United States District Court,
D. Massachusetts.

TRI-TECH, INC,
Plaintiff.
v.
ENGINEERING DYNAMICS CORP,
Defendant.

Civil Action No. 88-0883-H

June 23, 1988.

MEMORANDUM AND ORDER

HARRINGTON, D.J.

The plaintiff Tri-Tech, Inc. ("Tri-Tech") moves for a preliminary injunction against Engineering Dynamics Corporation ("EDC") seeking to enjoin EDC from infringing on plaintiff's patent rights and trade dress of its StairMaster ^{R} 6000 stairclimbing machine. For the reasons stated below Tri-Tech's motion for preliminary injunction is granted.

Statement of Facts

Tri-Tech is engaged in the business of manufacturing and selling exercise equipment, including a stair-type treadmill exerciser, the StairMaster ^{R} 6000 (the "StairMaster"). On August 18, 1987, U.S. Letters Patent No. 4,687,195 (the "'195 patent") was issued to Tri-Tech as assignee of the inventor Lanny L. Potts.

The steps of the StairMaster are activated when a person walks up them. The tread and riser portions of each step are connected at both ends by hinges to each other and also to endless chains that allow the steps to move or fold around sprockets at the lower and upper end of the steps.

The innovative part of the StairMaster is the ability of each individual step to fold so that each step can go around the outside radius of the upper and lower sprockets during its movement. The folding of the steps occurs at the forward portion of each tread and upper portion of each riser. Tri-Tech contends that the folding step action never existed in prior art, and is necessary for any stairclimbing machine of this type to work. FN1

FN1. Tri-Tech also alleges that EDC's stairclimbing machine infringes on the StairMaster's trade dress by copying the outward appearance, arrangement and configuration of the StairMaster. Since EDC is enjoined from selling its StairMaster until the resolution of this litigation, it is not necessary to rule on plaintiff's trademark infringement claim or unfair competition claim at this time.

The defendant EDC is also a manufacturer and wholesaler of exerciser equipment, including its own stairclimbing exercise machine, known as the Bioclimber(TM) ("Bioclimber"). In March of 1988 EDC introduced and demonstrated the Bioclimber for the first time.

EDC contends that Tri-Tech's '195 patent is invalid and even if the '195 patent is valid the Bioclimber does not infringe on Tri-Tech's '195 patent.

Discussion

Injunctive relief in patent cases is authorized by statute, 35 U.S.C. s. 283 and caselaw. *Smith International, Inc. v. Hughes* against others and against the relief demanded." *Roper,* 757 F.2d at 1269 n. 2.

I. *LIKELIHOOD OF SUCCESS*

A. Validity

The first question for this Court to address is whether the movant Tri-Tech has demonstrated a reasonable likelihood that EDC would fail to meet their burden at trial of proving, by clear and convincing evidence, that the '195 patent was invalid. A patent is presumed to be valid. 35 U.S.C. s. 282; *Roper,* 757 F.2d at 1270. "it remains valid until a challenger proves it was stillborn or had birth defects, or it is no longer viable as an enforceable right." *Id.* (footnote omitted). Thus, although the burden is always on the movant to demonstrate entitlement to preliminary relief, such entitlement is determined in the context of the presumption of patent validity. H.H. Robertson Co. v. United Steel Deck, Inc., 820 F.2d 384, 388 (Fed.Cir.1987) (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986)).

To determine the validity of a patent, a court must compare the claimed invention with the prior art. Prior art is the state of the relevant technology before the time of the claimed invention. Before a patent is issued, the patent examiner determines whether "the subject matter of the claimed invention would not have been obvious to a person having ordinary skills in the art to which the subject matter pertains." 35 U.S.C. s. 103.

This Court finds that the defendant EDC did not overcome the presumption of validity of the '195 patent because the concept of foldable steps that traverse a sprocket during its movement was not obvious from prior art at the time the '195 patent was issued.

Defendants assert that the Wright Patent, U.S. Patent No. 783,769, when combined with the Parson's Patent, U.S. Patent No. 3,592,466, rendered the ' 195 patent obvious.

Parson's Patent is described as a "Revolving Step Exerciser." It has chains, sprockets and steps. Parson's machine's treads and risers were held together rigidly and could not move relative to each other. Because the Parson's patent had no *first hinge,* the riser and tread could not fold.

Defendant contends, however, that the patent examiner was unaware of the Wright Patent, U.S. Patent No. 783,769, in the escalator field that did deal with the problem of rotating foldable steps over sprockets, and did have risers pivotally connected at both their lower ends and their upper ends.

Wright describes a movable stairway with steps having risers pivotally connected at both their lower and upper ends to treads. The double pivoting of the Wright machine allows the steps to flatten out as they go

around the wheels. The Wright moveable stairway is a conveyor which is carried on cylindrical drive and guide pulleys or rollers. The conveyor travels around the rollers. *The two bands that constitute the conveyor* must be made out of flexible material throughout the length and breadth of the conveyor.

Wright is not relevant prior art. Unlike Potts' '195 patent, it shows no mechanical hinge or other pivot means at all. Wright's stairs flatten out around rollers; they do not fold in. In short, Wright has an essentially different type of action, as its steps flatten out around the cylindrical rollers in contrast to the folding-in action of '195 patent's treads and risers, as they traverse a sprocket on chains.

Infringement

Tri-Tech claims that EDC's Bioclimber infringes on StairMaster's '195 patent. To determine whether infringement is present, the Court must compare the claim language to the accused's device. *See generally,* Palumbo v. Dawn-Sox Company, 762 F.2d 969, 974 (Fed.Cir.1985). "The grant of a preliminary injunction does not require that infringement be proved beyond all question, or that there be no evidence supporting the viewpoint of the accused infringer." H.H. Robertson v. United Steel Deck, Inc., 820 F.2d 384, 390 (Fed.Cir.1987) (citing Atlas Powder Co v. Ireco Chemical, 773 F.2d 1230, 1233 (Fed.Cir.1985)). In order to grant the injunction, Tri-Tech must demonstrate the likelihood that it will meet its burden at trial of proving infringement.

The Court rules that there is a reasonable probability that Tri-Tech will establish at trial, under the Doctrine of Equivalence, that the Bioclimber operates in substantially the same way as the '195 patent. Although the Bioclimber has minimally spaced apart lateral pivots where the '195 patent calls injunction not enter. EDC began making, using and selling the Bioclimber quite recently. EDC has an established business making and selling many other pieces of exerciser and medical equipment and will not be put out of business by virtue of the injunction. EDC will be harmed by the issuance of this injunction. The harm suffered by the accused in a patent case where likelihood of success on the merits has been established is, however, the necessary price of enforcing the constitutional grant of patent protection "to promote the progress of science and useful arts ... by securing to others and inventors the exclusive right to their respective writings and discoveries." U.S. Const., art. I, s. 8, cl. 8. Therefore where a strong showing of likelihood of success on the merits has been established, courts should not be reluctant to grant injunctive relief.

III. ***PUBLIC INTEREST***

The protection of patents furthers the strong public interest of promoting the progress of science by enforcing valid and infringed patents.

In *Smith International, Inc.,* 718 F.2d at 1581, the court held that "where validity and continuing infringement have been established ... immediate irreparable harm is presumed. To hold otherwise would be contrary to the public policy underlying the patent laws." (footnotes omitted).

IV. ***ORDER GRANTING PRELIMINARY INJUNCTION***

In summary, the Court concludes that Tri-Tech has demonstrated its entitlement to a preliminary injunction on the claim of patent infringement. The aforesaid conclusions of law, however, are made without prejudice to either party in finally determining the issues herein on the merits.

SO ORDERED.

D.Mass.,1988.
Tri-Tech Inc. v. Engineering Dynamics Corp.