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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

THE TONYTAIL COMPANY, INC., a Delaware Corporation,

Plaintiff, Counterdefendant,

v

CONAIR CORPORATION, SCUNCI INT'L, LTD., RITE AID CORPORATION., L&N SALES & MARKETING INC., and 1-10, inclusive,

Defendant, Counterclaimant.

Case No.: 3:07-cv-05895-WHA

TONYTAIL COMPANY, INC.'S OPENING CLAIM CONSTRUCTION BRIEF

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2	The Independent Claim 4 of the Utility Patent 6,263,884 (884 Patent)
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THE INDEPENDENT CLAIM 4 OF THE UTILITY PATENT 6,263,884 (884 PATENT)

Reprinted for the Court's convenience at Attachment 2

(Disputed terms are in bold)

Claim 4

A hair binding method, for use by a person having a ponytail having a ponytail end for securing said ponytail, using a device comprising **an elastic band having a pair of elastic band ends, synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends, the synthetic hair fiber ends joined to the elastic band ends to form a closed loop**, comprising the steps of:

a) **encircling the ponytail with the device by inserting the ponytail end through the closed loop of said device;**

b) tensioning the device around the ponytail by doubling up the device; and

c) **covering the elastic band with the synthetic hair fibers so that the outward appearance of the device is formed solely by the synthetic hair fibers.**

THE DEPENDENT CLAIM 5 OF THE 884 UTILITY PATENT

Reprinted for the Court's convenience at Attachment 3

Claim 5

The hair binding method as recited in claim 4, wherein the step of doubling up the device further comprises repeatedly:

a) twisting the closed loop to form a secondary loop; and inserting the ponytail end through the secondary loop.

FIVE CLAIM TERMS PROPOSED FOR CONSTRUCTION

Reprinted for the Court's convenience at Attachment 4

Claim Term or Step	Plaintiff's Construction	Defendants' Construction	Pages in Brief
1. "...an elastic band having a pair of elastic band ends..."	an elastic band whose two ends serve to join together and encircle…	…an elastic cord whose two ends are not joined to one another…	5
2. "…synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends…"	synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends	…synthetic hair fibers whose two ends are not joined to one another…	10
3. "…the synthetic hair fiber ends joined to the elastic band ends…"	the synthetic hair fiber ends joined to the elastic band ends	…wherein one of the elastic band ends is permanently joined with one of the synthetic hair fiber ends, and the other of the elastic band ends is permanently joined with the other of the synthetic hair fiber ends…	12
4. "…to form a closed loop…"	to take on a closed loop shape	…to form a single unbroken ring...	15

5. "…covering the elastic band with the synthetic hair fibers so that the outward appearance of the device is formed solely by the synthetic hair fibers…"	covering the elastic band with the synthetic hair fibers so that the outward appearance of the device is formed singly, to the exclusion of all else, by the synthetic hair fibers	…adjusting the ring so that the outward appearance of the ring is formed only by synthetic hair fibers…	16

Sixth Step requested by Plaintiff

Claim Term or Step	Plaintiff's Construction	Defendants' Construction	Pages in Brief
6. "…encircling the ponytail with the device by inserting the ponytail through the closed loop of said device…"	"…encircling the ponytail with the device by inserting the ponytail through the closed loop of said device…"	…inserting the ponytail end through the ring so that the ring encircles the ponytail…	17

I. INTRODUCTION

This case involves one utility patent, U.S. Patent No. 6,263,884 (the "'the '884 Patent") and two design patents, U.S. Design Patent No. D413,693 ("the 'D693 Patent") and U.S. Design Patent ("the 'D239 Patent"). Although Tonytail has made an effort to limit the scope of the patent claim terms selected for construction in the claim construction hearing set for May 28, 2008 to those asserted by Plaintiff in the '884 Patent, an agreement has not been reached. As a result, the parties have selected five steps found in claims 4 and 5 of the '884 Patent to be considered by the court during the claim construction hearing. Additionally, Plaintiff submits a sixth step from claims 4 and 5 for the court's review. Beyond the '884 Patent, Defendants also seek construction of the two design patents: the 'D693 Patent and the 'D239 Patent. The parties disagree over whether these design patents should be construed during the claim construction hearing. Plaintiff asserts that the two design patents in this case should be construed by the Court during trial and not during the upcoming claim construction hearing. In addition, Plaintiff asserts that claims 1-3 of the '884 utility patent are not a proper subject for the scheduled claim construction hearing. Defendants have argued that the '884 Patent claims 1, 2 and 3 are invalid for indefiniteness in their preliminary invalidity contentions and Defendants have subsequently counterclaimed for declaratory judgment against these claims. Plaintiff moved to dismiss Defendant's counterclaim for declaratory judgment due to the court's lack of subject matter jurisdiction due to a lack of "case or controversy" over the unasserted claims 1, 2 and 3. The Pretrial Motion to Dismiss Hearing was scheduled 35 days after service for June 5, 2008. Furthermore, a Motion to Shorten Time for the Court to Hear the Motion to Partially Dismiss on May 22, 2008 has been filed.

With regard to the six selected steps found in claims 4 and 5 of the '884 Patent which are submitted for the court's review, the disputed terms and the parties' current proposed constructions are reprinted at Attachment 4.

II. CLAIM CONSTRUCTION STANDARD OF REVIEW

The Court has set forth the standard of review for claim construction in recent cases.

Plaintiff incorporates by reference the framework announced by the Court. Intergraph Hardware Tech. Co. v. Toshiba Corp., 2007 U.S. Dist. LEXIS 56424, at 8-14 (N.D. Ca. August 2, 2007). Under Markman v. Westview Instruments, Inc., 527 U.S. 370, 389-90, 116 S. Ct. 1384, 134 L.Ed. 2d 577 (1996), the court construes the scope and meaning of disputed patent claims as a matter of law. The first step of this analysis requires the court to consider the words of the claims. Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1324 (Fed. Cir. 2002). "Claim construction begins, as it must, with the words of the claim." Donald S. Chisum, CHISUM ON PATENTS 18.03[2] n.1 (2002). It is now well established that the language of a claim should be given its "ordinary and accustomed meaning" as would be understood by a person of skill in the relevant art as of the effective filing date. Phillips v. AWH Corp., 415 F.3d 1303, 1322 (Fed. Cir. 2005) (en banc). To determine the ordinary meaning, the court may review other intrinsic evidence such as the written description, prosecution file history, dictionaries, and treatises. Teleflex, 299 F.3d at 1325. The court must conduct this inquiry not from the perspective of a lay observer, but from the perspective of a person of ordinary skill in the relevant art. Id. However, the specification (written description) is the single best guide to the meaning of a disputed term. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). At the same time, the Federal Circuit has cautioned that the written description should never trump the clear meaning of the claim terms. Comark Comms., Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed. Cir. 1998).

Nonetheless, the specification may assist in resolving ambiguity where the ordinary and accustomed meaning of the words used in the claims lack sufficient clarity to permit the scope of the claim to be ascertained from the words alone. Teleflex, 299 F.3d at 1325. However, it is improper to read limitations from the written description into a claim. Tate Access Floors, Inc. v. Maxcess Techs., Inc., 222 F.3d 958, 966 (Fed. Cir. 2000). Dictionary definitions may also provide evidence of the ordinary meaning of a claim. Phillips, 415 F.3d at 1322. However, there is no requirement that claim interpretation begin with a dictionary definition of the disputed terms. Phillips, 415 F.3d at 1320-21. Although Phillips stands for the proposition that

claim terms must be interpreted in light of their context, especially the language used in other claims and the specification,… it is entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims. Id. The court may rely on dictionary definitions so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents. Vitronics, 90 F.3d at 1584 n.6.

Extrinsic evidence in general, and expert testimony in particular… may not be used to vary or contradict the claim language. Indeed, where the patent documents are unambiguous, expert testimony regarding the meaning of a claim is entitled to no weight. Vitronics, 90 F.3d at 1584. Extrinsic evidence, including dictionaries and expert testimony, are viewed as less reliable than the patent and prosecution history. Phillips, No. 03-1269 at 19-21.

It is error to limit a claim to the preferred embodiment if the specification supports a broader interpretation. Liebel-Flarsheim, 358 F.3d at 906 (Fed. Cir. 2007); Electro Sci. Indus. v. Dynamic Details, Inc., 307 F.3d 1343, 1349 (Fed. Cir. 2002). Finally, patent claims are presumed valid, and, thus, if a court has the choice between two interpretations, one of which would render the claim invalid, the court should ordinarily adopt the construction that retains claim validity. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1384 (FedCirc 2001).

III. BACKGROUND OF THE TECHNOLOY

Plaintiff's '884 Patent

The '884 Patent claims an apparatus and method for binding a ponytail where the device securely attaches around a ponytail while providing an outward appearance of natural hair. The patent application was filed by inventor Mia Minnelli on or about March 14, 2000 which was later issued as the '884 Patent on or about July 24, 2001. Ms. Minnelli also filed related design patent applications which later issued as the 'D693 and 'D239 Patents on or about September 7, 1999 and January 29, 2002 respectively. Ms. Minnelli later legally assigned her intellectual property to Plaintiff, The Tonytail Company, Inc. which Ms. Minnelli founded in the fall of 1997.

The object of the '884 patent is the production and use of a device which can firmly maintain a ponytail while creating the natural appearance of human hair. *Patent* 1:40-50. Prior to the issuance of the '884 patent, the traditional way of creating a "ponytail" hairstyle was to encircle the hair with a ribbon tied into a knot which often times proved to be tedious requiring coordination and dexterity. *Id.* 1:10-15. Hair clips and elastic bands have also been used to create the "ponytail" hairstyle, however, their unnatural appearance rendered the clips and bands to be noticeable when placed in the hair. *Id.* 1:17-30.

The invention disclosed in the '884 Patent solves these problems. The device disclosed in the specification comprises two main parts: an elastic band and synthetic fibers which are joined in order to form a loop. *Id.* 3:27 – 4:14. The claimed method is directed towards the use of a similar loop to encircle and bind the ponytail by doubling up the loop and inserting the ponytail into the subsequently formed secondary loop. *Id.* 4:15-33. Utilizing the claimed method with an apparatus similar to the disclosed device allows the firm maintenance of a ponytail appearance while simultaneously allowing the synthetic hair fibers to disguise the apparatus when the secondary loop is formed. *Id.* 3:10-18. The desired end result is a ponytail hairstyle bound by what appears to be a part of the person's natural hair. *Id.* 3:19-22.

IV. CLAIM CONSTRUCTION

The Disputed Steps or Terms in independent claim 4 and dependent claim 5

The six selected steps submitted for the court's review are taught by independent method claim 4 and incorporated by reference in dependent method claim 5.

Disputed Step 1: **"...an elastic band having a pair of elastic band ends..."** *Please see Item 1 of Comparative Claim Construction Chart at Attachment 5.*

Plaintiff's Construction	Defendants' Construction
an elastic band whose two ends serve to join together and encircle...	...an elastic cord whose two ends are not joined to one another...

The claim terms at issue in the first disputed step are (i) the replacement of the claim's original term "band" with that of the Defendants' proffered term "cord"; and (ii) the inclusion

of additional language describing the original term "band" (or the proffered "cord" in the Defendants' construction) as respectively offered by both parties. Plaintiff's construction preserves the term "band" as it appears in the claim language and throughout the specification. Further, Plaintiff's construction clarifies the function of the term "band" with the claimed method in a way that is consistent with the patent's specifications without modifying the scope of the claim. However, Defendant's construction seeks to replace the highly utilized term "band" with the term "cord", a term which does not currently appear on the face of the patent. By doing so, the Defendant seeks to add a limitation not taught by the claim or the specification. The words "band" and "cord" as used by Defendants represents a distinction without meaning in the context of the method claim. Further, the additional language offered in Defendant's construction adds a second impermissible structural limitation to the method claim's meaning by inserting the additional structural language "whose two ends are not joined to one another" taken from the preferred embodiment, which is not found in the ordinary meaning of the term "band."

Preserving the term "band" in disputed Step 1 instead of substituting the term "cord" prevents the addition of a limitation only supported by extrinsic evidence. During claim construction, the court must first look at the claims themselves while "indulging a heavy presumption that a claim term carries its ordinary and customary meaning." Intergraph, at 8 [citing Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1324 (Fed. Cir. 2002)]. In determining the customary meaning, the court may review intrinsic evidence such as the claims, the written description and the prosecution history and must review these sources from the standpoint of a person of ordinary skill in the art. Id. at 9 [citing Teleflex 299 F.3d at 1325 and Zelinski v. Brunswick Corp., 185 F.3d 1311, 1316 (Fed. Cir 1999)]. Use of dictionary definitions as extrinsic evidence is permitted to help the court understand the underlying technology "so long as the dictionary definition does not contradict any definition in or ascertained by a reading of the patent documents." Id. at 11 (citing Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 n.6. (Fed. Cir. 1996). The Federal Circuit warned that

"a claim should not rise or fall based upon the preferences of a particular dictionary editor, or the court's independent decision, uninformed by the specification, to rely on one dictionary rather than another. Phillips, 415 F.3d at 1322. Defendants' replacement of the term "band" with the term "cord" impermissibly relies heavily on Defendant's cited dictionary definition unsupported by intrinsic sources. More importantly, use of the word "cord" artificially reads in or inserts a limitation not found in or supported by intrinsic sources.

Allowing the use of the term "cord" impermissibly adds a new limitation requiring the binding device to be constructed from cord-like material. In support for Defendants' substitution of the term "band" for cord, Defendants' cite the dictionary definition of the word "cord" [Corrected Joint Claim Construction and Prehearing Statement Exhibit C.] which defines "cord" in the first instance as "a slender length of flexible material *usually made of twisted strands or fibers* and used to bind, tie, connect or support." emphasis added. The American Heritage Dictionary of the English Language Fourth Edition, 2000. However, throughout the specification and all the claims in Patent '884, the term "band" is explicitly used and the word "cord" does not appear at all. Both Plaintiff's and Defendants' cited dictionaries define "band" as a strip that is used to encircle something. (American Heritage defining "band" as a thin strip of flexible material used to encircle and bind…; Merriam-Webster's Online Dictionary (2008) defining "band" as a thin flat encircling strip") Neither definition limits the usual manufacturing of a "band" to that of a "cord's" manufacturing, being one "usually made of twisted strands or fibers." In light of these dictionary definitions, it is clear that the term "band" referred to in the device used in method claims 4 and 5 may be constructed of cord-like material (usually made of twisted strands or fibers) but is not limited to the use of such material. The only limitation discussed in both the specification and the claims themselves regarding the material to be used in manufacturing of the "band" is that the material to be used must be elastic. *Patent* 2:39-44; 3:30-33; 4:17. By allowing Defendant's construction in this case, the court would impermissibly read in a limitation from an extrinsic source. As such, Defendants' construction allowing the use of the word "cord" should be rejected.

The inclusion of Plaintiff's additional language clarifies the term "band" while Defendants' additional language impermissibly imposes a structural limitation created from the preferred embodiment which is not found in the ordinary meaning of the term "band". An accused infringer cannot use the preferred embodiment to overcome the heavy presumption that a claim term takes on its ordinary meaning. CNET Networks, Inc. v. Etilize, Inc., 2008 U.S. LEXIS 16531 at 20 (N.D. Ca. March 4, 2008) (citing Teleflex, 299 F.3d at 1327). Further, claims must not be construed to be limited to a single embodiment disclosed in the specification. Gemstar-TV Guide, 383 F.3d at 1366 (Fed. Cir. 2004). Defendants' construction includes the additional language "whose two ends are not joined to one another" in order to modify the above discussed impermissible term "cord" in Defendants' construction and possibly the term "band" in the original language of claims 4 and 5. Defendants' cite language in the preferred embodiment to support the limitation that the band ends are not joined together: "band ends joined to connectors or synthetic band ends directly." [Corrected Joint Claim Construction and Prehearing Statement Exhibit C]. However, as discussed, the definition of a "band" under both parties' definitions is merely something that encircles. Neither this definition nor the disputed step at issue add any qualifications requiring that the elastic band ends must not be joined to one another. *Patent* 4:14-20. Further, the patent language that the Defendants' cite in support of their proffered additional language does not explicitly state that the elastic band ends must not be joined to each other. *Patent* 2:29-31. Rather, it appears that the Defendant is attempting to imply that the elastic band ends must not be joined to each other since these ends are joined to the synthetic fiber ends. Even if such an implication is a possible construction for the language found in the preferred embodiment, limiting method claims 4 and 5 to one possible embodiment discussed in the specification runs contrary to Gemstar.

Further, Defendants' construction would add a further limitation that the "band" ends not be joined together in any fashion in order for one to practice method claims 4 and 5. However, claim 4's language does not contemplate this limitation. In fact, a later step in claim

4's language indicates that the band ends and the synthetic fiber ends are joined in order to form a loop ("the synthetic fiber ends joined to the elastic band ends to form a closed loop.") *Patent* 4:18-20. This step does not contemplate how the band ends and the synthetic fiber ends are joined thus allowing a possible practice of the claimed method to be one where all the ends of both the elastic band and the synthetic fiber strands may be joined together in any fashion. This contention is further supported by Figure 3 of the '884 patent which was discussed in the preferred embodiment. *Patent* 2:57-67. Aforementioned Figure 3 illustrates the invention being used to gather and hold the ponytail. *Patent* 2:16-17. The figure illustrates the synthetic fiber ends and the elastic band ends joined together in one group at the base of the ponytail so that the formed loop maybe twisted in order for the user to properly tension the device. *Id.* 2:57-67. Inclusion of Defendants' construction would prevent this possible joining of the elastic band ends and the synthetic fiber ends at the base of the ponytail. As a result, Defendant's construction creates an additional limitation not contemplated anywhere in the patent and runs contrary to a possible practice of the claimed methods illustrated in the patent itself. In fact, in Defendants' claim construction, without ultimately joining the ends, there is no way for the ponytail to be held in place at all.

Plaintiff's construction avoids the pitfalls of Defendant's construction by adding clarifying language without modifying the scope of the claim. The additional language in Plaintiff's construction ("whose two ends serve to join together and encircle") clarifies the function of the band ends in a way that complies with the ordinary meaning of the term "band." Utilization of this language to describe the band end functions are evidenced by the claims themselves, the specification, and both dictionaries cited by the parties. A later step in claim 4 describes the full device, including the bands, serving to encircle the ponytail. *Patent* 4:22-23 ("encircling the ponytail with the device"). Further, the specification for the '884 Patent describe the bands of having a quality to allow the bands to "stretch *around* a group of hair", thus allowing the bands to encircle around the user's ponytail. *Patent* 2:40-45 (emphasis added). Finally, as previously mentioned, both parties' dictionary definitions define "band" as

something that encircles and joins or binds things together. In each of the aforementioned instances, language describing a function of the band ends, being one that "serves to join and encircle," merely stems from the ordinary meaning of the term "band." Further, since the band is used to encircle a joined group of hair, Plaintiff's construction aids in the practice of claims 4 and 5 by teaching that the device, including the bands, must encircle a joined group of hair. Because the addition of Plaintiff's language does not modify the ordinary meaning of the term "band" and only teaches that the bands must encircle the hair, the inclusion of Plaintiff's construction would not modify the scope of the claims. Since evidence in the claim itself, the specification, and the extrinsic sources cited by both parties demonstrate that the Plaintiff's construction complies with the ordinary meaning of the term without broadening the scope of the claim, Plaintiff's construction in its entirety should be granted.

Disputed Step 2: "...synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends..."

Plaintiff's Construction	Defendants' Construction
synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends	...synthetic hair fibers whose two ends are not joined to one another...

The claim term at issue here is that Defendants seeks to add additional structural language to Disputed Step 2 of the method claim similar to that of the impermissible additional language Defendants sought to add in the abovementioned Disputed Step 1. Plaintiff seeks to preserve the language and scope of this step as issued in the patent. Defendants' construction must be rejected because (i) Defendants' construction reads in an extraneous structural limitation into the method cliam; and (ii) Defendant's construction reads out a permissible way of practicing method claims 4 and 5.

Defendants' proposed construction of Disputed Step 3 adds an impermissible extraneous structural limitation created from the language of the preferred embodiment. As stated for the construction of Disputed Step 1, claims must not be construed to be limited to a single embodiment disclosed in the specification. Gemstar, 383 F.3d at 1366. Defendants'

addition of the language "whose two ends are not joined to one another" adds an impermissible extraneous structural limitation to the method claim from language found in the preferred embodiment of the device disclosed in the specification. Defendants' cite language in the preferred embodiment to support the limitation that the synthetic hair fibers ends are not joined together. [Corrected Joint Claim Construction and Prehearing Statement Exhibit C]. In doing so, it appears that Defendants are attempting to make a similar implication Defendants made in Disputed Step 1, that the synthetic hair fibers cannot be joined together. However, this implication is not stated in Defendants' cited language taken from the preferred embodiment or from the language of the claims. Even if Defendants' implication can possibly be construed from the language of the preferred embodiment, Defendants' construction would import a limitation from the preferred embodiment unsupported from the language of the claims 4 and 5.

In addition, Defendants' additional limitation would suggest that the method could not be operative, which it clearly is for both the claimed method and the Defendant's accused infringing method. As in the possible practice of the claimed method discussed in Disputed Step 1 and in FIG. A2 (below). Defendants' construction adds a limitation that is not contemplated by claim 4 or 5 and runs contrary to a possible practice of these method claims. Defendants' construction requires that the synthetic hair fiber ends not be joined together. However, when the original step language is read with a later step in claim 4's language ("the synthetic fiber ends joined to the elastic band ends to form a closed loop"), the claim does not teach that the synthetic fibers cannot be joined together. *Patent* 4:18-20. Rather, within the claim's scope is the possibility that all the ends, the elastic band ends and the synthetic hair fiber ends, may be joined together in order to practice claims 4 and 5. See Fig. 1. This possible practice of claim 4 and 5 is illustrated in Figure 3 of the '884 patent and in the language of the preferred embodiment where all the ends are joined at the base of the ponytail. *Patent* 2:57-67. Inclusion of the Defendants' construction would prevent this permissible joining illustrated in the patent itself. In addition, Defendants' have also removed a limitation of the method that the synthetic hair fibers have an appearance similar to the user's hair. Surely, Defendants'

infringing method had as one purpose of the band having the appearance similar to the user's ponytail. Since Defendants' construction would add an extraneous limitation and read out a permissible way of practicing method claims 4 and 5, Defendants' construction should be rejected.

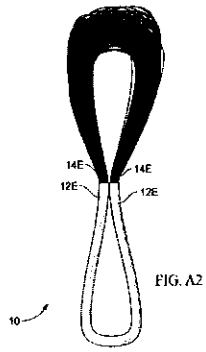

FIG. A2

Disputed Step 3: **"...the synthetic hair fiber ends joined to the elastic band ends..."**

Plaintiff's Construction	Defendants' Construction
the synthetic hair fiber ends joined to the elastic band ends	...wherein one of the elastic band ends is permanently joined with one of the synthetic hair fiber ends, and the other of the elastic band ends is permanently joined with the other of the synthetic hair fiber ends...

The claim term at issue here is whether the Defendants' construction should be allowed when it impermissibly introduces the word "permanently" into claims 4 and 5 effectively adding an extraneous limitation. Plaintiff seeks to preserve the language and scope of this step as issued. Defendants' construction must be rejected because; (i) Defendants' intrinsic evidence is irrelevant in the construction of this step because the relied upon Office Action from the United States Patent and Trademark Office and subsequent patent amendment adding the term "permanent" only refer to independent claims 1, 2 and 3 thus creating no ambiguity in terms in claims 4 and 5; (ii) Defendants' citation to the prosecution history in order to narrow claims 4 and 5 is not on point because the relied upon Office Action and subsequent claim amendment only pertains to claims 1-3 and does not demonstrate a narrowing of claims 4 or 5 that is a "clear and deliberate" and (iii) Defendants' do not satisfy their burden under the "clear and convincing" standard to demonstrate that the patent examiner who caused a narrowing of claims 1, 2 and 3 unintentionally failed to require the patentee to make a similar structural limitation for independent claim 4 and related dependent claim 5. There is nothing in

the specification or the prosecution history that applicant's or the examiner believed that the word "permanent" in any way pertained to method claims 4 and 5. In fact, the record proves the exact contrary.

Defendants' intrinsic evidence is irrelevant in the construction of Disputed Step 3 because the relied upon prosecution history adding the term "permanent" only refers to independent claims 1, 2 and 3 thus creating no ambiguity in terms for claims 4 and 5. Claim construction begins with the words of the claim itself. Intergraph at 8 (citing Teleflex, 299 F.3d 1313, 1324). Since the claim itself defines the scope of the right to exclude, "claim construction begins and ends with the actual words of the claim." Teleflex, 299 F.3d 1313, 1324. During claim construction, court must "indulge a heavy presumption that a claim term carries its ordinary and customary meaning." Intergraph at 8 (citing CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002). Defendants' cite the prosecution history in support of Defendants' construction introducing the term "permanently" in order to modify the term "joined." [Corrected Joint Claim Construction and Prehearing Statement Exhibit C]. Specifically, Defendants refer to the Response to Office Action dated October 17, 2000 which amends the '884 Patent's claims 1 and 2 to include the term "permanently." However, under the remarks section of the aforementioned response, the patentee clearly states that the patentee and the patent examiner agreed to the amendment only in relation to claims 1 and 2. Response to Office Action dated October 17, 2000 p2. Further, in the same remarks section, the patentee reflects the previous allowance of claims 4 and 5 by the patent examiner as stated in the prior Office Action dated October 4, 2000. Id. and Office Action dated October 4, 2000 p3 item 4. Therefore, while there was an intentional decision by the patentee to add the term "permanently" in claim 1 in order to allow issuance of claim 1, the patentee did not intend that the previously allowed claims 4 and 5 should also be amended to include the term "permanently." As such, there lies no ambiguity that the term "permanently" is excluded from claims 4 and 5. The dictionary definition of the word "joined", "to put or bring together," does not include a temporal requirement as to how long the "joined" state is to last. The inclusion of

the term "permanently" would superimpose an enduring temporal state of "bring together" on the term "joined," effectively adding a limitation intentionally left out by the examiner and the patentee. Adopting Defendants' construction would read in a temporal limitation intentionally absent from claims 4 and 5 in order to change the ordinary meaning of the term "joined" which is in violation of the heavy presumption that the court must afford the ordinary and customary meaning of a term.

Defendants' citation to the prosecution history is not on point because the relied upon office action and subsequent amendment does not demonstrate a narrowing of claims 4 or 5 that is "clear and deliberate." Absent arguments by the patentee during prosecution does not necessarily indicate a clear and deliberate disavowal of subject matter. Superguide Corp. v. DirecTV Enters., 358 F.3d 870,881 (Fed. Cir. 2004). Silence from the examiner or from the patentee is an improper basis on which to construe a claim. Demarini Sports v. Worth, Inc., 239 F.3d 1314, 1326 (Fed. Cir. 2001). The addition of the term "permanently" would serve to disavow subject matter in method claims 4 and 5 effectively narrowing the claims scope to only those situations where the device in the method solely used permanently joined elastic band ends and synthetic hair fiber strands. In support of this narrowing limitation, Defendants' again cite the Response to Office Action dated October 17, 2000, p 2-3. As discussed above, the patentee only intended to amend claim 1 in response to the examiner's rejection of claims 1 and 2. Id. at p2. Patentee had no need to amend already allowed claims 4 and 5. Further, with regards to claims 4 and 5, Patentee's remarks in the aforementioned response merely acknowledges the examiners previous allows of claims 4 and 5. The acknowledgement by a patentee that the examiner allowed patentee's claims can hardly qualify as a clear and deliberate disavowal of any subject matter within claims 4 and 5. Even if patentee intended to modify the scope of claims 4 and 5, the patentee failed to make arguments during prosecution history to make such a modification. Such silence on the part of the patentee is not a proper basis to narrowly construe claims 4 and 5 by adding the term "permanently." Demarini Sports, 239 F.3d 1314, 1326. Since the Defendants' proffered structural limitation is not properly

based on a clear and deliberate disavowal of subject matter by the patentee, Defendants' construction should be rejected.

Defendants' construction would violate the doctrine of claim differentiation because Defendants' introduction of the term "permanently" would read terms in claims 1-3 to be superfluous. Beyond the specific interaction among dependent and independent claims, the Federal Circuit has characterized claim differentiation to include the "presumption that each claim in a patent has a different scope." Curtiss-Wright Flow Control Corp. v. Velan, Inc., 438 F.3d 1374, 1380 (Fed. Cir. 2006) (citing Versa Corp. v. Ag-Bag Int'l Ltd., 392 F.3d 1325, 1330 (Fed. Cir. 2004). When applying claim differentiation to two *independent* claims, (i) claim differentiation applies when a claim construction would render additional language in another independent claim superfluous; and (ii) claim differentiation cannot act to broaden the claims beyond their proper scope. Curtiss-Wright Flow Corp., F.3d 1374, 1381. (emphasis added). Following these rules, Defendants' proffered construction introducing the term "permanently" into Disputed Step 3 would render the use of the word "permanently" in claims 1-3 superfluous. This contention is supported by the Office Action and the subsequent Response to the Office Action. At the time of prosecution, had the patentee and the examiner read the term "permanently" into claims 4 and 5, as Defendants' construction suggests, then the amendment to Claim 1 would have been unnecessary. Although claim 1 is an apparatus claim and claim 4 is a method claim, the device disclosed by claim 1 is similar to the device utilized in method claim 4. Further, both claims 1 and 4 utilize the term "joined" to refer to the joining of the elastic band and synthetic fiber ends. Thus, the scope of the term "joined" would be similar between claims 1 and 4 with the exception that the intentionally amended term "permanently" in claim 1 explicitly narrows the term "joined" solely for claim 1. To adopt Defendants' construction would render the intentional addition of the word "permanently" as a superfluous term and effectively declare the patentee's amendment unnecessary. However, Since Defendants' construction renders the scope of a term in another claim superfluous, Defendants' construction should be rejected.

Disputed Step 4: "...to form a closed loop..."

Plaintiff's Construction	Defendants' Construction
to take on a closed loop shape	...to form a single unbroken ring...

The claim term at issue here is whether the Defendants' substitution of the term "unbroken ring" for the term "closed loop" should be granted when doing so would read in an impermissible narrowing limitation similar to that found in Disputed Step 3. There is nothing in claim 4, the specification, or the file history of the '884 patent that suggests that the structural limitation of the band being "unbroken" should be allowed to be read into claim 4. Further, Defendant's construction attempts to add in the term "unbroken" as another veiled attempt to read in the word similar to "permanent" into claims 4 and 5, which is impermissible as discussed in the section under Disputed Step 3. The dictionary defines "unbroken" as an adjective describing something that is "uninterrupted or continuous." The American Heritage Dictionary of the English Language: Fourth Edition (2000). Additionally, the dictionary defines "ring" as a circular object. Id. The combination of these proffered terms, when read in context of the rest of the claim, would require that the band ends and the synthetic hair fiber ends form a circular object that is uninterrupted or continuous. The result would read in a narrowing limitation superimposing a temporal requirement having a similar effect to that of reading the impermissible term "permanently" into Disputed Step 3. Without support in the claim language, the specification, or the prosecution history and due to the danger of adding an impermissible temporal limitation, Defendants' claim construction attempting to introduce the term "unbroken ring" should be rejected.

Disputed Step 5: "...covering the elastic band with the synthetic hair fibers so that the outward appearance of the device is formed solely by the synthetic hair fibers..."

Plaintiff's Construction	Defendants' Construction
covering the elastic band with the synthetic hair fibers so that the outward appearance of the device is formed singly, to the exclusion of all else, by the synthetic hair fibers	...adjusting the ring so that the outward appearance of the ring is formed only by synthetic hair fibers...

The terms at issue here is whether Defendants' construction should be granted when the proffered construction adds an extraneous limiting language impermissibly narrowing the claim. As aforementioned, the language of the claim must be given its "ordinary and customary meaning." Defendants' insertion of the "adjusting" language is an impermissible narrowing of the claim which reads in a limitation that the method requires adjusting the band in order for the method to achieve its end result. The literal reading of the claim and Plaintiff's construction read in light of the claim itself, the method, specifically indicate that synthetic hair fibers are adjusted independently from the elastic bands in order to create the intended result of the claimed method. *Patent* 3:15-20; 4:25-27. The exact same adjustment is identical in the Defendants' infringing method. To allow Defendants' construction which requires the adjustment of the band where the ordinary meaning of the claim itself requires the covering of the band by the synthetic hair fiber would be an impermissible modification to the scope of claim. As such, Defendant's construction must be rejected.

Plaintiff's construction serves to add clarifying language without modifying the scope of the claim. The term "singly, to the exclusion of all else" merely stems from the ordinary meaning of the word "solely." Merriam-Webster's Online Dictionary, (2008). Further, since claims 4 and 5 disclose a "doubling up" of the device, Plaintiff's construction aids in the practice of claims 4 and 5 by teaching that the "covering" of the elastic band by the synthetic fibers occurs in a way allowing the outward appearance of the device to be formed by the synthetic fibers "to the exclusion of all." As such, other non-synthetic fiber portions of the device, including those portions resulting from the "doubling up" of the device in claim 4 and the repeated doubling up as disclosed in claim 5, must be excluded from the device's outward appearance when practicing methods 4 and 5. *Patent* 4:24 and 4:30. Since Plaintiff's construction preserves the ordinary meaning of the term "solely" while aiding in the practice of claims 4 and 5, Plaintiff's construction should be granted.

Disputed Step 6: "...encircling the ponytail with the device by inserting the ponytail through the closed loop of said device..." (note: requested for review by Plaintiff

only)

Plaintiff's Construction	Defendants' Construction
…encircling the ponytail with the device by inserting the ponytail through the closed loop of said device…	…inserting the ponytail end through the ring so that the ring encircles the ponytail…

The claim terms at issue here is whether Defendants' construction should be granted when such construction (i) unnecessarily reverses the order of the original claim's language; and (ii) adds the term "ring," a term not found anywhere in the patent. The organization of Defendants' construction reverses the order of the claim 4's use of the words "encircling" and "inserting." Such reversal is unnecessary and just confuses the interpretation, which is clear and unambiguous on its face, without any change. Further, as mentioned previously, adding the word "ring" adds impermissible structural language which is just an attempt to distort the clear meaning in the original language of step 5;. The Defendants' fortuitous insertion of the term "ring" is nothing more than another attempt to insert structural limitations relating back to impermissible structural language additions of the words of the terms "permanently" and "unbroken ring" which the Defendants attempt to do in disputed steps 3 and 4 as discussed above.

Plaintiff's construction seeks to preserve the language of claim 4 as it appears in the patent. The result of preserving the language of claim 4 assures that the clearly unambiguous terms of that claim is afforded their ordinary and customary meaning. Specifically, preserving the "closed loop" language prevents the addition of the impermissible narrowing limitation attempted by Defendants in Disputed Step 4. As discussed in Disputed Step 4, Defendants' inclusion of the proffered term "unbroken ring" is an attempt to add a lasting and permanent temporal limitation on the formation of the "closed loop." Since Plaintiff's construction is not a modification of the claim language but rather a clear preservation of the claim language's ordinary meaning as stated, the court should grant Plaintiff's construction in order to deny Defendants' attempt to read in another impermissible narrowing limitation.

The Design Patents should not be construed during the claim construction hearing

Plaintiff herein asserts that Design Patents 'D239 and 'D693 should not be construed during the claim construction hearing because the focus on such a hearing and relevant case law is an inappropriate methodology to determine the scope of Plaintiff's ornamental designs. Indeed, each design patent contains exactly one claim directed to the ornamental appearance of the design, a completely different focus from the spate of case law directed to ordinary and customary meaning of terms found in multiple claims of a utility patent. It is well settled that the meaning of claim terms must be determined to determine victory in an infringement suit. Markman, 517 US at 370. However, it is an open question of law as to whether a claim construction hearing and claim construction itself is appropriate for interpretation of design patents claims and figures. See Egyptian Goddess Questions Presented before the Court of Appeals for the Federal Circuit (2008). The focus in design patents is the ornamental appearance in the eyes 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 an observer, inducing him to purchase one supposing to be the other. Gorham Co. v. White, 81 U.S. 511, 528 (U.S. 1872). Currently, there is no requirement that design patents be subject to a claim construction hearing given that each design patent only has one claim to the "ornamental design and appearance as described in Figures" …, etc. See Egyptian Goddess Amicus Briefs and Questions Presented before the Court of Appeals for the Federal Circuit (2008). The "visual impression" standard of Contessa Food Products v. Conagra, 282 F.3d 1370, 1377 (Fed. Cir. 2002) (holding that he scope of the claim of a patented design "encompasses 'its visual appearance as a whole,' and in particular 'the visual impression it creates.'" and that such scope be determined as a question of claim construction), is unnecessarily rigid in its approach because that case merely reinforces previous holdings … that ornamental features cannot be excluded from the infringement analysis if such ornamental features were not excluded from the patent application. Mobile Hi-Tech Wheels v. CIA Wheel Group, 514 F. Supp.2d 1172 (C.D. Cal. 2007). Further, a claim construction analysis in

accordance with Contessa fails to apply the visual appearance as seen by the ordinary observer giving such attention as a purchaser usually gives, as mandated by the Gorham test, Gorham v. White, 81 US 511 (1871), nor does it apply the point of novelty test properly in construing the scope and meaning of the design patent. Tonytail respectfully requests that this Court, in light of the unsettled law in this area, in its discretion allow the fact finder to determine infringement after the claim has been construed by this Court at trial.

Both the ordinary observer and the point of novelty tests are factual inquiries that are undertaken by the fact finder during the infringement stage of proceedings, after the claim has been construed by the Court. Bernhardt v. Collezione, 386 F.3d 1371 (Fed. Cir. 2004). Delaying claim construction (of the 'D173 design patent) until trial is not error because the District Court has considerable latitude in determining when to resolve issues of claim construction. CytoLogix Corp. v. Ventana Medical Systems, Inc., 424 F.3d 1168, 1172 (Fed. Cir. 2005). Accordingly, The Tonytail Company respectfully requests the Court in its discretion allow the fact finder to determine infringement after the claim directed to the ornamental appearance has been construed by this Court at trial and use its discretion to interpret the scope and the meaning of the design patents as an issue at trial.

The Disputed Steps or Terms in Design Patents: 'D693 & 'D239 Plaintiff's Design Patents

Plaintiff has asserted its ornamental designs of US Design Patent D453,239 ('D239) and US Design Patent D413,693 ('D693) in its suit against Defendants. The Tonytail Company asserts that the 'D693 and 'D239 Design Patents ornamental designs are infringed by Conair and Rite Aid. It is well settled that the meaning of claim terms must be determined to determine victory in an infringement suit. Markman v. Westview Instruments, 517 US 370 (1996). Plaintiff therefore respectfully requests the court to construe design patents based on the ornamental appearance in the eyes of an ordinary observer, giving such attention as a purchaser usually gives, Gorham, 81 US at 528 and not two designs are substantially the same, if the resemblance

is such as to deceive an observer, inducing him to purchase one supposing to be the other. Gorham v. White, 81 US 511, 528.

I. D453,239 Claim Language

1. The ornamental design for a ponytail holder, as shown and described.

A. Figure 1

" ***a front view of a ponytail holder, the rear view being a mirror image of the front view*** " - The front view of the Tonytail D453,239 ponytail holder in its intended application shows a product that looks like natural hair when worn by a user, as illustrated in its product packaging and when the product itself is configured as used by a consumer. Further, the product itself is commonly mistaken by consumers and sales personnel for the Tonytail hair ponytail band when stocked in its retail location. The front view in its configuration when used, i.e. worn by a user is an ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail holder and distinctly looks like natural hair used to wrap around in the shape and location of a ponytail holder when viewed in its position to be worn by a user leaving the functional features, such as elastic bands or other joining methods, not visible to a user in the worn position. As a result, with respect to the front view of the ponytail holder, the ornamental design is constructed with a feature as claimed by patentee in its claim and related Fig. 1 such that an ordinary observer intending to purchase such a device, supposing it to be the Tonytail D453,239, if only looking at the front view in its typical configuration when used, i.e. worn by a user, would find its rear view and front view to be a mirror image, as to its ornamental aspect of looking like natural hair.

B. Figure 2

" ***a left side elevation view thereof, the right side elevation view being a mirror image of the left side view*** " - The left side elevation view of the patented design is an ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail holder and distinctly looks like natural hair used to wrap around in the shape and location of a ponytail

holder. From the left side, the view includes stranded fibers that look like natural hair, a sewn magnetic housing that hides an end of the stranded natural hair color and texture stranded fibers joined to both ends of a non-stranded elastic band end. As a result, with respect to the left side elevation view of the ponytail holder, the right side elevation view is a mirror image of such an ornamental feature as claimed by the patentee such that an observer is induced to purchase one with a substantially similar design, here an ornamental design that looks like natural hair, supposing it to be the Tonytail D453,239 if only looking at the left side elevation view because the device when configured as used, i.e. worn by a user looks substantially similar to in the eyes of an ordinary consumer, giving such attention as an ordinary consumer gives when purchasing such a design, since functional features, such as a magnetic pouch or elastic band, used to encircle the design, will be overlapping and will appear substantially the same to the consumer. The same analysis can be applied to a right side elevation view because the right side elevation view is a mirror image in the D453,239. The patented ponytail holder design includes an ornamental appearance with natural hair colored and textured stranded fibers, affixed to a functional feature such as clamped housings and magnetic pouches, that hide a first and second end of the stranded natural hair color and texture stranded fibers, respectively affixed to first and second end non-stranded elastic bands or other joining means, such as via a common magnetic pouch, and the first and second stranded fiber ends and non-stranded elastic band ends form a continuous loop when joined by the first and second end of a magnetic pouch and configured as worn by a user. As a result of the ornamental appearance in its configuration when used, i.e. worn by a user, the D453,239, both the left side and right side elevation views look substantially similar to natural hair wrapped around a ponytail in the eyes of an ordinary observer. Further, the design feature directed to stranded natural hair looking fibers, affixed to clamped housings and elastic bands, forms a configuration novel with respect to the prior art, when viewed from the left side or right side elevation of previous devices, and is therefore a point of novelty of the patented design as well.

C. Figure 3

" ***a top plan view thereof*** " - The top plan view of the Tonytail D453,239 ponytail holder is directed to the ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail holder and distinctly looks like natural hair used to wrap around in the shape and location of a ponytail holder. From the top, the view includes stranded fibers that look like natural hair and the functional feature, clamped housing that hides an end of the stranded natural hair color and texture stranded fibers which is joined to an end of a non-stranded elastic band end are not visible unless the top view is a perspective view and further hides the common magnetic pouch or elastic band where a first and second end of stranded fibers are joined. As a result, with respect to the top plan view of the ponytail holder in its typical consumer application configuration as used, the ornamental feature as claimed by patentee is directed to an ornamental appearance such that an observer who purchases a ponytail holder, supposes it to be the Tonytail D453,239 if only looking at the top plan view in its typical consumer application configuration, when giving it the attention as a purchaser usually gives.

D. Figure 4

" ***a bottom plan view thereof*** " - The bottom plan view of the Tonytail D453,239 ponytail holder in its intended application shows a product that looks the same as illustrated in its product packaging and when the product itself is configured as used by a consumer even though this view might also reveal the magnetic pouch alongside the elastic band when configured in a typical consumer application because such items are functional features and not directed to the ornamental design. However, the product is rarely viewed from the bottom by the consumer as evidenced by typcial consumer packaging found on such products, and when giving such attention as a purchaser usually gives such a product. The bottom plan view of the patented device is therefore an ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail holder and distinctly looks like natural hair used to wrap around in the shape and location of a ponytail holder. From the bottom, the view includes first the functional, elastic non-stranded fibers, then the functional magnetic pouch housing and the ornamental, stranded fibers that look like natural hair. As a result, with respect to the bottom

plan view of the ponytail holder, the patented device is constructed to highlight the ornamental feature as claimed by patentee such that an observer is induced to purchase such a product supposing it to be the Tonytail D453,239 if only looking at the bottom plan view. Further, the design feature directed to stranded natural hair looking fibers, affixed to clamped housings and elastic bands, forms a configuration novel when viewed from the bottom with respect to the prior art and is therefore a point of novelty of the patented design as well.

The portions of the band and ponytail holder that are not shown in the drawings are not being claimed.

II. D413,693 Claim Language

1. The ornamental design for a hair ponytail band, as shown and described.

A. Figure 1

" ***a diagrammatic perspective view of the hair ponytail band in full lines*" -** the natural head shown in broken lines being for illustrative purposes only and forming no part of the claimed invention. The perspective view of the accused device is an ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail and distinctly looks like natural hair used to wrap around an actual ponytail.

B. Figure 2

" ***a top plan view of the hair ponytail band*" -** The bottom plan view of the Tonytail D453,239 ponytail holder in its intended application shows a product that looks the same as illustrated in its product packaging and when the product itself is configured as used by a consumer even though this view might also reveal the magnetic pouch alongside the elastic band when configured in a typical consumer application because such items are functional features and not directed to the ornamental design. However, the product is rarely viewed from the bottom by the consumer as evidenced by typcial consumer packaging found on such products, and when giving such attention as a purchaser usually gives such a product. The bottom plan view of the patented device is therefore an ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail holder and distinctly looks like natural hair used to wrap

around in the shape and location of a ponytail holder. From the bottom, the view includes first the functional, elastic non-stranded fibers, then the functional magnetic pouch housing and the ornamental, stranded fibers that look like natural hair. As a result, with respect to the bottom plan view of the ponytail holder, the patented device is constructed to highlight the ornamental feature as claimed by patentee such that an observer is induced to purchase such a product supposing it to be the Tonytail D453,239 if only looking at the bottom plan view. Further, the design feature directed to stranded natural hair looking fibers, affixed to clamped housings and elastic bands, forms a configuration novel when viewed from the bottom with respect to the prior art and is therefore a point of novelty of the patented design as well.

C. Figure 3

" ***a right side elevation view*** " - the left side view being a mirror image of the right side view. The left side elevation view of the patented design is an ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail holder and distinctly looks like natural hair used to wrap around in the shape and location of a ponytail holder. From the left side, the view includes stranded fibers that look like natural hair, a sewn magnetic housing that hides an end of the stranded natural hair color and texture stranded fibers joined to both ends of a non-stranded elastic band end. As a result, with respect to the left side elevation view of the ponytail holder, the right side elevation view is a mirror image of such an ornamental feature as claimed by the patentee such that an observer is induced to purchase one with a substantially similar design, here an ornamental design that looks like natural hair, supposing it to be the Tonytail D453,239 if only looking at the left side elevation view because the device when configured as used, i.e. worn by a user looks substantially similar to in the eyes of an ordinary consumer, giving such attention as an ordinary consumer gives when purchasing such a design, since functional features, such as a magnetic pouch or elastic band, used to encircle the design, will be overlapping and will appear substantially the same to the consumer. The same analysis can be applied to a right side elevation view because the right side elevation view is a mirror image in the D453,239. The patented ponytail holder design

includes an ornamental appearance with natural hair colored and textured stranded fibers, affixed to a functional feature such as clamped housings and magnetic pouches, that hide a first and second end of the stranded natural hair color and texture stranded fibers, respectively affixed to first and second end non-stranded elastic bands or other joining means, such as via a common magnetic pouch, and the first and second stranded fiber ends and non-stranded elastic band ends form a continuous loop when joined by the first and second end of a magnetic pouch and configured as worn by a user. As a result of the ornamental appearance in its configuration when used, i.e. worn by a user, the D453,239, both the left side and right side elevation views look substantially similar to natural hair wrapped around a ponytail in the eyes of an ordinary observer. Further, the design feature directed to stranded natural hair looking fibers, affixed to clamped housings and elastic bands, forms a configuration novel with respect to the prior art, when viewed from the left side or right side elevation of previous devices, and is therefore a point of novelty of the patented design as well.

D. Figure 4

" ***a front elevation view*** " - the rear elevation view being a mirror image of the front view. The front view of the Tonytail D453,239 ponytail holder in its intended application shows a product that looks like natural hair when worn by a user, as illustrated in its product packaging and when the product itself is configured as used by a consumer. Further, the product itself is commonly mistaken by consumers and sales personnel for the Tonytail hair ponytail band when stocked in its retail location. The front view in its configuration when used, i.e. worn by a user is an ornamental feature because it is designed to 'look' like it blends into the natural hair of a ponytail holder and distinctly looks like natural hair used to wrap around in the shape and location of a ponytail holder when viewed in its position to be worn by a user leaving the functional features, such as elastic bands or other joining methods, not visible to a user in the worn position. As a result, with respect to the front view of the ponytail holder, the ornamental design is constructed with a feature as claimed by patentee in its claim and related Fig. 1 such that an ordinary observer intending to purchase such a device, supposing it to be the Tonytail

D453,239, if only looking at the front view in its typical configuration when used, i.e. worn by a user, would find its rear view and front view to be a mirror image, as to its ornamental aspect of looking like natural hair.

The portions of the band and the ponytail holder that are not shown in the drawings are not being claimed.

V. CONCLUSION

With regard to the '884 patent, Defendants' attempt to add structural limitations to the disputed claim steps as set forth above is not legally supportable and there is no language found in the patent, the file history or the plain language of method claims 4 and 5 that would even suggest such structural limitations can be read into method claims 4 and 5. Plaintiffs believe, as evidenced by its Motion to Dismiss claims 1-3 from this case because of lack of any controversy over those claims, that since claims 1-3 should not even be in this case, there is no basis for any of the structural limitations Defendants are urging this Court to read into method claims 4 and 5. Furthermore, even if claims 1-3 were in this case, the law is clear that it is impermissible to read structural limitations from descriptions of an embodiment of a device from the specification into the method claims 4 and 5, which are the only claims at issue.

With regard to the design patents ('D239 and 'D693), Defendants' request to construe the design patent claims during the claim construction hearing is currently an open question of law. Being such, the court should exercise its discretion to construe the scope and meaning of the claims directed to the ornamental appearance during trial.

Dated: May 9, 2008

MATLOCK LAW GROUP, PC

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