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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218072
Party	Plaintiff Epiq Systems, Inc.
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Attachments	Cases in support of Epiq System's motion to strike.pdf(1515991 bytes) Epiq vs Epic River Motion to Strike.pdf(115480 bytes)

or parties only upon an express determination that there is no just reason for delay and upon an express direction for the entry of judgment." Fed.R.Civ.P. 54(b). The parties have failed to obtain such a partial judgment and the other possible avenues of finality have not been followed. *See Nystrom*, 339 F.3d at 1347.

This court has often rebuked parties for presenting an appeal to this court without a final judgment. *See Pause Tech. LLC v. TiVo Inc.*, 401 F.3d 1290, 1293 (Fed.Cir. 2005) ("Despite our repeated admonitions, this court again confronts an appeal with a jurisdictional defect. For whatever reasons, parties too frequently are not reviewing the actions of the district courts for finality before lodging appeals."); *see also Enzo Biochem, Inc. v. Gen-Probe Inc.*, 414 F.3d 1376 (Fed.Cir.2005); *Silicon Image, Inc. v. Genesis Microchip, Inc.*, 395 F.3d 1358 (Fed.Cir.2005); *Nystrom*, 339 F.3d at 1350. The parties are required to certify that the judgment being appealed is final. In this particular case, the appellant filed an appeal on a non-final judgment and the appellee has not objected. Our Federal Circuit rules require that the "jurisdictional statement includ[e] a representation that the judgment or order appealed from is final or, if not final, the basis for appealability." Fed. Cir. R. 28(a)(5); *see also* Fed. R.App. P. 28(a)(4)(B).

The court takes umbrage at parties who have not carefully screened their cases to ascertain whether or not a judgment is final. It is incumbent on all parties to do so. The court should not be required or obligated to scrub every case to determine finality. At this time, the court shall not issue an order to show cause as to whether both parties should be cited or sanctioned for failing to determine finality before filing; however, the parties and other members of the bar are hereby placed on notice that the court shall in the future begin to cite counsel for failure to determine whether or not the appealed judgment is final.

Without finality at the district court, this court cannot entertain the present appeal. Accordingly, the appeal is dismissed for lack of jurisdiction.

In re BOSE CORPORATION.

No. 06–1173 (Serial No. 74/734,496).

United States Court of Appeals, Federal Circuit.

Feb. 8, 2007.

Background: Speaker manufacturer appealed decision of the United States Patent and Trademark Office, Trademark Trial and Appeal Board, denying registration of design.

Holding: The Court of Appeals, Lourie, Circuit Judge, held that Court of Appeals' prior decision that speaker design was functional and not entitled to trademark registration was res judicata.

Affirmed.

1. Trademarks ⇐1322

The Court of Appeals for the Federal Circuit applies a limited standard of review to decisions by the Trademark Trial and Appeal Board and reviews legal determinations de novo and factual findings for substantial evidence.

2. Federal Courts ⇐776

Whether a claim is barred by the doctrine of res judicata is a legal determination reviewed de novo.

3. Trademarks ⇐1322

On appeal from Trademark Trial and Appeal Board decisions, the functionality of trade dress is a factual finding reviewed for substantial evidence.

4. Judgment ⇐548, 585(5)

Court of Appeals' prior decision that speaker design was functional and not entitled to trademark registration was res judicata as to subsequent application to register design based on substantially pentagonal cross-section with a substantially pentagonal shaped top with a bowed edge parallel to a substantially pentagonal-shaped bottom end; the prior decision acknowledged that the curved edge was part of design, intervening Supreme Court case supported finding that design was functional, and since the design was not merely of the curved front edges, new advertising materials, which did not promote the utilitarian aspects of the curved front edge, were irrelevant.

5. Judgment ⇐584

Under the doctrine of "res judicata," or "claim preclusion," a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action.

See publication Words and Phrases for other judicial constructions and definitions.

Patents ⇐328(2)

4,146,745. Cited.

Charles Hieken, Fish & Richardson P.C., of Boston, MA, argued for appellant. With him on the brief were Cynthia Johnson Walden and Amy L. Brosius.

John M. Whealan, Solicitor, United States Patent and Trademark Office, of Arlington, VA, argued for the Director of the United States Patent and Trademark Office. With him on the brief were Cynthia C. Lynch and Nancy C. Slutter, Associate Solicitors.

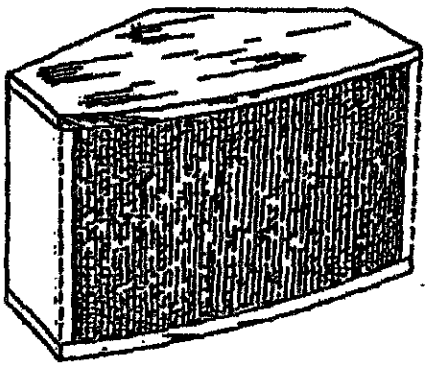
Before LOURIE, RADER, and SCHALL, Circuit Judges.

LOURIE, Circuit Judge.

Bose Corporation ("Bose") appeals from the decision of the United States Patent and Trademark Office ("PTO") Trademark Trial and Appeal Board (the "Board") denying registration of a proposed speaker design as a trademark. *In re Bose Corp.*, Serial No. 74734496, 2005 WL 1787217 (T.T.A.B. July 12, 2005). Because the Board correctly determined that the appeal was barred by the doctrine of res judicata, we affirm.

BACKGROUND

Bose filed an application to register the following design as a trademark for "loudspeaker systems" on September 26, 1995:



Although the application as filed contained no written description of the mark, Bose amended the application to include a statement that the mark "comprises an enclosure and its image of substantially pentagonal cross-section with a substantially pentagonal shaped top with a bowed edge parallel to a substantially pentagonal-shaped bottom end." Bose further stated in its response to an office action that the proposed mark is "identical to trademark application serial no. 73/127,803."

We previously considered the registration of the identical mark in application serial no. 73/127,803 and held that that mark was functional and therefore not entitled to trademark registration. *In re Bose Corp.*, 772 F.2d 866 (Fed.Cir.1985) (*Bose I*). In affirming the Board's decision that the configuration was functional, we applied the standard set forth in *In re Morton–Norwich Products, Inc.*, 671 F.2d 1332 (CCPA 1982). We observed that Bose's promotional materials explained the functional reason for such a design. *Bose I*, 772 F.2d at 871. We also observed that the speaker enclosure configuration was the subject of a Bose patent (U.S. Patent 4,146,745) as part of a speaker system and that the "pentagonally shaped cross-section of the enclosure is part and parcel of the functional, i.e. utilitarian, advantage stated by Bose itself to inhere in the enclosure as an element of a speaker system." *Id.* at 872 (emphasis omitted). We rejected Bose's argument that competitors could compete in the speaker market without using a five-sided speaker and determined that we need only look to Bose's own statements to support a conclusion that the "Bose enclosure design is one of the best from the standpoint of performance of the speaker system." *Id.* Finally, we noted that an advantage of the Bose design is that it is inexpensive to manufacture and is within "the category of a superior design in this respect." *Id.* at 873.

When presented with the identical mark at issue in the present application, serial no. 74/734,496, the Board affirmed the examiner's refusal to register the proposed mark, concluding that the appeal was barred by the doctrine of res judicata. The Board determined that Bose was the same applicant as in *Bose I*, that this court rendered a final decision in *Bose I* on the issue of de jure functionality of the identical mark, and that no conditions, facts, or circumstances of consequence to the issue of de jure functionality had changed since the prior decision.

Bose conceded that the applicant and marks were the same as in the prior proceeding, but argued extensively to the Board that the facts and circumstances had changed since *Bose I* such that application of claim preclusion, in this case via res judicata, was not appropriate. The Board rejected Bose's related argument that there was an important factual difference between the proceedings because the mark in the prior proceeding had a "bowed" edge, whereas, in the present proceeding, the mark is "curved." The Board found no meaningful difference between the characterization in the prior application of a "bowed" front edge and the characterization in the present application of a "curved" front edge. The Board also rejected Bose's changed circumstances argument. It concluded that the public recognition of Bose's design that may have been achieved over twenty years did not cause it to differ from its prior decision that the design was de jure functional.

The Board distinguished this case from *In re Honeywell*, in which the Board determined that that appeal was not barred by application of the doctrine of res judicata. 8 U.S.P.Q.2d 1600, 1988 WL 252417 (T.T.A.B 1988). In *Honeywell*, the design sought to be registered was for a round thermostat cover. The Board rejected the

design as functional. Subsequently, Honeywell sought to register a design that was a variation of the previously registered design. The Board observed that in *Honeywell*, the marks were different in the two proceedings, the round configuration was chosen for source-indicating purposes and the components were designed to fit that configuration, and that case involved a design, not a utility, patent. The Board also determined that in the alternative, even if we were to reverse on the issue of res judicata, the proposed design still consists of a de jure functional configuration of a loudspeaker.

Bose requested reconsideration of the Board's decision, which the Board denied. *In re Bose Corp.*, Serial No. 74734496, 2005 WL 2769634 (T.T.A.B. Oct. 4, 2005) (*Request for Reconsideration*). In its opinion denying the request for reconsideration, the Board rejected Bose's argument that circumstances had changed since the earlier decision, and in particular that there had been a change in the law on the issue of de jure functionality with the decision of *TrafFix Devices v. Marketing Displays*, 532 U.S. 23, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001). The Board noted that statements made in a patent application can demonstrate the functionality of a design, and that if a design is found to be functional, it is unnecessary for the court to consider the availability of alternative designs. The Board concluded that a "design feature that is shown by way of an exhaustive analysis of a utility patent to be de jure functional does not become not de jure functional by the passage of time, more promotional efforts or increased sales." *Request for Reconsideration*, slip op. at 12.

Bose timely appealed, and we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(B).

DISCUSSION

[1–3] We apply a limited standard of review to Board decisions, reviewing legal determinations de novo and factual findings for substantial evidence. *In re Pacer Tech.*, 338 F.3d 1348, 1349 (Fed.Cir.2003). Whether a claim is barred by the doctrine of res judicata is a legal determination reviewed de novo. *Hallco Mfg. Co., Inc. v. Foster*, 256 F.3d 1290, 1294 (Fed.Cir.2001). The functionality of trade dress is a factual finding reviewed for substantial evidence. *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273 (Fed.Cir.2002).

[4] On appeal, Bose again argues that facts and circumstances have changed since *Bose I* such that the doctrine of res judicata should not bar Bose from registering its proposed design as a trademark. According to Bose, the curved front edge was not an issue in *Bose I*, and the court only considered the pentagonal-shaped design in its determination of functionality. Hence, Bose argues that the design with the curved front edge was neither litigated nor decided in *Bose I*. Bose next contends that there has been a change in the legal standard of inquiry for functionality of trade dress, and hence a changed circumstance, since *Bose I*. According to Bose, the Supreme Court's decision in *TrafFix* set forth additional considerations to be applied in a functionality analysis. Bose also argues that it presented additional evidence, such as the absence of promotional material that "touts" the utilitarian aspects of the mark, which the Board allegedly disregarded. According to Bose, the additional evidence represents a significant changed circumstance affecting the *Morton–Norwich* functionality analysis. Finally, Bose argues that because application of res judicata is such a drastic remedy, it should be used only in limited circumstances, and this is not such a circumstance.

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