United States District Court,
C.D. California, Western Division.

Ilan GOLAN,
Plaintiff.
v.
PINGEL ENTER., INC,
et al. Defendants.

No. CV 99-3143 MRP

Nov. 4, 1999.

MEMORANDUM OF DECISION

PFAELZEL, J.

BACKGROUND

The plaintiff, Ilan Golan ("Golan"), brings this action against the defendants, Pingel Enterprise, Inc., Wayne H. Pingel, Donna M. Pingel, and Arlen Ness (collectively "Pingel") for declaratory judgment of non-infringement of design and utility patents and a trademark, and additionally has made common law unfair competition and interference with contract and prospective business advantage claims. Pingel has counterclaimed, alleging, among other things, trademark, trade dress, and patent infringement, trademark dilution and state unfair competition.

Golan and Pingel are direct competitors in the sale of after-market motorcycle fuel valves used in Harley-Davidson motorcycles. These valves, also called petcocks, regulate the flow of fuel from either the main or reserve fuel tanks to the engine itself, and are purchased mostly by motorcycle enthusiasts.

Golan now asks this Court, by its motion for summary judgment, to determine that its fuel valve does not infringe U.S. Patent No. Des. 363,533 (the " '533 patent"), issued to Wayne H. Pingel.

ANALYSIS

I. *Summary Judgment Standards*

Summary judgment is governed by Federal Rule of Civil Procedure 56 and is appropriate when the moving party demonstrates that there is no genuine issue as to any material fact and that it is entitled to a judgment as a matter of law. *See* Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986). An issue of fact is genuine if the evidence is such that a reasonable jury could return a verdict for the nonmoving party. *See* State of California v. Campbell, 138 F.3d 772, 780-01 (9th Cir.1998).

II. *Design Patent Infringement Standards*

Because the '533 patent is a design patent, this Court must follow a two step analysis in determining infringement. "[F]irst, as with utility patents, ... the claim [must] be properly construed to determine its meaning and scope. Second, the claim as properly construed must be compared to the accused design to determine whether there has been infringement." Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995) (citations omitted).

A. ***Claim Construction***

The purpose of claim construction in a design patent case is to "discern the correct visual impression created by the patented design as a whole," and to "translate [those] visual depictions into words." Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed.Cir.1993). "When properly done, this verbal description should evoke the visual image of the design." *Id.*

However, a design patent only protects the novel, ornamental features of the patented design. *See* Keystone Retaining Wall Systems, Inc. v. Westrock, Inc., 997 F.2d 1444, 1450 (Fed Cir.1993). Where the design contains both functional and nonfunctional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent. *See* Oddzon Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed.Cir.1997). "When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose." Avia Group Int'l v. L.A. Gear California, Inc., 853 F.2d 1557 (Fed.Cir.1988). Additionally, there is support for the proposition that portions of the design hidden during ordinary use, and which are not a "matter of concern" to the purchaser, are not ornamental and not the proper subject matter for a design patent. *See* In re Webb, 916 F.2d 1553, 1557-58 (Fed.Cir.1990), *cf.* Keystone Retaining Wall Systems, 997 F.2d at 1450-51. For the purposes of this decision, this Court will assume, *arguendo,* that the portions of the valves covered in ordinary use are not ornamental.

B. ***Comparison for Overall Similarity***

Once the claim has been properly construed, "the patented and accused designs are compared for overall similarity." Elmer, 67 F.3d at 1577. The Court accomplishes this task by utilizing the test established in Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 528 (1871):

[I]f, in the eye of the ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Furthermore, when a design is comprised of both ornamental and functional features, "the patentee must show that the perceived similarity is based on the ornamental features of the design." Oddzon Prods., 122 F.3d at 1405.

III ***Infringement of*** the '533 Patent

A. ***Claim Construction***

The "design" or "inventive concept" in the '533 patent was the subject of five different design patent applications. On initial examination, the Patent Office rejected each application on the ground of double patenting of the invention claimed in the other four. In response, Pingel combined the five original applications into a sixth application and abandoned the five earlier filed applications. The sixth application

became the '533 patent, and the '533 patent is therefore limited to the single inventive concept common to the five alternate embodiments disclosed in the application.

Golan claims that this single inventive concept includes a combination of (1) a filter sleeve with a flattened hat shaped extremity, (2) an end cap having raised ears against which a straight actuating lever rests, and is stopped during operation of the valve, (3) a valve body exterior having tapered top and bottom edges, and (4) a protruding valve outlet that has a cylindrical shoulder near the valve body and a dual tapered, enlarged cylindrical discharge end. Pingel, however, claims that the single inventive concept of the '533 patent is a vertically oriented rounded or barrel shaped valve body, which may also contain a design on the outside of the valve body such as bands or grooves.

Upon consideration, this Court has determined that the claim in the '533 patent, as properly construed, falls between these two conflicting interpretations. As noted above, those portions of the valve hidden during ordinary use are not proper subject matter for a design patent. Therefore, the hat shaped extremity and the protruding valve outlet cannot be properly considered part of the inventive concept of the '533 patent. The inventive concept of the '533 patent, and therefore the claim as properly construed, includes (1) an end cap having raised ears against which a straight actuating lever rests, and is stopped during operation of the valve, (2) a valve body exterior having tapered top and bottom edges, and (3) a vertically oriented rounded or barrel shaped valve body, which may also contain a design on the outside of the valve body such as bands or grooves.

B. ***Substantial Similarity***

Having construed the claim of the '533 patent, the Court must now determine whether a genuine issue of material fact exists as to the issue of substantial similarity under the *Gorham* standard. The Court must "visually compare the patented and accused designs to determine whether the jury reasonably could [conclude] that they are substantially similar." Elmer, 67 F.3d at 1577. The '533 patent, as discussed above, is limited to a valve which includes a valve body exterior having tapered top and bottom edges. The Golan valve does not have these features. Furthermore, the '533 patent only protects designs which have straight actuating levers. Golan's actuating lever is not straight, but contains a ninety degree bend. While it is true that the Golan valve appropriates a portion of the ornamental features covered by the '533 patent, here, as in *Elmer,* "the overall appearance of the [patented] design, as shown in the patent drawings, is too different from the [accused] design for an ordinary observer to be induced into purchasing [the accused] product thinking it was [the patented] design." Elmer, 67 F.3d at 1578. Therefore, no reasonable jury could conclude that the overall visual appearance of the Golan valve is substantially similar to the design protected by the '533 patent, and no genuine issue of material fact exists for trial.

CONCLUSION

Because, after properly construing the claim of the '533 patent, no genuine issue of material fact remains as to whether the Golan valve infringes the design protected by the '533 patent, this Court grants Golan's motion for summary judgment of non-infringement.

This Memorandum of Decision shall constitute the Court's findings of fact and conclusions of law.

IT IS SO ORDERED.

C.D.Cal.,1999.

Golan v. Pingel

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