



IPR “Booted” Where Images on Webpage Coupled with Evidence of Sales Deemed Insufficient to Establish Prior Art Status

August 28, 2024

Reading Time : **3 min**

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The Patent Trial and Appeal Board has denied institution of an *inter partes* review for a design patent in part because the petitioner failed to show that three asserted references qualified as prior art. Specifically, the PTAB ruled that images of a boot design taken from a website after the critical date, coupled with evidence that the design was on sale before the critical date, was insufficient to establish the design as prior art. Critical to the PTAB’s determination was the fact that webpages are “dynamic” and change over time, rendering images taken from the current webpage insufficient to establish prior disclosure.

The challenged patent is directed to an ornamental design of the upper portion of a boot. Certain grounds of the petition relied on three references: the “UGG Neumel Boot,” the “Emu Stinger Micro Boot” and the “UGG Classic Mini.” The patent owner’s preliminary response challenged the prior art status of the three references, arguing for each that the petitioner relied on **prior sales** of the boots and thus failed to show that each was disclosed in a **printed publication** before the critical date. The PTAB agreed with the patent owner and determined that the references were not prior art.

With respect to the UGG Neumel Boot, the petitioner relied on two pieces of evidence: (1) the patent owner’s complaint in district court alleging that the boots were “introduced in 2011” and featured in various “publications” before the critical date; and (2) images from an Amazon.com sales listing that depicted the boots and stated that they “went on sale” before the critical date. First, the PTAB rejected the complaint itself as evidence because it was filed after the critical date and because the alleged “publications” cited therein were not provided

to the PTAB. Second, the PTAB rejected the images from Amazon.com because product listings on a website change over time. Thus, “[t]he date that a product was listed as first available on a website” does not show that “the content of the listing, including the photographs depicted therein, were published at that time.” Accordingly, the PTAB determined that the UGG Neumel Boot was not prior art.

The PTAB also found insufficient evidence that the Emu Stinger Micro Boot was prior art. For that reference, the petitioner relied on images from various websites that either (1) depicted photographs of the boot, or (2) showed that the boot was on sale or reviewed by customers before the critical date. The PTAB rejected photographs of the boots recently taken from webpages because “a printout of a webpage from 2024 does not provide sufficient evidence of what was publicly available on the website . . . prior to the critical date.” The PTAB rejected other photographs from the Wayback Machine because they depicted a different design from the one relied on in the petition. With respect to images showing that the boots were on sale or reviewed, the PTAB determined that they were insufficient because they did “not provide sufficient evidence that the **images displayed on the website in 2024** were publicly available prior to the critical date.” Accordingly, the Emu Stinger Micro Boot also did not qualify as prior art.

The UGG Classic Mini did not qualify as prior art, either. For that reference, the petitioner again relied on images of webpages from 2024, evidence showing that the boot was on sale before the critical date, and photographs of designs that were not relied on in the petition. As the PTAB explained, such evidence does not show that a reference was disclosed in a printed publication before the critical date.

Finally, the petitioner also argued that—because patent owner sells the UGG boots and competes with the Emu Stinger Micro Boot—**patent owner** had an obligation to submit evidence that the references were prior art, citing the duty of candor under 37 C.F.R. § 1.56. But the PTAB rejected that argument because PTAB proceedings “are not subject to § 1.56,” quoting the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 77 Fed. Reg. 48612, 48638 (Aug. 14, 2012).

Practice Tip: Petitioners in IPRs must show that each asserted reference is a printed publication that was “publicly accessible” before the critical date. Petitioners should exercise caution when relying on webpages for prior art because they are dynamic in nature, making it a challenge to show when the information on the webpage became publicly accessible. This

can be particularly challenging in design patent cases where petitioners rely on images of a design as a reference. In such cases, Petitioners should ensure that they provide concrete evidence that the images they rely on were depicted on a webpage **before** the critical date. As this case demonstrates, an image of a design taken from a webpage dated **after** the critical date—even if coupled with evidence that the design was **on sale** before the critical date—is insufficient.

Next Step Group, Inc. v. Deckers Outdoor Corp., IPR2024-00525, Paper 16 (PTAB Aug. 6, 2024).

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