

**2018-2214**

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United States Court of Appeals  
for the Federal Circuit

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CURVER LUXEMBOURG, SARL,

*Plaintiff - Appellant,*

v.

HOME EXPRESSIONS INC.,

*Defendant - Appellee.*

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*Appeal from the District Court of New Jersey, Case No. 2:17-cv-4079*

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**BRIEF OF PLAINTIFF-APPELLANT**

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OCTOBER 2, 2018

**CERTIFICATE OF INTEREST**

Counsel for Appellant certifies the following:

1. The full name of every party or *amicus* represented by us is:

*Curver Luxembourg SARL*

2. The name of the real party in interest represented by us is:

*Curver Luxembourg SARL*

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or *amicus curiae* represented by me are:

*Curver Luxembourg SARL*, a wholly owned subsidiary of *Curver Benelux BV*, which is a wholly owned subsidiary of *Keter Group BV*, which is a wholly owned subsidiary of *Krona Holding II Sarl*, which is a wholly owned subsidiary of *Krona Holding I Sarl*, which is a wholly owned subsidiary of *Keter Group Holding Sarl*. None of these entities are publicly traded.

4. The names of all law firms and the partners or associates that appeared for the party or *amicus* now represented by me in the trial court or agency or are expected to appear in this court are:

*Greenberg Traurig, LLP: Jason Kislin, Barry Schindler, Michael Nicodema*

5. The title and number of any case known to me to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision are:

*None.*

October 2, 2018

/s/ Jason Kislin

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## **I. STATEMENT OF RELATED CASES**

This appeal concerns the United States District Court for the District of New Jersey's ("District Court") dismissal of Curver Luxembourg, SARL's ("Curver" or "Appellant") Complaint against Home Expressions Inc. ("Home Expressions" or "Appellee"), which alleged infringement of design patent No. D677,946 (the "'946 Patent"), owned by Appellant, and the District Court's subsequent decision denying a request for reconsideration. There has been no prior appeal from this proceeding in this, or any other, appellate court and counsel is not aware of any case that will be directly affected by the Court's decision in this appeal.

## **II. JURISDICTIONAL STATEMENT**

This is an appeal from the District Court's January 8, 2018, final decision dismissing Curver's Complaint alleging design patent infringement and the District Court's subsequent decision denying a request for reconsideration on July 6, 2018. Appellant timely filed a notice of appeal on July 30, 2018, within the time limit set by 35 U.S.C. § 142 and 37 C.F.R. § 90.3. This Court therefore has jurisdiction over this appeal under 35 U.S.C. § 141(a) and 28 U.S.C. § 1295(a)(4)(A).

## **III. STATEMENT OF THE ISSUES**

1. Whether the District Court committed reversible error by limiting the scope of the '946 Patent claim to a "chair" embodying the design illustrated in the patent figures based on the title of the patent, when the figures themselves do not depict a chair or require that the claimed design be used in a chair?

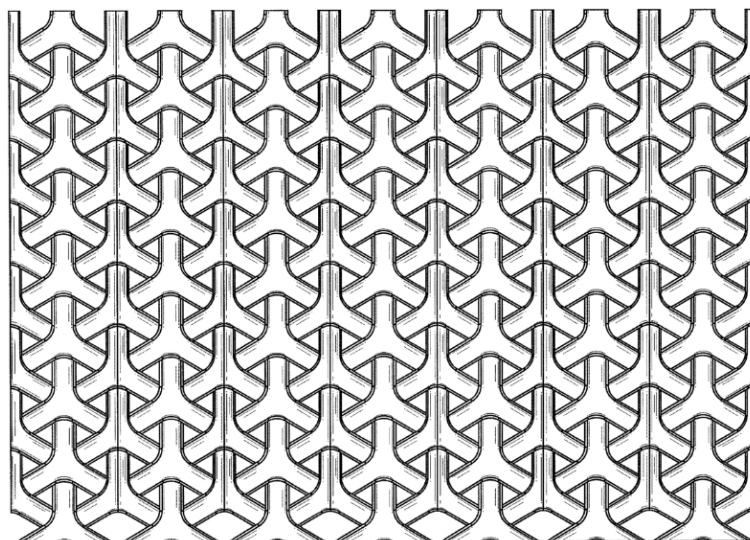
2. Whether the District Court committed reversible error by focusing entirely on the articles of manufacture, rather than the patented ornamental design, in its infringement analysis, when the test for infringement is the same as the test for anticipation and anticipation turns solely on the patented ornamental design itself, without reference to its particular article of manufacture?

3. Whether the District Court committed reversible error by limiting the scope of the '946 Patent claim, under the doctrine of prosecution history estoppel, to a “chair” embodying the design illustrated in the patent figures, based on the patentee changing the title of the patent, when the figures themselves were not changed and do not require that the claimed design be used in a chair?

#### **IV. STATEMENT OF THE CASE**

##### **A. The '946 Patent.**

Curver is a manufacturer of home products, and owns the '946 Patent. The '946 Patent claims the ornamental overlapping “Y” design pictured below:



(Appx022). The United States Patent and Trademark Office (“PTO”) reviewed and allowed the claimed design upon Curver’s initial application but, nevertheless, issued formality objections, explaining that “[t]he title of the design must *designate the particular article*, which is the subject of the design.” (Appx060-061) (emphasis in original). The PTO further suggested that “the title be amended to read: ‘Pattern for a Chair.’” (Appx061). The PTO also objected to the figures for minor issues such as the use of a computer-generated graphic, repetitive figures and lack of proper shading. (Appx061-063). Curver revised the title of its design patent application and the corresponding text of its claim to conform to the PTO’s suggestion and cancelled the repetitive figure and made minor amendments to the figures in the design patent application to the address the formality objection. (Appx065-077). On March 19, 2013, the PTO issued Curver the ’946 Patent. (Appx022-028).

Curver manufactures and distributes storage baskets incorporating the design claimed in the ’946 Patent, which are sold throughout the United States. (Appx030). Curver has taken reasonable measures to mark its products within the scope of the ’946 Patent, including its basket, in accordance with 35 U.S.C. § 287. (*Id.*).

### **B. Home Expressions' Design Patent Infringement.**

Like Curver, Home Expressions is a houseware manufacturer that makes and sells a basket that is identical to Curver's in every way. An image of Home Expressions' infringing design is depicted below:



(Appx041). As can be plainly seen, Home Expressions' basket utilizes the patented overlapping "Y" design of the '946 Patent and contains each element of the claimed design in the '946 Patent. (*Id.*). In fact, Home Expressions' basket even replicates the unprotected elements of Curver's basket, such as an alternating matte and glossy finish on the bottom of the basket. (Appx031). Upon information and belief, Home Expressions has sold their infringing basket design within the United States, including in the U.S. District for the District of New Jersey. (*Id.*).

On June 6, 2017, Curver filed its Complaint in the District Court of New Jersey against Home Expressions, alleging patent infringement under the patent laws of the United States, 35 U.S.C. § 271 *et seq.*, and seeking a permanent

injunction and damages. (Appx029-032). On July 24, 2017, Home Expressions filed a motion to dismiss Curver's Complaint. (Appx045-056).

**C. The District Court's Dismissal of Curver's Design Patent Infringement Claims Against Home Expressions.**

On January 8, 2018, the District Court granted Home Expressions' motion to dismiss Curver's Complaint. (Appx001; Appx003-018). In granting Home Expressions' motion to dismiss, the District Court concluded that, under the doctrine of prosecution estoppel, Curver was barred from asserting infringement claims against Home Expressions because, by adopting the title recommended by the PTO, Curver limited the scope of its patent to chairs. (Appx011-016). Therefore, the District Court reasoned, even though Home Expressions' basket employed an identical ornamental design to the one shown in the '946 Patent figures, it did not infringe. (*Id.*). In addition, focusing entirely on the claim text and title of the '946 Patent, the District Court construed the scope of the claimed design to be limited to the article of manufacture identified therein, a chair. (Appx016-017). Finally, in comparing the '946 Patent to the infringing basket, the District Court again relied on the articles of manufacture to conclude that no ordinary observer would mistake a basket for a chair, though it acknowledged that the ornamental design applied to Home Expression's product was "substantially similar" to the ornamental design covered by the '946 Patent. (Appx017-018).

## **1. Claim Construction**

At step one of the infringement analysis, claim construction, the District Court narrowed the scope of the '946 Patent to the ornamental "Y" design for a chair based on the doctrine of prosecution history estoppel and a more generalized claim construction analysis. (Appx010-017).

In discussing prosecution history estoppel, the District Court focused entirely on the change in title and claim text of Curver's design patent application. (Appx012-013). As noted above, while the PTO substantively allowed the claimed design following an examination on the merits, it technically objected to the application and required Curver to designate a particular article of manufacture. (Appx060-061). At the PTO's direction, Curver amended the title of the patent application to a "Pattern for a Chair." (Appx065-077). Based upon that amendment, the District Court reasoned, "Curver surrendered a claim for an ornamental pattern 'for furniture' and accepted a design patent for an ornamental pattern 'for a chair.'" (Appx013). As such, the District Court concluded that Curver was estopped from asserting infringement against any articles of manufacture other than chairs. (Appx016).

In addition, in its general claim construction analysis, again focusing on the article of manufacture identified in the '946 Patent, the District Court concluded that Curver's patent was limited to a chair. (Appx016-017). Here, the District

Court explained, “[t]he scope of a design patent is limited to the ‘article of manufacture’ – *i.e.*, the product – listed in the patent.” (Appx016). Because the ’946 Patent identified its article of manufacture as a chair, the District Court held that Curver could not assert infringement claims against a basket. (Appx017).

## **2. Comparison of the Construed Claim and Accused Basket.**

After determining that the ’946 Patent only protects an ornamental “Y” design as applied to a chair, the District Court, at step two of the infringement analysis, ignored the design shown in the ’946 Patent figures and focused on the different articles of manufacture at issue. (Appx018). Utilizing the “ordinary observer” standard, the District Court concluded that “[a] reasonable observer would not purchase the Home Expressions’ basket, with the ornamental ‘Y’ design, believing that he or she was purchasing what was protected by the ’946 Patent – *i.e.*, the ornamental ‘Y’ design applied to a chair.” (*Id.*). In arriving at this conclusion, the District Court, again, focused on the title and claim text of the ’946 Patent, which identified the article of manufacture as a chair, rather than the design shown in the ’946 Patent figures. (*Id.*). The design illustrated in the patent drawings do not depict a chair (or any other specific article of manufacture). (Appx035-039). In fact, the District Court acknowledged that “the ‘Y’ design on the Home Expressions’ basket is substantially similar to the ‘Y’ design shown in the ’946 Patent.” (Appx018).

**D. The District Court's Denial of Curver's Motion for Reconsideration**

Thereafter, Appellant timely filed a motion for reconsideration, contending that the District Court's decision, which raised prosecution history estoppel *sua sponte*, was directly at odds with Supreme Court and Court of Customs and Patent Appeals' (now the Federal Circuit) holdings regarding the scope of design patents. (Appx114-128). Specifically, Appellant contended that the District Court erred in determining the scope of the '946 Patent based upon the title of the patent application and the text of the patent claim (rather than the figures). (Appx120-125).

In denying Appellant's motion, the District Court held that no manifest injustice or error was demonstrated. (Appx002; Appx019-021). Conceding that it had raised the issue of prosecution history estoppel for the first time, the District Court maintained its conclusion that "[Appellant's] design patent did not, as a matter of claim construction, extend to other articles of manufacture." (Appx020). Consistent with its prior decision, the District Court explained that, based on the title and claim text of the patent, Appellant's design patent was limited to chairs only and, therefore, it could not claim infringement of other articles of manufacture. (*Id.*).



## **V. SUMMARY OF THE ARGUMENT**

1. The scope of a design patent claim is determined based on what is depicted in the patent drawings, and not the title or the accompanying text. As such, the District Court's reliance on the patent's title and text in construing the claim of the '946 Patent constitutes reversible error.

2. The District Court also committed reversible error in concluding that Home Expression's basket could not infringe the '946 Patent under the ordinary observer test, because the District Court reached that conclusion based solely on the article of manufacture identified in the patent, rather than on the ornamental design illustrated in the patent drawings.

3. The District Court committed reversible error in concluding that the doctrine of prosecution history estoppel limited the scope of the '946 Patent to chairs that use the ornamental design shown in the drawings, since in design patent cases, the doctrine is limited to circumstances where substantive amendments are made to the patent drawings, and does not apply to situations where changes to the title or text of the patent have been made with no substantive changes to the figures.

## **VI. ARGUMENT**

### **A. Standard of Review**

This Court reviews a decision to grant a motion to dismiss under regional circuit law. *C&F Packing Co., Inc. v. IBP, Inc.*, 224 F.3d 1296, 1306 (Fed. Cir.

2000). The Third Circuit reviews dismissals under Rule 12(b)(6) *de novo*. See *Boring v. Google Inc.*, 362 F. App'x 273, 277 (3d Cir. 2010). “To avoid dismissal, the complaint must set forth facts that raise a ‘plausible inference’ that the defendant inflicted a legally cognizable harm upon the plaintiff.” *Id.* at 277-78 (citing *Ashcroft v. Iqbal*, 556 U.S. 662, 682 (2009)). In addition, when presented with a 12(b)(6) motion to dismiss, the court “must accept the truth of all factual allegations in the complaint and must draw all reasonable inferences in favor of the non-movant.” *Id.* at 278 (citing *Gross v. German Found. Indus. Initiative*, 549 F.3d 605, 610 (3d Cir. 2008)).

### **B. The Court Erred in Dismissing Appellant’s Complaint**

The District Court erred in relying on the title and claim text of the '946 Patent to narrowly construe its claim to apply solely to a chair and determine, under the ordinary observer standard, that a basket could not infringe the claim in '946 Patent. In addressing a design patent infringement claim, courts employ a two-step analysis: (1) construing the meaning and scope of the design patent claim; and (2) comparing the protected patent to the infringing product. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). Here, the District Court’s step one analysis was flawed because of its reliance on the title and text of the

patent, as opposed to the figures, which determine its true scope.<sup>1</sup> And the Court's decision to limit the scope of the patent to an ornamental design for chairs was reversible error. In addition, the District Court erred at step two by concluding that, based solely on the article of manufacture identified in the '946 Patent, Curver could not assert claims beyond that article. As such, the District Court granted Home Expressions' motion to dismiss on each of these grounds. For the reasons discussed herein, however, all three bases constitute reversible error.

1. *The District Court's Failure to Assess the Figures Attached to Curver's Design Patent Application Tainted the District Court's Claim Construction Analysis*

Here, the District Court's claim construction analysis failed to examine, or even reference, the patent figures. Instead, the District Court relied upon the title and text of the patent to limit its scope to an ornamental design for a chair. By relying on the title and text of the '946 Patent, the District Court ran afoul of the Federal Circuit's instruction that "in determining the scope of the claimed design, 'it is the drawings of the design patent that provide the description of the invention.'" *Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014) (quoting *In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998)). "Figures are required in design patent applications because they, **not the textual claim**, 'constitute a complete disclosure of the appearance of the design.'" *Id.*

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<sup>1</sup> The District Court's claim construction was guided by its *sua sponte* prosecution history estoppel analysis, which, as discussed below, was also done in error.

*Id.* (quoting 37 C.F.R. § 1.152) (emphasis added). Indeed, “in design patents, unlike utility patents, the claimed scope is defined by drawings rather than language . . . .” *Id.* “Accordingly, design patents have almost no scope; they are limited to what is shown in the application drawings.” *Reddy v. Lowe’s Cos., Inc.*, 60 F. Supp. 3d 249, 256 (D. Mass. 2014) (quoting *Concept Innovation v. CFM Corp.*, No. 04-3345, 2004 WL 2812109, at \*1 (N.D. Ill. Dec. 7, 2004) (citing *Elmer*, 67 F.3d at 1577)). In fact, “any written description that goes beyond the scope of the figures would be unprotected by the patent, and thus, ought not be part of the construed claim.” *Id.*

Moreover, the District Court’s determination that the patent’s claim could be no broader than its descriptive title misconstrues the nature of a design patent’s title. *Minka Lighting, Inc. v. Craftmade Int’l, Inc.*, No. 00-888, 2001 U.S. Dist. LEXIS 27471, at \*12 (N.D. Tex. May 15, 2001). “A design patent title is simply the generic name for the article of manufacture in which the patented design is embodied. That same generic name appears in a design patent claim because of the requirement that the title and claim ‘correspond.’” *Id.* As such, “[i]n a design patent application, the subject matter which is claimed is the design embodied in or applied to an article of manufacture (or portion thereof) and **not the article itself.**” *Reddy*, 60 F. Supp. 3d at 251-52 (quoting *Manual of Patent Examining Procedure* § 1502 (9th ed. 2014)) (emphasis added). This is consistent with 35 U.S.C. § 171,

because “§ 171 refers, not to the design of an article, but to a design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods.” *In re Zahn*, 617 F.2d 261, 268 (C.C.P.A. 1980) (emphasis added). Indeed, in *Zhan*, the court “explained that the word ‘therefor,’ in the phrase ‘may obtain a patent, therefor,’ refers back to ‘design,’ not to ‘article of manufacture.’” *Minka*, 2001 U.S. Dist. LEXIS 27471, at \*12 (quoting *In re Zahn*, 617 F.2d at 268). Here, the “subject matter” at issue is the ornamental “Y” design shown in the ’946 Patent figures, not a chair, which is simply an article of manufacture in which the design is embodied. As such, by failing to construct Curver’s patent claim based on the figures attached to its patent application, the District Court erred in concluding that the ’946 Patent is limited to chairs.

## 2. *The District Court Misapplied the Ordinary Observer Standard*

After improperly limiting the scope of Curver’s patent claim, the District Court also misapplied the ordinary observer standard for determining infringement of a design patent. Under the ordinary observer standard, “the claim as properly construed must be compared to the accused device or process” to determine whether a design patent has been infringed. *Carroll Touch, Inc. v. Electro Mech. Sys.*, 15 F.3d 1573, 1576 (Fed. Cir. 1993). A design patent is infringed if “an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design.” *Egyptian Goddess, Inc. v.*

*Swisa, Inc.*, 543 F.3d 665, 672 (Fed. Cir. 2008) (en banc). In applying the ordinary observer test, “[i]t is the drawings in the patent, not just one feature of the claimed design, that define the patented design.” *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006).

Significantly, the ordinary observer test applied to determine infringement is the same test applied to determine anticipation. *See Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889) (“That which infringes, if later, would anticipate if earlier.”); *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1239 (Fed. Cir. 2009) (“it has been well established for over a century that the same test must be used for both infringement and anticipation”); *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1378 (Fed. Cir. 2004) (explaining that the test for determining anticipation of a design patent is the same as the test for infringement); *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312 (Fed. Cir. 2001) (“the design patent infringement test also applies to design patent anticipation”). In other words, if a preexisting design would prevent the issuance of a patent by anticipation, that same design would infringe a patent if published after the patent has issued. This principle is significant to this case, because as determined long ago by this Court’s predecessor, a prior art design can be anticipatory regardless of the article of manufacture in which it is embodied.

Specifically, in *Application of Glavas*, the Court of Customs and Patent Appeals explained that the question of design patent anticipation turns solely on the design itself, without reference to its particular article of manufacture. 230 F.2d 447, 450 (C.C.P.A. 1956). In *Glavas* the PTO rejected a patent application for a swimming float as anticipated by various different articles of manufacture: a life preserver, a pillow, a baby supporter, bottles, a razor blade sharpener, and a bar of soap. *Id.* The court upheld the rejection of the application, explaining that “the use to which an article is to be put has no bearing on its patentability as a design and that if the prior art discloses any article of substantially the same appearance as that of an applicant, it is immaterial what the use of such article is.” *Id.* The court emphasized that, “if the problem is merely one of giving an attractive appearance to a surface, it is immaterial whether the surface in question is that of wall paper, an oven door, or a piece of crockery.” *Id.*; see also *H.K. Porter Co., Inc. v. Black and Decker Mfg. Co.*, Nos. 71-2859, 71-2860, 1974 WL 20209, at \*19-20 (N.D. Ill. July 17, 1974) (invalidating a design patent embodied in a cordless electric grass shear, since it was “very similar” to the design of a kitchen stand mixer, and holding, based on *Glavas*, that it “is immaterial that the Vista design is for a kitchen appliance and the Disston design is for a lawn tool”); *Black and Decker Inc. v. Pittway Corp.*, 636 F. Supp. 1193, 1196-97 (N.D. Ill. 1986) (same, relying on *Glavas* and *H.K. Porter*); *Manual of Patent Examining Procedure* § 1504.01

(9th ed. 2015) (“Anticipation does not require that the claimed design and the prior art be from analogous arts.”).<sup>2</sup>

Here, the District Court’s application of the ordinary observer standard was flawed because it focused its analysis on the articles that embodied the designs, rather than the designs themselves. In doing so, the District Court framed the analysis as comparing a chair to a basket and, therefore, concluded that no reasonable observer would mistake one product for the other. The District Court’s focus on the article of manufacture, rather than the ornamental design, directly conflicts with Federal Circuit precedent. The Federal Circuit, in *Egyptian Goddess*, made clear that the proper test is whether “the accused article ‘embod[ies] the patented design or any colorable imitation thereof.’” *Egyptian Goddess*, 543 F.3d at 677 (quoting *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1116-17 (Fed. Cir. 1998)). Put differently, “[t]he question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *In re Glavas*, 230 F.2d at 450. Again, as the *Glavas* Court explained, “if the problem is merely one of giving an attractive appearance

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<sup>2</sup> That the article of manufacture is irrelevant for purposes of determining validity or infringement of the ’946 Patent is further supported by the fact that the PTO conducted a broad search of potential prior art, which included searching several classes of patents unrelated to chairs. (Appx033).



to a surface, it is immaterial whether the surface in question is that of wall paper, an oven door, or a piece of crockery.” *Id.*

In support of its decision, the District Court cited three nonbinding district court decisions, which purportedly hold that a design patent is limited to the article of manufacture that embodies the ornamental design. The lead case, *Vigil v. Walt Disney Co.*, No. 97-4147, 1998 U.S. Dist. LEXIS 22853, at \*8-10 (N.D. Cal. Dec. 1, 1998), *aff’d in part and rev’d in part on other grounds*, 2000 U.S. App. LEXIS 6231 (Fed. Cir. Apr. 5, 2000), provides little analysis other than to say that the plaintiff’s tubular and hockey stick-themed duck calls were not “substantially similar” to Disney’s Mighty Ducks key chain. Indeed, contrary to Federal Circuit authority, the *Vigil* court did not limit its infringement analysis to the ornamental design at issue but, rather, appeared to combine the design and the article of manufacture to reach its determination. The other two cases relied upon by the District Court, *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 679-80 (E.D. Mich. 2003) and *P.S. Products, Inc. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795, 801-03 (E.D. Ark. 2014), both cite to and rely upon *Vigil*, and suffer from the same infirmity of intertwining the ornamental design of the patent with the article of manufacture in which it is embodied to determine infringement. In sum, all three cases that the District Court relied upon should be disregarded, because they fail to adhere to the proper infringement analysis espoused by this Court.

In fact, when the District Court here conducted the proper infringement analysis, and focused on the ornamental design, it **did** find the design applied to the infringing basket to be substantially similar to the '946 Patent design. Nevertheless, the District Court improperly concluded that there was no infringement, because the accused product embodying the patented design is a basket, not a chair. This decision constitutes reversible error.

*3. The District Court's Application of the Doctrine of Prosecution History Estoppel Was Misplaced*

The District Court also erred in finding the doctrine of prosecution history estoppel applicable. The doctrine of prosecution history estoppel serves to limit the bounds of what “a patentee can claim as equivalent by ‘requir[ing] that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process.’” *Pac. Coast*, 739 F.3d at 700 (quoting *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002)). Determining whether a patent infringement claim is barred requires three considerations: “(1) whether there was a surrender; (2) whether it was for reasons of patentability; and (3) whether the accused design is within the scope of the surrender.” *Id.* at 702.

The first inquiry, surrender of claim, requires the court to determine the scope of the claimed design. *Id.* As noted above, unlike utility patents, “[i]t is the drawings of the design patent that provide the description of the invention.” *In re Daniels*, 144 F.3d at 1456. Accordingly, as the Federal Circuit has made clear,

“while we look primarily to the wording of the claims in utility patents for the purpose of prosecution history estoppel, we must look at the requisite drawings in design patents to determine whether a surrender has occurred.” *Pac. Coast*, 739 F.3d at 702 (emphasis added).

Thus, in *Pacific Coast*, the Federal Circuit affirmed the district court’s application of prosecution history estoppel relating to a design patent, where the patentee eliminated certain figures in response to an initial rejection issued by the PTO. There, the design patent application claimed an ornamental design of a marine windshield and attached seven figures depicting various embodiments of the claimed design. *Id.* at 697-98. The examiner determined that the attached embodiments were patentably distinct and, therefore, issued a restriction requirement. *Id.* at 698-99. In response, the patentee elected a single embodiment and struck from its application the figures associated with the alternative configurations, which resulted in the issuance of a design patent for the single embodiment. *Id.* at 699. In analyzing the issue of prosecution history estoppel, the Federal Circuit noted that the patentee “amended the claim by cancelling figures associated with all but one of the patentably distinct groups of designs identified by the examiner . . . and striking references to alternate configurations from the test.” *Id.* These changes to the figures, the Federal Circuit explained, constituted a

surrender of claim scope and, as such, the patentee narrowed the scope of his original application. *Id.*

Neither Home Expressions nor the District Court cited any case where the doctrine of prosecution history estoppel was applied to a situation where the change made to a design application during prosecution was a change in the title with no substantive changes to the figures.<sup>3</sup> Fatal to the District Court's prosecution history estoppel analysis is the fact that it failed to examine, or even mention, the patent figures. Indeed, the office action issued by the PTO, regarding the title, was submitted after the substantive examination of the application on its merits had closed, pursuant to *Ex Parte Quayle*, 1935 Dec. Comm'r Pat. 11, 25 U.S.P.Q. 74 (1935). Under *Ex Parte Quayle*, “**after all claims in an application have been allowed** the prosecution of the application on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution.” *Manual of Patent Examining Procedure* § 714.14 (9th ed. 2015) (emphasis added). In other words, the design application had been allowed but for the minor formality objections.

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<sup>3</sup> The cases cited by the District Court do not stand for such a proposition, as both cases involved utility patents, as opposed to design patents. *See Honeywell Int'l. Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1144 (Fed Cir. 2004) (finding estoppel in the context of a utility patent and changes made to the claim language, including changing dependent claims into independent claims); *Deering Precision Instruments, L.L.C. v. Vector Distrib. Sys., Inc.*, 347 F.3d 1314, 1325-26 (Fed. Cir. 2003) (finding estoppel applicable where dependent and independent claims were re-written to include limiting language).

Based on the foregoing, there was no surrender of claim scope, much less any surrender for reasons of patentability. As such, the District Court's application of prosecution history estoppel to limit the scope of the claim to the article of manufacture identified in the patent constitutes reversible error.

## **VII. CONCLUSION AND STATEMENT OF RELIEF SOUGHT**

When considering the factual allegations presented in the Complaint, along with the ornamental design of the '946 Patent and the ornamental design of the accused product Curver has presented more than sufficient evidence that Home Expressions' baskets infringe the '946 Patent under the ordinary observer test. As the District Court itself acknowledged, the patented and accused designs are "substantially similar." Accordingly, Curver respectfully requests that the Court reverse the District Court's judgment dismissing Curver's Complaint.

Dated: October 2, 2018

Respectfully submitted,

By: s/ Jason Kislin

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## **ADDENDUM**

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY

**CURVER LUXEMBOURG, SARL,**

**Plaintiff,**

**vs.**

**HOME EXPRESSIONS INC.,**

**Defendant.**

Civ. No. 2:17-cv-4079-KM-JBC

**ORDER**

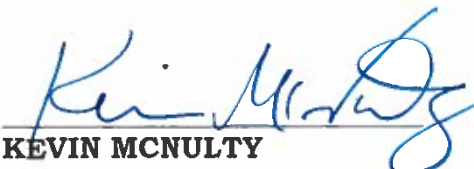
**KEVIN MCNULTY, U.S.D.J.:**

**THIS MATTER** having come before the Court on the motion of defendant Home Expression Inc. to dismiss, pursuant to Federal Rule of Civil Procedure 12(b)(6) (ECF no. 13); and plaintiff Curver Luxembourg, SARL having opposed the motion (ECF no. 15); and the Court having reviewed the moving (ECF no. 13), opposition (ECF no. 15), and reply papers (ECF no. 16), as well as the exhibits (ECF nos. 7, 13); for the reasons set forth in the accompanying Opinion, and for good cause shown;

**IT IS** this 8th day of January, 2018,

**ORDERED** that defendant's motion to dismiss (ECF no. 13) is **GRANTED**. The dismissal is without prejudice to the filing of a properly supported motion to file a second amended complaint, with proposed pleading attached, within 30 days. If no such motion is timely received, this dismissal shall become final.

The clerk shall close the file.

  
**KEVIN MCNULTY**  
United States District Judge

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY**

**CURVER LUXEMBOURG, SARL,**

**Plaintiff,**

**vs.**

**HOME EXPRESSIONS INC.,**

**Defendant.**

Civ. No. 2:17-cv-4079-KM-JBC


**ORDER**

The plaintiff, Curver Luxembourg, SARL ("Curver"), having filed a motion (ECF no. 19) for reconsideration of the Court's order and opinion (ECF nos. 17, 18) granting the motion to dismiss the complaint; and the defendant, Home Expressions Inc. ("Home Expressions") having filed an opposition (ECF no. 20); and the Court having considered the matter without oral argument; for the reasons stated in the accompanying Opinion, and good cause appearing therefor;

IT IS, this 6<sup>th</sup> day of July, 2018

ORDERED that Curver's motion for reconsideration. (ECF no. 19) is DENIED.

The clerk shall close the file.

  
**KEVIN MCNULTY**  
United States District Judge



**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY**

**CURVER LUXEMBOURG, SARL,**

**Plaintiff,**

**vs.**

**HOME EXPRESSIONS INC.,**

**Defendant.**

Civ. No. 2:17-cv-4079-KM-JBC

**OPINION**

**KEVIN MCNULTY, U.S.D.J.:**

Plaintiff Curver Luxembourg, SARL (“Curver”) is the owner of a design patent, No. D677,946 (“the ’946 Patent”), which claims an overlapping “Y” design. Curver alleges that Home Expressions Inc. (“Home Expressions”) makes and sells a basket that incorporates this design and therefore infringes the ’946 Patent. Now before the court is defendant Home Expressions’ motion to dismiss the Complaint. (ECF no. 13).<sup>1</sup> For the following reasons, Home Expressions’ motion is granted.

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<sup>1</sup> Citations to the record are abbreviated as follows:

“Compl.” = Complaint (ECF no. 1)

“’946 Patent” = Patent D677,946 (ECF no. 7)

“Ex. 2” = Plaintiff’s Exhibit 2 (ECF no. 7-1)

“Ex. 3” = Plaintiff’s Exhibit 3 (ECF no. 7-2)

“Def. Br.” = Memorandum of Points and Authorities in Support of Home Expressions Inc.’s Motion to Dismiss (ECF no. 13-1)

“Ex. A” = Defendant’s Exhibit A (ECF no. 13-3)

“Ex. B” = Defendant’s Exhibit B (ECF no. 13-4)

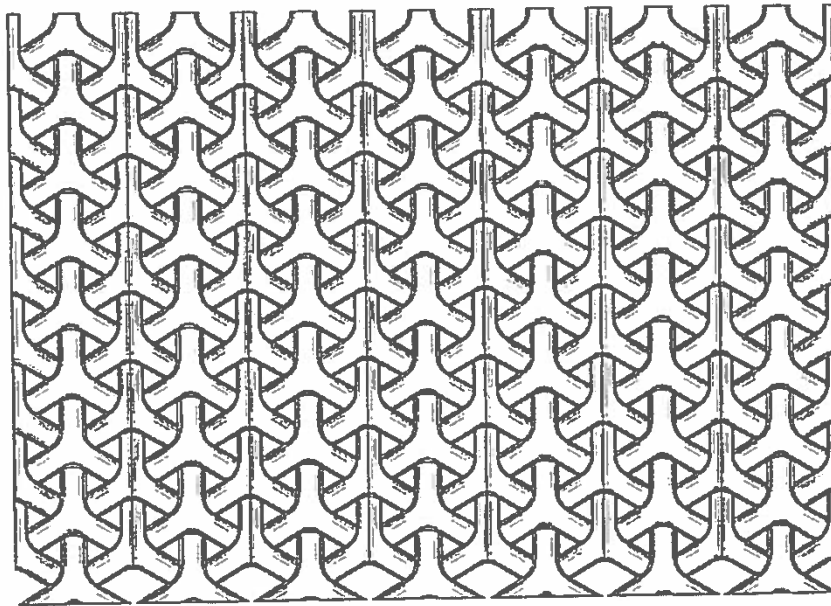
“Pl. Br.” = Plaintiff’s Opposition to Defendant’s Motion to Dismiss (ECF no. 15)

## I. BACKGROUND<sup>2</sup>

Curver, a Luxembourg corporation, owns the '946 Patent, which is titled "Pattern for a Chair." (Compl. ¶ 1; '946 Patent). Home Expressions is a New York corporation with its principal place of business in New Jersey. (Compl. ¶ 2).

The '946 Patent claims the ornamental "Y" design pictured below:

**Figure 1**



(Compl. ¶ 7; '946 Patent).

Curver's original design patent application was not accepted by the U.S. Patent and Trademark Office ("PTO"). (Ex. A). Curver originally applied for a design patent with the titles "Furniture Part" and "Furniture (Part of)." (Ex. A). The PTO objected, explaining:

The title of the design must *designate the particular article*, which is the subject of the design. 37 CFR 1.153. The title of the design

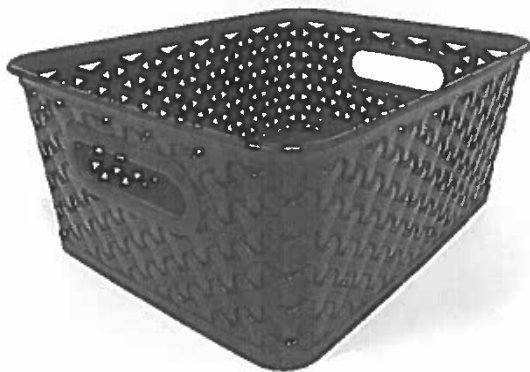
<sup>2</sup> For purposes of this motion to dismiss I take all allegations in the complaint to be true and draw all inferences in favor of Curver as plaintiff. See Section II.A, *infra*.

identifies the article in which the design is embodied by the name generally known and used by the public. MPEP 1503, I.

(Ex. A). Curver rectified this by resubmitting the design patent for “[t]he ornamental design for a pattern for a chair.” (’946 Patent); (Ex. A; Ex. B). Each figure in the patent was now described as a view of a “design for a pattern for a chair.” (’946 Patent).

Curver makes and sells storage baskets that incorporate the patented “Y” design. (Compl. ¶ 8). Home Expressions sells storage baskets that are allegedly “identical” to baskets sold by Curver. (Compl. ¶ 10). Home Expressions’ baskets allegedly contain “each element of the claimed design in the ’946 Patent,” as well as unprotected elements of Curver’s basket, such as an alternating matte and glossy finish on the bottom surface. (Compl. ¶¶ 11-12). Figure 2 shows an example of Curver’s basket. (Ex. 2). Figure 3 shows an example of Home Expressions’ baskets. (Ex. 3).

**Figure 2**



**Figure 3**



On June 6, 2017, Curver filed a complaint against Home Expressions, claiming that the manufacture, use, sale, offer for sale, and/or importation of Home Expressions’ basket constitutes patent infringement under 35 U.S.C. § 271 *et seq.* (Compl. ¶ 11). Curver seeks a permanent injunction and

damages. (Compl.). Home Expressions filed a motion to dismiss Curver's claim on July 24, 2017. (ECF no. 13).

## II. LEGAL STANDARDS

### A. Motion to Dismiss

Federal Rule of Civil Procedure 12(b)(6) provides for the dismissal of a complaint, in whole or in part, if it fails to state a claim upon which relief can be granted. The moving party bears the burden of showing that no claim has been stated. *Hedges v. United States*, 404 F.3d 744, 750 (3d Cir. 2005). In deciding a motion to dismiss under Rule 12(b)(6), a court must take all allegations in the complaint as true and view them in the light most favorable to the plaintiff. *See Warth v. Seldin*, 422 U.S. 490, 501 (1975); *Trump Hotels & Casino Resorts, Inc. v. Mirage Resorts Inc.*, 140 F.3d 478, 483 (3d Cir. 1998); *see also Phillips v. County of Allegheny*, 515 F.3d 224, 231 (3d Cir. 2008).

Federal Rule of Civil Procedure 8(a) does not require that a complaint contain detailed factual allegations. Nevertheless, "a plaintiff's obligation to provide the 'grounds' of his 'entitlement to relief' requires more than labels and conclusions, and formulaic recitation of the elements of a cause of action will not do." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). Thus, the factual allegations must be sufficient to raise a plaintiff's right to relief above a speculative level, such that it is "plausible on its face." *See id.* at 570; *see also Umland v. PLANCO Fin. Servs., Inc.*, 542 F.3d 59, 64 (3d Cir. 2008). A claim has "facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 556). While "[t]he plausibility standard is not akin to a 'probability requirement' ... it asks for more than a sheer possibility." *Iqbal*, 556 U.S. at 678.

The United States Court of Appeals for the Third Circuit has explicated the *Twombly/Iqbal* standard on several occasions. *See, e.g., Argueta v. U.S. Immigration & Customs Enforcement*, 643 F.3d 60, 70-73 (3d Cir. 2011);

*Santiago v. Warminster Twp.*, 629 F.3d 121, 129-30 (3d Cir. 2010). In doing so, it has provided a three-step process for evaluating a Rule 12(b)(6) motion:

To determine whether a complaint meets the pleading standard, our analysis unfolds in three steps. First, we outline the elements a plaintiff must plead to state a claim for relief. *See Iqbal*, 556 U.S.] at 675; *Argueta*, 643 F.3d at 73. Next, we peel away those allegations that are no more than conclusions and thus not entitled to the assumption of truth. *See Iqbal*, 556 U.S. at 679; *Argueta*, 643 F.3d at 73. Finally, we look for well-pled factual allegations, assume their veracity, and then “determine whether they plausibly give rise to an entitlement to relief.” *Iqbal*, 556 U.S. at 679; *Argueta*, 643 F.3d at 73. This last step is “a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Iqbal*, 556 U.S. at 679.

*Bistrrian v. Levi*, 696 F.3d 352, 365 (3d Cir. 2012).

“In deciding a Rule 12(b)(6) motion, a court must consider only the complaint, exhibits attached to the complaint, matters of the public record, as well as undisputedly authentic documents if the complainant’s claims are based upon these documents.” *Mayer v. Belichick*, 605 F.3d 223, 230 (3d Cir. 2010); *see also In re Asbestos Prods. Liability Litig. (No. VI)*, 822 F.3d 125, 134 & n.7 (3d Cir. 2016); *Buck v. Hampton Twp. Sch. Dist.*, 452 F.3d 256, 260 (3d Cir. 2006) (“In evaluating a motion to dismiss, we may consider documents that are attached to or submitted with the complaint, and any matters incorporated by reference or integral to the claim, items subject to judicial notice, matters of public record, orders, and items appearing in the record of the case.”).

### **B. Design Patent Infringement**

Federal patent law permits those who invent designs for manufactured articles to patent their designs. 35 U.S.C. § 171(a). Patent protection is available for a “new, original and ornamental design for an article of

manufacture.”<sup>3</sup> *Id.* A patentable design “gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form.” *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 525 (1871); *see also Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429, 432-33 (2016).

In general, a patent infringement analysis involves two steps: claim construction and claim comparison.

First, the court construes the patent. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372-74 (1996); *see MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323, 1329 (Fed. Cir. 2007). Claim construction is an issue of law committed to the district judge for determination. *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1337 (Fed. Cir. 2015); *see Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995) (holding that claim construction is “a matter of law exclusively for the court”).

In the case of design patents, which involve matters of physical appearance, the claim construction process is often uncomplicated. Relevant precedent requires that the court simply construe the design patents as they are shown in the patent drawings. *MSA Prods., Inc. v. Nifty Home Prods., Inc.*, 883 F. Supp. 2d 535, 540-41 (D.N.J. 2012). “Design patents are typically claimed as shown in drawings, and claim construction must be adapted to the pictorial setting.” *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1302 (Fed.

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<sup>3</sup> “Article of manufacture” has a broad meaning, but essentially describes any product. As the Supreme Court explained in *Samsung*,

An “article” is just “a particular thing.” J. Stormonth, *A Dictionary of the English Language* 53 (1885) (Stormonth); *see also* American Heritage Dictionary, at 101 (“[a]n individual thing or element of a class; a particular object or item”). And “manufacture” means “the conversion of raw materials by the hand, or by machinery, into articles suitable for the use of man” and “the articles so made.” Stormonth 589; *see also* American Heritage Dictionary, at 1070 (“[t]he act, craft, or process of manufacturing products, especially on a large scale” or “[a] product that is manufactured”). An article of manufacture, then, is simply a thing made by hand or machine.

*Samsung Elecs. Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429, 434-35 (2016).



Cir. 2010). “Depictions of the claimed design in words can easily distract from the proper infringement analysis of the ornamental patterns and drawings.” *Id.*; see *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008); *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002).

At the second step of this analysis, the design patent’s claims (as now construed) are compared to the allegedly infringing products. See *PC Connector Sols. LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1362 (Fed. Cir. 2005). This step involves a factual determination. See *id.* at 1364. When considering infringement of a design patent, courts use the “ordinary observer” test. *Crocs*, 598 F.3d at 1303. Under the ordinary observer test, infringement occurs:

[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, the first one patented is infringed by the other.

*Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871); *Egyptian Goddess*, 543 F.3d at 670-71. This test was codified in the Patent Act of 1952, which provides as follows:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

35 U.S.C. § 289.

Infringement is not found unless the accused article embodies the patented design or any colorable imitation of it. *Egyptian Goddess*, 543 F.3d at 678. If no ordinary observer could determine that the allegedly infringed patent and the allegedly infringing article are substantially the same, dismissal is appropriate. *Id.*; see *MSA Prods.*, 883 F. Supp. 2d at 541. Thus, while

infringement is a question of fact, courts may dismiss claims of design infringement on a Rule 12(b)(6) motion where, as a matter of law, no reasonable factfinder could find infringement. *See Vigil v. Walt Disney Co.*, 232 F.3d 911 (Fed. Cir. 2000) (unpublished table decision) (“We agree that the district court did not exceed its discretion in dismissing the action on its merits.”); *Colida v. Nokia, Inc.*, 347 F. App’x 568, 569-70 (Fed. Cir. 2009); *MSA Prods. v. Nifty Home Prods.*, 883 F. Supp. 2d 535, 540 (D.N.J. 2012); *Parker v. Kimberly-Clark Corp.*, No. 11 C 5658, 2012 WL 74855, at \*2-3 (N.D. Ill. Jan. 10, 2012); *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 679-80 (E.D. Mich. 2003).

### III. DISCUSSION

I discuss the two steps of the analysis in order: First, the construction of the claim as a matter of law, and second, the comparison of the claim to the allegedly infringing product, as a matter of fact.

#### A. Claim Construction

Courts generally need not conduct an elaborate claim construction analysis for design patents because the court should construe design patents as they are shown in the patent drawings. *MSA Prods., Inc. v. Nifty Home Prods., Inc.*, 883 F. Supp. 2d 535, 540-41 (D.N.J. 2012). “[A] design [patent] is better represented by an illustration ‘than it could be by any description and a description would probably not be intelligible without the illustration.’” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)); *see also Manual of Patent Examining Procedure* § 1503.01 (9th ed. 2015) (“[A]s a rule the illustration in the drawing is its own best description.”). For those reasons, a court is not obligated to issue a detailed verbal description of the design if it would not be helpful. *Egyptian Goddess*, 543 F.3d at 679-80. Nonetheless, it is necessary to determine the scope of the design patent at issue. I will separately address (1) prosecution history estoppel and (2) the scope of the patent more generally.



### 1. Prosecution History Estoppel

The doctrine of prosecution history estoppel prevents a patentee from “recaptur[ing] in an infringement action the very subject matter surrendered as a condition of receiving the patent.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 734 (2002). It requires that “the claims of a patent be interpreted in light of the proceedings in the PTO during the application process.” *Id.* at 733.

Where the patentee in the course of his application in the patent office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed.

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 218 (1940); *see Festo*, 535 U.S. at 733-34. While prosecution history estoppel has more commonly been applied in utility patent proceedings, it applies to design patents as well. *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014).<sup>4</sup>

Whether prosecution history estoppel bars the infringement claim in this case turns on three questions: **(a)** whether there was a surrender of claim scope; **(b)** whether the surrender was for reasons of patentability; and **(c)** whether the accused design is within the scope of the surrender. *Id.*

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<sup>4</sup> “With respect to utility patents, prosecution history estoppel limits a patentee’s ability to recover under the doctrine of equivalents, but does not limit literal infringement.... For design patents, the concepts of literal infringement and equivalents infringement are intertwined.” *Pacific Coast*, 739 F.3d at 700-01. Thus, prosecution history estoppel applies to all design patent infringement claims. This is because “the test for design patent infringement is not identity, but rather sufficient similarity—whether ‘the accused design could not reasonably be viewed as so similar to the claimed design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs,’ ‘inducing him to purchase one supposing it to be the other.’” *Id.* (citing *Egyptian Goddess*, 543 F.3d at 683 (quoting *Gorham*, 81 U.S. (14 Wall.) at 528)).

(a) There was a surrender of claim scope during prosecution. In general, courts look “primarily to the wording of the claims in utility patents for the purpose of prosecution history estoppel, [but ...] look at the requisite drawings in design patents to determine whether a surrender has occurred.” *Pacific Coast*, 739 F.3d at 702. Nonetheless, language used in a design patent, such as the title, is relevant to the infringement analysis. The title of a design patent, for instance, can help delineate the scope of the design patent’s protections. *See P.S. Prods., Inc. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795, 802-03 (E.D. Ark. 2014) (construing a design patent as for the ornamental design for a stun gun because the ’294 patent’s “sole claim is for ‘[t]he ornamental design for a stun gun, as shown and described’”); *see also Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 679-80 (E.D. Mich. 2003) (discussing the scope of a design patent and noting that it was for “[t]he ornamental design for a hat, as shown and described”).

In this case, the title of the patent is relevant because the design patent was explicitly and intentionally narrowed to one article of manufacture during the prosecution history. Curver originally applied for a patent directed to a pattern for “furniture.” (Ex. A). The PTO rejected this application, explaining its decision as follows:

The title of the design must *designate the particular article*, which is the subject of the design. 37 CFR 1.153. The title of the design identifies the article in which the design is embodied by the name generally known and used by the public. MPEP 1503, I. The claim in a design patent must be directed to the design for an article. 35 U.S.C. 171.

(Ex. A). Curver then resubmitted the design patent as “[t]he ornamental design for a pattern *for a chair*.” (’946 Patent (emphasis added); Ex. A; Ex. B). Each figure in the published patent is described as a view of a “design for a pattern *for a chair*.” (’946 Patent (emphasis added)). The title of the patent is a “Pattern *for a Chair*.” (’946 Patent (emphasis added)).

The scope of the claim was thus narrowed during the prosecution history. Curver surrendered a claim for an ornamental pattern “for furniture” and accepted a design patent for an ornamental pattern “for a chair.” (Ex. A); (Ex. B; ’946 Patent). This is just the sort of claim surrender that gives rise to prosecution history estoppel. *See Honeywell Int’l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1144 (Fed. Cir. 2004); *Deering Precision Instruments, L.L.C. v. Vector Distrib. Sys., Inc.*, 347 F.3d 1314, 1325-26 (Fed. Cir. 2003).

(b) Second, the claim scope was surrendered in order to secure the patent—indeed, as a *condition* of obtaining the patent. The PTO, rejecting the initial, broader application, explained that Curver’s patent must “*designate the particular article*” that is the subject of the design. (Ex. A). A design patent extends to “an article of manufacture”; 35 U.S.C. § 171 provides that, “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” Thus, by statute, a design patent is limited to one article of manufacture, and an inventor of an ornamental design may obtain a patent for that design for that article.

Relevant regulations confirm that initial impression. Thus 35 C.F.R. § 1.153 states, in relevant part, as follows:

The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

This regulation confirms that a design patent protects an ornamental design on one specified article of manufacture. The *Manual of Patent Examining Procedure* concurs: “In a design patent application, the subject matter which is claimed is the design embodied in or applied to *an* article of manufacture (or portion thereof) and *not* the article itself.” § 1502 (9th ed. 2015) (first emphasis added).

Curver demurs. It argues that 35 U.S.C. § 289, which provides for damages in design patent infringement cases, allows infringement claims

against “any article of manufacture,” not just for the same article of manufacture. (Pl. Br. 2-7). Section 289 provides as follows:

Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, *to any article of manufacture* for the purpose of sale, or (2) sells or exposes for sale *any article of manufacture* to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.

35 U.S.C. § 289 (emphasis added).

However, Section 171, which provides for design patents, clarifies that an inventor can obtain a patent for an ornamental design for an article of manufacture. Section 289, which provides for damages in design patent infringement cases, should not be read as creating a remedy that is broader than the right. Section 289 is premised upon a prior finding of infringement; that finding of infringement is the narrow gate through which any claim for damages must first pass. If Section 289 permitted damages in design patent cases whenever an individual used an ornamental design with any product, it would make a hash of the statutory scheme.

Curver’s interpretation has been rejected by three district courts in which it has been asserted. First, in *Vigil v. Walt Disney Co.*, the court found that defendant’s product did not infringe plaintiff’s “duck call” largely because “plaintiff’s duck call is not even an analogous article of manufacture when compared to Disney’s key chain.” 1998 U.S. Dist. LEXIS 22853, at \*9-10 (N.D. Cal. Dec. 1, 1998). Second, in *Kellman v. Coca-Cola Co.*, the court found that plaintiff’s design patent was directed to “[t]he ornamental design for a [‘wing nut’] hat” and did not cover defendants using the “wing nut” design on t-shirts or bottle caps. 280 F. Supp. 2d 670, 679-80 (E.D. Mich. 2003). Third, in *P.S. Products, Inc. v. Activision Blizzard, Inc.*, the court held that a design patent for a stun gun did not extend to that image as used in a video game. 140 F. Supp. 3d 795, 801-03 (E.D. Ark. 2014). I agree with these three cases in finding that

design patents are limited in scope to the article of manufacture the design patent claims.

Curver's original application was for "Furniture Part" and "Furniture (Part of)." (Ex. A). The PTO objected, stating that the title of the design "must *designate the particular article*, which is the subject of the design." (Ex. A). Curver responded by designating the particular article as a chair. The surrendered claim was clearly related to patentability. Curver cannot, in this infringement action, "recapture" the claim it surrendered in the patent prosecution.<sup>5</sup>

(c) On the third issue, the accused design is surely within the scope of the surrender. From one point of view, what Curver surrendered was application of its patent to anything that was not a chair. Home Expressions' basket is not a chair.

If there is any doubt on this issue, it is only because Home Expressions' basket is not even within the scope of the patent as *originally* proposed. A basket would not reasonably be regarded as an item of "furniture."<sup>6</sup> Therefore, I

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<sup>5</sup> In this respect, the mode of interpretation of a design patent must be contrasted with that of a utility patent. In general, the title is not given weight in an action for infringement of a utility patent. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1312-13 (Fed. Cir. 1999). *Id.* "In short, utility patent titles are unimportant to claim construction because, unlike design patents, utility patents may take a variety of forms and may or may not use the same terms as the patent title." *Minka Lighting, Inc. v. Craftmade Int'l, Inc.*, No. 3-00-cv-0888-x, 2001 WL 1012685, at \*4 (N.D. Tex. Aug. 20, 2001).

By contrast, the title of a design patent may be relevant to the scope of the design patent. *See P.S. Prods., Inc. v. Activision Blizzard, Inc.*, 140 F. Supp.3d 795 (E.D. Ark. 2014); *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670 (E.D. Mich. 2003). As relevant here, it may designate the "article of manufacture" to which the design patent applies.

<sup>6</sup> For instance, in *United States v. Quon Quon Co.*, the U.S. Court of Customs and Patent Appeals (which was replaced by the Federal Circuit) disputed whether wicker tabletops intended for use as patio furniture and made of woven rattan should be classified as "baskets" or "furniture." 46 C.C.P.A. 70 (1959). The tabletops were classified as "furniture" because they were sold and used only as tops of coffee or cocktail tables; "baskets" were a separate, non-furniture category. *Id.* at 73-74. In the end, baskets were not considered furniture unless they were being used for a non-basket purpose. That would not apply in this case.

suppose, it is arguable that this scope was not “surrendered” because it was never contemplated or claimed in the first place. As a basis for a claim of infringement, this argument is ironic, to say the least.

Requirements (a), (b), and (at least the spirit of) (c) are met. It would be reasonable to conclude that prosecution history estoppel bars Curver’s claim that the scope of the patent extends to anything but a chair. Nevertheless, to remove doubt, I will for purposes of argument concede the issue of prosecution history estoppel and construe the scope of the patent directly.

## 2. Scope of Design Patent

The analysis above helps to clarify the scope of the ’946 Patent.<sup>7</sup> The scope of a design patent is limited to the “article of manufacture”—i.e., the product—listed in the patent. Thus the patent protects only a pattern for a chair. It does not protect that same pattern on a basket. That *Curver* manufactures a basket using the design only confuses the issue. Curver’s claim must be that its patent was infringed; a basket, as such, cannot be infringed.

Curver argues that a design patent confers protection whenever an ordinary observer would view the two designs as substantially the same—regardless of the article of manufacture on which the design is located. In subsection III.A.1(b), *supra*, I explained that Curver’s interpretation has been rejected by three district courts and is not supported by the relevant statutes and regulations. *P.S. Products* and *Kellman* rejected design patent infringement claims by finding that design patents cover one article of manufacture; they found that a design patents’ protection does not extend to other articles of manufacture. See *P.S. Products, Inc. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795, 801-03 (E.D. Ark. 2014); *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 679-80 (E.D. Mich. 2003). *Vigil* relied on the fact that the accused product was

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<sup>7</sup> This analysis assume that the ’946 Patent is valid. Home Expressions suggests otherwise, but seemingly concedes validity *arguendo* at the motion to dismiss stage. (See Def. Br. 3-4.)



not of the same article of manufacture. *Vigil v. Walt Disney Co.*, C-97-4147, 1998 U.S. Dist. LEXIS 22853, at \*9-10 (N.D. Cal. Dec. 1, 1998). I agree with these three cases and hold that design patents are limited in scope to the article of manufacture that the design patent claims.

As noted above, even Curver's original, rejected patent application would not have encompassed Home Expression's design on a basket. (Ex. A; Ex. B). The original application was for a design on furniture. And what Curver got, as opposed to what it asked for, was a patent that protects against infringement for a particular "Y" design on chairs only.

For those reasons, I find that the '946 Patent is limited to an ornamental "Y" pattern, as shown in the patent's figures, as used in chairs. Its scope does not extend to other products or articles of manufacture.

#### **B. Claim Comparison**

The second stage of the patent infringement analysis is claim comparison. Here, the claim (as construed in the preceding step) is compared to the allegedly infringing product. *See PC Connector Sols. LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1362 (Fed. Cir. 2005). In design patent cases, the court employs the "ordinary observer test." *Egyptian Goddess*, 543 F.3d at 670; *Pacific Coast*, 739 F.3d at 701. That test is as follows:

[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, the first one patented is infringed by the other.

*Id.* (citing *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871)).<sup>8</sup> The specific designs used for comparison are the figures in the patent and images of the accused product. *See Crocs*, 598 F.3d at 1302-03. "The patentee must establish that an ordinary observer, familiar with the prior art designs, would

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<sup>8</sup> This test has been codified in 35 U.S.C. § 289, which was discussed in subsection III.A.1(b), *supra*.

be deceived into believing that the accused product is the same as the patented design.” *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010); *see Crocs*, 598 F.3d at 1302-03.


In this case, the '946 Patent, which protects an ornamental “Y” design for a chair, is compared to Home Expressions’ basket as shown in Figure 3. It is true that the “Y” design on the Home Expressions’ basket is substantially similar to the “Y” design shown in the '946 Patent. However, the '946 Patent is for a pattern for a chair. A reasonable observer would not purchase the Home Expressions’ basket, with the ornamental “Y” design, believing that he or she was purchasing what was protected by the '946 Patent—*i.e.*, the ornamental “Y” design applied to a chair. *See P.S. Prods.*, 140 F. Supp. 3d at 803 (“No reasonable person would purchase defendants’ video game believing they were purchasing plaintiffs’ stun gun.”). Design features aside, a basket is not a chair, and could not be mistaken for one.

Design patterns are limited to their article of manufacture and do not provide protection outside of those bounds. *See id.* at 801-03; *Kellman*, 280 F. Supp. 2d at 679-80; *Vigil*, 1998 U.S. Dist. LEXIS 22853, at \*9-10. Therefore, the complaint does not set forth a plausible claim that Home Expressions’ basket infringes Curver’s '946 Patent.

#### **IV. CONCLUSION**

For the foregoing reasons, I grant Home Expressions’ motion to dismiss the complaint. An appropriate order accompanies this opinion.

Dated: January 8, 2018

  
**KEVIN MCNULTY**  
United States District Judge



**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY**

**CURVER LUXEMBOURG, SARL,**

**Plaintiff,**

**vs.**

**HOME EXPRESSIONS INC.,**

**Defendant.**

Civ. No. 2:17-cv-4079-KM-JBC

**OPINION**

**KEVIN MCNULTY, U.S.D.J.:**

Plaintiff Curver Luxembourg, SARL (“Curver”) is the owner of a design patent, No. D677,946 (“the ’946 Patent”), which claims an overlapping “Y” design. Curver alleges that Home Expressions Inc. (“Home Expressions”) makes and sells a basket that incorporates this design and therefore infringes the ’946 Patent. In an opinion filed on January 8, 2018, I stated my reasons for granting defendant Home Expressions’ motion to dismiss the Complaint. (“Op.” ECF no. 17). Now before the Court is Curver’s motion (ECF no. 19) for reconsideration of that decision. For the reasons stated herein, the motion is denied.

The standards governing a motion for reconsideration are well settled. See generally D.N.J. Loc. Civ. R. 7.1(i). Reconsideration is an “extraordinary remedy,” to be granted “sparingly.” *NL Indus. Inc. v. Commercial Union Ins. Co.*, 935 F. Supp. 513, 516 (D.N.J. 1996). Generally, reconsideration is granted in three scenarios: (1) when there has been an intervening change in the law; (2) when new evidence has become available; or (3) when necessary to correct a clear error of law or to prevent manifest injustice. See *North River Ins. Co. v. CIGNA Reinsurance Co.*, 52 F.3d 1194, 1218 (3d Cir. 1995); *Carmichael v. Everson*, 2004 WL 1587894, at \*1 (D.N.J. May 21, 2004). Local Rule 7.1(i) requires such a motion to specifically identify “the matter or controlling decisions which the party believes the Judge or Magistrate Judge has overlooked.” *Id.*; see also *Egloff v.*

*New Jersey Air Nat'l Guard*, 684 F. Supp. 1275, 1279 (D.N.J. 1988). Evidence or arguments that were available at the time of the original decision will not support a motion for reconsideration. *Damiano v. Sony Music Entm't, Inc.*, 975 F. Supp. 623, 636 (D.N.J. 1997); *see also North River Ins. Co.*, 52 F.3d at 1218; *Bapu Corp. v. Choice Hotels Int'l, Inc.*, 2010 WL 5418972, at \*4 (D.N.J. Dec. 23, 2010) (citing *P. Schoenfeld Asset Mgmt. LLC v. Cendant Corp.*, 161 F. Supp. 2d 349, 352 (D.N.J. 2001)).

Curver argues that I should reconsider my decision because “neither party briefed the issue of prosecution history estoppel, which has resulted in a manifest error of law.” True, I discussed whether Curver had surrendered part of the scope of its claim (or failed to claim at all) with regard to items other than chairs. I concluded that Curver had purposely narrowed the scope of its claims in order to induce the examiner to allow the patent. That holding I still believe to be correct, and it is also but one of two alternative holdings. Having reached that conclusion, I conceded the issue *arguendo* and construed the patent itself: “Nevertheless, to remove doubt, I will for purposes of argument concede the issue of prosecution history estoppel and construe the scope of the patent directly.” (Op. 14)

In the alternative, I concluded that this design patent did not, as a matter of claim construction, extend to other articles of manufacture. (Op. 14–15 (citing *P.S. Products, Inc. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795, 801-03 (E.D. Ark. 2014); *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 679-80 (E.D. Mich. 2003); *Vigil v. Walt Disney Co.*, C-97-4147, 1998 U.S. Dist. LEXIS 22853, at \*9-10 (N.D. Cal. Dec. 1, 1998).) So even assuming that Curver intended to claim coverage of other articles of manufacture, “what Curver got, as opposed to what it asked for, was a patent that protects against infringement for a particular “Y” design on chairs only.” (Op. 15)

Curver, as before, argues that a design patent, as a matter of law, should be deemed to extend to other items of manufacture. This is not a new argument. Curver merely asks the court “to rethink what it had already

thought through—rightly or wrongly.” *Oritani Savings & Loan Ass’n v. Fidelity & Deposit Co.*, 744 F. Supp. 1311, 1314 (D.N.J. 1990).

Curver has one new argument. It now cites case which, in its view, hold that a design on one article of manufacture anticipated a design on another. Because anticipation and infringement are equivalent, it says, those cases imply that design patents apply to all articles of manufacture, and this court’s construction of this patent must therefore have been incorrect. A reconsideration motion is not the place for such new arguments, which I will not consider.<sup>1</sup>

### CONCLUSION

For the foregoing reasons, I deny Curver’s motion for reconsideration. (ECF no. 19) An appropriate order accompanies this opinion.

Dated: July 6, 2018

  
**KEVIN MCNULTY**  
United States District Judge

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<sup>1</sup> The argument is weak in any event; Curver reads too much into the cases when it finds an implied holding that design patents extend to all items of manufacture.

Curver cites *Application of Glavas*, 230 F.2d 447 (C.C.P.A. 1956), which involved an obviousness challenge to a design patent for an inflatable swimmer’s float. A design, the court said, might be suggested by prior art that disclosed an article of substantially the same appearance, but the court did not open the door to the kind of universal coverage suggested here. *Glavas* stated, for example, that while a prior patented design on a pillow might naturally render the float’s design obvious, the same did *not* hold true for prior designs on a bottle, a razor blade sharpener, or a bar of soap, because those designs did not suggest application of the design to a float.

Curver also cites *Int’l Seaway Trading Corp. v. Walgreens Corp.*, 589 F. 3d 1233 (Fed. Cir. 2009). There, the Court abandoned the “point of novelty” test and confirmed that the “ordinary observer” test is appropriate for a claim of anticipation, just as it is for a claim of obviousness. The case itself, however, involved comparisons of insole designs for footwear. It does not suggest that a court must construe a patented design to cover all articles of manufacture. At any rate, I did apply the “ordinary observer” test to the uncontested documents and depictions of the design. Curver’s indirect argument from *Int’l Seaway* does not suggest that there was a manifest injustice or clear error of law here.



US00D677946S

(12) **United States Design Patent** (10) **Patent No.:** **US D677,946 S**  
**Duvigneau** (45) **Date of Patent:** **\*\* Mar. 19, 2013**

(54) **PATTERN FOR A CHAIR**(75) Inventor: **Nikolai Duvigneau, Zichron Yaacov (IL)**(73) Assignee: **Curver Luxembourg SARL,**  
**Neidercom (LU)**(\*\*) Term: **14 Years**(21) Appl. No.: **29/389,254**(22) Filed: **Apr. 8, 2011**(30) **Foreign Application Priority Data**

Oct. 18, 2010 (IL) ..... 50171

(51) **LOC (9) Cl.** ..... **06-01**(52) **U.S. Cl.** ..... **D6/500**(58) **Field of Classification Search** ..... D6/500-502,  
D6/587, 595-598, 613, 616-619, 603-606;  
D5/47-54, 1-3, 23, 29, 11-12, 19, 56; 428/17-18,  
428/151, 154, 156, 171, 187, 198-199, 542.2,  
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See application file for complete search history.

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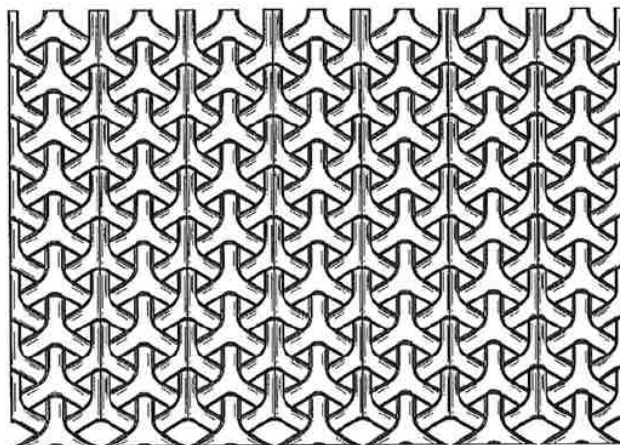
(Continued)

*Primary Examiner* — Kelley Donnelly(74) *Attorney, Agent, or Firm* — Nath, Goldberg & Meyer;  
Jerald L. Meyer(57) **CLAIM**

The ornamental design for a pattern for a chair, as shown and described.

**DESCRIPTION**

FIG. 1 is a front view of a design for a pattern for a chair;  
 FIG. 2 is a top view of a design for a pattern for a chair;  
 FIG. 3 is a bottom view of a design for a pattern for a chair;  
 FIG. 4 is a perspective view of a design for a pattern for a chair; and,  
 FIG. 5 is an enlarged view from the perspective view a rattan design for a pattern for a chair.

**1 Claim, 5 Drawing Sheets**

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Enclosure C Invoice n. 1728i dated on Dec. 4, 2007 issued by Ipaepro-garden S.p.A. to Plasticos Santi S.L. related to chairs named Capri shown on catalogue of enclosure B; 1 page total.

Enclosure D Invoice n. 2032 dated on May 16, 2007 issued by Ipaepro-garden S.p.A. to Castorama Savignano related to chairs named Capri shown on catalogue of enclosure B; 2 pages total.

Enclosure E Front page and p. 3 of Ipaepro-garden catalogue dated 1997; 2 pages total.

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Enclosure H Photographs showing a section of detail of the chair seats of Enclosure A; 2004; 1 page total.

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Enclosure L Photographs showing a section detail of the chairs named Camelia; 1997; 1 pages total.

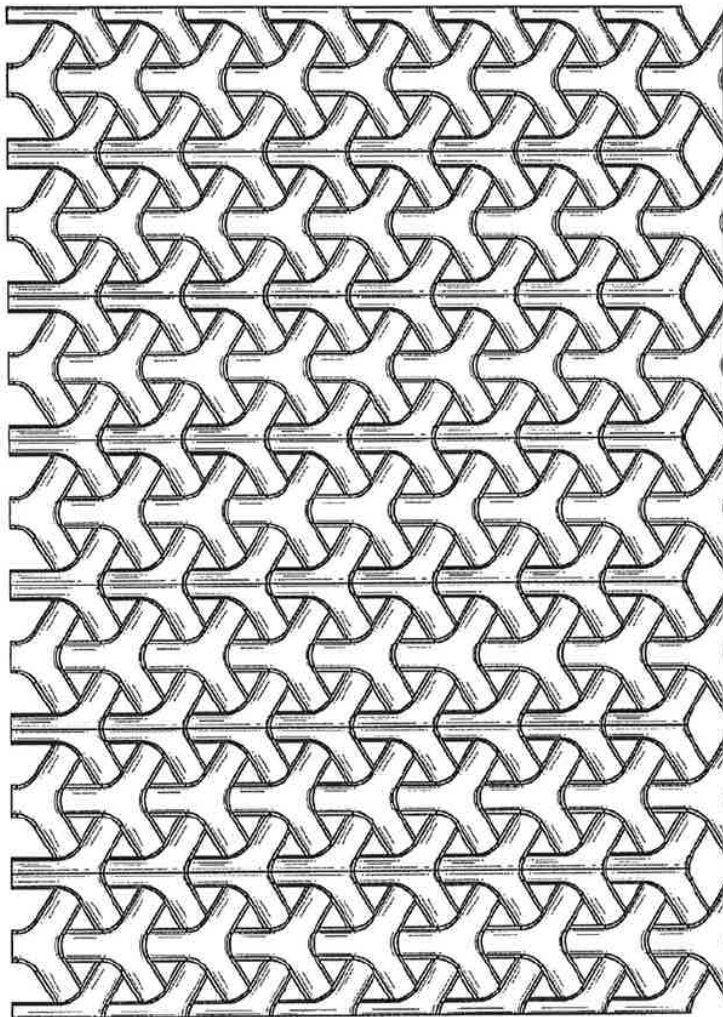
\* cited by examiner

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**FIG. 1**

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**FIG. 2**

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**FIG. 3**

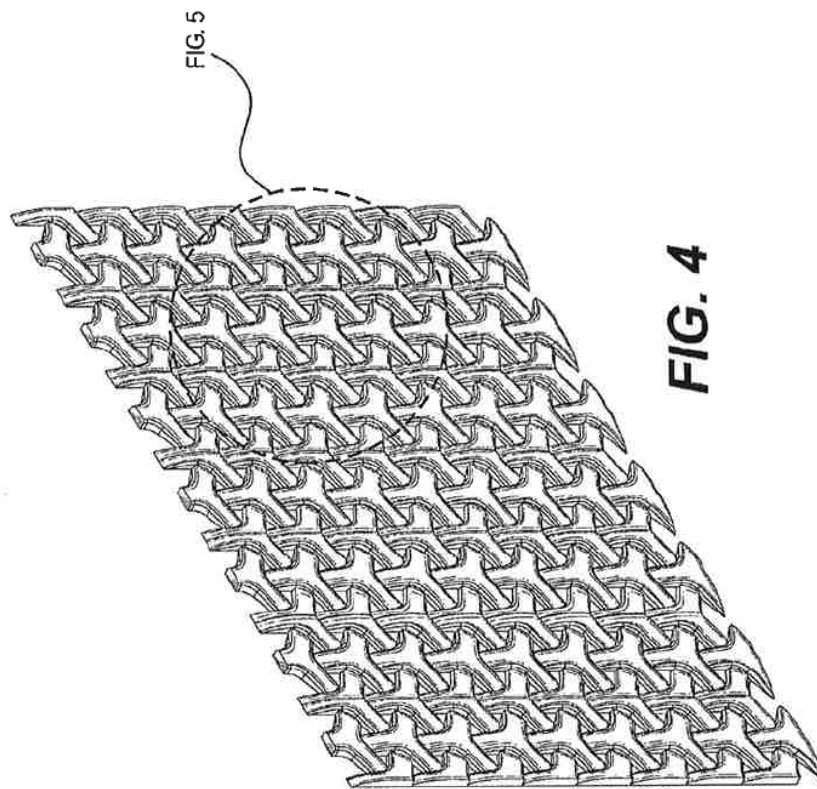


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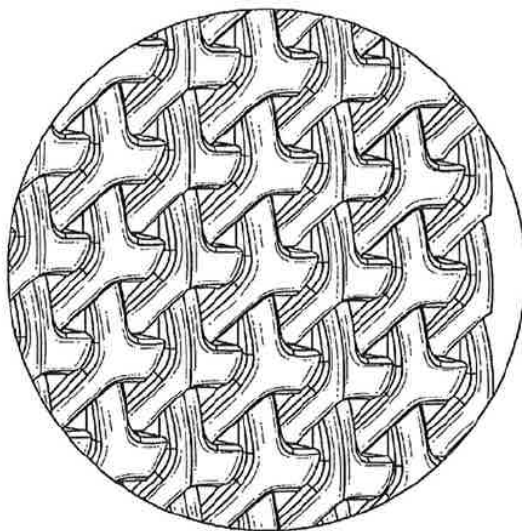
**FIG. 4**

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***FIG. 5***

**CERTIFICATE OF SERVICE**

On October 2, 2018, I caused the foregoing Brief of Appellant to be electronically filed with the Clerk of the Federal Circuit using the CM/ECF System, which will serve e-mail notice of such filing on the following attorneys:

Mr. Steven M. Auvil, Esq.  
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Mr. Jeremy W. Dutra, Esq.  
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Washington, DC 20037

Upon acceptance by the Court of the e-filed document, I will cause six paper copies of the brief to be filed with the Court, via Federal Express, within the time provided in the Court's rules.

/s/ Jason H. Kislin  
Jason H. Kislin

**CERTIFICATE OF COMPLIANCE**

This brief complies with the type-volume limitations of Federal Rule of Appellate Procedure 32(a)(7)(B) or Federal Rule of Appellate Procedure 28.1(e). This brief contains 4,824 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Fed. Cir. R. 32(b). This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in fourteen (14) point Times New Roman font.

Dated: October 2, 2018

/s/ Jason H. Kislin  
Attorney for Appellant  
Curver Luxembourg, Sarl