the profile of the back of the boot, the ratio of the length of the foot opening to the length of the boot, the single wavy line on the back heel of the boot, and the pull tab. As such, Petitioner’s arguments fail to sufficiently compare the visual appearance of the claimed design with the prior art designs from the perspective of an ordinary designer in the field of footwear uppers.

In the Reply Brief, Petitioner argues for the first time that, if there are any perceived differences because of the pull tab, “they are slight” and that a designer would be motivated to add a pull tab to CN’897 to assist in pulling on the boot. Reply 10 (stating a pull tab is a “commonplace, very well-known feature in the art, and industry custom”). Petitioner also asserts that a designer would be especially motivated to add a pull tab consistent with other short shaft shoes in its own line (like its Neumel). Reply 10.

We note that this is a new argument as Petitioner explicitly stated Ground 2 is based upon the pull tab not being part of the claim construction. *See, e.g.*, Pet. 10, 44–45. Even if we were to consider this argument, however, it is still not persuasive as it is based upon the pull tab of the UGG Neumel Boot depicted in Exhibit 1009, which as we state above, does not qualify as printed publication prior art. And, Petitioner does not offer adequate reasoning why a designer would select, from all the possible design options, the specifically configured pull tab of the claimed design. Additionally, this argument does not address the remaining differences between the '161 patent design and CN'897.

Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail in showing that the claimed design of the '161 patent would have been obvious over CN'897.

I. Emu Stinger Micro Boot or CN'897 in Combination with the UGG Neumel Boot (Ground 5)

In Ground 5, Petitioner asserts that if the pull tab is included in the construction of the claimed design, then the claimed design would have been obvious over either the Emu Stinger Micro Boot or CN'897 and the UGG Neumel Boot, which has an identical pull tab to that of the '161 patent.⁸ Pet. 46–49 (citing Ex. 1009; Ex. 1011 ¶¶ 102–110); Reply 11–12 (citing Ex. 1016 ¶¶ 54–57, 93). Petitioner relies on its arguments set forth in Ground 2 (Emu Stinger Micro Boot) or Ground 4 (CN'897) and then states that it would have been obvious to implement the footwear of either the Emu Boot or CN'897 with the pull tab of the UGG Neumel Boot to make it easier to

⁸ Petitioner's contentions in Ground 5 that the claimed design would have been obvious over the combination of CN'897 and the UGG Neumel Boot is addressed below.

put on and remove the footwear from the foot. Pet. 47–48. Petitioner further asserts that using the pull tab that matches the pull tab of the UGG Neumel Boot was a simple design choice that involved no more than a mere substitution of one known element for another. Pet. 48–49.

In the Reply, Petitioner further states that a manufacturer like Patent Owner would have been motivated to include a pull tab consistent with its other long-used pull tabs used in short shaft boots, such as its UGG Neumel. Reply 11–12 (citing Ex. 1016 ¶¶ 93–97). Petitioner also states that motivation to combine the references is found in the knowledge of an ordinary designer. Reply 11 (citing Ex. 1016 ¶¶ 89–98).

Petitioner’s arguments are not persuasive. As noted above, Petitioner has not shown that Exhibits 1009 or 1010 qualify as prior art and, thus, Petitioner has not provided any evidence that the particular pull tab of the UGG Neumel boot, disclosed in Ex. 1009, was in the prior art. Additionally, Petitioner’s arguments fail to address the additional differences between the overall appearance of the ’161 patent design and the asserted art identified above. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that it would prevail in showing that the claimed design of the ’161 patent would have been obvious over the Emu Stinger Micro Boot or CN’897 in combination with the UGG Neumel boot.

J. UGG Classic Mini (Obviousness - Ground 6)

Petitioner asserts that the claimed design of the ’161 patent would have been obvious over the UGG Classic Mini (Ex. 1005). Pet. 49–54; Reply 12–13. Petitioner provides the following chart comparing the UGG Classic Mini and the claimed design.

View	'161 patent	UGG Classic Mini
1	 <p>FIG. 1</p>	
2	 <p>FIG. 2</p>	
3	 <p>FIG. 3</p>	



Pet. 50–51. Petitioner asserts UGG Classic Mini has the same footwear upper as that claimed in the '161 patent and has each of the relevant non-functional elements identified by Patent Owner, namely:

1. An ankle high boot (views 1-5);
2. Classic suede boot styling (views 1-5)
3. An exaggerated, raised and exposed circular stitch pattern (views 1-5)
4. Exposed tufting (views 5-6)
5. A raised and rounded vamp (views 1-4)
6. Fabric binding along the top of the boot (views 1-6)
7. A top line that is higher in the front and lower in the back (views 1-3, 5).

Pet. 52 (citing Ex. 1011 ¶ 116; Ex. 1005, 11 (depicting the UGG Classic Mini II)). Petitioner asserts that to the extent there are any minor variations,

they do not preclude a finding of obviousness because the overall impression remains the same as there are no substantial differences between the UGG Classic Mini and the claimed design. Pet. 51–52 (citing Ex. 1011 ¶¶ 111–121; Ex. 1013, 23–25, 27–31). Petitioner further asserts, that to the extent there are any differences, such as the overall height and proportions of the footwear uppers, the proportions are purely functional because they relate to putting on and removing the boot and how much ankle is covered. Pet. 52. Petitioner also asserts that a designer of ordinary skill would have found changing the overall length width of the footwear upper to be trivially obvious. Pet. 53–54.

Petitioner’s arguments are not persuasive. First, as explained above, Petitioner has not shown a reasonable likelihood that the images of the UGG Classic Mini that it relies on in its unpatentability argument are from printed publication prior art. Thus, for at least this reason, Petitioner has not shown a reasonable likelihood that the ’161 patent would have been obvious over the UGG Classic Mini (Ex. 1005).

Second, to the extent Petitioner’s arguments could be understood to be based on the images of depicted on pages 7, 10, or 11 of Exhibit 1005, Petitioner has admitted that the images on these pages “are remarkably so poor that this prior art also cannot be considered fairly represented for design patent prosecution.” Pet. 8 (also stating that certain of the rear boot lines cannot be observed in the images).

Thus, for at least these reasons, Petitioner fails to demonstrate a reasonable likelihood that it would prevail in showing that the ’161 patent would have been obvious over the UGG Classic Mini.

Additionally, even if we were to consider the images of the UGG Classic Mini that Petitioner relies upon in its Petition as qualified prior art,

Petitioner's arguments of unpatentability are not persuasive because the arguments fail to adequately address differences between the overall appearance of the claimed design and the UGG Mini, including the ratio of the length of the foot opening to the length of the boot, the pull tab, and the sloping top line. As such, the arguments set forth in the Petition fail to sufficiently compare the visual appearance of the claimed design with the prior art designs from the perspective of an ordinary designer in the field of footwear uppers.

For example, the claimed design depicts the footwear as having a backward sloping top line. *See* Ex. 1001, Figs. 2, 3, 5; Pet. 52 (stating the '161 patent should be construed as having a top line that in some views appears to be higher in the front and lower in the back). In contrast, the images relied upon by Petitioner depict the UGG Classic Mini as having a generally horizontal top line. *See* Pet. 50–51. We acknowledge that Petitioner cites to the “UGG Classic Mini II” depicted on page 11 of Exhibit 1005 as appearing to have a sloped line. Pet. 52 (citing Ex. 1005, 11; Ex. 1011 ¶ 116). This image, however, is of a different boot than the boot that is relied upon in Petitioner's unpatentability arguments. *Compare* Ex. 1005, 11 *with* Pet. 50–51. Additionally, as noted above, Petitioner admits that this image is “remarkably so poor” and that “[c]ertain of the rear boot lines” cannot be observed in this image. Pet. 8. Finally, the UGG Classic Mini has a different pull tab than that depicted in the '161 patent design. As such, the arguments set forth in the Petition fail to sufficiently compare the overall visual appearance of the claimed design with the UGG Classic Mini from the perspective of an ordinary designer in the field of footwear uppers.

In the Reply Brief, Petitioner adds that if there is any perceived difference in the pull tabs of the two boots, they are also slight and it is predictable and well known to add or make the pull tabs of different and consistent shapes. Reply 12–13 (citing Ex. 1016 ¶¶ 54–57, 61, 63–65; Ex. 1017, 6–8, 10–13, 16–18). We note that this is a new argument as Petitioner explicitly stated Ground 6 is based upon the pull tab not being part of the claim construction. Even if we were to consider this argument, however, it is still not persuasive because, *inter alia*, Petitioner fails to address the remaining differences between the UGG Classic Mini and the ’161 patent claim.

Accordingly, based on the present record, Petitioner fails to demonstrate a reasonable likelihood that it would prevail in showing that the claimed design of the ’161 patent would have been obvious over the UGG Classic Mini.

K. UGG Classic Mini and UGG Neumel Boot (Ground 7)

In Ground 7, Petitioner asserts that if the pull tab is non-functional and included in the claimed design, then the claimed design would have been obvious over the UGG Classic Mini and the UGG Neumel Boot. Pet. 54–60; Reply 13.

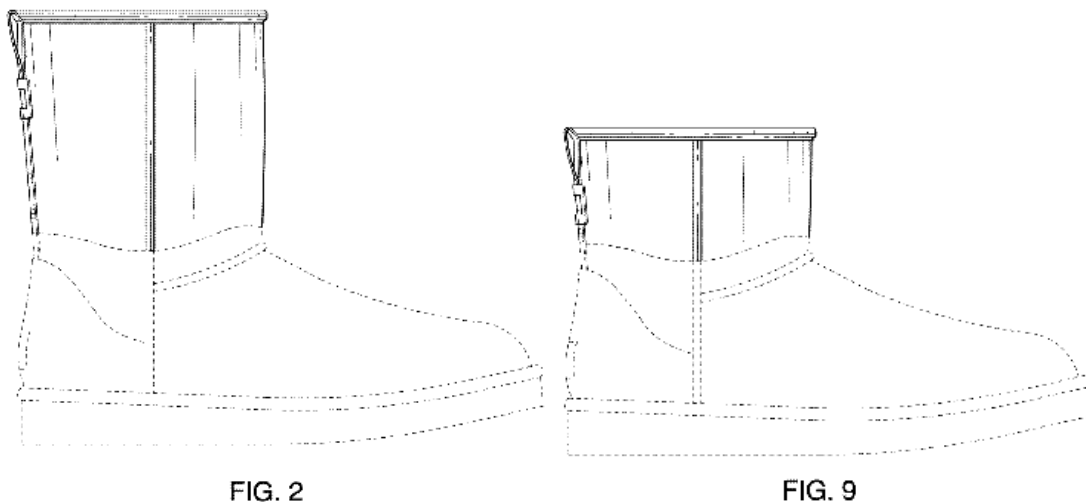
Petitioner’s arguments fail to address the deficiencies discussed above with respect to ground 6. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that it would prevail in showing that the claimed design of the ’161 patent would have been obvious over the UGG Classic Mini in combination with the UGG Neumel Boot.

L. Grounds Adding MacIntyre '974 and/or Chung '186 (Grounds 8, 9, 10)

1. Overview of MacIntyre '974 (Ex. 1007)

MacIntyre '974 is titled "Footwear Upper." Ex. 1007, code (54). MacIntyre '974 claims "[t]he ornamental design for a footwear upper, as shown and described." *Id.* at code (57). MacIntyre '974 discloses two embodiments of a footwear upper design having different shaft lengths.

Figures 2 and 9 of MacIntyre '974 are reproduced below:

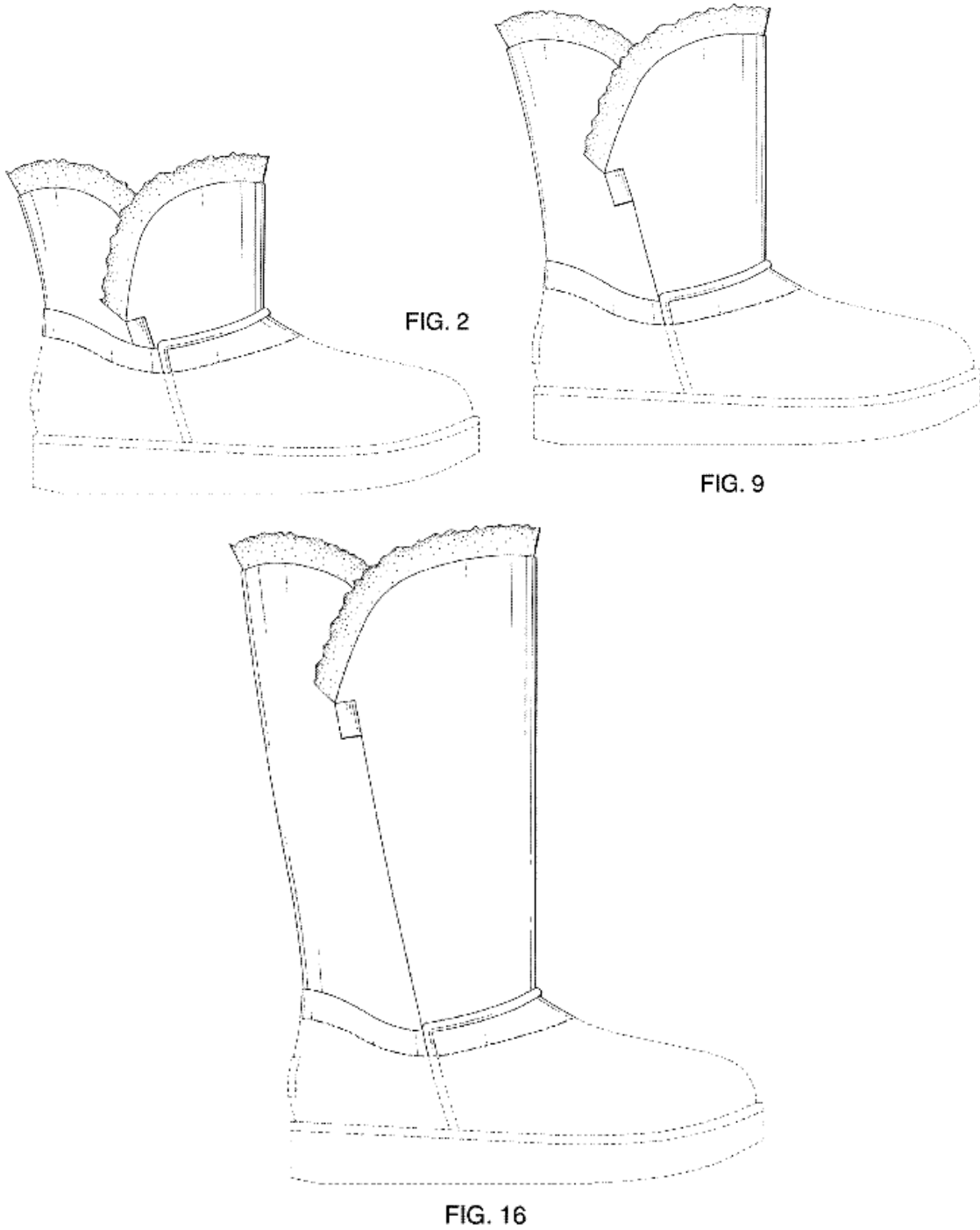


Figures 2 and 9 each depict "a side elevational view" of an embodiment of a footwear upper. Ex. 1007, code (57).

2. Overview of Chung '186 (Ex. 1008)

Chung '186 is titled "Footwear Upper." Ex. 1008, code (54). Chung '186 claims "[t]he ornamental design for a footwear upper, as shown and described." *Id.* at code (57). Chung '186 discloses three embodiments of a footwear upper design and includes twenty-one drawings.

Figures 2, 9, and 16 of Chung '186 are reproduced below:



Figures 2, 9, and 16 each depict “a side elevational view” of an embodiment of a footwear upper. Ex. 1008, code (57).

3. *Discussion*

In Grounds 8–10, Petitioner asserts, *inter alia*, that to the extent the asserted primary references either alone or in combination with the UGG Neumel Boot, do not render the claimed design obvious because the UGG Classic Mini has a footwear upper with a slightly different length/width or shaft length, that it would have been obvious to vary the length/width and shaft length in view of MacIntyre '974 or Chung '186. Pet. 63–64; Reply 14–15.

Petitioner asserts that MacIntyre '974 and Chung '186 each teach “that it is the same alleged patentable invention to change the shaft length and the overall height among embodiments and to still obtain the same overall impression of the design.” Pet. 60–61. Petitioner asserts that there is nothing predictable or nonobvious about designing a shaft length to be shorter to allow for footwear to be more easily removed or put on the foot and/or as part of a product line. Pet. 62; *see also* Reply 14 (stating MacIntyre '974 and/or Chung '189 teach and motivate an ordinary designer to make footwear with various shaft heights).

We disagree with Petitioner’s arguments. To the extent MacIntyre '974 or Chung '186 may teach modifying shaft height, neither reference teaches modifying shaft width. Accordingly, neither reference teaches modifying the UGG Classic Mini to have a top opening for insertion of the foot that constitutes more than 50% of the length of the boot, as depicted in Ex. 1001, Figs. 2, 3, 6. Accordingly, Petitioner has not shown a reasonable likelihood that it would prevail on asserted Grounds 8–10.

M. Discretionary Denial

Patent Owner asserts that the Petition should be denied under 35 U.S.C. § 325(d) because the Petition relies on CN'897, which Patent

Owner contends was considered by the Office during prosecution. Prelim. Resp. 18, 21–32. Patent Owner further asserts that the Petition should be denied under 35 U.S.C. § 314(a) because the majority of Petitioner’s asserted grounds are based on prior sales, not on patents or printed publications as required by the statute, and are thus facially deficient, and argues that “Board precedent strongly disfavors instituting review when the majority of the challenges fail to satisfy the threshold for institution.” *Id.* at 18.

Because we deny the Petition on the merits, we decline to address these arguments directed to discretionary denial.

III. CONCLUSION

For the reasons set forth above, we conclude that Petitioner has not shown a reasonable likelihood that it would prevail with respect to the claimed design of the ’161 patent.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no trial is instituted.

IPR2024-00525
Patent D927,161 S

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