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## REQUEST FOR *INTER PARTES* REEXAMINATION TRANSMITTAL FORM

Address to:  
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**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

Attorney Docket No.: 529815

Date: August 3, 2012

1. ☒ This is a request for *inter partes* reexamination pursuant to 37 CFR 1.913 of patent number D517,789 issued March 28, 2006. The request is made by a third party requester, identified herein below.
2. ☒ a. The name and address of the person requesting reexamination is:  
Lathrop & Gage LLP  
4845 Pearl East Circle, Suite 201  
Boulder, Colorado 80301
- b. The real party in interest (37 CFR 1.915(b)(8)) is: USA Dawgs, Inc.
3. ☐ a. A check in the amount of \$ \_\_\_\_\_ is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(2);
- ☒ b. The Director is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(2) to Deposit Account No. 12-0600; or
- ☐ c. Payment by credit card. Form PTO-2038 is attached.
4. ☒ Any refund should be made by ☐ check or ☒ credit to Deposit Account No. 12-0600. 37 CFR 1.26(c). If payment is made by credit card, refund must be made to credit card account.
5. ☒ A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.915(b)(5)
6. ☐ CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table  
☐ Landscape Table on CD
7. ☐ Nucleotide and/or Amino Acid Sequence Submission  
*If applicable, items a. – c. are required.*
- a. ☐ Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i. ☐ CD-ROM (2 copies) or CD-R (2 copies); or
- ii. ☐ paper
- c. ☐ Statements verifying identity of above copies
8. ☐ A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.
9. ☒ Reexamination of claim(s) The sole claim is requested.
10. ☒ A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO/SB/08, PTO-1449, or an equivalent.
11. ☐ An English language translation of all necessary and pertinent non-English language patents and/or printed publications is included.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.915. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop *Inter Partes* Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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12. ☒ The attached detailed request includes at least the following items:
- A listing of the grounds that the requester asserts to raise a showing of a reasonable likelihood that the requester will prevail with respect to at least one of the claims challenged in the request. 37 CFR 1.915(b)(3).
  - For each ground listed, an identification of every claim to which the showing applies, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim which is identified for that ground. 37 CFR 1.915(b)(3).

13. ☒ It is certified that the estoppel provisions of 37 CFR 1.907 do not prohibit this reexamination. 37 CFR 1.915(b)(7).

14. ☒ a. It is certified that a copy of this request has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).

The name and address of the party served and the date of service are:

Faegre Baker Daniels LLP,

PATENT DOCKETING—INTELLECTUAL PROPERTY, 2200 Wells Fargo Center, 90 South Seventh Street

Minneapolis, MN 55402-3901

Date of Service: August 24, 2012; or

- ☐ b. A duplicate copy is enclosed because service on patent owner was not possible. An explanation of the efforts made to serve patent owner **is attached**. See MPEP 2620.

15. Third Party Requester Correspondence Address: Direct all communications about the reexamination to:

- ☒ The address associated with Customer Number: 30955

OR

- ☐ Firm or  
Individual Name \_\_\_\_\_

Address \_\_\_\_\_

City \_\_\_\_\_

State \_\_\_\_\_

Zip \_\_\_\_\_

Country \_\_\_\_\_

Telephone \_\_\_\_\_

Email \_\_\_\_\_

16. ☒ The patent is currently the subject of the following concurrent proceeding(s):

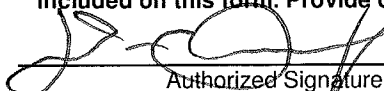
- ☐ a. Copending reissue Application No. \_\_\_\_\_
- ☐ b. Copending reexamination Control No. \_\_\_\_\_
- ☐ c. Copending Interference No. \_\_\_\_\_

- d. Copending litigation styled:

Federal court in the District of Colorado, Case 1:06-cv-00605-PSF-BNB, Crocs., Inc. v. \_\_\_\_\_

Acme EX-IM Inc., et al. \_\_\_\_\_

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**



Authorized Signature

August 24, 2012

Date

Dan Cleveland, Jr.

Typed/Printed Name

36,106

Registration No., if applicable

**REQUEST FOR *INTER PARTES* REEXAMINATION  
OF U.S. PATENT NUMBER D517,789 UNDER 35 U.S.C. §§ 311-318**

U.S.A. Dawgs, Inc. (“Requestor”) respectfully requests *inter partes* reexamination of the sole claim of U.S. Patent Number D517,789 (“the ‘789 Patent”) titled “FOOTWEAR.” The ‘789 Patent was filed on May 28, 2004 and issued on March 28, 2006, and it has not yet expired. A copy of the ‘789 Patent, in the format specified by 37 C.F.R. § 1.915(b)(5), is attached as Exhibit 2.<sup>1</sup> The patent is owned of record by Crocs, Inc. with security interests being held by Union Bank of California, N.A. and PNC Bank, National Association.

The fee set forth in 37 C.F.R. § 1.20(c)(2) accompanies this request. If any additional fee is necessary for this Request to be fully considered, please charge Deposit Account No. 12-0600.

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<sup>1</sup> A complete listing of all accompanying Exhibits is set forth in Exhibit 1.

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**I. REAL PARTY IN INTEREST UNDER 37 C.F.R. § 1.915(b)(8)**

The real party in interest is U.S.A. Dawgs, Inc., of 4120 W Windmill Ln., Unit 106, Las Vegas, Nevada.

**II. CERTIFICATION UNDER 37 C.F.R. § 1.915(b)(7)**

Requestor certifies that the estoppel provisions of § 1.907 do not prohibit the requested *inter partes* reexamination.

**III. CERTIFICATION UNDER 37 C.F.R. § 1.915(b)(6)**

Requestor certifies that a copy of this Request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). Specifically, this Request for *Inter Partes* Reexamination is being served on the correspondent of record for the '789 Patent:

Faegre Baker Daniels LLP  
PATENT DOCKETING—INTELLECTUAL PROPERTY  
2200 Wells Fargo Center  
90 South Seventh Street  
Minneapolis, MN 55402-3901

**IV. IDENTIFICATION OF EVERY CLAIM FOR WHICH REEXAMINATION IS REQUESTED (37 C.F.R. § 1.915(b)(1)) AND CITATION OF PRIOR ART PRESENTED TO SHOW THAT THERE IS A REASONABLE LIKELIHOOD THAT THE REQUESTER WILL PREVAIL**

Reexamination of the sole claim of the '789 Patent is requested based on the following references, which are presented to show that there is a reasonable likelihood that the requester will prevail:

Reference	Exhibit
UK Patent Application GB 2,322,286 ("GB '286")	3
U.S. Patent Number 6,237,249 to Aguerre ("Aguerre '249")	4
U.S. Patent Number D422,780 to Aguerre ("Aguerre '780")	5

U.S. Patent Number D473,040 to Hawker ("Hawker '040")	6
Softmoc Sales Literature dated September 11, 2002 (Softmoc)	7
Copyright Assignment Agreement from L'Artigiana Stampi to Finproject NA. effective October 1, 2000 ("Battistion Designs")	8
Crocs Sales Literature Archived October 16, 2002	9
Crocs Sales Literature Archived December 13, 2002	10
Crocs Sales Literature Archived May 26, 2003	11

**V. STATEMENT SHOWING THAT THERE IS A REASONABLE LIKELIHOOD THAT THE REQUESTER WILL PREVAIL ON AT LEAST ONE CLAIM, BASED ON THE PRIOR ART SET FORTH ABOVE**

**A. Background**

The '789 patent (Ex. 2) now at issue is a design patent illustrating a clog-style of shoe to which a strap has been added. Figures 1 and 2 are illustrative.

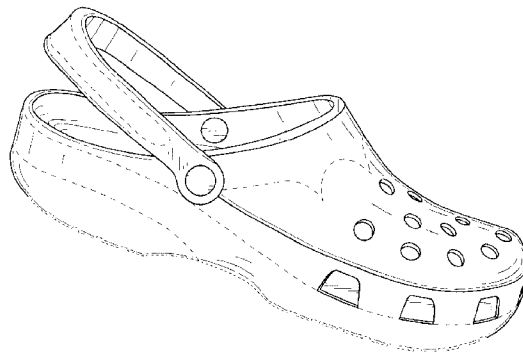


FIG.1

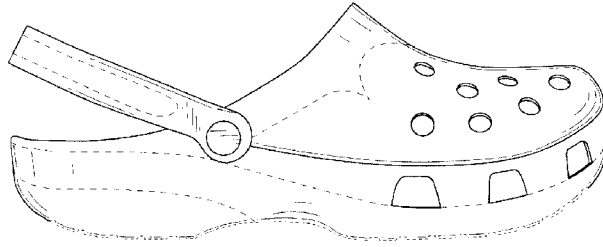


FIG.2

The application that resulted in issuance of the '789 Patent (Ex. 2) was filed on May 28, 2004 and received a notice of allowance dated August 18, 2005 (Ex. 12). The file wrapper shows that the allowance occurred without the claim ever having been rejected over the prior art. The only comment in the file wrapper that concerns the prior art is a Supplemental Notice of Allowability dated February 16, 2006 (Ex. 13). This Notice (Ex. 13) advises the Patent Owner that the Information Disclosure statement filed on August 29, 2005 and November 14, 2005 were filed after payment of the issue fee. Accordingly, the contents of these Information Disclosure Statements were not considered. The Notice (Ex. 13) advised the Patent owner that the application could be withdrawn from allowance, in order to have the prior art considered, but the application was not withdrawn in accordance with this advice.

**B. Discussion of Certain Prior Art Printed Publications.**

The following references present a material question of patentability for reasons discussed below.

**1. Softmoc (Ex. 7)**

Softmoc (Ex. 7) provides the primary reference to show, with one exception, a base shoe that is identical in every material aspect as compared to what is shown and claimed in the '789 Patent (Ex. 2). The one exception is a strap, which may be provided using other printed publications described below. As Softmoc (Ex. 7) a sales publication describing a shoe in existence, the disclosure of Softmoc may be expanded by inherency to encompass the perspective of each figure of the '789 patent.



Softmoc (Ex. 7) either expressly or by inherency shows all design features of the base section of the footwear that is described and claimed in the '789 Patent (Ex. 2). There is not a mere resemblance. The two designs are identical:



**Aqua Garden  
Clogs**

UNISEX AQUA, BLUE  
Unisex Blue Aqua Clog

Reg: CA\$19.95

Sale: CA\$14.95

REG. U.S. PAT. & TM. OFF.

## **2. Crocs Sales Literature.**

Exhibits 9, 10 and 11 are copies of sales literature archived from the website at <http://crocs.com> on dates ranging from October 16, 2002 to May 26, 2003 as indicated in the upper right hand corner of the exhibits. The archival service is commonly referred to as the Wayback Machine at the URL <http://web.archive.org>. These exhibits show shoes that are identical to the footwear that is described and claimed in the '789 Patent (Ex. 2).

## **3. Aguerre '780 (Ex. 5) and Aguerre '249 (Ex. 4)**

Included among the references not considered by the Examiner in the Information Disclosure Statement filed on November 14, 2005 (Ex. 14) was D422,780 to Aguerre (Ex. 5). This shows a shoe that is open at the rear end and which has been provided with a thick strap attached to the upper of the shoe by a mushroom-headed rivet, i.e.:

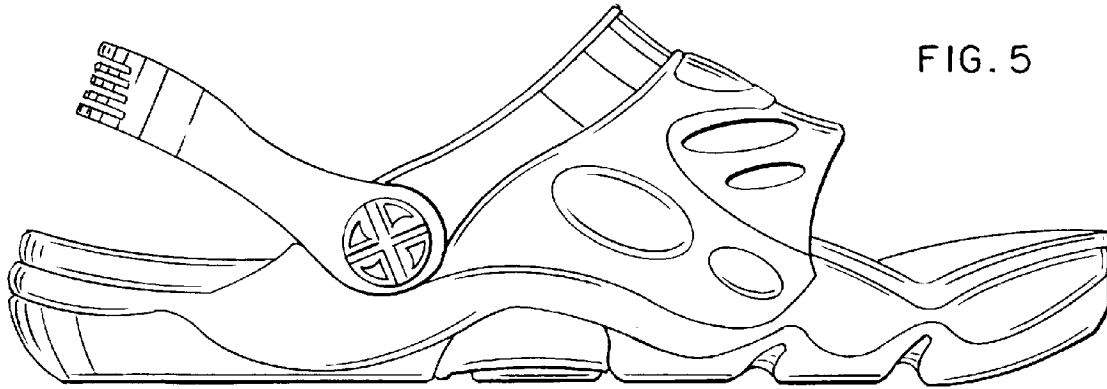


FIG. 5

Aguerre '249 (Ex. 4) shows this same shoe except the rivet, here numbered as rivet 138, presents a smooth head that does not have a design as indicated by lining in Fig. 5 of Aguerre '780. This confirms that the rivet head may be provided with a design or interchanged with a smooth rivet head not having a design:

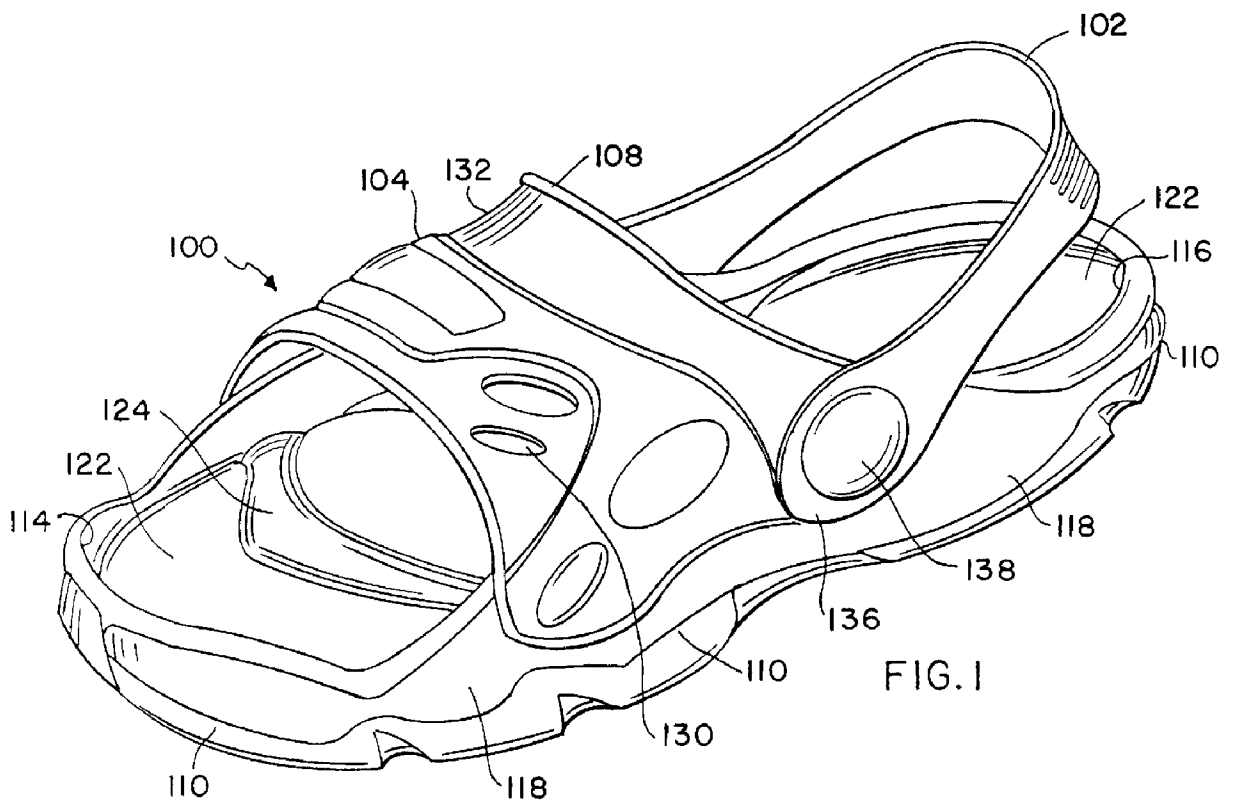


FIG. 1

## **C. The Claim of the '789 Patent Is Invalid**

### **1. Anticipation By Crocs Sales Literature.**

The claim of the '789 patent is anticipated pursuant to 35 U.S.C. §102 by multiple instances of Crocs Sales Literature (Ex. 9, 10, 11). Since the effective priority date of the '789 patent disclosure is May 28, 2004, any printed publication showing the Crocs Beach model shoe (Ex. 20) prior to May 28, 2003 constitutes an anticipatory reference. These Exhibits show shoes that are identical in all material elements with respect to the drawings of the '789 patent, and so constitute an anticipation. These exhibits were archived by the Wayback machine located at the URL <http://web.archive.org>. The archival date is provided at the upper right hand corner, and all such dates are before May 28, 2003.

### **2. Obviousness over Softmoc (Ex. 7) in view of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4).**

The claim of the '789 patent is invalid pursuant to 35 U.S.C. §103(a) as being obvious over Softmoc (Ex. 7) in view of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4). According to MPEP §1504.03, obviousness of designs is assessed by providing a first reference of something in existence, which in this case is the Aqua Clog design shown in Softmoc (Ex. 7). Next, there is an assessment of the differences between the prior art and the claimed design. The design of Softmoc (Ex. 7) is identical in all respects to the claimed design, except for the heel strap. The design may be modified by the addition of the heel strap of either Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4) to arrive at a shoe that is virtually indistinguishable from the claimed design. Motivation to modify Softmoc (Ex. 7) by addition of the strap would have been to retain the shoe on the foot of the wearer as taught by Aguerre '249 (Ex. 4; see Abstract thereof, as well as in col. 2 at lines 7-36).

Moreover, the shoes of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4) are closely related in appearance to the Aqua Clog of Softmoc (Ex. 7), such that the appearance of the strap in Aguerre '780 or Aguerre '249 suggests this as a modification to the Aqua Clog. The commonalities of design contributing to this closely related appearance includes, first, all items being shoes. These shoes are further similar in design where they share an open rear construction with an upwardly molded rim making. The base shoe is also formed in the nature of a slide. There are also ventilation holes in the tops and sides of all these shoes, which have also an overall appearance

of having been injection molded. Thus, the references are properly combinable under MPEP §1504.03.

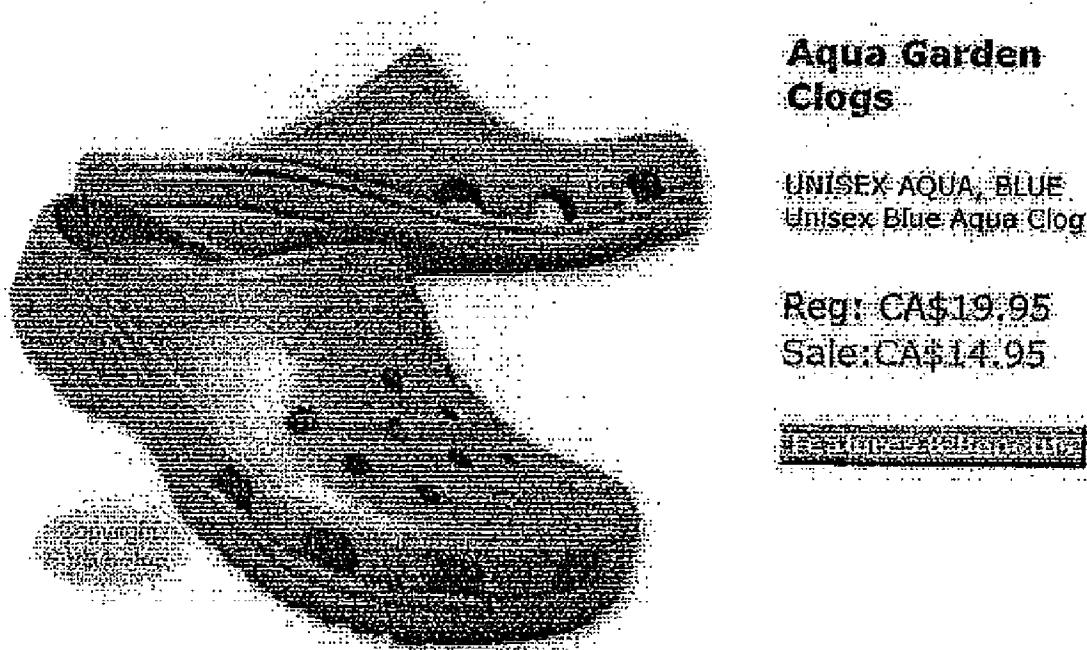
**VI. DETAILED EXPLANATION OF THE PERTINENCY AND MANNER OF APPLYING THE PRIOR ART TO EVERY CLAIM FOR WHICH REEXAMINATION IS REQUESTED (37 C.F.R. § 1.915(b)(3))**

**A. Description of Certain Prior Art References.**

These printed publications will be applied below in a showing of invalidity.

**1. Softmoc (Ex. 7) As clarified by the inherent showing of Canadian Action (Ex. 15) and Battistion Designs (Ex. 8).**

Softmoc (Ex. 7), dated September 11, 2002, shows a product identified as the Aqua Garden Clog. This clog is identical to the base section as shown and described in the drawings of the '789 patent (Ex. 2). Scott Seamans, the sole named inventor of the '789 patent, adopted this base section wholly from the prior art and merely added a strap. Softmoc (Ex. 7) shows:



Softmoc (Ex. 7) may be applied for the inherency of its disclosure, in addition to what it expressly shows and says. Extrinsic evidence may be used to show inherent features of such printed publications as Softmoc:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

*Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991); cited with approval in *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) ("a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference").

Inherency is not limited to cases of pure anticipation. It is moreover the case that intrinsic features of the prior art may be applied in obviousness rejections.<sup>2</sup> Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *In re Zurko*, 258 F.3d 1379, 1383-1384 (Fed. Cir. 2001). Thus, Requester is entitled to submit extrinsic evidence to show the inherency of what is disclosed in Softmoc (Ex. 7). The burden of proof is to show that the disclosure of the Aqua Garden Clog as shown in Ex. 7 necessarily has all elements of the '789 patent claim.

The inherency is established by Canadian Action (Ex. 15), which is a copy of a pleading filed in Canadian Federal Court by Foam Creations Inc. versus Holey Soles Holdings Ltd. On information and belief, Foam Creations Inc. was a wholly owned subsidiary of the Patent Owner, Crocs, Inc. at the time of this litigation. Exhibit 16 accompanying this Petition is the Patent Owner's 10-K for 2005, which says "[i]n June 2004, we acquired Foam Creations."

Canadian Action (Ex. 15) proves that the Aqua Clog of Softmoc (Ex. 7) invariably and without exception teaches hidden elements of what is claimed the '789 patent. The shoes are made of injection molded foam (Ex. 15; Para. 5). The Crocs Beach model shoe there depicted is identical to the shoe shown and described in the '789 patent (see Ex. 15; Para. 6 referencing this as "Foam's Designs.") Paragraph 7 states that Foam's Designs were created by Ettore Battistion **and were first published in April 2002**. Stampi, Mr. Battistion's employer, owned these

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<sup>2</sup> *In re Kubin*, 561 F.3d 1351, 1357-1358 (Fed. Cir. 2009) cites with approval *In re Wiseman*, 596 F.2d 1019, 1023 (CCPA 1979) "(rejecting the notion that 'a structure suggested by the prior art, and, hence, potentially in the possession of the public, is patentable . . . because it also possesses an inherent, but hitherto unknown, function which [patentees] claim to have discovered. This is not the law. A patent on such a structure would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art.' "

designs. Paragraph 8 says that Foam's President, Mr. Andrew Reddyhoff viewed a shoe as depicted in Para. 6 "minus the strap" during a trip to Italy in 2000. Mr. Reddyhoff then purchased a mold to create Foam's Initial Shoe, "which would eventually be marketed under the trade mark AQUA CLOG." The Aqua Clog is the Aqua Clog garden shoe shown in Softmoc (Ex. 7). Although the picture quality is poor, Canadian Action (Ex. 15 at Para. 6) shows the Battistion/Stampi "TREAD DESIGN" of the Beach model shoe as having a flat middle section connecting forward and rearward sections of tread.

It is then further significant to show inherency that Paragraph 5 of Canadian Action (Ex. 15) admits to manufacturing shoes of the Beach model design by use of the REBOUND foam. Paragraph 18 admits that the shoes purchased from Foam Creations during this timeframe were marked with the trademark REBOUND located on the sole. Exhibit 17 attached to this Petition shows one of these REBOUND shoes, which is of the very same identical style as shown in Softmoc (Ex. 7). This design marked REBOUND (Ex. 17) constituted "Foam's Initial Shoe" as of 2002 (Ex. 15; Para. 18), which is the same "Foam's Initial Shoe" sold under the trademark Aqua Clog and the Beach model (Ex. 15; Para. 8). Thus, all of these features are inherent to the Aqua Garden Clog of Softmoc (Ex. 7).

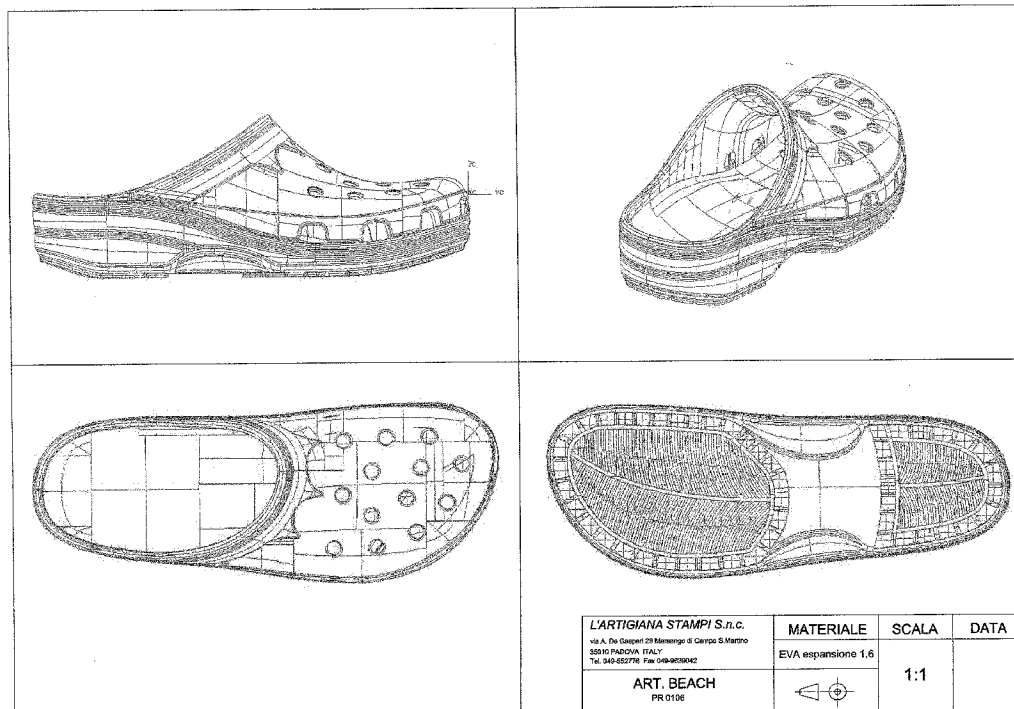
These facts, which are admitted by Crocs Inc's wholly owned subsidiary Foam Creations Inc., establish a link between the Aqua Clog of Ex. 7 and the designs of Ettore Battistion (Ex. 8) as published in April of 2002.<sup>3</sup>

Significantly, Paragraph 10 of Canadian Action (Ex. 15) says that Foam Creations acquired the Stampi designs to Foam's Initial Shoe pursuant to an agreement effective October 1, 2000. A copy of that assignment is attached as Ex. 7, showing an assignment by Stampi to Finproject. N.A. as executed by Mr. Battistion (here spelled "Battiston"). Note that Para. 2 of

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<sup>3</sup> Petitioner of course realizes that, pursuant to 37 C.F.R. §1.906(a) and (c), *inter partes* reexamination is conducted only on the basis of patent or printed publications. Thus, to be perfectly clear, Canadian Action (Ex. 15) Battistion Designs (Ex. 7) and the Rebound shoe of Ex. 17 constitute evidence extrinsic here submitted only for the purpose of showing the inherent nature of Softmoc (Ex. 7). Petitioner acknowledges that Canadian Action provides admissions which raise significant questions about other issues of inventorship, inequitable conduct before the Patent Office, and prior art on-sale activity constituting a one-year bar with respect to what is claimed in the '789 patent. Petitioner understands that these other issues cannot be resolved because they are not properly the subject matter of inter partes reexamination. Thus, Canadian Action (Ex. 15) is submitted only for the limited purpose of showing inherency, and not to address these other issues which cannot be properly presented at this time. There is, accordingly, no estoppel effect with respect to these other issues by operation of 35 U.S.C. §315(c). Petitioner has been named as a defendant in a federal patent lawsuit in the District of Colorado identified as Civil Action No. 06cv00605-PSF-BNB, which is the appropriate forum in which to raise these other issues.

Exhibit 15 specifies that Foam Creations was formerly known as Finproject. This further confirms that the "Beach" design is identical to the Aqua Clog and the base section of the shoe that is shown and described in the '789 patent. Thus, it is conclusively established that Softmoc (Ex. 7) inherently shows these features of Mr. Battistion's design:



## B. The Priority Date Is May 28, 2004.

A question exists as to what is the effective priority date for the claim of the '789 patent. The '789 patent was filed on May 28, 2004, but claims priority as a continuation-in-part (C-I-P) back to two applications filed on May 23, 2003, namely, applications 10/602,416 (Ex. 18) and 10/603,126 (Ex. 19). Exhibit 18 accompanying this Petition contains a copy of the Specification and drawings for 10/602,416 and Exhibit 19 contains a copy of the Specification and drawings for 10/603,126. The drawings for both cases are identical, so the discussion below references those for 10/602,416 (Ex. 18). The '789 Patent (Ex. 2) also claims priority as a C-I-P from

10/803,569 (Ex. 21). The drawings of this case are not the same as the other two (Ex. 18, 19) because more drawings have been added; however, the relevant figures 1-6 are the same. Thus, the same comparison as shown below in Table 1 may be made with respect to the drawings of any of 10/602,416, 10/603,126, or 10/803,569.<sup>4</sup>

The '789 Patent (Ex. 2) cannot connect with the priority of either 10/602,416 (Ex. 18) or 10/603,126 (Ex. 19) because the '789 Patent discloses and claims new matter. The designation of the '789 patent as a C-I-P establishes that the application filed on May 28, 2004 may have contained new matter with respect to the disclosures of 10/602,416 (Ex. 18) or 10/603,126 (Ex. 19). Although it is permissible for a design patent to claim priority back to a parent utility case, whether or not this priority has been established is a finding for the court as a matter of law. *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998). The inquiry is whether the disclosure of the parent utility application provides full and complete support for what is later claimed as the design, in terms that are sufficient to meet the requirements of 35 U.S.C. §112:

It is the drawings of the design patent that provide the description of the invention. *In re Klein*, 987 F.2d 1569, 1571, 26 U.S.P.Q.2D (BNA) 1133, 1134 (Fed. Cir. 1993) ("usually in design applications, there is no description other than the drawings"). Although linguists distinguish between a drawing and a writing, the drawings of the design patent are viewed in terms of the "written description" requirement of § 112. Thus when an issue of priority arises under § 120, one looks to the drawings of the earlier application for disclosure of the subject matter claimed in the later application . . . The inquiry is simply to determine whether the inventor had possession at the earlier date of what was claimed at the later date.

*In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998).

The relevant inquiry may be stated in a number of different ways:

Thus the earlier application must meet the written description requirement of § 112. The test for sufficiency of the written description is the same, whether for a design or a utility patent. This test has been expressed in various ways; for example, "whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina*

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<sup>4</sup> The Undersigned observes that the face of the '798 Patent (Ex. 2) does not recite a priority claim to provisional applications 60/473,371 or 60/473,360 filed May 23, 2003; however, the Patent Application Information Retrieval System ("PAIR") states that there is a priority claim to these provisional applications. Indeed, the patent Owner attempted to claim this priority during prosecution of the '789 patent, but to no avail. The priority claim is invalid for two reasons. First, even assuming that the provisional applications show possession or written description of what is claimed (which they do not), as shown in Table 1 there is no continuity of disclosure in any of 10/602,416 (Ex. 18), 10/603,126 (Ex. 19), or 10/803,569 (Ex. 21). Moreover, a design application is not entitled to claim priority to a provisional patent application, pursuant to 35 U.S.C. §172 "[t]he right of priority provided for by section 119(e) of this title [i.e., priority to provisional patent applications] shall not apply to design patents."



*Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 U.S.P.Q. (BNA) 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. (BNA) 1089, 1096 (Fed. Cir. 1983)). When the earlier disclosure is less than clear on its face, courts have explained that the prior application must "necessarily" have described the later claimed subject matter. *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1423, 5 U.S.P.Q.2D (BNA) 1194, 1198 (Fed. Cir. 1987). In general, precedent establishes that although the applicant "does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed." *In re Gosteli*, 872 F.2d at 1012, 10 U.S.P.Q.2D (BNA) at 1618 (citations omitted).

*In re Daniels* at 1456.

In fact, the '789 Patent (Ex. 2) does disclose and claim new matter and, consequently, is unable to establish priority back to June 23, 2003. The new matter is partially disclaimed, but not wholly disclaimed.

Table 1 below is provided as a convenient way of comparing the claims the '789 Patent drawings of Ex. 2 to the priority applications 10/602,416 (Ex. 18) and 10/603,126 (Ex. 19). The drawings of these applications being identical, those of 10/602,416 are referenced in Table 1. It is well settled that to qualify for an earlier filing date by recitation of a claim to priority under 35 U.S.C. §120, the claims can address no new matter:

To qualify for an earlier filing date, section 120 requires, inter alia, that the earlier-filed U.S. patent application contain a disclosure which complies with 35 U.S.C. § 112, P 1 (1994) for each claim in the newly filed application. Thus, this benefit only applies to claims that recite subject matter adequately described in an earlier application, and does not extend to claims with subject matter outside the description in the earlier application. . . . In other words, a claim complies with 35 U.S.C. § 120 and acquires an earlier filing date if, and only if, it could have been added to an earlier application without introducing new matter.

*Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564 (Fed. Cir. 1997).

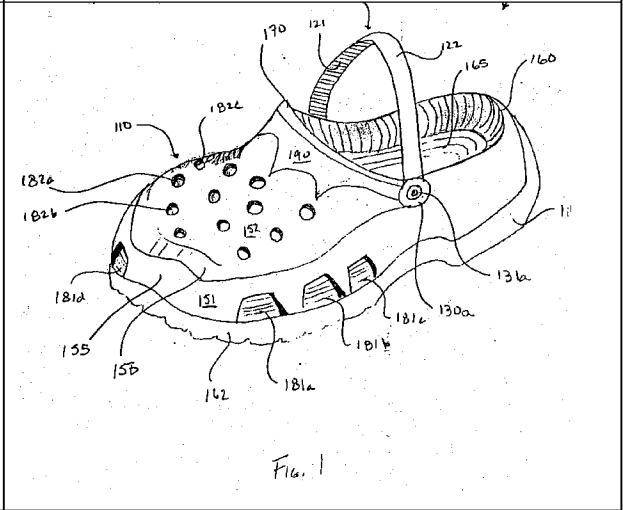
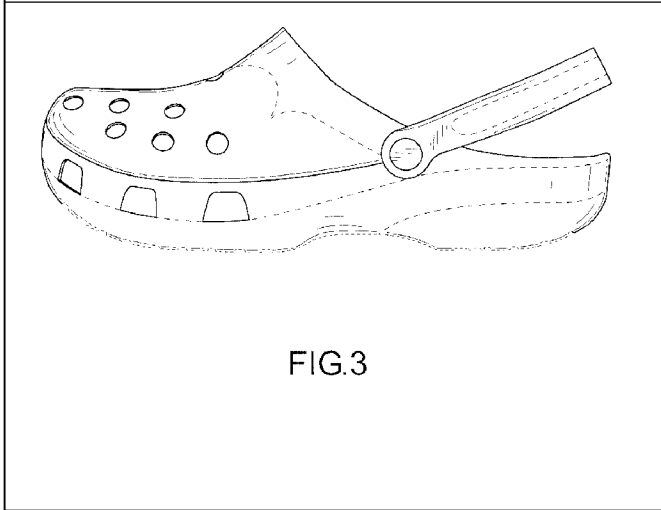
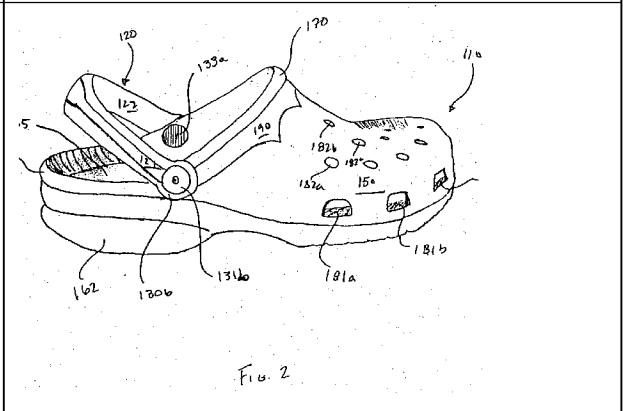
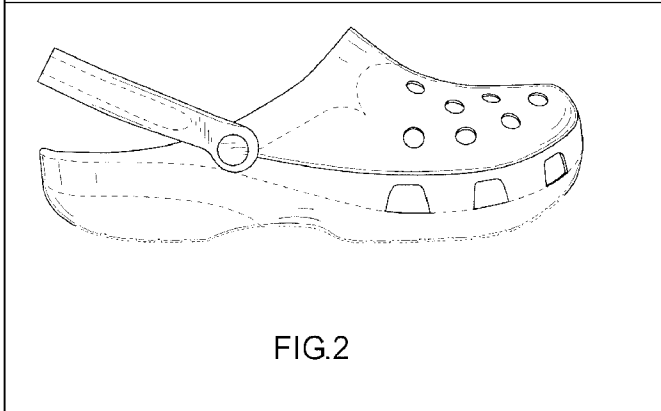
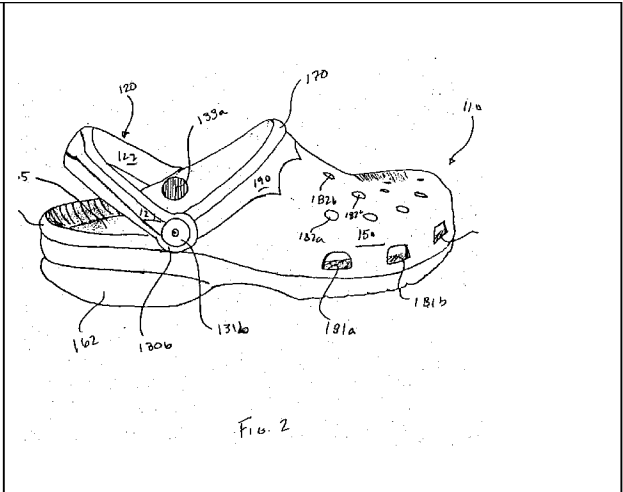
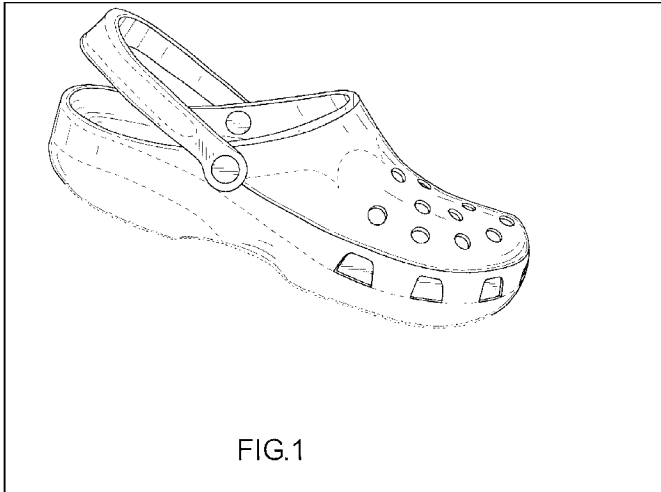
To be perfectly clear, 10/602,416 shows a number of different embodiments, which are illustrated in isolated single figures except for the shoe of Figs. 2-6. The remaining embodiments are for different shoes that are not sufficiently illustrated from different perspectives to provide adequate §112 support for the respective views of the '789 patent. New matter shown not to be possessed by the parent case includes (*see also* Table 1 below):

- A rising toe at the sole shown in the comparison of Fig. 4 from the '789 patent (Ex. 2) to Fig. 4 of 10/602,416 (Ex. 18).

- A rising heel at the sole at the sole shown in the comparison of Fig. 4 from the '789 patent (Ex. 2) to Fig. 4 of 10/602,416 (Ex. 18).
- A different number of holes and different spatial arrangement of the sidewall ventilator holes visible at the toe shown in the comparison of Fig. 4 from the '789 Patent (Ex. 2) to Fig. 4 of 10/602,416 (Ex. 18).
- Figs 1 and 2 of the '789 Patent (Ex. 2) show three ventilator holes in the sidewall and above these holes is a line demarcating the sidewall. The comparable view of Fig. 2 from 10/602,416 (Ex. 18) lacks this line. A similar line is shown in Fig. 1 of 10/602,416 (Ex. 18), but there are no other views of this alternative embodiment.
- Fig. 2 of the '789 Patent (Ex. 2) shows a lip indicated as numeral 170 at the top of the upper opening. This lip is missing in the drawings of 10/602,417 (Ex. 18).
- The strap at the apex of curvature (at the heel) of the strap in the '789 Patent drawings is of uniform width. Figs. 2 and 3 of 10/602,416 (Ex. 18) show a slight beelling of the strap at the rearmost apex of curvature.
- As shown in the comparisons of Figs. 1 and 2, the heel strap has a head located at the rivet that attaches the shoe to the upper of the base section. In the '789 patent, this head has the shape of a "d" formed as a straight line at the upper edge of the strap and a belly pointing down. The corresponding Figs. of the '416 patent lack the straight back, presenting there an upwardly rounded section giving the appearance of a lollipop, as opposed to the "d" of the patented design.

**Table 1:** A showing of new matter claimed in the '789 Patent (Ex. 2) by comparison to the drawings of priority application no. 10/602,416 (Ex. 18).

Figures From The '789 Patent (Ex. 2)	Figures from 10/602,416 (Ex. 18)
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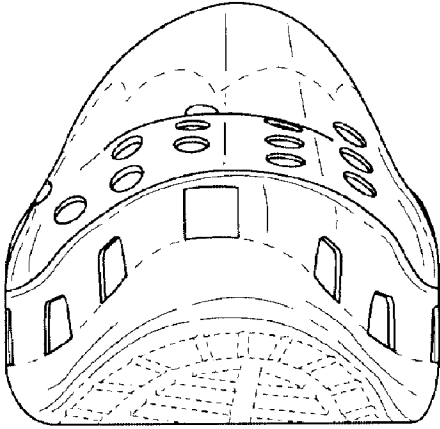


FIG. 4

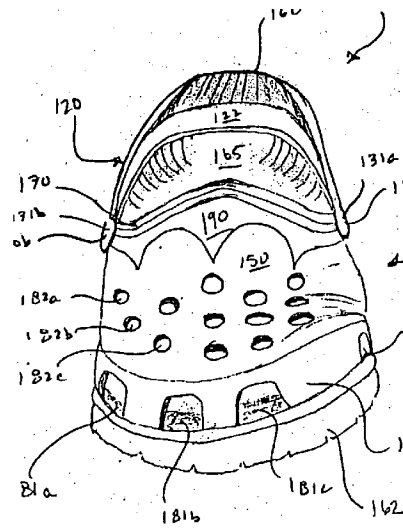


FIG. 4

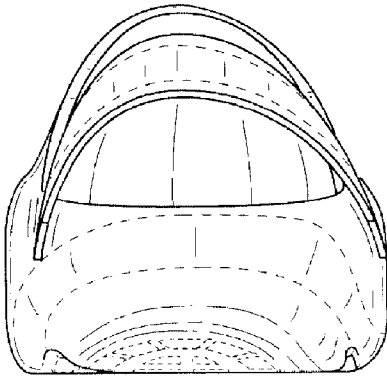


FIG. 5

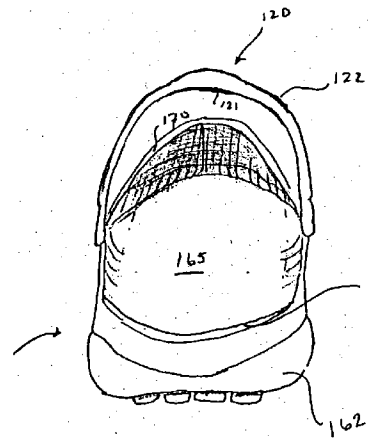
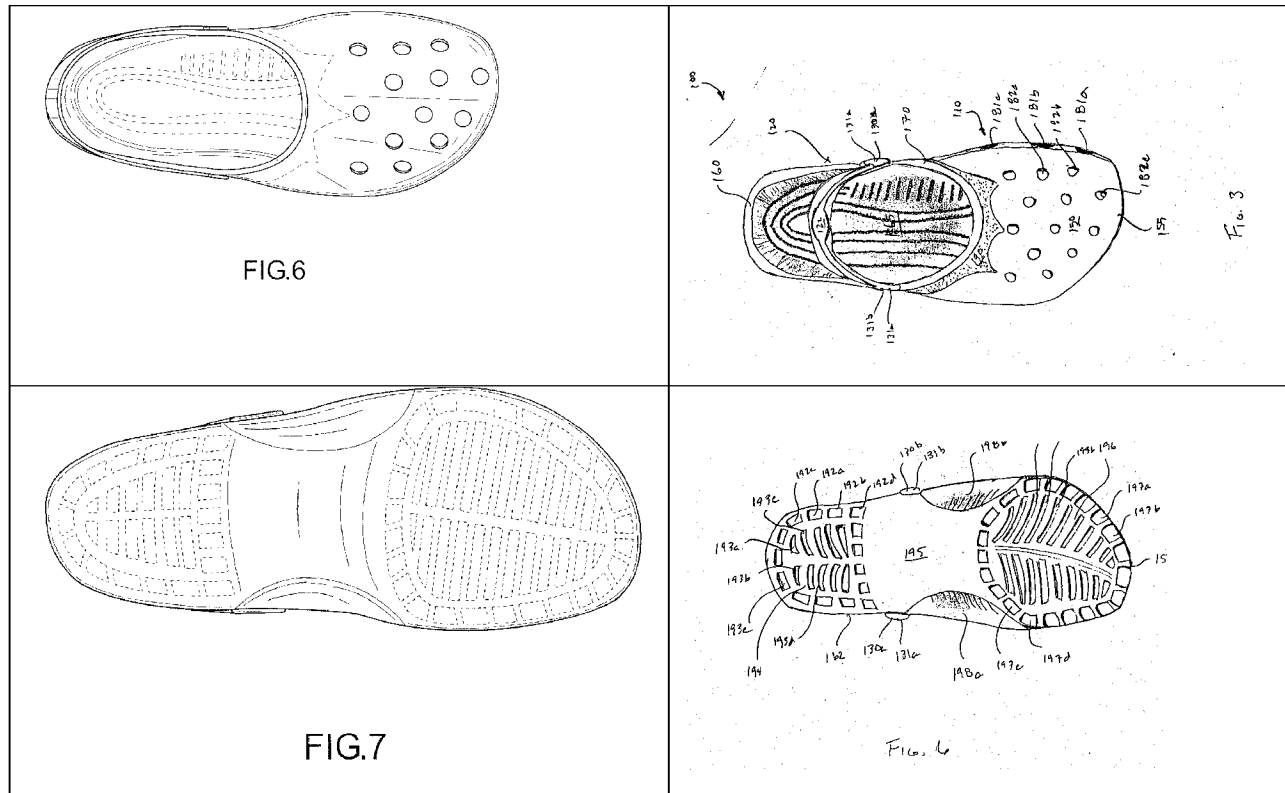


FIG. 5



Taken altogether, these differences show a great many design changes. The change to the strap is particularly poignant since, as will be shown below, the base section of the shoe without the strap was largely copied from the prior art. The priority application fails to show possession of all aspects of what is claimed. *See In re Mann*, 861 F.2d 1581, 1582, 8 U.S.P.Q.2D (BNA) 2030, 2031 (Fed. Cir. 1988) ("If . . . the design is changed, the result is a new and different design; the original design remains just what it was. Design patents have almost no scope."). Therefore, the '789 patent cannot connect with the priority date of June 23, 2003.

### C. Showing of Claim Invalidity

The claim of the '789 Patent (Ex. 2) is invalid for the reasons discussed below.

#### 1. Crocs Sale Literature.

The claim of the '789 patent is anticipated pursuant to 35 U.S.C. §102 by multiple instances of Crocs, Inc.'s own sales literature (Ex. 9, 10, 11). Since the effective priority date of the '798 patent disclosure is May 28, 2004, any printed publication showing sales of the Beach model shoe prior to May 28, 2003 constitutes an anticipatory reference. The claim is anticipated by any of Exhibits 9, 10, and 11. All of these Exhibits show shoes that that are identical in all

material respects to the drawings of the '789 patent, and so constitute an anticipation. These exhibits were archived by the Wayback machine located at the URL <http://web.archive.org>. The archival date is provided at the upper right hand corner, and all such dates are before May 28, 2003. Exhibits 9, 10 and 11 all show the Beach shoe as documented also in Canadian Action (Ex. 15). This shoe is indistinguishable in all material aspects of what is described and claimed with respect to the '789 patent (Ex. 2).

The ordinary observer test for anticipation has long been established and recently affirmed:

that if, 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 Mfg. Co. v. White*, 81 U.S. 511, 528, 20 L. Ed. 731 (1871); *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009) (The "ordinary observer test must logically be the sole test for anticipation.").

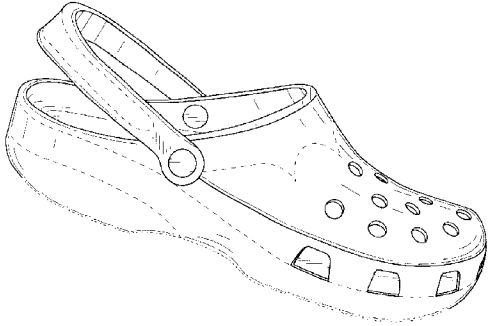
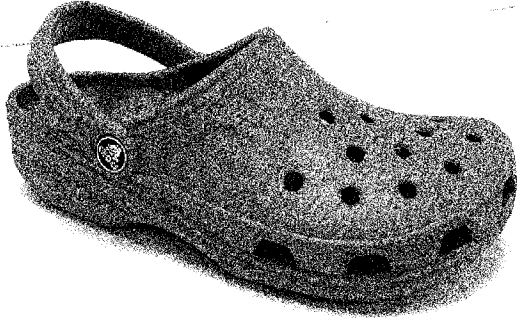
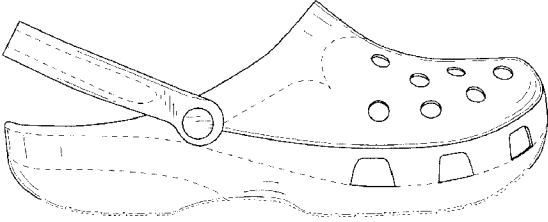
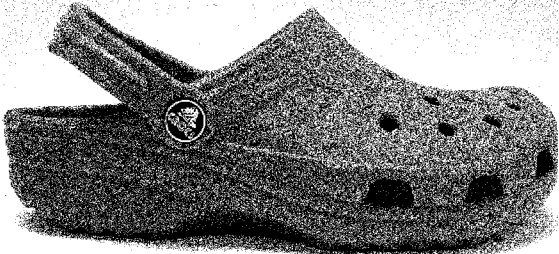
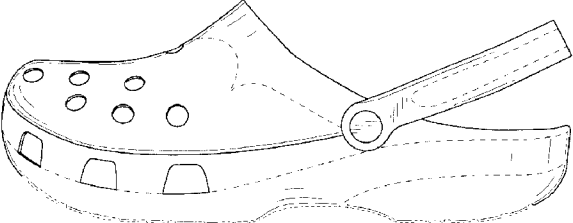
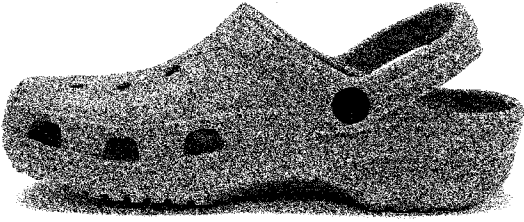
Because emphasis is upon the overall impression that the design makes upon the ordinary observer, minor or trivial differences in design shall not prevent a finding of anticipation:

We agree with the district court that these minor variations in the shoe are insufficient to preclude a finding of anticipation because they do not change the overall visual impression of the shoe. Although the ordinary observer test requires consideration of the design as a whole, . . . [citations omitted] this does not prevent the district court on summary judgment from determining that individual features of the design are insignificant from the point of view of the ordinary observer and should not be considered as part of the overall comparison. The mandated overall comparison is a comparison taking into account significant differences between the two designs, not minor or trivial differences that necessarily exist between any two designs that are not exact copies of one another. Just as "minor differences between a patented design and an accused article's design cannot, and shall not, prevent a finding of infringement," . . . [citation omitted] so too minor differences cannot prevent a finding of anticipation.

*Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243 (Fed. Cir. 2009).

Table 2 below meets the standard for anticipation by showing an overall identity of design between the drawings of the '789 Patent (Ex. 2) and a sample of the Crocs Beach model shoe (Ex. 20) that has been in existence since before May 28, 2003 as is inherent to the Crocs Sales Literature of any of Exhibits 9, 10 and 11.

**TABLE 2:** A comparison of the '789 patent drawings versus Crocs Sales Literature (Ex. 9, 10, 11) as clarified by the inherent showing of Crocs Beach model shoe (Ex. 20).

Figures From The '789 Patent	Crocs Beach model shoe
 <p data-bbox="402 783 477 814">FIG.1</p>	
 <p data-bbox="443 1171 518 1203">FIG.2</p>	
 <p data-bbox="456 1570 537 1602">FIG.3</p>	

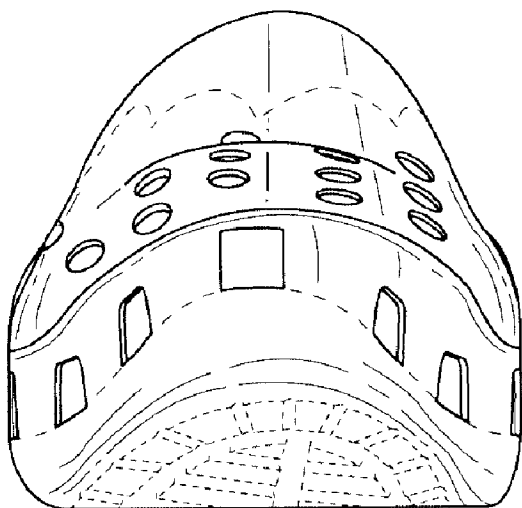


FIG.4

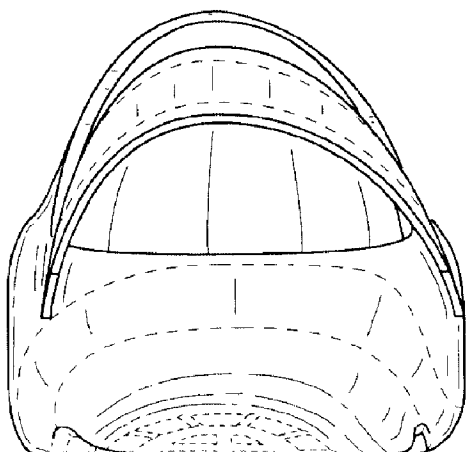
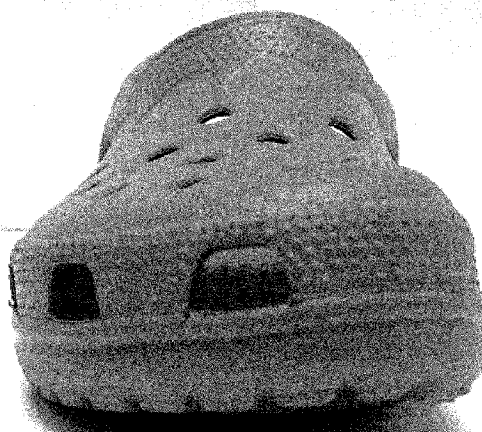
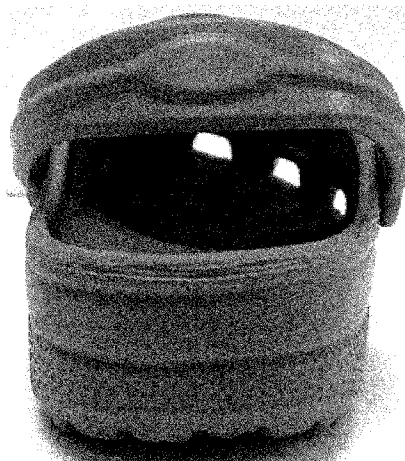
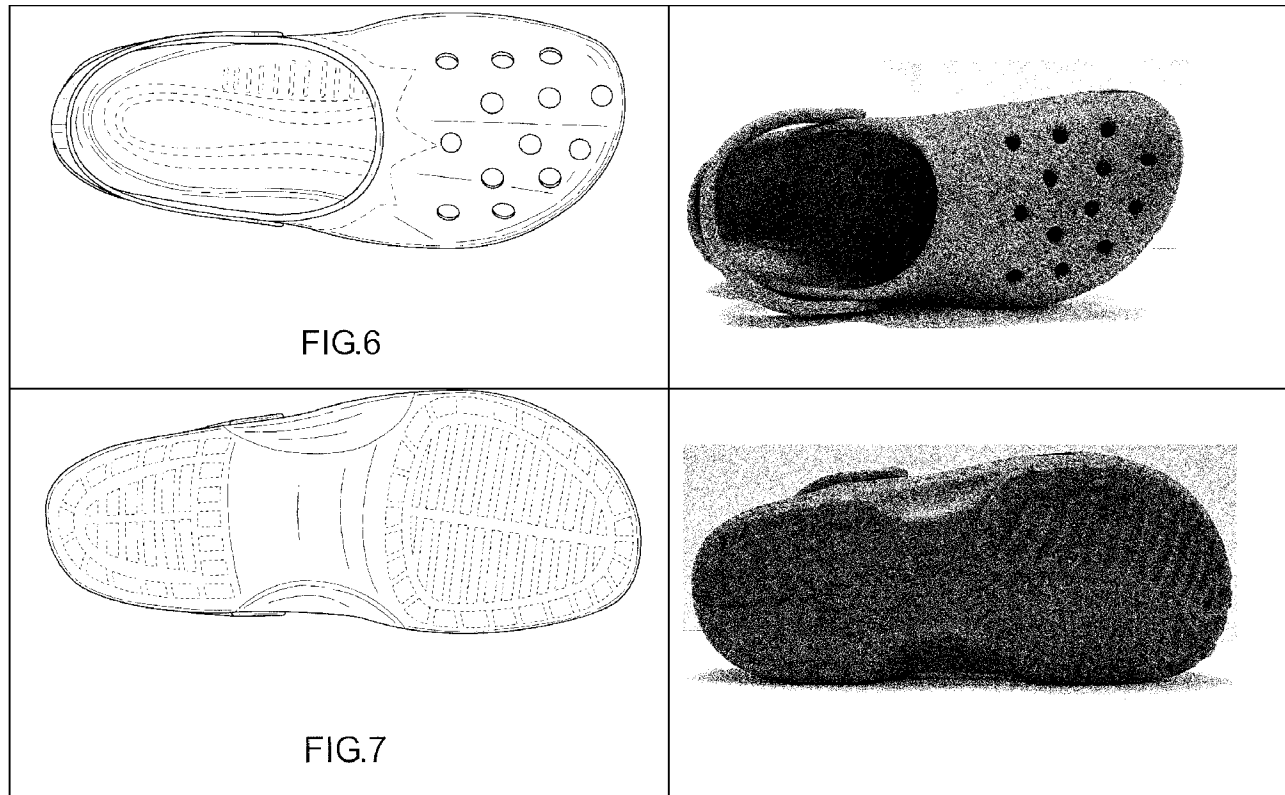


FIG.5







**2. Softmoc (Ex. 7) in View of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4 ) As Guided By GB '286 (Ex. 3).**

The claim of the '789 patent is invalid by reason of obviousness pursuant to 35 U.S.C. §103(a) over Softmoc (Ex. 7) in view of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4) as guided by GB '286 (Ex. 3). According to MPEP §1504.03, obviousness of designs is assessed by providing a first reference of something in existence, which in this case is the Aqua Clog design shown in Softmoc (Ex. 7). Next, there is an assessment of the differences between the prior art and the claimed design. The design of Softmoc (Ex. 7) is identical in all respects to the claimed design, except for the strap. The design may be modified by the addition of the strap of either Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4) to arrive at a shoe that is virtually indistinguishable from the claimed design. Motivation to modify Softmoc (Ex. 7) by addition of the strap would have been to retain the shoe on the foot of the wearer as taught by Aguerre '249 (Ex. 4). The

The commonalities of design contributing to this closely related appearance includes, first, all items being shoes. These shoes are further similar in design where they share an open rear construction with an upwardly molded rim making. The base shoe is also formed in the nature of a slide. There are also ventilation holes in the tops and sides of all these shoes, which have also an overall appearance of having been injection molded. This modification is further guided by GB '286, which shows a similar strap placed on a clog –style of shoe:

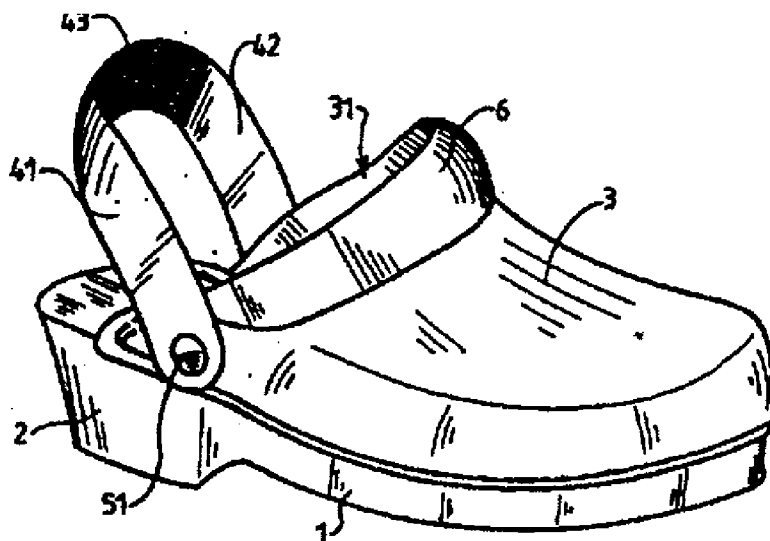
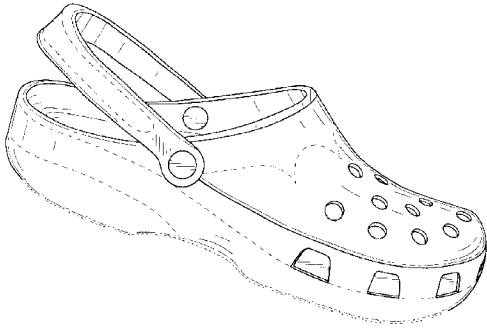
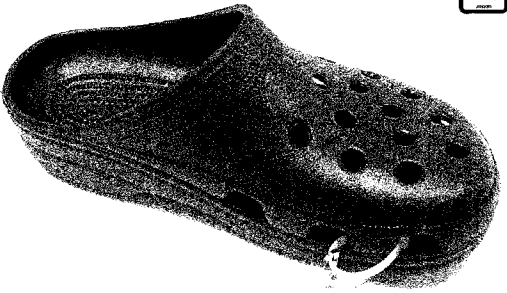
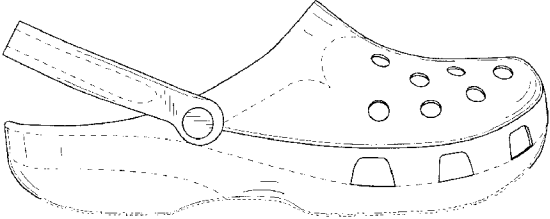
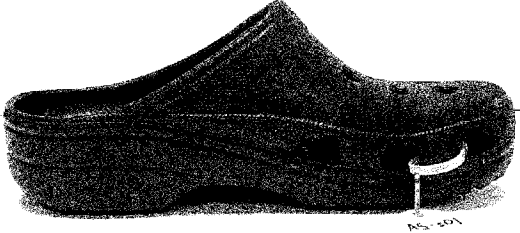
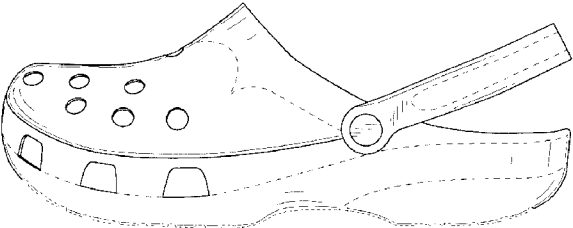
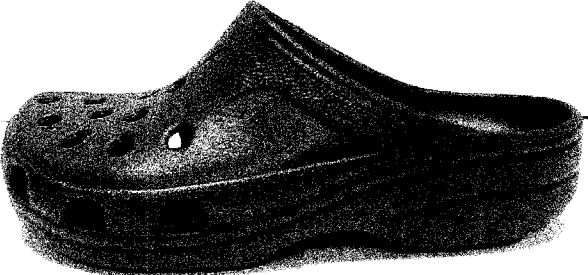


Table 3 below provides a comparison which, allowing for the mirror-image difference of a right shoe versus a left shoe, shows that the base shoe of Softmoc is identical in all respects to the base shoe of the claimed design.

<sup>5</sup> "Obviousness, like anticipation, requires courts to consider the perspective of the ordinary observer." *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1243-1244 (Fed. Cir. 2009)

Figures From The '789 Patent	Softmoc (Ex. 7)
 <p data-bbox="402 674 477 705">FIG. 1</p>	
 <p data-bbox="440 1058 521 1089">FIG. 2</p>	
 <p data-bbox="456 1461 537 1493">FIG. 3</p>	

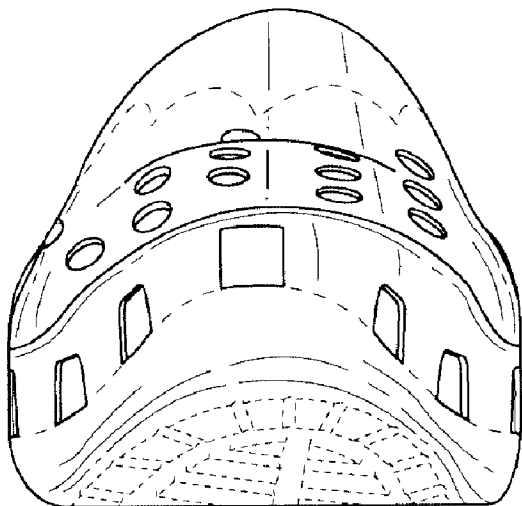


FIG.4

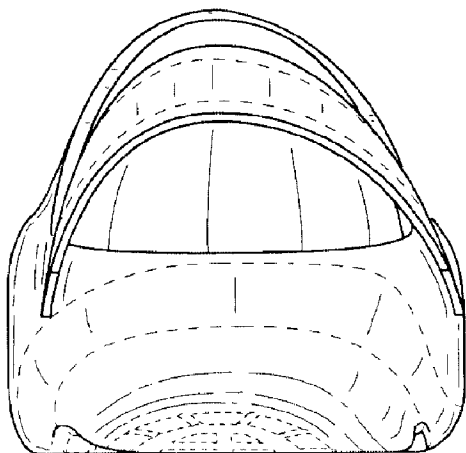
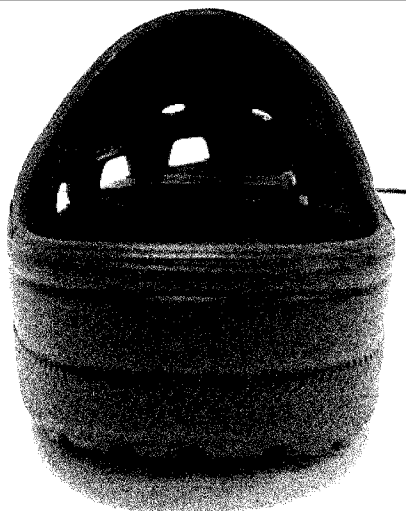
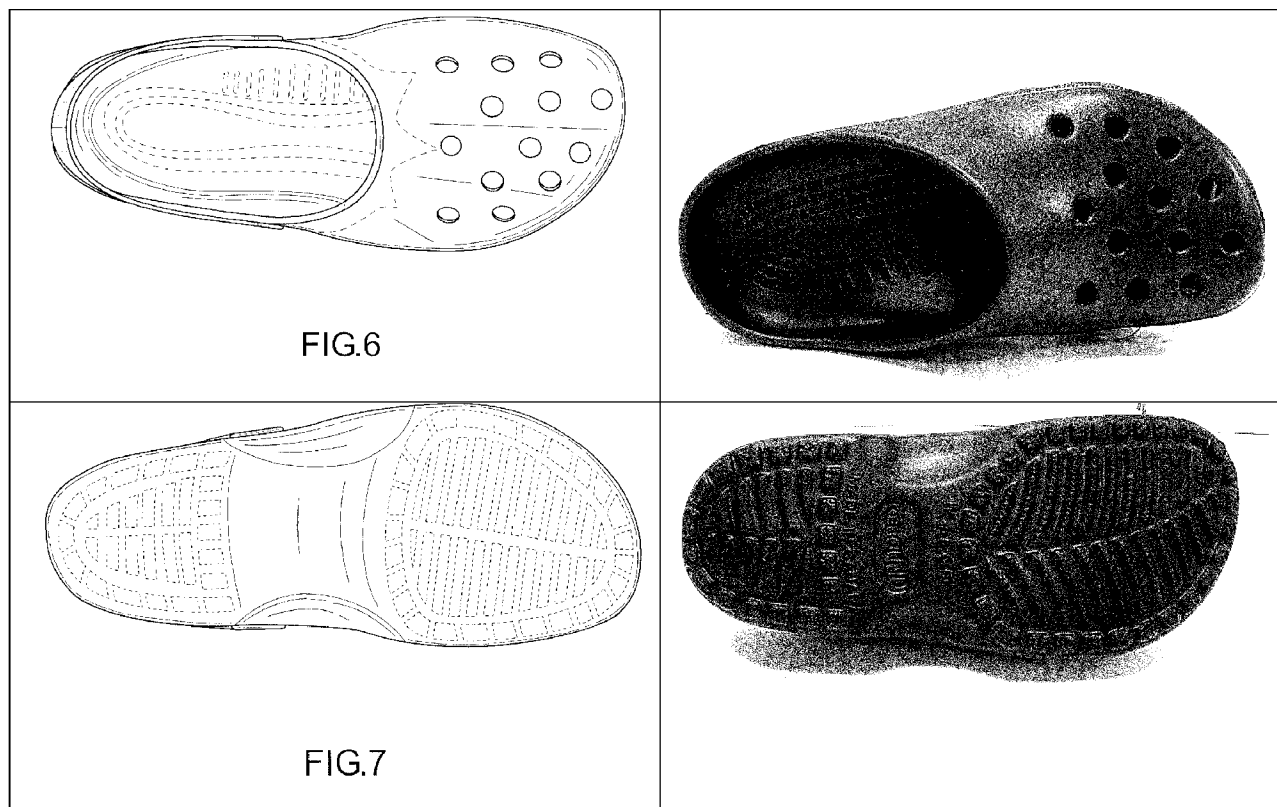
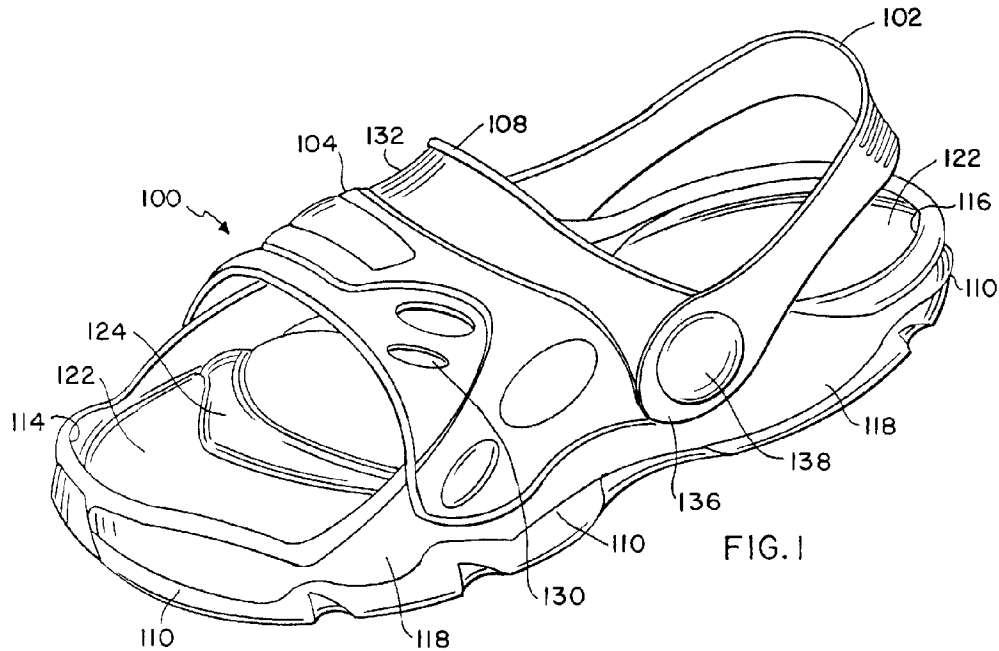


FIG.5



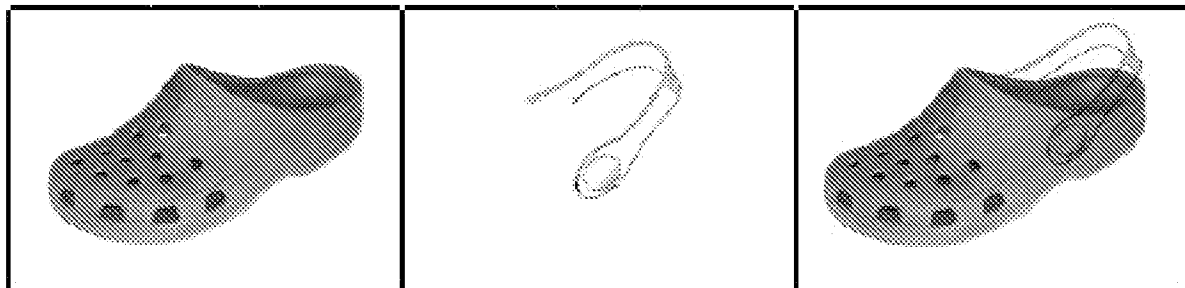


Placement of the strap of Aguerre '249 (Ex. 4) renders the claimed design indistinguishable from the Softmoc shoe. The same is true of the strap from Aguerre '780 (Ex. 4). Thus, modification of the foregoing design would meet the ordinary observer test by rendering the two designs indistinguishable to the ordinary observer.



The combination achieves this result, as shown in Table 3a:

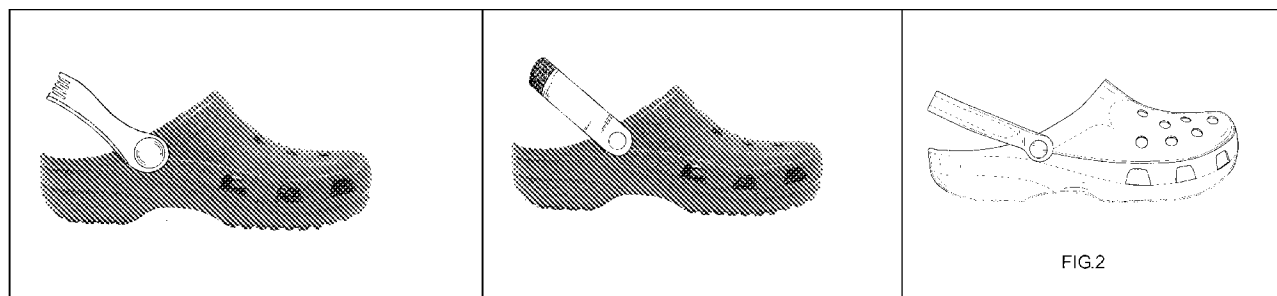
**Table 3a:** Illustration to show attaching the strap of Aguerre '249 (Ex. 4) to the shoe of Softmoc (Ex. 7) as clarified by the inherency shown in Rebound (Ex. 17)..



For demonstrative purposes further illustrating this combination, Table 3b shows an artistic rendering of the shoe of Softmoc (Ex. 7) combined with the strap of Aguerre '249 (Ex. 4) from a side view, and compares this also with the strap of GB '268 (Ex. 3).

Table 3b: Demonstrative comparison to show similarity of design.

Base Shoe of Ex. 7 As Shown By Inherency of Rebound (Ex. 17) Plus Strap of Ex. 4	Base Shoe of Ex. 7 As Shown By Inherency of Rebound (Ex. 17) Plus Strap of Ex. 3	Fig. 2 of '789 Patent
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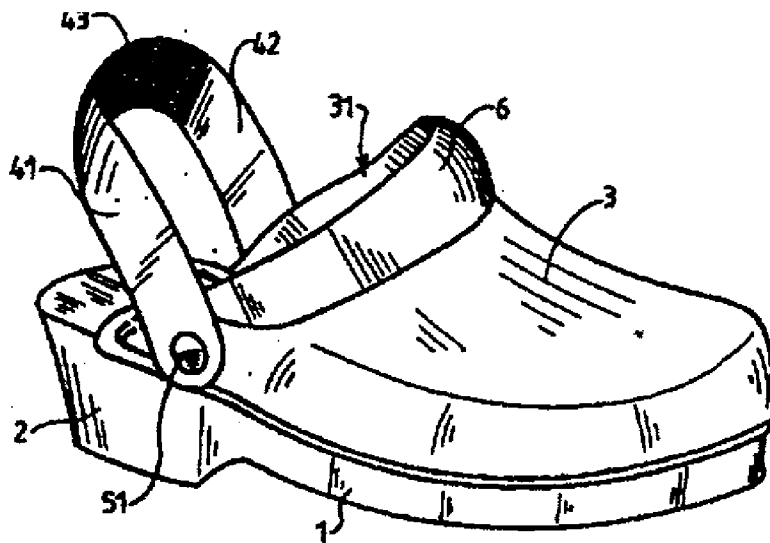
### 3. Battistion Designs (Ex. 8) in View of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4) As Guided by GB '286 (Ex. 3).

Battistion Designs (Ex. 8) is an admitted publication. *See* Canadian Action (Ex. 15; Para. 7). The claim of the '789 patent is invalid by reason of obviousness pursuant to 35 U.S.C. §103(a) over Battistion Designs (Ex. 8) in view of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4). According to MPEP §1504.03, obviousness of designs is assessed by providing a first reference of something in existence, which in this case is the Beach shoe design shown in Battistion Designs (Ex. 8). Next, there is an assessment of the differences between the prior art and the claimed design.

The design of Battistion Designs (Ex. 8), admittedly published in April of 1992, is identical in all respects to the claimed design, except for the strap. The design may be modified by the addition of the strap of either Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4) to arrive at a shoe that is virtually indistinguishable from the claimed design, thus meeting the ordinary observer test. Motivation to modify Battistion Designs (Ex. 8) by addition of the strap would have been to retain the shoe on the foot of the wearer as taught by Aguerre '249 (Ex. 4). Moreover, the shoes of Aguerre '780 (Ex. 5) or Aguerre '249 (Ex. 4) are closely related in appearance to the Aqua Clog of Battistion Designs (Ex. 8), such that the appearance of the strap in Aguerre '780 or Aguerre '780 suggests this as a modification to the Aqua Clog.

The commonalities of design contributing to this closely related appearance includes, first, all items being shoes. These shoes are further similar in design where they share an open rear construction with an upwardly molded rim making. The base shoe is also formed in the nature of a slide. There are also ventilation holes in the tops and sides of all these shoes, which

have also an overall appearance of having been injection molded. This modification is further guided by GB '286, which shows a similar strap placed on a clog –style of shoe:



Thus, the references are properly combinable under MPEP §1504.03 to achieve the same result as shown above in Table 3a.

Table 4 below provides a comparison which, allowing for the mirror-image difference of a right shoe versus a left shoe, shows that the base shoe of Softmoc is identical in all respects to the base shoe of the claimed design, thus meeting the ordinary observer test.

**TABLE 4:** A comparison of the '789 patent drawings versus Softmoc (Ex. 7) as clarified by the inherent showing of Battistion Designs (Ex. 8).

Figures From The '789 Patent	Battistion Designs
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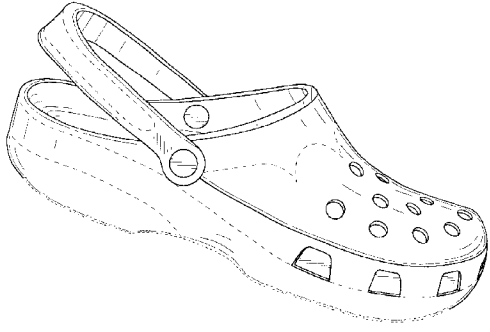


FIG.1

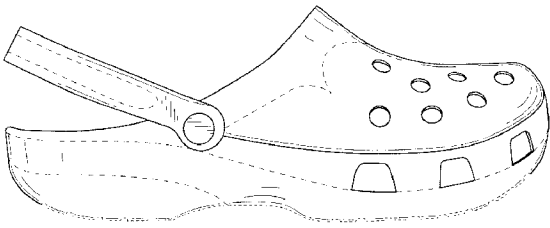


FIG.2

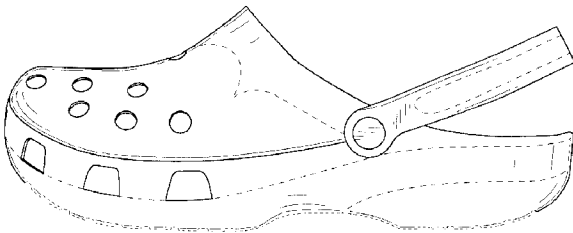
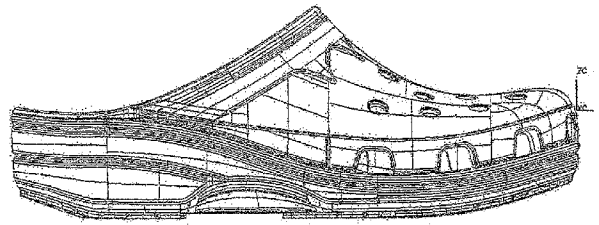


FIG.3

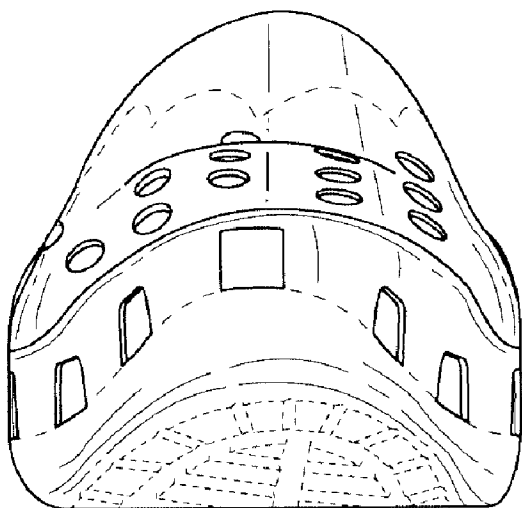


FIG.4

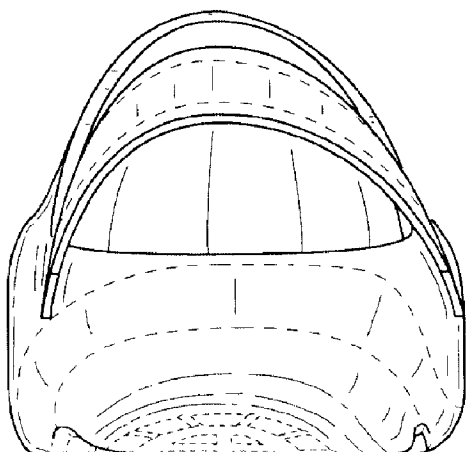
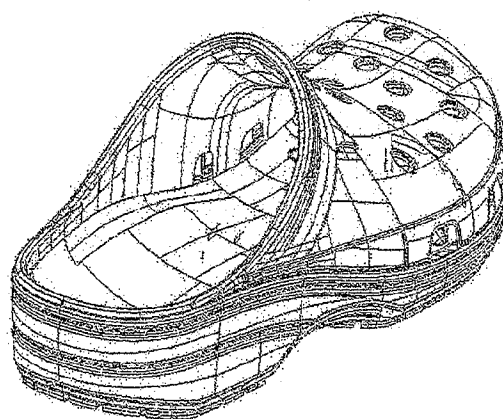
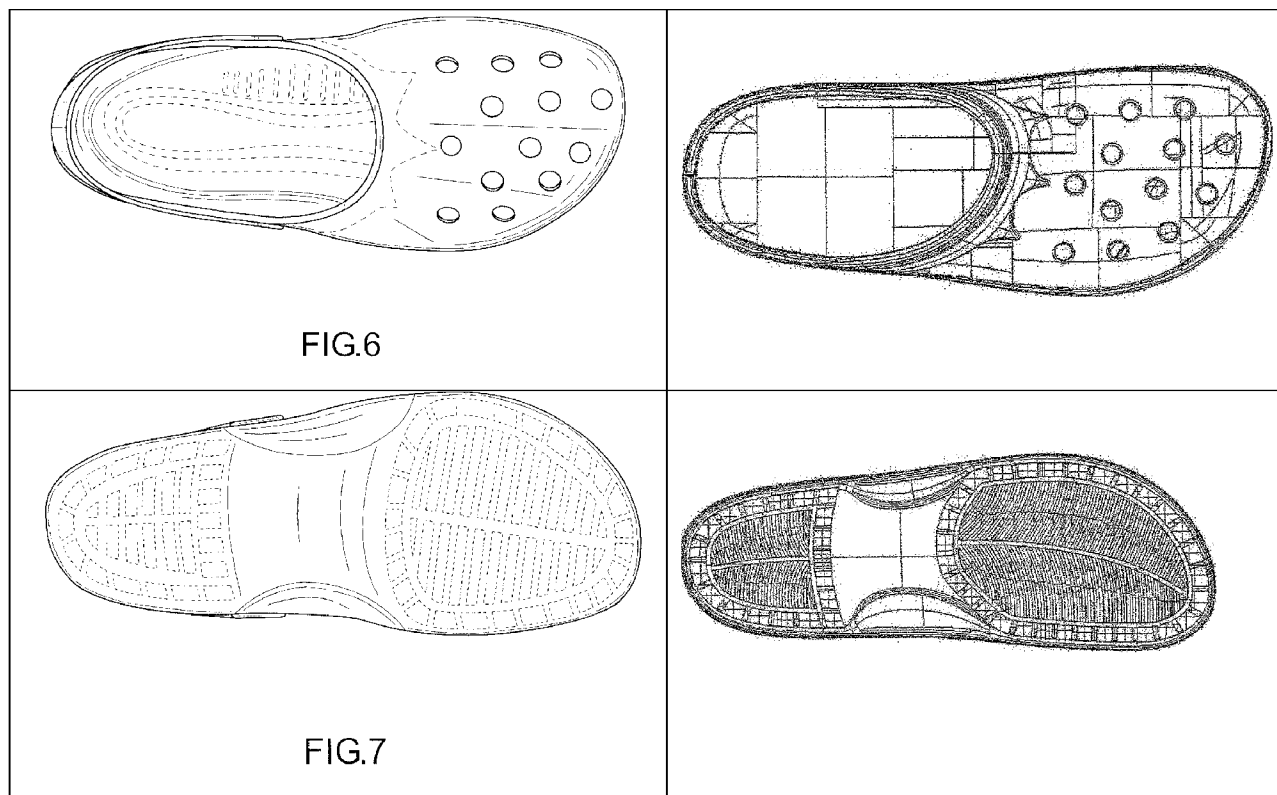


FIG.5

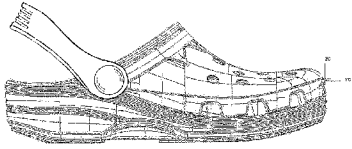
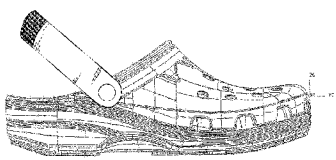
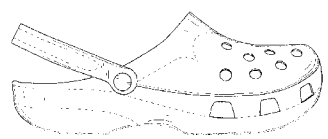




Placement of the strap of Aguerre '249 (Ex. 4) renders the claimed design indistinguishable from the shoe of Battistion Designs (Ex. 8) The same is true of the strap from Aguerre '780 (Ex. 5). Thus, modification of the foregoing design would meet the ordinary observer test by rendering the two designs indistinguishable to the ordinary observer.

For demonstrative purposes further illustrating this combination, Table 4a shows an artistic rendering of the shoe of Battistion Designs (Ex. 8) combined with the strap of Aguerre '249 (Ex. 4) from a side view, and compares this also with the strap of GB '268 (Ex. 3).

Table 4a: Demonstrative comparison to show similarity of design.

Base Shoe of Ex. 8 Plus Strap of Ex. 4	Base Shoe of Ex. 8 Plus Strap of Ex. 3	Fig. 2 of '789 Patent
		 FIG.2

#### 4. Softmoc (Ex. 7) in View of GB '286 (Ex. 3).

The claim of the '789 patent is invalid by reason of obviousness pursuant to 35 U.S.C. §103(a) over Softmoc (Ex. 7) in view of guided by GB '286 (Ex. 3). According to MPEP §1504.03, obviousness of designs is assessed by providing a first reference of something in existence, which in this case is the Aqua Clog design shown in Softmoc (Ex. 7). Next, there is an assessment of the differences between the prior art and the claimed design. The design of Softmoc (Ex. 7) is identical in all respects to the claimed design, except for the strap. The design may be modified by the addition of the strap of GB '286. to arrive at a shoe that is virtually indistinguishable from the claimed design. Motivation to modify Softmoc (Ex. 7) by addition of the strap would have been to use the strap as shown in context of closely related clog shoe design of GB '286, such that the appearance of the strap of GB '286 suggests this as a modification to the Aqua Clog.

The commonalities of design that provide motivation to modify Softmoc (Ex. 7) include a closely related appearance where all items are shoes. These shoes are further similar in design where they share an open rear construction with the base shoe being formed in the nature of a clog. This modification is guided by GB '286, which shows a similar strap placed on a clog – style of shoe:

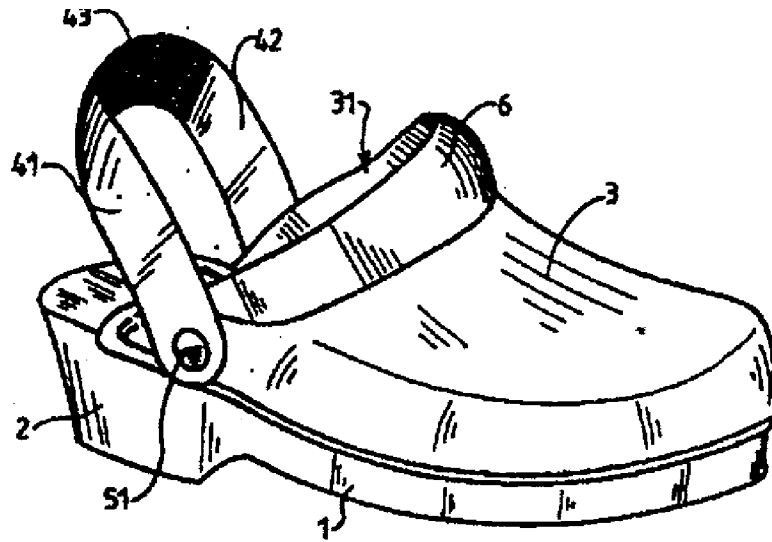
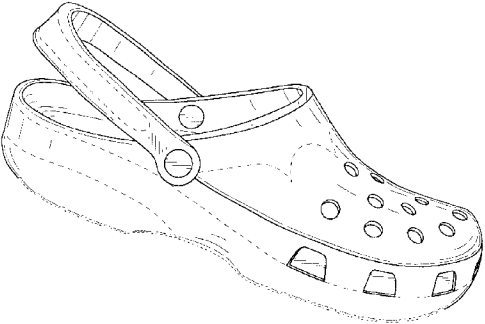
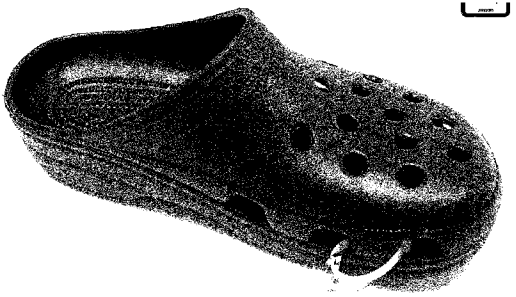


Table 5 below provides a comparison which, allowing for the mirror-image difference of a right shoe versus a left shoe, shows that the base shoe of Softmoc is identical in all respects to the base shoe of the claimed design.

**TABLE 5:** A comparison of the '789 patent drawings versus Softmoc (Ex. 7) as clarified by the inherent showing of REBOUND (Ex. 17).

Figures From The '789 Patent	Softmoc
 <p data-bbox="402 1606 474 1638">FIG.1</p>	

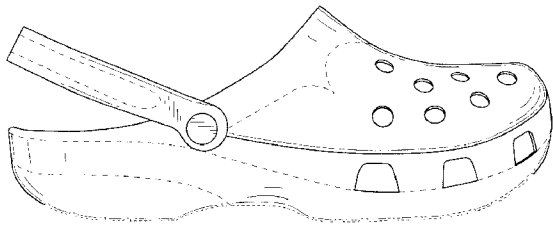


FIG.2

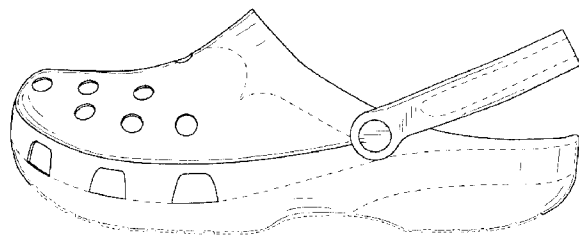
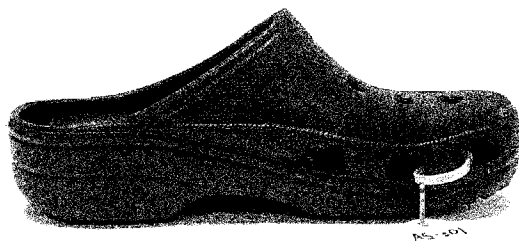


FIG.3

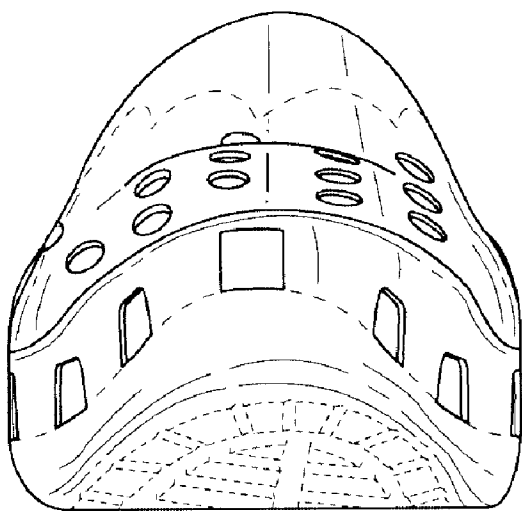
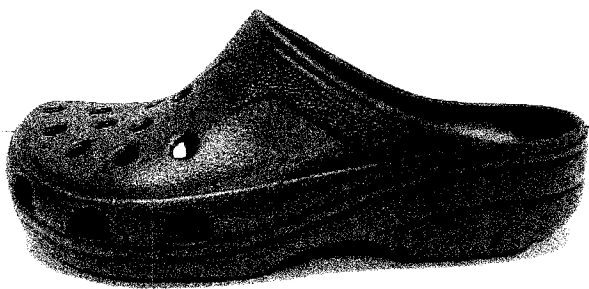


FIG.4



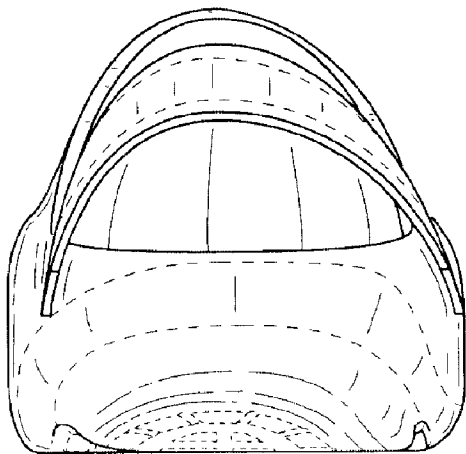


FIG.5

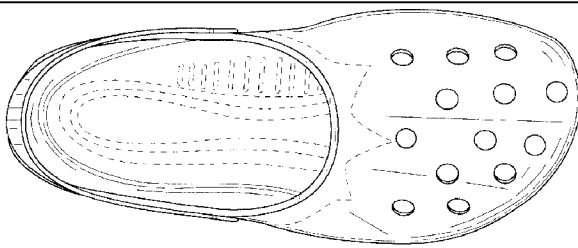


FIG.6

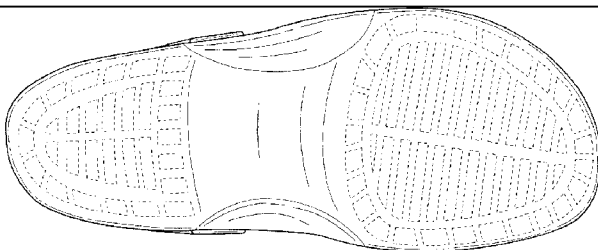
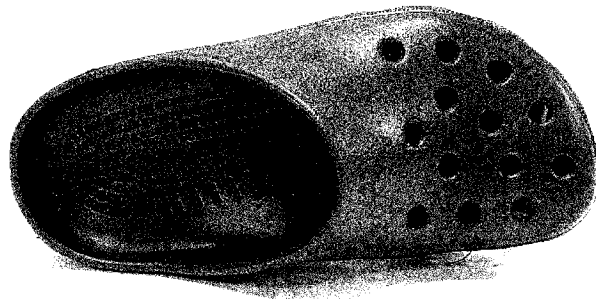
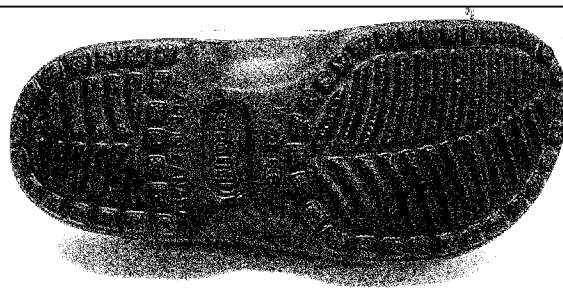


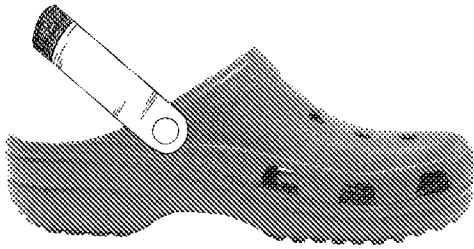
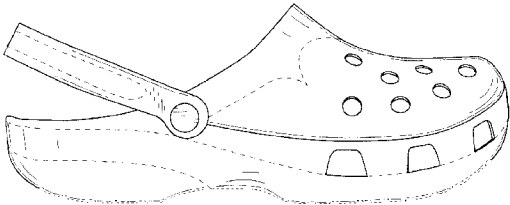
FIG.7



Thus, modification of the foregoing design to incorporate the strap of GB'286 would meet the ordinary observer test by rendering the two designs indistinguishable to the ordinary observer.

For demonstrative purposes further illustrating this combination, Table 5a shows an artistic rendering of the shoe of Softmoc (Ex. 7), as confirmed by the inherency of Exhibit 17, combined with the strap of GB '268 (Ex. 3).

Table 5a: Demonstrative comparison to show similarity of design.

Base Shoe of Ex. 7 As Shown By Inherency of Ex. 17 Plus Strap of Ex. 2	Fig. 2 of '789 Patent
	 <p data-bbox="1036 1060 1107 1092">FIG.2</p>

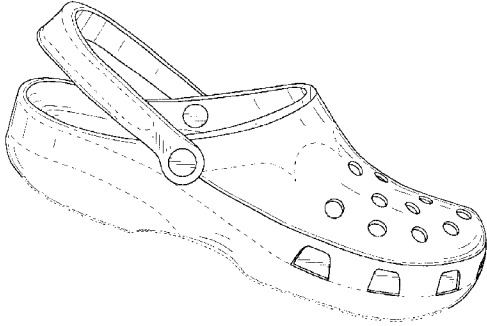
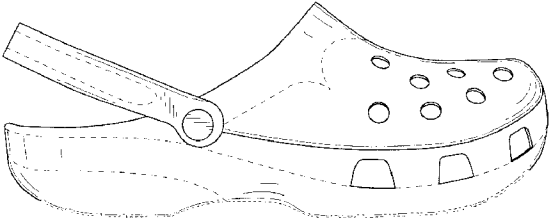
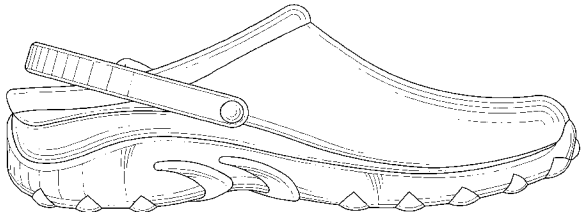
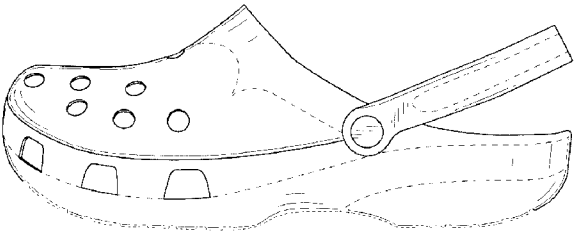
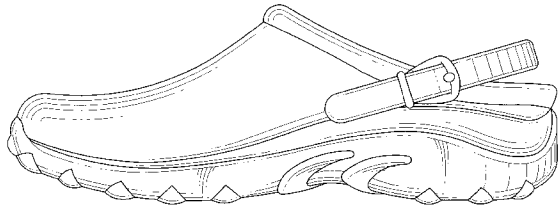
##### 5. Hawker '040 (Ex. 6) in View of Aguerre '789 (Ex. 5) or Aguerre '249 (Ex. 4).

The claim of the '789 patent is invalid by reason of obviousness pursuant to 35 U.S.C. §103(a) over Hawker '040 (Ex. 6) in view of Aguerre '789 (Ex. 5) or Aguerre "249 (Ex. 4). According to MPEP §1504.03, obviousness of designs is assessed by providing a first reference of something in existence, which in this case is the shoe of Hawker '040 (Ex. 6). Next, there is an assessment of the differences between the prior art and the claimed design. The base shoe design of Hawker '040 (Ex. 6) is highly similar to the claimed design, except for the strap which depicts a buckle on one side. The design may be modified by the addition of the strap of Aguerre '789 (Ex. 5) or Aguerre "249 (Ex. 4) to arrive at a shoe that meets the ordinary observer test with respect to the claimed design. Motivation to modify Hawker '040 (Ex. 6) by addition of the strap would have been to use the alternative strap as an equivalent alternative design choice selected from a closely related prior art shoe design.



Table 6 below provides a comparison to show overall similarity of design.

**TABLE 6:** A comparison of the '789 patent drawings versus Hawker (Ex. 6) suggest the same placement of a strap as is provided in the drawings of the '789 patent (Ex. 2).

Figures From The '789 Patent	Figures From Hawker '040 (Ex. 6)
 <p>FIG.1</p>	
 <p>FIG.2</p>	 <p>FIG. 1</p>
 <p>FIG.3</p>	 <p>FIG. 2</p>

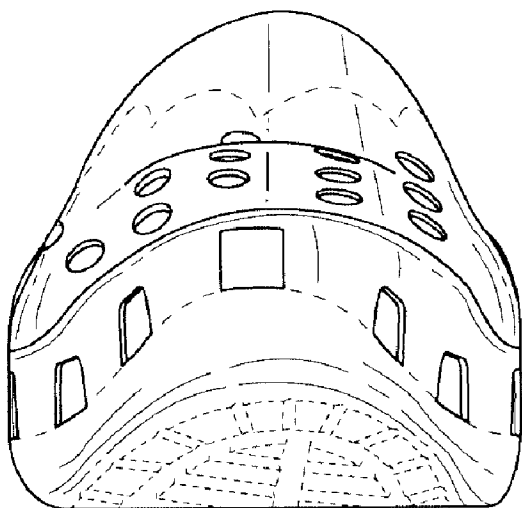


FIG. 4

FIG. 5

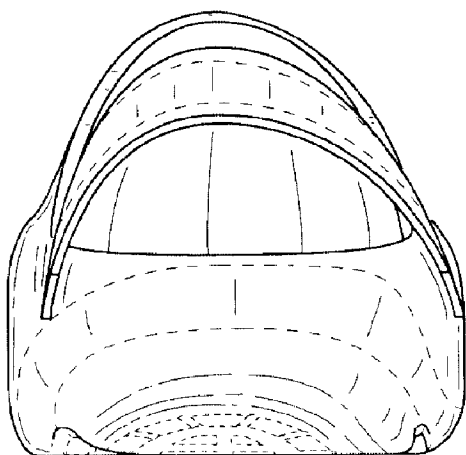
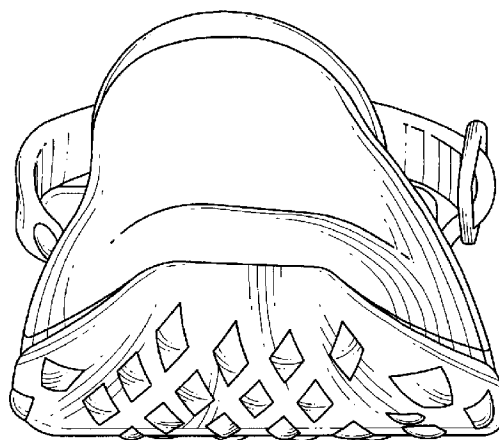
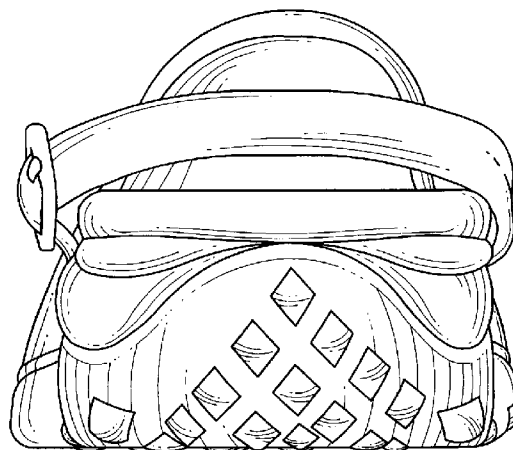
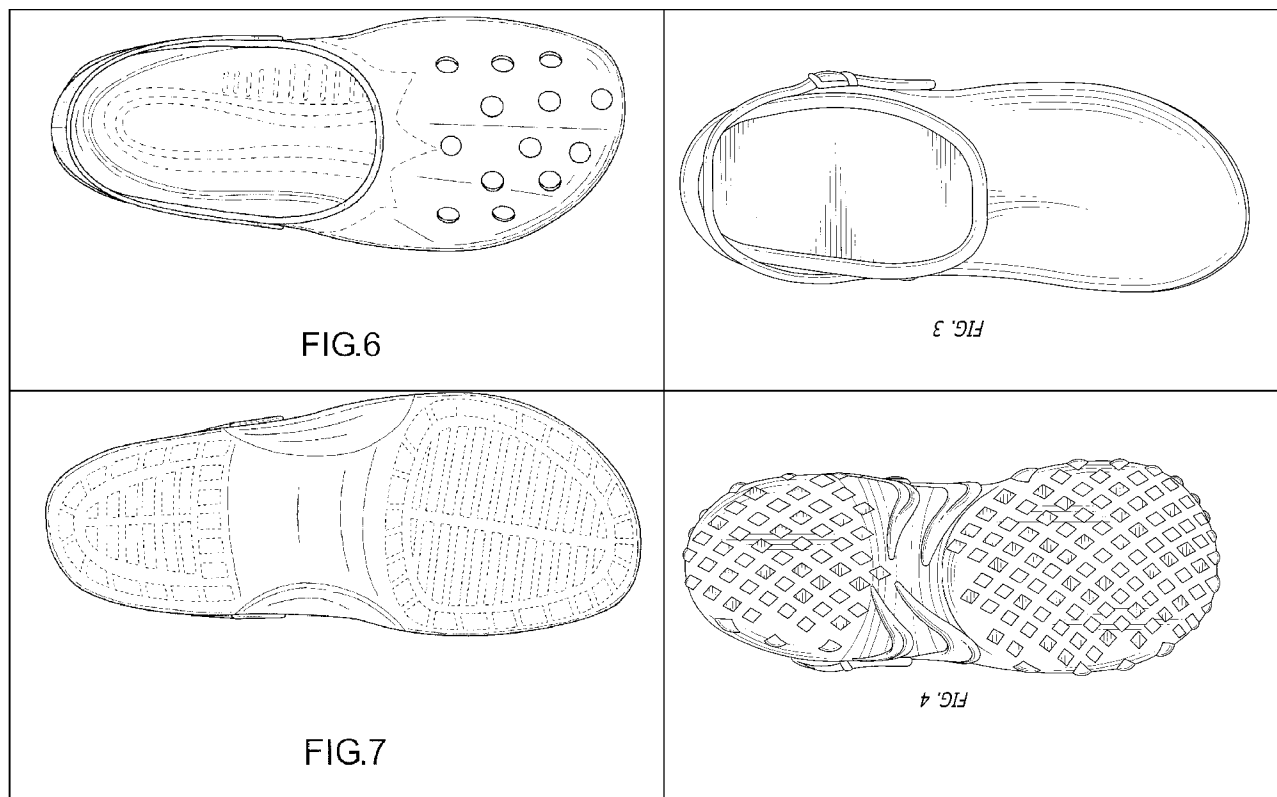


FIG. 5

FIG. 6


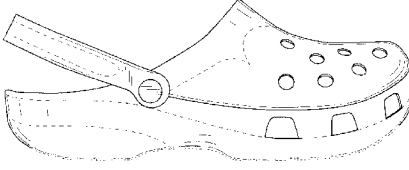




Thus, modification of the foregoing design would meet the ordinary observer test by rendering the two designs indistinguishable to the ordinary observer, especially as clarified by the inherent showing of REBOUND (Ex. 17).

For demonstrative purposes further illustrating this combination, Table 6a shows an artistic rendering of the shoe of Softmoc (Ex. 7), as confirmed by the inherency of Exhibit 17, combined with the strap of GB '268 (Ex. 3).

Table 6a: Demonstrative comparison to show similarity of design.

Base Shoe of Ex. 7 As Shown By Inherency of Ex. 17 Plus Strap of Ex. 6	Fig. 2 of '789 Patent
	 <p style="text-align: center;">FIG. 2</p>

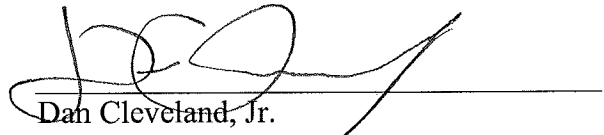
## CONCLUSION

This Request presents several material new issues of patentability. These grounds justify commencing an inter partes reexamination proceeding—one from which the claims of the '789 patent cannot survive. The '789 patent cannot reach the priority date of June 23, 2003, and so it is relegated to the filing date of May 28, 2004. This means that the claims are invalid over printed publications constituting Crocs's own sales literature for the Beach model shoe. Exhibits 9-11, 15, 16 and 20 clarify what is inherent to the sales literature publications. Moreover, the base section of the shoe design was copied in all material respects from the prior art design created by Ettore Battistion that previously went undisclosed as prior art to the Patent Office. The claims at issue are further invalid because it is obvious to add the strap of Aguerre '249 to Mr. Battistion's Beach model shoe.

Date: 8/24/12

Respectfully submitted,

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