

United States Court of Appeals for the Federal Circuit

CURVER LUXEMBOURG, SARL,
Plaintiff-Appellant

v.

HOME EXPRESSIONS INC.,
Defendant-Appellee

2018-2214

Appeal from the United States District Court for the District of New Jersey in No. 2:17-cv-04079-KM-JBC, Judge Kevin McNulty.

Decided: September 12, 2019

MICHAEL ANTHONY NICODEMA, Greenberg Traurig, LLP, Florham Park, NJ, argued for plaintiff-appellant. Also represented by JASON HARRIS KISLIN, BARRY SCHINDLER.

STEVEN M. AUVIL, Squire Patton Boggs (US) LLP, Cleveland, OH, argued for defendant-appellee. Also represented by JEREMY WILLIAM DUTRA, Washington, DC.

ERIK STALLMAN, Samuelson Law, Technology & Public Policy Clinic, University of California, Berkeley School of Law, Berkeley, CA, for amicus curiae Open Source

Hardware Association. Also represented by JENNIFER M. URBAN.

Before CHEN, HUGHES, and STOLL, *Circuit Judges*.

CHEN, *Circuit Judge*

Plaintiff-appellant Curver Luxembourg, SARL (Curver) is the assignee of U.S. Design Patent No. D677,946 ('946 patent), entitled "Pattern for a Chair" and claiming an "ornamental design for a pattern for a chair." The design patent's figures, however, merely illustrate the design pattern disembodied from any article of manufacture. Curver sued defendant-appellee Home Expressions Inc. (Home Expressions) in the United States District Court for the District of New Jersey, alleging that Home Expressions made and sold baskets that incorporated Curver's claimed design pattern and thus infringed the '946 patent. Home Expressions moved to dismiss under Federal Rule of Civil Procedure 12(b)(6), arguing that its accused baskets could not infringe because the asserted design patent was limited to chairs only. The district court agreed with Home Expressions and granted the motion. The question on appeal is whether the district court correctly construed the scope of the design patent as limited to the illustrated pattern applied to a chair, or whether the design patent covers any article, chair or not, with the surface ornamentation applied to it. Because we agree with the district court that the claim language "ornamental design for a pattern for a chair" limits the scope of the claimed design in this case, we affirm.

BACKGROUND

The '946 patent was filed in 2011 and claims an overlapping "Y" design, as illustrated in Figure 1 below. J.A. 24. The title, description of figures, and claim of the '946 patent all consistently recite a "pattern for a chair." *Id.* But none of the figures illustrate a design being applied to a chair.

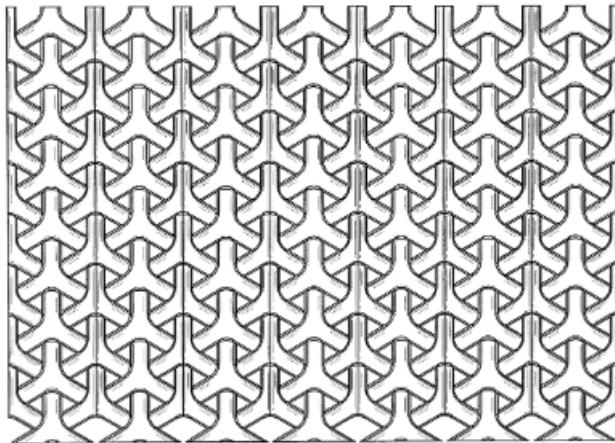


FIG. 1

The term "chair" first appeared through amendment during prosecution. Curver originally applied for a patent directed to a pattern for "furniture," not a chair specifically. The original title was "FURNITURE (PART OF)." J.A. 66. The original claim recited a "design for a furniture part." J.A. 67. And each of the figures was described as illustrating a "design for a FURNITURE PART." J.A. 66–67. None of the figures illustrated a chair, any furniture, or any furniture part.

The Patent Office allowed the claim but objected to the title, among other things. The examiner stated that under 37 C.F.R. § 1.153 and the Patent Office's Manual of Patent Examining Procedure (MPEP) § 1503(I), the title must designate a "particular article" for the design. Under these provisions, the examiner found that the title's use of "Part of" and the specification's use of "Part" were "too vague" to

constitute an article of manufacture. J.A. 61. To remedy this problem, the examiner suggested that the title be amended to read “Pattern for a Chair,” and that “[f]or consistency,” the “title [] be amended throughout the application.” *Id.* (noting that “[t]he claim in a design patent must be directed to the design for an article” under 35 U.S.C. § 171). Curver adopted the examiner’s suggestion, replacing the original title with “Pattern for a Chair” and replacing “furniture part” with “pattern for a chair” in the claim and figure descriptions to be consistent with the amendment to the title. J.A. 66–67. Referring to these amendments, Curver acknowledged that “the title and the specification have been amended as required in the Office Action.” J.A. 69. Curver did not amend the figures to newly illustrate a chair. The examiner accepted these amendments and allowed the application.

DISTRICT COURT PROCEEDINGS

Home Expressions makes and sells baskets that incorporate an overlapping “Y” design similar to the pattern disclosed in the ’946 patent, as shown below. J.A. 5.



Curver filed a complaint against Home Expressions in district court accusing these basket products of infringing the '946 patent. Home Expressions filed a motion to dismiss Curver's complaint under Rule 12(b)(6) for failing to set forth a plausible claim of infringement. The district court granted the motion.

To determine whether the complaint stated a plausible infringement claim, the district court conducted a two-step analysis. First, it construed the scope of the design patent. Second, it compared the accused products to the claimed design as construed to determine whether the products infringed. Under the "ordinary observer" test, an accused product infringes a design patent if "in the eye of an ordinary observer . . . two designs are substantially the same," such that "the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other . . ." *Gorham Co. v. White*, 81 U.S. 511, 528 (1871) (articulating the "ordinary observer" test for design patent infringement); *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 672 (Fed. Cir. 2008) (en banc) (making the "ordinary observer" test in *Gorham* the sole test for determining design patent infringement). At the first step, the district court construed the scope of the '946 patent to be limited to the design pattern illustrated in the patent figures as applied to a chair, explaining that "[t]he scope of a design patent is limited to the 'article of manufacture'—i.e., the product—listed in the patent." J.A. 16. At the second step, the district court found that an ordinary observer would not purchase Home Expressions's *basket* with the ornamental "Y" design believing that the purchase was for an ornamental "Y" design applied to a *chair*, as protected by the '946 patent. Accordingly, the district court dismissed the complaint pursuant to Rule 12(b)(6) for failing to set forth a plausible claim of infringement.

Curver timely appealed to this court. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

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