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8 **United States District Court**
9 **Central District of California**

10 DECKERS OUTDOOR CORPORATION,
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12 Plaintiff,

13 v.

14 ROMEO & JULIETTE, INC.; THOMAS
15 ROMEO; and DOES 1-10, inclusive,

16 Defendants.

Case № 2:15-cv-02812-ODW (PLAx)

**ORDER GRANTING IN PART AND
DENYING IN PART PLAINTIFF'S
MOTION FOR SUMMARY
JUDGMENT [89]**

17 **I. INTRODUCTION**

18 Plaintiff Deckers Outdoor Corporation designs and sells “UGG” brand boots
19 and owns several design patents related to those boots. Defendant Romeo & Juliette,
20 Inc., owned by Defendant Thomas Romeo, also designs and sells boots under the
21 brand names BearPaw and Attix. Deckers alleges that several of Defendants’ boot
22 styles infringe on three of its design patents: (1) U.S. Patent No. D599,999 (“the ’999
23 patent”); (2) U.S. Patent No. D616,189 (“the ’189 patent”); and (3) U.S. Patent No.
24 D582,650 (“the ’650 patent”). Defendants have counterclaimed for non-infringement
25 and invalidity for those same three patents and for U.S. Patent No. D642,781 (“the
26 ’781 patent”). Deckers now moves for summary judgment on Defendants’ invalidity
27 counterclaims. The Court concludes that Deckers is entitled to summary judgment on
28 the counterclaims for invalidity as to the ’650 patent, the ’999 patent, and the ’781

1 patent, but not as to the '189 patent. Accordingly, the Court **GRANTS IN PART** and
2 **DENIES IN PART** Deckers' Motion.¹

3 **II. LEGAL STANDARD**

4 A court "shall grant summary judgment if the movant shows that there is no
5 genuine dispute as to any material fact and the movant is entitled to judgment as a
6 matter of law." Fed. R. Civ. P. 56(a). Courts must view the facts and draw reasonable
7 inferences in the light most favorable to the nonmoving party. *Scott v. Harris*, 550
8 U.S. 372, 378 (2007). A disputed fact is "material" where the resolution of that fact
9 might affect the outcome of the suit under the governing law, and the dispute is
10 "genuine" where "the evidence is such that a reasonable jury could return a verdict for
11 the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1968).
12 Conclusory or speculative testimony in affidavits is insufficient to raise genuine issues
13 of fact and defeat summary judgment. *Thornhill's Publ'g Co. v. GTE Corp.*, 594 F.2d
14 730, 738 (9th Cir. 1979). Moreover, though the court may not weigh conflicting
15 evidence or make credibility determinations, there must be more than a mere scintilla
16 of contradictory evidence to survive summary judgment. *Addisu v. Fred Meyer*, 198
17 F.3d 1130, 1134 (9th Cir. 2000). Where the moving and nonmoving parties' versions
18 of events differ, courts are required to view the facts and draw reasonable inferences
19 in the light most favorable to the nonmoving party. *Scott*, 550 U.S. at 378.

20 **III. DISCUSSION**

21 Defendants assert that the designs in each patent are obvious in light of prior art
22 and thus the patents are invalid.² "A patent is invalid 'if the differences between the
23 subject matter sought to be patented and the prior art are such that the subject matter
24 as a whole would have been obvious at the time the invention was made to a person
25

26 ¹ After considering the papers submitted by the parties, the Court deemed the matter appropriate
27 for decision without oral argument. Fed. R. Civ. P. 78(b); C.D. Cal. L.R. 7-15.

28 ² The Court previously rejected Defendants' assertion that the '650, '999, and '189 patents were
invalid based on indefiniteness. (ECF No. 61.) Moreover, while Defendants previously asserted that
the '781 patent was anticipated by prior art, they appear to have abandoned that argument.

1 having ordinary skill in the art to which said subject matter pertains.” *Cadence*
2 *Pharm. Inc. v. Exela PharmSci Inc.*, 780 F.3d 1364, 1373 (Fed. Cir. 2015) (quoting 35
3 U.S.C. § 103(a) (2006)).³ “In addressing a claim of obviousness in a design patent,
4 ‘the ultimate inquiry . . . is whether the claimed design would have been obvious to a
5 designer of ordinary skill who designs articles of the type involved.’ *Apple, Inc. v.*
6 *Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (quoting *Titan Tire Corp.*
7 *v. Case New Holland, Inc.*, 566 F.3d 1372, 1375 (Fed. Cir. 2009)). “When assessing
8 the potential obviousness of a design patent, a finder of fact employs two distinct
9 steps: first, ‘one must find a single reference, a something in existence, the design
10 characteristics of which are basically the same as the claimed design’; second, ‘[o]nce
11 this primary reference is found, other references may be used to modify it to create a
12 design that has the same overall visual appearance as the claimed design.’” *High*
13 *Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311 (Fed. Cir. 2013)
14 (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)). An
15 obvious modification to a single primary prior art reference can also invalidate a
16 patent, even without any secondary references. *Int’l Seaway Trading Corp. v.*
17 *Walgreens Corp.*, 589 F.3d 1233, 1240 (Fed. Cir. 2009); *SIBIA Neurosciences, Inc. v.*
18 *Cadus Pharm. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000). An infringer must
19 “prove invalidity by clear and convincing evidence,” and must also carry “the initial
20 burden of going forward with evidence to support its invalidity allegation.” *Titan Tire*
21 *Corp.*, 566 F.3d at 1376.

22 “Obviousness under 35 U.S.C. § 103 is a legal conclusion involving four factual
23 inquiries. These inquiries consist of: (1) the scope and content of the prior art; (2) the
24 differences between the claims and the prior art; (3) the level of ordinary skill in the
25 pertinent art; and (4) secondary considerations, if any, of nonobviousness.” *B.F.*
26 *Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582 (Fed. Cir. 1996)

27 ³ Because the application that led to the patents in this case were filed prior to March 16, 2013,
28 the America Invents Act’s amendments to § 103 do not apply. See *Cadence Pharm.*, 780 F.3d at
1374 n.2.

1 (citations and internal quotation marks omitted). “Where . . . the content of the prior
2 art, the scope of the patent claim, and the level of ordinary skill in the art are not in
3 material dispute, and the obviousness of the claim is apparent in light of these factors,
4 summary judgment is appropriate.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 427
5 (2007) (citations omitted).

6 **A. Scope of the Prior Art**

7 Deckers argues that several of the prior art references on which Defendants rely
8 do not qualify as prior art because there is no admissible evidence establishing their
9 sale or publication dates. (Reply at 1–6, ECF No. 131.)

10 “The term ‘prior art’ as used in section 103 refers at least to the statutory
11 material named in 35 U.S.C. § 102.” *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324
12 F.3d 1346, 1354 (Fed. Cir. 2003). Section 102 contains several complex sections that
13 define the universe of prior art references. In general, prior art is the body of
14 knowledge publicly available to a person skilled in the particular art or field of the
15 invention at the time the invention was made or one year prior to the filing of the
16 patent application. *See generally* 35 U.S.C. § 102 (2006); *Ormco Corp. v. Align*
17 *Tech., Inc.*, 463 F.3d 1299, 1305 (Fed. Cir. 2006). Thus, to be considered “prior art,”
18 the art generally must have been patented, described in a printed publication, in public
19 use, or offered for sale during the relevant time period. *See generally* *OddzOn Prod.,*
20 *Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1402 (Fed. Cir. 1997).

21 The following table summarizes the prior art references on which Defendants
22 rely, as well as the Court’s conclusion as to which prior art references are admissible:

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Patent	Defendants' Asserted Prior Art	Admissible Prior Art
'650 patent	<ul style="list-style-type: none"> • Rebels Cayenne boot • U.S. Patent No. D500,583 • U.S. Patent No. D561,983 	<ul style="list-style-type: none"> • The '583 patent • The '983 patent
'999 patent ⁴	<ul style="list-style-type: none"> • EMU Australia Barossa boot • EMU Australia Matilda boot • Steve Madden Missy boot • Sketchers Shinding Scintilla boot • Sketchers Voyagers Angel Face boot • Earth Dakota boot • Camper Industrial boot • U.S. Patent No. D529,269 • UGG Classic boot 	<ul style="list-style-type: none"> • Earth Dakota boot • The '269 patent • UGG Classic boot
'189 patent	<ul style="list-style-type: none"> • Born Malawi boot • Minnetonka Solitude boot • U.S. Patent No. D575,495 • U.S. Patent No. D539,024 • U.S. Patent No. D581,140 • U.S. Patent No. D591,496 • UGG Bailey Button boot 	<ul style="list-style-type: none"> • The '495 patent • The '024 patent • The '140 patent • The '496 patent • UGG Bailey Button boot
'781 patent	<ul style="list-style-type: none"> • UGG Rainier • Bass Pullon • Bearpaw Elise • Bearpaw Tama • U.S. Patent No. D335,946 	<ul style="list-style-type: none"> • UGG Rainier • The '946 patent

The Court addresses Deckers' arguments regarding each of the prior art references in detail below.

⁴ Defendants also contend that the prior art asserted as to the '999 patent also invalidates the '189 patent, and vice-versa. However, aside from this conclusory assertion, Defendants do nothing to develop this argument. The Court therefore considers this argument waived. *See, e.g., Greenwood v. F.A.A.*, 28 F.3d 971, 977 (9th Cir. 1994) ("We will not manufacture arguments for an appellant, and a bare assertion does not preserve a claim"); *United States v. Ramirez*, 448 F. App'x 727, 729 (9th Cir. 2011).

1 **1. The '650 Patent**

2 **i. Rebels Cayenne Boot**

3 Defendants argue that this boot was sold between 2004 and 2008. (SUF 94–
4 96.) In support of their contention, Defendants rely on an e-mail sent to their counsel
5 from the CEO of the company that sold the boot. (Alaniz Decl., Ex. 1, ECF No. 103.)
6 Deckers argues that this e-mail is inadmissible and thus that there is no competent
7 evidence that the boot was ever available in the public domain. (Reply at 1–2, ECF
8 No. 131.) The Court agrees. “A trial court can only consider admissible evidence in
9 ruling on a motion for summary judgment.” *Orr v. Bank of Am., NT & SA*, 285 F.3d
10 764, 773 (9th Cir. 2002). Hearsay, which is an out-of-court statement used to prove
11 the truth of the matter asserted, is not admissible unless there is an applicable
12 exception. *See* Fed. R. Evid. 801(c), 802. Here, the assertion by the CEO clearly
13 constitutes hearsay: the statement that the boot was sold between 2004 and 2008 was
14 made out of court and is used to prove the very fact asserted. Moreover, there does
15 not appear to be any applicable hearsay exception. Consequently, Defendants fail to
16 show that the boot was ever publicly accessible, and thus it does not constitute prior
17 art.

18 The Court also notes that Defendants fail to authenticate any of the pictures that
19 they contend correspond to this boot style. This is problematic in two ways. First, of
20 course, if the pictures are not authenticated, they are inadmissible on summary
21 judgment for the purpose of an obviousness analysis. *Orr*, 285 F.3d at 773. Second,
22 because there is no evidence showing that these pictures actually correspond to this
23 boot style, the evidence purporting to prove the date this boot style was publicly
24 available is meaningless. All we know is that *some* boot called “Rebels Cayenne boot”
25 was offered for sale between 2004 and 2008; there is no evidence that the boots in
26 these pictures (which form the entire basis of the obviousness analysis) are in fact the
27 “Rebels Cayenne boot,” and thus there no evidence that the boots in those pictures
28 were offered for sale in the relevant time frame. For this additional reason, the boots

1 shown in those pictures do not constitute prior art.

2 **2. The '999 Patent**

3 **i. EMU Australia Barossa / Matilda Boots**

4 Defendants contend that these boots were available for sale in the United States
5 beginning in 2008. (SUF 103, 105.) Defendants rely on the declaration of Jeffrey
6 Weinstein, who was an independent sales representative for EMU Australia at that
7 time to establish this fact. (Alaniz Decl., Ex. 4.) Deckers contends that Weinstein's
8 affidavit lacks foundation because he was not an officer or director of EMU Australia.
9 (Reply at 2.) The Court disagrees. As an individual who sold these boots on EMU
10 Australia's behalf, he has the requisite knowledge and foundation to make these
11 statements. Nonetheless, the Court concludes that these boots are inadmissible as
12 prior art because Defendants fail to authenticate any of the pictures that they contend
13 correspond to this boot style.

14 **ii. Steve Madden Missy Boot**

15 Defendants contend that this boot was available for sale in the United States
16 beginning in July 2007. (SUF 107.) Defendants rely on business records produced by
17 Steve Madden, Ltd. in response to a document subpoena to prove this fact. (Alaniz
18 Dec., Ex. 3.) Deckers contends that the records are inadmissible because they have
19 not been authenticated. (Reply at 3.) While evidence generally must be authenticated
20 to be admissible, Fed. R. Evid. 901(a), business records are self-authenticating if they
21 meet the requirements of the business records exception to the hearsay rule. Fed. R.
22 Evid. 803(6), 902(11). The proponent of such evidence must demonstrate compliance
23 with these requirements through "a certification of the custodian or another qualified
24 person that complies with a federal statute or a rule prescribed by the Supreme Court."
25 Fed. R. Evid. 902(11). Here, Defendants do not submit any certification
26 demonstrating compliance with those requirements, and thus the records are
27 inadmissible on summary judgment. *Orr*, 285 F.3d at 773. The Court also concludes
28 that these boots are inadmissible as prior art because Defendants fail to authenticate

1 any of the pictures that they contend correspond to this boot style. Accordingly,
2 Defendants have not demonstrated that this boot constitutes prior art.

3 **iii. Sketchers Shinding Scintilla / Voyagers Angel Face Boots**

4 Defendants contend that these boots were available for sale in the United States
5 through a shoe company called Sketchers beginning in July 2006. (SUF 108, 110.)
6 To establish this, Defendants rely on: (1) what appears to be a printout of a Sketchers
7 online catalog; and (2) sale invoices produced by Sketchers to Defendants, ostensibly
8 in response to a document subpoena. (Alaniz Decl., Ex. 6.) The catalog printouts
9 have not been authenticated⁵ and thus are not admissible. *Orr*, 285 F.3d at 773. The
10 sales invoices, on the other hand, are supported by the declaration of a Vice President
11 at Sketchers which meets the requirements of Rules 803(6) and 902(11). Nonetheless,
12 the Court concludes that these boots are inadmissible as prior art because Defendants
13 fail to authenticate any of the pictures that they contend correspond to this boot style.

14 **iv. Earth Dakota Boot**

15 Defendants contend that these boots were available for sale in the United States
16 through a shoe company called Earth beginning in January 2007. (SUF 112.) To
17 establish this, Defendants rely on a declaration to that effect from the Vice President
18 of Finance and Operations at Earth, which includes as an exhibit a Fall 2007 catalogue
19 that depicts the Dakota Boot. (Alaniz Decl., Ex. 7.) Deckers argues that this is
20 insufficient because the declarant “does not explain the basis for his knowledge.”
21 (Reply at 3.) The Court disagrees. The declarant’s position at the company is
22 sufficient for the Court to infer that he would know the facts attributed to him,
23 including that the catalogue attached is indeed one from Fall 2007. Thus, the
24 declaration is sufficient to establish the timeframe in which these boots were offered
25 for sale, and thus the boot style constitutes prior art for the purpose of an obviousness
26 analysis.

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28 ⁵ The declaration submitted by Strasser relates to the invoices only and thus does not authenticate
the catalogue printouts.

1 **v. Camper Industrial Boot**

2 Defendants contend that these boots were available for sale in the United States
3 as early as 2004. (SUF 114.) To establish this, Defendants rely on an e-mail from a
4 person in Camper’s Legal Department to Defendants’ counsel stating that this boot
5 was sold in 2004. (Alaniz Decl., Ex. 8.) This is insufficient, as the relevant
6 statements in the e-mail constitute inadmissible hearsay with no applicable
7 exception. *See* Fed. R. Evid. 801(c), 802. The Court also concludes that these boots
8 are inadmissible as prior art because Defendants fail to authenticate any of the pictures
9 that they contend correspond to this boot style.

10 **3. The ’189 Patent**

11 **i. Born Malawi Boot**

12 Defendants contend that H.H. Brown Shoe Company, a division of Born
13 Footwear, sold this boot in the United States as early as May 2008. (SUF 122.) To
14 establish this, Defendants rely on a statement by the Vice President of Corporate
15 Administration of H.H. Brown Shoe Company purporting to attest to this fact and to
16 authenticate a photograph of the boot. (Alaniz Decl., Ex. 11.) Deckers argues that the
17 statement is inadmissible because it was not made under penalty of perjury. (Reply at
18 4–5.) The Court agrees. A declaration may be considered only if it is “subscribed by
19 [the declarant], as true under penalty of perjury, and dated, in substantially the
20 following form: . . . ‘I declare (or certify, verify, or state) under penalty of perjury that
21 the foregoing is true and correct. Executed on (date). (Signature)’.” 28 U.S.C.
22 § 1746(2). While declarations need not include this statement verbatim, the declarant
23 must at least assert that the statements made in the declaration are made “under
24 penalty of perjury.” *See Schroeder v. McDonald*, 55 F.3d 454, 462 n.10 (9th Cir.
25 1995); *Luxul Tech. Inc. v. NectarLux, LLC*, No. 14-CV-03656-LHK, 2016 WL
26 3345464, at *5 (N.D. Cal. June 16, 2016). Here, the declaration at issue contains no
27 such assertion, and thus the Court may not consider it on summary judgment.
28 Without it, Defendants have not demonstrated that this boot constitutes prior art.

1 **ii. Minnetonka Solitude Boot**

2 Defendants contend that these boots were available for sale through a shoe
3 company called Minnetonka as early as July 2007. (SUF 124.) Defendants rely on
4 documents that it received from Minnetonka in response to a subpoena, which
5 Defendants contend demonstrate the sale dates of these boots. (Alaniz Decl., Ex. 9.)
6 Deckers argues that this evidence is inadmissible because there is no declaration
7 authenticating these documents. (Reply at 4.) The Court agrees. As previously
8 noted, business records are self-authenticating only where the proponent of such
9 evidence demonstrates compliance with the requirements of Rule 803(6) through “a
10 certification of the custodian or another qualified person that complies with a federal
11 statute or a rule prescribed by the Supreme Court.” Fed. R. Evid. 902(11).
12 Defendants do not include any such certification here. Thus, the documents are
13 inadmissible. Accordingly, Defendants have not demonstrated that this boot
14 constitutes prior art.

15 **4. The '781 Patent**

16 **i. Bass Pullon**

17 Defendants contend that these boots were offered for sale in the 1980s. (SUF
18 137.) To establish this, Defendants rely on several photographs and the declaration of
19 Defendants’ counsel authenticating the photographs and averring that the boots were
20 in fact available for sale in the 1980s. (Alaniz Decl. ¶ 15, Ex. 14.) This is clearly
21 insufficient. Defendants’ counsel lays no foundation for how he would know whether
22 or not the boots were available for sale in the 1980s, and thus this does not constitute
23 admissible evidence. Accordingly, Defendants have not demonstrated that this boot
24 constitutes prior art.

25 **ii. Bearpaw Elise and Bearpaw Tama**

26 Defendants contend that these boots were offered for sale in 2006. (SUF 140,
27 142.) Defendants rely on the declaration of Defendant Thomas Romeo to this effect,
28 which also includes photographs of both boot styles. (Alaniz Decl., Ex. 12.) Deckers

1 argues that a single self-serving declaration as to the date these boots were offered for
2 sale is insufficient. (Reply at 5–6.) The Court agrees. “The law has long looked with
3 disfavor upon invalidating patents on the basis of mere testimonial evidence absent
4 other evidence that corroborates that testimony.” *Finnigan Corp. v. Int’l Trade*
5 *Comm’n*, 180 F.3d 1354, 1366 (Fed. Cir. 1999). “Mere testimony concerning
6 invalidating activities is received with further skepticism because such activities are
7 normally documented by tangible evidence such as devices, schematics, or other
8 materials that typically accompany the inventive process.” *Id.* Thus, the Court
9 requires more than a single declaration attesting to facts that would establish the sale
10 or publication date of prior art. *See, e.g., Apple, Inc. v. Samsung Elecs. Co.*, No. 11-
11 CV-01846-LHK, 2012 WL 2571719, at *10 (N.D. Cal. June 30, 2012); *Colucci v.*
12 *Callaway Golf Co.*, 750 F. Supp. 2d 767, 774 (E.D. Tex. 2010) (“[W]ithout the
13 requisite evidence corroborating Mr. Hansberger’s testimony that the alleged prior art
14 putter preceded Colucci’s invention, the Court cannot reach the legal merits on
15 Callaway’s obviousness contention.”). This is particularly so where, as here, the
16 declarant has an interest in the outcome of the litigation. *See Finnigan Corp.*, 180
17 F.3d 1367–68. As a result, the Court concludes that neither the Bearpaw Elise nor the
18 Bearpaw Tama constitutes prior art.

19 **B. Similarities and Differences with Prior Art**

20 **1. The ’650 Patent**

21 Defendants argue that the ’983 patent serves as the primary prior art reference
22 for the ’650 patent. (Opp’n at 8, ECF No. 124.) Defendants also argue that several
23 other prior art references, including the ’583 patent, can serve as secondary references
24 that modify the primary reference to achieve Deckers’ patented design. (*Id.*)

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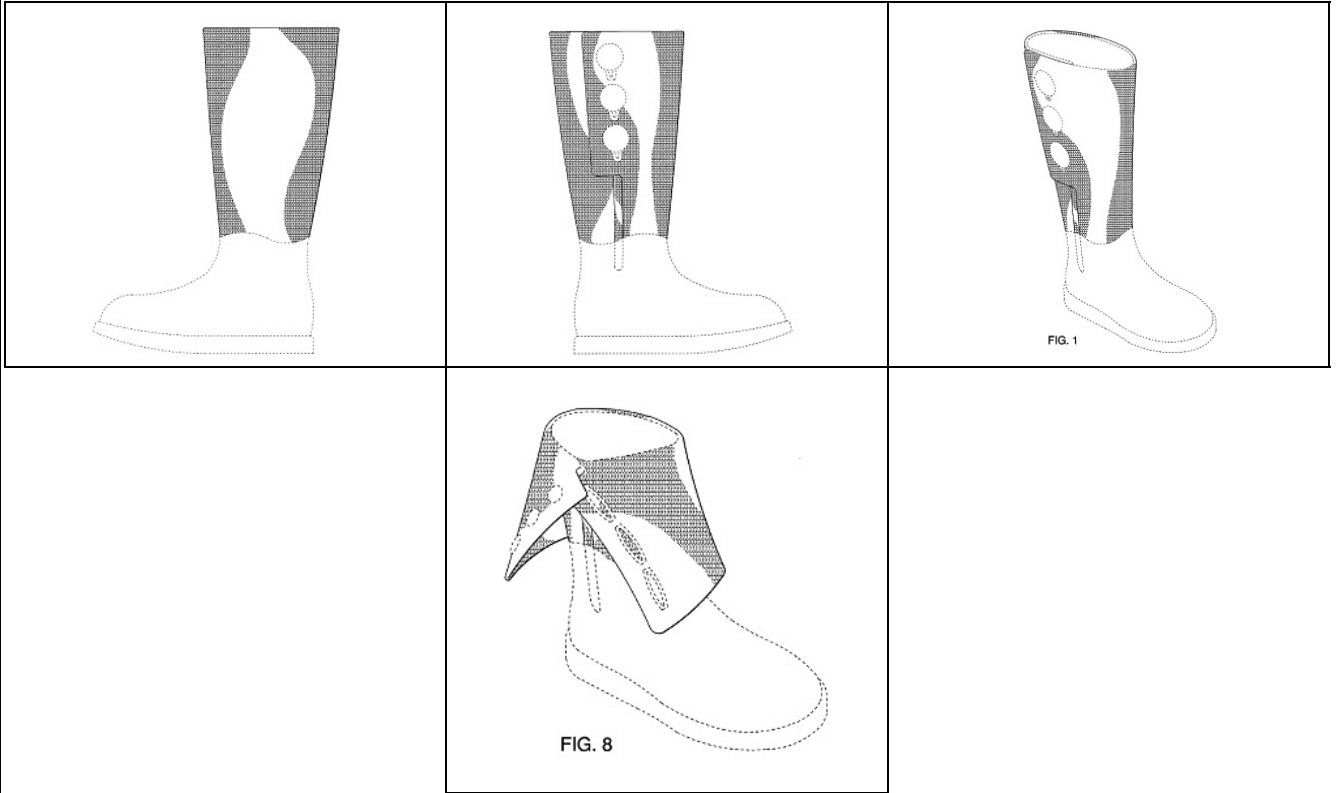
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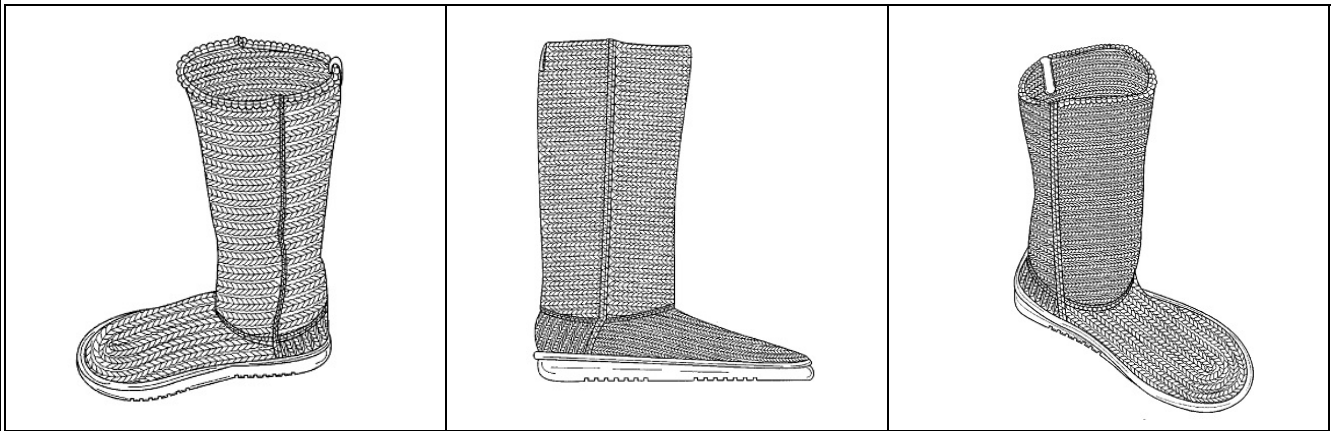
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The following illustrate several views of the '650 patent and the '983 patent:

'650 Patent



'983 Patent



The Court agrees with Deckers that no reasonable jury could find the boot

1 design in the '983 patent to be “basically the same” as the design in the '650 patent,
2 *High Point Design*, 730 F.3d at 1311, and thus it may not serve as the primary prior
3 art reference. The only similarities between the two boots are that they are high-shaft
4 boots seemingly comprised of knit material. Critically, however, the boot in the '983
5 patent has no side opening at all (let alone a side flap), its shaft is circular rather than
6 oval, and there are prominent seams running vertically up each side of the shaft.
7 Indeed, it is clear that the prominent design feature of the boot in the '650 patent is the
8 side flap and opening, which is wholly absent from the '983 patent. Moreover, the
9 side opening enables the shaft of the boot to be folded down (as shown in the final
10 picture), which allows the boot to take on a radically different look if the user so
11 chooses. This makes it markedly dissimilar from the '983 patent.

12 The Court is also not convinced that the side flap would be an obvious
13 modification to the '983 boot. Defendants point to the '583 patent, which shows a
14 zipper running down an otherwise-dissimilar high-shaft boot, and suggest that all side-
15 openings (including side-flaps) are simply common and obvious functional elements
16 that allow the user to insert their foot into the boot. While side-openings certainly
17 serve a functional purpose, the wide variation in types of side-openings show that
18 there are unique aesthetic characteristics among them—particularly with respect to the
19 '650 boot. For example, the side flap on the '650 patent extends only halfway down
20 the shaft, as opposed to all the way down the shaft; the flap overlaps the shaft material
21 substantially; and the shaft folds down to create a shorter boot. These are all unique to
22 the boot in the '650 patent, and Defendants do not identify any prior art references that
23 would suggest these features. The conclusory opinion of Defendants' expert to the
24 contrary is insufficient to create a genuine dispute on these issues. *See, e.g.,*
25 *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir.
26 2012). Thus, summary judgment as to Defendants' invalidity counterclaim for the
27 '650 patent is warranted.

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2. The '999 Patent

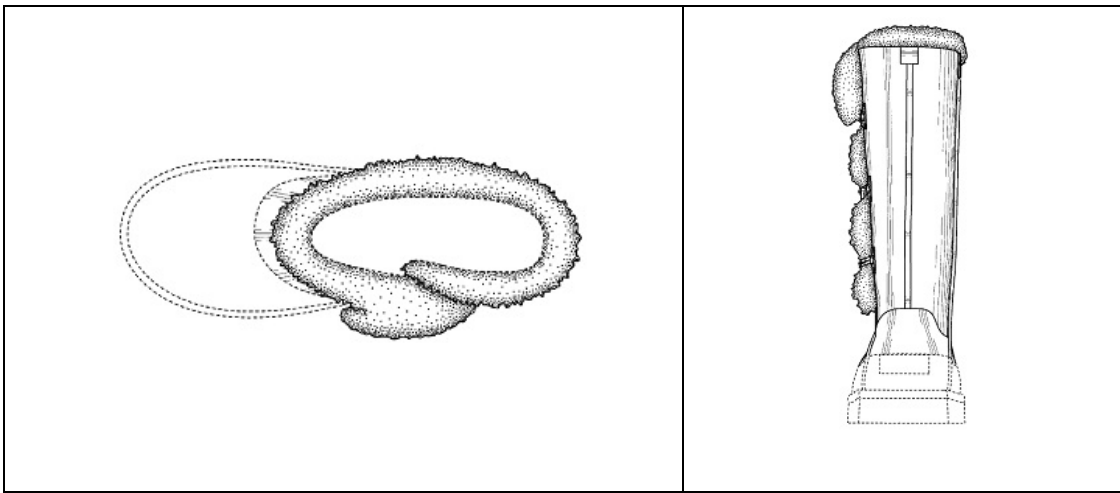
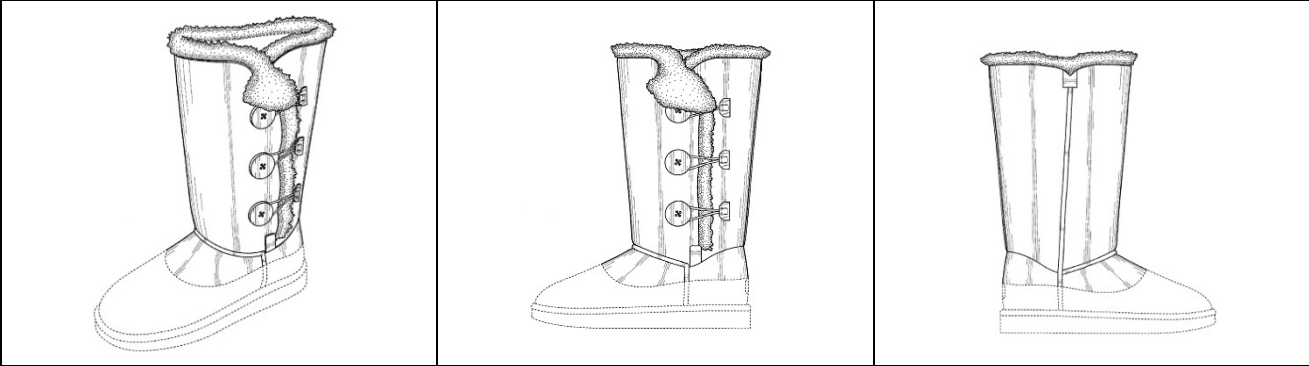
Defendants argue that the EMU Australia Barossa boot or the EMU Australia Matilda boot can serve as primary prior art references for the '999 boot. However, the Court has concluded that neither boot constitutes admissible prior art. Without any primary reference, Defendants cannot prove obviousness. Thus, summary judgment as to Defendants' invalidity counterclaim for the '999 patent is warranted.

3. The '189 Patent

i. Primary Prior Art Reference

Defendants argue that Deckers' UGG Bailey Button boot can serve as the primary prior art reference for the '189 boot. The following illustrate several views of the '189 design and the Bailey Button boot:

'189 Patent



1 **UGG Bailey Button Boot**



21 The Court concludes that a reasonable jury could view the UGG Bailey Button
22 boot as “basically the same” as the boot design in the ’189 patent, and thus the boot
23 can serve as a primary prior art reference. *High Point Design*, 730 F.3d at 1311.
24 There are substantial similarities between the two boots: the button-side of each boot
25 has the exact same pronounced vertical stitching; the exact same pronounced stitching
26 going across the front ankle portion of the boot; the exact same button, cross-stitching
27 attaching the button, button loop, and seam patch; the exact same pronounced vertical
28 stitching on the non-button side going from the sole to the top of the boot; the same V-

1 shaped notch at the top of the boot; the same fluffy interior lining protruding from the
2 top of the boot; and several other similarities.

3 Deckers' expert, Caroline de Baër, points out that the two boots are dissimilar
4 in that: (1) the boot shaft in the '189 patent is taller than the Bailey Button boot; (2)
5 the boot in the '189 patent has three button-loop systems, whereas the Bailey Button
6 boot only has one; and (3) the back of the boot in the '189 patent has a vertical seam
7 and a seam overlay patch, whereas the Bailey Button boot does not. (de Baër Decl.
8 ¶ 52.) The Court concludes that these differences do not necessarily preclude the
9 Bailey Button boot from serving as a primary prior art reference. The first two
10 differences are substantially interdependent—a shorter boot shaft requires fewer
11 button-loops—and thus do not really constitute two distinct differences. Moreover,
12 the taller shaft size of the '189 boot over the Bailey Button boot is not as significant a
13 difference as it might appear at first blush; indeed, a mere increase in shaft size (and
14 concomitant addition of two buttons-loops) is a conceptually simple and minor
15 modification to the Bailey Button boot. And while the absence of both a back seam
16 and a seam overlay patch does cut against a finding that the Bailey Button boot is a
17 primary prior art reference, the Court does not consider it to be dispositive on
18 summary judgment. Thus, a reasonable jury could conclude that the Bailey Button
19 boot is a primary prior art reference.

20 **ii. Other Prior Art References**

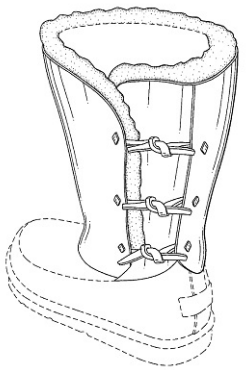
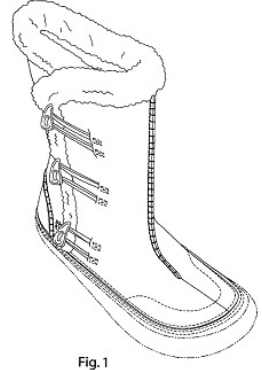
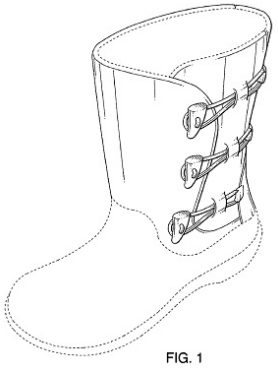
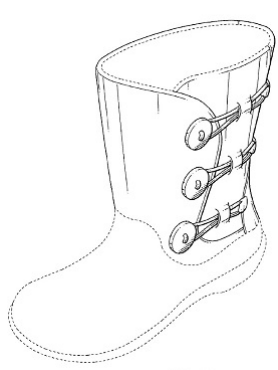
21 Defendants contend that there are four other patented boot designs that could be
22 used to modify the UGG Bailey Button boot to achieve the design in the '189 patent.
23 Each of these other patented boots consists of boots with tall shafts and three loop-
24 closure systems, as illustrated below:

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The '495 Patent	The '024 Patent	The '140 Patent	The '496 Patent

Defendants submit the declaration of their expert, Linda Poetsch, who attests that increasing the height of the shaft of the Bailey Button boot, so as to include three button loops instead of one, would be an obvious modification to a person reasonably skilled in the art at the time. (Poetsch Decl. ¶ 51.) While Deckers points out that Poetsch does not specifically reference these four patents in her declaration, she does reference other boots with similar triple-loop closure systems. (*Id.* ¶ 49.) The obvious import of her testimony is that a tall shaft and a triple-loop closure system are fairly common elements in certain boot designs, and thus they would be obvious modifications to make to the Bailey Button boot. To the extent Deckers' expert disagrees with Poetsch's conclusion, this is a factual dispute for the jury to resolve. Finally, Defendants' expert testifies that adding prominent stitching to a boot is also an obvious modification to one skilled in the art, thus also suggesting that the changes in the design as a whole were obvious.

iii. Secondary Considerations

Deckers points to various secondary indicia of non-obviousness. Secondary considerations include: "commercial success enjoyed by devices practicing the patented invention, industry praise for the patented invention, copying by others, and the existence of a long-felt but unsatisfied need for the invention." *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1052 (Fed. Cir. 2016). Deckers here points to: (1) the fact that the sale of Bailey Button Boots have exceeded 100,000 pairs every

1 year; (2) the fact that the Bailey Button Triplet (which is the embodiment of the '189
2 patent) “rank[s] high amongst the styles offered” by UGG; (3) the fact that the boot
3 receives significant unsolicited media exposure; and (4) the fact that the boot has been
4 the target of unauthorized third-party copying, as evidenced by the numerous
5 infringement lawsuits Deckers has filed. (Mot. at 17–18.) These considerations do
6 not warrant a different outcome. First, Deckers does not show that the commercial
7 success of the Bailey Button Boot is due to the unique features of the '189 patent.
8 *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010) (“[T]he patentee
9 must establish a nexus between the evidence of commercial success and the patented
10 invention.”). That is, it is not clear that the commercial success of the Bailey Button
11 Triplet was not due to general recognition of the UGG brand, the comfort (rather than
12 the look) of the boot, or even the basic look of the Bailey Button boot from which the
13 '189 patent improved on. *See J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d
14 1563, 1571 (Fed. Cir. 1997) (“[T]he asserted commercial success of the product must
15 be due to the merits of the claimed invention *beyond what was readily available in the*
16 *prior art.*” (emphasis added)). Second, the fact that Deckers has filed numerous
17 lawsuits against other companies for infringement of the '189 patent alone does not
18 establish copying. *Wyers*, 616 F.3d at 1246 (“Not every competing product that
19 arguably falls within the scope of a patent is evidence of copying; otherwise, ‘every
20 infringement suit would automatically confirm the nonobviousness of the patent.’”
21 (quoting *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir.
22 2004))). And while the remaining indicia identified by Deckers could suggest non-
23 obviousness to a reasonable jury, the Court is not convinced that the evidence is such
24 that *any* reasonable jury *must* conclude that the '189 patent is not obvious. *Cf. id.*
25 (“[S]econdary considerations of nonobviousness . . . simply cannot overcome a strong
26 prima facie case of obviousness.”).

27 For these reasons, summary judgment on obviousness as to the '189 patent is
28 inappropriate.

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4. The '781 Patent

Defendants contend that the UGG Rainier boot can serve as the primary prior art reference for this patent. The Court disagrees. First, the overall appearance of the UGG Rainier is unclear based on the evidence Defendants have presented. Defendants produce the following two pictures of the UGG Rainier boot:



The image on the right has not been authenticated at all, and thus it cannot be considered on summary judgment. *Orr*, 285 F.3d at 773. Indeed, it differs quite significantly from the image on the left in several respects: it has no lace tied around the ankle portion of the boot; the fur appears less fluffy and does not come as far down the ankle; and there appears to be an enlarged ridge around the top opening. These differences cast substantial doubt on the image’s authenticity. Moreover, the image on the left gives only a single view of the boot. Based on this single view, no reasonable factfinder could find by clear and convincing evidence that the design characteristics of this boot are “basically the same” as the images in the '781, *High Point Design*, 730 F.3d at 1311, for the simple fact that one would not even know what the other half of the UGG Rainier boot looks like. Thus, summary judgment as to Defendants’ invalidity counterclaim for the '781 patent is warranted.

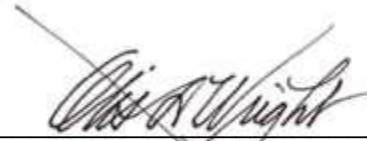
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IV. CONCLUSION

For the reasons discussed above, the Court **GRANTS IN PART** and **DENIES IN PART** Deckers' Motion for Summary Judgment. (ECF No. 89.) The Court holds that Deckers is entitled to summary judgment on Defendants' counterclaims for invalidity of the '650 patent, the '999 patent, and the '781 patent. The Court concludes that genuine issues of material fact preclude summary judgment on Defendants' counterclaims for invalidity of the '189 patent.

IT IS SO ORDERED.

June 13, 2017



OTIS D. WRIGHT, II
UNITED STATES DISTRICT JUDGE