

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

ALFRED C. DEPAOLI,)
Plaintiff,)
)
v.) CIVIL ACTION
) NO. 07-cv-11778-DPW
DAISY MANUFACTURING)
COMPANY, INC.,)
Defendant.)

MEMORANDUM AND ORDER

July 14, 2009

Plaintiff Alfred C. DePaoli is the owner of U.S. Patent No. D469,840 S ("the '840 design patent"). DePaoli has brought this action against Defendant Daisy Manufacturing Company, Inc. ("Daisy") for infringement of the '840 design patent. In the aftermath of the Federal Circuit decision *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008), cert. denied, 129 S. Ct. 1917 (2009), the parties dispute whether claim construction is the proper stage for a district court to resolve the limiting effects of prosecution history and functionality on the scope of a design patent's claims. In this claim construction order, I will address the parties' arguments on this issue and will construe the claims provided in the '840 design patent.

I. BACKGROUND

A. Parties and Litigation History

Plaintiff Alfred C. DePaoli is the President of ADCO Sales Inc., a Massachusetts corporation that sells accessories for handguns and paintball guns. Defendant Daisy Manufacturing

Company, Inc. is a Delaware corporation with a principal place of business in Arkansas.

On September 21, 2007, DePaoli brought an action against Daisy for infringement of the '840 design patent, which claims an ornamental design for an air gun sight. Daisy filed a motion for summary judgment of non-infringement on January 18, 2008, contending that DePaoli's claim should be dismissed under the so-called "point of novelty" infringement test. Following a hearing on April 30, 2008, I denied Daisy's summary judgment motion without prejudice and stayed the case pending the outcome of en banc determination by the Federal Circuit in the *Egyptian Goddess* litigation. The Federal Circuit issued its en banc opinion on September 22, 2008, holding that the "point of novelty" test should no longer be used in the analysis of a design patent infringement claim. See *Egyptian Goddess*, 543 F.3d at 678. The parties thereafter filed competing claim construction briefs for the '840 design patent. A *Markman* claim construction hearing was held in this matter on July 8, 2009.

B. The '840 Design Patent

DePaoli initially filed for the '840 design patent on November 1, 1993. The United States Patent and Trademark Office ("PTO") eventually issued the patent on February 4, 2003. The '840 design patent is titled "Air Gun Sight." It provides only a single textual claim, which reads: "The ornamental design for [an] air gun sight, as shown and described." The patent also provides two figures, which are identified as follows: "Fig. 1 is

a perspective view of an air gun sight, showing my new design; and, Fig. 2 is a rear elevational view thereof."

II. LEGAL STANDARD

"A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent." *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995); see also 35 U.S.C. § 171 ("Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor."). In some respects, a design patent is fundamentally different from a utility patent. In general, "[a] design patent contains no written description; the drawings are the claims to the patented subject matter." *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1464 (Fed. Cir. 1997). However, as with utility patents, determining whether a design patent has been infringed first requires "that the claim be properly construed to determine its meaning and scope." *Elmer*, 67 F.3d at 1577.

In *Egyptian Goddess*, the Federal Circuit noted that in the context of design patents the court had not "prescribed any particular form that the claim construction must take." 543 F.3d at 679. Although trial courts have traditionally issued detailed verbal descriptions of the drawings in design patents, the Federal Circuit has never required such constructions. *Id.* To the contrary, the *Egyptian Goddess* court explained, "the level of detail to be used in describing the claimed design is a matter

within the [trial] court's discretion." *Id.*

Nevertheless, the Federal Circuit cautioned against the dangers of detailed verbal constructions, emphasizing "the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole." *Id.* at 680. In light of these risks, and "[g]iven the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to 'construe' a design patent claim by providing a detailed verbal description of the claimed design." *Id.* at 679. The Federal Circuit acknowledged, however, that "a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court's own analysis, various features of the claimed design as they relate to the accused design and the prior art." *Id.* at 680.

In some circumstances, the scope of a design patent's claims can be limited by factors beyond the specifications of the patent itself. As with utility patents, assertions made by an applicant during the patent's prosecution history may be limiting. *Id.* Furthermore, because design patents are limited to ornamentation, they "do not and cannot include claims to the structural or functional aspects of the article." *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988). "Whether a patented design

is functional or ornamental is a question of fact." *PHG Techs., LLC v. St. John Cos., Inc.*, 469 F.3d 1361, 1365 (Fed. Cir. 2006).

III. ANALYSIS

A. Claim Construction

A disputed threshold question in this case is whether claim construction is the appropriate stage for the court to resolve the limiting effect of prosecution history and functionality on the scope of a design patent's claims.

DePaoli contends that the "preferable course" identified by the Federal Circuit in *Egyptian Goddess* favors design patent claim constructions that are as minimal as possible. DePaoli's proposed construction for the '840 design patent reads simply: "an ornamental design for [an] air gun sight, as shown and described [in Figures 1 and 2 of the patent]." This construction would leave the issues of prosecution history and functionality to be resolved later in the proceedings, either on summary judgment or following a trial.

Daisy contends that prosecution history and functionality issues should be incorporated into the claim construction adopted by the court at this stage, arguing that such an approach would best assist the factfinder in determining infringement. Daisy proposes the following construction for the '840 design patent:

The ornamental design for [an] air gun sight as shown, which includes an elevation control housing and LED housing at the rear end of a tube holder and a ramp extending the distance between the sighting tube and the LED housing. The elevation control housing and the LED housing step up from the sides of the

tube holder. The ramp is not flat, drops below the sides of the tube holder, and the stand that mounts the sighting tube onto the tube holder is not part of the ramp. Controlling elevation through the use of an elevation control screw is a functional feature that is not covered by the design.

According to Daisy, the descriptions of the elevation control housing, the light-emitting diode ("LED") housing, and the ramp are based on DePaoli's representations to the PTO examiner during the patent's prosecution. The limitation concerning the elevation control screw is an issue of functionality.¹

In discussing the proper role of claim construction in design patent cases, the Federal Circuit in *Egyptian Goddess* briefly addressed issues of prosecution history and functionality. The court explained:

Apart from attempting to provide a verbal description of the design, a trial court can usefully guide the finder of fact by addressing a number of other issues that bear on the scope of the claim. Those include such matters as . . . assessing and describing the effect of any representations that may have been made in the course of the prosecution history, see *Goodyear Tire & Rubber Co.*, 162 F.3d at 1116; and distinguishing between those features of the claimed design that are ornamental and those that are purely functional, see *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997) ("Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in

¹ These proposed limitations are addressed in more detail in Section III.B, *infra*.

the patent.").

Providing an appropriate measure of guidance to a jury without crossing the line and unduly invading the jury's fact-finding process is a task that trial courts are very much accustomed to, and any attempt by an appellate court to guide that process in detail is likely to do more harm than good.

Egyptian Goddess, 543 F.3d at 680. It is not entirely apparent from this passage whether the Federal Circuit advocates resolving prosecution history and functionality issues through formal *Markman* claim construction, jury instructions, or some other means. On the one hand, the court refers to "guid[ing] the finder of fact" in a manner "[a]part from attempting to provide a verbal description of the design," *id.*, which suggests jury instructions may be the best avenue. On the other hand, the court's parenthetical quotation from *OddzOn* suggests that these issues, or at least the question of functionality, may properly be addressed during claim construction. One thing that does seem clear from *Egyptian Goddess* is that district courts have considerable discretion for resolving this type of question.

Very few decisions have had the opportunity to address the proper approach to claim construction of a design patent since the *Egyptian Goddess* decision was issued. A brief survey of the district court cases that have considered the question may help illuminate the issues presented here. In two cases, the courts already had engaged in detailed verbal claim constructions prior to the *Egyptian Goddess* decision and found it unnecessary to abandon or amend those constructions. See *Minka Lighting, Inc.*

v. Maxim Lighting Int'l, Inc., No. 3:06-cv-995-K, 2009 WL 691594, at *4 (N.D. Tex. Mar. 16, 2009) (“[T]he Court finds that the claimed designs are best represented by the illustrations contained in each patent. But because the Court has already made such a description, it would be incongruent to completely ignore this previous effort to adequately reduce the patents to words.”); *see also Dexas Int'l, Ltd. v. Tung Yung Int'l (USA) Inc.*, No. 6:07cv334, 2009 WL 838174, at *3 (E.D. Tex. Feb. 25, 2009). Because the instant case provides a fresh opportunity for claim construction, I find the law of the case analysis of these decisions not directly on point.

Several other cases have more broadly touched upon the question of when it is appropriate or necessary for a district court to provide a detailed verbalized claim construction for design patents. In two of these cases, the courts declined to engage in any descriptive claim construction at all, finding that the best representations of the claimed designs were found in the patents' illustrations. *See Mondo Polymers Techs., Inc. v. Monroeville Indus. Moldings, Inc.*, No. 2:07-cv-1054, 2009 WL 230123, at *2 (S.D. Ohio Jan. 30, 2009); *Arc'teryx Equip., Inc. v. Westcomb Outerwear, Inc.*, No. 2:07-CV-59 TS, 2008 WL 4838141, at *2 (D. Utah Nov. 4, 2008). Yet another case found that a verbal description of the claims was necessary, but only to the extent that the various drawings in the patent were inconsistent with one another. *See HR U.S. LLC v. Mizco Int, Inc.*, No. CV-07-2394 (DGT)(JO), 2009 WL 890550, at *9 (E.D.N.Y. Mar. 31, 2009).

Finally, the court in *International Seaway Trading Corp. v. Walgreens Corp.*, 599 F. Supp. 2d 1307 (S.D. Fla. 2009), held on a summary judgment motion for invalidity that it was necessary to engage in a detailed verbal description of the patent claims in order to express clearly the court's reasoning for its finding of anticipation. *Id.* at 1315; see also *Egyptian Goddess*, 543 F.3d at 679 n.1 ("Requiring . . . an explanation of a legal ruling as to invalidity is quite different from requiring an elaborate verbal claim construction to guide the finder of fact in conducting the infringement inquiry.").

It appears that only two post-*Egyptian Goddess* district court design patent cases have spoken directly to the question of whether prosecution history and functionality should be resolved at the claim construction stage or later in the proceedings. In *Mag Instrument, Inc. v. JS Products, Inc.*, 595 F. Supp. 2d 1102 (C.D. Cal. 2008), the plaintiff, who owned two design patents, moved to dismiss the defendant's affirmative defense that the patents "provide no discernable distinctions or demarcations between the functional and non-functional elements of the design." *Id.* at 1107. The court denied the plaintiff's motion, explaining that the "affirmative defense raises and preserves an issue the Court can address in a claim construction order." *Id.* at 1108. The court elaborated: "Assuming, for the sake of argument, that Plaintiff's [] Patents contain both functional and non-functional elements, the Court, in the usual course of issuing a claim construction order, will construe the challenged

claims to 'identify the non-functional aspects of the design as shown in the patent.'" *Id.* (quoting *Egyptian Goddess*, 543 F.3d at 680).

The district court in *Dexas International, Ltd. v. Office Max Inc.*, No. 6:07cv396, 2009 WL 252164 (E.D. Tex. Jan. 30, 2009), relied on *Egyptian Goddess* to take a different approach. In that case, the court adopted a construction of the disputed design patent very similar to DePaoli's proposed construction in this case: "A clipboard adapted to hold documents of a certain design, as shown in Figures 1-7." *Id.* at *7. The *Office Max* court rejected the defendant's more detailed proposed construction, concluding that it "would entail a significant risk that the jury would place undue emphasis on particular features of the claimed designs or otherwise focus on distinct features rather than on the designs as a whole." *Id.* at *5.² The court added: "Moreover, the Court may guide the jury by addressing issues of . . . the proper role of prosecution history; and the distinction between ornamental and functional features, among

² The court in *Office Max* further noted that the *Egyptian Goddess* court's warnings about detailed verbal claim constructions derived from the same concerns that prompted the Federal Circuit to abandon the "point of novelty" test. See *Dexas Int'l, Ltd. v. Office Max Inc.*, No. 6:07cv396, 2009 WL 252164, at *5 (E.D. Tex. Jan. 30, 2009) ("Pointing out such features could easily result in a claim construction akin to a determination of points of novelty - a prong of the infringement analysis for design patent infringement which was specifically discarded by the Federal Circuit in *Egyptian Goddess*.").

other issues, when instructing the jury." *Id.* (citing *Egyptian Goddess*, 543 F.3d at 680).

I find the approach adopted by the court in *Office Max* to be persuasive. Assuming, *arguendo*, that certain physical elements of the '840 design patent must be limited based on prosecution history and functionality, as Daisy argues, those limitations are entitled to no more special attention from the jury on the question of infringement than any other elements of the design. To provide the jury with a verbalized construction of the '840 design patent's claims which directs their attention to the two illustrations in the patent and then describes *only* those elements that are implicated by prosecution history and functionality would place undue emphasis on those few elements. This is precisely the danger against which the *Egyptian Goddess* court cautioned.

For these reasons, I find at this stage that the best representation of the '840 design patent's claims is the patent's illustrations. I will therefore adopt the Plaintiff's proposed claim construction of the '840 design patent: "an ornamental design for an air gun sight, as shown and described in Figures 1 and 2 of the patent." To the extent the scope of the claim must be limited by prosecution history or functionality, I will address those issues definitively if and when they are raised at some later stage in these proceedings, such as resolution of motions for summary judgment or as part of the jury instructions

at trial.³

B. Prosecution History and Functionality Issues

However, to the extent it may be helpful at this stage, for example in development of expert witness testimony and discovery, I will also preliminarily address at this time the substantive dimensions of Daisy's contentions regarding prosecution history and functionality.

1. Prosecution History

Daisy has argued that the scope of the '840 design patent must be limited according to assertions DePaoli made to the PTO while attempting to secure the patent. Daisy contends these assertions should be incorporated in the claim construction for the '840 design patent as follows:

The ornamental design for [an] air gun sight . . . which includes an elevation control housing and LED housing at the rear end of a tube holder and a ramp extending the distance between the sighting tube and the LED housing. The elevation control housing and the LED housing step up from the sides of the tube holder. The ramp is not flat, drops below the sides of the tube holder, and the stand that mounts the sighting tube onto the tube holder is not part of the ramp.

In short, Daisy identifies three limiting elements of the invention - the elevation control housing, the LED housing, and the ramp - and provides a physical description of each.

³ In *Richardson v. Stanley Works, Inc.*, 610 F. Supp. 2d 1046 (D. Ariz. 2009), the district court waited until even later in the travel of the case by conducting a claim construction on the question of functionality as part of its findings of fact and conclusions of law *after* a trial on the issue of infringement. *Id.* at 1049-51.

a. *Legal Standard*

The scope of a design patent, like that of a utility patent, may be limited by the applicant's representations during the patent's prosecution history. *See Egyptian Goddess*, 543 F.3d at 680; *see also Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (noting that prosecution history "is often of critical significance in determining the meaning of the claims"). The prosecution history "contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims." *Vitronics*, 90 F.3d at 1582. This history "provides evidence of how the PTO and the inventor understood the patent." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005). The Federal Circuit has cautioned, however, that "because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Id.*

b. *Summary of the Prosecution History*

DePaoli filed his initial application for the '840 design patent on November 1, 1993. Although the specification referenced four figures, only two were actually included with the application. These two informal illustrations showed a front perspective view and a rear elevational view, which were very

similar to the figures ultimately included in the patent as issued. On December 6, 1993, the PTO issued a Notice of Incomplete Application. Thereafter, on December 16, 1993, DePaoli filed a Response and Amendment, which included substitute formal drawings for all four figures referenced in the initial application, as well as a new fifth figure. Unlike the illustrations in the initial application, the substitute Figure 1 clearly showed a ramp between the LED housing and the sighting tube of the gun sight. DePaoli also filed a "Petition for Filing Date of November 1, 1993," in which he asserted that the substitute drawings were ultimately unnecessary because "the distinctive design of the AIR GUN SIGHT is shown completely by Figures 1 and 2 as filed, even though Figures 1 and 2 are informal drawings." The PTO granted DePaoli's request for a priority date of November 1, 1993, but it did not enter his substituted drawings into the application.

On January 21, 1994, DePaoli filed a "Petition to Make Special" under 37 C.F.R. § 1.102, in an effort to advance the examination of his application. The petition included a "Discussion of References," in which DePaoli identified two elements he argued distinguished his design from the prior art:

The first feature is the LED pedestal at the back, the elongated sighting tube at the front and the ramp in between, all contained on a common mount.

The second feature is the sloping entrance to the sighting tube as it appears from the side and the top.

DePaoli indicated that these features were shown clearly in two of his substitute formal drawings, but those drawings were not accepted by the PTO. Nonetheless, on July 21, 1994, the PTO granted DePaoli's Petition to Make Special and expedited the examination of his application.

The PTO issued an initial rejection of DePaoli's application on August 19, 1994. DePaoli thereafter submitted a new Response and Amendment, filed September 27, 1994. DePaoli included only two figures this time, both formal versions of the figures submitted with his initial application. On November 28, 1994, the PTO issued a Final Office Action, again rejecting DePaoli's application. The rejection notice explained that "the new drawings are quite different (more detailed) from the drawings as originally filed and the Examiner was unable to find a basis for all these 'new parts.'" In response, on January 10, 1995, DePaoli filed another Response and Amendment, attempting to convince the examiner that the formal substitute drawings were indeed faithful to the figures from his original application. On February 3, 1995, the PTO notified DePaoli that it had considered and rejected his new arguments. Later in the proceedings, a substitute Examiner identified the specific reasons that DePaoli's substitute drawings were "quite different" from those originally filed, noting, inter alia, that "[t]he tube ramp seen in the new drawing is not visible in the original."

Unable to overcome the PTO's rejections, DePaoli eventually appealed to the Board of Patent Appeals and Interferences ("the

Board"). After his initial brief was rejected for lack of proper form, DePaoli filed a Revised Appeal Brief on May 5, 1998.

Exhibit E to this revised brief included an annotated version of the drawings DePaoli had submitted with his original application, as well as an annotated version of the more formal drawings he had submitted later. The exhibit purported to demonstrate that the original drawings included all of the distinguishing features that were more clearly visible in the later drawings. The brief's "Summary of the Invention" identified "[t]he unique features of the design that distinguishes it from the references," including:

the elevation control housing 5 and LED housing 4 at the rear end of the tube holder 10 that step up from the sides of the tube holder; and the tube ramp 3 that is essentially even with the sides of the tube holder, between the sighting tube and the elevation control housing 5 and LED housing 4.⁴

On January 17, 2000, the Board sustained the rejection of DePaoli's application. The Board noted that DePaoli's substitute formal drawings "were never entered as an amendment" to his application. Like the examiner, the Board concluded that DePaoli's new formal drawings had "numerous differences" from the drawings originally filed.

On May 24, 2000, the Board remanded DePaoli's application to

⁴The numbers in this passage correspond to the numbers used to label these features in the annotated drawings of Exhibit E to DePaoli's appeal brief.

the examiner for reconsideration. DePaoli subsequently engaged in another series of exchanges with the PTO, during which the examiner again rejected certain formalized substitute drawings of the design. On November 30, 2001, DePaoli once more submitted new formal drawings, which were far more similar to the original figures than his previous substitute drawings had been. The examiner accepted these drawings in the application and issued a Notice of Allowability on January 22, 2002. The PTO issued the '840 design patent on February 4, 2003.

c. Analysis

Daisy contends that the scope of the '840 patent claim should be limited according to the arguments DePaoli repeatedly made to the examiner to distinguish his application over the prior art. In support, Daisy relies on *Laitram Corp. v. Morehouse Industries, Inc.*, 143 F.3d 1456 (Fed. Cir. 1998), in which the Federal Circuit held that "[t]he fact that an examiner placed no reliance on an applicant's statement distinguishing prior art does not mean that the statement is inconsequential for purposes of claim construction." *Id.* at 1462. I preliminarily find that with respect to DePaoli's assertions regarding the LED housing and the elevation control housing, Daisy is correct, and the scope of the patent's claim must be limited to designs where those elements "step up from the sides of the tube holder," as

DePaoli described them.⁵

I also preliminarily find, however, that the '840 design patent is not limited with regard to the ramp extending between the sighting tube and the LED housing. It is true that DePaoli repeatedly attempted to add illustrations to his application that clearly depicted the ramp, and he frequently described the ramp as a distinguishing element of his invention. Those efforts, however, were consistently rebuffed by the PTO examiner, who determined that the ramp was *not* disclosed by the figures in DePaoli's original application. Because the prosecution history of a patent "represents an ongoing negotiation between the PTO and the applicant," *Phillips*, 415 F.3d at 1317, it is important to recognize that not every assertion by an applicant as to the scope of his claim will be accepted by the examiner as part of the patent as issued. The examiner in this case did not merely fail to rely on DePaoli's assertions concerning the ramp, as in *Laitram*; rather, the examiner expressly *rejected* DePaoli's attempt to include the ramp. Therefore, to the extent that the prosecution history offers guidance for claim construction on this issue, it demonstrates that the '840 design patent does *not* claim a ramp that extends between the sighting tube and the LED housing.

⁵ It is doubtful this finding provides any meaningful limitation beyond what is disclosed in the illustrations of the '840 design patent. Figure 1 of the patent clearly depicts the LED housing and elevation control housing as "stepping up" from the side of the tube holder.

2. Functionality

Daisy also contends that the elevation control screw visible in the '840 design patent's illustrations should be excluded from the scope of the patent because it is primarily functional in nature. According to Daisy, this limitation should be reflected in the claim construction of the '840 design patent as follows: "Controlling elevation through the use of an elevation control screw is a functional feature that is not covered by the design."

a. Legal Standard

The protection of a design patent is limited to ornamental aspects of the invention and does not extend to its structural or functional aspects. *Lee*, 838 F.2d at 1188. The Federal Circuit has held that "the design of a useful article is deemed to be functional when the appearance of the claimed design is 'dictated by' the use or purpose of the article. If the particular design is essential to the use of the article, it can not be the subject of a design patent." *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (internal citations omitted). Simply because an element of a design serves a utilitarian purpose, however, "does not mean that the specific design of each element, and the combination of these elements into the patented design, is dictated by primarily functional considerations." *Id.* Rather, "[w]hen there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose." *Id.* Whether an

element of a design patent is primarily "functional" or "ornamental" is a question of fact. *PHG*, 469 F.3d at 1365.

b. Analysis

There can be no doubt that the elevation control screw depicted in the '840 design patent serves a functional purpose. The air gun sight shown in the '840 design patent works by projecting a red dot from its LED onto the lens of the sighting tube. A shooter, looking through the lens, attempts to overlay the dot on his target before firing. The elevation control screw is used to adjust the elevation of this aiming mechanism. As the ADCO product brochure explains, "The rear screw is mounted vertically and is used for adjustment to elevation. A clockwise turn will raise the point of impact." (emphasis omitted).

At this stage of the litigation, however, it is impossible to determine whether other considerations would indicate that the appearance of the elevation control screw in the '840 design patent is primarily ornamental. It is true, as Daisy argues, that the Federal Circuit has recognized assertions of specific utility in advertising materials as an appropriate consideration for assessing functionality. See *Berry Sterling Corp. v. Prescor Plastics, Inc.*, 122 F.3d 1452, 1456 (Fed. Cir. 1997). But that is only one possible consideration out of many. See *id.* ("Other appropriate considerations might include: whether the protected design represents the best design; whether alternative designs would adversely affect the utility of the specified article; whether there are any concomitant utility patents . . . and

whether there are any elements in the design or an overall appearance clearly not dictated by function."). For this reason, I conclude that determining which features of the '840 design patent are ornamental and which, if any, are purely functional must await a later stage in the proceeding, such as summary judgment practice or trial.⁶

IV. CONCLUSION

For the reasons set forth more fully above, I adopt the claim construction proposed by DePaoli: "an ornamental design for an air gun sight, as shown and described in Figures 1 and 2 of the patent." Further definitive determinations on claim construction regarding the impact of prosecution history and the functional dimensions of certain features must await a later stage in these proceedings.

/s/ Douglas P. Woodlock
DOUGLAS P. WOODLOCK
UNITED STATES DISTRICT JUDGE

⁶ As discussed in Section III.A, *supra*, in connection with the *Egyptian Goddess* decision, the Federal Circuit held in *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997), that "[w]here a design contains both functional and non-functional elements, *the scope of the claim must be construed* in order to identify the non-functional aspects of the design as shown in the patent." *Id.* at 1405 (emphasis added). Such a construction clearly must occur prior to determining infringement. However, given that functionality is a finding of fact, it may be more reasonable to determine the claim construction on summary judgment or in jury instructions than to attempt it earlier in the proceedings. *See, e.g., Richardson*, 610 F. Supp. 2d at 1049-51.