United States District Court,
W.D. Texas, San Antonio Division.

Gilbert R. SADA, and Victor L. Hernandez,
Plaintiffs.
v.
JACK IN THE BOX, INC., a Delaware Corporation,
Defendant.

Civil Action No. SA-04-CA-541-OG

Feb. 15, 2006.

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Terry S. Bickerton, San Antonio, TX, pro se.

ORDER

ORLANDO L. GARCIA**, District Judge.**

This is a lawsuit for patent infringement. Plaintiffs are two individuals residing in San Antonio, Texas. Defendant Jack in the Box, Inc. ("JBX") is a Delaware corporation with its corporate offices located in San Die go, California. On February 15, 2000, the United States Patent Office issued design patent number 420,670 (the '670 patent) for a "football helmet antenna ornament," listing Plaintiffs as the inventors. Thereafter, JBX designed and distributed its own antenna ornaments. Plaintiffs refer to the JBX ornaments as "Jack/NFL ornaments," and Defendant describes its ornaments as "Jack wearing a helmet." Plaintiffs contend that the design of the JBX ornament infringes the '670 design patent, and they seek damages and injunctive relief. JBX denies infringement, and claims that the '670 patent is invalid and unenforceable and that Plaintiffs are estopped from asserting infringement. Defendant seeks a declaratory judgment. The only issue presently addressed by the Court is construction of the claim in the '670 patent.

I.

The task at hand

Pursuant to the *Markman* decision, district courts are charged with the task of claim construction-a responsibility that is, as a matter of law, exclusive to the judge. Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Whether the liability issues relate to validity or infringement, the first step is claim construction. Thus, the Court must *first*

construe the patent claim and then apply the construed claim to the accused design to determine the infringement issues. FN1

The Court held a Markman hearing on June 23, 2005, and the parties have filed claim construction briefs in support of their positions. The parties' briefs pertain solely to their interpretation of the patent and the manner in which they believe the Court should construe the claim in issue. The Court has reviewed the '670 patent, the prosecution history, the parties briefs and the applicable law, and makes the following determination on claim construction.

II.

Overview of design patents

35 U.S.C. s.s. 171 and 173 provide that a patent may be granted, for a term of 14 years, for any "new, original and ornamental design for an article of manufacture." A design patent and its scope of protection is different than a utility patent. A utility patent protects the functional aspects of a product, while a design patent protects the nonfunctional or ornamental aspects of a product. *See* Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995). In simpler terms, a utility patent protects the way an article is used and works, while a design patent protects the way an article looks. M.P.E.P. s. 1502.01. A design patent includes a title, a claim, a description of the drawings and the drawing(s). 37 C.F.R. s. 1.154(b); M.P.E.P. s. 1503.01. Design patents are limited to only one claim, which should contain the following terminology: "The ornamental design for [the article] as shown," or "as shown and described." 37 C.F.R. s. 1.153(a); M.P.E.P. s.s. 1502.01(C), 1503.01, subsection III. The drawings, which represent the design, must include "a sufficient number of views to constitute a complete disclosure of the appearance of the design." 37 C.F.R. s. 1.152.

III.

Basic rules of claim construction

In the *Markman* decision, the Federal Circuit (sitting en banc) discussed two types of evidence to be considered in the claim construction analysis: intrinsic evidence, which consists of the patent and file history; and extrinsic evidence, which consists of anything outside the patent record (e.g. expert testimony, dictionaries, or treatises). Markman, 52 F.3d at 979-985. The Federal Circuit emphasized that the patent's prosecution history, if in evidence, is very significant in ascertaining the true meaning of the claim. Id. at 980. The *Markman* court also noted that "[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim (*except as documented in the prosecution history*)." *Id*. at 985 (emphasis added).

In the *Vitronics* case, which was decided one year later, the Federal Circuit indicated that it would be legally incorrect to rely on extrinsic evidence if analysis of the intrinsic evidence alone would resolve the Court's interpretation of the claim. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed.Cir.1996). Moreover, if the Court must rely on extrinsic evidence, it may only be used to help the Court understand the claim; it may not be used to vary or contradict the claim language. Id. at 1584. The Federal Circuit later clarified its position on extrinsic evidence, stating that there is no prohibition against considering extrinsic evidence even if the patent document itself is clear, as long as the Court does not *rely* on the extrinsic evidence to contradict the meaning of the claim. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1308 (Fed.Cir.1999).

In analyzing the intrinsic evidence, the Court must start with the words in the claim itself. Vitronics, 90 F.3d at 1582; Pitney Bowes, 182 F.3d at 1305. Then, the Court must consider the drawings and any written description of the drawings. Vitronics, 90 F.3d at 1582; *see also* Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., Inc., 162 F.3d 1113, 1116 (Fed.Cir.1998) ("patented design is claimed as shown in its drawing ... [t]here is usually no description of the design in words";); *see also* In re Mann, 861 F.2d 1581, 1582 (Fed.Cir.1988)("Design patents have almost no scope. The claim at bar, as in all design cases, is limited to what is shown in the application drawings"). Finally, the Court may consider the prosecution history if it is in evidence. Vitronics, 90 F.3d at 1582.

In construing a design claim, the Court must translate visual descriptions into words that evoke the visual image of the design. Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 & n. 2 (Fed.Cir.1996). The Court's construction must limit the scope of the patent to its overall ornamental visual impression, rather than a broad general design concept. Id. at 104; Oddzon Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1405 (Fed.Cir.1997); Contessa Food Products, Inc. v. Conagra, Inc., 282 F.3d 1370, 1378 (Fed.Cir.2002). The claim is limited to the design "as shown and described," and the Court's task is to verbalize what is shown in the patent drawings. Durling, 101 F.3d at 103; *see also* Elmer, 67 F.3d at 1577. While the Court's construction does not need to be complex, the Court does need to provide a reasonably detailed description of the various ornamental features. *See* Durling, 101 F.3d at 104 (trial court erred in describing the general concept of a sectional sofa with integrated end tables); *see also* Oddzon, 122 F.3d at 1405 (trial court properly noted the ornamental features that produced the overall "rocket-like" appearance of the design, rather than describing a broader general design concept of a rocket-like tossing ball).

IV.

Construction of the claim in issue

The claim in the '670 design patent reads as follows:

We claim the ornamental design for a football helmet antenna ornament, as shown and described.

(Dkt.# 25, Exh. A). The patent includes six drawings or figures, which reflect different sides or views of the design and a brief written description of each figure or drawing. (Dkt.# 25, Exh. A). The prosecution history, which contains several statements that are helpful in construing the claim, has also been provided to the Court for review. (Dkt.# 25, Exh. G). FN2

Plaintiffs propose an overly broad construction of the design claim: "an antenna ornament shaped like a conventional football helmet." (Dkt.# 25, p. 10). In doing so, they go far afield in their analysis, relying on rules of infringement rather than rules of claim construction. (Dkt. # 25, pp. 3-5; 8-12). Specifically, Plaintiffs employ the "ordinary observer" and "points of novelty" tests in their construction analysis, even though they acknowledge that such tests are part of the infringement analysis. (Dkt.# 25, p. 3). The law clearly states that determining liability in a patent infringement case involves a two step process: construction of a patent claim (a question of law) is step one, and infringement (a question of fact) is step two. Omega Engineering, Inc. v. Raytek Corp., 334 F.3d 1314, 1320 (Fed.Cir.2003); Vitronics, 90 F.3d at 1582; Oddzon, 122 F.3d at 1405. Just as it is improper to consider infringement prior to construction, it is also improper to intermingle the construction and infringement analyses, which could lead to a comparison of the claimed design and the accused design before the claim is properly construed.

Plaintiffs also rely on extrinsic evidence-their own deposition testimony-even though the inventors' subjective intent is given no deference unless it is reflected in the prosecution history. Markman, 52 F.3d at 985 ("the subjective intent of the inventor when he used a particular term is of little or no weight in determining the scope of a claim *except as documented in the prosecution history* ") FN3 Plaintiffs further urge the Court to disregard certain features of the patent design such as the configuration of the holes on the sides of the helmet and the number of horizontal bars on the face mask, stating that "an ordinary observer would not remember" such features and they are simply "minor variations" that have no import. (Dkt.# 25, pp. 9-10). However, these features are clearly reflected in the drawings, and the Court cannot simply disregard the limiting features of a patent design. *See* Elmer, 67 F.3d at 1577 ("[the patentee] could have omitted these features from its patent application drawing ... [it] did not do so, however, and thus effectively limited the scope of its patent claim by including those features in it"). After reviewing Plaintiffs' arguments, the Court finds that their reasoning and analysis is unsound, and their proposed claim construction is nothing more than a broad general design concept, which the Federal Circuit has expressly rejected. Durling, 101 F.3d at 104; Oddzon, 122 F.3d at 1405.

On the other hand, Defendant proposes a detailed construction of the design claim, describing each ornamental feature in the drawings and excluding those features that are functional. (Dkt.# 27, pp. 19-20). Defendant's proposed construction comes much closer to the type of claim construction expected by the Federal Circuit, and the Court construes the claim in the '670 design patent in substantially similar fashion.

Defendant correctly notes that a design patent only protects the non-functional, ornamental features of the claimed design; thus, the Court's construction analysis should exclude any functional aspects of the design. Oddzon. 122 F.3d at 1405 ("[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"). In so doing, the Court notes that the helmet has a solid interior with a circular opening and cylindrical cavity that *functions* as an antenna holder slot, and this functional aspect of the claim is not included in its construction. However, the *appearance* of the helmet's solid interior and the *appearance* of the circular feature on the bottom of the helmet, as shown in figures 3 and 5, and as described in the prosecution history, clearly affect the overall visual impression of the design and should be part of the construction of the claim. (Dkt. # 25, Exh. A and Exh. G @ GS 00103-104).

After analyzing all of the intrinsic evidence, including the claim, drawings and prosecution history, and in focusing on the features that are purely ornamental, the Court construes the claim in the '670 design patent as follows:

A design shaped like a contemporary football helmet.FN4 (Dkt.# 25, Exh. A). On each side of the helmet, in the ear area, are three circles arranged in triangular formation, with the top circle being bigger than the other two. (Dkt. # 25, Exh. A, figures 1, 2). The front of the helmet has a bar that wraps around the upper and side edges of the face opening in the general shape of an "upside down U ." (Dkt. # 25, Exh. A, figures 1, 2; Exh. G @ GS 00104). There is a rectangular plate that lies in front of the wrap around bar directly above the middle of the helmet's face opening.FN5 (Dkt. # 25, Exh. A, figure 2). The helmet has a face mask comprised of two horizontal bars and two vertical bars. (Dkt. # 25, Exh. A, figures 1, 2). The upper horizontal bar starts at the end of the wrap around bar, in the ear area on each side of the helmet, and extends outward around the face opening of the helmet. (Dkt. # 25, Exh. A, figures 1, 2). The lower horizontal bar has the appearance of starting behind the wrap around bar, in the temple area, and angles downward at approximately 60 degrees and then outward around the face opening of the helmet, parallel to the upper horizontal bar. (Dkt. # 25, Exh. A, figures 1, 2). The upper horizontal bar has the visual effect of

lying outside the diagonal portion of the lower horizontal bar at the point where they intersect. (Dkt. # 25, Exh. A, figures 1, 2; Exh. G @ GS 00104). A cross section view reflects that the horizontal bars are relatively flat on the interior side, and rounded on the exterior side. (Dkt. # 25, Exh. A, figure 3; Exh. G @ GS 00103). Two vertical bars extend between the upper and lower horizontal bars at the front of the face mask, and connect with the inside surface of the horizontal bars. (Dkt. # 25, Exh. A, figures 1, 2). The helmet has a solid interior with a contour that gradually curves or bows inward from the front of the helmet, and does not protrude or extend beyond any edge of the helmet. (Dkt. # 25, Exh. A, figures 3, 5; Exh. G @ GS00103-104). The bottom of the helmet reflects a circular feature in the middle of the solid interior. (Dkt. # 25, Exh. A, figure 5).

The Court does not find it necessary to consider any extrinsic evidence because the intrinsic evidence is sufficient for construction of the claim. The Court has avoided construing the claim as a "general design concept," and has described each of the ornamental features of the design as "shown and described" in the patent drawings, taking the prosecution history into consideration for purposes of clarification.

It is therefore ORDERED that the claim in design patent number 420,670 is construed as set forth above. The parties may supplement their summary judgment briefs within seven (7) days from the date below, based on the Court's construction of the claim. The Court will then rule on any pending summary judgment motions.

FN1. In this case, the parties have waived their right to a jury. Therefore, the Court will determine validity and infringement, and apply its own construction of the patent when doing so.

FN2. *See* Markman, 52 F.3d at 980 (the patent's prosecution history is of "primary significance in understanding the claims").

FN3. The Federal Circuit in *Markman* also noted that "it is not unusual for there to be a significant difference between what an inventor *thinks* his patented invention is and what the ultimate scope of the claim is after allowance by the PTO." Markman. 52 F.3d at 985 (emphasis added).

FN4. As opposed to the dog ear helmets of the early 1900's.

FN5. The rectangular plate has the appearance of being *above* the wrap around bar in figures 1, 3 and 6. However, the rectangular plate is prominently displayed *in front of* the wrap around bar in figure 2. The Court has chosen the most prominent display of this feature in its construction. (*See* Dkt. # 25, Exh. A).

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