

United States District Court,
N.D. Illinois.

BLACK & DECKER (U.S.) INC. Black & Decker Inc., and Lockwood Products, Inc,
Plaintiffs.

v.

CEDARBERG INDUSTRIES, INC., DST Corporation and John F. Cedarberg III,
Defendants.

Aug. 14, 1998.

MEMORANDUM OPINION AND ORDER

HOLDERMAN, District J.

On August 13, 1997, plaintiffs Black & Decker (U.S.) Inc., Black & Decker Inc., and Lockwood Products, Inc. filed a three count Amended Complaint against defendants Cedarberg Industries, Inc., DST Corp., and John F. Cedarberg III. Count I alleges a claim for utility patent infringement under 35 U.S.C. s. 217. Count II alleges a claim for design patent infringement under 35 U.S.C. s. 217. Count III alleges a claim for copyright infringement under 17 U.S.C. s. 501. Defendants have filed a motion for summary judgment based on the invalidity and noninfringement of the design patent, a motion for summary judgment based on the invalidity of the utility patent, and a motion for summary judgment based on the noninfringement of the utility patent. For the following reasons, each of defendants' motions for summary judgment must be denied.

BACKGROUND

Plaintiff Lockwood Products, Inc. owns United States Patent No. 5,449,206 (the '206 patent). Plaintiff Black & Decker FN1 is the exclusive licensee under the '206 patent and it uses this patent in the manufacturing and sale of a flexible flashlight using the trademark "SnakeLight." Black & Decker also owns United States Patent No. Des. 364,935 (the "5 patent) which is entitled "Flexible Flashlight." Plaintiffs allege that defendants Cedarberg Industries, Inc., DST Corp., and John F. Cedarberg III have violated these two patents through the sale and manufacturing of Cedarberg Industries, Inc.'s "Rap-A-Lite" device.

FN1. This opinion will refer collectively to plaintiffs Black & Decker (U.S.) Inc. and Black & Decker Inc. as "Black & Decker."

The "5 patent claims an "ornamental design for a flexible flashlight, as shown and described." (Defs.' Local Rule 12(M) Stmt., Ex. A.) The "5 patent has a flashlight head at one end and a flange containing a hole at the other end. The body of the "5 patent has a ribbed appearance. The Rap-A-Lite device is a flashlight holder with a flexible body and a ribbed exterior. Plaintiffs allege that the design of the Rap-A-Lite device infringes on the design of the "5 patent; defendants deny this. Defendants argue that United States Patent

No. 3,641,333 (the '333 patent), which was not considered by the patent examiner during the prosecution of the '5 design patent, acts to invalidate the '5 patent. The '333 patent describes an "illuminated belt [comprised of] a translucent, accordian-type, flexible tubular plastic material which forms the main body of the belt." (Defs.' Local Rule 12(M) Stmt., Ex. I col. 1, Ins. 54-56.)

Plaintiffs also allege that the Rap-A-Lite device infringes the '206 patent. According to plaintiffs, the Rap-A-Lite flexible core design allegedly achieves the stop function of the '206 patent of limiting the motion of the ball element by contact with the boundary of the recess design to receive the stop by simply extending the stiff tube running along the central axis of its core further into the stop receiving opening. Plaintiff also alleges that the wire used in the Rap-A-Lite device is also integral to this design. According to plaintiffs, the Rap-A-Lite device allegedly performs the same function that is called for in the '206 patent: when the adjacent body is pivoted, the stop contacts the interior wall of the stop receiving opening to limit further deflection. In addition to denying that the Rap-A-Lite device infringes the '206 patent, defendants argue that Cedarberg Industries Inc.'s E-Z Mist device and the Eaton device are prior art and invalidate the '206 patent.

STANDARD OF REVIEW

Under Rule 56(c), summary judgment is proper "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c). In ruling on a motion for summary judgment, the evidence of the nonmovant must be believed and all justifiable inferences must be drawn in the nonmovant's favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). This court's function is not to weigh the evidence and determine the truth of the matter, but to determine whether there is a genuine issue for trial. A party who will bear the burden of proof on a particular issue at trial may not rest on the pleadings, but must affirmatively demonstrate, by specific factual allegations, that there is a genuine issue of material fact which requires trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). There is no issue for trial "unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party." *Anderson*, 477 U.S. at 249.

PATENT 364,935

I. *Validity*

A patent is presumed valid. 35 U.S.C. s. 282. "The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." *Id.* Moreover, "a challenger must establish facts, by clear and convincing evidence, which persuasively lead to the conclusion of invalidity." *Avia Group International, Inc. v. L.A. Gear California*, 853 F.2d 1557, 1562 (Fed.Cir.1988).

Defendants argue that plaintiffs' '5 patent is invalid because it is obvious in light of U.S. Patent 3,641,333 (the '333 patent). The '333 patent was not considered by the patent examiner during the prosecution of the '5 patent. A design patent must meet a nonobvious requirement identical to that applicable to a utility patent; accordingly, 35 U.S.C. s. 103 applies. *Avia Group*, 853 F.2d at 1563. This court must consider four factors when making a determination regarding obviousness: (1) the scope and content of the prior art; (2) the differences between the prior art and claims at issue; (3) the level of ordinary skill in the art when the invention was made; and (4) secondary indicia, such as commercial success and copying. *Id.* at 1564 (*citing* *Graham v. John Deere Co.*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966)). The '333 patent describes a belt with translucent, ribbed tubing in which are a number of light bulbs. (Defs.' Local Rule 12(M) Stmt.

Ex. I.) The ends of the belt have a magnetic coupling which "performs the dual function of holding the ends of the belt together and completing the electrical circuit to cause illumination of the bulbs within the belt. (Defs.' Local Rule 12(M) Stmt. Ex. I.) In contrast, the '5 patent describes an "ornamental design for a flexible flashlight" with the only source of illumination coming from the cylindrical headpiece at the end of the flashlight. (Defs.' Local Rule 12(M) Stmt. Ex. A.) Defendants argue that both the '5 patent and the '333 patent use a similar, although not identical, type of ribbed tubing along their lengths. Nevertheless, the '333 patent's tubing is translucent and allows the tubing to be illuminated by the bulbs within its length, while the '5 patent's tubing is opaque, does not contain any bulbs in its length, and its length is not capable of being illuminated. In light of these differences, defendants' motion for summary judgment as to the invalidity of the '5 patent is denied.

II. Infringement

In determining whether a design patent is infringed, the claim to the design must first be construed and then that claim must be compared to the design of the accused design. *Oddzon Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1404-05 (Fed.Cir.1997) (*citing* *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed.Cir.1995)). A design patent protects only the novel and ornamental features of the patented design. *Id.* (*citations omitted*). "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." *Id.*

Design patent infringement is a question of fact. *L.A. Gear, Inc. v. Thom McAn Shoe Company*, 988 F.2d 1117, 1124 (Fed.Cir.1993). "The comparison step of the infringement analysis requires the fact-finder to determine whether the patented design as a whole is substantially similar in appearance to the accused design." *Oddzon*, 122 F.3d at 1405. In other words, design patent infringement requires a showing that the accused design is substantially similar to the claimed design. *L.A. Gear*, 988 F.2d at 1124. The criterion is whether one design would be confused with the other by an ordinary observer:

[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.

Id. (*quoting* *Gorham v. White*, 81 U.S. (14 Wall.) 511, 528, 20 L.Ed. 731 (1871)). In conducting this analysis, it is the appearance of the design as a whole which is controlling in determining infringement. *Oddzon*, 122 F.3d at 1405; *L.A. Gear*, 988 F.2d at 1125. When a design contains both functional and ornamental features, "the patentee must show that the perceived similarity is based on the ornamental features of the design." *Oddzon*, 122 F.3d at 1405. The patentee "must establish that an ordinary person would be deceived by reason of the common features in the claimed and accused designs which are ornamental." *Id.* (*quoting* *Reed Corp. v. Portec, Inc.*, 970 F.2d 816, 825 (Fed.Cir.1992)).

A. Construction of the Claim

Although the tube-like body is a functional part of the '5 design, the sleeve with ribbed tubing is merely ornamental. According to John Russo, one of plaintiffs' engineers that worked on the "flexible flashlight" project, the following designs would have been easier to produce than the ribbed sleeve in the '5 patent: a smooth sleeve, a sleeve with the ribs running lengthwise, and a "spiral type corrugation." (Russo Dep. 50-51.) Also, while the end cap in the '5 patent is functional in that it would allow a person to hang the flashlight on an object such as a nail, the particular design of the end cap in the '5 patent is ornamental. As

plaintiffs point out, the end cap could use a hook instead of hole to accomplish the same end; a non-circular hole could also function similarly to the end cap in the "5 patent. These features are ornamental because "[i]f the functional aspect or purpose could be accomplished in many other ways ..., that fact is enough to destroy the claim that this design is primarily functional." Avia Group, 853 F.2d at 1563 (quoting *Pensa v. L.A. Gear*, 4 U.S.P.Q. 2d 1016, 1019 (C.D.Cal.1987)).

B. "5 Patent Compared to Defendants' Design

First, defendants argue that the grant of a design patent for their accused device shows that there are substantial differences between its accused device and the "5 patent. The granting of a separate patent to the accused device is relevant when comparing the claimed design to the accused design. *See Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1570 (Fed.Cir.1996). Although defendants argue that it is a strong factor, "[t]he grant of a separate patent on the accused device does not automatically avoid infringement, either literal or by equivalency." *National Presto Industries, Inc. v. West Bend Co.*, 76 F.3d 1185, 1192 (Fed.Cir.1996).

"Design patent infringement is a question of fact, to be proven by a preponderance of the evidence." *L.A. Gear*, 988 F.2d at 1124; *see also Tone Brothers, Inc. v. Sysco Corp.*, 28 F.3d 1192, 1196 n. 2 (Fed.Cir.1994) ("infringement of a design patent is a fact-intensive issue"). Viewing the accused device as a whole, the ribbed tubing and end cap are similar, although not identical, to the design of the "5 patent. In light of the similar ribbed tubing and end caps of the "5 patent and defendants' device, a reasonable jury could return a verdict in plaintiffs' favor. As a result, defendants' motion for summary judgment on the basis that its device does not infringe the "5 patent must be denied.

PATENT 5,449,206

I. Validity

Defendants argue that the '206 patent is invalid pursuant to 35 U.S.C. s. 102(b) because it was anticipated by either the E-Z Mist device or the Eaton device. Section 102(b) states the following:

[a] person shall be entitled to a patent unless ... the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

35 U.S.C. s. 102(b). Whether or not an invention was on sale or in public use is a question of law, but the basis for that determination turns on questions of fact. *Manville Sales Corp. v. Paramount Systems, Inc.*, 917 F.2d 544, 549 (Fed.Cir.1990). Under s. 102(b), the party seeking to invalidate a patent must prove that the allegedly invalidating patent or publication contains "each and every element of [the] claimed invention." *Applied Medical Resources Corp. v. United States Surgical Corp.*, --- F.3d ----, No. 97-1526, 147 F.3d 1374, 1998 WL 348008, * 3 (Fed.Cir. June 30, 1998) (*quoting Lewmar Marine, Inc. v. Bariant, Inc.*, 827 F.2d 744, 747 (Fed.Cir.1987)). The issue of whether the prior art anticipated the patentee's invention is a question of fact. *Texas Instruments Inc. v. United States International Trade Commission*, 988 F.2d 1165, 1177 (Fed.Cir.1993). Moreover, "[a] party seeking to prove anticipation must do so with clear and convincing evidence because the patent must be presumed valid." *Applied Medical Resources*, 147 F.3d 1374, 1998 WL 348008, at *3.

Genuine issues of material facts remain which prevent the entry of summary judgment on the basis of invalidity. Defendants have failed, at this stage of the litigation, to prove by clear and convincing evidence

that the E-Z Mist device or the Eaton device contain each and every element of the '206 patent. This is due, in part, to the issues of fact raised by plaintiffs that could enable a jury to return a verdict in their favor regarding the validity of the '206 patent. For example, plaintiffs point to the January 18, 1993 notes of defendants' engineering manager which state that the plaintiffs' project would involve a "special Snap-Loc Application" that "would require specially tooled product with features and timing as indicated in [Diane Cedarberg's] 1/14/93 notes." (Pls.' Combined Response Ex. 6.) In regard to those January 18, 1993 notes, plaintiffs pose the issue of why a "special" application with a "specially tooled" product would be needed if plaintiffs' existing E-Z Mist device would have met plaintiffs' immediate design requirements. As for the Eaton device, plaintiffs argue that that device fails to contain each and every claim in the '206 patent because the beads used in the Eaton device were designed to be easily decoupled and the length changed. These types of fact questions are reserved for the trier of fact and cannot be resolved in the context of a motion for summary judgment. As a result, defendants' motion for summary judgment on the invalidity of the '206 patent is denied.

II. Infringement

A two step analysis is required to determine whether these has been infringement: (1) the claims must be correctly construed to determine the scope of the claims and (2) the claims must be compared to the accused device. *Kahn v. General Motors Corp.*, 135 F.3d 1472, 1476 (Fed.Cir.1998); *General Mills, Inc. v. Hunt-Wesson, Inc.*, 103 F.3d 978, 981 (Fed.Cir.1997). "To establish literal infringement, a plaintiff must demonstrate that every limitation in the claim is literally met by the accused device ." *Kahn*, 135 F.3d at 1476. A plaintiff may also prove infringement under the doctrine of equivalents when literal infringement is not established. *Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1125 (Fed.Cir.1996). "The doctrine of equivalents enables a patent owner to prove infringement, despite a lack of literal infringement, where the differences between the claimed product and the accused product are insubstantial." *General Mills*, 103 F.3d at 984. Infringement, both literal and under the doctrine of equivalents, is a question of fact. *Id.* at 981, 984; *Roton Barrier*, 79 F.3d at 1125.

A. Construction of the Claim

Claim construction is a matter of law. *Kahn* at 1476. In construing the claims, this court must "independently assess the claims, the specification, and if necessary, the prosecution history, and relevant extrinsic evidence and declare the meaning of the claims." *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1556 (Fed.Cir.1995), cert. denied, 518 U.S. 1020, 116 S.Ct. 2554, 135 L.Ed.2d 1073 (1996).

Claims 1, 8, and 12 of the '206 patent are at issue in this case. Claim 1, in part, requires the following:

the body also including an internal socket receiving cavity or opening at the second end portion; and the body including a stop projecting longitudinally from the body and into the internal socket receiving cavity, whereby when the socket engaging end surface of a first of said connectors is inserted into the internal socket receiving cavity of a second of said connectors, the stop of the second connector is inserted into the stop receiving opening of the first connector to limit the relative pivoting of the connectors.

Claim 8 describes a hose connector assembly which requires, in part, the following:

the second male portion being sized for insertion into the first female portion to interconnect the first and second connectors with the first connector being free to pivot about the first longitudinal axis and relative to the second connector and the second connector being free to pivot about the second longitudinal axis and

relative to the first connector, an annular flange disposed within the first female portion and positioned to extend into the stop receiving opening to engage the interior wall of the second male portion to limit the extent of pivoting movement of the second longitudinal axis out of alignment with the first longitudinal axis when the second male portion is disposed within the first female portion.

Finally, Claim 12 requires, in part, the following:

the stop of ... each connector projecting into the stop receiving passageway of an adjoining connector when interconnected to limit the relative pivoting of the interconnected connectors, the internal passageways of a plurality of interconnected connectors forming a hose or conduit.

Each of these claims requires that a stop or limiting device which acts to limit the ability of the user to bend the device past a specific point be present in the device.

B. '206 Patent *Compared to Defendants' Device*

As stated *supra*, infringement is a question of fact. General Mills, 103 F.3d at 981. Plaintiffs have pointed to sufficient evidence in their favor which would enable a reasonable jury to return a verdict in their favor regarding the alleged infringement by defendants of the '206 patent. For example, plaintiffs have pointed to evidence which shows that, when defendants experienced problems with their first Rap-A-Lite designs, they decided to measure and analyze the patented "Black & Decker SnakeLight bead detail." (Pls.' Combined Response Ex. 12 and Ex. 1 John Cedarberg Dep. at 233.) Also, Cedarberg Industries, Inc.'s engineering manager, David L. Nystuen, agreed in his deposition that the same function of limiting the pivoting of the flexible beads so that they do not pop apart is performed in both the patented Black & Decker product and the Rap-A-Lite device. (Pls.' Combined Resp. Ex. 2, Nystuen Dep. at 148-49.) Nystuen agreed that this function is performed in the patented Black & Decker product by using an internal protrusion and by the use of a plastic tubing liner and a copper wire in the Rap-A-Lite device. (Pls.' Combined Resp. Ex. 2, Nystuen Dep. at 149.) Since genuine issues of material fact exist, defendants' motion for summary judgment must be denied.

CONCLUSION

For these reasons, defendants' Motion for Summary Judgment Based Upon Invalidity and Noninfringement of U.S. Patent 364,935 is DENIED, defendants' Motion for Summary Judgment Based Upon Invalidity of U.S. Patent 5,449,206 is DENIED, and defendants' Motion for Summary Judgment of Noninfringement of U.S. Patent 5,449,206 is DENIED. The parties are strongly urged to discuss the settlement of this case and report on the status thereof on September 3, 1998 at 10:00 a.m.

N.D.Ill.,1998.

Black & Decker Inc. v. Cedarberg Industries, Inc.

Produced by Sans Paper, LLC.