

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

CONVERSE INC.,

Plaintiff,

v.

STEVEN MADDEN, LTD.,

Defendant.

Civil Action No.: 20-11032-NMG

**Leave to file granted on
November 20, 2020**

**REPLY MEMORANDUM OF LAW IN SUPPORT OF DEFENDANT
STEVEN MADDEN, LTD.'S MOTION TO PARTIALLY DISMISS
PLAINTIFF CONVERSE INC.'S COMPLAINT**

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I. INTRODUCTION

Converse's opposition to Madden's motion to dismiss is replete with irrelevant arguments and misstatements of law and fact that seek to argue that Madden's motion is procedurally incorrect and premature. These misstatements necessitate this reply, and contrary to Converse's claims, the law clearly shows the time is ripe for a dismissal of Converse's claim.

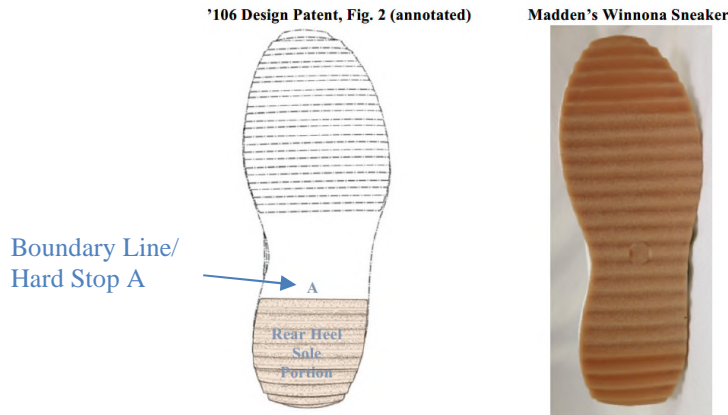
First, Converse argues that its allegations "exceed the pleading requirements" for design patent infringement. (ECF No. 25 at 1, 5-6.) This argument, however, is a red herring. Madden seeks dismissal because Converse's design patent infringement claim is facially implausible, and not because of a technically deficient pleading requirement.

Second, Converse relies on misstatements of law to argue that Madden's motion is premature because the Court must somehow first conduct formal claim construction proceedings. This is not true. Simply put, "**many courts have dismissed** claims of design infringement on Rule 12(b)(6) motions," and there is no reason to delay dismissal here. *MSA Prods., Inc. v. Nifty Home Prods., Inc.*, 883 F. Supp. 2d 535, 540 (D.N.J. 2012) (citations omitted).¹

Third, Converse relies on misstatements of law to argue that the jury must perform the ordinary observer analysis. (ECF No. 25 at 6, 8.) But Converse ignores that a "district judge is an ordinary observer" who can conduct this analysis. *Silverman v. Attilio Giusti Leombrumi S.P.A.*, No. 15 Civ. 2260 (PAC), 2016 U.S. Dist. LEXIS 20775, at *4 (S.D.N.Y. Feb. 19, 2016). All that is needed here for this analysis is a side-by-side comparison of the patented and accused designs. *Crocs, Inc. v. ITC*, 598 F.3d 1294, 1304 (Fed. Cir. 2010). As shown below, a side-by-side comparison shows that Converse's patent infringement claim is facially implausible. No

¹ All emphasis added herein unless otherwise indicated.

ordinary observer could find the *heel-to-toe* sole design in the Winnona Sneaker to be substantially similar to the '106 Patent, which limits the claimed design *to the rear, heel portion of the sole*.



Converse appears to realize that its patent as written does not cover the Winnona Sneaker, so it tries to rewrite the patent as if the boundary line A (i.e., Hard Stop A) was a broken line, and not a solid line. But Hard Stop A is claimed in the '106 Patent as a solid line, which clearly precludes the claimed design from extending beyond this boundary. *See MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1333 n.1 (Fed. Cir. 2014) (design patents “have ‘almost *no scope*’ *beyond the precise images* shown in the drawings.”)

Thus, Madden’s motion should be granted and Converse does not show otherwise.

II. ARGUMENT

Converse’s misstatements of law and fact in its opposition do not preclude this Court from granting Madden’s motion to dismiss.

A. Converse’s Infringement Claim Is Ripe for Dismissal

Converse argues that it is premature to dismiss a design patent infringement claim. (ECF No. 25 at 6-11.) Converse is wrong, as *many courts have dismissed* design patent claims on Rule 12(b)(6) motions. *See, e.g., MSA Prods., Inc.*, 883 F. Supp. 2d at 540 (collecting cases).

1. Converse Misstates the Law on Claim Construction

Converse misstates the law on claim construction to avoid having Madden’s Rule 12(b)(6) motion granted. (ECF No. 25 at 6.) But under the correct and applicable law, any claim construction issues can be resolved now, especially here where the designs are so different.

First, Converse argues that “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).” (*Id.* at 7.) Converse cites the wrong law. *Nalco* involved a *utility* patent, not a *design* patent. 883 F.3d at 1342. Courts can and do construe design patents on a motion to dismiss. See *Curver Lux. SARL v. Home Expressions Inc.*, 938 F.3d 1334, 1338 (Fed. Cir. 2019) (affirming *dismissal* where district court “*construed* the scope of the design patent”); *Silverman*, 2016 U.S. Dist. LEXIS 20775, at *5-6 (construing design patent in dismissing claim).

Although Converse cites some district court decisions declining to construe design patents on a motion to dismiss, those cases are readily distinguishable. (See ECF No. 25 at 7.) For example, in *simplehuman, LLC v. iTouchless Housewares & Prods.*, the Court found that the differences between the accused and claimed designs were *too minor* and “*barely perceptible*” to render the designs “plainly dissimilar.” No. 19-cv-02701-HSG, 2019 U.S. Dist. LEXIS 197024, at *12 (N.D. Cal. Nov. 13, 2019). Here, there is a major and perceptible difference between the claimed design (which requires a distinct design limited to the rear heel portion of the sole) and the Winnona Sneaker (which has no distinct design limited to the rear heel portion of the sole).

In *Shure Inc. v. ClearOne, Inc.*, (1) the court previously considered the issues “in some depth” and found that “the ultimate infringement question” will be “a nuanced and challenging

one,” and (2) claim construction involved the analysis of prior art and whether the claimed design recited functional features. No. 19-1343-RGA-CJB, 2020 U.S. Dist. LEXIS 95352, at *35 n.23 (D. Del. June 1, 2020). Here, there are no such “nuanced” and “challenging” issues.²

In *First Act Inc. v. Kids Station United States*, No. 05-12114-REK, 2006 U.S. Dist. LEXIS 106441, at *6 (D. Mass. Apr. 4, 2006), the Court was asked to consider whether the asserted design patent contained functional features, which is not an issue here.

Second, Converse argues that Madden seeks to have the Court disregard its local patent rules. (ECF No. 25 at 7-8.) Actually, Converse seeks to disregard the Federal Rules and Supreme Court precedent requiring it to “state a claim to relief that is *plausible on its face*.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). Converse must first state a plausible claim before the local patent rules can apply.

Last, Converse wrongly claims that a “developed evidentiary record” is needed for claim construction. Claim construction, however, is a question of law and courts can readily construe a design patent “as shown in its drawing.” See *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc.*, 162 F.3d 1113, 1116 (Fed. Cir. 1998). Here, one need look no further than the solid lines in Figure 2 of the ’106 Patent, i.e., Hard Stop A, to construe the claim.

2. The Court Is the Ordinary Observer and Can Decide the Issue of Infringement Without a Jury

Converse argues that this Court cannot perform the ordinary observer analysis. (ECF No. 25 at 8.) Converse, however, ignores the well-settled principle (raised by Madden in ECF No. 20 at 9) that a “district judge is an ordinary observer, and courts may therefore conduct the ordinary-

² Similarly, unlike here, *Poly-Am., L.P. v. API Indus., Inc.*, 36 F. Supp. 3d 444, 446 (D. Del. 2014) (cited at ECF No. 25 at 17) involved the analysis of prior art and ornamental features.

observer test without referring to some hypothetical ordinary observer.” *Silverman*, 2016 U.S. Dist. LEXIS 20775, at *4 (quotations omitted). Thus, there is no basis for Converse’s claim that Madden did not identify the ordinary observer. (ECF No. 25 at 18.)

The case law that Converse cites in its brief permits this Court to decide this issue. Citing *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995), Converse argues that Madden “asks the Court to conduct the jury’s infringement analysis.” (ECF No. 25 at 8.) *Elmer* says nothing of the sort, and if anything, supports Madden’s position. Indeed, in *Elmer*, the Federal Circuit *set aside a jury’s finding* of design patent infringement and *ruled on the merits* that “no reasonable jury” could have found design patent infringement. 67 F.3d at 1578.

Converse also argues that, according to *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010), “design patent cases are typically not suitable for dismissal under Rule 12(b)(6).” (ECF No. 25 at 8.) *Richardson* says nothing of the sort. It did not even involve the review of a Rule 12(b)(6) motion. Instead, the Federal Circuit affirmed the district court’s ruling on the merits that the accused product did not infringe. *Richardson*, 597 F.3d at 1296, 1298 (affirming denial of request for jury trial).

Converse next misstates the holding in *Deckers Outdoor Corp. v. J.C. Penney Co.*, 45 F. Supp. 3d 1181, 1186 (C.D. Cal. 2014) (cited in ECF No. 25 at 9). Contrary to Converse’s claim, the court did not “refus[e] dismissal because design [patent] infringement is primarily a question of fact.” (ECF No. 25 at 9.) Instead, it declined to dismiss because it found plaintiff’s claims to be plausible under the ordinary observer test. *Deckers*, 45 F. Supp. 3d at 1186.

B. Converse’s Infringement Claim Is Facially Implausible, and Converse Has Not Shown Otherwise

Converse once again improperly resorts to misstatements of law and fact to argue that

Madden's position is wrong on the merits. But as shown below, this case must be dismissed.

1. Converse Again Misstates the Law and Facts on Claim Construction

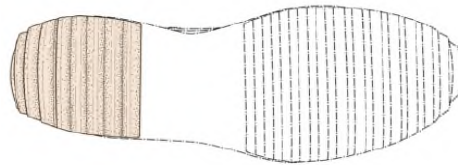
In arguing that Madden's claim construction is incorrect, Converse misstates the law and mischaracterizes Madden's position.

Converse argues that the *Egyptian Goddess* decision holds that design patents should not be construed with words. (ECF No. 25 at 11-12.) To the contrary, *Egyptian Goddess, Inc. v. Swisa, Inc.* actually held that it is "within the court's discretion" to construe the claims of a design patent with words and a "court's decision to issue a relatively detailed claim construction will not be reversible error." 543 F.3d 665, 679-80 (Fed. Cir. 2008) (finding there was "**nothing wrong**" with the District Court's verbal claim construction of design patent).

Converse does correctly state that the "**proper claim construction** for the '106 Patent is simply what is shown in **solid lines** in the patent figures." (ECF No. 25 at 12.) Converse's patent shows a sole bounded on all sides by **solid lines** in the rear portion of the sole of the shoe. Under the "proper claim construction" rule recited by Converse, these solid lines must be construed as defining a distinct sole design portion located at, and limited to, the rear of the shoe. This should be the end of the analysis.

Yet incredibly, Converse disregards the "proper claim construction" rule that it espouses by pretending that **the solid lines** have no meaning. For example, Converse argues that "solid line A" (i.e., Hard Stop A) is not a boundary because under "design patent principles, . . . boundary lines are typically depicted in *broken lines* and clearly described as such. See M.P.E.P. § 1503.01(III)." (*Id.* at 13 n.1) (emphasis in original). This is contrary to "proper claim construction law" and misstates what the M.P.E.P. actually says. What the M.P.E.P. does say is that a "boundary line may be shown in broken lines **if it is not intended to form part of the**

claimed design.” M.P.E.P. § 1503.01(III). Converse’s position is also contrary to the admission in its Complaint that the “*claimed portion* of the design” in the ’106 Patent is the area that it highlighted in beige (reproduced below), which appears *only* in the rear heel portion of the sole. (ECF No. 1, ¶ 21.) Converse cannot now walk away from this admission to avoid dismissal. *Schott Motorcycle Supply, Inc. v. Am. Honda Motor Co.*, 976 F.2d 58, 61 (1st Cir. 1992) (“A party’s assertion of fact in a pleading is a judicial admission by which it normally is bound throughout the course of the proceeding.”).



But the relevant boundary line here, Hard Stop A, is not drawn in broken lines. Converse purposely drew the Rear Heel Sole Portion (including Hard Stop A) in solid lines, making the solid lines, and the distinct rear sole portion that the solid lines form, the totality of the claimed design. Consequently, the claimed Rear Heel Sole Portion cannot extend past the solid line that forms Hard Stop A. *See In re Maatita*, 900 F.3d 1369, 1372 (Fed. Cir. 2018); *Kreative Power, LLC v. Monoprice, Inc.*, No. 14-cv-02991-SI, 2015 U.S. Dist. LEXIS 26489, at *22 (N.D. Cal. Mar. 3, 2015) (design patent claim construed to be limited to product “*as shown* in the D’215 figures *by solid boundary lines*”).

Converse seeks to obfuscate the issues by mischaracterizing Madden’s claim construction position. Specifically, Converse argues that Madden’s position is that only the “rear, heel portion” can have the claimed tread design, and no other part of the shoe (e.g., the “unclaimed front toe area”) can have these treads. (ECF No. 25 at 12-13.) This is not Madden’s position.

As Madden explains in its opening brief, “solid lines (A-D) form a *distinct boundary* that

completely surrounds and encloses the Rear Heel Sole Portion *at the rear heel region* of the sole.” (ECF No. 20 at 11) (emphasis in original). Madden then explained “[b]ecause of Hard Stop A, *the Rear Heel Portion cannot extend past* the rear region of the sole of the shoe.” (*Id.*) Madden’s position does not necessarily preclude a shoe from having treads on other regions of the sole, provided that the *Rear Heel Portion* is *distinct* from the remainder of the sole.

In sum, Madden’s proposed construction is correct, and Converse’s misstatements cannot form a basis for denying Madden’s motion.

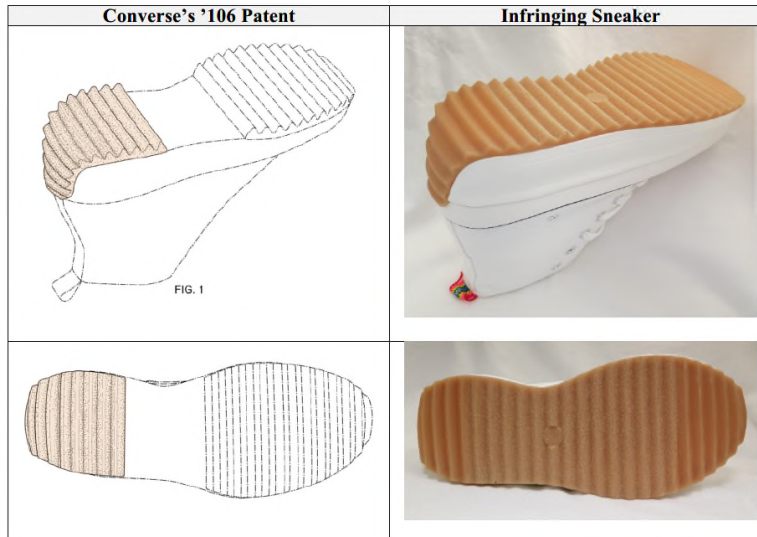
2. **Converse’s Own Side-by-Side Analysis Demonstrates That Its Infringement Claim Is Facially Implausible**

Converse’s arguments on the ordinary observer analysis fare no better. Converse first argues that Madden has not evaluated the “claimed design as a whole” and instead is only evaluating “separate elements in isolation.” (ECF No. 25 at 17.) But Converse completely ignores that the “claimed design as a whole” is just the Rear Heel Sole Portion, since this is the only portion drawn in solid lines. Everything else is drawn in broken lines, which show unclaimed matter. *See* M.P.E.P. § 1503.02, ¶ 15.50.

Converse also argues that the “side-by-side images in [its] Complaint speak for themselves and show that the claimed design and the corresponding portion of the Winnona sneakers, *however described in words*, have substantially the same *overall visual appearance*. Complaint ¶ 21.” (ECF No. 25 at 18 (emphasis in original).) But tellingly, Converse does not include these side-by-side comparisons in its brief. For the Court’s convenience, Madden reproduces Converse’s comparisons below (*see* ECF No. 1, ¶ 21).

As shown below, the “overall visual appearance,” “however described in words,” is sufficiently distinct in the eye of the ordinary observer. *Egyptian Goddess*, 543 F.3d at 678.

Indeed, the beige area in the '106 Patent that Converse highlighted in the Complaint -- to emphasize that the claimed design is located only at the rear portion of the sole -- is plainly substantially different from the Winnona Sneaker design.



Converse generally criticizes Madden's position as "attorney argument" without providing any credible factual or legal basis for this Court to deny Madden's motion. (ECF No. 1, ¶21.) To the contrary, Madden has provided a strong factual and legal basis to support its argument that the claimed and accused designs are "sufficiently distinct" and it is "[c]lear *without more* that" Converse cannot meet "its burden of proving the two designs would appear 'substantially the same' to the ordinary observer[.]" *Egyptian Goddess*, 543 F.3d at 678.

3. Converse Does Not Distinguish Factually Analogous Cases

Converse dedicates three sections of its opposition trying to distinguish dismissal decisions cited by Madden. (See ECF No. 25 at 9-11, 13-15, 17.) Converse mischaracterizes these decisions, arguing that these cases were dismissed only because "the claimed design was applied to an entirely different product than the accused design." (*Id.* at 9.) This is not true. The courts in those cases ultimately found, as this Court should here, that the accused and patented designs were not substantially similar pursuant to *Egyptian Goddess*.

Converse claims that the *Silverman* court dismissed the infringement claims solely because the claim required a “high-heel” shoe and the accused shoe had a “flat oxford-style.” (*Id.* at 10). However, in dismissing infringement claims, the court also held that the “patented design *covers only the middle of the sole*; the accused design *covers the entire sole.*” *Silverman*, 2016 U.S. Dist. LEXIS 20775, at *5-6. Similar to *Silverman*, Converse’s claimed design “covers only the [rear] of the sole” and the accused Winnona Sneaker “covers the entire sole.”

Converse also incorrectly argues that the court in *Steven Madden, Ltd. v. Laurent*, No. 18-CV-7592 (VEC), 2019 U.S. Dist. LEXIS 77863 (S.D.N.Y. May 8, 2019) dismissed design patent infringement allegations solely because the claimed and accused designs were directed to different shoe styles. (ECF No. 25 at 9.) But the court noted other significant differences, including that the accused shoe lacked the claimed “platform sole” (drawn in solid lines) at the front of the shoe. *Laurent*, 2019 U.S. Dist. LEXIS 77863, at *7. Similar to *Laurent*, the Winnona Sneaker lacks the claimed distinct sole at the rear of the shoe.

Finally, there is no basis for Converse’s argument that its “claimed design and Madden’s [Winnona Sneaker] are applied to the same style of sneakers . . .” (ECF No. 25 at 10-11.) Indeed, the type of sneaker design is irrelevant here. Converse disclaimed any particular sneaker design by drawing the figures of its patent in broken lines, except for drawing the claimed **Rear Heel Portion** in broken lines. (See M.P.E.P. § 1503.01 (III), discussed *supra* at Section II.B.1.) What is relevant here is that the accused Winnona Sneaker includes a design that is substantially different from the sole of the ’106 Patent design because, *inter alia*, it does not include a design portion that is located solely at the rear portion of the sole.

III. Conclusion

Madden’s motion should be granted and Converse’s opposition does not show otherwise.

Dated: October 26, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing REPLY MEMORANDUM OF LAW IN SUPPORT OF DEFENDANT STEVEN MADDEN, LTD.'S MOTION TO PARTIALLY DISMISS PLAINTIFF CONVERSE INC.'S COMPLAINT is being served by electronic means (via CM/ECF) this 21st day of November, 2020, upon Plaintiff's Counsel of Record.

Dated: New York, New York
November 21, 2020

By: /s/Douglas A. Miro
Douglas A. Miro