

of non-infringement and invalidity of the patent, and a judgment of false-marking against Douglas pursuant to 35 U.S.C. § 292.

Both parties have filed motions for summary judgment. Wal-Mart asks the Court to dismiss all counts of the amended complaint, to order that Wal-Mart's product does not infringe Douglas' patent, that Douglas' patent is invalid, and that Douglas has falsely marked promotional material in violation of 35 U.S.C. § 292. Wal-Mart requests Douglas be ordered to pay a fine pursuant to 35 U.S.C. § 292, and attorneys' fees and costs. Douglas seeks summary judgment on all of his claims, requests damages, attorneys' fees and costs, and asks that the Court enjoin Wal-Mart from further infringement of Wal-Mart's patent, copyright, and trademark.

For the reasons that follow, summary judgment will be granted to Wal-Mart on all of Douglas' claims. Wal-Mart's request for attorneys' fees and costs will be denied. Wal-Mart's first counterclaim will be dismissed as moot. Douglas' motion to dismiss Wal-Mart's second counterclaim will be granted.

I. BACKGROUND

On September 9, 1997, the United States Patent and Trademark Office issued a patent to Douglas (the "'272 patent"). The claims of the '272 patent are as follows:¹

¹ A claim in a patent registration is "[a] formal statement describing the novel features of an invention and defining the

1. A combined motor vehicle control pillow and tiltable steering wheel cover unit for straight highway driving comprising:
 - a fabric covered foam piece;
 - a hook and loop fastener strip mounted on one surface of said fabric covered foam piece;
 - said hook and loop fastener strip being arranged to engage a steering wheel cover, said cover of said steering wheel being of a suitable material to be gripped by said hook and loop fastener strip; and
 - a U-shaped plastic retainer secured to the opposite surface of said fabric covered foam piece, said U-shaped plastic retainer being adapted to fit on a thigh of a driver of a motor vehicle, whereby when said steering wheel is tilted toward the foam piece on the thigh of the driver a gripping contact is established between said hook and loop fastener strip and said steering wheel cover to maintain said steering wheel in a rotationless attitude.
2. The device of claim 1 wherein said fabric covered foam piece can be covered by plastic, silk, leather, cotton, and rayon or denim.
3. The pillow of claim 1 wherein said U-shaped retainer is mounted up beneath the said pillow and is supported by a funnel opening for easy assembly and cleaning.

Wal-Mart contends that Claims 2 and 3 are dependant on Claim 1, which is the only independent claim. The claims are accompanied by the specification and drawings of the "preferred embodiment of the invention."² The specification includes the sentence: "This invention can also be used as a neck support pillow."

scope of a patent's protection." Black's Law Dictionary 241 (7th Ed. 1999).

² The specification is "[a] patent applicant's written description of how an invention is constructed and used." Black's Law Dictionary 1406 (7th Ed. 1999).

On January 13, 2005, Douglas filed an action against Wal-Mart, alleging that Wal-Mart's "GÜEE MASSAGE™ NECK MASSAGE with Removable Massager" ("Güee Neck Massage") infringes the '272 patent. Wal-Mart states that the Güee Neck Massage is not a combined motor vehicle control pillow and tiltable steering wheel cover unit, does not contain a fabric covered foam piece,³ and does not contain a hook and loop fastener strip mounted on one surface of said fabric covered foam piece.

On March 22, 2005, Douglas registered Copyright TX 6-155-893, for advertising copy titled "Pleasurable Neck Pillow," or "neck support pillow." On March 25, 2005, Douglas filed an amended complaint, adding claims for copyright infringement, false advertising, trade dress infringement, state and common law unfair competition, and trademark infringement.

II. LEGAL STANDARD

A court may grant summary judgment only when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). A fact is "material" only if its

³ Wal-Mart alleges the Güee Neck Massage is "stuffed with thousands of cushiony foam beads." (Def.'s Mot. Summ. J. 7.)

existence or non-existence would affect the outcome of the suit under governing law. Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986). An issue of fact is "genuine" only when there is sufficient evidence from which a reasonable jury could find in favor of the non-moving party regarding the existence of that fact. Id. In determining whether there exist genuine issues of material fact, all inferences must be drawn, and all doubts must be resolved, in favor of the non-moving party. Coregis Ins. Co. v. Baratta & Fenerty, Ltd., 264 F.3d 302, 305-06 (3d Cir. 2001) (citing Anderson, 477 U.S. at 248).

Where the non-moving party is the plaintiff and, therefore, bears the burden of proof at trial, that party must present affirmative evidence sufficient to establish the existence of each element of his case. Id. at 306 (citing Celotex Corp. v. Catrett, 477 U.S. 317, 323, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986)). Accordingly, a plaintiff cannot rely on unsupported assertions, speculation, or conclusory allegations to avoid the entry of summary judgment, see Celotex, 477 U.S. at 324, but rather, the plaintiff "must go beyond pleadings and provide some evidence that would show that there exists a genuine issue for trial." Jones v. United Parcel Serv., 214 F.3d 402, 407 (3d Cir. 2000).

III. ANALYSIS

A. Patent Infringement

Wal-Mart argues that summary judgment should be granted in its favor on Douglas' claim of patent infringement for two reasons: (1) If the '272 patent covered all u-shaped neck pillows filled with beads it would be invalid under 35 U.S.C. § 102(b) because u-shaped neck pillows were on sale in the United States at least three years before Douglas received his patent; and (2) Douglas has not put forward evidence proving that the Güee Neck Massage infringes the '272 patent, either literally or under the doctrine of equivalents.

Douglas argues that the Güee Neck Massage infringes the '272 patent because the specification of the '272 patent states that the "invention can also be used as a neck support pillow." Douglas claims that his device and the Güee Neck Massage perform substantially the same function and Wal-Mart is therefore infringing the '272 patent under the doctrine of equivalents.

Douglas has not put forward sufficient evidence to show infringement under a traditional patent infringement analysis, and summary judgment will therefore be granted in favor of Wal-Mart on the patent infringement claim. It is not necessary to reach the issue of whether the '272 patent is valid.

"Determination of patent infringement requires a two-step analysis: (1) the scope of the claims must be construed; and

(2) the allegedly infringing device must be compared to the construed claims.” Mars, Inc. v. H.J. Heinz Co., L.P., 377 F.3d 1369, 1373 (Fed. Cir. 2004). It is the claims, not the specification, that define the scope of the patent and its protections. See, e.g., Johnson & Johnson Assoc. Inc. v. R.E. Service Co., Inc., et al., 285 F.3d 1046, 1052 (Fed. Cir. 2002) (the claim requirement “presupposes that a patent applicant defines his invention in the claims, not in the specification ... the claims, not the specification, provide the measure of the patentee’s right to exclude.”).

1. Literal infringement

Literal infringement of a patent exists when “each of the claim limitations ‘reads on,’ or in other words is found in, the accused device.” Allen Eng’g Corp. v. Bartell Indus., Inc., 299 F.3d 1336, 1345 (Fed. Cir. 2002). Douglas does not put forward any evidence showing that the claim limitations of the ‘272 patent read on the Güee Neck Massage. Wal-Mart has put forward evidence showing that the Güee Neck Massage is not a combined motor vehicle control pillow and tiltable steering wheel cover unit, and does not contain a fabric covered foam piece, a hook and loop fastener strip, or a U-shaped plastic retainer, all of which are claim limitations of the ‘272 patent.

2. Doctrine of equivalents

Although a finding of literal infringement is precluded if one or more of the claim limitations are not literally present in the allegedly infringing product, an accused device can still infringe a patent if it contains an equivalent of the claim limitation. A court will analyze an equivalent on a limitation-by-limitation basis, in order to be "specially vigilant against allowing the concept of equivalence to eliminate any claim limitations completely." Allen Eng'g Corp., 299 F.3d at 1345. To prove equivalence, a party must show "that an element of an accused device does substantially the same thing in substantially the same way to get substantially the same result as the claim limitation." Id. (citation omitted).

Wal-Mart argues that to find the Güee Neck Massage infringes the '272 patent under the doctrine of equivalents would erase the limitation that the '272 patent is for a "combined motor vehicle control pillow and tiltable steering wheel cover unit for straight highway driving" comprised of a fabric covered foam piece, a hook and loop fastener strip, and a U-shaped plastic retainer.

Douglas argues that the doctrine of equivalents applies because the Güee Neck Massage "does perform substantially the same function in substantially the same way to obtain the same result." (Pl.'s Mot. Summ. J. 52.) However, the only evidence

Douglas offers in support is information from the patent's specification, including the sentence, "[t]his invention can also be used as a neck support pillow," and a description of the shape of the pillow. (Pl.'s Mot. Summ. J. 46-49.) Again, it is the claims, not the specification, that define the scope of the patent's protection. Douglas also argues that because the Güee Neck Massage contains "thousands of cushiony foam beads," it is a fabric covered foam piece, because "if there would not be a fabric cover to Wal-Mart's pillow, there would not be anything to stuff the cushiony beads in." (Pl.'s Mot. Summ. J. 32.) With this assertion, the Douglas attempts to change the claim limitation of a "fabric-covered foam piece" into anything fabric covered. The doctrine of equivalents cannot be used to "erase meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement." Johnson & Johnson, 285 F.3d at 1054 (citing Conopco, Inc. v. May Dep't Stores Co., 46 F.3d 1556, 1562 (Fed. Cir. 1994)).

Douglas has failed to offer evidence showing that the Güee Neck Massage infringes the '272 patent, either literally or under the doctrine of equivalents. Accordingly, summary judgment in favor of Wal-Mart on the claim of patent infringement is appropriate.⁴

⁴ As stated above, Wal-Mart also contends that Douglas' assertion that the Güee Neck Massage is identical to the device covered by the '272 patent invalidates the patent, as such a

B. Copyright Infringement

In his amended complaint, Douglas alleges Wal-Mart infringed his copyright for the text of an advertisement for a pleasurable neck pillow. In order to prove copyright infringement, a plaintiff must show: (1) proof of plaintiff's ownership of the copyright, and (2) copying by the defendant. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1990). Copying is proven by showing: (1) the defendant had access to the copyrighted work, and (2) there are substantial similarities between the two works. Dam Things from Denmark, a/k/a Troll Co. ApS v. Russ Berrie & Co., Inc., 290 F.3d 548, 561 (3d Cir. 2002).

Wal-Mart contends that Douglas has put forward no evidence showing that Wal-Mart copied his copyrighted work. Douglas argues that "Wal-Mart's commercial packaging is complete evidence of copying." (Pl.'s Mot. Summ. J. 10.) He points to the color scheme, and the fact that both his and Wal-Mart's advertisements use the words, "neck," "pillow," "stretchable," "squeezable," "fabric," "pocket," "zipper," "for," "foam," and "vibrator."

Regarding ownership of the copyright, Douglas has put

device was sold in the United States more than three years before the patent issued. It is not necessary to reach this issue, however, as insufficient evidence has been offered to support a claim of patent infringement under a traditional patent infringement analysis.

forward evidence of his copyright registration, Number TX 6-155-893. Wal-Mart has not challenged this registration beyond noting that the copyright is a "TX" registration, for a literary work, and therefore covers only the text of Douglas' advertising copy, not its visual aspects.⁵

In order to prove copying of the protected work, a plaintiff may put forward direct evidence of copying, or circumstantial evidence of access and substantial similarity between the allegedly infringing and the protected work. See, e.g., Franklin Mint Corp. v. National Wildlife Art Exch., 575 F.2d 62, 64 (3d Cir. 1978). The indirect evidence necessary to show access must only show "there is a reasonable possibility of access." Cottrill v. Spears, 87 Fed. Appx. 803, 805 (3d Cir. 2004) (citing Gaste v. Kaiserman, 863 F.2d 1061, 1066 (2d Cir. 1988)). For example, a plaintiff may show there is a relationship between the alleged copier and an intermediary with access to the protected work. Id.; see also Midway Mfg. Co. v. Bandai-America, Inc., 546 F. Supp. 125, 145-46 (D.N.J. 1982) (wide publication of a work will suffice to show access). Additionally, the access shown must be meaningful, in that the

⁵ "Literary works" are defined by the Copyright Act as, "works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied." 17 U.S.C. § 101 (2005).

plaintiff must show the defendant had an opportunity to view or copy the work before the allegedly infringing work was completed. Id.

In this case, Douglas has put forward no evidence that Wal-Mart had access to his copyrighted material. "Access must be more than a mere possibility and may not be inferred through speculation or conjecture." Franklin Mint, 575 F.2d at 806 (citing Gaste, 863 F.2d at 1066). The failure of Douglas to prove access, either directly or circumstantially, is sufficient reason for the Court to grant summary judgment to Wal-Mart on the copyright infringement claim.

In addition, Douglas has not sufficiently pointed to substantial similarity between the advertisement for the Güee Neck Massage and the advertisement for the Pleasurable Neck Pillow. An inquiry into substantial similarity considers two factors: (1) whether the defendant copied plaintiff's work; and (2) whether this copying, if proven, constituted an improper appropriation - or, in other words, whether the substantial similarity related to protectible material. Kay Berry, Inc. v. Taylor Gifts, Inc., 421 F.3d 199, 207-08 (3d Cir. 2005). The second factor is to be considered from the perspective of a lay person. Id.

Here, Douglas points to the Wal-Mart's use of the following words as evidence of copying: "neck," "pillow,"

"stretchable," "squeezable," "fabric," "pocket," "zipper," "for," "foam," and "vibrator." The Court finds that, from the perspective of a lay person, the use of these common words does not constitute illicit copying. On this basis, too, the Court finds it appropriate to grant summary judgment for Wal-Mart on the copyright infringement claim.⁶

C. Trade Dress Infringement

"'Trade dress' refers to the design or packaging of a product which serves to identify the product's source." Shire US Inc. v. Barr Lab. Inc., 329 F.3d 348, 353 (3d Cir. 2003). To

⁶ Douglas makes the argument that Wal-Mart has admitted its copyright infringement by alleging it is protected under the doctrine of "fair use." "Fair use" is indeed a defense used to counter a charge of infringement in the copyright context, and is asserted to excuse conduct that may otherwise amount to copying, see, e.g., Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc., 342 F.3d 191, 205 n.13 (3d Cir. 2003), but Wal-Mart does not assert such a defense here. Instead, Wal-Mart argues there has been no proof of infringement offered by Douglas, and the Court agrees.

At oral argument on October 10, 2005, Wal-Mart stated that in response to Douglas' requests for admission, Wal-Mart had admitted that the outside of the box of the Güee Neck Massage contained the word, "squeezable." Wal-Mart then stated that if the Wal-Mart had trademark rights to enforce, such a use of the word "squeezable" would be fair use. (Tr. 26, Oct. 10, 2005.) In the trademark context, nominative fair use can occur if the only practical way to refer to something is by using the trademarked term. See, e.g., Century 21 Real Estate Corp. v. Lendingtree, Inc., 425 F.3d 211, 214 (3d Cir. 2005). This may be the source of Douglas' contention that Wal-Mart had asserted a fair use defense. The Court will not reach the fair use doctrine in either the copyright nor the trademark contexts, as it finds there has been no infringement.

establish infringement, a plaintiff must show: (1) the allegedly infringing feature is non-functional; (2) the feature is inherently distinctive or has acquired secondary meaning, and (3) consumers are likely to confuse the source of plaintiff's product with that of the allegedly infringing product. Id.

Wal-Mart asserts that Douglas has not offered sufficient evidence to prove the claim of trade dress infringement. Douglas argues that "Plaintiff's trade dress is found on Defendant's design of the product and its packaging and advertisement in violation of both the Lanham Act and Federal Trade Act." (Pl.'s Mot. Summ. J. 17.) This unsupported assertion is not sufficient to establish the elements of trade dress infringement and summary judgment will be granted in favor of Wal-Mart on this claim.

D. False Advertising

Douglas also alleges Wal-Mart has engaged in conduct amounting to false advertising under the Lanham Act, 15 U.S.C. § 1125(a). To establish such a claim, Douglas must show: (1) Wal-Mart made false or misleading statements about his own product (or another's); (2) there is actual deception or a tendency to deceive a substantial portion of the intended audience; (3) the deception is material in that it is likely to influence

purchasing decisions; (4) the advertised goods traveled in interstate commerce; and (5) there is a likelihood of injury to the plaintiff, e.g., declining sales and loss of good will. Warner-Lambert Co. v. Breathasure, Inc., 204 F.3d 87, 92 (3d Cir. 2000).

Wal-Mart asserts that Douglas has not offered sufficient evidence to show false advertising. Douglas states that the false advertising consists of Wal-Mart's use of his color and text. He also states that the products at issue have traveled in interstate commerce and that he has been and will continue to be irreparably harmed by Wal-Mart's false advertising.

Douglas has put forward no evidence that Wal-Mart made false or misleading statements regarding its product, on any intended deception, or on any likelihood of injury Douglas may suffer due to Wal-Mart's alleged conduct. Instead, he relies on conclusory allegations and unsupported assertions. Summary judgment will be granted for Wal-Mart on this claim.

E. Unfair Competition; Trademark Infringement

To establish a claim for unfair competition or trademark infringement, a plaintiff must show: "(1) the mark is valid and legally protectable; (2) the mark is owned by the plaintiff; and (3) the defendant's use of the mark to identify

goods and services is likely to create confusion concerning the origin of the goods or services." Scott Fetzer Co. v. Gehring, 288 F. Supp.2d 696, 703 (E.D. Pa. 2003) (citation omitted).⁷

Wal-Mart argues that Douglas has not put forward evidence to establish any of the necessary elements for the claims of unfair competition and trademark infringement. Wal-Mart also contends the mark "Pleasurable Neck Pillow" is descriptive, and thus not entitled to trademark protection. (Def.'s Mot. Summ. J. 29-31.)

Douglas states that his "first evidence is Defendants' fraudulent Güee Neck Massage™ Neck Massage with removable massager," and that Douglas is the first user of the trademark "Pleasurable Neck Pillow" in the state of Pennsylvania. Douglas also contends that Wal-Mart's use of the colors red, white, and blue on its commercial packaging infringes his trademark. (Pl.'s Mot. Summ. J. 17, 28.)

Although Douglas argues that color itself can be protected by trademark, Douglas has offered no evidence to supplement his own assertions that the mark is valid, legally protectable, and owned by Douglas. Summary judgment will be

⁷ The elements of unfair competition under Pennsylvania law and federal law are the same, except the federal claims require an effect on interstate commerce, and the elements necessary to establish a claim of unfair competition and one of trademark infringement are the same. Scott Fetzer Co., 288 F. Supp.2d at 703.

granted for Wal-Mart on the trademark infringement and unfair competition claims.

F. Wal-Mart's Counterclaims

1. Declaratory judgment of non-infringement and
invalidity of the '272 patent

Wal-Mart seeks a declaratory judgment of non-infringement and invalidity of the '272 patent based on the assertion that u-shaped neck pillows were being sold in the United States more than three years prior to the registration of the '272 patent. This counterclaim will be dismissed as moot.

2. False marking

Wal-Mart seeks summary judgment on its counterclaim for false marking, alleging that Douglas has falsely marked his advertisements for the "3rd Hand Auto Control Pillow," and the "Pleasurable Neck Pillow" with the '272 patent registration number, in violation of 35 U.S.C. § 292. Wal-Mart argues that neither of these devices falls within the claims of the '272 patent.

Douglas moves to dismiss Wal-Mart's counterclaim, contending that his patent encompasses many different materials and methods of assembling the device, and he has therefore properly labeled his devices with the '272 patent registration

number.

Under federal law, patent mismarking is a criminal offense. 35 U.S.C. § 292; Boyd v. Schildkraut Giftware Corp., 936 F.2d 76, 79 (2d Cir. 1991). "The statute is enforceable by a qui tam remedy, enabling any person to sue for the statutory penalty and retain one-half of the recovery." Boyd, 936 F.2d at 79. False marking is established when "an unpatented article is marked with the word 'patent' or any word or number that imports that the article is patented, and such marking is for the purpose of deceiving the public." Clontech Laboratories, Inc. V. Invitrogen Corp., 406 F.3d 1347, 1351 (Fed. Cir. 2005).

Intent to deceive the public must be established to find a violation of § 292. See Boyd, 936 F.2d at 79; Mayview Corp. V. Rodstein, 620 F.2d 1347, 1359 (9th Cir. 1980); FMC Corp. v. Control Solutions, Inc., 369 F. Supp.2d 539, 584 (E.D.Pa. 2005) ("A claim for false marking fails absent evidence of an actual intent to deceive."). In its counterclaim complaint, Wal-Mart alleged that Douglas falsely marked an unpatented article with the intent to deceive the public. Douglas moved to dismiss this counterclaim, and Wal-Mart responded that Douglas' statement "in open Court that he is experienced in intellectual property litigation," (Def.'s Mot. Summ. J. 33.), shows his intent to deceive the public. Even viewed in the light most favorable to Wal-Mart, Wal-Mart's allegations are insufficient to state a

claim for false marking, and this claim will be dismissed without prejudice. See Clontech, 406 F.3d at 1352-53 (liability under § 292 only ensues if plaintiff can show defendant did not have a reasonable belief that the articles were properly marked).

IV. ATTORNEYS' FEES AND COSTS

Wal-Mart requests attorneys' fees and costs under the Patent Act, the Lanham Act, and the Copyright Act, due to the "objective unreasonableness of the claims that Douglas has asserted, and the bad faith litigation tactics he has employed." (Def.'s Mot. Summ. J. 35.) Douglas contests the allegations of bad faith and unreasonableness.

Although it is a close issue, given that the litigation is now at an end and Douglas was proceeding pro se, the request for attorneys' fees will be denied.⁸

V. CONCLUSION

For the reasons set forth above, summary judgment will be granted to Wal-Mart on Douglas' claims for patent infringement, copyright infringement, false advertising, trade dress infringement, state and common law unfair competition, and trademark infringement.

Wal-Mart's counterclaim for a declaratory judgment of

⁸ Douglas also requests attorneys' fees and costs, which will be denied.

non-infringement and the invalidity of the '272 patent will be dismissed as moot. Wal-Mart's counterclaim for false marking will be dismissed without prejudice. Wal-Mart's request for attorneys' fees will be denied.

An appropriate order follows.

prejudice; and

4. Defendant's request for attorneys' fees and costs is **DENIED**.

It is **FURTHER ORDERED** that Plaintiff's Motions for Summary Judgment (docs. no. 19, 29) are **DENIED**.

AND IT IS SO ORDERED.

EDUARDO C. ROBRENO, J.

