

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

CONVERSE INC.,

Plaintiff,

v.

STEVEN MADDEN, LTD.

Defendant.

C.A. No. 20-11032-NMG

**CONVERSE INC.'S OPPOSITION TO STEVEN MADDEN, LTD.'S
MOTION TO PARTIALLY DISMISS THE COMPLAINT**

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I. INTRODUCTION

Converse filed this lawsuit because Madden continues to willfully infringe Converse's patented sneaker designs despite repeated requests that it stop. Converse provided detailed infringement allegations in its Complaint, including side-by-side comparisons of its patented designs and the infringing sneakers. In response, Madden filed its motion to partially dismiss the Complaint. But Madden does not challenge the sufficiency of Converse's allegations under the relevant pleading standards. Madden instead challenges the merits of one of Converse's infringement allegations. Madden's motion should be denied for three reasons.

First, Converse's allegations exceed the pleading requirements for stating a claim for design patent infringement. Madden does not dispute this point.

Second, Madden's merits-based challenge is premature under Federal Circuit law and other relevant authority. To grant Madden's motion, the Court would first need to issue a claim construction ruling without the type of evidentiary record required by the Federal Circuit and the Local Patent Rules. The Court would then need to conduct the jury's infringement analysis based solely on its premature claim construction and again without the required evidentiary record. The salient factual inquiry for the jury turns on whether the "ordinary observer"—not Madden's attorneys—would find the claimed and accused designs substantially similar when viewed as a whole. These claim construction and infringement determinations cannot be made in this case at the pleading stage and without the required evidentiary record.

Third, even if the merits of Converse's allegations were ripe for resolution, Madden's non-infringement argument still fails. Madden's proposed claim construction is incorrect. Moreover, Madden failed to present any evidence establishing, as a matter of law, that under its incorrect claim construction the ordinary observer would find the claimed and accused designs are not substantially similar. The only evidence at this point is Converse's infringement

allegation that Madden's accused sneakers bear designs that, in the eye of an ordinary observer, are substantially the same as the claimed designs. Converse's allegations must be accepted as true and they preclude dismissal.

II. BACKGROUND

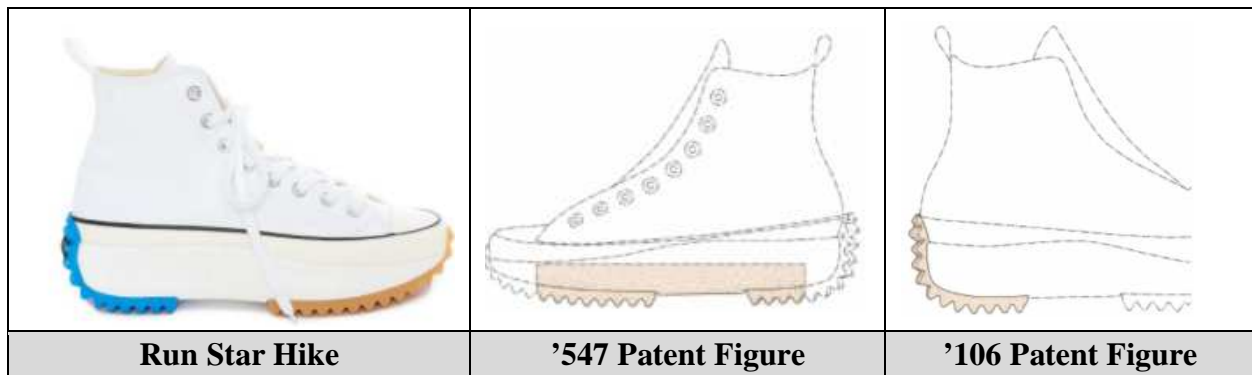
Converse was founded in Massachusetts in 1908. Complaint (Dkt. No. 1) ¶ 12. It is a leading producer of original sneaker designs, producing several iconic designs over the past century. *Id.*, at ¶ 13. One of Converse's more recent designs is its Run Star Hike. *Id.* Converse released the Run Star Hike sneaker in 2019. *Id.*, at ¶ 14. The sneaker has since enjoyed success in part because of its unique ornamental design. *Id.*, at ¶ 15.

Converse's Run Star Hike design is an important component of Converse's strategy, and it is integral to Converse's success moving forward. *Id.*, at ¶ 16. As such, Converse has taken steps to protect the design, including by obtaining design patents. *Id.*, at ¶ 17. A patent grants its owner the right to exclude others from practicing the patent's "claim." 35 U.S.C. § 271. A design patent, in particular, protects the ornamental design of an article of manufacture, such as a sneaker. 35 U.S.C. § 171. The "claim" of a design patent is shown in its figures, and the scope of exclusion is defined by the overall visual impression of the claimed portion in the figures. *Id.*

The patent laws permit inventors to obtain multiple patents protecting a design applied to an article of manufacture. Inventors may obtain patents protecting the entire design, and inventors may also obtain patents protecting a partial portion of the design. *Id.*; see also *Times Three Clothier, LLC v. Spanx, Inc.*, No. 13-cv-2157, 2014 WL 1688130, at *8 (S.D.N.Y. Apr. 29, 2014) (inventor "may claim a design for a portion of an article of manufacture and need not claim a design for a 'complete article[]'") (citing *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980)).

To claim a partial portion of a design, inventors use solid and broken lines in the figures of the patent. *See* M.P.E.P. § 1503.01(III). Solid lines indicate the claimed partial portions of the design and broken lines indicate the unclaimed portions. *Id.*; *Apple, Inc. v. Samsung Elecs. Co.*, No. 11-CV-01846-LHK, 2012 WL 3071477, at *4 (N.D. Cal. July 27, 2012) (inventor “may indicate the claimed part of the design with the use of solid lines and may indicate the unclaimed, remaining article of manufacture with the use of broken lines.”); 37 C.F.R. § 1.152 (“The use of broken lines indicates that the environmental structure or the portion of the article depicted in broken lines forms no part of the design, and is not to indicate the relative importance of parts of a design.”); M.P.E.P. § 1503.02(III) (“Unclaimed subject matter may be shown in broken lines for the purpose of illustrating the environment in which the article embodying the design is used.”).

Converse owns several patents protecting its Run Star Hike design, including the asserted patents in this case: U.S. Patent Nos. D873,547 (the “’547 patent”) and D874,106 (the “’106 patent”). Complaint, at ¶ 17. The asserted patents claim partial portions of the design. *Id.*, at Exs. A and B. The claimed portions are indicated in solid lines in the patent figures, and the unclaimed portions are indicated in broken lines. *Id.* Below Converse reproduces an image of its Run Star Hike sneaker and example figures from the asserted patents to illustrate the partial portion of the design that each patent claims. The claimed portions are highlighted in yellow.





Earlier this year, Madden began selling sneakers that copy these patented portions of Converse’s Run Start Hike design. *Id.*, at ¶¶ 20-33. Converse notified Madden of its infringements and asked that it stop. *Id.* Madden not only refused to stop, but it escalated its unlawful conduct by releasing additional infringing sneakers. *Id.* Madden has now released at least two infringing sneakers, including its Shark sneakers and its Winnona sneakers. Both sneakers infringe the ’106 patent (Count I of Complaint), and the Shark sneakers also infringe the ’547 patent (Count II of the Complaint). *Id.*, at ¶¶ 20, 34-45. Below Converse reproduces figures from the asserted patents next to images of the infringing sneakers. *Id.*

Count I of the Complaint

		
'106 Patent Figure	Shark Sneaker	Winnona Sneaker

Count II of the Complaint

	
'547 Patent Figure	Shark Sneaker

Converse filed its Complaint on May 29, 2020. Dkt. No. 1. Madden obtained three extensions of time to respond. Dkt. Nos. 10-16. Madden then filed its motion to dismiss Converse’s infringement allegations as to the Winnona sneakers—*i.e.*, to dismiss Count I as to the Winnona sneakers. Dkt. Nos. 19-20. The parties have not engaged in other substantive case

activity to date. The parties have not conducted fact or expert discovery, the parties have not exchanged the patent disclosures required by the Local Patent Rules, and the parties have not exchanged the claim construction disclosures required by the Local Patent Rules.

III. ARGUMENT

A. CONVERSE EXCEEDED THE PLEADING REQUIREMENTS FOR STATING A CLAIM FOR DESIGN PATENT INFRINGEMENT

Madden ignores the proper standard for pleading a claim for design patent infringement. A design patent infringement count is properly pleaded under Rule 12(b)(6) if it “(i) allege[s] ownership of the patent, (ii) name[s] each defendant, (iii) cite[s] the patent that is allegedly infringed, (iv) state[s] the means by which the defendant allegedly infringes, and (v) point[s] to the sections of the patent law invoked” with “enough detail to allow the defendants to answer.” *Hall v. Bed Bath & Beyond, Inc.*, 705 F.3d 1357, 1362 (Fed. Cir. 2013); *see also Shure Inc. v. ClearOne, Inc.*, No. CV 19-1343, 2020 WL 2839294, at *13 (D. Del. June 1, 2020) (using the *Hall* factors to evaluate a motion to dismiss); *Nikola Corp. v. Tesla, Inc.*, No. 3:18-CV-07460-JD, 2020 WL 5408059, at *2 (N.D. Cal. Sept. 9, 2020) (“Overall, the [complaint] identified the proper legal standard, alleged specific facts about infringement, and presented evidence of confusion among likely ordinary observers. Rule 8 requires no more for a design infringement claim.”). Furthermore, a patentee’s assertion that the accused product is substantially the same (which, under Rule 12(b)(6), must be taken as true) is sufficient to present a plausible claim under the *Twombly* standard. *See Hall*, 705 F.3d at 1363 (holding that patentee’s assertion that the accused design is “virtually identical in design” to the patented design was sufficiently plausible to survive a motion to dismiss).

Converse’s infringement allegations for the ’106 patent and Winnona sneakers exceed the pleading standard. Converse (i) alleges ownership of the asserted patents, including the ’106

patent, (ii) names the defendant, Madden, (iii) cites the patents that are allegedly infringed, including the '106 patent, (iv) states the means by which Madden infringes, including by making, using, offering to sell, selling, and/or importing into the United States the Shark sneakers and Winnona sneakers, and (v) points to the sections of the patent law invoked with enough detail to allow Madden to answer. *See* Complaint, at ¶¶ 17, 21, 35. Furthermore, Converse provided figures highlighting the claimed portions of the asserted patents, detailed side-by-side comparisons of those claimed portions and the corresponding portions of the accused sneakers, and detailed allegations that the accused sneakers are substantially the same as the claimed designs in the eye of the ordinary observer. *Id.*, at ¶¶ 21-33; 34-39.

Thus, Converse's infringement allegations present more than the requisite plausible claim. Converse requests that the Court deny Madden's motion for this reason alone.

B. MADDEN'S MOTION IS PREMATURE BECAUSE IT REQUIRES THE COURT TO ISSUE A CLAIM CONSTRUCTION RULING AND CONDUCT THE JURY'S INFRINGEMENT ANALYSIS, BOTH WITHOUT THE REQUIRED EVIDENTIARY RECORD

Madden does not challenge the sufficiency of Converse's complaint itself under the applicable pleading standard as discussed above. Madden instead urges the Court to make two substantive determinations on the merits and without a developed evidentiary record. Madden asks the Court to (i) construe the claim of the '106 patent, and (ii) conduct the jury's infringement analysis. Both requests are premature at this stage in this case. *Hall*, 705 F.3d at 1364 (“[The] court’s task in ruling on a Rule 12(b)(6) motion is merely to assess the legal feasibility of the complaint, not to assay the weight of the evidence which might be offered in support thereof.”).

First, Madden asks the Court to construe the claim of the '106 patent. Mot. at 10, 13. In particular, Madden argues the Court “must” verbally construe the claim of the '106 patent “to cover a tread design that is located only at the rear, heel portion of the sole of the shoe, and such

tread design cannot extend beyond that rear heel portion of the sole.” *Id.* Madden’s proposed construction is incorrect for a number of reasons that Converse addresses in Section III.C below. As a preliminary matter, however, it is premature for the Court to even consider Madden’s proposed claim construction at this stage in this case. The Federal Circuit has cautioned that such claim construction determinations are typically “not suitable for resolution on motion to dismiss.” *See Nalco Co. v. Chem-Mod, LLC*, 883 F.3d 1337, 1349 (Fed. Cir. 2018).

This Court and others have followed the Federal Circuit’s guidance and denied motions to dismiss that would have required the courts to construe design patent claims at the pleading stage. *See, e.g., First Act Inc. v. Kids Station (U.S.) Inc.*, No. CV 05-12114, 2006 WL 8458337, at *3 (D. Mass. Apr. 4, 2006) (“Since this proceeding is not yet at the claim construction stage, I will for the purposes of this motion assume that the patents protect as broadly as plaintiff asserts. Based on this assumption, plaintiff has pleaded sufficiently to state a claim for patent infringement. The ‘ordinary observer’ test requires only that plaintiff allege that defendant’s design is substantially similar to plaintiff’s patented design[.]”) (citations omitted); *simplehuman, LLC v. iTouchless Housewares & Prod., Inc.*, No. 19-CV-02701-HSG, 2019 WL 5963245, at *5 (N.D. Cal. Nov. 13, 2019) (construction questions such as what falls outside of the claimed design and interpretation of dashed lines are “properly considered at claim construction, and the Court declines to do so at this preliminary stage.”); *Shure Inc.*, 2020 WL 2839294, at *14 (“As even ClearOne acknowledges, assessing its non-infringement argument would require claim construction. . . . Thus, ClearOne’s argument is premature.”).

This Court’s Local Patent Rules are consistent with the Federal Circuit’s guidance. The Court recently overhauled the rules in an effort to promote consistency across patent cases and to streamline patent litigation. *See* Local Rule 16.6. The rules provide for an orderly exchange of

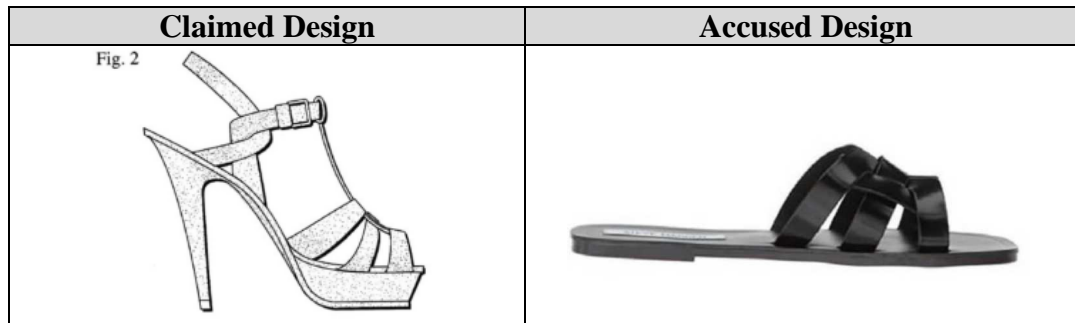
information to build an evidentiary record and frame disputes *before* the Court issues its claim construction ruling. *Id.* The parties first exchange automatic patent-related disclosures. *Id.* Those disclosures are followed by formal claim construction proceedings, which include claim construction-related discovery, joint claim construction statements, claim construction briefing, and a claim construction hearing. *Id.* Madden would have the Court disregard these rules, as well as Federal Circuit law, and proceed directly to a claim construction ruling without a developed evidentiary record.

Second, Madden asks the Court to conduct the jury's infringement analysis based solely on Madden's incorrect claim construction. Mot. at 14-17. In design patent infringement cases, the fact finder—the jury in this case—must compare the properly construed claim to the accused design. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). In comparing the designs, the jury applies the ordinary observer test—*i.e.*, infringement is found “[i]f in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008) (en banc) (*quoting Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871)). The proper comparison is between the overall visual impression of the claimed design, as indicated in solid lines in the patent figures, and the overall visual impression of the corresponding portion of the accused design. *Id.*; *Crocs, Inc. v. Int'l Trade Com'n*, 598 F.3d 1294, 1304 (Fed. Cir. 2010).

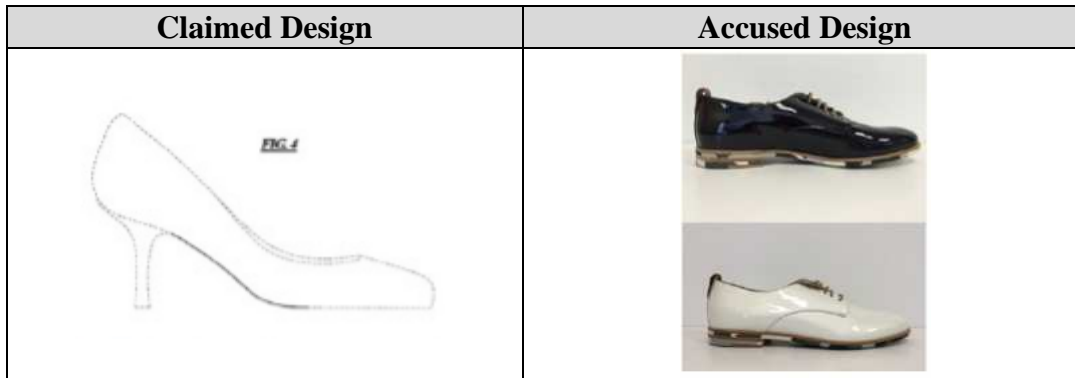
The ordinary observer inquiry is a question of fact. *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1287 (Fed. Cir. 2002). As such, design patent cases are typically not suitable for dismissal under Rule 12(b)(6). *See Richardson v. Stanley Works, Inc.*, 597 F.3d

1288, 1295 (Fed. Cir. 2010). As courts have explained, it is “improper in a situation like this one to contend that a plaintiff has failed to allege design-patent infringement based on a comparison of the subject designs, since the Court must accept all factual allegations as true in deciding a Rule 12(b)(6) motion.” *Deckers Outdoor Corp. v. J.C. Penney Co. Inc.*, 45 F. Supp. 3d 1181, 1186 (C.D. Cal. 2014) (citing *Catalina Lighting*, 295 F.3d at 1287); *see also Nikola Corp.*, 2020 WL 5408059, at *2 (refusing dismissal because design infringement is primarily a question of fact); *Five Star Gourmet Foods, Inc. v. Fresh Express, Inc.*, No. 19-CV-05611-PJH, 2020 WL 513287, at *9 (N.D. Cal. Jan. 31, 2020) (“The court declines to resolve this inherently factual question [of whether designs are substantially the same] on this motion to dismiss”).

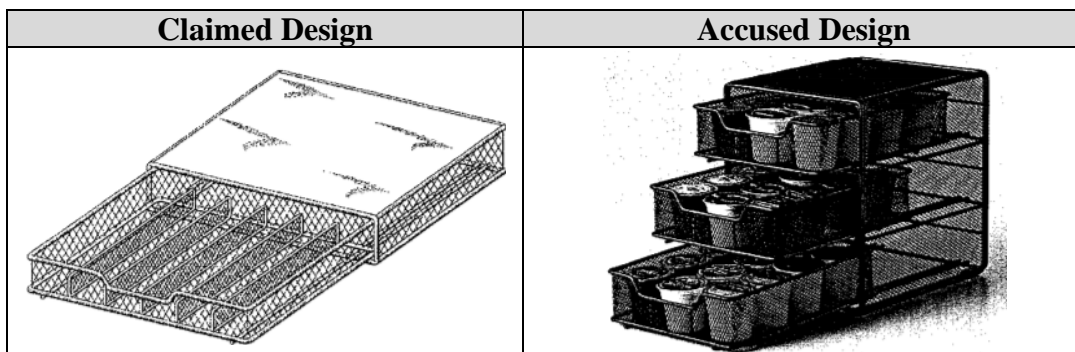
Madden cites three cases where courts dismissed a design patent infringement claim at the pleading stage. Mot. at 7. But Madden’s reliance on those cases is misplaced. Each of the cases held that no questions of fact remained for the jury because the claimed and accused designs were “plainly dissimilar” in that the claimed design was applied to entirely different product than the accused design. For example, in *Madden v. YSL*, the asserted patent claimed a design applied to a high-heeled dress shoe—the entire shoe was claimed in solid lines. *Steven Madden, Ltd. v. Yves Saint Laurent*, No. 18-CV-7592 (VEC), 2019 WL 2023766, at *3 (S.D.N.Y. May 8, 2019). The accused product, in contrast, was a flat sandal. *Id.* The court found the overall visual impressions of the two designs were plainly dissimilar because they were applied to different shoe styles. *Id.* The dissimilarity is shown below.



Likewise, in *Silverman v. Leombruni*, the asserted patent claimed a design applied to the outsole of a high-heeled dress shoe. No. 15 CIV. 2260, 2016 WL 715735, at *3 (S.D.N.Y. Feb. 19, 2016). In contrast, the accused product was a flat oxford-style shoe without a high-heel. *Id.* The court found that the overall visual impressions of the two designs were plainly dissimilar because they were applied to different shoe styles. *Id.* The dissimilarity of is shown below.



In *MSA Prods., Inc. v. Nifty Home Prods., Inc.*, the asserted patent claimed a design applied to a single-level drawer—the entire drawer was claimed in solid lines. 883 F. Supp. 2d 535, 541-42 (D.N.J. 2012). The accused product, in contrast, was a three-level set of drawers. *Id.* The court found the overall visual impressions of the two designs were plainly dissimilar because they were applied to different drawer styles. *Id.* The dissimilarity is shown below.



In the instant case, unlike the cases cited by Madden, Converse’s claimed design and Madden’s accused design are applied to the same style of sneakers and they are applied in the

same location on the sneakers. *See* Complaint, at ¶ 21. Converse illustrated the overall visual similarity of the sneaker styles and the relevant portions of the designs in its Complaint. *Id.*

Thus, Madden’s merits-based challenge is premature. Converse requests that the Court deny Madden’s motion for this additional reason.

C. EVEN IF THE COURT ADDRESSES THE MERITS AT THIS EARLY STAGE AND WITHOUT THE REQUIRED EVIDENTIARY RECORD, MADDEN’S NON-INFRINGEMENT ARGUMENT STILL FAILS

Madden’s non-infringement argument fails on the merits for at least two reasons. First, Madden’s proposed claim construction for the ’106 patent is incorrect. Second, Madden failed to present any evidence establishing, as a matter of law, that under its incorrect claim construction the ordinary observer would find the claimed and accused designs are not substantially similar.

1. Madden’s proposed claim construction is incorrect

Claim construction is the legal process of defining the metes and bounds of a patented invention. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1000 (Fed. Cir. 1995) (Newman, J., dissenting). The modern claim construction process grew out of utility patent cases, where courts are expected to define the metes and bounds—or “scope”—of claimed inventions by construing the words of written claims. *See generally id.* In contrast, the scope of a design patent is shown by its drawings. *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993) (design patent scope is “limited to what is shown in the application drawings”).

Because design patents are visual, not verbal, the Federal Circuit has “cautioned, and continues to caution, trial courts about excessive reliance on a detailed verbal description.” *Crocs*, 598 F.3d at 1302 (citing *Egyptian Goddess*, 543 F.3d at 679). Claim construction in a design patent case “must be adapted to a pictorial setting,” and courts must guard against “undue emphasis on particular features of the design rather than examination of the design as a whole.” *Id.* Verbal descriptions risk “that a finder of fact will focus on each individual described feature

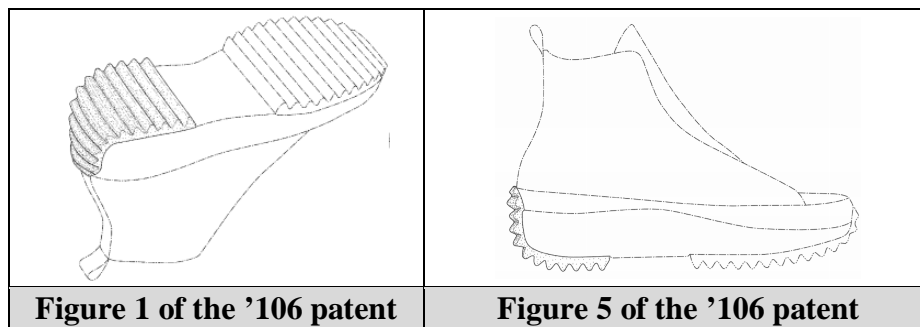
in the verbal description rather than on the design as a whole.” *Egyptian Goddess*, 543 F.3d at 680 (“[A]s a general matter ... courts should not treat the process of claim construction as requiring a detailed verbal description of the claimed design....”).

Consistent with that guidance, the proper claim construction for the ’106 patent is simply what is shown in solid lines in the patent figures. That is, the Court should construe the claim as “the overall visual impression created by what is shown in solid lines in the figures of the patent, and the broken lines depicting the remainder of the sneaker show features that form no part of the claimed design.” *Egyptian Goddess*, 543 F.3d at 679 (“Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.”); *Hutzler Mfg. Co., Inc. v. Bradshaw Intl., Inc.*, No. 11 Civ. 7211, 2012 WL 3031150, at *5 (S.D.N.Y. July 25, 2012) (finding that “the claims articulated in each of the design patents at issue are unambiguous and are clearly illustrated by the figures contained therein”; the “[c]ourt will not provide a detailed verbal description ... and will rely instead on the illustrations set out in the patents.”).

Madden incorrectly argues the Court should construe the claim of the ’106 patent with a detailed verbal description, including that the “tread design” is “limited in location to the rear, heel portion of the sole of the shoe, and nowhere else, stopping at solid line A.” Mot. at 11 (emphasis added). Madden’s construction is incorrect for at least two reasons.

First, Madden improperly ignores Federal Circuit law cautioning against construing design patents with detailed verbal descriptions. *Crocs*, 598 F.3d at 1302; *Egyptian Goddess*, 543 F.3d at 679. And Madden’s proposal shows why the Federal Circuit cautions against verbal descriptions. Madden’s proposal improperly adds limitations that find no support in the patent

figures. In fact, Madden’s proposal is contradicted by the figures. Madden’s proposal requires that the “tread design” be strictly limited to the “rear, heel portion” of the outsole and nowhere else. But the figures depict “tread design” in several claimed and unclaimed areas, including (i) in the claimed area on the rear, heel portion of the outsole, (ii) in the claimed area extending up the back heel of the sneaker but not technically the outsole, and (iii) in the unclaimed front toe area of the outsole. Complaint, Ex. B. Figures 1 and 5 of the ’106 patent, reproduced below, show the “tread design” in these multiple claimed and unclaimed areas extending beyond the solid line Madden refers to as “solid line A.” *Id.*

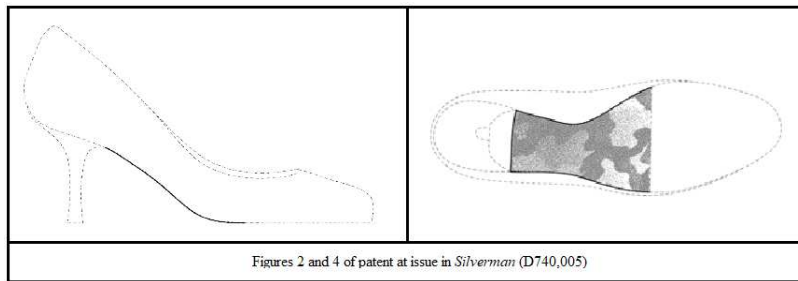


Second, Madden’s sole argument for its construction is that the claimed portion of the ’106 patent is “bounded on all sides by solid lines[.]” Mot. at 11. But Madden’s argument misunderstands design patent law. The purpose of solid lines in design patents is to indicate what is claimed.¹ *See* M.P.E.P. § 1503.01(III); *Apple, Inc.*, 2012 WL 3071477, at *4 (“The patentee may indicate the claimed part of the design with the use of solid lines[.]”). That is, the solid lines referenced by Madden indicate what is claimed in the ’106 patent. *Id.* They do not indicate a “hard stop” past which the claimed design may not extend. *Id.*

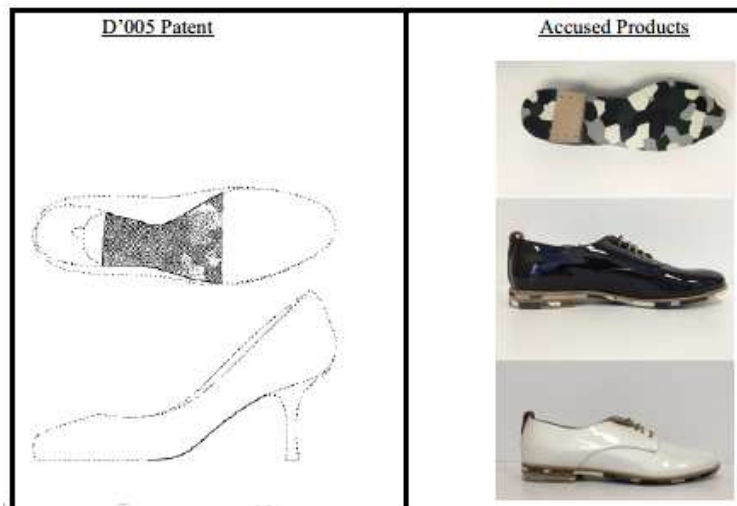
Tellingly, Madden fails to provide any case law or other authority that actually supports

¹ Madden’s characterization of “solid line A” as a boundary line past which the claimed design may not extend is also contrary to design patent principles, as boundary lines are typically depicted in *broken lines* and clearly described as such. *See* M.P.E.P. § 1503.01(III).

its argument that the solid lines in the figures of the '106 patent form a “hard stop” or “distinct boundary” beyond which the “trade design” may not extend. Motion at 11-14. Madden relies on *Silverman*. See Mot. at 12-13 (citing *Silverman*, 2016 WL 715735, at *3). But *Silverman* did not hold, as Madden incorrectly argues, that the claimed camouflage design at issue in that case covered only the middle portion of a shoe because it was “bound by solid lines on all four sides.” Mot. at 13. In fact, the claimed camouflage design at issue in *Silverman* was bound by solid lines on only three sides, not four sides:



The *Silverman* court’s determination that the claimed design extended “only to a woman’s high-heeled dress shoe in which the camouflage pattern covers only the middle portion of the sole of the shoe” turned on facts and issues not present in this case. *Silverman*, 2016 WL 715735, at *2-3 The asserted patent in *Silverman* depicted a camouflage pattern on a women’s high-heeled shoe, alleged to be infringed by defendant’s shoe, a women’s oxford-style shoe:



Id., Dkt. No. 36 (Def.'s Memo. In Support of Motion to Dismiss) at 4 (Dec. 23, 2015). The defendant argued the patent figures "unequivocally show a high heeled shoe with a narrow heel and no other style." *Id.*, at 8. In response, plaintiffs urged the court to disregard that the patent figures depicted the design on a high-heeled shoe, and instead hold that the "design patent protection extends to all colors, all heels, all flats and high stilettos, all open and closed toes and all shoes that have a midsole decorative camouflage design." *Id.*, Dkt. No. 37 (Plaintiffs' Opposition to Motion to Dismiss) at 3, 8-9 (Jan. 15, 2016). The court refused to do so. The court explained that "the portion in dotted lines is the claimed design's environment," and the depicted environment was that of a high-heeled shoe. *Id.* at *2. The court, therefore, determined the claimed design extended only to a women's high heel shoe in which the camouflage pattern covers the middle portion of the sole. *Id.* at *2.

The court determined the design covered the middle portion of a high-heeled shoe, not because of solid lines in the patent figures, but because the "distinction between patterns covering only the middle, visible portion of the sole of a woman's highheeled dress shoe versus the entire sole has significance in the woman's luxury shoe industry[.]" *Id.* n.2 The court noted the middle, visible portion of the heel creates a contrast between the sole and the upper that causes the sole to "pop." *Id.* Here, in contrast, the '106 patent does not depict a high-heeled shoe, and it does not claim design elements such as color or colored patterns meant to make a high-heeled shoe "pop." Thus, *Silverman* does not support Madden's argument that the solid lines in the figures of the '106 patent form a "distinct boundary" or "hard stop."

Consequently, Madden's proposed claim construction for the '106 patent is incorrect and should be rejected. Converse requests that the Court deny Madden's motion for this additional reason.

2. Madden failed to present evidence establishing, as a matter of law, that the ordinary observer would find the claimed and accused designs are not substantially similar

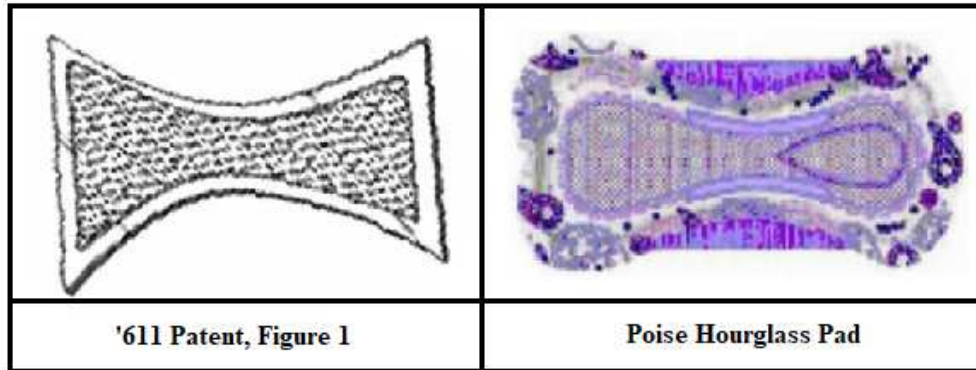
As Converse explained above in Section III.B, this is not the type of case where the Court may short-circuit the infringement analysis as a matter of law because the claimed and accused designs are applied to entirely different products. To grant Madden’s motion, therefore, the Court would need to find the evidentiary record establishes, as a matter of law, that the claimed and accused designs, when viewed as a whole in the eye of the ordinary observer, are not substantially the same. But Madden has not—and cannot at this stage of case—present evidence to support such a finding.

Madden tacitly acknowledges the overall visual similarity between the claimed and accused designs by not disputing that the claimed portion of the ’106 patent shown in solid lines and the corresponding portion of the design of the Winnona sneakers are substantially the same. *See, e.g.*, Mot. at 14-15. Indeed, the only record evidence at this point is Converse’s infringement allegation that Madden’s accused sneaker bears a design that, in the eye of an ordinary observer, is substantially the same as the claimed design. Complaint, ¶ 21. Converse’s allegations must be accepted as true and they preclude dismissal. *See, e.g., Deckers Outdoor*, 45 F. Supp. 3d at 1186 (C.D. Cal. 2014).

Instead of relying on record evidence, Madden bases its non-infringement position on flawed attorney argument, which invites legal error for a number of reasons. *First*, Madden’s attorney argument incorrectly relies on the existence of design elements in unclaimed areas of the Winnona sneakers to argue non-infringement. *Id.* at 14-17. Specifically, Madden’s attorneys argue the Winnona sneakers do not infringe because the “tread design” on the Winnona sneakers “runs the full length of the sole of the sneaker[.]” *Id.* at 14-15. In other words, Madden’s attorneys argue the Winnona sneakers do not infringe because the sneakers contain “tread

design” in the middle portion and front portion of the outsole. *Id.* at 15. But the middle and front portions of the outsole are *not* part of the claimed design. *See e.g., Poly-Am., L.P. v. API Indus., Inc.*, 36 F. Supp. 3d 444, 446 (D. Del. 2014) (denying motion for judgment of non-infringement on the pleadings and stating, *inter alia*, “[t]he solid bottom cannot be a design difference that renders the accused product substantially dissimilar because it is not an ornamental design feature” of the claimed box design.). Moreover, Madden fails to present any evidence that shows “tread design” in the middle and front outsole portions of the Winnona sneakers would, as a matter of law, cause the ordinary observer to conclude the claimed and accused designs are not substantially the same. Madden’s focus on specific, unclaimed features while ignoring similarities between the designs ignores the fundamental tenet of design patent law that, in evaluating infringement, any differences “must be evaluated in the context of the claimed design as a whole, and not in the context of separate elements in isolation.” *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1335 (Fed. Cir. 2015).

Madden’s cited cases do not support its attorneys’ attempt to argue non-infringement based on the presence of additional, unclaimed features. Mot. at 15-17. In *Silverman*, the court found dissimilarity because: (1) “the [accused and claimed] designs are on different types of shoes[,]” (2) “the camouflage designs are used differently,” and (3) “the two camouflage designs are notably distinct.” 2016 WL 715735, at *3. Similarly, in *YSL*, the accused and claimed designs were on different types of shoes (high-heeled shoe vs. flat sandal). 2019 WL 2023766, at *3. Likewise, in *Curver Lux., SARL v. Home Expressions, Inc.*, the accused product (baskets) and patented design (chair) were completely different products. 938 F.3d 1334, 1343 (Fed. Cir. 2019). Moreover, in *Parker v. Kimberly-Clark Corp.*, a visual comparison of the patent and accused designs illustrated fundamental differences between the two designs:



No. 11 C 5658, 2012 WL 74855, at *2 (N.D. Ill. Jan. 10, 2012). Here, in contrast, the claimed design of the '106 patent and the corresponding design on Madden's infringing Winnona sneakers are applied to the same style of sneakers and share substantial visual similarities. *See* Complaint, at ¶ 21.

Second, the words Madden's attorneys use to characterize the claimed design and the Winnona sneakers are irrelevant. *See Oakley, Inc. v. Trillion Top Co. Ltd. LLC*, No. SACV1701580AGJCGX, 2018 WL 5099484, at *3 (C.D. Cal. June 4, 2018) ("a design patent 'is claimed as shown in its drawing'"). The side-by-side images in Converse's Complaint speak for themselves and show the claimed design and the corresponding portion of the Winnona sneakers, ***however described in words***, have substantially the same ***overall visual appearance***. Complaint ¶ 21.

Third, and finally, Madden's cursory infringement analysis leaves unanswered many factual questions that are central to a design patent case. For example, a "question that is central to this case, and every design patent case, is the identity of the 'ordinary observer' of the design at issue." *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1321 (Fed. Cir. 2007). While Madden acknowledges the test for infringement looks to the ordinary observer (Mot. at 7), it does not attempt to identify the ordinary observer in its Motion. Additional unanswered factual questions involve, for example, the alleged design differences and whether

they are “relevant differences.” *Poly-Am.*, 36 F. Supp. 3d at 447 (“It also remains an issue of fact whether the perforated extension of the accused design is actually a relevant difference, i.e., whether an ordinary observer would actually open the accused box to its full extent if not necessary to reach the product.”).

Thus, because factual issues remain, a finding of non-infringement as a matter of law is improper at this early stage in this case. *See, e.g., id.* at 445 (“The purpose of judgment on the pleadings is to dispose of claims where the material facts are undisputed.”). Converse requests that the Court deny Madden’s motion for this additional reason.

D. ORAL ARGUMENT IS UNNECESSARY

Madden requested oral argument. Converse contends oral argument is unnecessary because the issues are sufficiently briefed and Madden’s motion should be denied for the reasons set forth in this opposition. That said, should the Court determine oral argument would be helpful, Converse is available at the Court’s convenience.

IV. CONCLUSION

Converse’s complaint is sufficient on its face, asserting more than the requisite plausible claim that Madden’s Winnona sneakers infringe the asserted ’106 patent. Converse requests that the Court deny Madden’s motion.

Dated: October 12, 2020

Respectfully submitted,

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Certificate of Service

I hereby certify that on October 12, 2020, a true and correct copy of this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing.

/s/ Michael J. Harris

Attorney for Plaintiff Converse Inc.