United States District Court,
E.D. Michigan, Southern Division.

In re PLASTICS RESEARCH LITIGATION

No. 97-CV-76323-DT

Aug. 29, 2001.

ORDER CONSTRUING PATENT NUMBERED 402,381

CLELAND**, District J.**

Plaintiff Plastics Research Corporation ("PRC") commenced this action alleging patent infringement of its United States Design Patents numbered 402,381 (the " '381 patent") and 374,485 (the " '485 patent"). Both patents protect plastic lattice products manufactured by PRC. Defendants Weyerhaeuser USA, Inc. ("Weyerhaeuser") and Brite Millwork, Inc. ("Brite Millwork") manufacture competing products. In view of PRC's pending motion to dismiss all claims regarding the '485 patent, the court at this time will address only the '381 patent.

I. DISCUSSION

Pursuant to Markman v. Westview 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), a court conducting a patent infringement analysis must undergo a two-step process. First, the court must determine the meaning and scope of the protected patents. This is known as the claim construction phase and is a question of law for the court. Markman, 52 F.3d at 976, 979. Once the court has interpreted the claims at issue, the second step requires comparing the properly construed claim and the accused device to determine whether the accused device is infringing. Id. at 976. The infringement analysis generally is for the jury.

This matter is presently before the court for construction of the patents under step one. The parties, however, present differing views as to the court's appropriate role at this stage. PRC contends that *Markman* concerned a utility patent, not a design patent as is at issue here, and that the *Markman* analysis thus is inapplicable. Instead, PRC argues that a court must construe a design patent only where it is necessary to distinguish between the patent's ornamental and functional aspects. *See* Oddzon Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed.Cir.1997) ("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."). Asserting that the '381 patent contains only ornamental features, PRC concludes that the court should construe the '381 patent broadly, if at all, and then permit the jury to determine whether infringement has occurred. Weyerhaeuser and Brite Millwork, on the other hand, argue that a design patent must be construed in the same manner as a utility patent. Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995) (stating that "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"). They both propose a point-by-point, narrow construction of the '381 claim.

This court agrees with the approach propounded by PRC, concluding that a broad construction of design patents best conforms with the infringement test that applies in such cases. As set forth by the United States Supreme Court, the infringement analysis for design patents proceeds as follows:

[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). In contrast, to find infringement of a utility patent the plaintiff must show "the presence of every element [of the claimed device] or its substantial equivalent in the accused device." DeMarini Sports, Inc. v. Worth, Inc., 239 F.3d 1314, 1322 (Fed.Cir.2001). Thus, with utility patents, construction is essential to provide the fact finder with the means by which to make the requisite point-by-point comparison. Such a regimented analysis is unnecessary in the design patent context where the fact finder does not seek to compare the protected and accused designs point for point, but rather considers "the *overall* ornamental

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matter of law procedures. Finally, a patent design's limited scope is given further effect by the point-of-novelty requirement, which requires the finder of fact to attribute the similarity between the protected and accused designs "to the novelty which distinguishes the patented device from the prior art." Litton Syss., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed.Cir.1994); Elmer, 67 F.3d at 1577 ("[T]he accused design must appropriate the novel ornamental features of the patented design that distinguish it from the prior art."). In the court's opinion, these factors sufficiently limit the potential that a jury might apply the infringement analysis arbitrarily without being given a point-by-point description of the patent drawings.

II. CONSTRUCTION

Thus, having considered all of the evidence, the court construes the '381 patent as shown and described in the patent drawings and description. The design thus may be described in the following manner.

An injection molded lattice composed of a first set of diagonal slats unitarily formed with a second set of oppositely running diagonal slats to form a lattice with a partial height offset between the first set of diagonal slats and the second set of diagonal slats, having the second set of diagonal slats positioned on top of the first set of diagonal slats, the slats having a wood grain appearance.

The court declines to define the point of novelty at this time. The parties briefs failed to sufficiently address, for example, whether the scope and content of the prior art is a question of fact for the jury or a legal question to be determined by the court. A brief survey of cases indicates that, at least in the obviousness context, the scope and content of the prior art is a question of fact for the jury. *See, e.g.,* Wang Labs., Inc. v. Toshiba Corp., 993 F.2d 858, 863 (Fed.Cir.1993) ("Nonobviousness is a legal conclusion, having factual underpinnings, including the scope and content of the prior art. 'When the ... factual underpinnings have been genuinely disputed, as in this case, we presume that the jury resolved them in favor of the verdict winner." ') (citing Graham v. John Deere Co., 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966)). The

court thus determines that further briefing in this regard is necessary. The parties are encouraged to address the issue more fully in their motions for summary judgment.

IT IS SO ORDERED.

E.D.Mich.,2001.
In re Plastics Research Litigation

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