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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.

_____ /

I. BACKGROUND

According to the First Amended Complaint in this case,
plaintiff Sofpool, LLC, is the assignee of all rights to Pierre R.
Carreau's October 14, 2003 "design patent," No. US D480,817 S (the
'817 claimed patent) for an above-ground pool.¹ Sofpool alleges

¹ "Design" patents are granted pursuant to 35 U.S.C. § 171:
"Whoever invents any new, original and ornamental design for an
article of manufacture may obtain a patent therefor, subject to the
conditions and requirements of this title. [¶] The provisions of

1 that defendants infringed the patent by making and selling their
2 own "Summer Escapes" pool.² Dkt. No. 24. In their Answers,
3 defendants deny that they infringed the '817 claimed patent. Dkt.
4 Nos. 27 (Kmart) & 29 (Big Lots). Their Answers also included
5 counterclaims asserting that the '817 claimed patent is invalid
6 under 35 U.S.C. §§ 102 ("novelty"), 103 ("non-obvious subject
7 matter"), and 112 ("specification").

8 Plaintiff moved for summary judgment on its infringement
9 claim. Defendants cross-moved for summary judgment that they have
10 not infringed the patent, and that the patent itself is invalid
11 because it was "obvious" in light of the "prior art."³

12 The patent "claim" for the pool is very simple. It reads, in
13 its entirety:

14 The design for an above-ground swimming pool, as shown
15 and described [accompanied by several drawings].

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

26
² Infringement of design patents is prohibited by 35 U.S.C.
§§ 271 ("infringement of patent") and 289 ("additional remedy for
infringement of design patent").

³ "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 Dkt. No 24 ("First Amended Complaint"), Exh. A.⁴ It was not clear
2 to this court which part of the patent's drawings depicted elements
3 of design, and which parts, if any, depicted purely functional
4 elements. This matters because a design patent "only protects the
5 novel, ornamental features of the patented design." OddzOn
6 Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1404-05 (Fed.
7 Cir. 1997).

8 On May 16, 2012, this court ordered plaintiff to file a
9 supplemental memorandum distinguishing the "ornamental" elements of
10 the patent from the "functional" elements. After plaintiff did so,
11 defendants noticed this claim construction ("Markman")⁵ hearing,
12 urging a competing claim construction.

13 **II. STANDARDS - CLAIM CONSTRUCTION OF A DESIGN PATENT**

14 "[T]rial courts have a duty to conduct claim construction in
15 design patent cases, as in utility patent cases." Egyptian
16 Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 679 (Fed. Cir. 2008)
17 (en banc), cert. denied, 556 U.S. ___, 129 S. Ct. 1917 (2009).⁶

18
19 ⁴ Plaintiff's patent did not expressly limit the claim to the
20 "ornamental" design. However, by law, the design patent only
21 covers the ornamental aspects of the design, so its omission of
22 that language appears to make no difference. See Richardson v.
23 Stanley Works, Inc., 597 F.3d 1288, 1293 (Fed. Cir. 2010) ("The
24 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").

25 ⁵ Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996).

26 ⁶ Citing Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577
(Fed. Cir. 1995).

1 "[T]he purpose of 'claim construction' is to resolve issues of
2 infringement." Typhoon Touch Technologies, Inc. v. Dell, Inc., 659
3 F.3d 1376, 1383 (Fed. Cir. 2011). Where, as here, a design patent
4 is involved (as opposed to a utility patent), a principal goal of
5 claim construction is to "factor out the functional aspects" of the
6 patented design. Richardson v. Stanley Works, Inc., 597 F.3d 1288,
7 1295 (Fed. Cir. 2010) (internal quotation marks omitted). That is
8 because the infringement inquiry in a design patent case focuses
9 solely on the ornamental aspects of the patent, not its functional
10 aspects. See Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577
11 (Fed. Cir. 1995) ("A design patent protects the nonfunctional
12 aspects of an ornamental design as shown in the patent"); OddzOn,
13 122 F.3d at 1404-05 ("Where a design contains both functional and
14 non-functional elements, the scope of the claim must be construed
15 in order to identify the non-functional aspects of the design as
16 shown in the patent") (citations omitted).

17 In making a claim construction for a design patent, the
18 district court does not "attempt to provide a detailed verbal
19 description of the claimed design, as is typically done in the case
20 of utility patents." Egyptian Goddess, 543 F.3d at 679. That is
21 because, as a rule, "'the illustration in the drawing views is its
22 own best description.'" Crocs, Inc. v. ITC, 598 F.3d 1294, 1303
23 (Fed. Cir. 2010).⁷ The court's claim construction must therefore
24 "be adapted to a pictorial setting," since design patents are

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26 ⁷ Quoting Manual of Patent Examining Procedure § 1503.01 (8th
ed. 2006).

1 "typically claimed as shown in drawings." Crocs, 598 F.3d at 1302.
2 Moreover, "a design is better represented by an illustration 'than
3 it could be by any description and a description would probably not
4 be intelligible without the illustration.'" Egyptian Goddess, 543
5 F.3d at 679, quoting Dobson v. Dornan, 118 U.S. 10, 14 (1886).⁸

6 Another goal of claim construction is simply for the court to
7 help the fact-finder by, for example, pointing out "either for a
8 jury or in the case of a bench trial by way of describing the
9 court's own analysis, various features of the claimed design as
10 they relate to the accused design and the prior art." Egyptian
11 Goddess, 543 F.3d at 680. The court can also describe "the role of
12 particular conventions in design patent drafting, such as the role
13 of broken lines," and "assessing and describing the effect of any
14 representations that may have been made in the course of the
15 prosecution history." Id.

16 **III. PROPOSED CLAIM CONSTRUCTIONS**

17 **A. Plaintiff.**

18 Plaintiff asks the court to use the following claim
19 construction:

20 1. an overall effect of an above-ground oval pool with
21 smooth sides having angles and bulges;

22 2. another overall effect of the '817 design is the
23 prominent top tube having a round cross section wherein the top
24 tube follows the oval pool shape along the top of the pool, while
overlapping the sides and joining with the top of the sides; and

25 ⁸ Nevertheless, "the level of detail to be used in describing
26 the claimed design is a matter within the court's discretion."
Egyptian Goddess, 543 F.3d at 679.

1 3. a further overall effect of generally U-shaped side
2 struts joining beneath the top tub and being cast at an angle and
3 retained at their bottoms by straps which extend horizontally a
4 distance from the bottom of the pool sidewall.

5 **B. Defendants.**

6 Defendants ask the court to use the following claim
7 construction:⁹

8 1. trapezoidal shaped struts that angle outwards as the
9 eye moves up, which include a base of a smaller length than the top
10 of the strut, and said struts having sharp corners where vertical
11 bars intersect with horizontal bars;

12 2. struts that are nearly parallel to the angles of the
13 side wall at approximately 16 degrees, and that touch the side wall
14 of the pool at the top and near the bottom;

15 3. four straps connecting the struts to the pool body
16 that primarily project underneath the pool body, whose visibility
17 is limited, as virtually no open space is seen between the strap
18 and the pool or the strut, and which only extend a partial distance
19 under the pool;

20 4. walls that include a top ring and bottom portion
21 that are the same overall size from the top and bottom views, with
22 walls that are concave and bulbous;

23 5. segmented and/or uplifted portions on the lower part
24 of the rounded or curved panels that are without struts;

25 6. straight side panels with struts that do not uplift
26 from the ground;

 7. one strut per panel assembly;

 8. elongated sides each consisting of eight curved
panels and two straight panels, with said curved panels being of
varying sizes: a small one next to the straight panel, two larger

⁹ Defendants also ask the court to exclude from any claim construction the mere existence of (as opposed to the design of): (1) struts on the straight side walls of the pool; (2) outwardly angled or bulged curved or rounded end walls; (3) a round inflatable top collar; (4) straps connecting the struts to the body of the pool; (5) seams between the panels of the pool; and (6) an elongated shape. See Defendant's Motion (Dkt. No. 65-1) at p.17 (ECF p.20).

1 ones next to it, and a half panel visible from the side view; and

2 9. seams that form a starburst oval pattern when viewed
3 from above, with said seams projecting a considerable distance
4 underneath the floor of the pool when viewed from the end, side, or
5 perspective views.

6 **C. Functional vs. Ornamental Elements.**

7 For some reason, both sides have submitted purely verbal claim
8 constructions, with no reference to the patent drawings. Neither
9 side explains why it has done so. Since a design patent is
10 involved here, it seems clear that the most helpful claim
11 construction is going to make reference to the drawings in the
12 patent. The Federal Circuit has warned of "the dangers of reliance
13 on a detailed verbal claim construction." Crocs, 598 F.3d at 1303.

14 Defendants' proposed claim construction seems to be exactly
15 the detailed verbal description the Federal Circuit has warned
16 courts not to engage in. Plaintiff's proposal, meanwhile, appears
17 to be too broad, at least when divorced from the drawings (to which
18 it makes no reference).

19 Each element depicted in the drawings has (or could have) a
20 function, while it also has an ornamental aspect. Thus, regardless
21 of whether these elements have a function or not, the following
22 elements depicted in the drawings also have ornamental features:
23 the tubular top; side-struts; side-straps; angled and bulging side-
24 walls; rounded, angled and bulging end walls; and segmented panel
25 walls of varying widths, connected by seams and creating a pattern
26 as seen from above.

As best the court can tell, the only element depicted in the

1 drawings that has only an ornamental element is the oval shape of
2 the pool. Neither side has asserted that the oval shape is
3 necessary to carry out any function of the pool.

4 **IV. ANALYSIS**

5 **A. Scope of the Claim.**

6 In construing this patent, this court follows the cue of
7 OddzOn Products, a case carefully and well described by defendants'
8 counsel at oral argument.

9 In construing the claim of OddzOn's patent, the district
10 court carefully noted the ornamental features that
11 produced the overall "rocket-like" appearance of the
12 design. We agree with the district court's claim
13 construction, which properly limits the scope of the
14 patent to its overall ornamental visual impression,
15 rather than to the broader general design concept of a
16 rocket-like tossing ball.

17 OddzOn, 122 F.3d at 1405 (emphasis added). In OddzOn, the claimed
18 design patent and the accused design both involved a ball shaped
19 like a football with a protruding straight tailshaft and fins
20 arranged around the tailshaft.

21 It was undisputed in that case that the tail and fins were
22 functional in that they enabled the ball, when embodied in foam, to
23 travel farther and with greater stability than a traditional foam
24 football. Id., 122 F.3d at 1406. The tail and fins were the only
25 elements that distinguished the ball from a traditional football,
26 yet they did not invalidate the design patent. Rather, they
"merely limit[ed] the scope of the protected subject matter." Id.
The district court properly limited the scope by construing the
ball in such a way as to capture "the overall ornamental quality of

1 the design." Id. Specifically, the district court identified the
2 design elements of the tailshaft and the fins: the tailshaft was
3 "slender" and "straight;" the fins were "symmetrically arranged
4 around the tailshaft;" the fins each had "a gentle curve up and
5 outward;" the fins "flare[d] outwardly along the entire length of
6 the tailshaft;" and so on.

7 Thus, the district court correctly construed the claimed
8 design patent by describing the ornamental aspects of these
9 functional elements of the design, as a way of capturing the
10 overall visual impression of the ball.

11 In this case, both sides agree that only the ornamental
12 aspects of the elements depicted in the '817 patent should be
13 included in claim construction, regardless of whether any given
14 element of the pool also has a function or does not. For example,
15 even assuming the struts are functional,¹⁰ they can be designed in
16 a U-shape, a trapezoidal shape, they can splay out from the pool or
17 stand vertically, they can touch the bulging side-wall of the pool
18 or not, and so forth. Similarly, the tubular top can be
19 cylindrical or oblong,¹¹ large or small, and so on.

20 ////

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22 ¹⁰ According to defendants, the struts hold up the sides of
23 the oval pool.

24 ¹¹ According to defendants, the tubular top is necessary for
25 the pool to be "self-rising" when water is poured into it, and to
26 prevent water from splashing over the side. Moreover, they assert
that it must be cylindrical in order to work, but they have offered
no evidence of this, nor any logical explanation for why an oblong
tube would not work.

1 **B. Drawing Conventions.**

2 The parties agree on the drawing conventions used in the
3 patent drawings - hatched lines, seams, and the like. To assist
4 the jury in understanding the meaning of these conventions, both
5 parties' descriptions will be included in the claim construction.

6 **V. CONCLUSION**

7 **A. Claim Construction.**

8 The court thus believes that the most helpful claim
9 construction will describe generally the claimed design with
10 reference to the patent drawings, while clarifying that only the
11 ornamental aspects of the elements depicted there are included in
12 the claim. Accordingly, the court issues the following **CLAIM**
13 **CONSTRUCTION:**

14 The claimed design is an above-ground, oval-shaped pool
15 with side-struts, and additional elements or features, as
16 shown in the '817 patent drawings. Whatever functional
17 role may be played by any element or feature of the pool
18 depicted in the drawings is not a part of the claim, and
19 should therefore be disregarded; but the design of those
20 same elements or features is a part of the claim. The
21 elements or features referred to include, but are not
22 limited to the following as depicted in the drawings: the
23 tubular top; side-struts; side-straps; angled and bulging
24 side-walls; rounded, angled and bulging end walls; and
25 segmented panel walls of varying widths, connected by
26 seams, and creating a pattern as seen from above.

21 **B. Drawing Conventions.**

22 The '817 patent contains drawings which employ certain
23 conventions - hatched lines, shading and the like - which are not
24 necessarily self-explanatory. Each side has offered un-opposed
25 explanations of those conventions. Accordingly, the claim
26 construction includes, and hereby incorporates by reference:

1 Section II(b) of Dkt. No. 64 ("Technical Aspects of the
2 Drawings/Surface Shading");¹² and Section IV of Dkt. No. 65-1
3 ("Drafting Conventions").¹³

4 **C. Further Proceedings.**

5 The parties' cross-motions for summary judgment were filed
6 without the benefit of this claim construction. Those motions
7 (Dkt. Nos. 48 & 54), are therefore **DENIED** without prejudice.

8 The parties are instructed that any motion or cross-motion for
9 summary judgment they wish to file shall be filed no later than 30
10 days from the date of this order.¹⁴

11 IT IS SO ORDERED.

12 DATED: August 28, 2012.

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LAWRENCE K. KARLTON
SENIOR JUDGE
UNITED STATES DISTRICT COURT

¹² Plaintiff's Supplemental Memorandum.

¹³ Defendants' Memorandum of Points and Authorities in Support of their Markman Claim Construction Hearing.

¹⁴ So long as one side's motion is filed within 30 days, the other side's cross-motion, if any, may be filed thereafter in accordance with the local rules.