UNPUBLISHED

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF WEST VIRGINIA

CHARLESTON DIVISION

ENTERED
JUL 26 2002
SAMUEL L. KAY, CLERK
U. S. District & Bankruptcy Courts
Southern District of West Virginia

BOONE SUPPLY COMPANY, and
WILLIAM J. B. JACOBS,

Plaintiffs,

v. CIVIL ACTION NO. 2:01-0420

CAMBRIA COUNTY ASSOCIATION
FOR THE BLIND & HANDICAPPED, et al.,

Defendants.

**ORDER**

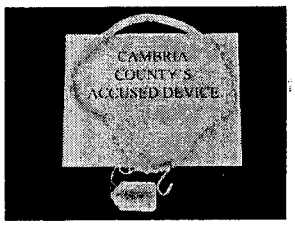
Pending before the court are the defendants Cambria County Association's and Superior Filter Company's motions for summary judgment [dockets #124 & 126]. For the reasons discussed below, the court **GRANTS** the defendants' motions.

I. Background

This case involves an alleged patent infringement over a mining hanger. On September 19, 1989, the United States Patent and Trademark Office issued the plaintiff, William J. B. Jacobs, a design patent for a hanger unit for cable or similar articles listed as patent number 303,493 (the '493 patent) (see figure below).

Jacobs subsequently entered into an agreement with the plaintiff, Boone Supply Company, for Boone Supply to have the exclusive right to make and sell the patented hanger unit.

On May 16, 2001, the plaintiffs filed a complaint in this court against numerous defendants, including Cambria County Association for the Blind and Handicapped (Cambria) and Superior Filter Company (Superior Filter), alleging infringement of the '493 patent by manufacturing and selling hanger units with the same design (see figures below).



With respect to the other defendants in this case who have not settled or have otherwise been dismissed, there is a motion pending for entry of default judgment against the defendant Elk Sales and Service, Inc., and the defendant Shawnee Hills, Inc. has filed for bankruptcy. Thus all matters with respect to Shawnee Hills are stayed.

On June 6, 2002, this court held a Markman's hearing where counsel for the plaintiffs, Boone Supply and Jacobs, and counsel for Cambria and Superior Filter, argued for their proposed construction of the '493 patent. On June 7, 2002, the court issued an order setting forth the following claim construction:

> The ornamental design for a hanger unit for cable or similar articles where the hanger unit is formed of a main loop and a second loop of relatively small diameter. The entire circumference of both the main loop and the second loop is covered with a cross-over braid ("fiber pattern") design. The relatively small diameter second loop extends outward from the main loop, and is of a thickness less than the thickness of the main loop. An s-shaped hook with a smooth surface is attached to the hanger unit. One end of the s-shaped hook has a diameter smaller than the other, with the smaller diameter end closed around the hanger unit. The larger diameter end of the s-shaped hook is not formed into a closed position.

On June 27, 2002, Cambria and Superior Filter filed motions for summary judgment, which are now ripe for this court's review.

## II. Standard of Review

To obtain summary judgment, the moving party must show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. *Fed. R. Civ. P.* 56(c). In considering a motion for summary judgment, the court will not "weigh the evidence and determine the truth of the matter." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). Instead, the court will draw any permissible inference from the underlying facts in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587-88 (1986).

Although the court will view all underlying facts and inferences in the light most favorable to the nonmoving party, the nonmoving party nonetheless must offer some "concrete evidence from which a reasonable juror could return a verdict in his [or her] favor." *Anderson*, 477 U.S. at 256. Summary judgment is appropriate when the nonmoving party has the burden of proof on an essential element of his case and does not make, after adequate time for discovery, a showing sufficient to

establish that element. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986). The nonmoving party must satisfy this burden of proof by offering more than a mere "scintilla of evidence" in support of his or her position. *Anderson*, 477 U.S. at 252.

III. Discussion

A design patent protects only the novel, ornamental features of the patented design. *Unidynamics Corp. v. Automatic Prods. Int'l, Ltd.*, 157 F.3d 1311, 1323 (Fed. Cir. 1998) (citing *Oddzon Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997)). In determining whether a design patent has been infringed, two separate tests must be applied: the ordinary observer test and the point-of-novelty test. *Id.* (citations omitted). Under the ordinary observer test, the court must determine:

> If, 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.

*Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871). The patent owner carries the burden in demonstrating that the ordinary observer would be deceived by the common *ornamental* features. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 825 (Fed. Cir. 1992); *Unidynamics Corp.*, 157 F.3d at 1323. In the second step of the analysis, the court must determine under the point-of-novelty test whether the accused devices appropriate the novelty in the patented device which distinguishes it from the prior art. *Id.*; *Oakley, Inc. v. Int'l Tropic-Cal, Inc.*, 923 F.2d 167, 169 (Fed. Cir. 1991).

A. Ordinary Observer Test

This court previously construed the plaintiff's '493 design patent as a mining hanger formed by a main loop and a second smaller loop made up of a fiber-pattern, cross-over braid design. The smaller second loop extends outward from the main loop, and is thinner than the main loop. An s-shaped hook with a smooth surface is attached to the hanger unit. The plaintiffs argue, however, that the hollow fiber pattern of the main loop is the only ornamental feature of the patented design, not the secondary loop. In sum, the plaintiffs assert that the '493 design patent protects against another making a loop of common rope and attaching an s-hook to it. Nonsense.

The plaintiff Jacobs included in his patent application drawings of a hanger unit with a secondary loop clearly present. He effectively limited the scope of his patent claim when he included that feature in it. *See Elmer v. ICC Fabricating*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). A design patent claim is limited to what is shown in the patent drawings. *Id.*; *In re* Mann, 861 F.2d 1581, 1582 (Fed. Cir. 1988). Furthermore, when applying the ordinary observer test, the court must view the patented design in its entirety, and cannot focus on one feature of the claimed design. *Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1378 (Fed. Cir. 2002).

Applying the ordinary observer test, the court finds that an ordinary observer would not be deceived into believing the accused devices were the same as the claimed patent. The plaintiff's claimed design reflects a hanger unit having one continuous large loop, and one smaller loop made up of a rope-like material with an s-hook attached to the larger loop. Cambria's accused device is composed of a simple, continuous rope-like loop with an s-hook attached. *See* Cambria Def.'s Ex. 1 to Mot. for Summ. J. Superior Filter's accused device is composed of a rope attached separately by the joined ends of the rope into a loop and connected to an s-hook. *See* Superior Filter Def.'s Ex. 1 to Joinder to Cambria's Mot. for Summ. J. Thus, neither Cambria's design nor Superior Filter's

design contain the secondary loop depicted in the plaintiff's '493 patent. At a glance, it is clear to this court that the designs are not deceptively similar because the accused designs lack this secondary loop, one of the notable features of the '493 patent.

Notwithstanding the absence of a secondary loop in the defendants' devices, the plaintiffs assert that there is a material question of fact as to whether an ordinary observer would be deceived as to the '493 patent and the accused devices. In support of this argument, they have submitted affidavits by a number of coal miners who state that they believe the '493 patent looks substantially the same as the defendants' hanger designs. There is no evidence, however, that the affiants compared the court's construction of the claim to the accused devices in reaching their decision, or that they were confused by the common ornamental features of the devices. *See Oddzon Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1407 (Fed. Cir. 1997) (holding that surveys are flawed where "they fail to distinguish between the ornamental features of the [devices] and their functional" features); *see also* Pls.'s Ex. 2 to Resp. to Mot. for Summ. J. (depicting *a commercial* embodiment of the plaintiff's design as opposed to the designs submitted with the patent application or the court's construction of the patent). Accordingly, the court finds that such affidavits do not raise a genuine issue for trial.

B. Point-of-Novelty Test

When the court applies the point-of-novelty test in the second step of the analysis, it becomes even more clear that there is no infringement. At this step, the court must compare the accused devices to the patented design to determine whether the accused devices "appropriate the novelty in the patented [design] which distinguishes it from the prior art." *Unidynamics Corp.*, 157 F.3d at 1323. The court must review the prior art cited during the prosecution of this patent to determine which features of the claimed design are not present in the prior art. *Id.*

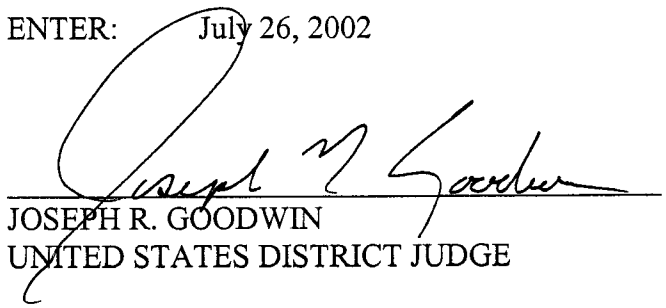
Here, the prior art includes the Encyclopedia of Knots which depicts various forms of rope with a fiber pattern similar to that of the plaintiff's patent, including one shaped in a continuous loop. *See* Cambria Def.'s Ex. 3 (plates 95-97). S-shaped hooks of various sizes and shapes also are disclosed in the prior history. *See* Cambria Def.'s Ex.4-5. Accordingly, the point of novelty of the plaintiffs' patent cannot be the main loop of rope, the fiber pattern, or the s-shaped hook because these are all apparent in the prior art. The only apparent point of novelty in the '493 patent is the smaller, secondary loop.

The plaintiffs argue, however, that a main loop with a secondary smaller loop already existed and is demonstrated in item 125 of plate 97 in the prior art. *See* Cambria Def.'s Ex. 3. Thus, according to the plaintiffs, the court should not consider that feature as the point of novelty. While the plaintiffs are correct that item 125 reflects two loops of rope, one smaller than the other, the point of novelty stems from the appearance of the loops as presented. The court finds, as the patent officer must have, that the configuration of the '493 patent's loops are different than the prior art. The plaintiffs' patent design has a much smaller and thinner secondary loop, whereas the loops in item 125 appear to have the same thickness.

Accordingly, the point of novelty in the claimed patent is the smaller, thinner, secondary loop as set forth in the court's claim construction of patent '493. Neither of the defendants' accused designs contains a secondary loop. Cambria's device is a continuous, single loop of rope with an s-hook attached to it, and Superior Filter's rope is one loop joined at the ends by an s-hook. Thus, the plaintiffs are unable to meet the requirements of the point-of-novelty test. For these reasons and those discussed above, the court finds that the devices of Cambria and Superior Filter do not infringe the '493 patent. The court **GRANTS** the defendants' motion for summary judgment.

The court **DIRECTS** the Clerk to send a copy of this Order to counsel of record and any unrepresented party.

ENTER: July 26, 2002



JOSEPH R. GOODWIN
UNITED STATES DISTRICT JUDGE