United States District Court,
N.D. Texas, Dallas Division.

MINKA LIGHTING, INC,
et al. Plaintiffs.
v.
CRAFTMADE INTERNATIONAL,
INC. Defendant.

No. 3-00-CV-0888-X

Aug. 20, 2001.

ORDER

KAPLAN**, Magistrate J.**

On May 16, 2001, the court-appointed special master submitted a Final Report and Recommendation on the claim construction issues presented in this patent case. An Amended Final Report and Recommendation was submitted on June 4, 2001. No objections have been filed. After conducting a *de novo* review of the claim construction briefs and supporting materials, the Court adopts the recommendation of the special master in its entirety. FN1

FN1. The parties have consented to allow the magistrate judge to make a final ruling on the claim construction recommendation made by the special master. By order dated August 13, 2001, all claim construction issues in this case were referred to the magistrate judge for final determination pursuant to 28 U.S.C. s. 636(c).

SO ORDERED.

SPECIAL MASTER'S FINAL REPORT AND RECOMMENDATION ON CLAIM CONSTRUCTION

This case raises several issues regarding *Markman* FN1-type claim construction of a design patent. Minka Lighting, Inc. and Sheng Yuan Electric Co., Ltd. (now Pan Air Electric Co., Ltd.) FN2 (collectively, "Minka") charge Craftmade International, Inc. ("Craftmade") with infringement of United States Patent No. Des. 380,539 (the " '539 patent"). The '539 patent-in-suit is directed to an ornamental design for a combined ceiling fan and light.

FN1. Markman v. Westricw Instruments, Inc., 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

FN2. Pan Air Electric Co., Ltd. has, apparently, been substituted for Sheng Yuan Electric Co., Ltd.

This Court's Order dated February 22, 2001, appointed the undersigned as special master. That Order referred "[a]ll pretrial matters involving patent claim construction" to the special master, and directed the special master "to hold a *Markman* hearing within 45 days" and to file a report by June 15, 2001. In accordance with that Order, the special master held a telephone conference with the parties on March 8, 2001, to discuss, *inter alia,* the preferred format for a *Markman* hearing. Neither party requested an evidentiary hearing. Accordingly, the disputed issues of claim construction will be addressed based on the parties' briefs.

After carefully reviewing the briefs offered by both parties, and pursuant to the foregoing Order and Rule 53(e)(5), Federal Rules of Civil Procedure, a Special Master's Draft Report and Recommendation on Claim Construction was circulated to the parties for comment on April 20, 2001. Minka chose to submit comments, but Craftmade did not. After considering Minka's comments, this is the Special Master's Final Report and Recommendation on Claim Construction.

I.

U.S. Patent No. Des. 380,539

The '539 patent-in-suit is drawn to an ornamental design for a combined ceiling fan and light, as shown in the following drawings:

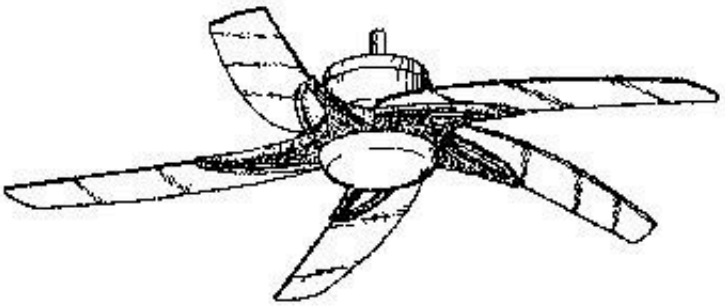


FIG. 1



FIG. 2

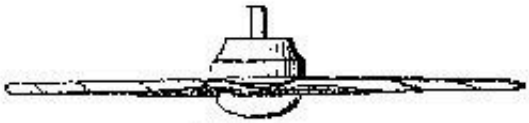


FIG. 4

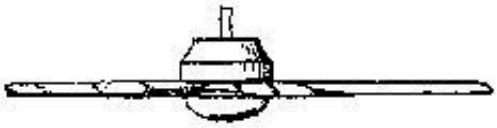


FIG. 3



FIG. 5

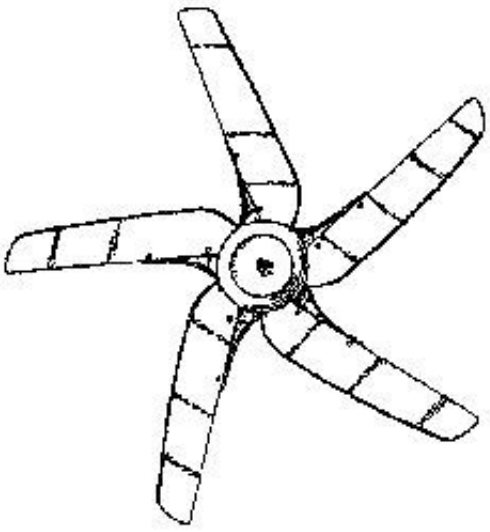


FIG. 6

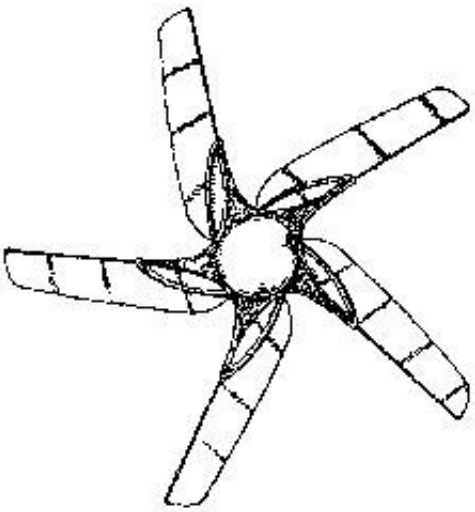


FIG. 7

The claim of the '539 patent-in-suit requiring construction reads, in typical formal terms: "The ornamental

design for a combined ceiling fan and light, as shown."

II.

Background

A. Design Patents-Overview

Under 35 U.S.C. s. 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.

A design patent protects the non-functional aspects of an ornamental design as shown in the patent drawing. KeyStone Retaining Wall Sys., Inc. v. Westrock., Inc., 997 F.2d 1444, 1450 (Fed.Cir.1993). Unlike utility patents, the heart and soul of a design patent is the content of the drawing. Indeed, the rules of practice of the U.S. Patent & Trademark Office (the "PTO") provide that the design must be represented by a drawing having "a sufficient number of views to constitute a complete disclosure of the appearance of the design." 37 C.F.R. s. 1.152. Thus, as in the '539 patent, drawings in a design patent typically show the design from the front, rear, top, bottom, left and right, and many times include a perspective view as well. Only one claim is permitted in a design patent, and that one claim must follow the form: "The ornamental design for the article (specifying name) as shown," or "as shown and described." *See* 37 C.F.R. s. 1.153(a),FN3 M.P.E .P. s. 1503.03.

FN3. 37 C.F.R. s. 1.153(a) provides:
The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

B. Design Patent Infringement

As in the case of utility patents, determining infringement of a design patent has two steps. The first step requires that the claim be properly construed to determine its meaning and scope. *See* Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995)("Determining whether a design patent claim has been infringed requires, first, as with utility patents, that the claim be properly construed to determine its meaning and scope."). The second step requires comparing the accused design to the properly construed claim. *Id*. In that second step, the patented and accused designs are compared for overall visual similarity using the perspective of "an ordinary observer giving such attention as a purchaser usually gives:"

[I]f, in the eye of an 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.

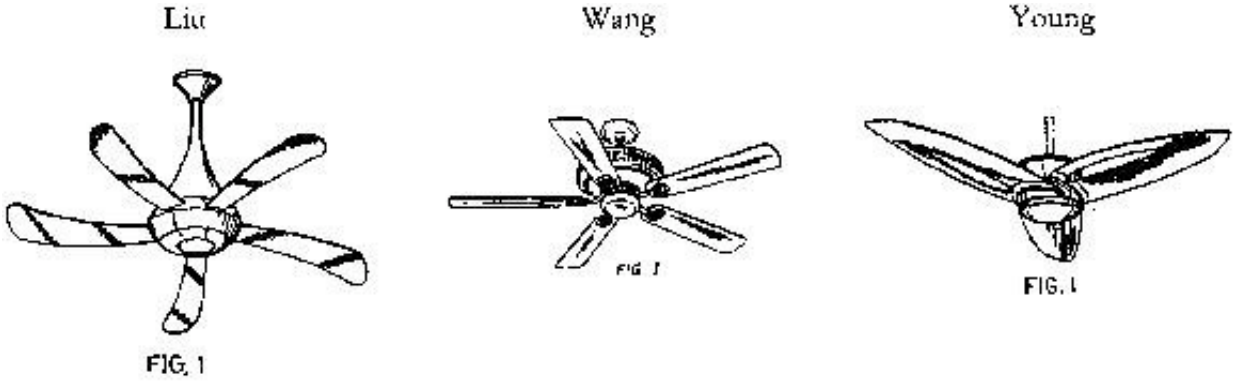
Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 528, 20 L.Ed. 731 (1871). Additionally, though, in analyzing that similarity, "[w]here * * * a [patented] design is composed of functional as well as ornamental features, to prove infringement a patent owner must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental." Read Corp. v. Portec. Inc., 970 F.2d 816, 825 (Fed.Cir.1993). Also, for there to be an infringement, "the accused design must appropriate the novel ornamental features of the patented design [sometimes referred to as the "point(s) of novelty"] that distinguish it from the prior art." Elmer, 67 F.3d at 1577 (citing Oakley, Inc. v. International Tropic Cal, Inc., 923 F.2d 167, 169 (Fed.Cir.1991)). The "point of novelty" analysis is separate and independent from the ordinary observer analysis, *see* Unidynamics Corp. v. Automatic Prods. Int'l, Ltd., 157 F.3d 1311, 1323 (Fed.Cir.1998), and the Federal Circuit has held that merging "the point of novelty test and the ordinary observer test is legal error." Id. at 1324.

Although the only issue requiring resolution here is the proper construction of the '539 patent claim, doing so requires addressing some related issues.

C. Prosecution History and Points of Novelty

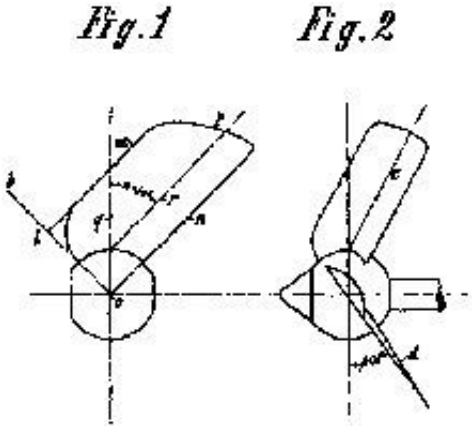
The prosecution history of the '539 patent-in-suit is attached as Exhibit B to the parties' Joint Claim Construction Statement. The parties agree "that a design patent's points of novelty relate to differences from prior designs, and are usually determinable based on the prosecution history." Joint Stmt. at 5, citing Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1118 (Fed.Cir.1998)("The points of novelty relate to differences from prior designs, and are usually determinable based on the prosecution history."). Four references were cited during the prosecution of the '539 patent. Three of those references were design patents, namely, U.S. Patent No. Des. 347,887 ("Liu"), U.S. Patent No. Des. 357,978 ("Young"), U.S. Patent No. Des. 363,345 ("Wang"), and one was a utility patent, namely U.S. Patent No. 1,086,274 ("Cardosa").

Those references are attached as Exhibit C to the parties' Joint Claim Construction Statement. The perspective view from each of the design patents illustrates the following:



The utility '274 patent to Cardosa is drawn to ship propellers, specifically "propellers for ships with flat blades which form with the axis of the propeller an angle of about 45 ~and whose parallel entrant and exit edges form an angle of 45 ~or close to 45 ~with the perpendicular line to the axis which passes through the

plane of the blade." ('274 patent, lines 10-16) Cardosa's claim also requires that "the blades form with the axis of the propeller an angle of up to or exceeding 80.~" Figs. 1 and 2 of the '274 patent generally illustrate that configuration:



Other than identifying the prior art that Minka points to in its proposed claim construction (discussed below), the prosecution history of the '539 patent, like many design patents, provides scant help in construing the claim. The application was allowed on the first action. Although the examiner cited the foregoing four patents, the examiner did not enter any rejections based on those references, and did not otherwise indicate what features pertinent to the claimed design, if any, that the examiner viewed those references as disclosing.FN4

FN4. The prosecution history also contains a petition to correct inventorship by substituting Stansfield Young for Chentze Liu, and a request for a certificate of correction effecting the same change. The prosecution history attached as Exhibit B to the parties' Joint Claim Construction Statement does not indicate what, if any, action the PTO has taken on either the petition or the request.

D. Patent Title

The only amendment made in the application that matured into the '539 patent was an Examiner's Amendment, authorized by the applicant's attorney, Mr. Morton J. Rosenburg, changing the title from "Ceiling Fan with a Light Means Disposed Thereto" to "Combined Ceiling Fan and Light." That same change was made in the claim. The sole reason given in the Examiner's Amendment for that change was: "For accuracy."

Despite the seemingly clear and easily understood words in the '539 title, the parties apparently disagree over the effect of a design patent title on claim construction, although why the parties disagree is a mystery.FN5 Nevertheless, that disagreement, unfortunately, necessitates a more complete discussion of design patent titles.

FN5. The reason for the parties' apparent disagreement is not at all apparent from the record. Inasmuch as claim construction, at least in utility patent cases, should be undertaken irrespective of the accused products,

the record does not reveal any description or illustration of the accused product(s), except that a footnote in Minka's Opening Brief refers to "the accused SOLO ceiling fan and lighting fixture." Minka's Opening Brief at 5 n. 3. The accused product would thus appear to be at least in the same general category of products identified as a "combined ceiling fan and light." Accordingly, the discussion here attempts to resolve what appears to be a source of disagreement between the parties, but necessarily does so without sufficient information to know whether or not this is at all a substantive issue.

The PTO rules of practice, 37 C.F.R. s. 1.153(a), provide that "[t]he title of the design must designate the particular article." The PTO Manual of Patent Examining Procedure (M.P.E.P.) further explains:

The title of the design identifies the article in which the design is embodied by the name generally known and used by the public. A title descriptive of the actual article aids the examiner in developing a complete field of search of the prior art and further aids in the proper assignment of new applications to the appropriate class, subclass, and patent examiner, and the proper classification of the patent upon allowance of the application. It also helps the public in understanding the nature and use of the article embodying the design after the patent has been published.

M.P.E.P. s. 1503.01, and states that "the language of the title and claim must correspond." Id.

Minka urges that "[t]o the extent that the '539 Patent's title is instructive of its claim, Plaintiffs state that the '539 Patent title does contain special or uncommon meaning or words or phrases. Specifically, the title 'COMBINED CEILING FAN AND LIGHT' is a designation that serves the Patent Office's classification needs and that is common to design patents in the same and related class and subclasses." Joint Claim Construction Statement ("Joint Stmt.") at 1.

Craftmade, on the other hand, urges that "[t]he 539 Patent's claim contains no special or uncommon meaning or words or phrases. The plain meaning of the title of the 539 Patent is instructive in determining the scope of the patent-in-suit. Specifically, the 539 Patent's claim can be no broader in scope that its descriptive title, namely a 'COMBINED CEILING FAN AND LIGHT." Id.

Both parties are partially, but not entirely, correct. This issue also illustrates one of the several differences between utility patents and design patents. In the case of utility patents, the Federal Circuit in Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298 (Fed.Cir.1999), effectively eliminated patent titles from any consideration *vis-a-vis* claim construction. The PTO rules of practice applicable to utility patents, 37 C.F.R. s. 1.72(a), simply provide that the title of the invention "should be as short and specific as possible * * *." Section 606.01 of the M.P .E.P., however, provides that "[w]here the title [of a utility patent] is not descriptive of the invention claimed, the examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed." The district court in *Pitney Bowes* had based its claim construction, in part, on an amendment that the examiner had required to the title.

In the course of reversing the district court's claim construction, the Federal Circuit noted that utility patent titles are "not to demarcate the precise boundaries of the claimed invention but rather to provide a useful reference tool for future classification purposes." The Federal Circuit further noted: "In any event, if we do not read limitations into the claims from the specification that are not found in the claims themselves, then we certainly will not read limitations into the claims from the patent title. * * * Consequently, an amendment of the patent title during prosecution should not be regarded as having the same or similar effect

as an amendment of the claims themselves by the applicant. * * * [T]hat the patent title has only been mentioned once by this court in the context of claim construction and, even then, merely to make an illustrative point in one sentence, makes a powerful statement as to the unimportance of a patent's title to claim construction." [Citations omitted.] 182 F.3d at 1312.

In short, utility patent titles are unimportant to claim construction because, unlike design patents, utility patent claims may take a variety of forms and may or may not use the same terms as the patent title. But applicants do not have such latitude in drafting design patent claims. Such claims, as noted above, must take the form: "The ornamental design for the article (specifying name) as shown," or "as shown and described." 37 C.F.R. s. 1.153(a).FN6 The M.P.E.P. further explains the PTO's position that because (1) design patent titles must designate a particular article, and (2) design patent claims are limited to the formal form specified in the rules of practice, the language of the title and the claim must correspond:

FN6. In certain instances, design patent specifications may include more than a description of the drawings. M.P.E.P. s. 1503.01, para. II.

Since 37 C.F.R. 1.153 requires that the title must designate the particular article, and since the claim must be in formal terms to the "ornamental design for the article (specifying name) as shown, or as shown and described," it follows that the language of the title and claim must correspond. When the language of the title and claim do not correspond, the title should be objected to under 37 C.F.R. 1.153 as not corresponding to the language of the claim.
M.P.E.P. s. 1503.01.
Nevertheless, Craftmade's argument that "the '539 Patent's claim can be no broader in scope that its descriptive title" is incorrect because it suggests that the patent title *per se* defines the outer boundaries of the claim. That misconstrues the nature of a design patent title. Section 171 does not permit design patents to issue for abstract designs, but rather authorizes design patents to issue on ornamental designs "for articles of manufacture." A design patent title is simply the generic name for the article of manufacture in which the patented design is embodied. That same generic name appears in a design patent claim because of the requirement that the title and claim "correspond." Here, the '539 patent claim calls for the "ornamental design for a combined ceiling fan and light, as shown" using the same terms used in the title, namely "Combined Ceiling Fan and Light." There is no doubt that the article of manufacture embodying the patented design is a combined ceiling fan and light, and that is likewise evident from even a casual glance at the drawings.

Further, the phrase "combined ceiling fan and light" is readily and easily understood. Craftmade is thus correct that the words of the '539 patent claim and title have no special or uncommon meaning. Although Minka is correct that the '539 patent title serves several purposes, including administrative purposes in the PTO, that does not mean that the patent title has any special or uncommon meaning. If Minka is implying by that assertion that the '539 patent applicant was somehow forced or required to accept the examiner's proposed change, Minka is mistaken, at least on the present record. Design patent applicants, like utility patent applicants, have both the privilege and obligation to claim "the subject matter which the applicant regards as his invention." 35 U.S.C. s. 112(2). If the '539 patent applicant, through his attorney, did not believe that the amended title and claim, as proposed by the examiner, accurately set out what the applicant regarded as his invention, he could have (and should have) refused to accept that amendment.FN7 *See generally* Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1425 (Fed.Cir.1997). The applicant could have insisted on a different title/claim, *see* M.P.E.P. s. 1503.01, although there is no readily apparent reason

why the applicant should have done so. "Combined ceiling fan and light" does not appear to be misdescriptive, inaccurate or unclear. If, on the other hand, Minka is implying that it should be allowed to focus on only part of the overall patented design, and that the title should not preclude it from doing so, Minka is mistaken. The applicant could also have applied for a patent on design elements exhibited by less than the entire article of manufacture.FN8 *See* In re Zahn, 617 F.2d 261, 268 (C.C.P.A.1980)(In addressing an application for a design of a drill bit shank, the court observed that "[w]hile the design must be embodied in some article, the statute is not limited to designs for complete articles, or 'discrete' articles, and certainly not to articles separately sold * * *."). Instead, the applicant, through his attorney, filed the application maturing into the patent-in-suit drawn to the entire configuration, and also agreed to the amendment to the title.

FN7. The '539 patent is classified in design class D23, subclass 377. Design class D23 generally covers "environmental, heating and cooling; fluid handling and sanitary equipment." Subclass 377 covers "Air treatment: Fan or ventilator: Blade unit rotates on vertical axis." Some sample titles of design patents in the same classification are "Combined Ceiling Fan and Light Fixture," Des. 439,322; "Ceiling Fan," Des. Nos. 438,946, Des. 433,114; Des. 431,290; "Combined Motor Housing, Blade Irons, Switch Housing and Light Fixture Unit for a Ceiling Fan," Des. 436,659.

FN8. For example, design patent Des. 428,133, entitled "Ceiling Fan Motor Housing," is drawn to just the ornamental design embodied in a motor housing.

One last comment is, perhaps, necessary.FN9 Once again, s. 171 provides that "[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor." As noted above, a correct generic name for the "article of manufacture" in which the claimed design is embodied is a "combined ceiling fan and light." Unlike utility patent cases, though, there is neither a need nor a justification for parsing and construing the generic name of an article of manufacture appearing in the claim, for example, to determine what "combined" means. The Federal Circuit's predecessor court, in *Zahn,* explained that the word "therefor," in the phrase "may obtain a patent, therefor," refers "back to 'design,' not to 'article of manufacture." ' 617 F.2d at 268. In short, '[i]n a design patent application, the subject matter which is claimed is the design embodied in or applied to an article of manufacture (or portion thereof) and *not* the article itself." [Emphasis in original.] M.P.E.P. s. 1502. That is because, as the court further explained in *Zahn,* " s. 171 refers, not to the design of an article, but to a design for an article, and is inclusive of ornamental designs of all kinds, including surface ornamentation as well as [a] configuration of goods." *Id*. *See also* In re Galvas, 43 C.C.P.A. 797, 230 F.2d 447, 450 (C.C.P.A.1956)(discussing that the nature of an ornamental design may affect the scope of analogous art).

FN9. Once again, the record does not reveal what, if any, substantive effect all of this may have in the case. *See* note 5 above.

In this case, the design depicted in the '539 patent drawings is largely a configuration and does not contain any broken line elements that might otherwise be excluded from the patented design. It is that design that must be infringed. In some cases, the patent title/claim may aid in interpreting a design, but here it would make no difference on the interpretation of the '539 patent design whether the '539 patent applicant chose to use, for example, "ceiling fan," or "ciling fan and light," or "combined ceiling fan and light," as the generic

name for the article of manufacture in the patent title and claim. In all of those cases, the claim of the '539 patent would cover precisely the same design illustrated in the '539 patent. Deciding infringement requires performing the *Gorham* deception analysis (augmented by the functionality and points-of-novelty analyses discussed above) "from the viewpoint of the person who is the ordinary purchaser of the article charged to be an infringement." Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116 (Fed.Cir.1998). The *Gorham* deception analysis will resolve any differences that might exist between the actual accused product and the generic name of the article of manufacture identified in the '539 patent, for example, whether the accused product can properly be characterized as a "combined ceiling fan and light." No further construction of "combined ceiling fan and light" is required.

The question now becomes the extent to which the Court should "explain" that design during *Markman*-type claim construction. More to the point, if a picture is worth a thousand words, is the Court required, as part of its *Markman* duties, to craft a thousand or so words (figuratively speaking) to "explain" the design?

E. The Parties' Proposed Claim Construction

Pursuant to the Court's July 7, 2000 Scheduling Order, the parties have filed a Joint Claim Construction Statement setting out the parties' proposed construction of the '539 patent claim. The parties agree that the Federal Circuit has mandated *Markman*-type claim construction as the first step in deciding design patent infringement. *See, e.g.,* Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995)("Determining whether a design patent claim has been infringed requires, first, as with utility patents, that the claim be properly construed to determine its meaning and scope."). The parties also agree that a design patent's claim is limited to the ornamental, novel features illustrated by its drawings. *See* Joint Stmt. at 2 (citing OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed.Cir.1997) and In re Mann, 861 F.2d 1581, 1582 (Fed.Cir.1988)). Additionally, the parties agree that the novelty of a claimed design is determined by the non-functional features of the claimed design which are not found in the prior art. *See id.* (citing Litton Sys., Inc. v. Whirtpool Corp., 728 F.2d 1423, 1444 (Fed.Cir.1984)). In connection therewith, the parties currently do not rely on any references other than the references discussed above that were cited during the prosecution of the '539 patent, namely, U.S. Patent No. Des. 347,887 ("Liu"), U.S. Patent No. Des. 357,978 ("Young"), U.S. Patent No. Des. 363,345 ("Wang"), and U.S. Patent No. 1,086,274 ("Cardosa"). *See* id. at 5-6.

The foregoing is essentially the extent of the parties' agreement. In particular, as illustrated by the parties' respective proposed methods and forms of claim construction discussed below, the parties have polar opposing views on what form *Markman*-type claim construction should take in cases involving a design patent, and, to a lesser extent, on *when* the Court should actually perform a *Markman* analysis.

1. Minka's Proposed Method of Claim Construction

Minka argues that the claim of a design patent should be construed by carrying out the following steps:

(a) review that design patent's illustrations;

(b) identify the ornamental features, *i.e.,* the features that are not purely functional, illustrated in the design patent's illustrations (the "Ornamental Set");

(c) review the illustrations of the prior art for ornamental features included in the Ornamental Set;

(d) subtract from the Ornamental Set those ornamental features also found in the prior art, leaving as a remainder the set of novel, ornamental features of the design patent (The "Ornamental, Novel Set"); and

(e) let the Ornamental, Novel Set equal the scope of the design patent claim.

Joint Stmt. at 2-3. Minka then proposes the following claim construction by applying those steps:

(a) reviewing Figs. 1-7 of the '539 Patent,

(b) the only purely-functional, non-ornamental feature illustrated in Figs. 1-7 of the '539 Patent is the short, rectangular downrod situated at the topmost part of the design (and best illustrated at the top of Figs. 2-5 ...); thus, the '539 Ornamental Set includes all illustrated features except for the downrod feature,

(c) reviewing the illustrations of the prior art ... for ornamental features included in the '539 Ornamental Set;

(d) the ornamental features illustrated in the prior art and included in the '539 Ornamental Set are:

(i) the number of blades (*Liu* and *Wang,* ...: 5 blades);

(ii) the tilt of the blades (*Young* and *Wang,* ...: angled at an acute degree from the plane perpendicular to the fan axis); and

(iii) the location of a single light cover (*Young,* ...: at center of fan blades);

Subtracting features (i)-(iii), above, from the '539 Ornamental Set, we are left with the '539 Ornamental, Novel Set;

(e) let the '539 Ornamental, Novel Set equal the scope of the '539 Patent' s claim.

Id. at 3. Minka argues that the Court should construe the claim of a design patent simply as the "overall visual ornamental impression" conveyed by the patent's drawings, without articulating any written description. *See* Minka's Opening Brief at 1-2. If any written description of the claimed design is necessary, Minka would permit, at most, the inclusion of a short simile concerning the overall ornamental appearance of the design. *See id*. at 10. Although Minka urges that the Court should identify the purely functional features of the claimed design after hearing testimony regarding functionality at trial, *see id*. at 2 & 7, Minka also argues that the Court should leave the determination of overall functionality, *i.e.,* invalidity, to the jury. *See id*. at 8. Minka also argues that the Court should leave the determination of the points of novelty of the '539 patent to the jury. *See* id. at 7.

In sum, Minka proposes the following as its construction for the '539 patent claim:

"the overall visual impression conveyed by the ornamental design for a combined ceiling fan and light as shown in its seven (7) drawings."

Id. at 10. In the alternative, Minka proposes the following claim construction:

"the overall 'spiral galaxy'-like visual impression conveyed by the ornamental design for a combined ceiling

fan and light as shown in its seven (7) drawings."

Id.

2. Craftmade's Proposed Method of Claim Construction

Craftmade, on the other hand, urges that the Court should "carefully articulate each of the ornamental features that create the overall ornamental visual impression of the patented design." Craftmade's Response Brief at 1. Craftmade asks the Court to provide "a detailed written description of each of the design features that comprise the claim of the '539 Patent.' Id. at 7. In particular, Craftmade argues that "a second, and equally important, element [to the overall visual impression] of the 539 Patent's claim interpretation is the point of novelty of the design embodied in the 539 Patent. Joint Stmt. at 4. Craftmade argues that "[i]t is appropriate for the court to set forth, in words, the 539 Patents point of novelty," and urges that the "scope of the 539 Patents point of novelty is limited to the combination of its housing * * *, its bracket * * *, its blades * * *, and its light fixture or globe * * *." Id. Craftmade urges the Court to adopt the following descriptions for those elements:"

1. The Housing

The Housing portion of the '539 Patent has two equally wide horizontal bands. One of the horizontal bands is perpendicular to the Brackets, while the other band is concave. In addition, the Housing portion displays one shoulder between each band. *See* ... Figs. 2 through 5.

2. The Bracket

The Bracket is an asymmetrical star having an interior closed loop that accentuates the asymmetrical star-shape. The Bracket is attached to the Housing and to each Blade. The Bracket follows one edge of the Blade for a distance equivalent to one-third of the blade. The opposite edge of the Blade is bare and reveals the bent Blade. *See* ... Figs. 1, 7.

3. The Blades

The wide Blades of the '539 Patent curve away from the Housing. The leading edge of the Blade curves, while the trailing edge is straight. The end of the Blade is round. *See* ... Figs. 1, 6 and 7.

4. The Light Fixture/Globe

The Light Fixture or Globe of the '539 Patent lies beneath the Housing, the Bracket, and the Blades. The Light Fixture or Globe contains a downwardly extending band with a curved surface forming a Globe. *See* ... Figs. 1 through 5.

Craftmade's Response Brief at 9-10.

Craftmade further argues that the Court should identify the functional elements of the patented design, *see* id. at 12, citing OddzOn, 122 F.3d at 1405 ("Where a design contains both functional and non-functional (ornamental) 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."). As noted above, Minka asserts that "the only purely-functional, non-ornamental feature * * * is the short, rectangular downrod situated at the topmost part of the design * * *." Joint Stmt. at 3. Craftmade argues that, in addition, "the number, size, angle, and shape of the Fan Blades serve a functional purpose," and therefore those features cannot be part of the claimed ornamental design. Craftmade's Response Brief at 13. Finally, Craftmade argues that the Court should conduct the foregoing detailed claim construction now rather than postpone claim construction until trial. *Id.*

F. Claim Construction Perspective-Whose Eyes Does One Use?

Before turning directly to resolving construction of the '539 patent claim, there is a related, and to a large extent, unresolved, issue that the parties have treated more or less in passing. That issue is what perspective the Court should use in adopting a particular construction of a design patent claim.

1. Design Patent Cases Require At Least Two Sets of Eyes

Utility patents are written to be read and understood by individuals of ordinary skill in the art. Therefore, terms and phrases used in utility patent claims must be construed through the eyes of one of ordinary skill in the relevant art. *See* Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1554 (Fed.Cir.1997). Technical terms in utility patents, accordingly, are given the ordinary and accustomed meaning such terms would be given in the relevant art at the time the application maturing into the subject patent was filed, unless the specification or prosecution history indicates that the inventor adopted a different meaning for such term. *See* National Recovery Techs, Inc. v. Magnetic Separation, 166 F.3d 1190, 1195 (Fed.Cir.1999). Thus, claims in utility patents are construed from the same perspective, namely through the eyes of one having ordinary skill in the art, for determining both validity and infringement, *i.e.*, there is just one set of relevant eyes.

The same is not true for design patents. Resolving design patent infringement and obviousness invokes at least two different sets of eyes. First, design patent infringement is judged using the perspective of "an ordinary observer giving such attention as a purchaser usually gives." Gorham, 81 U.S. at 528. With respect to obviousness, however, as the result of statutory construction, a different set of eyes are used. That portion of the patent statute dealing with design patents provides that "[t]he provisions of this title relating to patents for inventions [*i.e.*, utility patents] shall apply to patents for designs, except as otherwise provided." 35 U.S.C. s. 171. One of those patentability requirements that is applicable equally to utility and design patents is that the invention/design must have been non-obvious within the meaning of 35 U.S.C. s. 103 ("A patent may not be obtained though the invention is not identically disclosed * * * as set forth in section 102 of this title, 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 * * * *to a person having ordinary skill in the art to which said subject matter pertains*." [emphasis added.]) at the time the invention was made. Thus, in judging validity of a design patent under s. 103, the Federal Circuit has held that the claimed design and the prior art must be considered from the perspective of "a designer of ordinary skill who designs articles of the type involved." Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed.Cir.1996) (citing In re Rosen, 673 F.2d 388, 390 (C.C.P.A.1982)). *See also* In re Nalhandian, 661 F.2d 1214, 1216 (C.C.P.A.1981)(resolving prior inconsistent standards). *But see* In re Bartlett, 49 C.C.P.A. 969, 300 F.2d 942, 972 (C.C.P.A.1962)(applying the "average observer" test in determining anticipation under s. 102).

Current case law does not clearly specify which of those two sets of eyes should be used when "construing" a design patent claim-and suggests that neither set should be used.

2. The Eyes of the Ordinary Observer

Minka initially urged that "one construes a design patent through the eyes of an ordinary observer." Minka's Opening Brief at 8. In comments to the initial Draft Report and Recommendation, Minka urged two variations of that "ordinary" observer. Minka first urged that "the claims should be construed through the eyes of an ordinary observer of an article that incorporates the patented design, as opposed to the ordinary purchaser of the allegedly infringing article." Minka alternatively urged that "the claims should be construed

through the eyes of a truly ordinary observer, *i.e.,* a person with no special qualifications, similar to the guidelines used in determining the proper standard of care in an ordinary negligence case." Minka's Comments at 10.

Minka cites no case law support for either alternative. There is good reason that no case law has been cited. Although the eyes of an ordinary observer are used in determining infringement and although it would thus seem to make sense to use those same eyes during claim construction, current Federal Circuit precedent does not clearly provide support for that view. Indeed, one case specifically suggests that the "ordinary observer" perspective should *not* be used.

That case is Goodyear, 162 F.3d 1113, and involved one of Goodyear's design patents on a tire tread design. The design patent claim called for the "ornamental design for a tire tread, as shown and described." 162 F.3d at 1116. On appeal from the district court's finding of non-infringement, Goodyear argued that the district court had erred in construing "tire" as meaning a truck tire; namely, Goodyear argued that the district court had "erroneously selected a purchaser of truck tires as the 'ordinary observer' from whose viewpoint infringement is determined." *Id*. Goodyear argued that "tire" should have been construed as meaning any kind of tire, and that the "ordinary observer" should therefore have been characterized as a ordinary tire purchaser. In response, the Federal Circuit agreed "that the '080 patent is not limited to truck tires, for there is no such limitation on the face of the patent, or arising from the prosecution history." *Id*. The court further explained, though, that " *it is not a matter of claim construction to determine the qualifications of the observer through whose eyes infringement is determined*." [Emphasis added.] *Id*. *But see* Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed.Cir.1988)("the district court correctly viewed the design aspects of the accused devices: the wooden balls, their polished finish and appearance, the proportions, the carving on the handle, and all other ornamental characteristics, considered to the extent that they would be considered by 'the eye of an ordinary observer." ').FN10

FN10. In context, though, it is unclear whether the Federal Circuit in *Dayton Hudson* was commenting on the trial court's claim construction or its finding of non-infringement.

Thus, the Federal Circuit's direction in *Goodyear* to leave the attributes of an "ordinary observer" indeterminate during design patent claim construction strongly suggests that design patent claims should not be "construed," in a *Markman*-sense, through the eyes of an ordinary observer (or any other standard). Having said that, though, the Federal Circuit next wrote in *Goodyear* that "deception concerning the patented design is determined from the viewpoint of the person who is the ordinary purchaser of the article charged to be an infringement," *id.,* and concluded that the district court had correctly found that the "ordinary observer" was an ordinary trucker or fleet operator who purchases truck tires because the accused Hercules Power Trac was a truck tire. *Id*. at 1117.

Although the Federal Circuit held that Goodyear's design patent claim was not properly construed as being limited to truck tires, the court nevertheless performed its ultimate infringement analysis using the perspective of a buyer of truck tires because such buyers were the ones potentially deceived. One might gainfully ask what the point of claim "construction" is if that "construction" is blind in terms of the ultimate standard that must be used in determining infringement.

Nevertheless, one necessary conclusion from *Goodyear* is that if the accused tire had been a passenger car or some other tire, the attributes of the "ordinary observer" would also have changed, and a different

infringement conclusion may have resulted. If the claim of a design patent must be construed, as Minka says, through the eyes of an "ordinary observer," then (1) contrary to the Federal Circuit's direction in *Goodyear,* the qualifications of such an observer must necessarily be determined, and (2) the qualifications of such an observer must be determined in light of the accused infringing product. Doing so would introduce yet a further distinction between claim construction in a design patent case versus a utility patent case. In a utility patent context, the Federal Circuit has cautioned that claim construction should be performed notwithstanding the impact of a particular construction on infringement, and irrespective of the accused infringing product or process. *See generally* Vivid Techs. v. American Science & Eng'g, Inc., 200 F.3d 795 (Fed.Cir.1999). If the "ordinary observer" perspective were required to be used when construing a design patent claim, then the court must necessarily have information regarding the accused infringing product as well as information concerning the typical purchasers of such products. Moreover, because the qualifications of the ordinary observer may change depending on the nature of the accused infringing product, at least in theory, the "scope" of a design patent claim could therefore change as well, *i.e.,* a relatively sophisticated or discerning "ordinary observer" would presumably accord less "scope" to a design patent claim than an unsophisticated "ordinary observer." All of which seems to beg the very nature of *Markman*-type claim construction of a design patent claim. Using the "ordinary observer" perspective would not result in a single, true, consistent "construction" of a design patent claim.

The two alternatives that Minka suggests in its comments to the prior Draft Report and Recommendation must also be rejected. First, Minka points to no support for either alternative in any published decision by the Federal Circuit, or its predecessor courts. Secondly, adopting either alternative would introduce a third set of "eyes" into the analysis of design patent infringement, without adequate justification for doing so.

Perhaps more importantly, though, the seeming attractiveness and logic of both alternatives quickly and readily evaporates on closer inspection. Indeed, neither of the alternatives that Minka suggests actually articulates any standard. For example, Minka's first alternative is that "the claims should be construed through the eyes of an ordinary observer of an article that incorporates the patented design, as opposed to the ordinary purchaser of the allegedly infringing article." Minka's Comments at 10. Ceiling fans, such as those at issue here, may be "observed" by "ordinary" people in home improvement stores, department stores, lighting fixture outlets and a variety of other retail sales location. Ceiling fans may also be "observed" by "ordinary" people in hotels, restaurants, business offices and numerous other locations. In each instance, the person "observing," *i.e.,* seeing, a ceiling fan may give it attention ranging from a casual glance to a discerning inspection. The point is, one who simply "observes" or sees an article of manufacture, such as the ceiling fans at issue here, may or may not accord the article any level of attention whatsoever. That, of course, is one of the reasons that the viewpoint for determining infringement is that of a person who is the ordinary purchaser of the article charged to be in infringement. Such individuals are presumed to accord an article they are planning to purchase at least some level of discernment, although the sophistication and degree of that review will vary with the type of product at issue. Factual evidence may thus be adduced on the characteristics and qualifications of such an individual. Factual evidence on the class of people who ordinarily "observe" or see ceiling fans, on the other hand, who are not also prospective purchasers of the same, would be so wide and varied as to be meaningless. The same is true for Minka's alternative, namely a "truly ordinarily observer." Although Minka analogizes such an individual to "the proper standard of care in an ordinary negligence case," Minka's Comments at 10 n. 2, that is not an accurate analogy. The "reasonable man" standard familiar in tort cases has been quantified and qualified, *see, e.g.,* Restatement (Second) of Torts s. 283(b) FN11 as has the "one of ordinary skill in the art" standard in patent cases. *See, e.g.,* Bausch and Lomb Co. v. Barnes-Hind/Hydrocurve, 796 F.2d 443, 449-450 (Fed.Cir.1986). FN12 An "ordinary observer," on the other hand, as noted above, may range from someone giving an article a passing glance to

someone who accords an article intense inspection. In short, "ordinary observer" is akin to no standard at all and by itself is meaningless.

FN11. The RESTATEMENT (SECOND) OF TORTS, s. 283(b) , explains: " *Qualities of the 'reasonable man*.' The words 'reasonable man' denote a person exercising those qualities of attention, knowledge, intelligence, and judgment which society requires of its members for the protection of their own interests and the interests of others."

FN12. The court listed six factors relevant to a determination of the level of ordinary skill in the art: "[E]ducational level of the inventor, type of problems encountered in the art, prior art solutions, rapidity of innovation, sophistication of technology, and educational level of active workers in the field."

Moreover, introducing a "third" set of eyes different from those used to determine either obviousness or infringement adds no consistency to the analysis and, indeed, detracts therefrom. As noted above, an "ordinary observer" *per se,* or an ordinary, non-purchasing observer of articles that incorporate the patented design, potentially encompasses such a wide range of individuals with even a wider range of "observations," that the analysis becomes useless. Moreover, such an analysis says nothing about either infringement or validity. Determining how a shopper on a Saturday afternoon intent on buying plumbing fixtures in a home improvement store would view a display of ceiling fans in the same store is totally irrelevant to both infringement and validity. Similarly, determining how a diner in a seafood restaurant views the restaurant's ceiling fans is totally irrelevant to both infringement and validity. Adopting a familiar colloquialism from the 1970s, the design patent infringement analysis needs a third set of eyes about as much as a fish needs a bicycle.

Accordingly, Minka's two alternative "eyes" must be rejected.

3. The "Reasonable Competitor" or "Designer of Ordinary Skill Who Designs Articles of the Type Involved" Eyes

The Federal Circuit has recognized that the "requirement that the court construe disputed claim language, as applied to design patents, must be adapted to the practice that a patent design is claimed as shown in its drawing," Goodyear, 162 F.3d at 1116, and the foregoing illustrates some of the difficulties in doing so. There is another difficulty. In Markman v. Westricw Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995)(*en banc*), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), the Federal Circuit reasoned that claim construction was properly a matter of law because "it is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude" and that "competitors should rest assured, if infringement litigation occurs, that a judge, trained in the law, will similarly analyze the text of the patent and its associated public record and apply the established rules of construction, and in that way arrive at the true and consistent scope of the patent owner's rights to be given legal effect." 52 F.3d at 978-79. Does "adapting" claim construction to design patents then mean that design patent claims should be viewed, for claim construction purposes, from the perspective of a competitor? Likely not.

In *Gorham,* the design patent-at-issue was for a new design for tablespoon and fork handles. Both parties presented a number of witnesses, many, if not most of whom, were jewelers and silver-smiths, on the question of substantial similarity between the patented and accused designs. In general, several such

witnesses appearing on behalf of the plaintiff acknowledged that there were "substantial differences between the patterns," but also testified that the designs were "so nearly alike that ordinary purchasers would be led to mistake the one for the other." 81 U.S. at 515. Witnesses having similar qualifications appearing on behalf of the defendant, on the other hand, detailed a litany of differences they could detect between the designs. The trial court found no infringement rejecting the "ordinary observer" standard. The trial court concluded that design patent infringement should be judged "in view of the observation of a person versted [sic. versed] in the business of designs in the particular trade in question-of a person engaged in the manufacture or sale of articles containing such designs-of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side." Id. at 522.

The Supreme Court soundly rejected that standard explaining that "[s]uch a test would destroy all the protection which the act of Congress [authorizing design patents] intended to give." Id. at 527. The Court reasoned:

There never could be piracy of a patented design [if that were the test], for human ingenuity has never yet produced a design, in all its details, exactly like another, so like, that an expert could not distinguish them. * * * Experts, therefore, are not the persons to be deceived. Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, bring to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give.

Id. at 527-28. By analogy, a competitor, presumably having at least some expertise in producing the articles bearing a patented design, would likely be able to provide a litany of differences between the accused and patented designs (as the defendant's witnesses did in *Gorham*), and in doing so would necessarily or inherently "construe" the patented design in perhaps more detail, *i.e*., more narrowly, than an "ordinary observer." The same holds true for "a designer of ordinary skill who designs articles of the type involved," *i.e*., the standard used for determining obviousness, who likewise, by definition, would seem to hold at least some modicum more expertise than an "ordinary observer," and may, indeed, have extensive expertise. Thus, it seems unlikely that the correct standard for claim construction should be either a "reasonable competitor" or "a designer of ordinary skill who designs articles of the type involved."

4. Whose Eyes Have It?

Assuming that the correct standard is also not the "ordinary observer" standard, the question becomes whether the trial court is required to adopt some particular perspective in construing the claim of a design patent other than the court's own perspective.

Some clues emerge from cases involving questions of design patent validity. In Durling v. Spectrum Furniture Co., 101 F.3d 100 (Fed.Cir.1996), for example, in the context of explaining the trial court's proper obviousness analysis of a design patent, the Federal Circuit noted that "[i]n comparing the patented design to a prior art reference, the trial court judge may determine almost instinctively whether the two designs create basically the same visual impression." Id. at 103. "Nonetheless," the court noted, "the judge must communicate the reasoning behind the decision." *Id*. In short, the trial court, in a validity context, is charged with evaluating and then providing visual descriptions of the patented and prior art designs. Doing so, according to the Federal Circuit, provides the parties and the appellate courts with "the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design." *Id*. The trial court does so using its own perspective, aided by whatever evidence or

submissions the court may request from the parties.

The trial court is charged under *Markman* with construing the claims as a matter of law, *i.e.,* resolving the parties' disputes concerning the claims-or, in the case of design patents, the single formal claim. It seems to follow that the trial court should itself, through its own eyes, evaluate the patented design in resolving whatever disputes arise, aided by whatever other testimony or evidence the court chooses to consider, but recognizing that claim construction must depend primarily, if not solely, on the intrinsic record before the court. *See* Vitronics v. Conceptionic, Inc., 90 F.3d 1576, 1583 (Fed.Cir.1996). Although, in a utility patent context, the Federal Circuit has recognized that "the testimony of one skilled in the art about the meaning of claim terms at the time of invention will almost always qualify as relevant evidence," Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1555 (Fed.Cir.1997), that would seem to have questionable relevancy in light of the admonitions of *Gorham,* discussed above. Thus, while a court may admit and accept testimony by the parties' expert witnesses as background in the technical area at issue in utility patent cases, Mantech Environmental Corp. v. Hudson Environmental Systems, Inc., 152 F.3d 1368, 1372-73 (Fed.Cir.1998), and while the Federal Circuit has held that "it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field," Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1309 (Fed.Cir.1999), it would seem that the fundamental differences in adjudging infringement in a design patent case as compated to a utility patent case would typically render such testimony largely unhelpful. On the other hand, though, such testimony might prove helpful, in appropriate cases, in assisting resolution of functionality and "point(s)-of-novelty" issues.

In its comments, Minka urges that "[i]f a court is permitted to construe design patent claims without adopting any particular perspective and thus resolve whatever claim construction issues arise through its own eyes, there is effectively no standard for construing the claims," and that the "claims would likely be construed differently depending on how discerning the examining court is." Minka's Comments at 10. Although that is, to some extent, perhaps true, the court's proper role in design patent claim construction, as discussed below, would seem to primarily involve resolving disputes between the parties, *i.e.,* whether a particular description in words accurately conveys the protected visual impression of a patented design. In doing so, the court is not permitted to rewrite the claim, but may bring its legal expertise to bear in ensuring that *Markman*-type claim construction of a design patent claim accurately explains the legal effect of that claim. Furthermore, requiring courts to provide a written description, as discussed above, provides the parties and the appellate court with an appropriate basis to review the actions taken by the court.

Also, because design patents deal with visual appearances, there is necessarily some degree of subjectivity involved. Differences between descriptions of a design by two or more people must, to some extent, simply be tolerated. Judges, jurors, "ordinary observers" and "ordinary designers" all share the frequently frustrating, but nonetheless universally applicable, quality of having been born fallibly human; less than divine. Two judges may differ in their descriptions of a design, but so too may two "ordinary observers" and two "ordinary designers." Indeed, in *Gorham,* even the silver-smiths differed in the emphasis they placed on various aspects of the design at issue. Unskilled "ordinary observers" (which in this case would likely include the jurors themselves) could presumably differ yet further. At the very least, judges may differ in what they see, but would likely find harmony in evaluating the legal effect of a design patent claim.

Accordingly, the special master recommends that the Court not adopt any particular perspective in resolving disputed claim construction issues, *i.e.,* not the perspective of an "ordinary observer," a "reasonable

competitor," or "a designer of ordinary skill who designs articles of the type involved," but rather that the Court resolve whatever claim construction issues arise through its own eyes aided by whatever other submissions the Court chooses to consider.

III.

Discussion

A. The Court's Role in Construing Design Patent Claims

As noted above, the present dispute principally centers on how and when the Court should resolve the meaning of the '539 patent claim and how the Court should articulate that meaning. The first and foremost issue is the extent to which the claimed design should be "construed," *i.e.,* described in words. The parties agree, and the Federal Circuit has held, that the trial court must construe a patented design as a matter of law. *See* Elmer, 67 F.3d at 1577. The problem with doing so here is that the parties' fundamental disagreement over how the Court should proceed with claim construction has resulted in the parties' failure to join issue on what actually requires resolution by the Court. Basically, as noted above, Minka would have the Court simply instruct the jury that the claimed design covers the overall visual impression shown in the drawings, perhaps adding the term "spiral galaxy" to describe the overall visual impression. *See* Minka's Opening Brief at 10. Craftmade, on the other hand, would have the Court provide the jury with a detailed description of each ornamental feature of the various listed parts. *See* Craftmade's Response Brief at 7. Neither correctly implements the trial court's actual role in claim construction in design patent cases. On the other hand, the Federal Circuit has not clearly articulated what the trial court should do, either.

1. The Court is Not Permitted to Rewrite the Claims

Some guidance, though, comes from what a court is *not* permitted to do in construing patent claims, whether those claims appear in a utility or design patent. That is, trial courts are not permitted to rewrite the claims. Becton Dickinson & Co. v. C.R. Bard Inc., 922 F.2d 792, 799 n. 6 (Fed.Cir.1990)("Nothing in any precedent permits judicial redrafting of claims."). In *Markman,* the Federal Circuit instructed trial courts to resolve the meaning of *disputed* claim terms as a matter of law. 52 F.3d at 979. That does not require a trial court to explain each word, term and phrase in a claim. *See* United States Surgical Corp. v. Ethicon, Inc., 103 F.3d 1554, 1568 (Fed.Cir.1997), *cert. denied,* 522 U.S. 950, 118 S.Ct. 369, 139 L.Ed.2d 287 (1997)("The *Markman* decisions do not hold that the trial judge must repeat or restate every claim term in order to comply with the ruling that claim construction is for the court. * * * It is not an obligatory exercise in redundancy.") The Federal Circuit has repeatedly emphasized that "[t]he actual words of the claim are the controlling focus." Digital Biometrics, Inc. v. Identix, Inc., 149 F.3d 1335, 1344 (Fed.Cir.1998). Also, the court must independently review and construe disputed claim terms irrespective of the parties' positions. *See* Exxon Chemical Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1555 (Fed.Cir.1995), *cert. denied,* 518 U.S. 1020, 116 S.Ct. 2554, 135 L.Ed.2d 1073 (1996).

2. But a Court is Required to Resolve the Parties' Disputes Concerning Claim Construction

Although the courts cannot rewrite patent claims, courts may, and are required, to "explain" disputed terms and phrases used in the claims. The Federal Circuit recently noted that "[t]he role [of claim construction] is neither to limit nor broaden the claims, but to define, as a matter of law, the invention that has been

patented." Network, L.L.C. v. Centmal Corp., 242 F.3d 1347, 1352 (Fed.Cir.2001). In the context of utility patent claims, a "dispute" as to the meaning or interpretation of a word or phrase arises if there is an underlying disputed issue, for example, whether statements in the specification or elsewhere in the intrinsic record indicate that the patentee intended an uncommon or special meaning for a term or phrase, *i.e.,* the meaning of "inventory" in *Markman,* or if a term or phrase is ambiguous. In the design patent context, a "dispute" arises differently.

For example, in the present case, the claim in the '539 patent-in-suit calls for "[t]he ornamental design for a combined ceiling fan and light, as shown." The Court is not permitted to rewrite that claim. But, what, then, should the Court do in "construing" the '539 patent claim? Minka says, as noted above, that the Court should construe the claim as "the overall visual impression conveyed by the ornamental design for a combined ceiling fan and light as shown in its seven (7) drawings." Minka's Opening Brief at 10. Craftmade, on the other hand, urges that the Court should identify the "individual elements" of the article bearing the patented design, namely the housing, bracket, blades and light fixture/globe, and then provide a description of the "ornamental design components" for those elements. Craftmade's Response Brief at 9. Those are the types of disputes that courts are well-equipped to resolve, and which would seem to be contemplated by *Markman* adapted to a design patent setting.

Thus, it would seem that a court's proper role in claim construction should initially, and at least, extend to deciding the extent to which a patented design requires an explanation in words to define, as a matter of law, the design that has been patented. Some designs may require more explanation than others in order to properly inform the jury what has been patented. Other designs may require little or no explanation. In any event, that decisional process primarily involves an interpretation of Federal Circuit's guidance, something a court is well equipped to do.

It would also seem that a court's proper role in design patent claim construction should secondarily extend to resolving disputes, if any, between the parties concerning whether a particular description accurately conveys, in words, the protected visual impression of a patented design. *Markman* requires trial courts to resolve the meaning of disputed claim terms and phrases. As the court explained in *Network,* that results in defining, as a matter of law, the invention that has been patented. Because design patents involve visual appearance, by analogy, *Markman* would seem to require a trial court to resolve disputes whether a particular description in words accurately conveys the protected visual impression of a patented design.

In many, if not most, cases, given that patented designs are by their very nature visual, the parties presumably should be able to agree on words that accurately convey the visual appearance of a patented design. However, if the parties dispute whether, for example, a surface is more accurately described as "curved," or "angled" and the like, or whether a particular feature of the design is normally hidden from view, it would seem that a court has more than adequate ability to resolve such disputes based on its own experience and an inspection of the design-in-dispute coupled with the court's understanding of the law applicable to design patents. Doing so would also seem to be consistent with the *Markman* rationale that if infringement litigation occurs, a judge trained in the law will properly analyze the design and apply the law applicable to design patents in a way that results in defining the legal effect of the patented design.

Accordingly, the special master recommends that the Court reject the constructions proffered by both parties. *See Exxon, supra*. The patent claim is and remains "[t]he ornamental design for a combined ceiling fan and light, as shown." The Court is not permitted to rewrite that claim, but the Court should, as part of *Markman*-type claim construction, accurately explain the legal effect of that claim.

Although "the overall visual impression" that Minka points to is one facet of the infringement analysis, "[i]n analyzing visual similarity, '[w]here * * * a [patented] design is composed of functional as well as ornamental features, to prove infringement, a patent owner must establish that an ordinary person would be deceived by reason of the common features in the claims and accused designs which are ornamental," ' and additionally that the accused design must have "appropriate[ed] the novel ornamental features of the patented design that distinguish it from the prior art." Elmer, 67 F.3d at 1577 (internal citations omitted.) "Construing" the '539 patent claim as Minka suggests resolves nothing, and so charging the jury would have the likely effect of misleading the jury into believing that they need not consider other necessary factors, *e.g.,* the primarily functional aspects of the design, if any, as well as whether the accused design appropriates the point(s)-of-novelty of the patented design.

Craftmade's proposed construction, on the other hand, is not recommended because it would, in essence, have the court giving the jury a parts list along with a description of what those parts separately look like in only the most general terms. Craftmade, though, is correct that claim construction of a design patent claim should involve a description of the patented design, to the extent that such a description is necessary to resolve a dispute between the parties and to properly advise the jury on the legal effect of the patented design.

Specifically, a court's construction of a design patent claim should resolve any party disputes between what have been described as "general design concepts" and the actual ornamental features that collectively produce the patented design. *See* OddzOn., 122 F.3d 1396, 1405 (Fed.Cir.1997)("In construing the claim of OddzOn's patent, the district court carefully noted the ornamental features that produced the overall 'rocket-like' appearance of the design. We agree with the district court's claim construction, which properly limits the scope of the patent to its overall ornamental visual impression, rather than to the broader general design concept of a rocket-like tossing ball."). Also, a court's construction of a design patent claim should resolve any party disputes about what are functional and non-functional aspects of the design. *Id*. ("Where a design contains both functional and non-functional 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.")

In doing so, a court does not invade the province of the jury to determine infringement any more so than when a court "construes" utility patent claims for a jury by resolving party disputes about the meaning of words and phrases. The jury in a design patent case remains charged, under proper instructions, with deciding, ultimately, whether the accused design infringes the patented design. Any description of the patented design that the court gives, therefore, should not, and cannot, transform the jury's ultimate decision into one that would require the jury to compare a court's description of the patented design with the accused product, *i.e.,* something akin to reducing a patented design to a written description and then comparing that written description to the accused design on an element-by-element basis analogous to determining whether a utility patent claim "reads on" an accused product or process. The ultimate infringement decision must remain based on a comparison of the patented design with the accused product. Any description that a court provides the jury in the context of claim construction should, therefore, simply assist the jury in understanding the legal effect of the claim of a design patent so that the jury is better prepared to perform its role of determining infringement.

3. Cases Cited by the Parties

Although the Federal Circuit has not given the trial courts a great deal of guidance on what the courts

should do in construing design patent claims, the cases cited by the parties seem to generally support the proposition that the court should provide a description that evokes the visual appearance of the ornamental features of a patented design. Once again, doing so does not and cannot divert the jury's role in judging infringement from a comparison of the patented design and the accused product. But providing such a description should assist the jury in understanding the legal effect of the patented design.

Minka, in urging that the Court should summarily inform the jury that the '539 patent claim covers "the overall visual impression" of the design, relies primarily on Durling v. Spectrum Furniture Co., 101 F.3d 100 (Fed.Cir.1996), OddzOn Products. Inc. v. Just Toys, Inc., 122 F.3d 1396 (Fed.Cir.1997), and Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc., 47 U.S.P.Q.2d 1843 (E.D.Va.1998). Minka's reliance on those cases is misplaced.

Durling involved an obviousness analysis of a design patent under 35 U.S.C. s. 103, and noted the distinction that the trial court should make in distinguishing visual appearances from general design concepts. 101 F.3d at 104. In doing so, the Federal Circuit emphasized that the trial court should translate the drawings into a written description that evokes the visual image of the claimed design. Id. at 103 & n. 2. The Federal Circuit criticized the trial court's written description in *Durling* as being insufficient to evoke a visual image consonant with the claimed design, noting that the trial court's description merely represented "the general concept of a sectional sofa with integrated end tables ." *Id*. at 104. In particular, the trial court had described the claimed design as " 'a sectional sofa with double rolls of upholstery under the seating area which curve arcuately upward under the end tables. The end tables have the appearance of little vertical support.' " *Id*. at 103-04. Instead, the Federal Circuit indicated that the proper claim construction was:

This visual appearance is that of a contiguous three-piece sectional sofa group containing two sofa sections at approximately right angles to each other with a triangular corner table at their juncture. On the sides away from the corner table, each sofa section has rounded corners and includes a bolster pillow as an arm-rest. In addition, each sofa section has a double front rail that begins at the end adjacent to the corner table, follows along the bottom of the sofa towards the other end, and curves upwardly (*i.e.*, sweeps upward) through a 90 ~angle to truncate at a horizontal plane upon which the end table rests.

Id. at 104. Thus, the Federal Circuit indicated that a reasonably detailed description of the various ornamental features of the claimed design and their interrelationships was appropriate in order to properly evoke, in words, a visual image of the overall appearance.

Similarly, in *OddzOn,* the plaintiff patentee, OddzOn, argued that its claimed design for a football with tail fins should be construed simply as a tossing ball having a "rocket-like" appearance. 122 F.3d at 1405. However, the Federal Circuit rejected OddzOn's proposed claim construction as describing merely a general design concept, which was disapproved in *Durling*. The Federal Circuit specifically approved the district court's claim construction which the Federal Circuit characterized as "carefully not[ing] the ornamental features that produced the overall 'rocket-like' appearance of the design." *Id*. Specifically, the district court construed the patented design as:

[A] ball shaped like a football, with a slender, straight tailshaft projecting from the rear of the football. In addition, the [claimed] design has three fins symmetrically arranged around the tailshaft, each of which has a gentle curve up and outward which creates a fin with a larger surface area at the end furthest from the ball. The fins flare outwardly along the entire length of the tailshaft, with the front end of the fin extending slightly up along the side of the football so that the fins seemingly protrude from the inside of the football.

Id. at 1400. Once again, rather than settling for a summary descriptor such as "rocket-like," the Federal Circuit approved a reasonably detailed description of the ornamental features that produced the overall appearance of the patented design. Minka's proposed "spiral galaxy" descriptor is much akin to the "rocket-like" descriptor disapproved in *OddzOn* and is insufficient, by itself, to serve as a proper claim construction for the '539 patent.

By contrast, in *Black & Decker,* although the district court cited *OddzOn* and Durling, see 47 U.S.P.Q.2d at 1845 & n. 2, the court chose not to follow either. Instead, the *Black & Decker* court concluded that the drawings of the claimed design were their own best description. The court simply concluded that the scope of the patented design was "its overall ornamental visual impression" as shown in the drawings, without describing that impression in words. 47 U.S.P.Q.2d at 1845. Although the *Black & Decker* decision is instructive on the problems of adapting *Markman*-type claim construction to design patent cases, in view of the Federal Circuit's reasoning in *OddzOn* and *Durling,* among others, the *Black & Decker* decision does not seem to meet the *Markman* objectives.

Minka also argues that its proposed claim construction is consistent with the PTO rules of practice, 37 C.F.R. s. 1.153(a), namely that "No description, other than a reference to the drawing, is ordinarily required," and says that "[s]urely, if it were appropriate to construe a design patent claim by translating it into a list of design features, the Patent Office regulations would encourage or require an applicant to identify those features in that form in the application." Minka's Opening Brief at 4. That rule, however, simply specifies the content of a design patent application. Similar rules define the content of utility patent applications, but no one has even suggested that such rules should preclude *Markman*-type claim construction in utility patent cases. Once again, the purpose of *Markman*-type claim construction in both utility and design patent cases is specifically *not* to rewrite the asserted claims, but rather to interpret the legal effect of such claims.

Minka also argues that its proposed "overall impression" claim construction "soundly fits both the established test for infringement test [sic] and the Supreme Court's understanding of human perception that underlies that test." Minka's Opening Brief at 4 (citing Gorham, 81 U.S. at 528). Providing a description that assists the jury in understanding the legal effect of a patented design, however, does not, and cannot, change the ultimate test for infringement. Moreover, providing a description of the visual aspects of a design is not at all uncommon in connection with design patents. As the Federal Circuit pointed out in *Durling,* it may, for example, be necessary to translate the overall impression of the drawings "into a common medium of communication" in order for the parties and appellate courts to challenge and review the trial court's decisions. 101 F.3d at 103. In that respect, the construction of a design patent claim is perhaps more complicated than the construction of a utility patent claim because of the extra level of abstraction involved. *See id*. But that does not mean such construction cannot, or should not, be undertaken. Additionally, as already noted, articulating the ornamental appearance of the patented design seems to better achieve the goals of the *Markman* decisions by assisting the jury in identifying any functional aspects of the claimed design, as well as in understanding the legal effect of the patented design.

4. Recommended Construction

Although it seems clear that both parties' proposed constructions must be rejected, and although it seems clear that *Markman*-type claim construction should include a description sufficient to assist the jury in understanding the legal effect of a patented design, the parties' initial submissions provided little help in

crafting such a description. For example, Craftmade proposed the following description of the housing: "The housing portion of the '539 Patent * * * has two equally wide horizontal bands. One of the horizontal bands is perpendicular to the brackets, while the other band is concave. In addition, the housing portion displays one shoulder between each band." Joint Stmt. at 4. Minka did not, in response, say whether it agreed with that description or not, but rather simply took the position that the Court should not be providing any such description at all. On the other hand, Minka said that the "ornamental features" illustrated in the prior art, and which should not be considered in ultimately deciding infringement, are (i) the number of blades, (ii) the tilt of the blades, and (iii) the location of a single light cover. Joint Stmt. at 3. Craftmade did not say whether it agreed or disagreed that those were the only "ornamental features" illustrated in the prior art. The parties seem to agree that the "short, rectangular [sic. "tubular"?] downrod situated at the topmost part of the design" is "purely-functional, non-ornamental," Joint Stmt. at 3, but Craftmade also asserted that "because the number, size, angle, and shape of the Fan Blades serve a functional purpose, these aspects of those design features cannot be considered ornamental." Craftmade's Response Brief at 13. However, Craftmade offered no evidence, or even argument, in support of that assertion.

Accordingly, a description was proposed in the Draft Report and Recommendation for the parties' comments. That description was intended to evoke a visual impression of the patented design, but, the Draft Report noted that such description could be neither complete nor final because it could not address the functionality or points of novelty issues. Those issues are addressed further below. After considering Minka's comments on the Draft Report, the special master recommends that the Court adopt the following as its construction of the claim of the '539 patent-in-suit:

The '539 design patent claim is directed to an ornamental design for a combined ceiling fan and light having fan blades that overlie corresponding arms of a central bracket. The central bracket has a circular central opening through which a light fixture dome protrudes downward. The bracket has curved, fin-shaped arms, each of which sweeps outward from its base at the central opening and each of which terminates in a slightly rounded tip. The arms of the bracket are equally spaced about the central opening, and the length of each bracket arm is roughly one-third the length of the corresponding blade. The light fixture dome exhibits a partial sphere that transitions into a generally cylindrical portion adjacent the central bracket. A central housing, located above the fan blades, exhibits a generally cylindrical portion just above the fan blades that transitions into a concave portion.

When viewed from below, the fin-shaped arms of the central bracket seep outward from the central opening in a clockwise direction, which gives the appearance of a "running" pointed star. A symmetrical, elongated, generally football shaped cutout appears behind the leading edge of each arm. The fan blades are also swept in the clockwise direction, with the leading edges of the blades forming a sweeping curve near the bracket central opening. The trailing edges of the blades are straight but slightly offset from a diameter of the bracket central opening. The trailing edge of each blade smoothly transitions into the trailing edge of the corresponding bracket arm, which further forms a curved transition into the leading edge of the next bracket arm. A gently receding are in front of each bracket arm's leading edge runs from the tip of each arm to the middle of the smooth transition. Each fan blade terminates in a gently rounded corner on the leading edge and a sharply angled, rounded corner on the trailing edge. From its tip, the trailing edge of each bracket arm flares inwardly and rearwardly away from the straight trailing edge of the corresponding blade until it intersects the leading edge of the following blade. Due to the sweep of the bracket arms, the leading edge of each fan blade is substantially more exposed than in the trailing edge of each fan blade.

When viewed from above, the fan blades are swept in the counter-clockwise direction, which also gives the appearance of a pointed "running" star. Also when viewed from above, the trailing edge of the bracket arm is visible at the base of each fan blade.

The downrod is omitted from the foregoing description because both parties agree that downrod is purely functional.

B. Functionality and Points of Novelty

In the context of generally urging that the Court should postpone claim construction until trial, Minka argues that "[b]ecause the Court's identification of purely functional features will benefit from facts developed at trial, Plaintiffs respectfully suggest that the Court postpone such identification until then." Minka's Opening Brief at 2. Minka urges that identifying the point or points of novelty and overall functionality are jury issues. Id. at 7-8. Craftmade urges that claim construction should not await trial, and that claim construction should include determining functionality issues. Craftmade's Response Brief at 12-13.

Craftmade is correct that a *Markman* hearing in advance of trial during discovery provides a benefit to both the Court and the parties. The problem is that here, the issues of functionality and points of novelty cannot be resolved on the current record. Concerning functionality, for example, Craftmade argues that the number, size, angle, and shape of the fan blades of the '539 patent cannot be considered ornamental because those features serve a functional purpose, *see* Craftmade's Response Brief at 13, yet Craftmade has provided no evidence whatsoever in support of that conclusion. Presumably the parties could address functionality (and perhaps points of novelty) during an evidentiary hearing (which neither party requested), but Minka is correct that trying those issues now would, in effect, require the parties to try those same issues twice-once at a *Markman* hearing and once at trial. Also, claim construction is necessarily interlocutory unless and until the jury is charged with that construction, or the Court decides a dispositive motion based on that construction, or that construction otherwise becomes the law of the case. Thus, the presumably fuller proofs that the parties may present at trial on the issues of functionality and points of novelty likely would require revisiting any decision made on those issues now. Accordingly, the special master recommends that the Court defer those issues until trial. There are, however, some matters that *can,* and should, be resolved at this stage.

With respect to functionality, in *OddzOn,* the Federal Circuit held that "[w]here a design contains both functional and non-functional 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." 122 F.3d at 1405. Because claim construction is a matter of law for the Court, *OddzOn* may be reasonably interpreted as requiring the Court to identify the functional and non-functional aspects of the claimed design as part of *Markman*-type claim construction. It is true that determining whether individual features are primarily or solely functional may involve analyzing factual submissions and evidence, *see, e.g., Ltd*. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed.Cir.1993)("The elements of the design may indeed serve a utilitarian purpose, but it is the ornamental aspect that is the basis of the design patent."), nevertheless, the same can be said for *Markman*-type claim construction in general. Also, determining the primarily functional aspects of an article of manufacture in the course of analyzing what, in fact, are the design elements protected by a patented design, may be viewed as being closely aligned with traditional claim construction. Doing so is part and parcel to determining the legal effect of a patented design. Accordingly, it would seem most consistent with the *Markman* rationale that trial courts should, as *OddzOn* suggests, identify the non-functional aspects of the patented design as part of the court's claim construction.

Evaluating whether individual features are primarily functional and analyzing the legal effect of such features on the scope of the patented design, though, should be distinguished from determining overall functionality, *i.e.,* validity. Although the Federal Circuit has not specifically so held, it would seem that because validity is a jury issue, overall functionality should be deemed a fact issue that is reserved for the jury. *See, generally,* Hupp v. Siroflex of Am., Inc., 122 F.3d 1456, 1460 (Fed.Cir.1997); Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563, 1566 (Fed.Cir.1996).

Whether and to what extent the trial court should identify the point or points of novelty as part of claim construction, though, raises different concerns. Craftmade urges that "[i]t is appropriate for the court to set forth, in words, the '539 Patent's point of novelty," Joint Stmt. at 4, citing Unidynamics Corp. v. Automatic Prods. Int'l. Ltd., 157 F.3d 1311, 1324 (Fed.Cir.1998). *Unidynamics* was, however, an appeal from a summary judgment, *see id*. at 1314, and thus offers Craftmade little true support. As Minka points out, the Federal Circuit has held that "[t]he question of what the prior art teaches" is a fact issue that is part of an obviousness analysis of a design patent. In re Borden, 90 F.3d 1570, 1576 (Fed.Cir.1996). The same is true when the validity of a utility patent is questioned. *See* Elmer, 67 F.3d at 1574 (holding that "[w]hether the alleged prior art met the claim limitations is a factual question."). By analogy, the point or points of novelty of a design patent would seem to be more properly viewed as fact issues that should be decided by the jury.

Additionally, the point or points of novelty analysis is separate and independent from the ordinary observer analysis. Unidynamics, 157 F.3d at 1323. Even though an accused product exhibits a design sufficiently similar in its collection of ornamental features to those of a patented design that deception would result, infringement can nevertheless not be found if the accused product does not appropriate the novel ornamental features that distinguish the patented design from the prior art. Determining what distinguishes a patented design (or claimed invention) from the prior art has historically been an issue for the jury. There is no reason to depart from that treatment here. If a jury is to be entrusted with determining what distinguishes a patented design (or claimed invention) from the prior art for purposes of validity, it would seem that the same jury could rather easily resolve whether the design of the accused product has appropriated the same ornamental features that distinguish the patented design from the prior art.

Accordingly, although the special master recommends that the Court ultimately modify the foregoing "construction" of the '539 patent claim to eliminate primarily functional features, if any, the special master also recommends that the Court leave to the jury the task of determining what point or points of novelty distinguish the '539 patent design from the prior art, as well as to determine whether the accused product has appropriated the same.

N.D.Tex.,2001.
Minka Lighting, Inc. v. Craftmade Intern., Inc.

Produced by Sans Paper, LLC.