

2018-2214

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CURVER LUXEMBOURG, SARL,
Plaintiff-Appellant

v.

HOME EXPRESSIONS INC.,
Defendant-Appellee

Appeal from the United States District Court for the District of New Jersey
Case No. 2:17-cv-4079
Judge Kevin McNulty

BRIEF OF DEFENDANT-APPELLEE HOME EXPRESSIONS INC.

STEVEN M. AUVIL
steven.auvil@squirepb.com
JEREMY WILLIAM DUTRA
jeremy.dutra@squirepb.com
SQUIRE PATTON BOGGS (US) LLP
2550 M Street, NW
Washington, DC 20037
(202) 626-6600

*Attorneys for Defendant-Appellee
Home Expressions Inc.*

November 13, 2018

CERTIFICATE OF INTEREST

Counsel for Appellee Home Expressions Inc. certifies the following:

1. The full name of every party or amicus represented by me in this appeal:

Home Expressions Inc.

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

Home Expressions Inc.

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

None

4. The names of all law firms and the partners and 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 (and who have not or will not enter an appearance in this case) are:

Sean Neafsy with Squire Patton Boggs (US) LLP

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

None

Dated: November 13, 2018

/s/ Jeremy William Dutra

Jeremy William Dutra

SQUIRE PATTON BOGGS (US) LLP

2550 M Street, NW
Washington, D.C. 20037
(202) 626-6600
jeremy.dutra@squirepb.com

*Counsel for Defendant-Appellee
Home Expressions Inc.*

TABLE OF CONTENTS

CERTIFICATE OF INTEREST	ii
TABLE OF CONTENTS.....	iv
STATEMENT OF RELATED CASES	1
SUMMARY OF THE ARGUMENT	1
ARGUMENT	2
I. The district court correctly construed the claim of the ‘946 patent as “limited to an ornamental ‘Y’ pattern, as shown in the patent’s figures, as used in chairs.”	2
II. The district court correctly applied the ordinary observer standard to find that Curver failed to state a plausible claim of infringement against Home Expressions.....	7
III. Prosecution history estoppel was not necessary for the district court’s judgment and is immaterial to the determination of this appeal.....	11
CONCLUSION.....	14
CERTIFICATE OF SERVICE	15
CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS	16

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Elmer v. ICC Fabricating, Inc.</i> , 67 F.3d 1571 (Fed. Cir. 1995)	3, 4, 8, 11
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.</i> , 535 U.S. 722 (2002).....	13
<i>In re Glavas</i> , 230 F.2d 447 (C.C.P.A. 1956)	8, 9
<i>Kellman v. Coca-Cola Co.</i> , 280 F. Supp. 2d 670 (E.D. Mich. 2003)	9, 10
<i>Markman v. Westview Instruments</i> , 517 U.S. 370 (1996).....	4, 5, 7, 13
<i>Mass. Inst. of Tech. v. Abacus Software</i> , 462 F.3d 1344 (Fed. Cir. 2006)	12
<i>OddzOn Prods. v. Just Toys</i> , 122 F.3d 1396 (Fed. Cir. 1997)	11
<i>P.S. Prods. v. Activision Blizzard, Inc.</i> , 140 F. Supp. 3d 795 (E.D. Ark. 2014).....	10
<i>Pac. Coast Marine Windshields, Ltd. v. Malibu Boats, LLC</i> , 739 F.3d 694 (Fed. Cir. 2014)	3, 4, 12, 13
<i>SanDisk Corp. v. Kingston Tech. Co., Inc.</i> , 695 F.3d 1348 (Fed. Cir. 2012)	12
<i>Star Athletica, L.L.C. v. Varsity Brands, Inc.</i> , 137 S. Ct. 1002 (2017).....	6
<i>Vigil v. Walt Disney Co.</i> , No. 97-4147, 1998 U.S. Dist. LEXIS 22853 (N.D. Cal. Dec. 1, 1998), <i>aff'd</i> , 2000 U.S. App. LEXIS 6231 (Fed. Cir. Apr. 5, 2000).....	9, 10

Statutes

17 U.S.C. § 1016
17 U.S.C. § 113(a)6
35 U.S.C. § 112(b)5
35 U.S.C. § 1715, 6

Other Authorities

37 C.F.R. § 1.713
37 C.F.R. § 1.1523
37 C.F.R. § 1.153(a).....5
MPEP (9th ed. Rev. 07.2015, Nov. 2015), § 15025
MPEP, § 1504.016

STATEMENT OF RELATED CASES

There has been no prior appeal in this case and there are no related cases pending in this Court or in any other courts that will directly affect or be directly affected by this Court's decision.

SUMMARY OF THE ARGUMENT

The claim of '946 patent recites: "The ornamental design for a pattern for a chair, as shown and described" in the patent. From the inception of this case, and continuing on through this appeal, Curver has sought to expand its rights by reading "for a chair" out of the claim and asserting ownership of the ornamental design as applied to or embodied in any article of manufacture.

Curver's audacious claim of ownership of a design divorced from the article of manufacture in which it is embodied is inconsistent with this Court's decisions and irreconcilable with patent law. The Patent Act, patent regulations, and Patent Office guidance and practice each recognize that a design patent must be tethered to the article of manufacture recited in the claim. Without this tether, an ornamental design depicted in the drawings is nothing more than an abstract design directed to nonstatutory subject matter. Considering both the text and incorporated drawings, the district court correctly construed the '946 patent claim as "limited to an ornamental 'Y' pattern, as shown in the patent's figures, as used in chairs."

The district court continued its infringement analysis by comparing the

construed claim to the accused product. Consistent with this Court’s guidance, the district court applied the ordinary observer standard to the patented design in its entirety, as claimed. The district court employed the appropriate analytical framework to determine that Curver cannot state a plausible claim for infringement because no ordinary observer would ever be deceived into buying Home Expressions’ storage basket believing it to be the ornamental design for a pattern for a chair claimed in the ‘946 patent.

While the district court thought it would be reasonable to conclude that prosecution history estoppel bars Curver’s infringement claim, it did not base dismissal on this conclusion. Because prosecution history estoppel does not affect the final judgment, this Court should decline to consider the issue.

Even so, Curver’s argument fails on the merits. Curver surrendered subject matter by amending its claim from “design for a rattan design for furniture part” to “design for a pattern for a chair.” And Curver made the narrowing amendment to satisfy certain statutory and regulatory requirements, thereby giving rise to estoppel.

ARGUMENT

I. The district court correctly construed the claim of the ‘946 patent as “limited to an ornamental ‘Y’ pattern, as shown in the patent’s figures, as used in chairs.”

“Determining whether a design patent claim has been infringed requires, first, as with utility patents, that the claim be properly construed to determine its meaning

and scope.” *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). In construing the claim, the district recognized that both the drawings and “language used in a design patent” are relevant to determining the scope of a design patent claim. (Appx010; Appx012; Appx016-17.)

The district court correctly considered the claim text in determining the scope of the claimed design. Curver’s criticism of that conclusion is unfounded, and its reliance on *Pacific Coast Marine* is misplaced and is based on a misreading of the case. (Br. at 11.) This Court’s observation that “the drawings of the design patent . . . provide the description of the invention” merely highlights the distinction between how a patentee discloses the “description of the invention” in a utility patent and design patent. *Pac. Coast Marine Windshields, Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014). While a utility patent “must include a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the [invention],” a design patent “must be represented by a drawing . . . and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design.” *Compare* 37 C.F.R. § 1.71 *with* 37 C.F.R. § 1.152.

Acknowledging that courts “must look at the requisite drawings in design patents to determine whether a surrender has occurred,” is not an instruction to ignore the text of a design patent claim. To the contrary, this Court specifically

considered the claim text in *Pacific Coast Marine* to determine whether the patentee surrendered subject matter during prosecution of the design patent: “By removing broad claim language referring to alternate configurations and cancelling the individual figures showing the unelected embodiments, the applicant narrowed the scope of his original application, and surrendered subject matter.” *Pac. Coast Marine*, 739 F.3d at 703 (Fed. Cir. 2014) (emphasis added).

Nor has this Court eschewed reference to the claim text when construing a design patent to determine infringement. In *Elmer*, for example, the asserted patent claimed the “‘ornamental design for a vehicle top sign holder, as shown and described’ in the patent.” *Elmer*, 67 F.3d at 1577. Relying on both the text and figures, this Court construed the claim as “limited to a vehicle sign having, inter alia, triangular vertical ribs and an upper protrusion.” *Id.*

Curver asks this Court to ignore what the claim says and, instead, focus solely on the drawings when construing a design patent. But the law holds that the “claim define[s] the scope of a patent grant.” *Markman v. Westview Instruments*, 517 U.S. 370, 373 (1996) (internal quotations omitted).

Here, the patentee claims “an ornamental design for a pattern for a chair as shown and described.” (Appx022 (emphasis added).) The design patent grant is not to an ornamental design applied to any article; rather, it is tethered to the particular article of manufacture identified in the claim (and described in the specification).

(*Id.*) The patent statute, pertinent regulations, and PTO guidance and practice dictate that result.

First, Section 171 limits design patent eligibility to certain “design[s] for an article of manufacture.” 35 U.S.C. § 171(a); *see also* 35 U.S.C. § 112(b) (requiring that a claim for an ornamental design “particularly point[] out and distinctly claim[] the subject matter which the inventor . . . regards as the invention”). The statutory framework envisages that a patented design is intertwined with the article of manufacture to which it is applied or in which it is embodied.

Second, Patent Rule 1.153 mandates that the claim for a design patent “be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” 37 C.F.R. § 1.153(a). In other words, the PTO rules also reflect an understanding of the law that designs are tied to particular articles of manufacture.

Third, the Manual of Patent Examining Procedures reflects that a design patent is unavailable for an ornamental design untethered to a particular article manufacture. “Design is inseparable from the article to which it is applied, and cannot exist alone merely as a scheme of ornamentation.” MPEP (9th ed. Rev. 07.2015, Nov. 2015), § 1502. To enforce this principle, cemented in law, the MPEP specifically advises patent examiners to reject claims “as directed to nonstatutory subject matter” if the “picture, print, impression, etc. *per se*, . . . is not applied to or

embodied in an article of manufacture.” MPEP, § 1504.01. Section 171 therefore requires that the design “be shown as applied to or embodied in an article of manufacture,” because “[a] picture standing alone is not patentable.” *Id.* “The factor which distinguishes statutory design subject matter from mere picture or ornamentation, *per se* (i.e., abstract design), is the embodiment of the design in an article of manufacture.” *Id.*

What Curver seeks to enforce—an ornamental design applied to or embodied into any article of manufacture (*i.e.*, an abstract design)—invades the province of copyright protection. Congress authorized design patents to protect certain “design[s] for an article of manufacture.” 35 U.S.C. § 171. Copyright, by contrast, protects “pictorial, graphic, or sculptural feature[s]” that are separable from a useful article. *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017); 17 U.S.C. § 101 (defining “pictorial, graphic, and sculptural works”). Curver cannot use the ‘946 patent as a springboard for copyright-like protections. If Curver wanted the exclusive right to reproduce the design reflected in the ‘946 patent drawings “in or on any kind of article,” it could have sought copyright protection. 17 U.S.C. § 113(a). Having sought and obtained a design patent, however, Curver’s property right extends no further than the disclosed ornamental “Y” design used in chairs.

The ‘946 patent claims an ornamental design for a pattern for a chair as shown in the figures and described in the specification. (Appx022.) In construing the claim,

the district court did not fail “to examine, or even reference, the patent figures.” (Br. at 11.) The district court instead recognized that the entire claim—not just the referenced figures—defines the metes and bounds of the patent grant. *Markman*, 517 U.S. at 373. Applying this bedrock principle, the district court correctly construed the claim as “limited to an ornamental ‘Y’ pattern, as shown in the patent’s figures, as used in chairs.” (Appx017.)

II. The district court correctly applied the ordinary observer standard to find that Curver failed to state a plausible claim of infringement against Home Expressions.

Curver criticizes the district court’s application of the ordinary observer standard because “it focused its analysis on the articles that embodied the designs, rather than the designs themselves.” (Br. at 16 (emphasis removed).) Curver is mistaken.

While the district court observed that “a basket is not a chair, and could not be mistaken for one” (Appx018), the district court did not “frame[] the analysis as comparing a chair to a basket.” (Br. at 16.) The district court conducted a textbook infringement analysis by comparing the properly construed claim to the allegedly infringing product: “In this case, the ‘946 Patent, which protects an ornamental ‘Y’ design for a chair, is compared to Home Expressions’ basket.” (Appx017-18.) This analytical approach faithfully adheres to this Court’s instruction that the “claim as properly construed must be compared to the accused design to determine whether

there has been infringement.” *Elmer*, 67 F.3d at 1577.

Curver acknowledges that “[u]nder 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.” (Br. at 13 (internal quotations omitted).) Again, this is precisely the analysis the district court performed. Comparing the properly construed patent claim to the accused storage basket, the district court determined 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.” (Appx018.)

In a repackaged claim scope argument, Curver contends that the article of manufacture recited in the claim is irrelevant to the infringement analysis because: (1) the same test is used for infringement and anticipation, and (2) the Court of Customs and Patent Appeals determined in *Glavas* that “a prior art design can be anticipatory regardless of the article of manufacture in which it is embodied.” (Br. at 14.) Reliance on *Glavas* is misplaced. First, the *Glavas* court did not apply the ordinary observer test. Second, *Glavas* did not even involve an anticipation rejection. The case instead involved the PTO’s rejection of a design patent application on obviousness grounds. The PTO concluded that the claimed design for a float was obvious in light of a design patent for a float (or life preserver) as

modified by either a design patent for a pillow or any one of design patents for bottles, a razor blade sharpener, and a bar of soap. *In re Glavas*, 230 F.2d 447, 448-49 (C.C.P.A. 1956). The Court of Customs and Patent Appeals reversed because:

It is evident that a worker seeking ideas for improving the appearance of a device would look first to the similar devices of the prior art for ideas. If his problem were one of designing a float for swimmers, he would not be likely to turn to bottles, soap or razor blade sharpeners for suggestions, as was done by the board here[.]

Id. at 451.

While the court found it “plausible” that patents for pillows were analogous art to floats because “pillows are sometimes adapted to serve as floats,” the court still reversed the rejection because of an absence of “anything in either of the former [pillow] patents which would suggest modifying” the primary reference for a float “in such a manner as to produce” the claimed design. *Id.*

Glavas does not support the argument that Curver advances: that the scope of a design patent is unconstrained by the article of manufacture recited in the claim. Indeed, the Court in *Glavas* reversed an invalidity rejection based on the use of prior design patents for different—or non-analogous—articles of manufacture.

More broadly, Curver fails to identify any case law in which a patent claiming an ornamental design for a particular article of manufacture was found to be infringed by use of the design on a different article of manufacture. This is not unexpected. The only cases to address this issue—*Vigil*, *Kellman*, and *P.S.*

Products, which the district court discusses (Appx014-15; Appx016-17)—dismissed such infringement claims as a matter of law.

Curver still urges this Court to disregard the *Vigil*, *Kellman*, and *P.S. Products* decisions “because they fail to adhere to the proper infringement analysis espoused by this Court.” (Br. at 17.) Curver’s criticism is unfounded. Each court applied the ordinary observer test and determined that although the designs were similar, the accused products did not infringe as a matter of law because the accused articles were different than the article of manufacture identified in the claim of the asserted design patent. *P.S. Prods. v. Activision Blizzard, Inc.*, 140 F. Supp. 3d 795, 802-03 (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.*, No. 97-4147, 1998 U.S. Dist. LEXIS 22853, at *9 (N.D. Cal. Dec. 1, 1998), *aff’d*, 2000 U.S. App. LEXIS 6231, at *1 (Fed. Cir. Apr. 5, 2000) (affirming the judgment of dismissal and agreeing “that the district court did not exceed its discretion in dismissing the action on the merits”). These decisions are consonant with Federal Circuit law on determining infringement of a design patent.

By contrast, Curver’s argument that the infringement analysis can be reduced to a simple comparison of the patent drawings to the accused product without regard to the claim text (Br. at 16-18) is contrary to Federal Circuit law. The infringement inquiry requires more than “a simple comparison of the accused products with the

figures in the design patent.” *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1404 (Fed. Cir. 1997). Determining whether an accused product infringes a design patent requires “the claim as properly construed” to “be compared to the accused design to determine whether there has been infringement.” *Elmer*, 67 F.3d at 1577. The district court conducted this analysis, employing the ordinary observer test to conclude that Curver failed to state a plausible claim for infringement. The Court should affirm that conclusion.

III. Prosecution history estoppel was not necessary for the district court’s judgment and is immaterial to the determination of this appeal.

The district court did not dismiss Curver’s infringement claim because of prosecution history estoppel. While observing that “[i]t would be reasonable to conclude that prosecution history estoppel bars Plaintiff’s claim that the scope of the patent extends to anything but a chair,” the district court explained that to “remove doubt,” it would “for purposes of argument concede the issue of prosecution history estoppel and construe the scope of the patent directly.” (Appx016.) In short, the district court dismissed the action after construing the claim, applying the ordinary observer test, and concluding that Curver asserted no plausible claim of infringement. (Appx016-18.)

This Court previously admonished that an appeal “is not an opportunity to bring before the appellate court every ruling with which one of the parties disagrees without regard to whether the ruling has in any way impacted the final judgment.”

Mass. Inst. of Tech. v. Abacus Software, 462 F.3d 1344, 1350 (Fed. Cir. 2006); *see also SanDisk Corp. v. Kingston Tech. Co., Inc.*, 695 F.3d 1348, 1353 (Fed. Cir. 2012) (declining to consider certain claim construction issues because where “a party’s claim construction arguments do not affect the final judgment entered by the court, they are not reviewable”). Prosecution history estoppel does not constitute “reversible error” because the district court did not apply prosecution history estoppel to dismiss Curver’s infringement claim.

Even so, Curver’s argument fails on the merits. Curver surrendered claim scope when it amended its claim from “design for a rattan design for furniture part” to “design for a pattern for a chair.” (Appx067.) Relying on *Pacific Coast Marine*, Curver suggests that prosecution history estoppel occurs with design patents only when there are “substantive changes to the figures.” (Br. at 19-20.) But Curver mischaracterizes *Pacific Coast Marine*. In that case, this Court held that an amendment to the claim text during prosecution contributed to the surrender of subject matter: “By removing broad claim language referring to alternate configurations and cancelling the individual figures showing the unelected embodiments, the applicant narrowed the scope of his original application, and surrendered subject matter.” *Pac. Coast Marine*, 739 F.3d at 703.

Curver’s argument that there was no surrender of claim scope for reasons of patentability defies logic. (Br. at 20.) The examiner objected to the specification,

conditioning allowance on the applicant amending the title and claim of the patent application to comply with the statutory and regulatory requirements that the title and claim be directed to a particular article of manufacture. (Appx060-61.) Allowance of the patent occurred only after the applicant amended the application to address the objections. (Appx022.)

Curver also understates the breadth of prosecution history estoppel in design patent cases. Prosecution history estoppel for design patents is broader than surrenders to avoid prior art, and may occur when “a narrowing amendment [is] made to satisfy any requirement of the Patent Act.” *Pac. Coast Marine*, 739 F.3d at 703-04. The amendment here, which narrowed the claim scope from “furniture part” to “pattern for a chair,” was made to satisfy certain requirements of the Patent Act—precisely the circumstances that this Court held can give rise to estoppel. *Id.*

Although prosecution history estoppel is not the basis for the district court’s judgment, the district court’s analysis was correct. Curver surrendered subject matter by amending its claim during prosecution, and did so to secure the patent. The public is entitled to rely on this surrender to understand where Curver’s patent monopoly ends. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) (“A patent holder should know what he owns, and the public should know what he does not”); *Markman*, 517 U.S. at 373 (a patent must be precise enough to afford clear notice of what is claimed, thereby “appris[ing] the public of

what is still open to them”). And, as a result, Curver is estopped from claiming infringement against Home Expressions’ storage basket.

CONCLUSION

The ‘946 patent claims “an ornamental design for a pattern for a chair as shown and described.” Curver cannot state a plausible claim for infringement because no ordinary observer would ever be deceived into purchasing Home Expressions’ storage basket believing it to be the ornamental design for a pattern for a chair, as claimed in the ‘946 patent. Because Curver’s claim fails as a matter of law, the district court correctly granted Home Expressions’ motion to dismiss. This Court should affirm the district court’s judgment.

Respectfully submitted,

/s/ Jeremy William Dutra _____

Steven M. Auvil

steven.auvil@squirepb.com

Jeremy William Dutra

jeremy.dutra@squirepb.com

SQUIRE PATTON BOGGS (US) LLP

2550 M Street, NW

Washington, D.C. 20037

(202) 626-6600

Counsel for Defendant-Appellee

Home Expressions Inc.

CERTIFICATE OF SERVICE

I hereby certify that on November 13, 2018, I electronically filed the BRIEF OF DEFENDANT-APPELLEE HOME EXPRESSIONS INC. with the Court through the CM/ECF system, which will send a notice of filing to all registered CM/ECF users. All parties to this appeal are represented by counsel who are registered CM/ECF users.

/s/ Jeremy William Dutra _____

Jeremy William Dutra
SQUIRE PATTON BOGGS (US) LLP
2550 M Street, NW
Washington, D.C. 20037
(202) 626-6600
jeremy.dutra@squirepb.com

*Counsel for Defendant-Appellee
Home Expressions Inc.*

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE
STYLE REQUIREMENTS**

1. This brief complies with the type-volume limitation of Federal Circuit Rule 32(a). This brief contains 3,263 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

2. 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 2016 and 14 point Times New Roman.

Dated: November 13, 2018

/s/ Jeremy William Dutra _____
Jeremy William Dutra
SQUIRE PATTON BOGGS (US) LLP
2550 M Street, NW
Washington, D.C. 20037
(202) 626-6600
jeremy.dutra@squirepb.com

*Counsel for Defendant-Appellee
Home Expressions Inc.*