

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. SACV 20-101 JVS (DFMx) Date January 6, 2021

Title Zadro Products, Inc. v. Feit Electric Company, Inc.

Present: The **James V. Selna, U.S. District Court Judge**
Honorable

Lisa Bredahl

Not Present

Deputy Clerk

Court Reporter

Attorneys Present for Plaintiffs:

Attorneys Present for Defendants:

Not Present

Not Present

Proceedings: [IN CHAMBERS] Order Regarding Motion for Partial Summary Judgment

Before the Court is Defendant Feit Electric Company, Inc.’s (“Feit”) motion for partial summary judgment. Mot., ECF No. 92. Plaintiff Zadro Products, Inc. (“Zadro”) filed an opposition. Opp’n, ECF No. 101. Feit filed a response. Reply, ECF No. 111. Zadro filed a request for oral argument. ROA, ECF No. 116.

For the following reasons, the Court **GRANTS IN PART AND DENIES IN PART** the motion.

I. BACKGROUND

The facts of this case are well known to the parties and only restated here to frame the following discussion. On January 17, 2020, Zadro sued Feit for patent infringement alleging that Feit has infringed on two of Zadro’s patents: United States Patent No. 8,162,502 (“the ’502 Patent”) and United States Patent No. 8,356,908 (“the ’908 Patent”). Compl., ECF No. 1 ¶ 1. Zadro alleges that one of Feit’s products, the Enhance Rechargeable LED Vanity Mirror (model number VRM-1), infringes at least claims 1–9, 18, and 22–23 of the ’502 Patent under 35 U.S.C. § 271(a). *Id.* ¶ 18. Zadro also alleges that the Enhance Rechargeable LED Vanity Mirror infringes at least claims 28–32 of the ’908 Patent under 35 U.S.C. § 271(a). *Id.* ¶ 24. The Enhance Rechargeable LED Vanity Mirror was sold exclusively in 2019. Singh Declaration, ECF No. 91-8.

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II. LEGAL STANDARD

Summary judgment is appropriate where the record, read in the light most favorable to the nonmovant, indicates “that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); see also Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986). Summary adjudication, or partial summary judgment “upon all or any part of [a] claim,” is appropriate where there is no genuine dispute as to any material fact regarding that portion of the claim. Fed. R. Civ. P. 56(a); see also Lies v. Farrell Lines, Inc., 641 F.2d 765, 769 n.3 (9th Cir. 1981) (“Rule 56 authorizes a summary adjudication that will often fall short of a final determination, even of a single claim”) (internal quotation marks omitted).

Material facts are those necessary to the proof or defense of a claim, and are determined by referring to substantive law. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). In deciding a motion for summary judgment, “[t]he evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor.” Anderson, 477 U.S. at 255.¹

The moving party has the initial burden of establishing the absence of a material fact for trial. Anderson, 477 U.S. at 256. “If a party fails to properly support an assertion of fact or fails to properly address another party’s assertion of fact . . . , the court may . . . consider the fact undisputed.” Fed. R. Civ. P. 56(e)(2). Furthermore, “Rule 56[(a)]² mandates the entry of summary judgment . . . against a party who fails to make a showing sufficient to establish the existence of an element essential to that party’s case, and on which that party will bear the burden of proof at trial.” Celotex Corp., 477 U.S. at 322. Therefore, if the nonmovant does not make a sufficient showing to establish the elements of its claims, the Court must grant the motion.

¹ “In determining any motion for summary judgment or partial summary judgment, the Court may assume that the material facts as claimed and adequately supported by the moving party are admitted to exist without controversy except to the extent that such material facts are (a) included in the ‘Statement of Genuine Disputes’ and (b) controverted by declaration or other written evidence filed in opposition to the motion.” L.R. 56-3.

² Rule 56 was amended in 2010. Subdivision (a), as amended, “carries forward the summary-judgment standard expressed in former subdivision (c), changing only one word — genuine ‘issue’ becomes genuine ‘dispute.’” Fed. R. Civ. P. 56, Notes of Advisory Committee on 2010 amendments.

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III. DISCUSSION

Feit presents two arguments for why partial summary judgment is proper. First, Feit contends that Zadro is precluded from recovering pre-filing damages because Zadro's response to an interrogatory asserts only the provision of actual notice provided to Feit by the filing of the complaint and not constructive notice through marking. Mot. at 7-8. Second, Feit contends that Zadro's pre-filing marking practices do not comply sufficiently with 35 U.S.C. § 287(a). The Court addresses each argument in turn.

A. Interrogatory Response

Feit first argues that Zadro's failure to previously state that it provided constructive notice to Feit of the patents through marking precludes Zadro from relying on such a theory now, thereby preventing recovery. Mot. at 7-8. Specifically, in response to an interrogatory from Feit asking about the "manner in which [Zadro] provided actual and/or constructive notice of infringement," Zadro responded that it "first provided Feit Electric of its infringement on January 17, 2020, when it filed its complaint in this matter." Zadro Second Amended Objections and Answers to Feit's First Set of Interrogatories, ECF No. 91-3, at 44-45. But Feit does not provide any reason for why this serves as a basis for summary judgment. See Mot. at 7-8. Moreover, Feit never met and conferred with Zadro about this basis for summary judgment, as is required under Local Rule 7-3. See Bunsow Email, ECF No. 102-7. The Court therefore declines to grant summary judgment on this basis.

B. Marking

The requirements for marking patented products is provided at 35 U.S.C. § 287, which provides:

Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.," together with the number of the patent, or by fixing thereon the word "patent" or the abbreviation "pat." together with an address of a posting on the Internet, accessible to the public

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without charge for accessing the address, that associates the patented article with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

Notably, however, “a patentee who never makes or sells a patented article may recover damages even absent notice to an alleged infringer” because § 287 does not apply. Arctic Cat Inc. v. Bombardier Recreational Products, Inc., 950 F.3d 860, 864 (Fed. Cir. 2020) (“Arctic Cat II”). “[C]ompliance with the marking statute, 35 U.S.C. § 287(a), is a question of fact.” Gart v. Logitech, Inc., 254 F.3d 1334, 1339 (Fed. Cir. 2001).

When filing a motion for summary judgment, “an alleged infringer who challenges the patentee’s compliance with § 287 bears an initial burden of production to articulate the products it believes are unmarked ‘patented articles’ subject to § 287.” Arctic Cat Inc. v. Bombardier Recreational Products, Inc., 876 F.3d 1350, 1368 (Fed. Cir. 2017) (“Arctic Cat I”). This is “a low bar” that is not a burden of persuasion or proof. Id. “Once the alleged infringer meets its burden of production, however, the patentee bears the burden to prove the products identified do not practice the patented invention.” Id. Whether a product “meets each limitation of the claim as construed,” and therefore practices the patent, is a question of fact. See Packet Intelligence LLC v. NetScout Systems, Inc., 965 F.3d 1299, 1306 (Fed. Cir. 2020).

1. *'908 Patent*

Feit first argues that certain Zadro mirrors – including the LOURV45, FLOURV45, LEDMV410, LEDMVRG10, and LEDV45 – practice the '908 Patent and are unmarked, therefore precluding the award of pre-filing damages. Mot. at 9-11. Zadro does not contest that the products listed above are not marked, and so does not argue that Feit has not met its burden of production. See Mot. at 10-11. Zadro instead argues that the above-listed products do not include an “illumination source including an elongated, thin, narrow strip made of a flexible material bent into an arcuately curved beam having a plurality of longitudinally spaced apart light sources protruding from a curved surface of

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said beam,” as is required for Claims 28 through 42. Opp’n at 7; 22-23. Zadro argues that those products do not include a “beam” but rather only a “band,” a term that is used in Claims 9 through 17 of the Patent. Opp’n at 23. Since the LEDs are mounted on an object that must itself wrap around another object because it is not rigid, Zadro argues, the Zadro mirrors that Feit discusses contain “bands,” not “beams,” and so do not practice Claims 28 through 42. *Id.* Feit argues, by contrast, that the mirrors do practice those claims because they use “flexible LED strips.” Mot. at 10.

The parties did not seek to construe the term “beam.” See Joint Statement, ECF No. 75, at 18. The Court therefore assumes that the word “beam” should be given its plain and ordinary meaning. A beam is defined as “any of various relatively long pieces of metal, wood, stone, etc., manufactured or shaped especially for use as rigid members or parts of structures or machines.” “Beam,” Dictionary.com (last visited December 17, 2020);³ see also “Beam,” Cambridge Dictionary (last visited December 17, 2020)⁴ (“a long, thick piece of wood, metal, or concrete, especially used to support weight in a building or other structure”). These definitions suggest that the ability of the structure to stay rigid and support the weight of the LEDs on its own might make the difference between whether it should be considered a “beam.” As such, they convince the Court that there is at least a material issue of fact as to whether the above-listed products practice the ’908 Patent.

Feit argues that products that Zadro has accused in other cases of infringing the “beam” claims of the ’908 Patent have used structures similar to those in the products that Feit brings to the Court’s attention. Reply at 8-12. As such, Feit contends, even Zadro has previously argued that structures like the one used in its products count as “beams.” But even if the Court were to accept that the “beams” in the other cases’ accused products are in all relevant aspects the same as the “beams” in the Zadro products that Feit brings to the Court’s attention, Zadro’s arguments in those cases do not show that no reasonable jury could agree with Zadro’s position here. As noted above, the plain and ordinary meaning of the word “beam” supports Zadro’s argument here. As such, because there is a genuine issue of material fact as to whether the above-listed products practice the ’908 Patent, the Court **DENIES** the motion with respect to the ’908 Patent.

³ <https://www.dictionary.com/browse/beam>.

⁴ <https://dictionary.cambridge.org/us/dictionary/english/beam>.

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2. '502 Patent

Feit next argues that Zadro mirrors that practice the '502 Patent do not have marks on them that comply with the requirements of § 287(a). The parties agree that Zadro practices the '502 Patent. See Opp'n at 4; Reply at 3 n.2. The parties also agree that Zadro does not mark the practicing mirrors themselves. See Mot. at 12-13; Opp'n at 11. The key dispute between the parties is whether Zadro's marks on the packaging of the practicing products satisfy § 287(a). See Mot. at 12-15; Opp'n at 11-18.

As noted earlier, § 287(a) requires that a product itself be marked unless "from the character of the article, this can not be done." "[S]ubstantial compliance may be found to satisfy the [marking] statute." Global Traffic Technologies LLC v. Morgan, 620 Fed. Appx. 895, 905 (Fed. Cir. 2015) (alteration in original) (quoting Maxwell v. J. Baker, 86 F.3d 1098, 1111 (Fed. Cir. 1996)). No set list of factors can be used to determine whether the "character" of the product makes marking the packaging of the product permissible. Id. at 905-906. Some factors might include the size of the product, whether what is patented is a machine or a multi-part system, and whether the product is immediately installed out of public view once unpackaged. Id. at 905.

The Court concludes that no reasonable jury would find that Zadro properly marked the products that practiced the '502 Patent. Feit's strongest argument that Zadro did not adequately mark products that practice the '502 Patent is that some of them are marked with "patent pending" on the base of the mirror, molded into the battery case cover. Mot. at 13; see Hand Decl., Ex. 7, ECF No. 92-9, at Images 12-15 (LEDMV410); Ex. 11, ECF No. 92-13, at Images 10, 12 (LEDMVRG10); Ex. 12, ECF No. 92-14 at Image 12 (LEDV45); Ex. 13, ECF No. 92-15, at Images 10-11 (LEDSV410); Ex. 14, ECF No. 92-16 at Image 12 (LEDW410). Indeed, Feit calculates that as many as 85% of the mirrors sold in 2019 that Zadro admits practice the '502 Patent were marked "patent pending" on the battery case cover. Hand Decl., ECF No. 110-3, ¶¶ 2-6. Labeling a product with "patent pending" makes it readily apparent that the character of the product does not make it so that a proper mark "can not" be affixed to the product. 35 U.S.C. § 287(a). A "patent pending" mark also indicates that a patent has not yet issued, and "gives one no knowledge whatsoever." State Industries, Inc. v. A.O. Smith Corp., 751 F.2d 1226, 1236 (Fed. Cir. 1985). It is therefore insufficient that Zadro marked the packaging for its products with the patent number, for the products could be marked themselves, and marks on the products even suggested that they were not patented.

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Zadro relies heavily on Denneroll Holdings Pty Ltd. v. ChiroDesign Group, LLC, 2016 WL 705207 (S.D. Tex. Feb. 23, 2016), to argue that marking the packaging of the mirrors is sufficient, but the Court disagrees with Denneroll's reasoning. First, Denneroll implies that what is primarily important is for the public to be able to view the patent number when it encounters the product in a store. 2016 WL 705207, at *9 (“By placing the patent marking on the packaging of the Cervical Denneroll device, Denneroll’s patent rights are placed in plain view of the consuming public at the point at which the public encounters the product.”). But if all that was important was that a consumer view the patent number when she encounters the product in the store, marking a package would be the preferred method under § 287(a). After all, many products are not visible within their packaging, and so marking the product itself would be totally ineffectual in alerting the consumer walking through a store of the patent even if the product’s character allowed it. Denneroll therefore places undue emphasis on the perspective of the store customer.

Second, Denneroll suggests that if a product is used in the home, then it is not “in public view,” and therefore marking a product’s package is more appropriate. Id. at *9 (citing Global Traffic, 620 Fed. Appx. at 906). Zadro uses this line of reasoning to argue that because Zadro’s mirrors are intended for use in the home, marking the packaging is appropriate. Opp’n at 13-14. But this argument relies on Denneroll's mistaken reading of Global Traffic, which was not addressing a product that was used in the home. Rather, that case dealt with a system that would change traffic signals when it detected that emergency vehicles were approaching the intersection where it was installed. Global Traffic, 620 Fed. Appx. at 897. The system was installed inside a “traffic control cabinet” often “mounted on top of a mast arm or a pole that the signal lights are hanging on.” Id. at 906. The system was not “in public view” because it was placed inside a private residence. Rather, the system was not “in public view” because individuals could use the system without physically interacting with it. The logic in Global Traffic was that marks on products that are immediately installed such that people do not routinely physically interact with them are ineffectual because people will spend very little time looking at the product itself. Id. Rather, people will likely spend more time looking at the package before installation, meaning that marking of the package is more effective in providing constructive notice. Id.

Such is not the case for products that are used around the home. Consider the mirrors at issue in this case. Zadro’s advertising encourages consumers to use its vanity mirrors “in any room of the house.” Zadro Holidays: Gift for Her, ECF No. 102-6. It is

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easy to imagine that a guest to a house might see this product in a friend's living room, bathroom or "even [on] the kitchen table" and decide she wants to replicate it. Id. Alternatively, a consumer might decide that she wants to replicate a patented product well after having opened the product's package. Having a mark on the package alone in such circumstances is substantially less effective, or possibly wholly ineffective, in providing notice to the potential infringer.

This is why Stryker Corp. v. Zimmer Inc., 2012 WL 6821683 (W.D. Mich. Nov. 29, 2012), another case that Zadro relies heavily on, does not reflect the marking preferences embodied in § 287(a). Contra id. at *3 ("Since all InterPulse and Surgilav Plus devices are sold in their packaging and are not taken out of their packaging until use, marking the packaging guarantees that the user will come in contact with the patent information just as surely as would marking the product."). While the Court agrees with Stryker that the test for whether a package can be marked is not if marking the product itself would be "effectively impossible," the analysis cannot merely be that marking the packaging likely gives any purchaser notice and so satisfies the requirements of § 287(a).⁵ Such an analysis fails to explain why § 287(a) prefers that marks be made on the product instead of the packaging, particularly where that is feasible.

As such, Zadro's argument that "all that Zadro needed to do was to mark the packaging" is insufficient. See Opp'n at 14. Zadro also argues that it was permissible to mark the packaging alone because Zadro's competitors do the same. See Opp'n at 14-16. But no case suggests that this fact alone is sufficient to satisfy § 287(a). If that were so, industries could effectively opt out of § 287's for no reason. Cf. Stryker, 2012 WL 6821683, at *3 (noting practicalities such as cost and removal of the patent mark that justify the industry practice of not marking). Zadro provides no further reason for why Zadro and its competitors could not mark the products themselves.

Finally, Zadro makes an argument that it complied with § 287(a) by including the

⁵ Zadro argues in its Request for Oral Argument that in reaching this conclusion the Court is "draw[ing] upon both the majority and the minority legal standards for marking the packaging of a patented article." ROA at 1 (citing Stryker, 2012 WL 6821683, at *3). This is what the Court is doing, for the Court concludes that neither the permissive "majority" approach nor the strict "minority" approach accurately reflects the marking preferences stated in § 287(a). The Court is instead reaching a simple conclusion that a product labeled "patent pending" necessarily has a character such that a proper mark can be affixed to it.

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URL for Zadro’s website, which notes the ’502 Patent, on the packaging of the mirrors. Opp’n at 16-17. But since all “virtual markings” are on the packaging and not on the product itself, the above analysis applies. As such, the Court concludes that Zadro cannot collect damages for infringement of the ’502 Patent before the filing of the complaint. The Court therefore **GRANTS** the motion with respect to the claims for infringement of the ’502 Patent. Having granted the motion, the Court does not address Feit’s arguments with respect to the Frontgate mirrors that were sold wholly unmarked. Mot. at 12-13. The Court also does not address Zadro’s argument that Feit should be precluded from filing further motions for summary judgment, see Opp’n at 23-25, because the Court grants in part this motion.

IV. CONCLUSION

For the foregoing reasons, the Court **GRANTS IN PART AND DENIES IN PART** the motion. Having considered Zadro’s request for oral argument, the Court concludes that arguments were sufficiently addressed in the briefing papers. Zadro’s request for oral argument is therefore **DENIED**.

IT IS SO ORDERED.

Initials of Preparer

_____ : _____
lmb