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UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF CALIFORNIA

SOFPOOL LLC, a Limited  
Liability Company,

NO. CIV. S-10-3333 LKK/JFM

Plaintiff,

v.

KMART CORPORATION, a  
Michigan Corporation, and  
BIG LOTS, INC., an Ohio  
Corporation,

O R D E R

Defendants.

\_\_\_\_\_ /

I. **BACKGROUND**

In its First Amended Complaint, plaintiff Sofpool, LLC, alleges that defendants Kmart Corp. and Big Lot Stores, Inc., infringed its design patent for an oval, above-ground swimming pool, U.S. Patent No. D480,817 S (the '817 claimed patent), by selling their own "Summer Escapes" pool. Plaintiff has now moved for summary judgment on the infringement claim. Defendants have cross-moved for summary judgment, asserting that they have not

1 infringed the patent, and that in any event, the patent itself is  
2 invalid because it was "obvious" in light of the prior art. See 35  
3 U.S.C. § 103 ("non-obvious subject matter").<sup>1</sup>

4 For the reasons that follow, the court finds that the accused  
5 pool does not infringe the '817 claimed patent. Accordingly  
6 summary judgment will be granted to defendants.

7 **1. STANDARDS**

8 **a. Infringement.**

9 A design patent is infringed if "the patented design, or any  
10 colorable imitation thereof," is applied to "any article of  
11 manufacture for the purpose of sale." 35 U.S.C. § 289. Thus, "a  
12 design patent is infringed by the 'unauthorized manufacture, use,  
13 or sale of the article embodying the patented design or any  
14 colorable imitation thereof.'" Arminak and Associates, Inc. v.  
15 Saint-Gobain Calmar, Inc., 501 F.3d 1314, 1319 (Fed. Cir. 2007),  
16 cert. denied, 553 U.S. 1102 (2008), quoting Goodyear Tire & Rubber  
17 Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116-17 (Fed.  
18 Cir. 1998).<sup>2</sup>

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20 <sup>1</sup> "A patent for a claimed invention may not be obtained ...  
21 if the differences between the claimed invention and the prior art  
22 are such that the claimed invention as a whole would have been  
23 obvious . . . to a person having ordinary skill in the art to which  
24 the claimed invention pertains." 35 U.S.C. § 103. "Design  
patents, like utility patents, must meet the nonobviousness  
requirement of 35 U.S.C. § 103." Titan Tire Corp. v. Case New  
Holland, Inc., 566 F.3d 1372, 1384-85 (Fed. Cir. 2009).

25 <sup>2</sup> The statute's use of the term "colorable imitation"  
26 recognizes that "minor changes in a design are often readily made  
without changing its overall appearance." Goodyear, 162 F.3d at  
1117.

1 Of course, the claimed design does not cover the universe of  
2 designs that remotely resemble it. Rather, as an initial matter,  
3 a design patentee limits the scope of his patent by including  
4 ornamental features that give the overall design a distinctive  
5 ornamental appearance. See Elmer v. ICC Fabricating, Inc., 67 F.3d  
6 1571, 1577 (Fed. Cir. 1995) (patentee included in its drawings  
7 certain features that gave the design "a distinct ornamental  
8 appearance," and "thus effectively limited the scope of its patent  
9 claim by including those features in it"). Thus, the initial step  
10 in any comparison of designs is a determination of whether the  
11 accused design is even within the limitation on scope that the  
12 patentee has imposed, through his patent drawings.

13 If the patentee's limitations on his patent do not plainly  
14 exclude the accused design, however, the infringement inquiry then  
15 requires the fact-finder to compare the whole of the claimed design  
16 "to the design of the accused device." OddzOn Products, Inc. V.  
17 Just Toys, Inc., 122 F.3d 1396, 1404 (Fed. Cir. 1997). The  
18 comparison "requires the fact-finder to determine whether the  
19 patented design as a whole is substantially similar in appearance"  
20 to the accused design. Id., at 1405 (emphasis added).

21 In making this comparison, the fact-finder puts itself into  
22 the place of an "ordinary observer." Egyptian Goddess, Inc. V.  
23 Swisa, Inc., 543 F.3d 665, 687 (Fed. Cir. 2008) (en banc), cert.  
24 denied, 556 U.S. \_\_\_, 129 S. Ct. 1917 (2009). The "ordinary  
25 observer" is not an expert; he is an observer "of ordinary  
26 acuteness, bringing to the examination of the article upon which

1 the design has been placed that degree of observation which men of  
2 ordinary intelligence give." Gorham Mfg. Co. V. White, 81 U.S. 511,  
3 528 (1871); Arminak, 501 F.3d at 1324 (the "ordinary observer" is  
4 the purchaser of the item displaying the claimed design). However,  
5 he must not be too ordinary; rather he must be "familiar with the  
6 prior art designs." Richardson v. Stanley Works, Inc., 597 F.3d  
7 1288, 1295 (Fed. Cir. 2010).

8 The designs are "substantially similar" if, viewing the  
9 overall appearance of the designs, an "ordinary observer"  
10 would be deceived by the similarity between the claimed  
11 and accused bowls, "inducing him to purchase one  
12 Egyptian Goddess, 543 F.3d at 683, quoting Gorham, 81 U.S. at 528  
13 ;<sup>3</sup> OddzOn Products, 122 F.3d at 1405 ("There can be no infringement  
14 based on the similarity of specific features if the overall  
15 appearance of the designs are dissimilar"); Richardson, 597 F.3d at  
16 1295 ("ordinary observer" test).<sup>4</sup>

17  
18 <sup>3</sup> Egyptian Goddess is the key authority in determining  
19 infringement of a design patent. It appears to be the last en banc  
20 decision of the Federal Circuit on the topic, and discusses the  
21 pertinent issues at length.

22 <sup>4</sup> Before the decision in Egyptian Goddess, the courts used the  
23 "point of novelty" test, in addition to the "ordinary observer"  
24 test. Under the "point of novelty" test, "no matter how similar  
25 two items look, "the accused device must appropriate the novelty  
26 in the patented device which distinguishes it from the prior  
27 art." " Egyptian Goddess, Inc. v. Swisa, Inc., 498 F.3d 1354, 1357  
(Fed. Cir. 2007), overruled, 543 F.3d 665 (2008) (en banc). In  
other words, the court first identified a "point of novelty" that  
distinguished the claimed design from the prior art. If that  
"point of novelty" was not present in the accused design, then  
there could be no infringement.

28 The en banc court in Egyptian Goddess expressly did away with

1 Since the ordinary observer is familiar with the prior art,  
2 the fact-finder will be called upon to consider the prior art in  
3 any comparison between designs:

4 In some instances, the claimed design and the accused  
5 design will be sufficiently distinct that it will be  
6 clear without more that the patentee has not met its  
7 burden of proving the two designs would appear  
8 "substantially the same" to the ordinary observer, as  
9 required by Gorham. In other instances, when the claimed  
10 and accused designs are not plainly dissimilar,  
11 resolution of the question whether the ordinary observer  
12 would consider the two designs to be substantially the  
13 same will benefit from a comparison of the claimed and  
14 accused designs with the prior art, as in many of the  
15 cases discussed above and in the case at bar. Where  
16 there are many examples of similar prior art designs ...  
17 differences between the claimed and accused designs that  
18 might not be noticeable in the abstract can become  
19 significant to the hypothetical ordinary observer who is  
20 conversant with the prior art.

21 Egyptian Goddess, 543 F.3d at 678.

22 **B. Invalidity - "Obviousness."**

23 A patent is presumed to be valid. 35 U.S.C. § 282(a); Aero  
24 Products Intern., Inc. v. Intex Recreation Corp., 466 F.3d 1000,  
25 1015 (Fed. Cir. 2006). Defendants, who assert that the '817 patent  
26 is invalid for obviousness, bear the burden of proving its  
invalidity. Id.; Creative Compounds, LLC v. Starmark Laboratories,  
651 F.3d 1303, 1310 (Fed. Cir. 2011). The standard of proof  
defendants must meet is "clear and convincing evidence." Microsoft

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the "point of novelty" test. Egyptian Goddess, 543 F.3d at 678  
("we hold that the 'point of novelty' test should no longer be used  
in the analysis of a claim of design patent infringement"); Hall  
v. Bed Bath & Beyond, Inc., 705 F.3d 1357, 1363 (Fed. Cir. 2013)  
("infringement of a design patent is based on the design as a  
whole, not on any 'points of novelty'").

1 Corp. v. i4i Ltd. Partnership, 564 U.S. \_\_\_\_, 131 S. Ct. 2238, 2242  
2 (2011).

3 The Federal Circuit recently addressed how a party would go  
4 about challenging a design patent on obviousness grounds:

5 In addressing a claim of obviousness in a design patent,  
6 "the ultimate inquiry ... is whether the claimed design  
7 would have been obvious to a designer of ordinary skill  
8 who designs articles of the type involved." Titan Tire,  
9 566 F.3d at 1375, quoting Durling v. Spectrum Furniture  
10 Co., 101 F.3d 100, 103 (Fed. Cir. 1996). To determine  
11 whether "one of ordinary skill would have combined  
12 teachings of the prior art to create the same overall  
13 visual appearance as the claimed design," id. at 1381,  
14 the finder of fact must employ a two-step process.  
15 First, "one must find a single reference, 'a something in  
16 existence, the design characteristics of which are  
17 basically the same as the claimed design.'" Durling, 101  
18 F.3d at 103, quoting In re Rosen, 673 F.2d 388, 391 (CCPA  
19 1982). Second, "other references may be used to modify  
20 [the primary reference] to create a design that has the  
21 same overall visual appearance as the claimed design."  
22 Id. However, the "secondary references may only be used  
23 to modify the primary reference if they are 'so related  
24 to the primary reference that the appearance of certain  
25 ornamental features in one would suggest the application  
26 of those features to the other.'" Id., quoting In re  
Borden, 90 F.3d 1570, 1575 (Fed. Cir. 1996).

17 Apple, Inc. v. Samsung Electronics Co., Ltd., 678 F.3d 1314,  
18 1329-30 (Fed. Cir. 2012); see also Crocs, Inc. v. ITC, 598 F.3d  
19 1294, 1308 (Fed. Cir. 2010) ("Obviousness is a question of law  
20 based on underlying factual inquiries including: (1) the scope and  
21 content of the prior art; (2) the level of ordinary skill in the  
22 art; (3) the differences between the prior art and the claimed  
23 invention; and (4) the extent of any objective indicia of  
24 non-obviousness").

25 **C. Summary Judgment.**

26 Summary judgment is appropriate "if the movant shows that

1 there is no genuine dispute as to any material fact and the movant  
2 is entitled to judgment as a matter of law." Fed. R. Civ. P.  
3 56(a); Ricci v. DeStefano, 557 U.S. 557, 586 (2009) (it is the  
4 movant's burden "to demonstrate that there is 'no genuine issue as  
5 to any material fact' and that they are 'entitled to judgment as a  
6 matter of law'"); Walls v. Central Contra Costa Transit Authority,  
7 653 F.3d 963, 966 (9th Cir. 2011) (per curiam) (same).

8       Consequently, "[s]ummary judgment must be denied" if the court  
9 "determines that a 'genuine dispute as to [a] material fact'  
10 precludes immediate entry of judgment as a matter of law." Ortiz  
11 v. Jordan, 562 U.S. \_\_\_, 131 S. Ct. 884, 891 (2011), quoting Fed.  
12 R. Civ. P. 56(a); Comite de Jornaleros de Redondo Beach v. City of  
13 Redondo Beach, 657 F.3d 936 (9th Cir. 2011) (en banc) (same), cert.  
14 denied, 132 S. Ct. 1566 (2012).

15       Under summary judgment practice, the moving party bears the  
16 initial responsibility of informing the district court of the basis  
17 for its motion, and "citing to particular parts of the materials in  
18 the record," Fed. R. Civ. P. 56(c)(1)(A), that show "that a fact  
19 cannot be ... disputed." Fed. R. Civ. P. 56(c)(1); Nursing Home  
20 Pension Fund, Local 144 v. Oracle Corp. (In re Oracle Corp.  
21 Securities Litigation), 627 F.3d 376, 387 (9th Cir. 2010) ("The  
22 moving party initially bears the burden of proving the absence of  
23 a genuine issue of material fact"), citing Celotex v. Catrett, 477  
24 U.S. 317, 323 (1986).

25       If the moving party meets its initial responsibility, the  
26 burden then shifts to the non-moving party to establish the

1 existence of a genuine issue of material fact. Matsushita Elec.  
2 Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 585-86 (1986);  
3 Oracle Corp., 627 F.3d at 387 (where the moving party meets its  
4 burden, "the burden then shifts to the non-moving party to  
5 designate specific facts demonstrating the existence of genuine  
6 issues for trial"). In doing so, the non-moving party may not rely  
7 upon the denials of its pleadings, but must tender evidence of  
8 specific facts in the form of affidavits and/or other admissible  
9 materials in support of its contention that the dispute exists.  
10 Fed. R. Civ. P. 56(c)(1)(A).

11 "In evaluating the evidence to determine whether there is a  
12 genuine issue of fact," the court draws "all reasonable inferences  
13 supported by the evidence in favor of the non-moving party."  
14 Walls, 653 F.3d at 966. Because the court only considers  
15 inferences "supported by the evidence," it is the non-moving  
16 party's obligation to produce a factual predicate as a basis for  
17 such inferences. See Richards v. Nielsen Freight Lines, 810 F.2d  
18 898, 902 (9th Cir. 1987). The opposing party "must do more than  
19 simply show that there is some metaphysical doubt as to the  
20 material facts .... Where the record taken as a whole could not  
21 lead a rational trier of fact to find for the nonmoving party,  
22 there is no 'genuine issue for trial.'" Matsushita, 475 U.S. at  
23 586-87 (citations omitted).

24 **2. ANALYSIS**

25 **a. Infringement.**

26 Plaintiff's claimed design is U.S. Design Patent No. D480,817



1 ("the '817 patent"), for an oval-shaped, above-ground swimming  
2 pool. The claim reads as follows, in its entirety: "The design for  
3 an above-ground swimming pool, as shown and described." Dkt. No  
4 24, Exh. A.<sup>5</sup> The pertinent description consists of drawings. The  
5 court has construed the patent as follows:

6 The claimed design is an above-ground, oval-shaped pool  
7 with side-struts, and additional elements or features, as  
8 shown in the '817 patent drawings. Whatever functional  
9 role may be played by any element or feature of the pool  
10 depicted in the drawings is not a part of the claim, and  
11 should therefore be disregarded; but the design of those  
12 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.

13 ECF No. 73 (claim construction). The patent drawings are attached  
14 to this Order as Exhibit A.

15 As discussed above, the court's initial step is to determine  
16 whether the accused design is even within the limitation on scope  
17 that the patentee has imposed, through his patent drawings. At  
18 first glance, the accused design appears to be within the scope  
19 limitation of the claimed design. The claimed and accused designs,  
20 are both for an oval, above-ground pool. Plaintiff's Statement of

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21  
22 <sup>5</sup> Plaintiff did not expressly limit the claim to the  
23 "ornamental" design. However, by law, the design patent only  
24 covers the ornamental aspects of the design, so its omission of  
25 that language appears to make no difference. See Richardson, 597  
26 F.3d at 1293 ("The district court here properly factored out the  
functional aspects of Richardson's design as part of its claim  
construction. By definition, the patented design is for a  
multi-function tool that has several functional components, and we  
have made clear that a design patent, unlike a utility patent,  
limits protection to the ornamental design of the article").

1 Undisputed Facts ("PSUF") ¶ 5;<sup>6</sup> Defendant's Statement of Undisputed  
2 Facts ("DSUF") ¶ 19.<sup>7</sup> Both designs feature a tubular top.  
3 Defendants' Statement of Undisputed Facts ("DSUP") (ECF No. 81-1)  
4 ¶¶ 33-34. Both designs feature side struts along their long sides,  
5 stretching from just below the tubular top, to the ground. Id., ¶¶  
6 21-22. Both designs feature side straps that run underneath the  
7 pool and connect the struts where the struts meet the ground. Id.,  
8 ¶¶ 47-48. Both designs have angled side walls with a curve or  
9 bulge at the bottom, just before the structure meets the ground.  
10 Id., ¶¶ 35-36. Both designs contain segmented side walls.<sup>8</sup> Id.,  
11 ¶¶ 49-50.

12       However, one ornamental aspect of a design patent is the  
13 proportions of the design. See Lee v. Dayton-Hudson Corp., 838  
14 F.2d 1186, 1188 (Fed. Cir. 1988) ("the district court correctly  
15 viewed the design aspects of the accused devices: the wooden balls,  
16 their polished finish and appearance, the proportions, the carving  
17 on the handle, and all other ornamental characteristics") (emphasis  
18 added). The '817 patent claims a pool design that is approximately  
19 seven (7) times longer than it is tall, in its 2-strut design. See  
20 Complaint, Exh. A. Accordingly, the patent claims a design for a  
21 squat pool. Indeed, the overall appearance of the claimed design  
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23       <sup>6</sup> ECF No. 82-1.

24       <sup>7</sup> ECF No. 81-1.

25       <sup>8</sup> The segments of the claimed design form a specific pattern  
26 when viewed from above. The photographs of the accused design do  
not make clear whether a similar pattern exists or not.

1 is of a squat, wading-type pool.

2       The accused pool, on the other hand, has a taller and more  
3 elegant appearance. See Plaintiff's Motion for Summary Judgment  
4 ("PSJ") (ECF No. 77) at 35, Photographs B & E. It does not give  
5 the appearance of being squat. Indeed, the accused design is less  
6 than four (4) times longer (taking the length of the tubular top)  
7 than it is tall, approximately, in its 2-strut design. While both  
8 designs may give the impression of being wading pools, the claimed  
9 design gives the appearance of being a squat wading pool, even  
10 possibly permitting a person or child to sit in it, whereas the  
11 accused pool appears to be too tall for sitting.<sup>9</sup>

12       A design patent cannot, of course, claim every conceivable  
13 shape and proportion that could arise from its basic design. But  
14 that would appear to be the point of permitting design patents in  
15 the first place. The patent protects the shape and proportion the  
16 patentee chooses, but leaves other shapes and proportions to the  
17 imagination of other designers.

18       The court must keep in mind that the ultimate goal of the  
19 design patent is to prevent the "unauthorized manufacture, use, or  
20 sale of the article embodying the patented design or any colorable

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21  
22       <sup>9</sup> The comparison is somewhat awkward because the court is  
23 comparing the black-and-white drawings of the claimed design  
24 against the color photographs of the accused design. However, the  
25 court is instructed to use the claimed drawings, not the commercial  
26 embodiment of the claimed design. See Sun Hill Industries, Inc.  
v. Easter Unlimited, Inc., 48 F.3d 1193, 1196 (Fed. Cir. 1995)  
("The test for infringement is not whether the accused product is  
substantially similar to the patentee's commercial embodiment of  
the claimed design") (the "point of novelty" analysis of this case  
was overruled by Egyptian Goddess).

1 imitation thereof. See 35 U.S.C. § 289 (emphasis added). The  
2 court believes that no reasonable juror could find that an ordinary  
3 observer would conclude that the taller, more elegant accused pool  
4 "embod[ies]" the squat pool plaintiff patented, "or any colorable  
5 imitation thereof."<sup>10</sup>

6 **B. Invalidity and Non-obviousness.**

7 Both defendants have moved for summary judgment on their  
8 counterclaims that they did not infringe the patent, and that the  
9 patent is invalid for obviousness. The motions for summary  
10 judgment based upon non-infringement will be granted for the  
11 reasons stated above in Section III(A).

12 The motions for summary judgment based upon obviousness appear  
13 to be based upon the premise that "if the design of the '817 Patent  
14 is interpreted broadly enough to cover the Summer Escapes pool [the  
15 accused design], then it would have been obvious to one skilled in  
16 the art to combine earlier references to arrive at a single piece  
17 of art that is substantially the same as what is claimed in the  
18 '817 Patent." Defendants' Motion for Summary Judgment ("DSJ")  
19 at 34.<sup>11</sup> Since the court has determined that the design of the '817  
20 does not cover the accused design, this motion would appear to be

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21  
22 <sup>10</sup> The court is aware that in a case alleging infringement of  
23 a design patent, "it is often helpful to refer to any prior art  
24 with which the ordinary observer would reasonably be familiar."  
25 Revision Military, Inc. v. Balboa Mfg. Co., 700 F.3d 524, 527 (Fed.  
26 Cir. 2012). Here, because the accused design is not within the  
scope of the claimed design, there is no need to engage in a  
discussion or analysis of the prior art.

<sup>11</sup> ECF No. 78-1. The page numbering refers to the internal  
document page number, not the ECF page number.

1 moot.<sup>12</sup>

2 **IV. CONCLUSION**

3 For the foregoing reasons, the court orders as follows:

4 1. Plaintiff's motion for summary judgment (ECF No. 77), is  
5 **DENIED**;

6 2. Defendants' motion for summary judgment (ECF No. 78), is  
7 **GRANTED** on the grounds of non-infringement, and their motion for  
8 summary judgment on the grounds of obviousness is **DENIED** as moot;

9 3. The Clerk is directed to enter judgment for defendant and  
10 to close this case.

11 IT IS SO ORDERED.

12 DATED: May 29, 2013.

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LAWRENCE K. KARLTON  
SENIOR JUDGE  
UNITED STATES DISTRICT COURT

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<sup>12</sup> As plaintiff points out, a jury in another case specifically found that the '817 patent was not invalid for obviousness. See Sofpool v. Intex, Civ. No. 2:7-cv-97, ECF No. 148, Question No. 4 (E.D. Tex. April 17, 2008). However, that verdict was vacated by the Federal Circuit, although on grounds not apparently related to the non-obviousness finding. Sofpool, LLC v. Intex Recreation Corp., 328 Fed. Appx. 654, 654-655 (Fed. Cir. 2009) ("Because the jury in the present case was instructed based upon the point of novelty test eliminated by Egyptian Goddess, the judgment of the district court is vacated and the case is remanded for reconsideration and further proceedings as appropriate").