

Design Patent Case Digest

[Sofpool, LLC v. Kmart Corp.](#)



Decision Date: August 29, 2012

Court: E.D. California

Patents: [D480,817](#)

Holding: Parties' cross-motions for summary judgment denied

Opinion: Plaintiff Sofpool, LLC sued Defendant Kmart Corp. for infringement of U.S. Design Patent D480,817 titled Above-ground Swimming Pool. Both [Sofpool](#) and [Kmart](#) sell similar above-ground pools. Sofpool moved for summary judgment on its infringement claim and Kmart cross-moved for summary judgment on non-infringement and invalidity. The court ordered Sofpool to submit a claim construction distinguishing the functional and ornamental elements of its patented design. Sofpool complied and Kmart then offered a competing claim construction.

Sofpool's claim construction focused on the "overall effect" of certain features including an above-ground oval pool, the pool sides, the top tube section on top of the sides, and the generally U-shaped side struts.

Kmart's claim construction was more specific and focused on design details including trapezoidal shaped struts angling outward, walls that include a top ring and bottom portion with walls that are concave and bulbous, elongated sides each consisting of eight curved panels of various sizes and two straight panels.

Both parties' claim constructions failed to reference the patent drawings and made only purely verbal descriptions. The court found the detailed verbal description of Kmart to be exactly the type the Federal Circuit warned against in [Egyptian Goddess, Inc. v. Swisa, Inc.](#), 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc). In addition the court found that each element depicted in the patent drawings could have both a function and an ornamental aspect. Thus, the fact that an element has a function does not preclude the element from contributing to the overall patented design.

Relying on the Federal Circuit's approval of the claim construction used in [OddzOn Prods., Inc. v. Just Toys, Inc.](#), 122 F.3d 1396, 1405 (Fed. Cir. 1997) (the design concerned a football-shaped toy with a protruding tail shaft and fins) the court issued the following claim construction:

The claimed design is an above-ground, oval-shaped pool with side-struts, and additional elements or features, as shown in the '817 patent drawings. Whatever functional role may be played by any element or feature of the pool depicted in the drawings is not a part of the claim, and should therefore be disregarded; but the design of those same elements or features is a part of the claim. The elements or features referred to include, but are not limited to the following as depicted in the drawings: the tubular top; side-struts; side-straps; angled and bulging side-walls; rounded, angled and bulging end walls; and segmented panel walls of varying widths, connected by seams, and creating a pattern as seen from above.

The court then denied the parties' cross-motions for summary judgment without prejudice because they were made without the benefit of the court's claim construction.



Thumbs up:

The court correctly resisted the parties' attempts to verbalize the claim without reference to the drawings. The court also correctly analyzed the functional aspects of the design by recognizing that each design element "has (or could have) a function, while it too has an ornamental aspect." Rather than adopting the "excise" approach in [Richardson v. Stanley Works, Inc.](#), 597 F.3d 1288 (Fed. Cir. 2010), the court incorporated all features of the design patent drawings into the claim construction. One practice note, parties in litigation may be wise to wait for the claim construction before filing a motion for summary judgment regarding infringement or validity.

If you have any questions or would like additional information on this topic, please contact:

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