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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 REPLY IN OPPOSITION TO DEFENDANTS' CONAIR CORPORATION'S AND RITE AID HDGTRS CORP.'S RESPONSE BRIEF

Date: May 28, 2008
Time: 1:30 p.m.
Dept.: Courtroom 9, 19th Floor
Judge: Honorable William H. Alsup

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I. INTRODUCTION

The weight of the intrinsic record in this case does not support Defendants' constructions. Defendants Conair and Rite Aid's Response to Plaintiff's Opening Claim Construction Brief ("Defendants' Response Brief") is a continuation of Defendants' attempt to add extraneous limitations to claims 4-5 contrary to the ordinary meanings and context of the claims, the specification and the prosecution history. Defendants ignore rules regarding claim context, differentiation, and disavowal. Instead, Defendants (i) misinterpret patent examiner and patentee language in order to add limitations based on elements not referenced during prosecution; (ii) force a strained reading of the specification in order to add limitations; (iii) rely on out of context readings of patent sections; (iv) argue that two clearly different terms are the same term; and (v) provide constructions contrary to the actual practice of the device. This misguided approach fills the three main arguments forming Defendants' position.

Defendants' first main argument is the erroneous idea that the '884 Patent disclosed only a single embodiment. The Defendants often cite rules based on cases where there is only a single embodiment but fail to demonstrate how the '884 patent is a single embodiment case. In an attempt to improperly narrow the scope of claims 4-5, Defendants heavily focus on one section of the specification. [*See* Defendants Opening Claim Construction Brief ("Defendants Opening Brief") at 12, 14, 19, and 20) and "Defendants' Response Brief" at 5, 6, 12, 14, 16, and 17.] Relying on this focused approached, Defendants virtually ignore the remaining sections of the patent, including the Summary of the Invention section. Additionally, Defendants employ the same approach when reading the prosecution history. By focusing on "permanently" in claim 1, Defendants ignore the relevant prosecution history: claims 4-5 were allowed first and claim 1 was subsequently amended to add "permanently" only for claim 1.

Defendants' second main argument is the exclusion of an element found in one of the claims of U.S. Patent No. 5,899,211 ("the Brown '211 Patent"). Specifically, Defendants argue that the unattached synthetic hair fiber end of the Brown '211 Patent cannot be in the '884 Patent. However, nowhere in the prosecution history is that element referenced. Instead, Defendants employ a strained reading of the '884 Patent's Background section referring to the

entire Brown '211 device to argue for a disavowal of the unattached synthetic hair fiber element in that device. This runs contrary to the clear and deliberate disavowal requirement.

Defendant's third main argument is Defendants insistence to import "permanently" from claim 1 to claim 4. Defendants' attempt to do so directly by adding the term in their proposed construction and indirectly by offering the term "unbroken ring." However, these constructions ignore the aforementioned prosecution history. Further, Defendants fail to satisfactorily address the doctrines of claim disavowal and claim differentiation as roadblocks to Defendants' construction. Instead, Defendants insist that the Court read two clearly different terms, "joined" and "permanently joined," as being the same term. Given the fundamental flaws of Defendants' core arguments, Defendants' constructions and arguments in response to Plaintiff's constructions should be rejected.

With regard to U.S. Patent No. D453,239 ("the 'D239 Patent") and D413,693 ("the D693 Patent") (collectively the "Design Patents"), Plaintiff respectfully reminds the Court that the parties did not agree to construe two whole design patents at this time. Additionally, as demonstrated below, whether or not the Court is required to construe the Design Patents during the claim construction hearing is an open question of law. Defendants' own Markman-like request for a written description exemplifies the confusion between utility and design patent constructions. On the other hand, the Court has considerable latitude to construe the Design Patents during trial. Given the unique differences between utility and design patent methodologies, the Design Patents should be addressed during trial.

II. ARGUMENT

A. The court can find that an element of a claim found in the Brown '211 Patent is also found in the '884 Patent without finding that the device disclosed in the Brown '211 Patent reads on the '884 Patent.

Defendants' argument confuses elements of a device with the entire device. In anticipation of their non-infringement argument, the Defendants conclude that the synthetic fiber ends must be permanently joined to the elastic band ends. In support, Defendants argue that an element in the Brown '211 patent (the unattached synthetic fiber end) should not be read into the '884 Patent. *See* Defendants' Response Brief p3.

Defendants' argument confuses an element not discussed in the prosecution history (the unattached synthetic fiber end) with the entire device disclosed in the Brown '211 Patent. Defendants point to language in the Background section of the '884 Patent that describe the Brown '211 device as not being suitable for the purposes of the '884 patent. Id. at p3. Defendants also state that prosecution history supports the prior citation to the Brown '211 device as demonstrating a disavowal of the unattached synthetic fiber end element in the Brown '211 patent. However, the reference to the Brown '211 patent in the Background section concerns the device as a whole. Further, the '884 Patent's prosecution history discusses only an element of Brown: the synthetic hair fibers' appearance. Specifically, the Patent Examiner in '884 referenced the Brown '211 Patent's element "synthetic hair fibers" for the "purpose of having a natural look" into the Naidor '119 Patent (U.S. Patent No. 2,567,119). [*See* Declaration of Anne-Leith Matlock in Support of Plaintiff's Response to Defendants' Opening Brief ("Matlock Decl.") Exhibit C.] Additionally, this reference is reflected in patentee's response and amendment. [*See* Matlock Decl. Exhibit D. (patent reflects examiner's rejection in light of "Naidor in view of Brown.")] Therefore, the prosecution history cites the Brown '211 Patent for an element's (the synthetic hair fibers) feature (having a natural look). Consequently, absent is any mention of the synthetic hair fibers having an end that is unattached. Defendants cannot argue that a person ordinarily skilled in the art would read the prosecution history's reference to the natural look of the fibers in Brown '211 as meaning that a synthetic hair fiber end cannot be attached. However, Defendants' argument confuses this unmentioned element as being the same as the whole device and as a different element discussed during prosecution. Consequently, Defendants' construction (an elastic band being "attached to only one end of a length of synthetic hair") is unsubstantiated under the claims, the specification, or the prosecution history. Thus, Defendants' construction cannot operate as a clear disavowal. As a result, the Defendants' construction cannot stand.

B. The sum total of Defendants' proposed constructions is designed to improperly narrow claims 4-5 to the use of a permanently formed ring despite language to the contrary contained in the claims, the specification and in the prosecution history.

Defendants want to add an extraneous limitation to the '884 Patent by requesting a

construction of the terms "joined" and "closed loop" to effectively mean "permanently joined" and permanently closed loop ("unbroken ring"). In support, the Defendants' mischaracterize the term "permanently joined" as being the "most fundamental description" of the invention. Defendants' Response Brief at p4. Further, Defendants seek to read "permanently" into the term "closed loop" by proposing the unsupported construction "unbroken ring." Id. at 4, 6. However, Plaintiff's construction preserves the unambiguous language of claims 4-5. Specifically, the term "permanently" is clearly absent in claims 4-5, the invention's descriptions, and in the prosecution history concerning claims 4-5. Further, despite Defendants' citation to Figs. 1 and 2 of the '884 patent (Id at 4, 5.), the '884 device does not permanently maintain a perfect circular loop shape. Figs. 3 and 4 of the '884 patent demonstrate that the closed loop joins the synthetic fiber ends and elastic band ends at the base of the ponytail in order for the device to undergo "tensioning", and "doubling up." Matlock Decl. Exhibit A 4:24. Therefore, the 884 Patent's figures, language and prosecution history show that "joined" and "closed loop" are not limited to Defendants' narrow construction.

Faced with the clear exclusion of the termed "permanently" in claims 4-5, Defendants rely on DSU Medical Corp. v. JMC Co., Ltd., 471 F.3d 1293 (Fed. Cir. 2006). Defendants' Response Brief p5. Defendants use this case to argue that the patentee "envisioned" a concept allowing "permanently" to limit claims 4-5 contrary to the weight of intrinsic evidence. Id. Specifically, Defendants attempt to analogize DSU Med. Corp. to the current case concluding that the '884 Patent's reference to "fused" in the preferred embodiment conveys the concept "permanently joined." Id. at 5, 6. Defendants' strained analogy is misguided. In DSU Med., the issue was whether the term "slidably enclosing" included the "needle assembly" of a device designed to reduce needle-stick injuries. DSU Med. Corp., at 1297, 1300. The Court found that (i) express recitations of the needle being part of the assembly; (ii) the invention's context suggested a constant needle covering; (iii) specification language emphasized a locked or molded needle enclosure; and (iv) the patent figures demonstrated a permanent needle housing all combine to convey the concept of a permanent cover for the needle. Id.

Unlike in DSU Med., the context of Defendants' citation of the term "fused" indicate

that the synthetic fiber ends need not be "fused directly" to the elastic band ends but rather may utilize connectors. Matlock Decl. Exhibit A 2:52-54. Further, unlike the figures in DSU Med. Corp, Fig. 2 of the '884 patent demonstrates that the synthetic fiber ends and the elastic bands are not directly fused together. Id. Fig. 2. Finally, unlike the subject claim's express recitation that the assembly include the needle in DSU Med. Corp., only unasserted claim 1 of the '884 patent uses the term "permanently joined" whereas asserted claim 4 explicitly uses the word "joined" without any similar modification. Given these important distinguishing factors, Defendants' arguments based on DSU Med. Corp. fails in supporting Defendants' proposed construction.

Despite the differences between the present case and DSU Med. Corp., Defendants again attempt to import "permanently" by proposing the construction "unbroken ring." Specifically, Defendants rely on the single use of the term "continuous" in the Preferred Embodiment section. Defendants Response Brief at 6. Defendants' focus on this term runs contrary to intrinsic evidence. First, as previously discussed, Defendants err by focusing on the preferred embodiment when the specification and claims discloses a broader embodiment. [Plaintiff's Response Brief to Defendants' Opening ("Plaintiff's Response Brief") at 1-6, 17.] Second, the Defendants' own dictionary definition of "continuous" includes "uninterrupted in time." Declaration of Thomas F. Fitzpatrick in Support of Defendants' Brief Exhibit G. This temporal limitation does not appear with claim 4 anywhere in the intrinsic record. Finally, replacing the term "closed" with Defendants' term "unbroken" runs contrary to the repeated use of "closed" to modify "loop" throughout the claims and specification. Matlock Decl. Exhibit A 1:56, 58, 59; 2:32, 55, 61. Thus, "unbroken ring" (importing the same narrowing limitation as "permanently") to claims 4-5 is unsupported by the weight of intrinsic evidence.

C. The '884 Patent describes more than one embodiment.

Defendants argue that the '884 Patent only disclosed one embodiment and cites two paragraphs from the '884 specification in support. Defendants Response Brief p6. However, Defendants cited language from the specification discloses two different embodiments. Defendants' first cite the Summary of the Invention section of the '884 Patent whereas the

second citation refers to the Preferred Embodiments section. Id. at p 6, 7. The Preferred Embodiments section explicitly uses the term "permanently" while the same term is notably absent from the Summary of the Invention section. Id. Thus, the language Defendants' cite from the Summary of the Invention section contemplates a broader embodiment than that found in the Defendants' other cited language. Further, clear distinctions in the intrinsic evidence disclose other embodiments: (i) claim 4 lacks the "permanently" limitation found in claim 1; and (ii) Figure 3 of '884 patent discloses a joining of all the ends (elastic and fiber ends) where as Figure 1 demonstrates a state prior to such joining. Nevertheless, Defendants' seek to inject terms found in one part of the patent to other terms that clearly excludes them. In support of this approach, Defendants argue 35 U.S.C. § 112's written description and enablement requirements are not satisfied by embodiments not found in Defendants' cited language from the specification. Id. at 7. However, as demonstrated, Defendants' two cited excerpts contemplate two different embodiments: one with the "permanently" limitation and one without. With the differences in these embodiments and the differences in claim 4 and claim 1 as indicated above, Defendants fail to explain how one ordinarily skilled in the art would not understand how to make and use either of the embodiments described in Defendants' excerpts.

In forcing their single embodiment analysis to the '884 patent, Defendants' summarily dismisses the Federal Circuit's ruling in Gemstar-TV Guide Int'l Inc., v. Int'l Trade Comm., 383 F.3d 1352. Id at 7. Other than providing two excerpts from the '884 patent and inappropriately concluding that the excerpts disclose only one embodiment, Defendants fail to demonstrate how Gemstar is inapplicable. Instead, Defendants' cites cases where only a single embodiment is disclosed. Id. at 8. However, these cases are distinguishable from the present case. Representative of these cases is Defendants' cite to Wang Labs., Inc. v. Am. Online, Inc., 197 F.3d 1377, 1382-83 (Fed. Cir. 1999). As previously discussed (*see* Plaintiff's Response Brief p4), Wang Labs is distinguishable because the Federal Circuit found that a narrowing definition was "typically" used to reference the questioned term. Wang Labs at 1381. Here, the use of the term "permanently" is atypical as demonstrated by the abovementioned selective use (or lack of use) throughout the intrinsic record. Instead, Gemstar's rule, as cited by the

Defendants (Defendants' Response Brief p7) applies: that claims should not be limited to a preferred embodiment. Gemstar at 1366. Since Defendants' ignore the clear distinction in language of their cited excerpts and improperly narrow claims to one embodiment contrary to Gemstar, Defendants' single embodiment argument and related constructions cannot stand.

D. Plaintiff's Extrinsic Evidence

1. Plaintiff's illustrative aids are admissible.

Plaintiff's illustrative aids found in Attachment 5 of Plaintiff's Opening Brief were obtained during the course of discovery and are admissible pursuant to section 9 of Exhibit E to the parties Corrected Joint Claim Construction and Prehearing Statement.

2. The differences in definitions among Plaintiff's 2008 dictionary definitions and prior definitions are immaterial and do not materially affect Plaintiff's arguments.

"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 v. AWH Corp., 415 F.3d at 1303, 1322 (Fed Cir. 2005). Defendants' attempt to exclude the cited 2008 dictionary definitions only serves to distract from the merits of the case. Defendants do not demonstrate how the definitions of common and ordinary words like "band" and "solely" are different from their meanings eight years ago. In fact, a comparison of the 2008 definitions with prior definitions, including definitions from Defendants' own cited dictionary, demonstrate no material changes among definitions. *See* Declaration of Anne-Leith Matlock in Support of Plaintiff's Reply Brief Exhibit A. As such, Plaintiff's arguments are not materially affected. Further, pursuant to Defendants' Response Brief, Plaintiff's citation to "cord" and "solely" are no longer contested by the Defendants. (*See* Defendants' Response Brief at p11, 17.) Additionally, Plaintiff's arguments utilize Defendants' own dictionary definitions of "unbroken," "ring," and "continuous" to support Plaintiff's arguments. (*See* Plaintiff's Opening Brief at 16 and Plaintiff's Response Brief at 17.) Finally, as directed by Phillips, Plaintiff's arguments are not solely based on dictionary definitions. Rather, Plaintiffs consistently support their arguments with the language and context of the claims, the specification, and the prosecution history.

E. Plaintiff's construction takes into account the ordinary and customary meaning as

a person having the ordinary skill in the art would understand the meaning in context of the claims, specification and prosecution history.

Plaintiff's construction preserves unambiguous claim language while teaching the intended practice of claims 4-5. In so doing, the Plaintiff's construction is heavily supported by intrinsic evidence, particularly, (i) the language differences between claims 4 and 1; (ii) the language differences found throughout the specification; and (iii) the differences in terms as demonstrated by the prosecution history. As follows, emerging from the face of these differences are the clear ordinary and customary meaning of the terms, as a person ordinarily skilled in the art would understand these terms: such as "joined" and "permanently joined" having different meanings.

1. **The term "elastic band" cannot be construed to include the narrow term "not joined to one another."**

Defendants argument against Plaintiff's construction of Disputed Step 1 is based on the idea that the '884 device cannot encircle a ponytail if only a portion of the device performs the encircling. Defendants Response Brief p11. Defendants rely on this argument to support their construction that the elastic band ends cannot be joined. Id. Defendants are incorrect. As previously discussed herein (at p4), the '884 device does not permanently maintain a perfect circular loop shape during "tensioning" and "doubling up." *See* Matlock Decl. Exhibit A 4:22-24, Figs. 3 and 4. Further, the resulting loop caused by the "tensioning" and "doubling up" is later covered by the synthetic fibers. Id. at 4:26-28. Therefore, the encircling by the device is done by the elastic band portion of the device. Since Defendants' position (that a device cannot encircle unless the whole device enircles) is unsupported by a reading of the entire claim, Defendants' construction must fail. However, since the elastic band ends join to perform the abovementioned encircling, Plaintiff's construction which reflects this feature must stand.

In support of Defendants' argument, Defendants reiterate their position that the specification only discloses one embodiment. Defendants' Response Brief at p11. Further, Defendants use their single embodiment position to argue that Plaintiff's construction ("serve to join together and encircle") would render the claim invalid for lack of written description and enablement. In support, Defendants again point to language in the Preferred Embodiment section. However, as previously discussed herein (at p5), the weight of intrinsic evidence

demonstrates that the specification discloses more than one embodiment.

Without accounting for the disclosed embodiments, Defendants use their own finding of a single embodiment in conjunction with the Federal Circuit's statement in LizardTech, Inc. v. Earth Res. Mapping, Inc., 433 F.3d 1373, 1375 (Fed. Cir. 2006). *See* Defendants' Response Brief p13. Notwithstanding the arguable position whether LizardTech dealt with principles of claim construction or with the written description doctrine [see Id. at 1377, dissent discussing the differences between seemingly contradictory rulings found in LizardTech, Inc. v. Earth Res. Mapping, Inc., 424 F.3d 1336 (Fed. Cir 2005) and JVW Enterprises, Inc. v. Interact Accessories, 424 F.3d 1324 (Fed. Cir. 2005)], Defendants citation to LizardTech does not apply in this case. Defendants' citation refers to a single embodiment. Defendants' Response Brief p 13. However, as previously discussed by Plaintiff (*See* Plaintiff's Response Brief at 4-5), the intrinsic evidence demonstrates a whole host of distinguishable factors from the line of single embodiment cases utilized by the Defendants because the intrinsic evidence shows: (i) a broader embodiment disclosed as "the invention" in the Summary of the Invention section; (ii) the term "permanently" not being typically used in describing the invention; (iii) the patentee's express statement that "permanently" only applies to claim 1; (iv) absence of any language explaining the "permanent" attachment as being a "very important feature" of the invention; and (v) the different embodiments disclosed by the actual practice of claims 4-5. Since LizardTech does not apply because the '884 patent discloses more than one embodiment, claims 4-5 cannot be limited to the embodiment taught by the Defendants' construction.

2. The term "synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends" does not mean that the two ends are not joined together.

Defendants import much of their erroneous arguments from the elastic band term into the synthetic hair fiber term. Specifically, Defendants argue that the '884 Patent does not disclose a joining of the synthetic hair fiber ends as depicted in the patent's figures. However, as previously discussed herein (at p5), the '884 Patent discloses more than one embodiment which includes the embodiment required to "tension" and "double up" the device. *See* Matlock Decl. Exhibit A 1:58; 2:64; and 4:24. This embodiment requires a joining of all the ends

(elastic band and synthetic fiber ends) as depicted in the '884 Patent Fig. 3. Id. at Fig. 3. As a result of the actual language and depictions disclosed in the '884 Patent, this claim term cannot be limited to where the synthetic hair ends join to one another without contradicting the intended use of claims 4-5.

3. Patentee's own words in the intrinsic record do not amount to a clear disavowal of the claim scope as argued for in Defendants' construction adding the limitation "permanently."

As previously cited, a patentee's silence during prosecution does not 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). Defendants' addition of the word "permanently" into claims 4-5 ignores these claim construction rules. Defendants attempt to utilize the '884 Patent and the prosecution history in order to create a disavowal where the patentee was actually silent. Despite Defendants' statement that "permanently" was used during prosecution, such was only in reference to claim 1. Both examiner and patentee's statements reflect the explicit use of the term "permanently" with only claim 1 whereas claims 4-5 explicitly were allowed absent that term. *See* Matlock Decl. Exhibit C and D. Further, Defendants mischaracterize the connections show in the '884 Patent as being "fused." As previously discussed herein (at p.4), the word "fused" was used to describe one preferred embodiment and within that embodiment, the ends (elastic and synthetic hair fiber) need not be directly "fused" together but may use connectors. *See* Matlock Decl. Exhibit A 2:53-54. Thus, there is no clear disavowal allowing "permanently" to be added to claims 4-5. As such, Plaintiff's preservation of claim 4's language "...the synthetic hair fiber ends joined to the elastic band ends..." should be granted.

As a secondary argument, Defendants propose that the prosecution history disavowed the subject matter disclosed in the Brown '211 Patent. However, as previously discussed herein (at p3), Defendants confuse the prosecution history's reference to the Brown '211 Patent. What the prosecution history demonstrates is that the natural look feature of the Brown's synthetic hair fiber was discussed in connection with the Naidor patent. (*See* Matlock

Decl. Exhibit C and D.) Absent from the prosecution history is any reference to the unattached synthetic fiber end appearing on the Brown '211 device. Id. Such silence cannot operate as a clear and deliberate disavowal of subject matter.

4. Absent a clear disavowal of claim scope, the doctrine of claim differentiation requires the rejection of Defendants' proposed construction.

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 Control Corp. v. Velan, Inc., 438 F.3d 1374, 1381 (Fed. Cir. 2006) (emphasis added). Defendants make three arguments in support of their contention that claim differentiation does not apply. First, Defendants cite Inpro II Licensing, S.A.R.L v. T-Mobile, USA, Inc., 450 F.3d 1350, 1354 (Fed. Cir. 2006) for the proposition that claim differentiation does not apply where the patent disclosed only one embodiment. Defendants' Response Brief at 15. Application of Inpro II here is misplaced. As discussed herein (at pp5-7), the entire intrinsic record discloses more than one embodiment. Further, as previously discussed by Plaintiff, Inpro II is distinguishable because (i) the '884 Patent disclosed both broad (as disclosed in the Summary of the Invention section) and narrow embodiments (as disclosed by the Preferred Embodiments section which Defendants' isolate) and (ii) nowhere in the '884 Patent specification were Defendants' limitations described as a "very important" feature. Second, Defendants cite PODS, Inc. v. Porta Stor, Inc., 484 F.3d 1359 (Fed. Cir. 2007) in support of their argument that a reasonable competitor reading the prosecution history would inject the term "permanently" from claim 1 into claim 4. However, as discussed in detail by Plaintiff, PODS is distinguishable case because the term "permanently joined" from claim 1 and "joined" from claim 4 are clearly different terms. *See* Plaintiff's Response Brief pp 12-13. Further, Defendants fail to demonstrate how a reasonable competitor reading the prosecution history where claims 4-5 were allowed using the term "join" would construe the term "permanently joined" (added to claim 1 after claims 4-5) as being the same term. Finally, Defendants cite ADT Corp. v. Lydall, Inc., 159 F.3d 534 (Fed Cir. 1998) for their argument that a person having the ordinary skill in the art would understand the "permanently joined"

structure in claim 1 as being equivalent to the "joined" structure in claim 4. Defendants' Response Brief at 16-17. Although the Defendants' characterization demonstrates a structural limitation found in one claim to limit the structure of another claim (*see* Defendants' Response Brief at 16.), Defendants fail to mention the fact that the claim explicitly stating the structural limitation, (claim 11 in ADT), was a dependent claim of claim 1 where the limitation was imported. ADT Corp. v. Lydall, Inc. at 541. In the present case, claims 1 and 4 are two independent claims. Therefore, there is a disconnect between claims 1 and 4 that was not present in ADT Corp. Defendants should not be allowed to use ADT Corp. to create a bridge between claims 1 and 4 where there is none.

5. The intrinsic evidence demonstrates that the synthetic hair fibers are adjusted independently from the remainder of the device.

The claims and the specification teach that the synthetic hair fibers cover the elastic band ends. As previously discussed, claim 4 teaches that the synthetic hair fibers are adjusted around the stretchable elastic band. (*See* Plaintiff's Response Brief at p20.) Further, Plaintiff's demonstrate that the specification discusses the adjustment of the synthetic fibers apart from the elastic band. Id. Thus the entire device is not adjusted as Defendants suggest. Since "unbroken ring" would require the entire device to be adjusted, Defendants' construction cannot be adopted without contradicting the context of claim 4 and the specification.

6. Defendants' construction "...inserting the ponytail end through the ring so that the ring encircles the ponytail..." improperly severs the elastic band from the device and adds two extraneous limitations.

Defendants' argue that their term "unbroken ring" serves to clarify the distinction between the device as a whole and the elastic band. (*See* Defendants' Response Brief p18.) Consequently, Defendants' construction severs the band from the device. To the contrary, as previously discussed (at p8), the encircling of the ponytail by the device occurs via the elastic band. Further, the "tensioning" around the ponytail is preformed by the elastic band (*See* Matlock Decl. Exhibit A 1:46-49.) whereas the less stretchable synthetic hair fibers adjust independently to cover the tensioned elastic bands. Id. at 1:61-45. Further, as discussed, the terms "unbroken ring" would also add extraneous structural and temporal limitations. (*See* Plaintiff's Response Brief p16-19.) Since Defendants' construction threatens to import

extraneous limitations to claim 4, such construction should be avoided.

7. In properly exercising its considerable latitude to review the Design Patents during trial, the Court can properly apply Gorham's ordinary observer test.

As an initial matter, Design Patents 'D239 and 'D693 were not jointly proposed terms for construction by the Court. In addition to being outside the five jointly submitted terms for construction, the Design Patents should be construed during trial because design patent analysis applies a completely different focus than the traditional claim construction methodology used in utility patent cases. In fact, as Plaintiff previously discussed, whether to construe design patents during a traditional claim construction hearing is currently an open question before the Federal Circuit. (*See* Plaintiff's Response Brief p.21 discussing Egyptian Goddess Amicus Brief and Questions Presented before the Court of Appeals for the Federal Circuit (2008), as questioning claim construction hearing's role in design patent analysis.) Despite the non-existent requirement that design patents must be construed during a Markman-like hearing, Defendants offer the possibility of summary judgment in order to entice the Court to construe the Design Patents during the hearing despite that fact that (i) the parties did not jointly agree to request construction of the Design Patents at the hearing; (ii) the Court did not adopt Defendants' construction; and (iii) the Defendants have not demonstrated that their product does not infringe the Design Patents under the longstanding Gorham's ordinary observer test. Clearly, under these facts, the Defendants cannot demonstrate that a reasonable jury would find for the Defendants ....when construing these facts in a light most favorable to the Plaintiff.

Further, the ordinary observer test and the point of novelty test are factual inquires undertaken by the fact finder during the infringement stage of the proceedings, after the claim has been construed by the Court. Bernhardt v. Collezione, 386 F.3d 1371, 1383 (Fed. Cir. 2004). In Gorham, the Court considered the patent handle design and an accused handle design as shown in Matlock Decl. Exhibit I. In so doing, the Court expressly disqualified the observations of "persons in the trade." Gorham Co. v. White, 81 U.S. 511, 527 (U.S. 1872). Nothing herein makes such an analysis appropriate in a claim construction hearing which is based on the "written description" approach that Defendants advocate. For at least this reason, the Design Patents should be addressed at trial. Finally, the court has considerable latitude in

determining when to resolve issues of claim construction. Cytologix Corp. v. Ventana Med. Sys., Inc., 424 F.3d 1168, 1172 (Fed Cir. 2005). As such, the Court should allow the fact finder to determine infringement after the Court construes the ornamental features during trial.

8. Assuming the Court decides to address the Design Patents during the hearing, Defendants applied the wrong test and applied the wrong test incorrectly.

The United States Supreme Court held that the focus in design patents is (i) the ornamental appearance in the eyes of an ordinary observer, (ii) giving such attention as a purchaser usually gives, (iii) two designs are substantially the same, (iv) if the resemblance is such as to deceive an observer, (v) inducing him to purchase one supposing to be the other. Gorham Co., at 528. However, the Defendants rely on the "visual impression" standard from Contessa in requesting the Court to provide a written description of the Design Patents. Defendants' Opening Brief p21 and Defendants Response Brief p21. As stated in the Gorham rule above, Gorham has made it clear that the focus is on the eye of an ordinary observer, contrary to the written description of the visual impression Defendants request from the Court. Defendants fail to show how the rigid Contessa test complies with one hundred years of Supreme Court precedent in Gorham. Given the ordinary observer test, Defendants' request for a written description of a "visual impression" is improper at least to the extent that such request is contrary to Gorham..

Further, in applying the wrong rule, Defendants construction is a misapplication of the rule in Contessa as cited by the Defendants: "encompasses 'its visual appearance as a whole' and in particular 'the visual impression it creates.'" Defendants Opening Brief p21 citing Contessa Food Products v. Conagra, 282 F.3d 1370, 1377 (Fed. Cir. 2002). In Defendants' construction of the Design Patents, Defendants use words of assembly such as "are formed by," "connecting," "are collected together," "are inserted," and "is inserted." Defendants' Response Brief p21-22. Defendants do not show that their construction (i) satisfies the overall visual impression requirement in their rule from Contessa and (ii) does not operate as assembly language typically used to describe utility patents. It is this danger of confusion between construction of utility and design claim scopes that Defendants' use of Contessa demonstrates. To avoid this danger, the Court should properly exercise its discretion and address the Design

Patents at trial when Gorham may be properly applied.

9. Plaintiff's figure descriptions are not written descriptions of the overall visual impression but rather the proper application of the Gorham test.

Defendants argue that Plaintiff's description of each figure is unnecessary or unintelligible, however, these descriptions are proper under the Gorham test. As stated in the above Gorham rule, the ornamental appearance from the eyes of an ordinary observer is the proper focus in analyzing the Design Patent. Gorham at 528. Plaintiff's figure descriptions are not purported to be claim constructions of the visual impression of the Design Patents but rather descriptions of the ornamental appearance under Gorham. For example, Plaintiff's description of Figure 1 of the 'D239 Patent explains what an ordinary observer would see when the product is bought and applied: "looks like natural hair", "look like it blends into natural hair," "the typical configuration when used." Absent figure descriptions from the point of view of the ordinary observer, the fact finder during trial would not be in the proper position to compare the Design Patent with the accused product as required by one hundred years of Supreme Court precedent established in Gorham.

III. CONCLUSION

Defendants' take claim language out of their context in the intrinsic record resulting in improper narrow constructions. Plaintiff's proposed constructions preserves the '884 Patent language and the context of the intrinsic record. As such, the Court should reject Defendants' constructions and adopt Plaintiff's constructions. Additionally, given the unique methodology employed in design patent analysis, the Court should address the Design Patents during trial.

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