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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

PETER KAO, an individual, )  
 )  
Plaintiff, )  
 )  
v. )  
 )  
SNOW MONSTER INC., a )  
California Corporation; )  
CAFÉ DE PARIS, INC., a )  
California corporation; )  
HEEKTEA, a business entity )  
unknown; CINDY CAI, an )  
individual; and DOES 1-10, )  
inclusive, )  
 )  
Defendants. )

CV 17-08934-RSWL-GJSx  
  
ORDER re: Defendant Snow  
Monster Inc.'s Motion  
for Summary Judgment of  
Noninfringement [45]

Currently before the Court is Defendant Snow  
Monster Inc.'s ("Defendant") Motion for Summary  
Judgment of Noninfringement ("Motion") [45]. Having  
reviewed all papers submitted pertaining to this  
Motion, the Court **NOW FINDS AND RULES AS FOLLOWS:** the  
Court **DENIES** Defendant's Motion.

1 I. BACKGROUND

2 A. Factual Background

3 Plaintiff Peter Kao ("Plaintiff") brings this  
4 Action for damages and injunction for design patent  
5 infringement against Defendants Snow Monster Inc.; Café  
6 de Paris, Inc.; Heektea; Cindy Cai; and Does 1 through  
7 10. Compl., ECF No. 1. Defendant Snow Monster Inc.  
8 ("Defendant") is the only remaining defendant in this  
9 Action.<sup>1</sup>

10 Plaintiff is an individual residing in Los Angeles,  
11 California. Def.'s Statement of Uncontroverted Facts &  
12 Conclusions of Law ("SUF") ¶ 1, ECF No. 45-4.  
13 Defendant is a California corporation. Id. ¶ 2. On  
14 September 30, 2008, Plaintiff was issued a design  
15 patent, United States Design Patent No. D577,601 (the  
16 "'601 Patent"), for its bottle design entitled "Juice  
17 Bottle". Id. ¶ 3; Compl. Ex. 1, the '601 Patent, ECF  
18 No. 1-1. The '601 Patent's single claim reads "[t]he  
19 ornamental design for juice bottle, as shown and  
20 described." SUF ¶ 4; '601 Patent. The '601 Patent  
21 does not claim a lid, any surface treatment, or other  
22 indicia on the claimed bottle design. Id. ¶ 7.

23 Beginning around October 2006, Plaintiff began  
24 marketing and selling "Gloji" juice, packaged in a  
25 bottle that mimics the classic "A" type incandescent  
26

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27 <sup>1</sup> Plaintiff dismissed Defendants Café de Paris, Inc.; Cindy  
28 Cai; and Heektea on April 19, 2018 [32-33].

1 light bulb ("Gloji Bottle") and that practices and is  
2 protected by the '601 Patent. Id. ¶ 8. In or around  
3 August 2016, Defendant began marketing and offering for  
4 sale products which Plaintiff claims are "nearly  
5 identical" copies of Plaintiff's design, such as the  
6 "Light Bulb Jar" as its appears below (the "Accused  
7 Product"). Id. ¶ 11; Compl. ¶¶ 16, 21.



20 The Accused Product is 27 fl. oz., two to three times  
21 larger than the Gloji Bottle, which is sold in 8.5 fl.  
22 oz and 11 fl. oz versions. SUF ¶¶ 9, 16.

23 **B. Procedural Background**

24 On December 12, 2017, Plaintiff filed his Complaint  
25 [1]. After ADR proceedings dismissing the other  
26 defendants, two extensions of the discovery cut-off  
27 date, and an extension of the motion filing deadline,  
28 Defendant filed its Motion for Summary Judgment [45] on

1 March 18, 2019. Plaintiff timely opposed [46], and  
2 Defendant timely replied [47].

## 3 II. DISCUSSION

### 4 A. Legal Standard

5 Federal Rule of Civil Procedure 56(a) states that a  
6 "court shall grant summary judgment" when "the movant  
7 shows that there is no genuine dispute as to any  
8 material fact and the movant is entitled to judgment as  
9 a matter of law." A fact is "material" for purposes of  
10 summary judgment if it might affect the outcome of the  
11 suit, and a "genuine" issue exists if the evidence is  
12 such that a reasonable fact-finder could return a  
13 verdict for the nonmovant. Anderson v. Liberty Lobby,  
14 Inc., 477 U.S. 244, 248 (1986). The evidence, and any  
15 inferences based on underlying facts, must be viewed in  
16 the light most favorable to the nonmovant. Twentieth  
17 Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327,  
18 1328-29 (9th Cir. 1983). In ruling on a motion for  
19 summary judgment, the court's function is not to weigh  
20 the evidence, but only to determine if a genuine issue  
21 of material fact exists. Anderson, 477 U.S. at 255.

22 Where the nonmovant bears the burden of proof at  
23 trial, the movant need only prove that there is no  
24 evidence to support the nonmovant's case. In re Oracle  
25 Corp. Secs. Litig., 627 F.3d 376, 387 (9th Cir. 2010).  
26 If the movant satisfies this burden, the burden then  
27 shifts to the nonmovant to produce admissible evidence  
28 showing a triable issue of fact. Id.; Nissan Fire &

1 Marine Ins. Co. v. Fritz Cos., 210 F.3d 1099, 1102-03  
2 (9th Cir. 2000); see also Cleveland v. Policy Mgmt.  
3 Sys. Corp., 526 U.S. 795, 805-06 (1999) (quoting Celotex  
4 Corp. v. Catrett, 477 U.S. 317, 322 (1986)).

5 **B. Analysis**

6 1. Design Patent Infringement

7 A design patent may issue to the inventor of "any  
8 new, original and ornamental design." 35 U.S.C. § 171.  
9 Infringement of a design patent is evaluated in a  
10 two-step process. "First, the court must construe the  
11 claims of the design patent to determine their meaning  
12 and scope." Arminak and Assocs., Inc. v. Saint-Gobain  
13 Calmar, Inc., 501 F.3d 1314, 1319 (Fed. Cir. 2007)  
14 (citing OddzOn Prods., Inc. v. Just Toys, Inc., 122  
15 F.3d 1396, 1404-05 (Fed. Cir. 1997)). The Court then  
16 applies the ordinary observer test, which asks whether  
17 "the accused design could not reasonably be viewed as  
18 so similar to the claimed design that a purchaser  
19 familiar with the prior art would be deceived by the  
20 similarity between the claimed and accused designs,  
21 'inducing him to purchase one supposing it to be the  
22 other.'" Egyptian Goddess, Inc. v. Swisa, Inc., 543  
23 F.3d 665, 683 (Fed. Cir. 2008) (quoting Gorham Co. v.  
24 White, 81 U.S. 511, 528 (1871)).

25 a. *Claim Construction*

26 "Design patents are typically claimed as shown in  
27 drawings, and claim construction must be adapted to  
28 pictorial setting." Crocs, Inc. v. Int'l Trad Comm'n,

1 598 F.3d 1294, 1302 (Fed. Cir. 2010). "As a rule, the  
2 illustration in the drawing views is its own best  
3 description." Crocs, 598 F.3d at 1303 (citation  
4 omitted). The Federal Circuit instructs the district  
5 courts to defer to figures for claim construction of a  
6 design patent. Egyptian Goddess, 543 F.3d at 679.  
7 Here, the '601 Patent's sole claim recites "[t]he  
8 ornamental design for juice bottle, as shown and  
9 described." '601 Patent at 1. Because "the preferable  
10 course ordinarily will be for a district court not to  
11 attempt to 'construe' a design patent claim by  
12 providing a detailed verbal description of the claimed  
13 design," Egyptian Goddess, 543 F.3d at 679, the Court  
14 relies on the illustrations contained in the '601  
15 Patent as follows:

16 FIG. 1: "a perspective view of a juice bottle,  
17 showing my new design;"  
18 FIG. 2: "a front elevational view of the  
19 invention, the rear elevational view being an  
20 identical image thereof;"  
21 FIG. 3: "a left-side elevational view of the  
22 invention, the right-side elevational view being  
23 an identical image thereof;"  
24 FIG. 4: "a top plan view of the invention; and,"  
25 FIG. 5: "a bottom plan view of the invention."

26 ///

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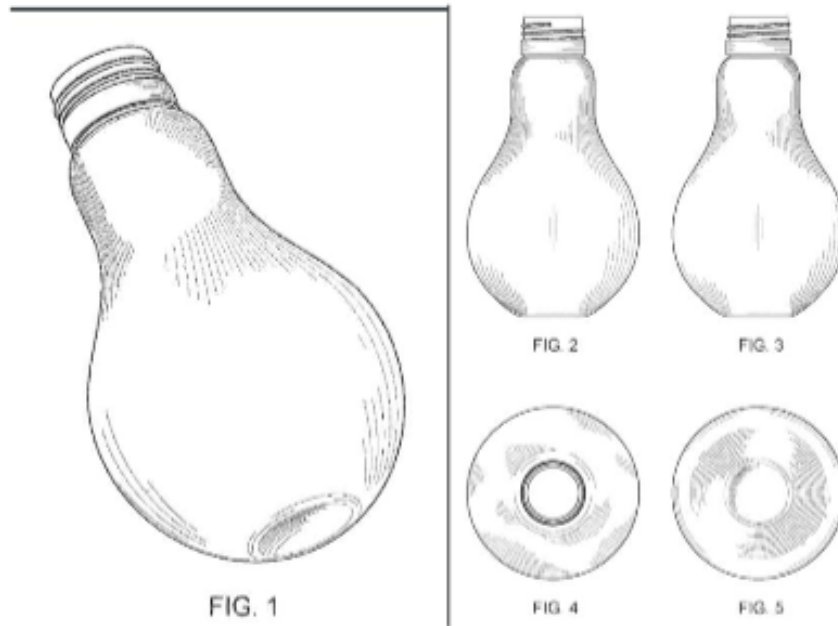
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'601 Patent at 1-3.

b. *Ordinary Observer Test*

Determining infringement of a design patent is a question of fact. Catalina Lighting, Inc. v. Lamps Plus, Inc., 295 F.3d 1277, 1287 (Fed. Cir. 2002); see also Richardson v. Stanley Works, Inc., 597 F.3d 1288, 1295 (Fed. Cir. 2010). "[I]n conducting a design patent infringement analysis, the patented design is viewed in its entirety, as it is claimed. The ultimate question requires determining whether 'the effect of the whole design is substantially the same.'" Payless Shoesource, Inc. v. Reebok Int'l Ltd., 998 F.2d 985, 990-91 (Fed. Cir. 1993) (citing L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1125 (Fed. Cir. 1993)) (quotation marks and alterations omitted). In making this comparison, the fact-finder puts itself into the place of an "ordinary observer." Egyptian Goddess, 543

1 F.3d at 667. The "ordinary observer" is not an expert;  
2 he is an observer "of ordinary acuteness, bringing to  
3 the examination of the article upon which the design  
4 has been placed that degree of observation which men of  
5 ordinary intelligence give." Gorham, 81 U.S. at 528;  
6 Arminak, 501 F.3d at 1324 (the "ordinary observer" is  
7 the purchaser of the item displaying the claimed  
8 design).

9 Here, Defendant argues that the designs of the  
10 Accused Product and the '601 Patent would be  
11 sufficiently dissimilar to the ordinary observer  
12 because (1) the proportions differ; (2) the mouth of  
13 the Accused Product is distinctly extra-wide; and (3)  
14 the '601 Patent lacks additional, distinguishing  
15 features contained in the Accused Product. The design  
16 claimed in the '610 Patent and the Accused Product are  
17 reproduced below.





1                   1.   *Proportions and Size of Mouth*

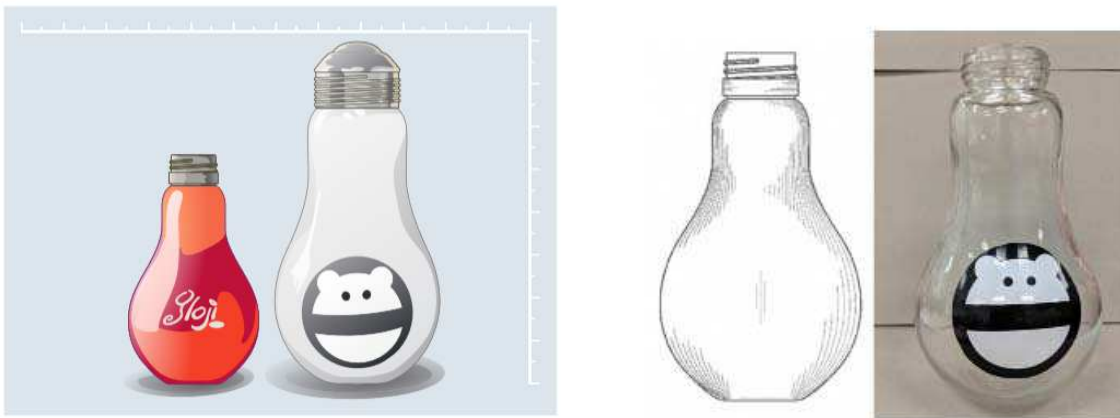
2           The Gloji Bottle is sold in 8.5 fl. oz. and 11 fl.  
3 oz. versions, while the Accused Product is a 27 fl. oz.  
4 jar.  SUF ¶ 16.  Defendant argues that due to its size,  
5 and the fact that the Accused Product has an elongated  
6 neck, it diverges from the '601 Patent's classic, A-  
7 type light bulb.

8           As a preliminary matter, Plaintiff argues that  
9 Defendant is improperly comparing the Accused Product  
10 to the Gloji Bottle, a commercial embodiment of the  
11 '601 Patent.  If a patentee is able to show that there  
12 is no substantial difference between the claimed design  
13 and the purported commercial embodiment, a comparison  
14 between that embodiment and the accused design is  
15 permissible.  See L.A. Gear, 988 F.2d at 1125-26 ("When  
16 the patented design and the design of the article sold  
17 by the patentee are substantially the same, it is not  
18 error to compare the patentee's and the accused  
19 articles directly[.]"); Lee v. Dayton-Hudson Corp., 838  
20 F.2d 1186, 1189 (Fed. Cir. 1988).  However, the Federal  
21 Circuit has "never mandated such comparisons . . . .".  
22 High Point Design LLC v. Buyer's Direct, Inc., 621 Fed.  
23 App'x. 632, 642 (Fed. Cir. 2015) (citing Payless, 998  
24 F.2d at 990).  As such, the Court declines to only  
25 compare the Gloji Bottle and the Accused Product and it  
26 will consider the claimed design as a whole, as well as  
27 the Gloji Bottle for purposes of proportionality.

28           Turning to the comparison of the size and

1 proportionality, the Court considers IMAGE 1 Defendant  
2 provided of the Gloji Bottle and the Accused Product  
3 (left image), as well as the comparison Plaintiff  
4 provided of the Accused Product next to the claimed  
5 design from the '601 Patent (right image), both  
6 pictured below.

7  
8 **IMAGE 1**



16 Def.'s Mot. at 12:14-27; Pl.'s Opp'n Ex. M, ECF No. 46-  
17 16.

18 While it is true that "[a] design patent cannot, of  
19 course, claim every conceivable shape and proportion  
20 that could arise from its basic design," Sofpool LLC v.  
21 Kmart Corp., No. CIV. S-10-3333 LKK/JFM, 2013 U.S.  
22 Dist. LEXIS 76293, at \*15 (E.D. Cal. May 29, 2013), the  
23 Court must keep in mind that the ultimate goal of the  
24 design patent is to prevent the "unauthorized  
25 manufacture, use, or sale of the article embodying the  
26 patented design or any colorable imitation thereof."  
27 See 35 U.S.C. § 289. If slight variances in size or  
28 proportion negated infringement, the protection

1 afforded by design patents would essentially be  
2 rendered useless.

3 Here, the '601 Patent's claimed design is the use  
4 of a classic light bulb shape as a bottle. Given the  
5 uniqueness of the shape, the Court is not convinced  
6 that Defendant has shown that Accused Product differs  
7 enough in size and proportionality so that there is no  
8 triable issue. Payless, 998 F.2d at 990-91 (citation  
9 omitted) ("[M]inor differences between a patented  
10 design and an accused article's design cannot, and  
11 shall not, prevent a finding of infringement."); see  
12 also Crocs, 598 F.3d at 1303-04 (explaining that the  
13 focus of the infringement analysis is the "overall  
14 impression of the claimed ornamental features" rather  
15 than "small differences in isolation."). The Court  
16 finds that the same is true as to Defendant's argument  
17 that the mouth of the Accused Product is larger than  
18 the '601 Patent. Moreover, the mouth's size is  
19 functional in that its purpose is to accommodate the  
20 larger straws used for boba drinks, and a design patent  
21 infringement analysis should be construed to only the  
22 ornamentation of the product and not to the functional  
23 features. See, e.g., Sport Dimension, Inc. v. Coleman  
24 Co., Inc., 820 F.3d 1316, 1320 (Fed. Cir. 2016); OddzOn  
25 Prods., 122 F.3d at 1405 ("Where a design contains both  
26 functional and non-functional elements, the scope of  
27 the claim must be construed in order to identify the  
28 non-functional aspects of the design as shown in the

1 patent.”).

2 A reasonable juror could find that an ordinary  
3 observer would conclude that the Accused Product, while  
4 slightly larger with a longer neck and a wider mouth,  
5 “emobod[ies]” a classic light bulb, “or any colorable  
6 imitation thereof.” Thus, the Court finds that in  
7 looking at the design as a whole, there is a triable  
8 issue as to whether the Accused Product’s overall  
9 effect of its design is substantially similar to the  
10 ‘601 Patent.

11 2. *Additional Features*

12 Defendant argues that the additional features of a  
13 lid, Defendant’s logo, and decoration such as a cotton  
14 candy cloud and flower crown, as shown below,  
15 distinguish the Accused Product from the claimed  
16 design.

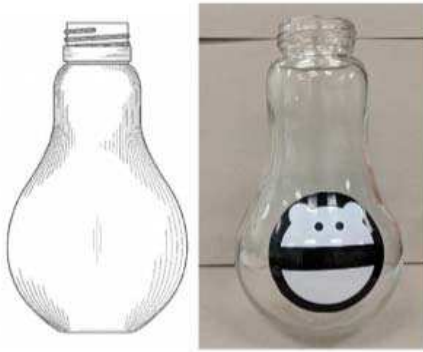


1 Plaintiff argues that the fact that the Accused Product  
2 may be sold with these additional non-permanent  
3 features is irrelevant. However, the infringement  
4 inquiry includes those features visible "at any time  
5 during the 'normal use' lifetime of the accused  
6 product." Int'l Seaway Trading Corp. v. Walgreens  
7 Corp., 589 F.3d 1233, 1241 (Fed. Cir. 2009). "Normal  
8 use" extends from "the completion of manufacture or  
9 assembly until the ultimate destruction, loss, or  
10 disappearance of the article." Id. (citing Contessa  
11 Food Products, Inc. v. Conagra, Inc., 282 F.3d 1370,  
12 1379-80 (Fed. Cir. 2002)). Thus, the use of the logo,  
13 lid, cotton candy cloud, and flower crown all fall  
14 under the "normal use" by Defendant and are relevant to  
15 this analysis.

16 First, as to the lid, while it is undisputed that  
17 the '601 Patent does not include a lid, it would be  
18 apparent to an ordinary observer by looking at the  
19 claimed design that a lid is intended to screw on to  
20 the top of the light bulb shaped glass. The Accused  
21 Product's use of a lid, if anything, is a "minimal  
22 difference," that does not show the absence of a  
23 triable issue. Payless, 998 F.2d at 990-91. Further,  
24 the comparison Plaintiff provided below shows the  
25 Accused Product without a lid, just as the '601 Patent  
26 claims.

27 ///

28 ///



7  
8 **Figure A**

9 Pl.'s Opp'n at 7:5-14.

10 The logo, flower crown, and cotton candy cloud, on  
11 the other hand, appear to be distinguishing features in  
12 comparison to the claimed design. However

13 "[d]ifferences . . . must be evaluated in the context  
14 of the claimed design as a whole, and not in the

15 context of separate elements in isolation." Ethicon  
16 Endo-Surgery v. Covidien, Inc., 796 F.3d 1312, 1335

17 (Fed. Cir. 2015); id. (citing Amini, 439 F.3d at 1372)

18 ("An element-by-element comparison, untethered from  
19 application of the ordinary observer inquiry to the  
20 overall design, is procedural error."). The flower

21 crown and cotton candy cloud features are optional  
22 additions, and thus there are Accused Products sold  
23 without such features. When stripped of the flower

24 crown and cotton candy cloud, a reasonable juror could  
25 find that the overall shape and effect of the Accused  
26 Product is substantially similar to the '601 Patent's

27 classic light bulb design. As to the use of

28 Defendant's logo, the logo is also an addition because  
it is "hand stucked to the jar" by employees. Pl.'s

1 Separate Statement of Genuine Dispute of Fact ("SGDF")  
2 ¶ 15, ECF No. 46-1; *id.*, Ex. Q, ECF No. 46-20. If  
3 every Accused Product was sold with the logo affixed to  
4 it, an ordinary observer might find the two designs  
5 dissimilar enough to not cause confusion when comparing  
6 the Accused Product to the Gloji Bottle. However, the  
7 Court must also compare the Accused Product to the  
8 claimed design, which does not include the Gloji logo.  
9 The Court emphasizes that a conclusion about what a  
10 reasonable juror would think in viewing the two designs  
11 is difficult to make given the factual nature of this  
12 inquiry, *Amini*, 439 F.3d at 1371-72, and thus finds  
13 that there is a triable issue as to whether these  
14 additional elements render the Accused Product  
15 dissimilar under the ordinary observer test.

16 c. *Prior Art*

17 The ordinary observer must also be "aware of the  
18 great number of closely similar prior art designs" and  
19 "conversant with the prior art." *Egyptian Goddess,*  
20 *Inc.*, 543 F.3d at 676. "[I]f the accused infringer  
21 elects to rely on the comparison prior art as part of  
22 its defense against the claim of infringement, the  
23 burden of production of that prior art is on the  
24 accused infringer." *Id.* at 678. When viewing the  
25 claimed design and an accused product in light of the  
26 prior art, "the attention of the hypothetical ordinary  
27 observer may be drawn to those aspects of the claimed  
28 design that differ from the prior art." *Crocs*, 598

1 F.3d at 1303 (citing Egyptian Goddess, 543 F.3d at  
2 681). "If the claimed design is close to the prior art  
3 designs, small differences between the accused design  
4 and the claimed design assume more importance to the  
5 eye of the hypothetical ordinary observer." Id.

6 Here, Defendant argues that when viewed in the  
7 context of prior art, the disparities between the  
8 Accused Product and the '601 Patent are significant.  
9 Def.'s Mot. at 16:6-8. Defendant first argues that  
10 Plaintiff's inspiration for the '601 Patent was the  
11 "Pomwonderful," a bottle consisting of two spheres to  
12 symbolize pomegranate fruits, demonstrating that such  
13 designs are intended to be suggestive of the contents  
14 of its beverage. Def.'s Mot. at 16:9-16; id., Ex. L,  
15 "Pomwonderful" image, ECF No. 45-3. Following this  
16 theme, Defendant argues that the company Orangina  
17 features a "bulbous bottom" bottle meant to recall the  
18 peel of an orange, and another product, Blood of Grapes  
19 Wine, is shaped like a human heart, recalling wine from  
20 grapes. Def.'s Mot. at 16:16-21. In line with this,  
21 Defendant argues that the '601 Patent is meant to  
22 recall a light bulb because the Gloji Bottle is "the  
23 juice that makes you glow," and that the Accused  
24 Product deviates from this theme and the look of a  
25 traditional light bulb. However, the "Pomwonderful,"  
26 Orangina, and the Blood of Grapes Wine are neither  
27 prior art references nor products assuming the classic  
28 light bulb shape, and are thus irrelevant to this



1 analysis.

2 As another example, Defendant includes a two-page  
3 screen shot of light bulb-shaped liqueur bottles sold  
4 online by an Italy-based company, E.V.E.L.T., to  
5 further demonstrate that the Accused Product diverges  
6 from the traditional light bulb shape. Def.'s Mot. Ex.  
7 O, ECF No. 45-3. Plaintiff argues that this is an  
8 inappropriate reference because the exhibit Defendant  
9 provides is an online post written at least four years  
10 ago, lacking foundation, accuracy, and reliability.  
11 Pl.'s Opp'n at 15:15-22. Defendant failed to address  
12 this issue in its Reply. "To satisfy the requirement  
13 of authenticating or identifying an item of evidence,  
14 the proponent must produce evidence sufficient to  
15 support a finding that the item is what the proponent  
16 claims it is." Fed. R. Evid. 901(a). Defendant did  
17 not provide a declaration or any form of authentication  
18 as to this webpage, and as such, the Court will not  
19 consider it as evidence. Even if the webpage were  
20 authenticated, the bottles are miniature in size, 35  
21 ml., and support the conclusion that the Accused  
22 Product is more similar in shape to the claimed design.  
23 See Ex. O.

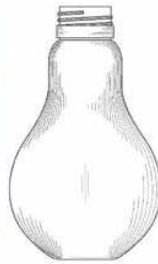
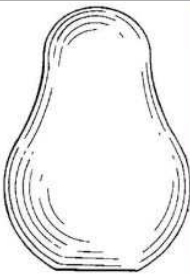
24 Finally, Defendant points to the list of references  
25 of prior art cited by the USPTO examiner. Def.'s Mot.  
26 at 16:25-17:1; id., Ex. N. Of the references listed,  
27 below are the images provided to the Court of the prior  
28 art designs—the first depicting a side by side

1 comparison to the Accused Product, and the second a  
2 sampling provided by Defendant of some of the prior  
3 art.



10 D462,611 prior art

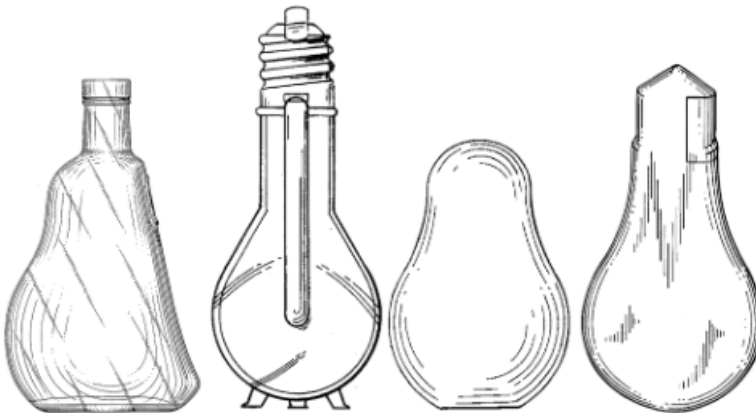
D406,203 prior art



16 D539,146 prior art

D'601 Patent

17 Pl.'s Opp'n, Ex. N, ECF No. 46-17.



28 Def.'s Reply 11:23-12:9, ECF No. 47.

1 Upon review of the images, the prior art designs depart  
2 from the traditional light bulb shape that the '601  
3 Patent depicts. For example, the D539,146 Patent is  
4 more align with a pear shape, and while the D406,203  
5 Patent is a traditional light bulb, it is right side up  
6 as opposed to the claimed design. Defendant also  
7 attempts to point to a Google search that there are  
8 "millions" of results showing light bulb shaped  
9 bottles, but this distracts from the analysis at hand.  
10 Def.'s Reply at 12:20-27; id., Ex. B, ECF No. 47-1.  
11 The fact that variations of the classic light bulb  
12 shape have been used in the past does not show that  
13 there is no genuine issue as to whether the Accused  
14 Product is dissimilar to the '601 Patent. Crocs, 598  
15 F.3d at 1303 ("Even if the claimed design simply  
16 combines old features in the prior art, it may still  
17 create an overall appearance deceptively similar to the  
18 accused design. In that case, this court will uphold a  
19 finding of infringement."). Thus, the Court finds that  
20 a reasonable juror could consider the Accused Product  
21 to most closely resemble the '601 Patent in light of  
22 the prior art references.

23 In sum, the ordinary observer test is a question of  
24 fact and Defendant has not shown there is no genuine  
25 dispute of material fact as to design infringement. In  
26 viewing the entire design and its effect as a whole,  
27 and in light of the prior art, there remains a triable  
28 issue as to whether an ordinary observer would find the

1 Accused Product and the claimed design to be  
2 substantially similar. Accordingly, the Court **DENIES**  
3 Defendant's Motion for Summary Judgment.

4 2. Exceptional Case

5 The parties also dispute whether this is an  
6 exceptional case based upon discovery conduct. Because  
7 the Court has denied Defendant's Motion for Summary  
8 Judgment, it is not appropriate at this stage to  
9 determine whether this is an exceptional case  
10 warranting attorneys' fees.

11 **III. CONCLUSION**

12 Based on the foregoing, the Court **DENIES**  
13 Defendant's Motion for Summary Judgment

14  
15 **IT IS SO ORDERED.**

16  
17 DATED: May 16, 2019

S/ RONALD S.W. LEW

18 **HONORABLE RONALD S.W. LEW**  
19 Senior U.S. District Judge