

United States District Court,
W.D. Michigan, Southern Division.

WHIRLPOOL CORPORATION,
Plaintiff.

v.

CURTIS INTERNATIONAL, LTD. et al,
Defendants.

No. 1:05-CV-200

Nov. 10, 2005.

G. Thomas Williams, Mary C. Bonnema, McGarry Bair PC, Grand Rapids, MI, Mark C. Terzola, Roetzel & Andress LPA, Akron, OH, for Plaintiff.

Timothy E. Eagle, Varnum Riddering Schmidt & Howlett LLP, Grand Rapids, MI, for Home Depot U.S.A., Inc.

ORDER

RICHARD ALAN ENSLEN, Senior District Judge.

This matter is before the Court to consider legal claim construction of a design patent (U.S. Patent DES 497,921, hereafter the '921 patent). The '921 patent concerns an ornamental design of a modular refrigerator door facing. Claim construction briefing was ordered as part of the Court's usual case management process. The parties to the dispute are: Plaintiff Whirlpool Corporation and Defendants Curtis International, Ltd. and Home Depot, U.S.A., Ltd.

In *Markman v. Westview Instruments Inc.*, 517 U.S. 370 (1996), the United States Supreme Court made clear that patent construction is an essential aspect of patent adjudication, but took no position on the process to be used in claim construction. *See Ballard Med. Products v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1358 (Fed.Cir.2001). As suggested in *Ballard*, in some cases claim construction will require evidentiary hearing, while in others it will not. When it does not, it may be accomplished after claim construction briefing, or may be done as part of summary judgment analysis. In this district, claim construction is typically done early to facilitate later summary judgment briefing. However, in this case, the briefing has left unanswered questions important to the construction of the single design claim. Thus, claim construction will be reserved.

While doing so, the Court will share with the parties its questions and concerns arising from the briefing. Plaintiff has taken the position that no claim construction, other than reference to the drawings, is necessary. (*See Pl.'s Markman Br.* at 10.) Defendants, to the contrary, have sought an extensive written description. (*See Defs.' Joint Prop. Constr.* at 11-12.) Both acknowledge that prosecution history FN1 must be considered

in claim construction, but Plaintiff argues that "points of novelty" are not part of claim construction. (Pl.'s *Markman* Br. at 6.) Plaintiff contends that its position is supported by the Federal Circuit's decision in *Bernhardt, LLC v. Collezione Europa U.S.A., Inc.*, 386 F.3d 1371, 1382-85 (2004). However, the *Bernhardt* Court was not presented with that question. Its statement about the "ordinary observer and point of novelty tests" only refers to the infringement analysis *per se*. It did not say that novel design features are irrelevant to claim construction, and this interpretation is illogical given the purpose of claim construction.

FN1. The prosecution history suggestions to this Court, so far, that Plaintiff has limited its application by disclaiming separate design drawings and concepts, other than drawings 1-4. (*See* Defs.' Ex. 2.)

As explained in *Markman*, *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1581-82 (Fed.Cir.1996) and *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317-24 (Fed.Cir.2005), while there is no magic formula or precise catechism for claim construction, the basics of that process must emphasize the patent language, drawings and other intrinsic evidence. In *Phillips*, the Federal Circuit made clear that "intrinsic evidence" includes the prosecution history and the prior art considered by the examiner. *Id.* at 1317. The prior art references are especially important in the context of a design patent because the "point of novelty" test used at the time of the infringement analysis permits a limitation of the patent design as determined from a review of the prior art. *See, e.g.*, *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed.Cir.1984). In other words, to properly construe a design patent, the Court must examine all the pertinent intrinsic evidence, including the prior art references. Because the prior art references have not been filed in this case and have not been briefed, the Court must delay claim construction pending later briefing.FN2

FN2. The parties may, as they see fit, either agree by stipulation to a briefing schedule for further claim construction briefing in advance of the summary judgment motion filing or leave further briefing on claim construction to be done at the time of the summary judgment briefing.

Additionally, the Court has the following questions, which should be addressed in later briefing: Since it has been argued that orientation of the stamped effects on the door facing is part of the design, is the orientation of the effects in relation to the center, sides and corners of the facing a defining characteristic of the design? If so, how is that orientation best described? Is the functional shape of the handle (that which makes it capable of grasp) a non-patented feature? If so, how is it defined in relationship to the design element of the handle? Is the functional positioning of the handle (*i.e.*, a portion of it is placed away from the hinge to allow for opening) a non-patented feature? If so, how is it defined in relationship to the design element of the handle?

ACCORDINGLY, IT IS HEREBY ORDERED that claim construction is **RESERVED** pending the completion of further briefing either at the time of the summary judgment briefing or such earlier time as the parties may agree to its completion.

W.D.Mich.,2005.

Whirlpool Corp. v. Curtis Intern., Ltd.

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