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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/002,100	08/24/2012	D517789	529816	2333
35657	7590	11/19/2012	EXAMINER	
Faegre Baker Daniels LLP PATENT DOCKETING - INTELLECTUAL PROPERTY 2200 WELLS FARGO CENTER 90 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-3901			FLUEGEMAN, DEANNA L	
			ART UNIT	PAPER NUMBER
			2911	
			MAIL DATE	DELIVERY MODE
			11/19/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Transmittal of Communication to Third Party Requester <i>Inter Partes</i> Reexamination	Control No.	Patent Under Reexamination	
	Examiner	Art Unit	
	95/002,100	D517789 ET AL.	
	DEANNA L. FLUEGEMAN	2911	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

INTER PARTES REEXAMINATION COMMUNICATION	Control No.	Patent Under Reexamination
	95/002,100 Examiner DEANNA L. FLUEGEMAN	D517789 ET AL. Art Unit 2911

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BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

**ORDER GRANTING/DENYING
REQUEST FOR INTER PARTES
REEXAMINATION**

Control No.	Patent Under Reexamination
95/002,100	D517789 ET AL.
Examiner	Art Unit
DEANNA L. FLUEGEMAN	2911

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The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): PTO-892 PTO/SB/08 Other: IDS filed 8/24/12

1. The request for *inter partes* reexamination is GRANTED.

An Office action is attached with this order.

An Office action will follow in due course.

2. The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Order.

Art Unit: 2911

Decision Granting *Inter Partes* Reexamination

The third party has demonstrated a reasonable likelihood that it will prevail (RLP) in one of the five proposed rejections of the sole claim of U.S. Patent No. D517,789 in the inter partes reexamination request filed August 24, 2012.

References Cited in the Request

- a. UK Patent Application GB 2,322,289 (Exhibit 3)
- b. U.S. Patent No. 6,237,249 to Aguerre (Aguerre '249) (Exhibit 4)
- c. U.S. Patent No. D422,780 to Aguerre (Aguerre '780) (Exhibit 5)
- d. U.S. Patent No. D473,040 to Hawker (Hawker '040) (Exhibit 6)
- e. Softmoc Sales Literature dated September 11, 2002 (Softmoc) (Exhibit 7)
- f. Copyright Assignment Agreement from L'Artigiana Stampi to Finproject NA, effective October 1, 2000 (Battistion Designs) (Exhibit 8)
- g. Crocs Sales Literature archived October 16, 2002 (Exhibit 9)
- h. Crocs Sales Literature archived December 13, 2002 (Exhibit 10)
- i. Crocs Sales Literature archived May 26, 2003 (Exhibit 11)

Effective Filing Date of U.S. Patent No. D517,789

U.S. Patent No. D517,789 ('789), filed May 28, 2004, claims priority as a continuation-in-part to U.S. Patent Application No. 10/803,569 (now Patent No. 7,146,751), filed March 17, 2004, which claims priority as a continuation-in-part of U.S. Patent Application Nos. 10/602,416 filed June 23, 2003 (now abandoned), and 10/603,126, filed June 23, 2003 (now Patent No. 6,993,858),

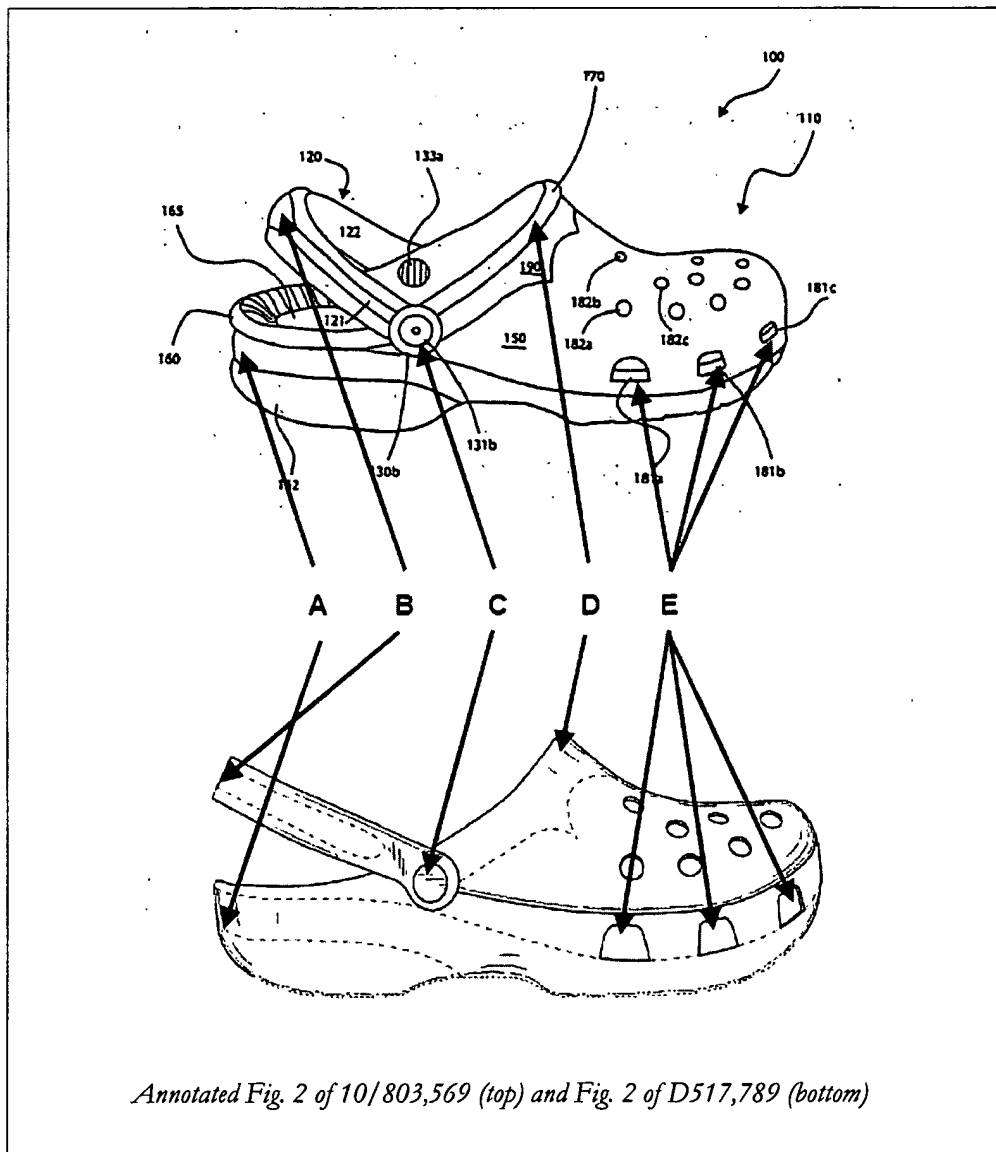
MPEP 1504.20 sets forth, "Unless the filing date of an earlier application is actually needed, for example, in the case of an interference or to avoid an intervening reference, there is no need for the examiner to make a determination in a continuation-in-part application as to whether the requirement of 35 U.S.C. 120 is met. Note the holdings in *In re Corba*, 212 USPQ 825 (Comm'r Pat. 1981)."

Exhibits 6, 7, 9, 10, and 11 are intervening references. Therefore, a determination must be made as to whether the prior application 10/803,569 discloses the patented design of the '789 patent in the manner required by the first paragraph 35 USC 112. Should the '789 patent contain new matter relative to the '569 application, our inquiry is at an end, and the effective filing date of the '789 patent will stand at May 28, 2004. Only if the disclosure of the '569 application is found to fulfill the

Art Unit: 2911

requirements of the first paragraph of 35 USC 112 with respect to the claimed design of the '789 patent will the inquiry extend to the question of the benefit of the filing dates of the '416 and '126 applications.

When comparing the appearance of the shoe disclosed in the '569 application (7,146,151 patent) to the design claimed in the '789 patent, it is clear that the '569 application does not disclose the design of the '789 patent in the manner required by the first paragraph of 35 USC 112, as the design of the '789 patent exhibits several areas of new matter relative to the shoe of the '569 application.



- A. The shoe of the '569 application has a ridged heel area, whereas the design of the '790 patent has a smooth heel area.

Art Unit: 2911

- B. The heel strap of the shoe of the '569 application has rounded, three-dimensional surface structure, while the heel strap of the '789 design is smooth with no additional surface structure or texture.
- C. The area where the heel strap connects to the pivot and the pivot itself have a completely different appearance in the '569 application as compared to the same area of the '789 design.
- D. The edge of the upper of the shoe of the '569 application has a ridge while the edge of the upper of the shoe of the '789 patent is smooth.
- E. In the '569 application, the vents along the bottom edge of the upper, where the upper meets the sole, are of a different shape and size than the vents along the bottom edge of the upper of the design of the '789 patent.

Due to the above-identified instances of new matter, the design claimed in D517,789 is not disclosed in application 10/803,569 as required by the first paragraph of 35 USC 112, and therefore D517,789 is not entitled to the benefit of the earlier filing date of the '569 application. Furthermore, because the '789 patent is not entitled to benefit of the earlier filing date of the '569 application, the '789 patent is also not entitled to the benefit of the earlier filing date of the '416 and '126 application.

Thus, the effective filing date of D517,789 stands at May 28, 2004.

Availability of the References as Prior Art

- a. The U.K. Patent Application 2,322,286 has a filing date of February 19, 1998 and a publication date of August 26, 1998, making it available as prior art under 35 USC 102(b)
- b. The Aguerre '249 patent has a filing date of April 22, 1999 and a patent date of May 29, 2001, making it available as prior art under 35 USC 102(b).
- c. The Aguerre '780 patent has filing date of April 22, 1999 and a patent date of April 18, 2000, making it available as prior art under 35 USC 102(b).
- d. The Hawker '040 patent has a filing date of April 11, 2002 and a patent date of April 15, 2003, making it available as prior art under 35 USC 102(b).

Art Unit: 2911

- e. The Softmoc Sales Literature has a retrieval date of September 11, 2002, making it available as prior art under 35 USC 102(b).

- f. The Battistion Designs reference was signed on September 15, 2004, but was made retroactively effective as of October 1, 2000. However, because the document was not made publicly available, it is not available as prior art.

Requester states on page 26 of the request that "Battistion Designs (Ex. 8) is an admitted publication. See Canadian Action (Ex. 15; Para 7)."

Paragraph 7 of the Canadian Action of Exhibit 15 states that Stampi, the employer of Mr. Ettore Battistion "was the first owner of the copyright in Foam's Designs, which were first published in April 2002."

Since the copyright publication has not been submitted, this is an insufficient evidence of publication of the document that is the Battistion Designs reference.

- g. The Crocs Sales Literature Exhibit 9 is dated October 16, 2002, making it available as prior art under 35 USC 102(b).

- h. The Crocs Sales Literature Exhibit 10 is dated December 13, 2002, making it available as prior art under 35 USC 102(b).

- i. The Crocs Sales Literature Exhibit 11 is dated May 26, 2003, making it available as prior art under 35 USC 102(b).

Proposed Rejections

1. Rejection of the design of the '789 patent under 35 USC 102(b) as being anticipated by the Crocs Beach Model Shoe shown in any of the instances of Crocs Sales Literature (Exhibits 9, 10, and 11).

Art Unit: 2911

2. Rejection of the design of the '789 patent under 35 USC 103(a) as being obvious over Softmoc (Exhibit 7) in view of Aguerre '780 (Exhibit 5) or Aguerre '249 (Exhibit 4) and GB 2,322,289 (Exhibit 3).
3. Rejection of the design of the '789 patent under 35 USC 103(a) as being obvious over the Battistion Designs reference in view of Aguerre '780 (Exhibit 5) or Aguerre '249 (Exhibit 4) and GB 2,322,289 (Exhibit 3).
4. Rejection of the design of the '789 patent under 35 USC 103(a) as being obvious over Softmoc (Exhibit 7) in view of GB 2,322,289 (Exhibit 3).
5. Rejection of the design of the '789 patent under 35 USC 103(a) as being obvious over Hawker '040 in view of Aguerre '780 (Exhibit 5) or Aguerre '249 (Exhibit 4).

Discussion of the RLP of the Proposed Rejections

1. Using either Exhibits 9, 10, or 11 as the reference for a rejection of the claim under 35 USC 102(b), the examiner agrees that an RLP is shown with respect to the sole patent claim. Exhibit 9, the Crocs Sales Literature archived October 16, 2002, shows a shoe having an appearance that is substantially the same as the patented design. Exhibit 10, the Crocs Sales Literature archived December 13, 2002, shows a shoe having an appearance that is substantially the same as the patented design. Exhibit 11, Crocs Sales Literature archived May 26, 2003, shows a shoe having an appearance that is substantially the same as the patented design.
2. Using the Softmoc reference as the primary reference in a rejection under 103(a), the examiner does not agree that an RLP is shown with respect to the sole patent claim. Specifically, the Softmoc reference is not a proper Rosen reference upon which to base a rejection under 35 USC 103(a), as the shoe shown in the Softmoc reference lacks a back strap and pivot assembly, which causes the Softmoc shoe and the design of the '789 patent to have overall appearances which are not basically the same, as the back strap and pivot assembly are primary design characteristics that significantly impact the overall appearance of the design of the '789 patent.

Art Unit: 2911

3. Using the “Battistion Designs” reference as the primary reference in a rejection under 103(a), the examiner **does not agree** that an RLP is shown with respect to the sole patent claim, as the “Battistion Designs” reference is not available as prior art.

4. Using the “Softmoc” reference as the primary reference in a rejection under 103(a), the examiner **does not agree** that an RLP is shown with respect to the sole patent claim. Specifically, the “Softmoc” reference is not a proper Rosen reference upon which to base a rejection under 35 USC 103(a), as the shoe shown in the “Softmoc” reference lacks a back strap and pivot assembly, which are primary design characteristics that significantly impact the overall appearance of the design of the ‘789 patent.

5. Using the Hawker ‘040 reference as the primary reference in a rejection under 103(a), the examiner **does not agree** that an RLP is shown with respect to the sole patent claim. Specifically, the Hawker ‘040 reference is not a proper Rosen reference upon which to base a rejection under 35 USC 103(a), as the design of the Hawker ‘040 reference does not have design characteristics that are basically the same as the design of the ‘789 patent.

Summary

The examiner **agrees** there is a reasonable likelihood to prevail with proposed rejection 1, the rejection of the design of the ‘789 patent under 35 USC 102(b) over the Crocs Sales Literature archived October 16, 2002 (Exhibit 9), the Crocs Sales Literature archived December 13, 2002 (Exhibit 10), and/or the Crocs Sales Literature archived May 26, 2003 (Exhibit 11).

The examiner **does not agree** there is a reasonable likelihood to prevail with the proposed rejection 2, the rejection of the design of the ‘789 patent under 35 USC 103(a) over Softmoc (Exhibit 7) in view of Aguerre ‘780 (Exhibit 5) or Aguerre ‘249 (Exhibit 4) and GB 2,322,289 (Exhibit 3), proposed rejection 3, the rejection of the design of the ‘789 patent under 35 USC 103(a) over the Battistion Designs reference in view of Aguerre ‘780 (Exhibit 5) or Aguerre ‘249 (Exhibit 4) and GB 2,322,289 (Exhibit 3), proposed rejection 4, the rejection of the design of the ‘789 patent under 35 USC 103(a) over Softmoc (Exhibit 7) in view of GB 2,322,289 (Exhibit 3), or proposed rejection 5, the rejection of the design of the ‘789 patent under 35 USC 103(a) over Hawker ‘040 in view of Aguerre ‘780 (Exhibit 5) or Aguerre ‘249 (Exhibit 4).

Art Unit: 2911

Litigation Activity

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. D517,789 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Extensions of Time

Extensions of time under 37 C.F.R. 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 C.F.R. 1.136 apply only to "an applicant" and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings "will be conducted with special dispatch" (37 C.F.R. 1.937). Patent Owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 C.F.R. 1.956. Extensions of time are not available for Third Party Requester comments, because a comment period of 30 days from service of the Patent Owner's response is set by statute 35 U.S.C. 314(b)(3).

An Office action on the merits does not accompany this order granting *inter partes* reexamination. An Office action will be provided in due course.

Correspondence and Contact Information

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
 Central Reexamination Unit
 Commissioner for Patents
 United States Patent & Trademark Office
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
 Central Reexamination Unit

Application/Control Number: 95/002,100

Page 9

Art Unit: 2911

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Any inquiry concerning this communication should be directed to Central Reexamination Unit at telephone number 571.272.7705.

/DEANNA L FLUEGEMAN/
Primary Examiner, Art Unit 2911

Conferee
/Adir Aronovich/

Conferee
Joel Sincavage /JS/