

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 District Court of New Jersey, Case No. 2:17-cv-4079

REPLY BRIEF OF PLAINTIFF-APPELLANT

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I. REPLY ARGUMENT

A. Introduction

In granting Home Expressions’ motion to dismiss, the District Court made its position clear: “The scope of a design patent is limited to the ‘article of manufacture’—i.e., the product—listed in the patent. Thus the [‘946] patent protects only a pattern for a chair. It does not protect that same pattern on a basket” (Appx016). It is clear throughout the District Court’s decision that this conclusion was based on the use of the word “chair” in the ‘946 Patent’s title.

This is a case of first impression, because we are unaware of any decision of the Supreme Court or this Court in which the scope of a design patent claim has been limited by the patent’s title. Under the Manual for Patent Examining Procedure (“M.P.E.P.”)—which sets out the procedures Patent Office Examiners follow in examining utility and design applications—a design patent’s title “does not define the scope of the claim”. *See* Manual of Patent Examining Procedure, § 1503.01 (9th ed. 2014) (hereinafter, “M.P.E.P.”). Rather, the title helps examiners develop a complete field of search of the prior art; ensures that applications are assigned to the appropriate class, subclass, and examiner; and ensures proper classification of the patent upon allowance. *Id.*

Since the 1800s, it has been black letter law that the scope of a design patent claim is determined by what is illustrated in the patent drawings. In short, a design

patent's drawings *are* the claimed invention. Here, the '946 Patent drawings do not illustrate a "chair". Rather, the drawings show a three-dimensional panel structure that includes an ornamental Y pattern. The typical functional elements of a chair—*i.e.*, the arms, legs, seat, and back—are not shown in the drawings. Although Patent Law requires that the claimed ornamental design be embodied in an "article of manufacture", such an article need not be a complete product. Under Supreme Court precedent, the panel structure illustrated in the '946 Patent is, of itself, an "article of manufacture". That panel structure was incorporated with other structures to form Home Expressions' accused baskets. Since the scope of a design patent is not limited by its title, the incorporation of the patented design into Home Expressions' product constitutes an infringement of the '946 Patent.

Further, it is black letter law that the same "ordinary observer" test for determining infringement of a design patent is used by the Courts and the Patent Office to determine whether the claimed design is invalid for anticipation. In applying the ordinary observer test to the question of anticipation, this Court's predecessor Court of Customs and Patent Appeals has held that a prior art design can anticipate a claimed design, regardless of the type of article in which the prior design is embodied. *See In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956).

Long ago, the Supreme Court held: "[t]hat which infringes, if later, would anticipate, if earlier". *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889).

Applying this time-honored maxim to design patents in view of *In re Glavas*, the infringement analysis should be conducted in the same way as for anticipation, *i.e.*: if an accused article contains the patented design, that article infringes the patent, regardless of the use to which the article is put. This is an additional reason why Home Expressions' accused basket infringes the '946 Patent, and why the District Court grant of Home Expressions' motion to dismiss should be vacated.

In re Glavas is followed by Patent Office Examiners to this day. If the '946 Patent is limited by the title to the claimed design embodied in a chair (even though a chair is not shown in the drawings), then the Patent Office's decades-old procedure for examining design patents for anticipation by the prior art would be eviscerated. This would create an irreconcilable inconsistency in the Patent Law regarding the type of articles of manufacture that can be considered in determining validity and infringement. Moreover, the value of patents issued under an *In re Glavas* examination procedure would be unfairly de-valued—to the detriment of patent owners—because the pool of products embodying the claimed design potentially subject to infringement liability would be significantly reduced.

We respond to the arguments made in Home Expressions' Responsive Brief below, and will discuss the above legal principles in more detail. As we will show, based on the relevant statutes, case law, regulations, and M.P.E.P provisions, the

District Court’s decision should be vacated, and Curver’s amended complaint against Home Expressions for infringement of the ‘946 Patent should be reinstated.

B. The District Court’s Decision Is Contrary To The Patent Statute

35 U.S.C. § 171 states: “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”. The plain language of § 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).

Nothing in the wording of § 171 limits the scope of a design patent to the particular article of manufacture “listed” in the patent’s title. This is especially true, where, as here, the features of that article are not illustrated in the drawings as being part of the claimed design. Consistent with the statutory scheme, M.P.E.P. § 1503.01 states that a design patent’s title “does not define the scope of the claim”.

Home Expressions cites to 35 U.S.C. § 112 (b) for the proposition that a claim for an ornamental design is required to “particularly point[] out and distinctly claim[] the subject matter which the inventor . . . regards as the invention” (Responsive Brief at 5). The ‘946 Patent drawings satisfy this requirement. *See In re Daniels*, 144 F.3d 1452, 1456 (Fed. Cir. 1998) (“It is the drawings of the design patent that provide the description of the invention.”).

Section 289 of the Patent Statute, addressing remedies for design patent infringement, also supports Curver's position. Section 289 states, in pertinent part:

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).

Thus, § 289 provides a remedy for infringement where the patented design is applied to “any article of manufacture”, not just the article listed in the patent's title. While the District Court conceded the breadth of § 289 as it relates to potentially-infringing articles, it improperly disregarded the statute based on the incorrect perception that § 171 contains more limiting language (Appx013-015).

C. The District Court's Final Judgment Should Be Vacated Under The Supreme Court's Definition Of “Article Of Manufacture”

Home Expressions argues based on M.P.E.P. § 1504.01 that “[a] picture standing alone is not patentable”, and that the design must be embodied in an “article of manufacture” (Responsive Brief at 6). This argument is without merit, because Curver has never contended that it patented “a picture standing alone”.

The parties do not dispute that, 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; *see also Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 702 (Fed. Cir. 2014) (“[I]n determining the scope of the claimed design, ‘[i]t is the drawings of the design patent that provide the description of the invention’”) (quoting *In re Daniels*, 144 F.3d at 1452); *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319 (Fed. Cir. 2007) (holding that design patents “typically are claimed as shown in drawings”).

The ‘946 Patent drawings do not show a “chair”. Rather, they show a three-dimensional panel structure that includes an ornamental Y pattern. The typical functional elements of a chair—*i.e.*, the arms, legs, seat, and back—are not shown.

In *Samsung Electronics Co., LTD v. Apple Inc.*, 137 S.Ct. 429 (2016), the Supreme Court had occasion to interpret the term “article of manufacture” used in 35 U.S.C. § 289. That case involved design patents Apple had obtained on certain components of its iPhone. *Id.* at 433. A jury had found that Samsung’s smartphone infringed these patents, and the question before the Supreme Court was whether the entire smartphone was the only permissible “article of manufacture” for purposes of calculating damages under § 289, because consumers could not separately purchase the components Apple had patented. *Id.* at 432.

In resolving the issue, the Supreme Court held that the term “article of manufacture” in § 289 “is broad enough to encompass both a product sold to a consumer as well as a component of that product. A component of a product, no

less than the product itself, is a thing made by hand or machine. That a component may be integrated into a larger product, in other words, does not put it outside the category of articles of manufacture.” *Id.* at 435. The Court viewed this interpretation as consistent with 35 U.S.C. § 171 (discussed above), because the Patent Office and the Courts have understood § 171 to extend to components of a multi-component product. *Id.* at 435 (quoting, *inter alia*, *In re Zahn*, 617 F.2d at 268).

Judged by this standard, the panel structure shown in the ‘946 Patent drawings is itself an “article of manufacture;” and the ornamental Y pattern is patentable regardless of whether a complete product is shown. As conceded by the District Court, a panel structure with a substantially similar ornamental Y pattern is embodied in Home Expressions’ accused basket (Appx018). Pertinent here, this Court’s predecessor Court of Customs and Patent Appeals held that a design patent may be infringed by articles “specifically different” from the article shown in the patent drawings, and that the “inventive concept” of a design patent is not limited to “the exact article which happens to be selected for illustration”:

It is well settled that *a design patent may be infringed by articles which are specifically different from that shown in the patent*, *Gorham Mfg. Co. v. White*, 14 Wall. 511, 81 U.S. 511, 20 L. Ed. 731; *Borgfeldt & Co. v. Weiss*, 2 Cir., 265 F. 268, and it has been repeatedly held that a patent will be refused on an application claiming a design which is not patentably different from, or involves the same inventive concept as, a design claimed in a patent granted to the same inventor, even on a copending application. *In*

re Bigelow, 194 F.2d 550, 39 CCPA 835; *In re Russell*, 239 F.2d 387, 44 CCPA 716, and cases there cited. It seems evident, therefore, ***that the inventive concept of a design is not limited to the exact article which happens to be selected for illustration in an application or patent.***

In re Rubinfeld, 270 F.2d 391, 393 (C.C.P.A. 1959) (emphasis added).

Thus, it matters not whether the ‘946 Patent’s title recites a chair, because the patent drawings do not illustrate a chair. Rather, they show an ornamental Y pattern embodied in a panel structure which qualifies as an article of manufacture under *Samsung*.¹ As evidenced by Home Expressions’ basket, that article can be incorporated with other structures to make a finished product. Since the scope of a design patent is not limited by its title, the incorporation of the patented design into Home Expressions’ product constitutes an infringement of the ‘946 Patent.

D. The District Court Cases Relied Upon By Home Expressions Do Not Require That The ‘946 Patent Be Limited to A Chair

The three non-binding lower court cases relied upon by the District Court and Home Expressions—*Vigil v. Walt Disney Co.*, 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); *Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 679-80 (E.D. Mich. 2003); and *P.S. Products, Inc. v.*

¹ This case is even one step removed from *Samsung* in terms of limiting the scope of a design patent claim to the article identified in the patent’s title, because unlike the ‘946 Patent, Apple’s design patents actually showed illustrations of the iPhones in which the claimed component designs were incorporated. *See Apple Inc. v. Samsung Electronics Co., LTD*, 786 F.3d 983, 996-97 (Fed. Cir. 2015).

Activision Blizzard, Inc., 140 F. Supp. 3d 795, 801-03 (E.D. Ark. 2014)—are inapposite. In each of those cases, the article of manufacture recited in the patent’s title and preamble was part of the design claimed in the drawings; and therefore, was part and parcel of the infringement analysis. No similar facts are present here.

E. The District Court’s Decision Is Inconsistent With *In re Glavas*

The District Court’s decision is also inconsistent with the following well-established legal principles embodied in the case law: (1) if a prior art design would prevent issuance of a patent due to anticipation, that same design would infringe the patent if published or sold after the patent issued, *see* Curver’s Principal Brief at 14-17 and cases cited therein; and (2) a prior art design can anticipate a claimed design regardless of the article in which the prior design is embodied. *See In re Glavas*, 230 F.2d at 450 (holding 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”).

Despite the clear holding of *In re Glavas* with respect to the test for determining anticipation, Home Expressions attempts to distinguish the case by quoting the following portion of the decision: “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” (See Responsive Brief at 9, quoting *In re Glavas*, 230 F.2d at 451). That quote, however, does not apply, because it relates to the question of what types of prior art can be *combined* in determining the *obviousness* of “ideas for improving the appearance of” a design; not the question of anticipation. Indeed, as the *In re Glavas* Court held, “so far as anticipation by a single prior art disclosure is concerned, there can be no question as to nonanalogous art in design cases”. *Id.* at 450. In any event, the *In re Glavas* Court also held that if the question of obviousness relates to the problem of “merely 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.*

Thus, Home Expressions’ assertion that *In re Glavas* does not support Curver’s position because “the Court in *Glavas* reversed an invalidity rejection based on the use of prior design patents for different – or non-analogous – articles of manufacture” (Responsive Brief at 9), is incorrect. The *In re Glavas* decision resulted from an Examiner’s obviousness rejection based on a combination of certain prior art references, when there was no teaching or suggestion in the references to make the combination. See 230 F.2d at 451. The decision was not based the question of anticipation, or the question of whether the application of an attractive appearance to a surface would have been obvious to the skilled artisan.

Patent Office Examiners are required to follow *In re Glavas*—and consider both analogous and non-analogous prior art articles of manufacture—when examining design applications for unpatentability due to anticipation:

Anticipation does not require that the claimed design and the prior art be from analogous arts. *In re Glavas*, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956). “It is true 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. Accordingly, so far as anticipation by a single prior art disclosure is concerned, there can be no question as to nonanalogous art in design cases.” *Id.* (internal quotation marks omitted).

M.P.E.P. § 1504.02.

Examiners are also directed to follow *In re Glavas*, and consider analogous and non-analogous prior art, when the question of obviousness concerns the application of an attractive appearance to the surface of an article:

When modifying the surface of a primary reference so as to provide it with an attractive appearance, it is immaterial whether the secondary reference is analogous art, since the modification does not involve a change in configuration or structure and would not have destroyed the characteristics (appearance and function) of the primary reference. *See In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956)).

M.P.E.P. § 1504.03.

Thus, because “[t]hat which infringes, if later, would anticipate, if earlier”, *Peters*, 129 U.S. at 537, an infringement analysis in view of *In re Glavas* should be conducted in the same way as for anticipation, *i.e.*: if an accused article contains

the patented design, that article infringes the patent, regardless of the use to which the article is put. This is yet another reason why Home Expressions' accused basket infringes the '946 Patent, and why the District decision should be vacated.

In re Glavas is still the law, and is followed by Patent Office Examiners to this day. If the District Court's decision stands, the scope of the '946 Patent claim will be limited to the illustrated design embodied in a "chair". In that event, the Patent Office's six decades old practice of considering both analogous and non-analogous prior art articles in determining whether a claimed design is unpatentable for anticipation and/or obviousness would be turned on its head. This would create an irreconcilable inconsistency in the Patent Law as to the appropriate tests for determining validity and infringement of a design patent; and patents examined and issued under an *In re Glavas* examination procedure would be de-valued, because the pool of products embodying the claimed design potentially subject to infringement liability would be significantly reduced.

F. The District Court's Decision Is Also Contrary To The Code Of Federal Regulations And The Provisions Of The M.P.E.P.

The Code of Federal Regulations allows the use of solid and broken lines in design patent drawings. Solid lines indicate the claimed features of the invention. Broken lines are used to indicate surrounding environment outside the scope of the claim. 37 C.F.R. § 1.152; *Contessa Food Prods., Inc. v. Congara, Inc.*, 282 F.3d

1370, 1378 (Fed. Cir. 2002) (“If features appearing in the figures are not desired to be claimed, the patentee is permitted to show the features in broken lines to exclude those features from the claimed design, and the failure to do so signals inclusion of the features in the claimed design”). Here, the ‘946 Patent drawings do not contain any solid or broken lines illustrating specific features of a chair.

Home Expressions cites to the requirement of 37 C.F.R. § 1.153 (a) that a design patent claim “be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described” (Responsive Brief at 5). That provision relates to the preamble of a design claim, and the ‘946 Patent’s preamble does include the word “chair”. Under 37 C.F.R. § 1.154, a design patent preamble should state, among other things, “a brief description of the nature and intended use of the article in which the design is embodied”. Under the law of utility patents, a preamble stating an intended use for the invention is not a claim limitation. *See Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). Home Expressions cites no decision of this Court holding that a different rule should apply to the preamble of a design patent.²

² The brief description of the drawings in the ‘946 Patent also uses the word “chair” (Appx022). Since this description does not use any words of limitation such as “the invention” or “the present invention”, it also cannot limit the scope of the ‘946 Patent to a chair. *Cf. SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1342-43 (Fed. Cir. 2001).

To support the District Court’s decision, Home Expressions also seeks to draw a distinction between the claiming requirements for design patents under 37 C.F.R. § 1.71, and the disclosure requirements for utility patents under § 1.152. Specifically, Home Expressions argues that “[w]hile 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’” (Responsive Brief at 3). What §§ 1.71 and 1.152 mean is that the specification of a utility patent must disclose the invention in sufficient detail to enable a person skilled in the art to practice it; and the scope of a design patent claim is determined by the patent drawings. These provisions do not support the District Court’s decision, but they are certainly consistent with Curver’s position.

The provisions of the M.P.E.P. also do not support Home Expressions or the District Court. As discussed above, § 1503.01 states that the title of a design patent “does not define the scope of the claim”. Any different result would be

inconsistent with the holding of *In re Glavas* that for anticipation, the use to which an article is put has no bearing on its patentability as a design. 230 F.2d at 450.³

Home Expressions relies on the last paragraph of § 1502 of the M.P.E.P., which states: “Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation” (Responsive Brief at 5). The rest of the paragraph reads: “It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method”.

Nothing in this portion of the M.P.E.P. states that the scope of a design patent claim is limited to the article of manufacture referenced in the patent’s title or preamble, even when that particular article is not part of the design shown in the drawings. The provision just means that a design cannot exist as an abstract idea, but instead must be embodied in an article of manufacture. However, as this Court’s predecessor held in *In re Rubinfeld*, 270 F. 2d at 393, “*the inventive concept of a design is not limited to the exact article which happens to be selected for illustration in an application or patent.*” (Emphasis added).

³ The District Court relied upon *P.S. Products* in holding that a design patent’s title is relevant to claim scope and infringement (Appx012; Appx014-015). As discussed above, *P.S. Products* is inapposite, because the patent in that case included the article of manufacture as part of the claimed design illustrated in the drawings.

G. Home Expressions' Argument Based On Copyright Law Cannot Limit The '946 Patent To The Claimed Design In A Chair

Home Expressions argues that Curver's interpretation of the scope of the '946 Patent seeks "to invade the province of copyright protection", because a copyright "protects 'pictorial, graphic, or sculptural feature[s]' that are separable from a useful article" (Responsive Brief at 6). This argument is without merit.

First, it is important to point out that the principles of copyright law and design patent protection can and do co-exist, and Curver's position is consistent with both areas of law. For example, only a "minimal degree of creativity" is required for copyright protection. *Feist Publ'ns, Inc. v. Rural Tel. Serv., Co.*, 499 U.S. 340, 362 (1991). In contrast, design patent protection is available for "any new, original, and ornamental design for an article of manufacture". 35 U.S.C. § 171. By virtue of the '946 Patent issuing, Curver met the patentability standard of § 171. Further, under copyright law, "pictorial, graphic, or sculptural features" of the "design of a useful article" are eligible for protection if those features "can be identified separately from, and are capable of existing independently of, the *utilitarian aspects* of the article". 17 U.S.C. § 101 (emphasis added). Similarly, under design patent law, it is the "*non-functional*" aspects of the claimed design that are relevant to patentability and infringement. *See Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988). Thus, both copyright law and design

patent law contemplate consideration of functional and non-functional design features applied to articles of manufacture.

Curver is not attempting to invade the province of copyright law. Rather, Curver's position—supported by statutory and case law, the M.P.E.P., and the regulations governing design patents—is that the inventive design claimed in the '946 Patent should *not be limited* to a “chair” for purposes of infringement.

H. The Doctrine Of Prosecution History Estoppel Does Not Support The District Court's Decision

As discussed in Curver's Principal Brief (pages 18-21), the District Court incorrectly concluded that the scope of the '946 Patent is limited to the claimed design embodied in a chair, because in response to prosecution, the inventor changed the title of the patent and corresponding text to substitute the word “chair” for the word “furniture”. The change was simply made in response to the Examiner's objection to the title “Furniture (Part of)” on the ground that the term “Part of” is not an article of manufacture (Appx004-005). The substance of the patent drawings (which do not illustrate a chair) was not changed. Moreover, during prosecution, the inventor never disclaimed application of the inventive design to articles such as Home Expressions' accused “baskets”. In any event, Home Expressions fails to cite any decision of this Court in which a change to a design patent's title during prosecution resulted in a disclaimer of claim scope.

Given the weakness of the case for prosecution history estoppel on both the facts and the law, it is not surprising that Home Expressions seeks to moot the issue in its Responsive Brief. Specifically, Home Expressions argues that it was inappropriate for Curver to address the issue of prosecution history estoppel in its Principal Brief, because “the district court did not apply prosecution history estoppel to dismiss Curver’s infringement claim” (Responsive Brief at 11-12). Thus, Home Expressions contends, “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’” (*Id.* at 11 (citations omitted)). As shown below, this general principle of appellate practice does not apply, because the District Court’s analysis of the estoppel issue clearly impacted its decision to grant Home Expressions’ motion to dismiss.

First, the District Court stated, albeit incorrectly, that: “[L]anguage 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” (Appx012). Next, the District Court analyzed the prosecution history of the ‘946 Patent, and concluded that “[t]he 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.’” (Appx013). Finally, the District Court stated: “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" (Appx016).

However, in construing the scope of the '946 Patent, "directly", the District Court necessarily relied upon the change made to the patent's title and corresponding text during prosecution, because no other claim construction analysis was conducted by the District Court in reaching the conclusion that there was no infringement (Appx016-017). As a result, it should be concluded that the District Court's estoppel analysis, which occupied a good portion of its written opinion, impacted the final judgment. Accordingly, it was appropriate for Curver to address the issue of prosecution history estoppel in its Principal Brief.

Despite arguing that the District Court never applied the doctrine of prosecution history estoppel, Home Expressions still attempts to address the issue on the merits (Responsive brief at 12-13). Home Expressions relies upon *Pacific Coast* and *Festo Corp. v. Shoketsu Kinoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002) to support its position (*Id* at 13); but neither case applies. In *Pacific Coast*, the applicant 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 text". 739 F.3d at 702-03.

Curver never cancelled any figures in prosecuting the '946 Patent. *Festo* is a utility patent case, not a design patent case. At bottom, both cases are irrelevant, because neither one involved the amendment of a design patent's title during prosecution.

Home Expressions seizes upon the words “[b]y removing broad claim language referring to alternate configurations” used by the *Pacific Coast* Court to argue that the Court considered “the claim text” in determining whether claim scope was surrendered during prosecution (Responsive Brief at 4). But the language in question had been used in the patent application to identify *figures* that were cancelled (once the figures were cancelled, the language was unnecessary). 739 F.3d at 703-703. Here, in contrast, the only part of the '946 Patent that was amended during prosecution was text relating to the patent's title, and minor formality amendments to the figures. As M.P.E.P. § 1503.01 clearly states, a design patent's title “does not define the scope of the claim”.

I. The District Court Misapplied The “Ordinary Observer” Test

Under the “ordinary observer” test for design patent infringement, a design patent will be 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*). Stated another way, “as this court has sometimes described it,

infringement will not be found unless the accused article ‘embod[ies] the patented design or any colorable imitation thereof’”. *Id.* at 678 (citations omitted).

As the Supreme Court recognized long ago, a design is better represented by an illustration “than it could be by any description and a description would probably not be intelligible without the illustration.” *Dobson v. Dornan*, 118 U.S. 10, 14 (1886). The Patent Office is in agreement. *See* M.P.E.P. § 1503.01 (“[A]s a rule the illustration in the drawing views is its own best description.”).

Thus, under either statement of the “ordinary observer” test discussed in *Egyptian Goddess*, the comparison to be made for purposes of determining infringement is between the claimed design shown in the patent drawings, and the design “embodied” in the accused article. By limiting the scope of the ‘946 Patent to the claimed design in a chair, and comparing a chair to a basket for purposes of infringement, the District Court misapplied the ordinary observer test. The correct test is to determine whether an ordinary observer would conclude that the panel structure with the ornamental Y pattern shown in the ‘946 Patent drawings is embodied in Home Expressions’ accused basket. Based on the District Court’s concession that the designs are substantially similar, the answer should be yes.

In addition, it cannot be disputed that the following principles of design patent law apply to this case: (1) that the ordinary observer test for design patent infringement is the same test used to determine invalidity of a design patent for

anticipation; and (2) that the question of whether a prior art reference anticipates the claimed invention of a design patent turns solely on a comparison of the designs themselves, without reference to the articles of manufacture in which the prior art and claimed invention are embodied. *See, e.g., 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) (holding that “the design patent infringement test also applies to design patent anticipation”); *In re Glavas*, 230 F.2d at 450. These legal principles also show why it was error for the District Court to limit the infringement inquiry to chairs; and therefore, why the District Court’s final judgment should be vacated.

Although it fails to come to grips with these legal principles, Home Expressions nevertheless argues that the District Court correctly applied the ordinary observer test (*see* Responsive Brief at 8-10). The argument, however, is without merit, because it is based on: (1) the inapplicable quote from *In re Glavas* on the standard for determining the obviousness (not anticipation) of a design patent based on a combination of prior art; and (2) the non-binding district court decisions in *Vigil*, *Kellman*, and *P.S. Products*, which are inapplicable because the patent drawings in those cases included the particular articles of manufacture recited in the preamble and title as part of the claimed designs (*see Id.*).

Home Expressions also quotes a portion of this Court's decision in *OddzOn Prods. v. Just Toys*, 122 F.3d 1396, 1404 (Fed. Cir. 1997) to argue that "[t]he infringement inquiry requires more than 'a simple comparison of the accused products with the figures in the design patent'" (Responsive Brief at 10-11). Although omitted from its Responsive Brief, the context of the quoted passage is important. The *OddzOn* Court went on to state that "[a] design patent only protects the novel ornamental features of the patented design", and the claim construction and infringement issues in that case required a determination of the ornamental and functional features of the claimed design. 122 F.3d at 1405. The question of whether the '946 Patent design contains any functional features was not before the District Court. Consequently, the *OddzOn* decision has no application here.

Finally, Home Expressions relies upon this Court's decision in *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995) for the unremarkable proposition that the claims, as "properly construed," must be compared to the accused design for purposes of determining infringement (Responsive Brief at 11). We agree, and as properly construed, the claimed design of the '946 Patent is not limited to chairs. Notably, the patent at issue in *Elmer* was for the design of a vehicle-mounted advertising sign, and the sign itself was illustrated in the drawings. *See* 67 F.3d at 1575-76. Thus, the facts of *Elmer* have no application to this case.

II. CONCLUSION

For all the above reasons, and the reasons discussed in Curver's Principal Brief, the District Court's judgment should be vacated, and Curver's Amended Complaint for patent infringement against Home Expressions should be reinstated.

Dated: November 27, 2018

Respectfully submitted,

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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 5,982 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: November 27, 2018

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CERTIFICATE OF SERVICE

On November 27, 2018, I caused the foregoing Reply 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:

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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 Overnight Delivery, within the time provided in the Court's rules.

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