

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK**

THIRTY THREE THREADS INC.,

Plaintiff,

v.

ARGENTO SC BY SICURA INC., THE TJX  
COMPANIES, INC. AND DOES 1-10,

Defendants.

Civ. Action No. 1:18-cv-8023-JMF

**DEFENDANTS' MEMORANDUM OF LAW IN SUPPORT OF THEIR MOTION TO  
DISMISS PLAINTIFF'S AMENDED COMPLAINT**

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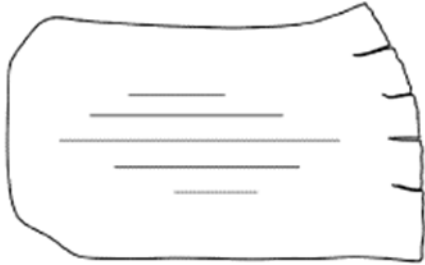

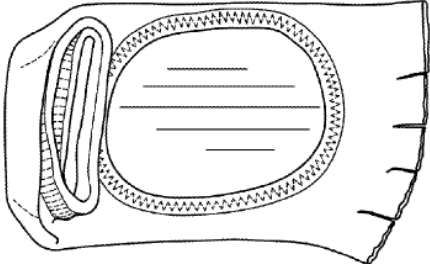

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, Defendants Argento SC by Sicura Inc. and The TJX Companies, Inc. (collectively, “Defendants”) move this Court for an Order dismissing the Amended Complaint (ECF No. 26) filed by Plaintiff Thirty Three Threads Inc. (“Plaintiff”).

## **I. INTRODUCTION**

This case involves a dispute over socks and, more specifically, partial-toe socks typically used for yoga and other types of exercises. Despite the fact that such socks were long-known, Plaintiff seeks a monopoly in selling such socks and has resorted to meritless design patent assertions in furtherance of that goal.

The scope of a design patent is extremely narrow—it is limited entirely to the ornamental features illustrated in the patent’s drawings. There can be no design patent infringement unless an ordinary observer, familiar with the prior art, would be deceived into thinking the accused product is the same as the patented design. Plaintiff cannot meet this standard because there are significant differences between the design claimed (“Claimed Design”) in U.S. Design Patent No. D707,036 (ECF No. 1-1, “the ‘036 Patent”) and the accused sock (“Argento Product”).

The Federal Circuit’s test for design patent infringement is a simple side-by-side comparison of the drawings contained in the asserted patent and photographs of the accused product. Such a comparison confirms that there is no infringement as a matter of law. For example: (1) where the Claimed Design includes a blank bottom side, the Argento Product includes an ornamental design; and (2) where the Claimed Design includes decorative stitching around the top opening, the Argento Product does not:

'036 Patent	Argento Sock
	
	

Not surprising then, Plaintiff does not assert any factual allegations sufficient to raise an inference of purported similarity between the Claimed Design and Argento Product. Instead, Plaintiff bases its infringement claim on a single, conclusory allegation that, “[u]pon information and belief, Defendants have been and are infringing the ‘036 patent within this district and elsewhere in the United States by making, using, selling, importing, distributing and/or offering for sale products that infringe one or more of the claims of the ‘036 patent.” (Amended Compl. ¶19). The Complaint should be dismissed because it fails to state a plausible claim for infringement.

**II. FACTUAL BACKGROUND**

Plaintiff filed its Amended Complaint in this Action on December 6, 2018. The one count complaint alleges infringement by the Defendants of the ‘036 Patent. Specifically, the

Amended Complaint alleges that the Defendants directly and indirectly infringe the ‘036 Patent. (Amended Compl. ¶¶19-21). The Amended Complaint further alleges that the infringement has been willful. (*Id.* at ¶25). As discussed further below, the Amended Complaint fails to state a claim for infringement, as a matter of law, and should be dismissed.

### **III. LEGAL STANDARDS**

To survive a Rule 12(b)(6) motion to dismiss, a pleading must allege “enough facts to state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). A pleading that only “offers ‘labels and conclusions’ or ‘a formulaic recitation of the elements of a cause of action will not do.’” *Id.* (quoting *Twombly*, 550 U.S. at 555).

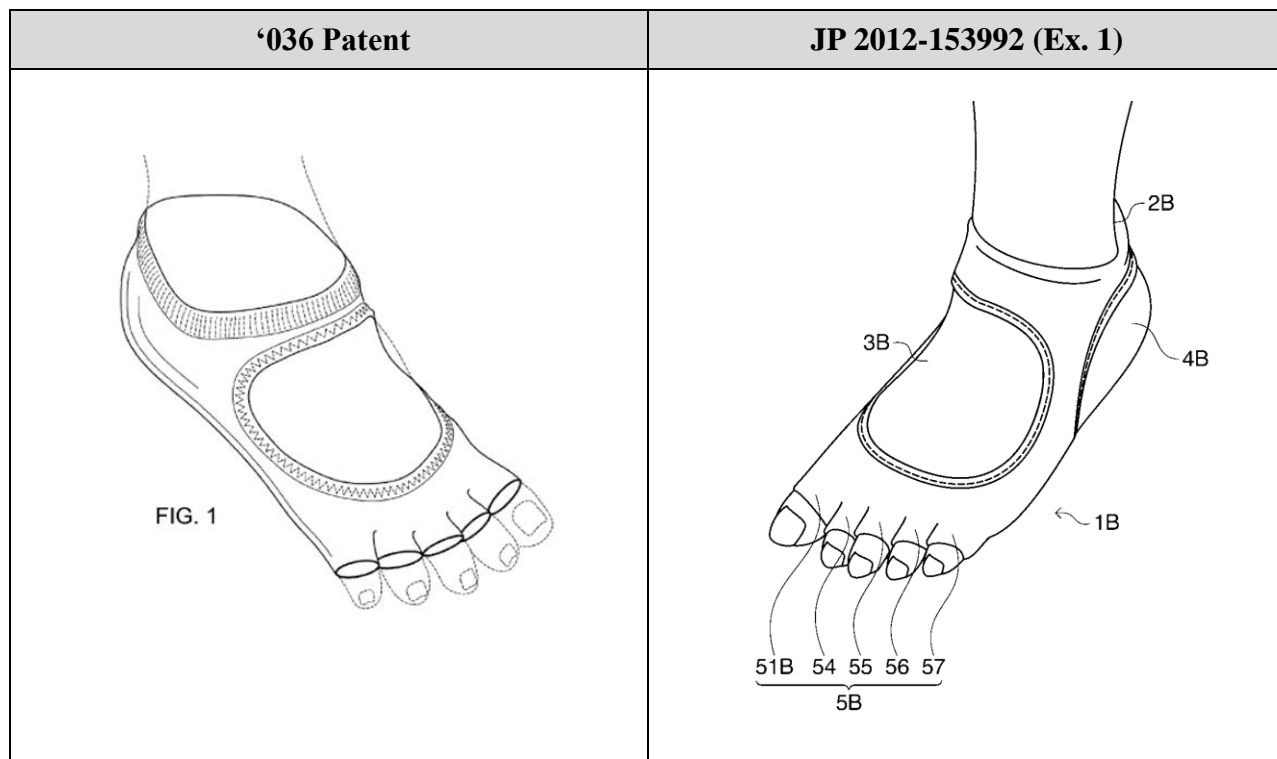
### **IV. THE AMENDED COMPLAINT FAILS TO PLEAD A PLAUSIBLE CLAIM OF DESIGN PATENT INFRINGEMENT**

#### **A. The ‘036 Patent and the Prior Art**

Plaintiff’s ‘036 Patent is directed to the sock shown in the seven figures of the patent. Specifically, the claimed sock includes, among other things: (1) partial toe coverings, i.e., five individual toe tubes that have been cut evenly with one another; and (2) an opening over the top of the instep that is surrounded by a “zig-zag” stitching pattern. A perspective view of the claimed sock is reproduced below (left). Similar socks were known in the prior art. A representative prior art sock is shown below, right.<sup>1</sup>

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<sup>1</sup> Plaintiff did not disclose any prior art to the Patent Office in connection with the application that matured into ‘036 Patent.



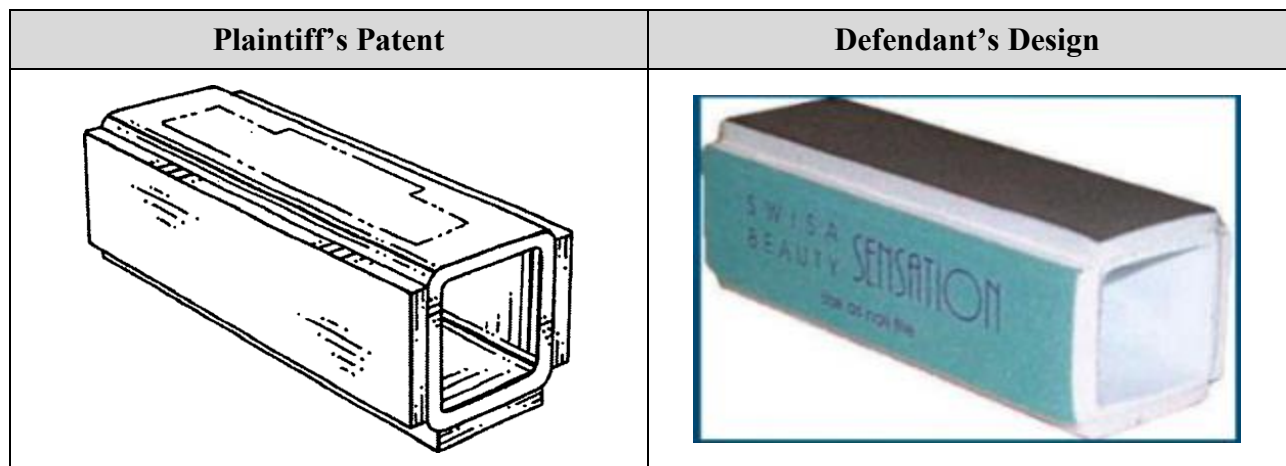
## B. The Ordinary Observer Test

A “design patent, unlike a utility patent, limits protection to the ornamental design of the article.” *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010) (citation omitted). To establish design patent infringement, Plaintiff has the burden to prove that “an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as [each of] the patented design[s].” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 672 (Fed. Cir. 2008). “In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear ‘substantially the same’ to the ordinary observer.” *Id.* (emphasis added). “It is the appearance of a design as a whole which is controlling in determining infringement. There can be no infringement based on the similarity of

specific features if the overall appearance of the designs are dissimilar.” *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997).

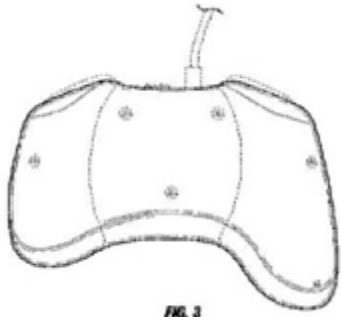

To illustrate, in *Egyptian Goddess*, the patented design consisted of a hollow rectangular tube with exposed edges and buffers on three sides, the fourth side being bare. The defendant’s nail buffer did not infringe the plaintiff’s design patent because, although it was similar in appearance, it had four buffers, one on each side. *Egyptian Goddess, Inc.*, 543 F.3d at 682-83.

The claimed design and accused nail buffer are reproduced below:



In *Performance Designed Prods. LLC v. Mad Catz, Inc.*, the court similarly dismissed the plaintiff’s claims of infringement at the pleading stage, finding that the below designs for a video game controller were “plainly dissimilar” where “[t]he underneath portion of the [claimed design] is a flat, smooth uniform surface without ridges, angles, reliefs, and protrusions while the underneath portion of the Accused Product has pronounced ridges, angles, relief and protrusions.” No. 16cv629-GPC(RBB), 2016 U.S. Dist. LEXIS 84848, at \*12 (S.D. Cal. June 29, 2016).



Plaintiff's Patent	Defendant's Design
 <p style="text-align: center;">FIG. 3</p>	

Whether two designs are plainly dissimilar is appropriate for determination on a motion to dismiss under Rule 12(b)(6). *See, e.g., Wine Enthusiast, Inc. v. Vinotemp Int'l Corp.*, No. 17cv6782(DLC), 2018 U.S. Dist. LEXIS 120734, at \*9 (S.D.N.Y. July 19, 2018); *Silverman v. Attilio Giusti Leombruni S.P.A.*, No. 15 Civ. 2260 (PAC), 2016 U.S. Dist. LEXIS 20775, at \*7 (S.D.N.Y. Feb. 19, 2016).

**C. The Amended Complaint Fails to State a Claim for Infringement of the '036 Patent**

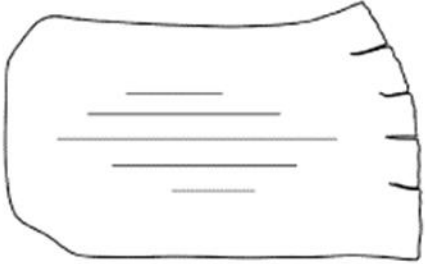

There are significant differences between the sock claimed in the '036 Patent and the Argento Product, including the: (1) design of the sock bottom; (2) design of the toe openings; and (3) stitching pattern that surrounds the opening over the instep. These differences result in a distinct overall appearance between the two designs. *See Crocs, Inc. v. ITC*, 598 F.3d 1294, 1303 (Fed. Cir. 2010) (“The ordinary observer test applies to the patented design in its entirety, as it is claimed.”).

“The design patent infringement analysis must involve a figure-by-figure review of the claimed design and comparable views of each accused product.” *Degelman Indus. v. Pro-Tech Welding & Fabrication, Inc.*, Civil Action No. 06-CV-6346, 2011 U.S. Dist. LEXIS 150187, at \*23-26 (W.D.N.Y. May 27, 2011). Here, a comparison of the figures of the '036 Patent with

comparable views of the Argento Product—which is not provided in the Amended Complaint—shows that Plaintiff cannot meet its burden of proving the two designs would appear “substantially the same” to the ordinary observer, particularly in view of the prior.

**1. The Designs of the Sock Bottoms Are Distinct**

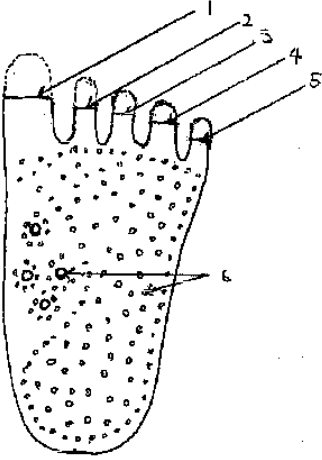
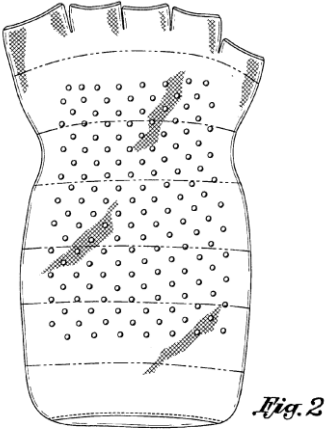
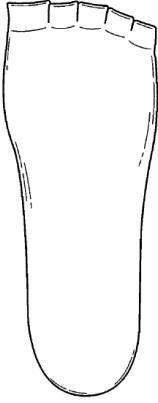
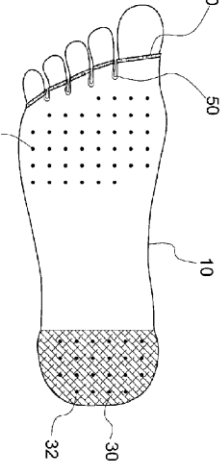
A comparison of the bottom side of the Claimed Design with that of the Argento Product establishes that Plaintiff has no viable infringement claim. As can be seen, the ‘036 Patent claims a sock with an plain bottom (below, left). In contrast, the bottom of the Argento Product contains a distinctive “dot” pattern that surrounds text (i.e., the Self® brand).

<b>‘036 Patent</b>	<b>Argento Product</b>
 <p data-bbox="474 1171 574 1209">FIG. 2</p>	

Plaintiff’s infringement claim would require that the Court completely ignore what Plaintiff has claimed in its patent, i.e., a sock with an unembellished bottom. This is contrary to the law. *See Contessa Food Prods. v. Conagra, Inc.*, 282 F.3d 1370, 1379 (Fed. Cir. 2002) (district court erred by failing to compare underside of accused tray with comparable view of claimed design); *see also Egyptian Goddess, Inc.*, 543 F.3d at 682-83 (no infringement where one side of the claimed design was bare, while the accused product had coverings on all sides); *Performance Designed Prods. LLC*, 2016 U.S. Dist. LEXIS 84848 at \*12 (dismissing design

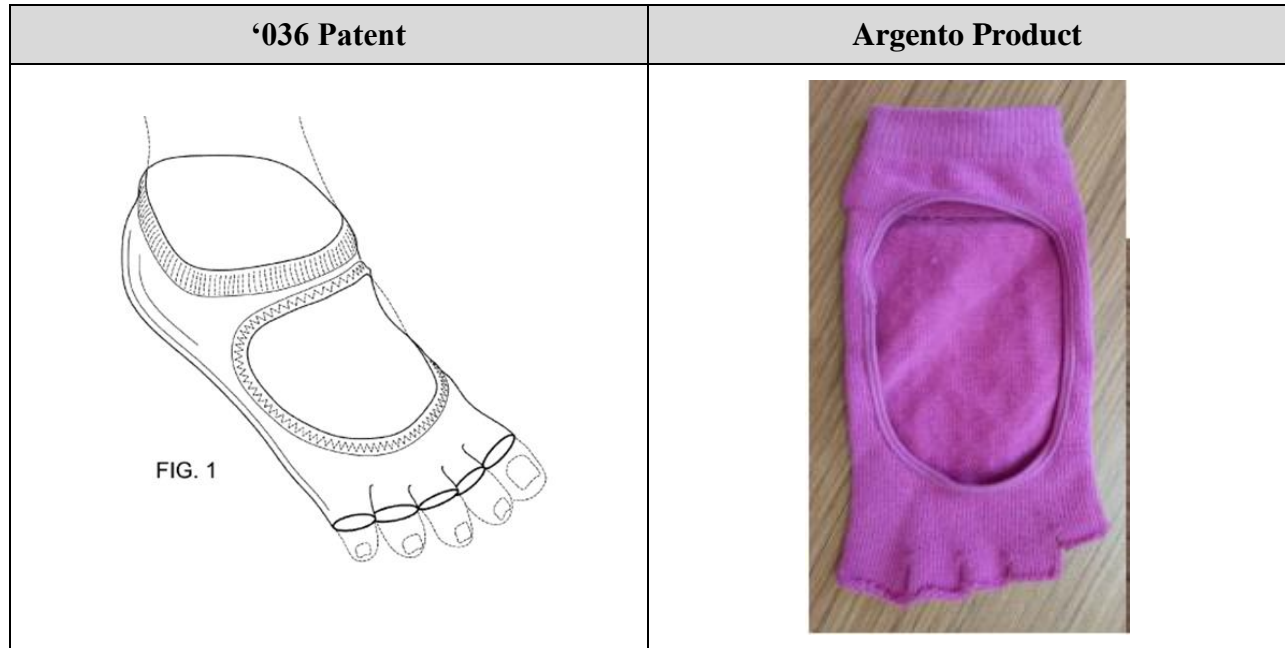
patent claim where claimed design had flat surface without protrusions while the accused product had pronounced protrusions).

In addition, in view of the prior art, the ordinary observed would readily recognize the difference between a sock having an unadorned bottom surface (i.e., the Claimed Design) versus one containing a distinct pattern (i.e., the Argento Product). A small sampling of the prior art designs is reproduced below:

JP2002-212803 (Ex. 2)	U.S. D548,951 (Ex. 3)
	
U.S. D581,654 (Ex. 4)	U.S. 2014/0298569 (Ex. 5)
	

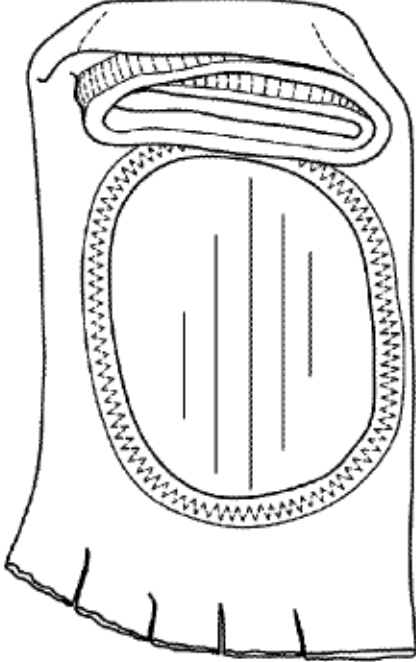

## 2. The Design of the Toe Openings is Distinct

In addition, in the Claimed Design, the toe openings line up neatly with one another. In contrast, in the Argento Product, the toe openings are stepped relative to one another, providing a distinct appearance. And here again, the prior art above (which includes socks having a wide variety of toe configurations) confirms that the ordinary observer would notice these differences.



## 3. The Stitching Pattern that Surrounds the Top Opening is Distinct

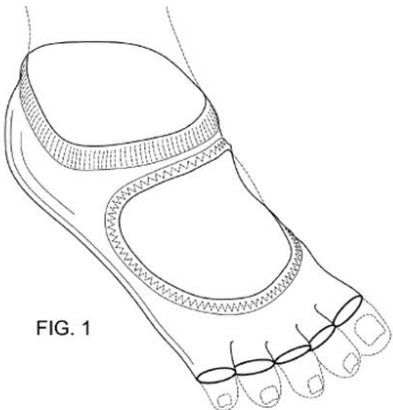
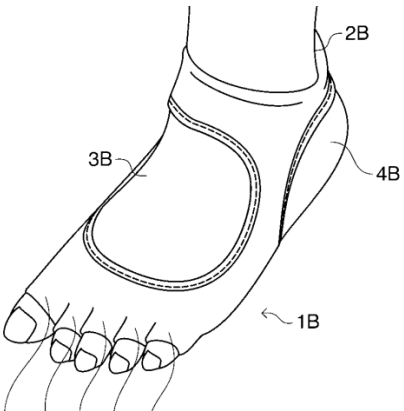
The most distinctive feature claimed in the '036 Patent (and the only non-functional feature) is a “zig-zag” stitching pattern that surrounds the opening around the top of the instep. This feature is not found in the Argento Product.

'036 Patent	Argento Product
	

Plaintiff contends that the '036 Patent provides it with a monopoly on *all socks* having: (1) individual partial toe tubes; and (2) a rounded opening on the top of the foot. But socks having these features were known in the art long before Plaintiff filed for its patent. For example, since at least 2011, a third-party has sold an exercise sock (known as the AQUA RUN) having these features. (*See Ex. 6*). A side-by-side comparison of the top views of this prior art with the Argento Product is provided below. As can be seen, the Argento Product has a straight stitching that circles the top opening, just like the prior art sock:

Argento Product	Prior Art AQUA RUN Sock (Exs. 6, 7)
	

Similar designs are shown in addition prior art references. A comparison of the design claimed in the '036 Patent with the prior art is provided below. As can be seen, the only feature that arguably distinguishes the sock claimed in the '036 Patent from the prior art is the “zig-zag” stitching pattern that circles the opening around the top of the instep. *This element is absent from the Argento Product.*

'036 Patent	JP 2012-153992 (Ex. 1)
 <p data-bbox="337 1749 396 1772">FIG. 1</p>	

In sum, an ordinary observer familiar with the above-identified prior art would never be deceived into believing that the appearance of the Argento Product is the same as the Claimed Design. Under these circumstances, the Argento Product cannot infringe the '036 Patent as a matter of law. *See Egyptian Goddess*, 543 F.3d at 682 (no infringement where accused design more similar to prior art than to patented design); *Seirus Innovative Accessories, Inc. v. Cabela's, Inc.*, 827 F. Supp. 2d 1150, 1156 (S.D. Cal. 2011) (in light of similarities between prior art and accused product, no reasonable fact-finder could conclude that an ordinary observer would believe accused product was same as patented design).

Plaintiff's design patent claim should be dismissed. *See Silverman*, 2016 U.S. Dist. LEXIS 20775, at \*6-7 (granting motion to dismiss where "the patented camouflage design uses curvy areas of various shapes and sizes, whereas the accused camouflage design uses smaller polygons with generally straight edges and hard corners"); *Parker v. Kimberly-Clark Corp.*, No. 11 C 5658, 2012 U.S. Dist. LEXIS 2565, at \*5 (N.D. Ill. Jan. 10, 2012) (granting motion to dismiss where a "side-by-side comparison illustrates several differences that an ordinary observer would notice as between the two napkins," including that the patented design had "extremely sharp edges at both sides" whereas the accused product "has a rounded end on one side").

## **V. CONCLUSION**

The Amended Complaint fails to state a claim for design patent infringement and should be dismissed.

Respectfully submitted,

Dated: December 20, 2018

By: s/Mark Berkowitz

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that I caused the foregoing to be electronically filed with the Court using CM/ECF which will send notification of such filing to all counsel of record.

Dated: December 20, 2018

By: s/Mark Berkowitz  
Mark Berkowitz

*Attorney for Defendants Argento SC by  
Sicura Inc. and The TJX Company Inc.*