United States District Court,
M.D. North Carolina.

BERNHARDT L.L.C,
Plaintiff.
v.
COLLEZIONE EUROPA USA, INC,
Defendant.

May 30, 2003.

MEMORANDUM OPINION

BULLOCK**, J.**

This case concerns five patents, United States Design Patent Nos. D 438,727 ("the '727 patent"), D 439,770 ("the '770 patent"), D 493,763 ("the '769 patent"); D 441,975 ("the '975 patent"), and D 441,980 ("the '980 patent"), issued to Thomas W. McDaniel and D. Scott Coley and currently assigned to Bernhardt L.L.C. ("Bernhardt"). All patents claim ornamental designs of individual pieces which are part of a suite of furniture named the "Coronado Collection." Bernhardt contends that Defendant Collezione Europa USA, Inc. ("Collezione") has infringed, and is presently infringing, its patents by manufacturing, importing and selling pieces of furniture that are confusingly similar to its protected ornamental designs of the Coronado Collection.

After receiving initial claim construction briefs, the court held a *Markman* hearing on April 22, 2003, and took the matter under advisement. The case is now before the court to interpret the claims of each patent.

Design Patent Infringement

As in the case of utility patents, determining infringement of a design patent has two steps. The first step requires the court to construe the claim and determine its meaning and scope. Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995). Claim interpretation is a matter of law and is usually accomplished with the assistance of a *Markman* hearing. Markman v. Westview Instruments, 52 F.3d 967, 976 (Fed.Cir.1995) (*en banc*), *aff'd,* 517 U.S. 370 (1996).

At a *Markman* hearing the court must examine and resolve disputes over the meaning and scope of the claim language in the patent. To interpret the disputed claims, the court must look first to the patent's intrinsic evidence, which consists of the claims themselves, the specifications, and the prosecution history. *Id*. at 979. If the claim's meaning is clear from the intrinsic evidence, it is improper for the court to look beyond the intrinsic evidence to other sources. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed.Cir.1996). If the claim's meaning is still unclear after review of the intrinsic evidence, it is permissible for the court to look to extrinsic evidence, such as expert or inventor testimony, in construing the claim. Id. at 1585.

The proper construction of a design patent focuses on the overall visual impression of its ornamental features. Durling v. Spectrum Furniture Co., 101 F.3d 100, 104 (Fed.Cir.1996). For a proper claim construction of a design patent, the court should translate the drawings into a written description that evokes the visual image of the claimed design. Id. at 103 and n. 2. In order to evoke properly a visual image of the overall appearance of a design, the Federal Circuit has indicated that the written description should reasonably detail the various ornamental features of the claim design. *Id*.

After the claim is construed, the second step for determining infringement requires the trier of fact to compare the accused design to the properly construed claim. Markman, 52 F.3d at 976. The trier of fact must compare the patented and accused designs for overall visual similarity using the perspective of "an ordinary observer, giving such attention as a purchaser usually gives." Gorham Co. v. White, 81 U.S. (14 Wall.) 511, 528 (1871). Also, for there to be infringement, "the accused design must appropriate the novel ornamental features of the patented design [or "points of novelty"] that distinguish it from the prior art." Elmer, 67 F .3d at 1577 (citation omitted). "The points of novelty relate to differences from prior designs, and are usually determinable based on the prosecution history." Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co. Inc., 162 F.3d 1113, 1118 (Fed.Cir.1998).

Defendant urges the court, as part of claim construction, to identify points of novelty of each design embodied in the five patents. Plaintiff, on the other hand, argues that the determination of the points of novelty are issues for the finder of fact. While the parties have presented to the court their views of the points of novelty of each design, determining what distinguishes a patented design from prior art has historically been an issue for the jury or fact finder. As noted, the points of novelty in a design patent are usually determined based on the prosecution history. Based on an examination of the intrinsic evidence in this case at this time, a determination of the points of novelty would likely result in a finding that they are essentially as proffered by Bernhardt. Such determination would necessarily be interlocutory because the more complete record which the parties will presumably present at trial will require revisiting any decision made on those points of novelty now. Juries have always been called upon to determine what distinguishes the patented design from the prior art. Likewise, it would seem that it would be for the same jury (or fact finder) to resolve whether the design of the accused product has appropriated the same novel features that distinguish the patented design from the prior art. As the Federal Circuit has pointed out, the question of what the prior art teaches is a fact issue that is part of an obviousness analysis of a design patent. In re Borden, 90 F.3d 1570, 1576 (Fed.Cir.1996). Consequently, the court will not seek to identify the specific points of novelty as part of claims construction, but will leave to the fact finding process the task of determining what points of novelty distinguish the patents in question from the prior art, as well as determining whether the accused products contain substantially the same points of novelty that distinguish the patented designs from the prior art.

Based upon an examination of the intrinsic evidence-the claims, the specifications, and the prosecution history-the court interprets the claims as follows.

Claims Construction

U.S. Design Patent No. D 438,727

The '727 patent-in-suit is drawn to an ornamental design for a buffet, as shown in the drawings attached hereto as Exhibit A.

The '727 patent claims the ornamental design for a buffet. The entire buffet has a breakfront which is echoed by a corresponding break in the overhanging top and the base molding. There are four rectangular doors of approximately equal width and height on the front of the buffet that, together, cover nearly the entire front portion of the buffet between the decorative frieze and the base molding. The two doors on the left-hand side of the buffet are hinged on the left side and the doors on the right-hand side of the buffet are hinged on the right side. Additionally, the two inner doors occupy the breakfront between the frieze and the base molding. Further, each of the four doors shares the same design, having an outer frame molding on each door surrounding the particular decorative filigree design shown and depicted in the '727 patent.

The buffet has an overhanging top with rounded corners on the front facing side and square corners on the rearward facing side. The top has a milled rounded edge that projects out slightly from the top surface running along the front and side edges. The central half of the top thrusts slightly outward by means of concave projections, so as to echo and maintain the degree of overhang over the breakfront of the center of the buffet. An original decorative acanthus-leaf frieze runs along the front and sides of the top outside edge of the buffet immediately below the overhanging top. The frieze is framed between narrow stripe of molding and is parallel to the buffet top and to the floor. Rounded pilasters perpendicular to the floor are on each of the outside front corners of the buffet.

The buffet also has a multi-stepped base molding on the front and sides of the buffet that touches, or appears to touch, the floor throughout its length. The base molding projects outward from the plane of the door and the side panels by approximately the same amount as the overhang of the top and similarly echoes the outward projection of the breakfront. Finally, the buffet uses common radii in the rounded front edge corners of the top, the pilasters, on the frieze above the pilasters, and on the base molding below the pilasters, and the common radii of the concave projections that provide the outward thrust of the breakfront on the top frieze, door frames, and base molding.

U.S. Design Patent No. D 439,770

The '770 patent-in-suit is drawn to an ornamental design for a table, as shown in the drawings attached hereto as Exhibit B.

The '770 patent claims the design for a dining room table. The table is a trestle table design in which the leg posts and stretchers are each rope-turnings of consistent diameter throughout their length and having a relatively large cross-section or diameter. Each of the leg posts has three and one-half to four "twists" (depending on viewing angle). The turnings of each stretcher have the same number of "twists" per unit of length as the legs, and the stretchers are the same diameter as the leg posts.

There are four rope-carved end stretchers, each of which runs at an angle from a trestle base on each leg post to a trestle base at the end of a central stretcher so as to form a pair of opposing open "Y" shapes. The rope carving of the trestles is similar to that of the table's legs. Each of the trestle bases on each leg post connects and separates the rope turning above it to a bun foot below it, and the trestle bases at the ends of the central structure each also have a bun foot. The trestle base on each leg post is the chamfered square of the turning with a ring turning above it. The trestle bases at the ends of the central structure are roughly cubical squares of the turning with molding on the top surface.

The top of each leg post is also a chamfered square of the turning of the same diameter as the trestle base on the leg. Four runners run between the tops of the leg posts in rectangular relation to each other and form, or

appear to form, the base for the table top. The table top is roughly rectangular with clearly visible and distinct planking on the top surface of the table. The two shorter edges of the table top are a distinctive serpentine shape while the two long-side edges are straight. A stepped undermolding runs along the entire circumference of the tabletop.

U.S. Design Patent No. D 493,763

The '763 patent-in-suit is drawn to an ornamental design for a cabinet, as shown in the drawings attached hereto as Exhibit C.

The '763 patent claims the ornamental design for a domed china or curio cabinet. The cabinet has a round arched top that rests, or appears to rest, on crown molding that begins at the top of each pilaster and continues back horizontally across the sides of the cabinet. There is a distinctive decorative scrollwork frieze on the front top section that runs in a arc directly beneath the curve of the arch. There is similar decorative scrollwork running down the pilasters.

Two doors extend from the curved decorative frieze on the arched top down to the base molding. Each door has an opaque framing surrounding a transparent inner surface. Each door is a mirror image of the other and each is hinged on the pilaster side of the cabinet so as to open outward. Each door has a straight bottom and sides and a top curve so as to follow the curve of the arched top, such that the two doors together form a complete arc, with the front of the arched top immediately below the decorative frieze on the arch.

Each door also has a mullion about one-third of the way up from the bottom of the door. The mullion on each door is shaped such that when the doors are closed it forms a serpentine shape across the front of the cabinet. Filigree (or lattice) work similar in design to that used on the doors of the buffet protected by the '727 patent extends from and fills the area between the bottom frame of the door and the mullion.

The sides of the cabinet consist of a transparent material framed by an opaque material. These sides reach from the base molding to the crown molding at the base of the arch, with straight mullion approximately one-third of the way up from the bottom of the frame. A series of transparent shelves situated horizontally within the cabinet are visible through the cabinet's transparent doors and sides.

The base of the cabinet is a stepped base molding that is wider at the bottom than the top (in pyramid fashion). This base molding runs continuously from one side of the cabinet, across the front, and down the other side. The base molding projects outward and in rounded fashion at the front facing bottom corners of the cabinet. Finally, the entire cabinet rests upon four intricately carved bun feet at each of the four bottom corners.

U.S. Design Patent No. D 441,975

The '975 patent-in-suit is drawn to an ornamental design for a chair, as shown in the drawings attached hereto as Exhibit D.

The '975 patent protects the design for a chair with an upholstered back and seat, such as might be used in a suite of dining room furniture. There are two embodiments of this chair, one having arms (the end chair embodiment) and one not having arms (the side chair embodiment).

The back of the chair is set back at slightly more than a ninety-degree angle from the seat. The top of the

back of the seat is a serpentine shape that is a characteristic design element seen in several of the patents-in-suit. The front of the top bears an acanthus-leaf carving reminiscent of the frieze on the '727 buffet. The sides of the frame of the back are straight and are a continuous piece with the rear legs. The front of the back is a padded upholstered cushion set within and surrounded by the wooden frame. The sides and bottom of the cushion are straight while the top of the cushion has the same serpentine shape as the top of the frame. The cushion ends slightly above the seat. On the frame, in the gap between the seat and the back, is a double bead.

The seat of the chair is a large plush upholstered cushion, slightly domed on top, having straight sides and back and slightly rounded corners. The upholstered front of the seat is serpentine shaped. The legs of the chair, like the arms of the end chair embodiment, are carved and scrolled in a Louis XV style. Each front and rear leg is joined by a serpentine side rail. The two side rails are joined near the front of the chair by a serpentine cross rail.

In the end chair embodiment, each arm angles slightly out and downward from the frame of the back and ends at about the level of the end of the seat cushion. In the front each arm is connected to the seat frame by a scrolled, somewhat serpentine, stile that angles back from the front of the seat and attaches beneath the arm slightly back of the curve of the scrolling on the front of the arm.

U.S. Design Patent No. D 441,980

The '980 patent-in-suit is drawn to an ornamental design for a bed, as shown in the drawings attached hereto as Exhibit E.

The '980 patent protects the design for a poster bed. It has a serpentine-shaped headboard surmounted by a serpentine cornice with ogee molding blending into a cove on the left- and right-most sides of the headboard. There are three recessed panels of equal width on the front of the headboard, each extending from near the bottom of the headboard to a point near the top and beneath the cornice. Each panel is framed by molding which projects outward from the plane of the headboard and the recessed edges are likewise molded. The top of each of the three panels is shaped such that, in combination, they follow the line of the serpentine shape of the headboard.

There are two relatively massive turned end posts on either side of the headboard, each extending well above the cornice of the headboard. The top portion of each post beginning at a point slightly below the cornice is rope turned, has a consistent diameter throughout its length, and has a continuous series of carved acanthus leaves trailing inside the grooves of the turning. The tops of the posts are intricately carved ovoid or acorn-shaped finials. The finials are separated from the rope turnings by two ring turnings. The bottom length of the end posts have a chamfered square cross section. The chamfered and rope-turned portions of the posts are separated by two ring turnings. At the bottom of each post is a rounded, somewhat urn-shaped, foot.

The bed also has a rectangular footboard joined by two end posts that are approximately equal in height to the end posts of the headboard. The front of the footboard has molding along its top and bottom. The top and bottom moldings extend outward so as to overhang the front and rear planes of the footboard. The back of the footboard is unadorned and flat, other than the overhang of the molding. There is a carved bead on the front of the footboard, slightly above the bottom molding. Above the bead are two rectangular recessed panels, each with its long edge horizontal. Each panel is framed by molding that extends outward from the

plane of the footboard, and the pattern of the molding continues inward into the recess in a similar fashion to the recessed panels on the headboard.

The posts of the footboard have turned, somewhat urn-shaped, feet like those on the headboard. Above each foot is a chamfered square section similar in cross section to that on the post of the headboard but shorter, extending only slightly above the horizontal top of the footboard. Above the chamfered square section is a rope-turned section having turnings and acanthus leaf carvings similar to those in the headboard post. This rope-turned section is separated from the chamfered section by one small and one large ring turning. There is an urn-shaped turning that breaks the rope-carved section into two pieces of uneven length, approximately two-thirds to three-quarters of the way up from the bottom of the rope-turned section. The footboard posts have the same type of finials as the headboard posts.

CONCLUSION

The court has endeavored in construing the patents above to provide descriptions that invoke a visual image of the overall appearance of the design and reasonably detail the various ornamental features of each design. Defendant is well aware of Plaintiff's contentions concerning the points of novelty of each design. Following the presentation of evidence, the court will determine what point or points of novelty distinguish each patent from the prior art, and whether the accused products have appropriated them.

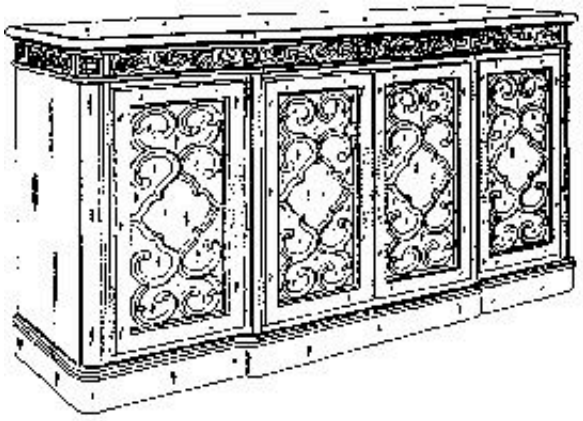

FIG. 1

FIG. 2

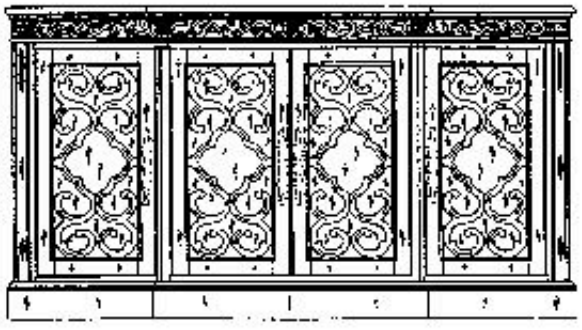

FIG. 3

FIG. 4

EXHIBIT A
U.S. Patent No. 438,727

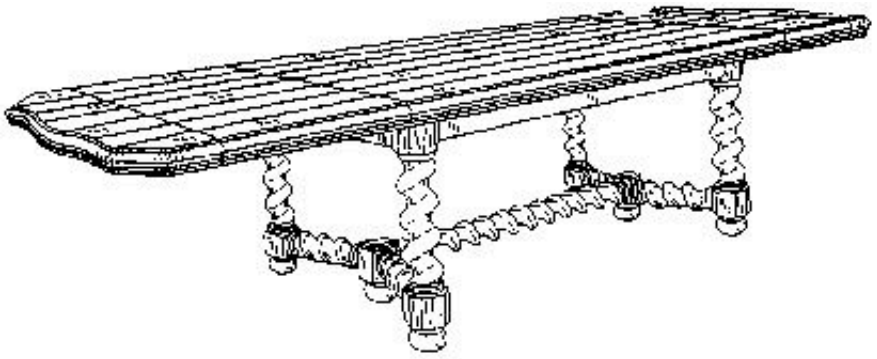

FIG. 1

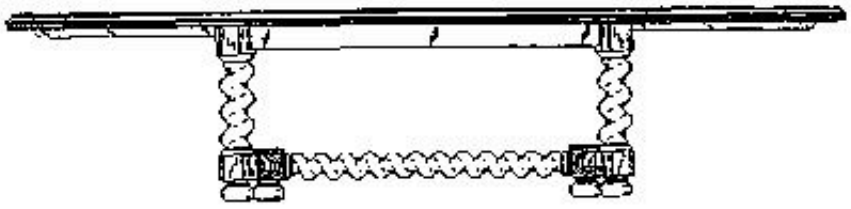

FIG. 2

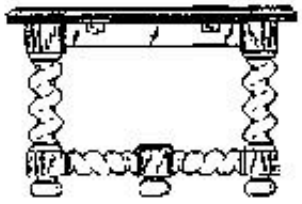

FIG. 3

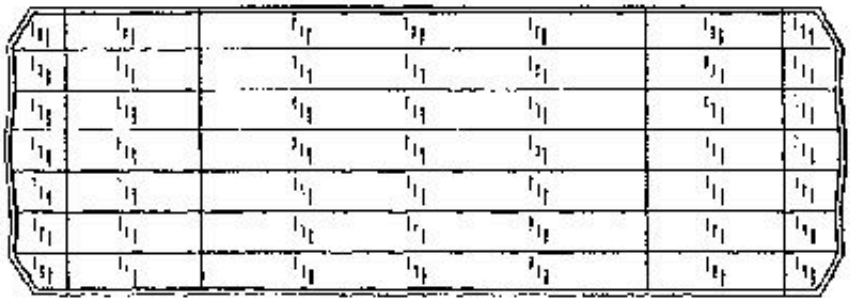

EXHIBIT B FIG. 4 U.S. Patent No. 439,770

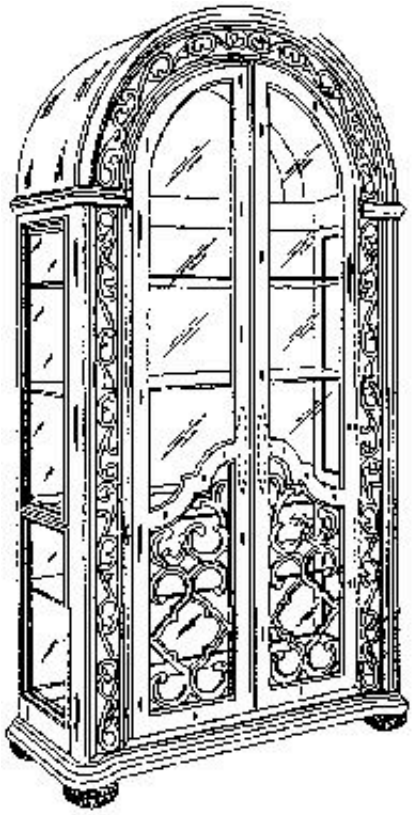

FIG. 1

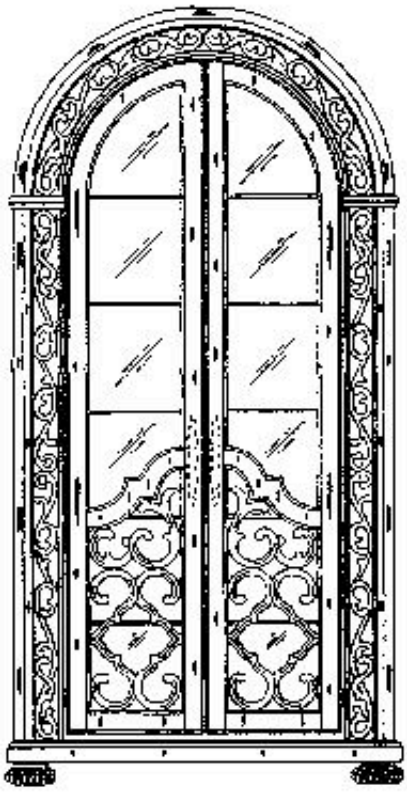

FIG. 2

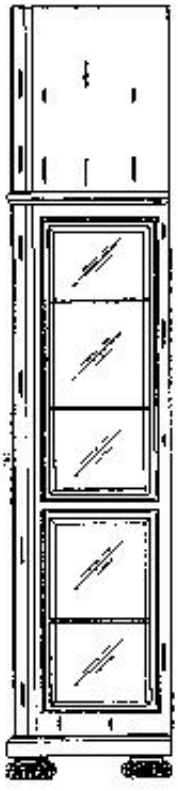

FIG. 3

EXHIBIT C U.S. Patent No. 493,763

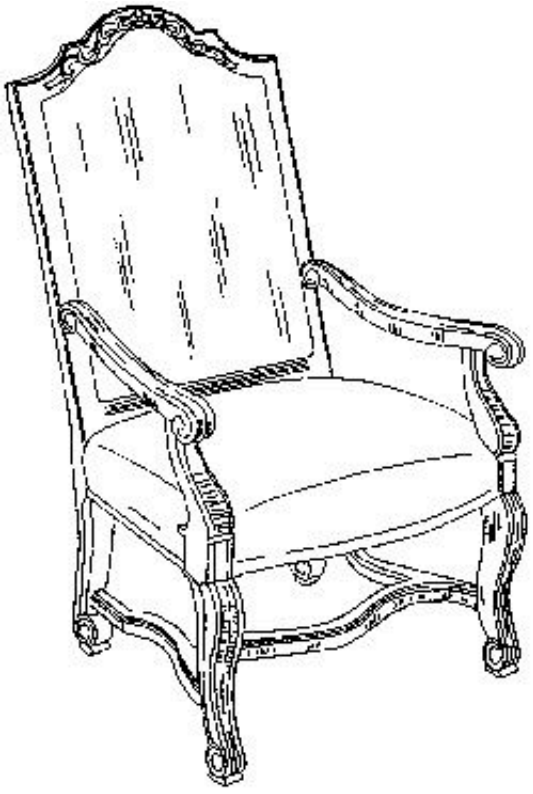

Fig.1

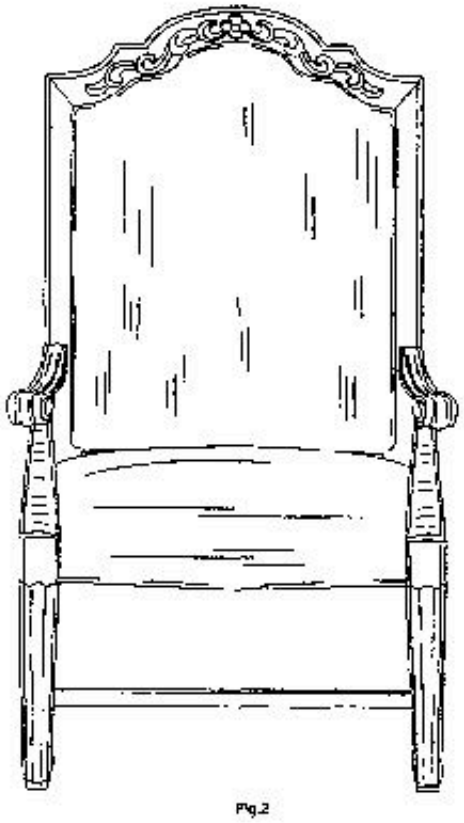

Fig.2

EXHIBIT D (Page 1 of 2) U.S. Patent No. 441,975

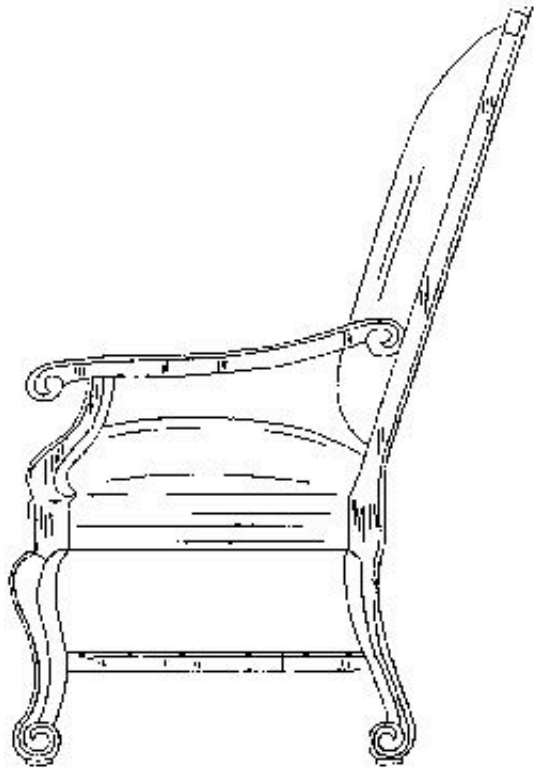

Fig.3

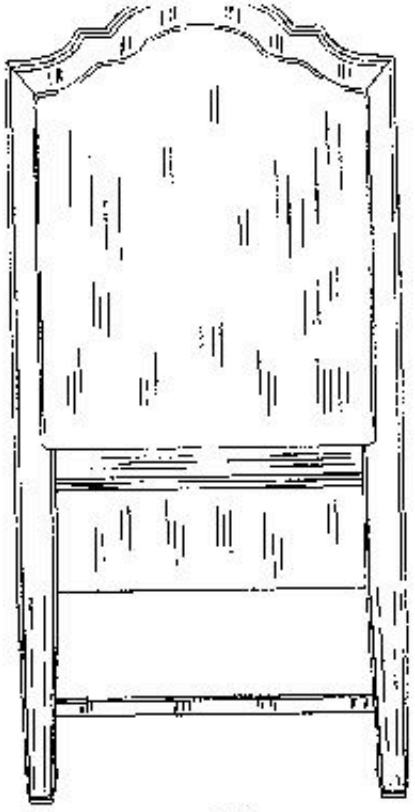

Fig.4

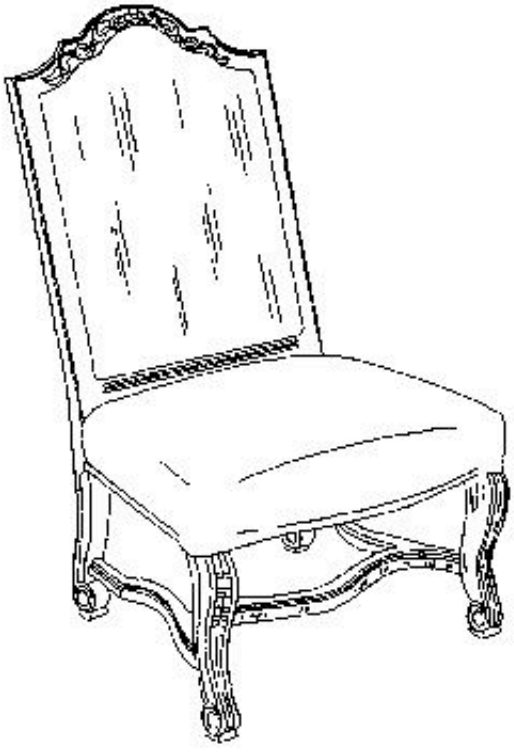

Fig.5

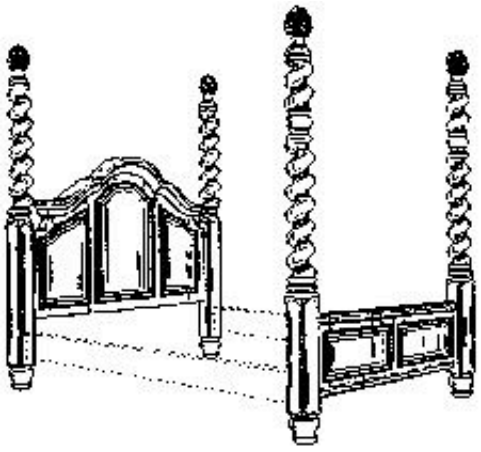

FIG. 1

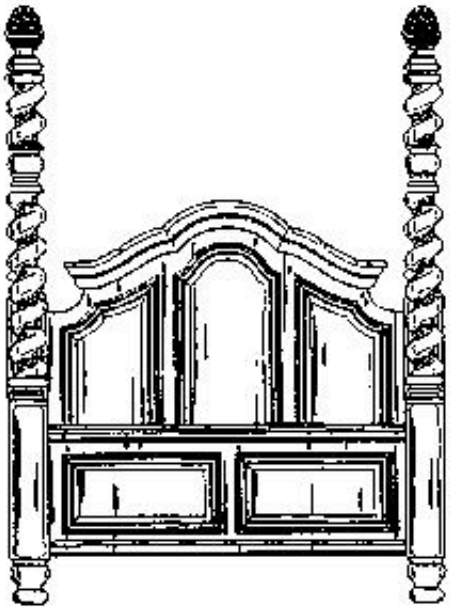

FIG.2

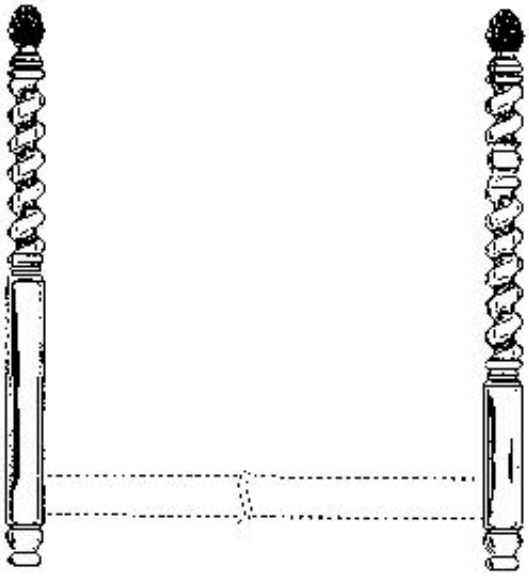

FIG.3

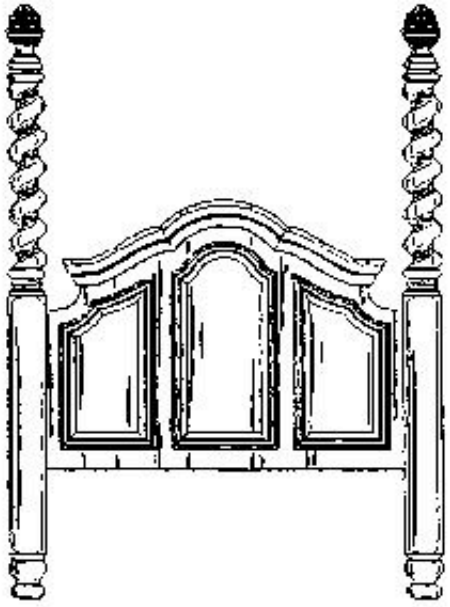

FIG.4

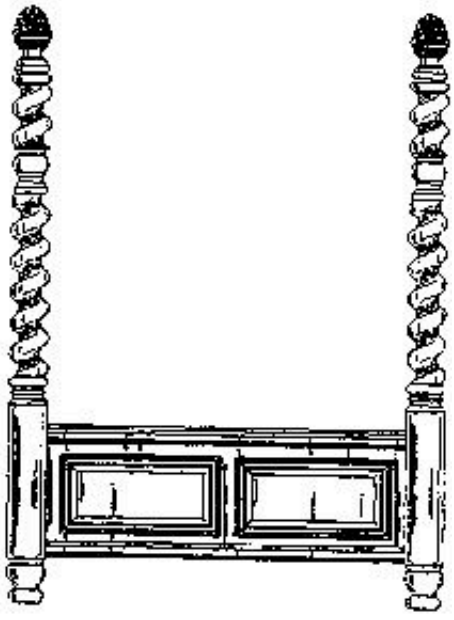

FIG.5

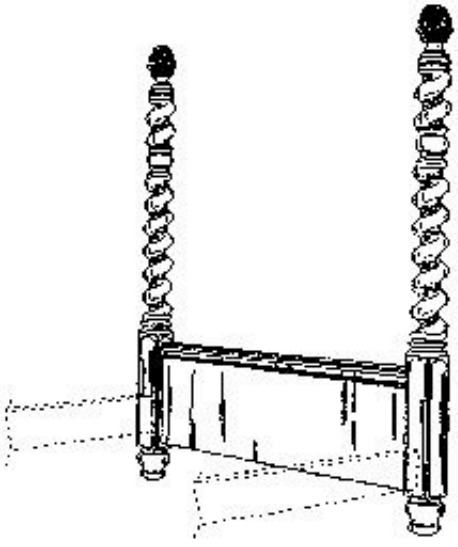

FIG.6

EXHIBIT E (Page 2 of 2) U.S. Patent No. 441,980

Bernhardt L.L.C. v. Collezione Europa USA, Inc.

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