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UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF CALIFORNIA

SOFPOOL LLC, a Limited  
Liability Company,

NO. CIV. S-10-3333 LKK/JFM

Plaintiff,

v.

KMART CORPORATION, a  
Michigan Corporation, and  
BIG LOTS, INC., an Ohio  
Corporation,

O R D E R

Defendants.

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For the reasons stated below, the hearing in this matter,  
currently scheduled for May 21, 2012, will be vacated.

**I. BACKGROUND**

In its First Amended Complaint, plaintiff Sofpool, LLC,  
alleges that defendants Kmart Corp. and Big Lot Stores, Inc.,  
infringed its design patent<sup>1</sup> for an oval, above-ground swimming

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<sup>1</sup> "Design" patents are granted pursuant to 35 U.S.C. § 171:  
"Whoever invents any new, original and ornamental design for an

1 pool, U.S. Patent No. D480,817 S (the '817 claimed patent).<sup>2</sup>  
2 Specifically, plaintiff alleges that the "Summer Escapes" pool,  
3 sold by defendants, infringes the patent. In its Answer and  
4 Counterclaim, Kmart denies that it infringed the '817 claimed  
5 patent. It also asserts that the '817 claimed patent is invalid  
6 under 35 U.S.C. §§ 102 ("novelty"), 103 ("non-obvious subject  
7 matter"),<sup>3</sup> and 112 ("specification").

8 Plaintiff has now moved for summary judgment that defendants  
9 have infringed its patent, and that the patent itself is "non-  
10 obvious." Defendants have cross-moved for summary judgment that  
11 they have not infringed the patent, and that the patent itself is  
12 invalid because it was "obvious" in light of the prior art.

## 13 **II. THE '817 DESIGN PATENT**

14 Plaintiff's Claim for the '817 claimed patent is as follows,  
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16 article of manufacture may obtain a patent therefor, subject to the  
17 conditions and requirements of this title. [¶] The provisions of  
18 this title relating to patents for inventions shall apply to  
19 patents for designs, except as otherwise provided." In contrast,  
20 "utility" patents are granted pursuant to 35 U.S.C. § 101 ("Whoever  
21 invents or discovers any new and useful process, machine,  
22 manufacture, or composition of matter, or any new and useful  
23 improvement thereof, may obtain a patent therefor, subject to the  
24 conditions and requirements of this title"). See Int'l Seaway  
25 Trading Corp. V. Walgreens Corp., 589 F.3d 1233, 1238 (Fed. Cir.  
26 2009) (comparing requirements for design versus utility patents).

<sup>2</sup> Infringement of design patents is prohibited by 35 U.S.C.  
§§ 271 ("infringement of patent") and 289 ("additional remedy for  
infringement of design patent").

<sup>3</sup> "A patent may not be obtained ... if the differences between  
the subject matter sought to be patented and the prior art are such  
that the subject matter as a whole would have been obvious at the  
time the invention was made to a person having ordinary skill in  
the art to which said subject matter pertains." 35 U.S.C. §  
103(a).

1 in its entirety: "The design for an above-ground swimming pool, as  
2 shown and described," followed by eleven (11) drawings which depict  
3 three "embodiments" of the patent. Complaint (Dkt. No 1) Exh. A.<sup>4</sup>

### 4 **III. ANALYSIS**

5 The court is aware that "design patents are typically claimed  
6 according to their drawings." Richardson v. Stanley Works, Inc.,  
7 597 F.3d 1288, 1294 (Fed. Cir. 2010). However, it is also the case  
8 that "trial courts have a duty to conduct claim construction in  
9 design patent cases, as in utility patent cases." Egyptian  
10 Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008)  
11 (en banc). In a design patent case, the "claim construction must  
12 be adapted to a pictorial setting." Richardson, 597 F.3d at 1294.

13 It is the court's understanding that the design patent covers  
14 only the ornamental aspects of the design, not the functional  
15 aspects. See Richardson, 597 F.3d at 1294 ("we have made clear  
16 that a design patent, unlike a utility patent, limits protection to  
17 the ornamental design of the article"). Accordingly, in construing  
18 the '817 claimed patent, this court is required to factor out the  
19 "functional aspects" of the design. See Richardson, 597 F.3d at  
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21 <sup>4</sup> The patent does not expressly limit the claim to the  
22 "ornamental" design. However, by law, the design patent only  
23 covers the ornamental aspects of the design, so its omission of  
24 that language would appear to make no difference. See Richardson  
25 v. Stanley Works, Inc., 597 F.3d 1288, 1293 (Fed. Cir. 2010) ("The  
26 district court here properly factored out the functional aspects  
of Richardson's design as part of its claim construction. By  
definition, the patented design is for a multi-function tool that  
has several functional components, and we have made clear that a  
design patent, unlike a utility patent, limits protection to the  
ornamental design of the article").

1 1293 ("The district court here properly factored out the functional  
2 aspects of Richardson's design as part of its claim construction").

3       However, neither side in this case has offered a construction  
4 of the '817 claimed patent to assist the court in determining how  
5 to construe the patent. Such assistance would help the court  
6 understand which aspects of the '817 claimed patent are ornamental,  
7 and which are functional. In this regard, the ornamental versus  
8 functional issues that come immediately to mind are the oval shape,  
9 the struts along the sides, the bulges along the sides, the  
10 sidewall angles, the tubular top, and the segmented appearance of  
11 the claimed design. This assistance would also help the court  
12 understand what appear to be technical aspects of the drawings,  
13 such as the meaning, if any, of the lines or hatch-marks that ring  
14 the inside and outside of the design (as well as whether they  
15 depict functional or ornamental aspects of the design).<sup>5</sup> As it  
16 stands, the parties have, in essence, invited the court to guess at  
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18       <sup>5</sup> Egyptian Goddess provided some guidance on this:

19       a trial court can usefully guide the finder of fact by  
20       addressing a number of other issues that bear on the  
21       scope of the claim. Those include such matters as  
22       describing the role of particular conventions in design  
23       patent drafting, such as the role of broken lines;  
24       assessing and describing the effect of any  
25       representations that may have been made in the course of  
26       the prosecution history; and distinguishing between  
27       those features of the claimed design that are ornamental  
28       and those that are purely functional.

25       Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 680 (Fed. Cir.  
26       2008).

1 these matters, but the court declines the invitation.

2 **IV. CONCLUSION**

3 For the foregoing reasons:


4 1. The hearing on these motions, currently scheduled for May  
5 21, 2012, is hereby **VACATED**.

6 2. Plaintiff shall, no later than June 4, 2012, submit a  
7 supplemental memorandum "highlight[ing] the ornamental  
8 aspects" of the '817 claimed patent and identifying which  
9 aspects of the design patent drawings depict functional  
10 aspects of the design.<sup>6</sup> The court is not requesting a  
11 lengthy or detailed opus, but simply a guide which the  
12 court can use in interpreting the drawings in the '817  
13 claimed patent.

14 3. Defendant shall, no later than June 18, 2012, either (1)  
15 file a statement that it has no objection to the claim  
16 construction offered by plaintiff and requesting this  
17 motion to be restored to the calendar, or (2) notice a  
18 claim construction ("Markman")<sup>7</sup> hearing in accordance  
19 with the court's local rules governing noticed motions.

20 IT IS SO ORDERED.

21 DATED: May 15, 2012.

22   
23 LAWRENCE K. KARLTON  
SENIOR JUDGE  
UNITED STATES DISTRICT COURT

24 <sup>6</sup> Richardson, 597 F.3d at 1294 ("the purpose of the [district  
25 court's] claim construction was simply to highlight the ornamental  
aspects of Richardson's design").

26 <sup>7</sup> See Markman v. Westview Instruments, 517 U.S. 370 (1996).