United States District Court,
N.D. Texas, Dallas Division.

Larry G. JUNKER,
Plaintiff.
v.
BARD ELECTROPHYSIOLOGY DIVISION, a division of C.R. Bard, Inc,
Defendant.

Civil Action No. 3:05-CV-2016-N

July 13, 2006.

Robert M. Mason, Mason & Petruzzi, Dallas, TX, James D. Petruzzi, Mason & Petruzzi, Houston, TX, for Plaintiff.

Jerry R. Selinger, Timothy G. Ackermann, Morgan Lewis & Bockius, Dallas, TX, for Defendant.

ORDER

DAVID C. GODBEY**, District Judge.**

Before the Court is Defendant Bard Electrophysiology Division, a division of C.R. Bard, Inc.'s ("Bard") motion for claim construction [9]. Bard moves the Court to construe the claims of Junker's United States Design Patent D450,839 (the "D'839 patent") as including all elements depicted in solid lines in the drawings. Junker opposes the motion arguing discovery is needed to determine, among other things, points of novelty. The Court disagrees with both propositions, at least in part.

First, the Court holds that a determination of points of novelty is not appropriately part of claim construction. As this Court recently observed:

The point of novelty issue has been clarified by Bernhardt, L.L.C. v. Collezione Europa USA, Inc., 386 F.3d 1371 (Fed.Cir.2004). As here, the parties in *Bernhardt* disagreed on whether points of novelty should be considered at claim construction or at infringement. "Finding that the points of novelty issue was a question for the fact finder, the [district] court postponed a determination of the points of novelty until trial." *Id*. at 1375. The Federal Circuit did not expressly address this holding. However, it did address "the question, 'What evidence must be presented to prove infringement under the point of novelty test?' " *Id*. at 1383. By framing the issue in that manner, the Federal Circuit was at least implicitly holding that the district court correctly determined that the point of novelty test was a question of fact for the fact finder when considering infringement, and not a matter to be addressed by the Court at claim construction. This Court will likewise decline to address points of novelty at claim construction. *Accord* Lamps Plus, Inc. v. Dolan, 2003 WL 22435702, (N.D.Tex.2003). FN1

FN1. This holding does not mean that a court could not in an appropriate case determine points of novelty as a matter of law on an appropriate record at summary judgment.

Egyptian Goddess, Inc. v. Swisa, Inc., No. 3:03-CV-0594-N (N.D .Tex. Mar. 4, 2005), slip op. at 2.

In connection with claim construction, the Court finds that Bard is requesting the Court to affirm an abstract proposition of law, i.e., that the claim includes all elements depicted in solid lines in the drawings. The Court agrees with that proposition of law. *See, e.g.,* Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1313 (Fed.Cir.2001); Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1378 (Fed.Cir.2002). However, the Court does not understand that to be its role in claim construction of a design patent.

In the design patent context, however, the judge's explanation of the decision is more complicated because it involves an additional level of abstraction not required when comprehending the matter claimed in a utility patent. Unlike the readily available verbal description of the invention and of the prior art that exists in a utility patent case, a design patent case present the judge only with visual descriptions. Given the lack of a visual language, the trial court must first translate these visual descriptions into words- *i.e.,* into a common medium of communication. FN2 From this translation, the parties and appellate courts can discern the internal reasoning employed by the trial court to reach its decision as to whether or not a prior art design is basically the same as the claimed design.

FN2. When properly done, this verbal description should evoke the visual image of the design.

Durling v. Spectrum Furniture Co., 101 F.3d 100, 103 (Fed.Cir.1996). Although *Durling* was not decided in the context of claim construction, many courts have applied its teaching to claim construction of design patents. *See, e.g., Egyptian Goddess, supra,* slip op. at 3; Lamps Plus, Inc. v. Dolan, 2003 WL 22435702, (N.D.Tex.2003); Minka Lighting, Inc. v. Craftmade Int'l, Inc., 2001 WL 1012685, (N.D.Tex.2001); Bernhardt L.L.C. v. Collezione Europa USA, Inc., 2003 WL 21254634, (M.D.N .C.2003), *rev'd on other grounds,* 386 F.3d 1371 (Fed.Cir.2004). Accordingly, although the Court finds the concept of claim construction of a design patent somewhat problematic to begin with, the Court must attempt to translate the visual descriptions of the drawings in the D'839 patent into words that evoke the visual image of the design.

At this point the Court has exhausted the assistance of counsel. Rather than venture off into the wilds of claim construction without guidance, the Court will wait upon further briefing from counsel regarding an appropriate translation into words of the images in the D'839 patent. The Court is, by separate order, setting this case for trial and setting a schedule for claim construction. The Court therefore denies Bard's motion for claim construction.

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