United States District Court,
S.D. Texas, Houston Division.

BERNARDO FOOTWEAR, L.L.C,
Plaintiff.
v.
FORTUNE DYNAMICS, INC,
Defendant.

Dec. 24, 2007.

Edward W. Goldstein, Alisa Anne Lipski, Wendy Lynn Boone, Goldstein Faucett & Preberg LLP, Houston, TX, for Plaintiff.

Jerry R. Selinger, Timothy G. Ackermann, Morgan Lewis & Bockius, LLP, Ryan Matthew Taylor Allen, Theodore J. Riney, Riney Palter PLLC, Dallas, TX, Angela P. Lin, Huang PC Lawyers, Los Angeles, CA, for Defendant.

MEMORANDUM ON CLAIM CONSTRUCTION

NANCY F. ATLAS**, District Judge.**

The Court conducted a hearing pursuant to Markman v. Westview Instruments, Inc., 517 U.S. 370, 390, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996) ("*Markman* hearing") on December 14, 2007, regarding United States Patent No. D513,447 (the "'447 Patent") owned by Plaintiff Bernardo Footwear, L.L.C. ("Bernardo"). FN1 Based on the drawings in the ' 447 Patent, the arguments presented by counsel at the *Markman* hearing, and the governing legal authorities, the Court issues this Memorandum construing the design patent claim.

FN1. Although a design patent has no written claim terms, the Court is required to "construe" the design patent as claimed in the drawings. *See* Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995) (citing *Markman,* 52 F.2d at 976).

I. *FACTUAL AND PROCEDURAL BACKGROUND*

Bernardo's '447 Patent is entitled "Sandal." Bernardo markets a sandal known as the "Medieval" sandal that embodies the design claimed in the '447 Patent. Bernardo alleges that Defendant Fortune Dynamics, Inc. ("Fortune") markets an infringing sandal under a "Classified" brand "Sour-S" style.

Bernardo sued Fortune and other defendants alleging infringement of the ' 447 Patent. FN2 Fortune no longer markets the allegedly infringing sandal, and has no plans to do so in the future. Fortune denies, however, that its accused sandal infringed the ' 447 Patent.

FN2. All other Defendant s have settled with Plaintiff.

The parties filed their Joint Claim Construction and Pre-Hearing Statement [Doc. # 46]. Plaintiff filed its Opening Claim Construction Brief [Doc. # 49], Fortune filed its Response [Doc. # 52], and Bernardo file a Reply [Doc. # 54]. The parties also filed a Joint Claim Construction Chart [Doc. # 55]. During the *Markman* hearing, Bernardo filed a Bench Brief In Reference to Broken Lines [Doc. # 74]. Subsequently, Fortune filed a Supplemental Post- *Markman* Brief [Doc. # 77]. The Court has considered each of these documents but, most importantly, has reviewed the '447 Patent and applied governing legal authorities. On this basis, the Court construes the '447 Patent as follows.

II. *GENERAL LEGAL STANDARDS FOR CLAIM CONSTRUCTION*

"A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent." Arminak and Assoc., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1319 (Fed.Cir.2007) (quoting Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995)). Design patents are generally claimed as shown in the drawings in the patent. Arminak, 501 F.3d at 1319. "The scope of the claim of a patented design encompasses its visual appearance as a whole, and in particular the visual impression it creates." Id. at 1319-20 (internal quotations omitted) (citing Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1376 (Fed.Cir.2002)). The Court's task is to "translate" the patent's visual images into a verbal description. *See* Durling v. Spectrum Furniture Co., Inc., 101 F.3d 100, 103 (Fed.Cir.1996). The Court's verbal description of the claimed design cannot be overly general-it must do more than state the general concept of the design. *See* id. at 104.

A significant dispute between the parties involves the broken lines drawn close to the outer edge of the sandal in the '447 Patent. Defendant argues that the broken lines represent the stitching that is a clear visual image in the sandal marketed by Bernardo under the '447 Patent. Plaintiff asserts that broken lines can indicate a feature not included in the claimed design. It is clearly established that if there are features in the drawings that the designer does not want to be claimed, "the patentee is permitted to show the features in broken lines to exclude those features from the claimed design .... " Contessa, 282 F.3d at 1378 (citing Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1313 (Fed.Cir.2001)). "Broken lines may be used to show visible environmental structure ...." 37 C.F.R. s. 1.152. Nonetheless, the Manual of Patent Examining Procedure ("MPEP") provides that the "specification should make it clear that the structure shown in broken lines is not part of the design sought to be patented." *See* MPEP s. 1503.02.

III. *CLAIM CONSTRUCTION OF THE* '447 PATENT

The '447 Patent design patent is for a thong sandal with the focal point being a curved ring at the top of the foot. The sandal also contains a sole, side straps, and a toe thong. The side straps and the toe thong attach the ring to the sole.

The sole of the sandal has a low profile, is thin and flat, and has a rounded heel and a rounded toe. The top and bottom of the sole have ornamental stitching around the entire perimeter, except on the bottom of the sole where the heel covers the stitching. FN3 The heel is low, approximately one-half the thickness of the sole itself. The top of the sole has a slightly raised portion across the sandal inside the decorative stitching, giving the appearance that the raised portion is padded.

FN3. The stitching is depicted by a broken line, but the patent does not make it clear that the broken lines

are not stitching that is part of the design sought to be patented as required by MPEP s. 1503.02. Consequently, in this case where the broken lines create the visual image of decorative stitching, the Court construes the broken lines as part of the claimed design as depicted in the drawing.

The toe thong and the side straps connect the ring to the sole. The toe thong appears to be two separate round strands attached to the ring as part of a Lark's Head Knot (two half hitches tied in opposite directions). FN4 Each of the side straps is comprised of three round strands passing from the sole over the ring and into the sole again, creating the appearance of three strands on top of the ring and six strands between the ring and the sole. The strands are gathered together immediately below the ring with a band that appears to have ridges. FN5

FN4. For further information about making a Lark's Head Knot, *see* www.ehow.com/how_13480_make-larks-head.html.

FN5. It is unclear how the ridged appearance is created, and there are several possibilities. One option is a single, ridged piece gathering the strands together. Other potential ways to create the ridged band include a thin cord wrapped approximately nine times around the strands, or approximately nine thin cords or loops placed next to each other and wrapped once around the strands.

The ring, when viewed from the side, has a slight upward curvature and, when viewed from the rear or heel, has a comparable downward curvature. When viewed from above, the left side of the ring has a depression on its top surface beginning near the front of the ring and ending near the back of the ring, giving the surface of the ring an irregular appearance.

IV. ***CONCLUSION***

The Court construes the '447 Patent as set forth herein. The remaining deadlines in the Court's Scheduling Order [Doc. # 38], beginning with the **February 8, 2008** deadline for Final Infringement Contentions and to Amend Pleadings on Infringement Claims, remain in effect.

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