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

LAMPS PLUS, INC. and Pacific Coast Lighting,
Plaintiffs.
v.
Patrick S. DOLAN, Design Trends, LLC, Lowe's Home Centers, Inc., and Craftmade International, Inc,
Defendants.

No. 3:01-CV-1537-K

Aug. 26, 2003.

MEMORANDUM OPINION AND ORDER

KINKEADE**, J.**

Before the Court are the parties' briefs on claim construction. After conducting a *Markman* proceeding, hearing oral argument of counsel, and reviewing the parties' briefs and all related filings and evidence, including the patents at issue, the specification, the patent prosecution history to the extent it was provided by the parties, and the parties' proposed claim constructions, this Court construes the disputed claim according *to* Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 360 (1996). The relevant patent covers lighting products generally described as "tree torchieres," and includes both a utility patent and a design patent.

Claim Construction

In this lawsuit, plaintiffs Lamps Plus, Inc. and Pacific Coast Lighting (collectively referred to as "Lamps Plus") sued Patrick S. Dolan, Design Trends, L.L.C., Lowe's Companies, Inc., and Craftmade International, Inc. (collectively referred to as "Dolan"), alleging Dolan infringed on United States Patent No. 5,221,141 (the " '141 Patent") issued June 22, 1993, describing a Stand-Alone Electric Lamp, and United States Patent No. Des. 353,904 (the " '904 Patent") issued December 27, 1994, describing a Combined Torchiere Lamp and Adjustable Accent Lights. Lamps Plus contends Dolan has directly infringed the '141 and '904 Patents because they have made, used, sold, or offered for sale and are still making, using, selling or offering for sale infringing products, including lighting products, which infringe the patents at issue.

Construction of the '141 Utility Patent

The determination of patent infringement requires a two-step analysis, the first step being claim construction. Markman, 52 F .3d at 983-84. Construction of a claim is a question of law for the court to decide. *Id*. The proper construction of a claim is based on the claim language, the specification, the prosecution history, and extrinsic evidence, if needed. *Id*. at 979-80. Terms in the claim are to be given their ordinary and customary meaning in the field of the invention, unless a special definition is clearly stated in the specification. *See id*.

The dispute in this case centers on only Claim 5 of the '141 utility patent. Lamps Plus first argues that Claim 5 has already been construed by a Federal Court in previous Florida litigation, and that this Court should

adopt the Florida Court's interpretation of the '141 patent at issue here. Specifically, Lamps Plus contends that because patent '141 was construed by the Florida District court, and such construction was necessary to the Federal Circuit's published decision affirming the jury's verdict of infringement, principles of uniformity and *stare decisis* should control the outcome of this Court's claim construction. *See* Catalina Lighting, Inc. v. Lamps Plus, Inc., 295 F.3d 1277 (Fed.Cir.2002).

Citing *Texas Instruments, Inc. v. Linear Technologies Corp.,* 192 F.Supp.2d 580 (E.D.Tex.2002), Dolan responds by arguing neither collateral estoppel nor *stare decisis* should be applied in this case to adopt the Florida district court's claim construction. Collateral estoppel can operate to preclude an issue from being relitigated if: (1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action: (3) resolution of the issue was essential to a final judgment in the first action; and (4) the party against whom estoppel is invoked had a full and fair opportunity to litigate the issue in the first action. Innovad Inc. V. Microsoft Corp, 260 F .3d 1326, 1334 (Fed.Cir.2001). Because the defendants here were not parties in the prior litigation, the fourth requirement cannot be met, and collateral estoppel cannot apply to prohibit relitigation of the claim construction.

Further, *stare decisis* does not dictate that this Court adopt the Florida Court claim construction without an independent review of the evidence. In *Texas Instruments,* the court addressed the issue of adopting a sister court's claim construction of the same patent in another case in which the defendants were not involved. Finding that due process rights could be violated, the court held that the "application of *stare decisis* in the form of an adoption of claims construction without Defendants' participation could cause an injustice of precisely the sort that due process seeks to avoid." *Id.* at 589-90.

While this Court agrees that neither collateral estoppel nor *stare decisis* dictate the adoption of the Florida court's claim construction on the patent at issue in this case, this Court finds the Florida court's determination instructive. *See id.* at 589 (although courts cannot give preclusive effect to prior claim construction against new defendant, court may defer to previous claims construction on case by case basis). After considering the parties' arguments and evidence presented at the *Markman* hearing, the briefs and claim construction statements, all related documents, and the Florida court's claim construction, this Court agrees with the Florida court and construes Claim 5 as follows:

Claim 5	*Markman* Interpretation
A stand alone electric lamp, comprising:	A stand alone electric lamp which
	includes at least the following features.
a base member for supporting said lamp;	no interpretation needed
an elongated hollow stem having first	no interpretation needed
and second ends, said first end	
connected to said base member,	
said stem rising centrally from said base	no interpretation needed
member;	
general area lighting means	no interpretation needed
carried by said second end of said stem	no interpretation needed
a plurality of separate direct light	no interpretation needed

reflectors;	
means for affixing each of said separate direct light reflectors to said stem at spaced apart positions disposed between said base and said general area lighting means; said means for affixing each separate direct light reflector including:	no interpretation needed
(a) a first hollow cylinder affixed to and extending from said stem	A first cylinder, that is, a hollow piece of which the two ends are equal and parallel circles, and the intervening curved surface is such as would be traced out by a straight line moving parallel to itself with its ends in the circumference of those circles, which first cylinder is affixed to and extending out some distance from the lamp pole.
(b) a second hollowed cylinder defining a through opening in a wall thereof rotatably affixed to said first hollow cylinder;	Another cylinder containing an opening in its wall, which cylinder is attached to and coextensive for some length with the first cylinder in such a manner as to allow it to rotate around the axis of the first cylinder.
(c) a protrusion extending from said light reflector; and	no interpretation needed
(d) said protrusion being received within said second hollow cylinder and	The protrusion from the task lamp extends into the second hollow cylinder

extending through said opening in said wall;	through the opening in its wall in such a manner so that when operated in conjunction with the rotatably affixed cylinders the task lamp is universally adjustable.
electrical wiring means disposed within said hollow stem for providing electrical energy to lamps disposed within said reflectors and said general area lighting means; and	no interpretation needed
switch means for individually controlling the application of electrical energy to each of said lamps.	no interpretation needed

Construction of the '904 Design Patent

As with a utility patent, to determine whether a design patent claim has been infringed, the court must engage in a two-step analysis, beginning with the proper construction of the claim. *Elmer,* 67 F.3d at 1577 (citing Markman, 52 F.3d at 975). The claim must be construed to determine its meaning and scope. *Id*.

The second step requires comparing the accused design to the properly construed claim. *Elmer,* 67 F.3d at 1577. The comparison begins with a test for overall visual similarity: if, in the eye of an ordinary observer, giving the attention a purchaser would give, the resemblance between two designs is such to deceive the observer into purchasing one supposing it to be the other, the first one patented may be infringed by the other. *Id*. (citing Gorham Co. v. White, 81 U.S. (14 Wall.) 511 (1871)). If the patented design is comprised of both functional and ornamental features, "the accused design must appropriate the novel ornamental features of the patented design that distinguish it from the prior art." *Id*. (citing Oakley, Inc. v. Int'l Tropic-Cal, Inc., 923 F.2d 167, 169 (Fed.Cir.1991)). The "points of novelty" test is separate and independent from the ordinary observer test; both must be met in order to establish infringement of a design patent. *See* Unidynamics Corp. v. Automatic Prods. Int'l., Ltd., 157 F.3d 1311, 1323 (Fed.Cir.1998); Sun Hill Indus., Inc. v. Easter Unlimited, Inc., 48 F.3d 1193, 1197 (Fed.Cir.1995). In this claim construction opinion, this Court addresses only the meaning and scope of the patent claim. *See OddzOn.,* 122 F.3d at 1405.

Unlike a utility patent, a design patent is defined by the content of the drawing; the proper construction of a design patent focuses on the overall visual impression of its ornamental, novel features. *See* OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed.Cir.1997); Durling v. Spectrum Furniture Co., 101 F.3d 100, 104 (Fed.Cir.1996). A design patent protects the non-functional aspects of an ornamental design as shown in the patent. Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995); KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d 1444, 1450 (Fed.Cir.1993). 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. Minka Lighting, Inc. V. Craftmade Intern., Inc., 2001 WL 1012685, (N. D.Tex.2001).

In construing a design patent claim, the Court should resolve the parties disputes regarding claim construction according to its own observation of the design aided by whatever other submissions the Court chooses to consider. *See id*. at * 16. The parties' dispute in this case centers around the extent to which the design patent is described in detail, and does not encompass disagreement on specific interpretations of the drawing. The dispute here is similar to the dispute in *Minka,* where the plaintiffs argued the Court should construe the design 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," and the defendant urged the Court to identify the "individual elements" of the article bearing the patented design and provide a description of the "ornamental design components" for those elements. *See id*. at *8. The *Minka* Court rejected both constructions, holding 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." *Id*. at *18. Ultimately, the Court's construction should translate the drawings into a written description that evokes the visual image of the claimed design. *Id* . at (citing Durling, 101 F.3d at 103 & n. 2).

Here, this Court finds similar problems with each party's proposed construction in this case. Lamps Plus' one-paragraph description gives a "broad general design concept" that would likely not be helpful to the jury in determining primarily functional aspects of the design, if any, or whether the accused design appropriates the points of novelty of the patented design. *See id*. at (citing OddzOn, 122 F.3d at 1405 (in carefully noting the ornamental features that produced the overall effect of the design, the court rejected a "broader general design concept")). A reasonably detailed description of the various ornamental features and their interrelationships is appropriate to evoke, in words, the required visual image. Durling, 101 F.3d at 104 (federal circuit criticized trial court's written description as merely representing "the general concept of a sectional sofa with integrated end tables," without including enough detail to evoke visual image of overall appearance).

On the other hand, the defendant's detailed, lengthy description could, as Lamps Plus argues, take the application of the "ordinary observer" test away from the jury. A part-by-part list such as the one presented by Dolan was rejected by the Court in *Minka*. The Court noted, "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," without noting the ornamental features that produce the overall appearance of the design. *See* Minka, 2001 WL 1012685 at *19.

Here, the claim of the design patent is "The ornamental design of a combined torchiere lamp and adjustable accent lights, as shown and described." The Court, although not permitted to rewrite that claim, it is charged by *Markman* to accurately explain the legal effect of the claim. *See id*. at *18. The Court's role in design patent claim construction is to "provide a description that evokes the visual appearance of the ornamental features of a patented design." *Id*. at *19. The description should assist the jury in its task of comparing the design patent with the accused product, but not require the jury to compare the Court's description to the accused product. *Id*.

Further, this Court's claim construction does not attempt to identify all the points of novelty of the design. Because determining what distinguishes a patented design from the prior art is and has historically been an issue for the jury, the issue of what constitutes a point or points of novelty of a design patent falls into the realm of fact issues for the jury to decide. *See id* . at *24-25. Rather, the claim construction is a description of the design patent sufficient to assist the jury in understanding the legal effect of the patented design.

Being mindful of the role of the Court in construing design patent claims, and having reviewed the parties' briefs, the prosecution history, and all related filings, the Court construes the design claim as follows:

The claim of this patent reads: "The ornamental design of a combined torchiere lamp and adjustable accent

lights, as shown and described." The design embodied in Patent Des. 353,904 is a combination of a traditional freestanding tree torchiere lamp comprising a disc-shaped base on which a vertically extending elongated stem is centrally mounted, which has disposed along the stem a pair of adjustable accent lights. An upwardly directed bowl-shaped light reflector is centrally mounted at the top of the stem. The stem may or may not be divided into sections. The bowl-shaped light may or may not include a band located around the top of the bowl. The adjustable accent lights are spaced apart along the stem with the lower most accent light placed approximately 2/3 of the distance along the stem from the base to the general area lighting member and the upper most accent light placed approximately half way between the lower most accent light and the top of the lamp. The two accent lights extend in opposite directions from the elongated stem which interconnects the base and the bowl-shaped upwardly directed reflector at the top. The accent lights include a closed end carrying a control knob for the light and an open end which may vary somewhat in appearance depending on the embodiment under consideration. Various embodiments of the overall configuration of the accent lights of patent Des. 353,904 are shown in figures 5, 7, 9, 11 and 13 thereof. The overall decorative asthetic appearance of the design provides the ornamental design which is protected by Design Patent Des. 353,904.

SO ORDERED.

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