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U.S. PATENT & TRADEMARK OFFICE

To: Commissioner of Patents and Trademarks PO BOX 1450 Alexandria VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116, you are hereby advised that a court action has been filed in the **U.S. District Court for the District of Utah** on the following ☐ Patents ☒ Trademarks:

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:06cv806 PGC	**09/22/06**	**Central District of Utah** **350 South Main Street, Room 150, Salt Lake City, UT 84101**

PLAINTIFF	DEFENDANT
Hammerton, Inc.	**Robert Heisterman**

PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 See Attached	See Attached	See Attached
2 D430,818		
3 D430,819		
4		
5		

In the above-entitled case, the following patents(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	**DATE OF PATENT OR TRADEMARK**	**HOLDER OF PATENT OR TRADEMARK**
1		
2		
3		
4		
5		

In the above-entitled case, a final decision had been rendered or judgment issued:

DECISION / JUDGMENT

NON-FINAL JUDGMENT: Partial Summary Jgm granted in favor of Heisterman and Kahm Industries, see attached order.

CLERK	(BY) DEPUTY CLERK	DATE
D. Mark Jones	Bonnie King	10/16/07

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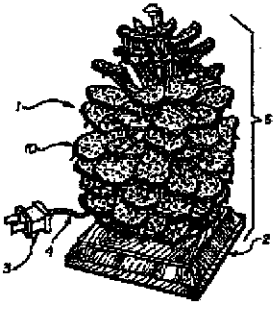
art and because there are multiple ways to accomplish this distinction, the court concludes that the base feature of the Pine Cone Patent design is ornamental. The base of the Pine Cone Patent is a smooth cylinder out of which the stem of the pinecone protrudes. The bases found in two of the design patents[30] referenced by the Pine Cone Patent are quite different in appearance, one square with routed edges, the other circular with a gentle incline from the edges toward the center of its top:



The base found in the Pine Cone Patent is clearly different from the bases found in the prior art, suggesting that it is ornamental. This also shows that there are any number of shapes and textures that might be used to accomplish the functions performed by the base (*e.g.*, a smooth triangle or a textured square), further indicating that the base in the Pine Cone Patent is ornamental in character and not primarily functional.

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[30] U.S. Patent No. 5,489,452 (filed Aug. 18, 1993); U.S. Patent No. 1,773,824 (filed Feb. 25, 1929).

Hammerton argues that the base is functional because it is "generic" and serves the primarily functional purpose of supporting the pine cone. From this Hammerton argues that because the base is functional it is not part of the Pine Cone Patent's claim and thus should not be considered for purposes of the infringement determination. However, as demonstrated in part by the differing bases used in the prior art, the number of available alternative designs that could serve the support function claimed by Hammerton leads the court to conclude that the base found in the Pine Cone Patent is ornamental in nature. Even assuming that the base is functional, it is still part of the claimed design because Hammerton included it in the drawings without using broken lines. As part of the claimed design, the base would still be considered when comparing the patented and accused designs "as a whole" for purposes of infringement.[31] That the base is functional would merely prevent a finding of infringement based on similarities in the Pine Cone Patent base and the base of an accused design, rather than on their common ornamental features. In other words, when a feature included in the claim of a design patent is functional, such feature actually limits the scope of a design patent instead of expanding it.[32]

Infringement

The second step of the infringement analysis, comparing the construed claim to the accused design, is itself a two step examination. In order to find infringement, this comparison must satisfy both the "ordinary observer" test and the "point of novelty" test.[33] As both tests

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[31] *See infra* note 40 and accompanying text.

[32] *See OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1406 (Fed. Cir. 1997)

[33] *Contessa Food Prods.*, 282 F.3d at 1377.

must be satisfied in order to find infringement, the court need proceed to the "point of novelty" test only when the "ordinary observer" test has been met.[34]

The ordinary observer test requires the court to perform the following inquiry:

> [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.[35]

The patented and accused designs need not be identical in order to find infringement.[36] Rather, "[t]he measure of infringement of a design patent is deception of the ordinary observer, when such person gives the design the attention usually given by a purchaser of the item bearing the design . . . ."[37] Although the principles of equivalency are applicable to design patent infringement analysis, the comparison must still satisfy the ordinary observer test in order to support a finding of infringement.[38]

In determining whether the ordinary purchaser would be so deceived, the court should compare "all ornamental features"[39] of the patented and accused designs "as a whole" rather than

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[34] *See Keystone Retaining Wall Sys.*, 997 F.2d at 1451.

[35] *Id.* (quoting *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871)).

[36] *Contessa Food Prods.*, 282 F.3d at 1376.

[37] *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1117 (Fed. Cir. 1998).

[38] *Lee*, 838 F.2d at 1190.

[39] *Contessa Food Prods.*, 282 F.3d at 1380.

singling out any subset of ornamental features.[40] Additionally, the required resemblance must be attributable to "the common features in the claimed and accused designs which are ornamental" rather than functional.[41]

Thus, the question before the court is whether a reasonable jury could conclude that Kahm Design's lighting fixtures are so similar to the Pine Cone Patent design, as construed above, that they could induce the ordinary observer to purchase the former supposing it to be the latter. If the answer to this question is no, Kahm Design is entitled to summary judgment on the issue of infringement. Otherwise, the court must proceed to the point of novelty test.

The court initially notes that Hammerton has not affirmatively indicated which of the lighting fixtures or other products held for sale by Kahm Design infringes the Pine Cone Patent. The only instance in which Hammerton points to any specific product of Kahm Design is in the Declaration of Levi Wilson in which Mr. Wilson refers to a series of side-by-side comparisons of lighting fixtures produced by Hammerton and similar lighting fixtures produced by Kahm Design, more than half of which include no pine cone feature at all.[42] However, Hammerton does not assert that these specific lighting fixtures infringe the Pine Cone Patent. Instead, Hammerton argues that it is not the lighting fixtures sold by Kahm Design that infringe the patent, but rather the pine cones incorporated into those lighting fixtures that are guilty of infringement. Yet, Hammerton has cited no authority that would allow this court to compare the

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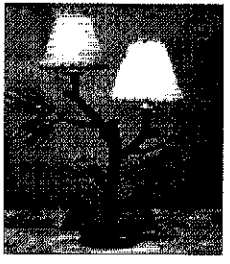
[40] *See Keystone Retaining Wall Sys.*, 997 F.2d at 1450-51.

[41] *See Amini Innovation*, 439 F.3d at 1371.

[42] Pl.'s Mem. Opp'n. Ex A ¶ 17 (Docket No. 64).

Pine Cone Patent design to only a portion of Kahm Design's lighting fixtures. To the contrary, Federal Circuit precedent requires the court to compare the patented and accused designs "as a whole."[43] Moreover, the court may not consider the similarity between Hammerton's lighting fixtures with those of Kahm Design because "[i]t is legal error to base an infringement finding on features of the commercial embodiment not claimed in the patent."[44]

When compared to the Pine Cone Patent design, with its single vertically-oriented pine cone with petals attached to the stem as construed above, including the cylindrical base from which the stem protrudes, the various lighting fixture designs sold or offered for sale by Kahm Design could not induce the ordinary observer to purchase Kahm Design's lighting fixtures supposing them to be the pine cone sculpture depicted in the Pine Cone Patent. Kahm Design has attached to its memo in support "[a] photograph or drawing of every Kahm Design product that includes or may have included a pinecone design feature sold or offered for sale by Kahm Design."[45] The following is a sampling of those drawings and pictures:



[43] *See Keystone Retaining Wall Sys.*, 997 F.2d at 1450-51.

[44] *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1196 (Fed Cir. 1995).

[45] Defs.' Mem Supp. Ex. D ¶ 4 (Docket No. 47).

Without exception, each product so identified has multiple other ornamental characteristics such as a branch-like frame, a pine needle feature, or ornate light fixtures and shades. Generally, any pine cone feature found in Kahm Design's products is attached directly to a branch-like frame or a lighting fixture, rather than directly to a cylindrical base. Such is also the case with the lighting fixtures of Kahm Design highlighted by Hammerton in the Declaration of Mr. Wilson. No reasonable jury could conclude that any of the Kahm Design products before the court could be confused by an ordinary observer with the single pinecone statue, the stem of which is directly affixed to a cylindrical base, as depicted in the Pine Cone Patent.

Under the doctrine of equivalents, Hammerton also submits allegations regarding defendant Robert Heisterman's prior employment with Hammerton, asserting that Heisterman thereby gained knowledge of Hammerton's designs and production methods that he presumably uses to produce the accused products. Even assuming these allegations to be true, the court may find infringement of the Pine Cone Patent only where the ordinary observer test is met. As explained above, no reasonable jury could find that the ordinary observer would mistake Kahm Design's products for the pine cone sculpture depicted in the Pine Cone Patent. In light of the court's finding that the comparison of the patented and accused designs in this case fails the ordinary observer test, no analysis of the point of novelty test is required.

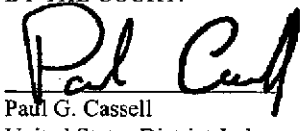
CONCLUSION

Accordingly, the court hereby GRANTS Kahm Design's Motion for Summary Judgment of Noninfringement of Asserted Patents (#46) and therefore enters partial summary judgment in favor of Defendants Heisterman and Kahm Industries, LLC, with respect to Hammerton's fourth

cause of action, design patent infringement.

DATED this 16th day of October, 2007.

BY THE COURT:



Paul G. Cassell
United States District Judge

IN THE UNITED STATES COURT FOR THE DISTRICT OF UTAH
CENTRAL DIVISION

HAMMERTON, INC, a Utah corporation, Plaintiff, v. ROBERT HEISTERMAN, individually and dba "KAHM DESIGN," and KAHM INDUSTRIES, LLC, a Utah limited liability company, Defendants.	**ORDER GRANTING PARTIAL SUMMARY JUDGMENT** Case No. 2:06-cv-00806

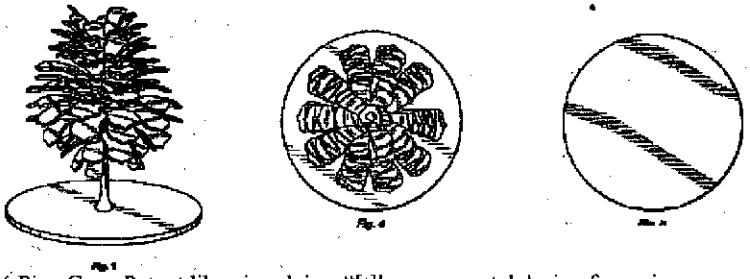
This case arises out of a dispute between two manufacturers of decorative lighting fixtures. Plaintiff Hammerton, Inc., ("Hammerton"), alleges multiple causes of action against Defendants Robert Heisterman and Kahm Industries, LLC, (collectively "Kahm Design"), including trade dress infringement, unfair competition, misappropriation of trade secrets, and design patent infringement. Currently before the court is Kahm Design's Motion for Summary Judgment of Noninfringement of Asserted Patents (#46).

For the reasons set forth below, the court finds noninfringement as a matter of law and accordingly GRANTS Kahm Design's motion, entering partial summary judgment in favor of Kahm Design with respect to Hammerton's fourth cause of action—design patent infringement.

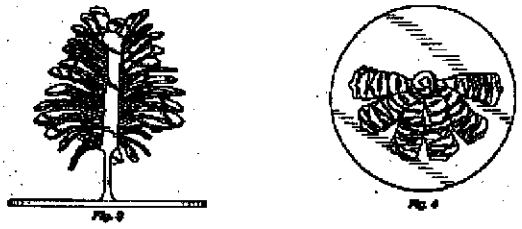
FACTS

On September 12, 2000, Hammerton obtained two design patents, United States Patent

Des. 430,818 (the "Pine Cone Patent") and United States Patent Des. 430,819 (the "½ Pine Cone Patent").[1] The Pine Cone Patent claims "[t]he ornamental design for a pinecone sculpture, as shown" in the five drawings accompanying the patent. These drawings[2] basically depict a single pine cone on a stand:



The ½ Pine Cone Patent likewise claims "[t]he ornamental design for a pinecone sculpture, as shown" in the five drawings accompanying that patent. However, the ½ Pine Cone Patent [3] is for a pine cone with petals on only the front half of the stem:



In its complaint, Hammerton claims that Kahm Design "incorporate[s] metal pine cone

[1] Pinecone Sculpture, U.S. Patent No. Des. 430,818 (issued Sep. 12, 2000); Pinecone Sculpture, U.S. Patent No. Des. 430,819 (issued Sep. 12, 2000).

[2] '818 Patent figs.1, 4, 5.

[3] '819 Patent figs.3, 4.

sculptures into their lighting fixture designs" that infringe "one or both of Hammerton's U.S. Design Patents."[4] In response, Kahm Design has attached to its memorandum in support "[a] photograph or drawing of every Kahm Design product that includes or may have included a pinecone design feature sold or offered for sale by Kahm Design."[5] Kahm Design does not sell individual pine cone sculptures, but rather "sells only lighting fixtures, tables, chairs, stools, firewood holders, lighting fixtures with mirrors, and fireplace screens" that incorporate pine cone features.[6]

Other than those products disclosed in the exhibits to Kahm Design's memorandum in support, Hammerton has offered no evidence of any specific products of Kahm Design that should be considered for purposes of infringement. Although the declaration of Levi Wilson submitted with Hammerton's memorandum in support includes a side-by-side comparison of multiple lighting fixtures of Hammerton and of Kahm Design, alleging that Kahm Design's lighting fixtures are "very similar" to the those Hammerton,[7] Hammerton does not point to any specific product sold or held for sale by Kahm Design that infringes its patents. Instead, Hammerton asks the court to limit the infringement inquiry to the pine cones incorporated into Kahm Design's lighting fixtures rather than the entirety of the lighting fixtures themselves. Similar to Kahm Design, Hammerton welds its metal pine cones to the lighting fixtures it sells

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[4] First Am. Compl. ¶¶ 56, 57 (Docket No. 53).

[5] Defs.' Mem Supp. Ex. D ¶ 4 (Docket No. 47).

[6] *Id.* at Ex. D ¶ 8; Pl.'s Mem. Opp'n. 6 (Docket No. 64).

[7] Pl.'s Mem. Opp'n. Ex. A ¶ 17 (Docket No. 64).

instead of selling the pine cones individually.[8]

STANDARD OF REVIEW

Summary judgment is appropriate only where there are no disputed material issues of fact, and where one party is entitled to judgment as a matter of law.[9] Where, as in this case, the nonmoving party will ultimately bear the burden of proof at trial, "the burden on the [party moving for summary judgment] may be discharged by 'showing' . . . that there is an absence of evidence to support the nonmoving party's case."[10] Upon such a showing by the moving party, the nonmoving party must then "set forth specific facts showing that there is a genuine issue for trial."[11] The court may grant summary judgment only where no "reasonable jury could return a verdict for the nonmoving party."[12] To apply this standard, the court must view the evidence in the light most favorable to the nonmoving party.[13]

DISCUSSION

"A design patent protects the non-functional aspects of an ornamental design as seen as a

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[8] *Id.* at 6, Ex. A ¶¶ 13-15.

[9] Fed. R. Civ. Pro. 56(c).

[10] *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986).

[11] *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986) (quoting Fed. R. Civ. Pro. 56(e)).

[12] *Id.*

[13] *Green v. New Mexico*, 420 F.3d 1189, 1192 (10th Cir. 2005).

whole and as shown in the patent."[14] Determining whether a patented design has been infringed requires the court to engage in a two step analysis: first, the court must construe a design patent claim as a matter of law to determine its meaning and scope; second, the fact-finder makes an infringement determination by comparing the construed claim to the accused design.[15]

Kahm Design indicates that it "has never sold or offered for sale any lighting fixtures with a pinecone having petals present on only one side of the vertically oriented pinecone."[16] Likewise, in its opposition to Kahm Design's motion for summary judgment of non-infringement, Hammerton concedes that "Kahm Design has not manufactured or sold any ½ pine cone designs which would infringe Hammerton's [½ Pine Cone Patent]."[17] As Hammerton has apparently conceded non-infringement of the ½ Pine Cone Patent, the court need consider only the Pine Cone Patent in its infringement analysis.

Claim Construction

"In construing a design patent claim, the scope of the claimed design encompasses 'its visual appearance as a whole,' and in particular 'the visual impression it creates.'"[18] Design

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[14] *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1370-71 (Fed. Cir. 2006) (quoting *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993)).

[15] *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1286 (Fed. Cir. 2002); *see also Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995).

[16] Defs.' Mem. Supp. 10 (Docket No. 47).

[17] Pl.'s Mem. Opp'n 3 (Docket No. 64).

[18] *Contessa Food Prods. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104-05 (Fed. Cir. 1996)).

patent claims must refer to the drawing or drawings accompanying the patent application, which depict the claimed design.[19] Thus, the scope of the claim is "defined by the drawings in the patent."[20]

Because a design patent protects only "ornamental" features of the claimed design, the court must also indicate in its claim construction those features of the design which are "functional" and therefore not within the scope of the patent's protection.[21] Generally a feature of the design is functional where "it is essential to the use or purpose of the article or if it affects the cost or quality of the article."[22] When there are several ways to express a feature it is more likely that such feature is ornamental rather than functional.[23]

Most important, the Federal Circuit has made clear that where a feature is included by the patentee in the design drawings, such feature becomes part of the claimed design and limits the scope of the design patent: "If features appearing in the figures are not desired to be claimed, the patentee is permitted to show the features in broken lines to exclude those features from the claimed design, and the failure to do so signals inclusion of the features in the claimed design."[24]

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[19] 37 C.F.R. § 1.152–1.153(a).

[20] *Keystone Retaining Wall Sys.*, 997 F.2d at 1450.

[21] *See Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188-89 (Fed. Cir. 1988).

[22] *Amini Innovation*, 439 F.3d at 1371 (quoting *Inwood Labs, Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 (1982)) (internal quotation marks omitted).

[23] *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1313 (Fed. Cir. 2001) (citing *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993)).

[24] *Contessa Food Prods.*, 282 F.3d at 1378.

For example, in *Elmer v. ICC Fabricating, Inc.*, the patentee argued that certain features of its design patent for a vehicle-mounted advertising sign were functional in nature and thus should not limit the scope of its claim.[25] In construing this patent, the Federal Circuit noted that the features at issue — "triangular vertical ribs and an upper protrusion" — appeared in each of the drawings to which the patent claim referred.[26] The court concluded that by choosing not to omit these features from the drawings, the patentee had "effectively limited the scope of its patent claim by including those features in it."[27]

With regard to the construction of the Pine Cone Patent, the primary dispute of the parties centers on whether the claim includes the base upon which the pine cone rests as pictured in each of the patent drawings. Hammerton argues that the claim does not include the base because it is functional, not ornamental, and because it is already part of the prior art, which is not part of Hammerton's claimed design. Kahm Design contends that the claim does include the base because Hammerton did not omit it from the patent drawings or show it in broken lines and that the base is ornamental rather than functional because any support function performed by the base could have been accomplished in multiple ways.

The court finds that the base is part of the Pine Cone Patent's claim and that it is ornamental in nature because it appears in all of the drawings to which the claim refers and because its appearance is visually distinguished from the prior art and is capable of expression in

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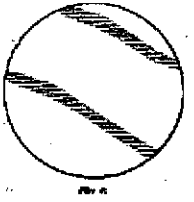
[25] *Elmer*, 67 F.3d at 1573, 1576-77.

[26] *Id.* at 1577.

[27] *Id.*

multiple ways. Accordingly, the court construes the Pine Cone Patent claim as follows: A single vertically-oriented pine cone with petals that are peaked and gradually bend downward at the tips, which are attached to a smooth stem in a manner that when viewed from above appear to be aligned in vertical columns, and with the stem protruding from the center of a smooth cylindrical base.

The base must be included in the claim as Hammerton opted to include it in the patent drawings without drawing it in broken lines. The claim description as shown on the patent itself is to "[t]he ornamental design for a pinecone sculpture, *as shown*."[28] The five drawings accompanying the Pine Cone Patent, and to which the claim description refers, each include the base in whole lines instead of broken lines. Figure 5,[29] a view from the bottom of the design, depicts the pine cone entirely obstructed by the base:



As Hammerton applied for the Pine Cone Patent on Oct. 13, 1999, four years after the *Elmer* case was decided, Hammerton was clearly on notice that the inclusion of any feature in the design patent drawings without using broken lines at the very least would raise a presumption that such feature would be included in the claim's construction. Hammerton's failure to draw the base in broken lines or to omit it from the drawings altogether signals to the court that Hammerton intended that the base be included in the claimed design.

Additionally, because the base is clearly visually distinguished from the base in the prior

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[28] Pinecone Sculpture, U.S. Patent No. Des. 430,818 (issued Sep. 12, 2000).

[29] *Id.* at fig.5.