

**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

PATENT HOLDER IDENTIFIED IN
EXHIBIT 1,

Plaintiff,

v.

THE INDIVIDUALS,
CORPORATIONS, LIMITED
LIABILITY COMPANIES,
PARTNERSHIPS, AND
UNINCORPORATED ASSOCIATIONS
IDENTIFIED ON SCHEDULE A TO
THE COMPLAINT,

Defendants

No. 24-cv-11094

Judge Jeremy C. Daniel

ORDER

The plaintiff's motion for a temporary restraining order [7] is denied. The plaintiff's motion to seal [9], which the plaintiff premised on the issuance of a TRO, is also denied.

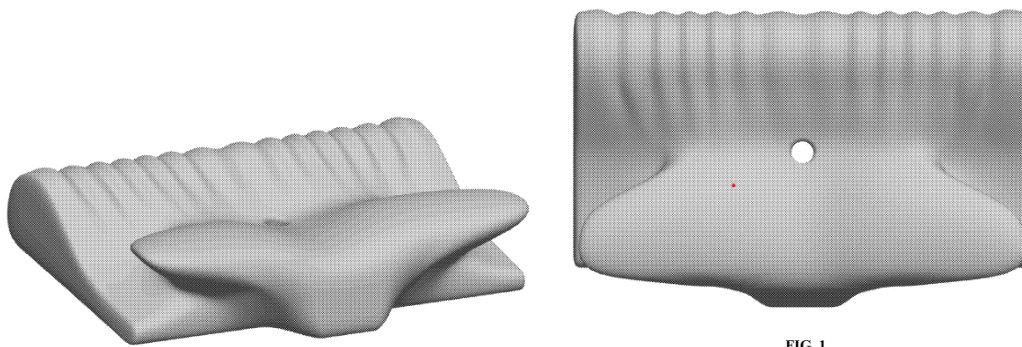
STATEMENT

The plaintiff seeks an *ex parte* TRO against seven defendants based on the defendants' alleged infringement of the plaintiff's design patent. "A party may obtain a [temporary restraining order] by showing that (1) it is 'likely to succeed on the merits,' (2) it is 'likely to suffer irreparable harm in the absence of preliminary relief,' (3) the 'balance of equities tips in [its] favor,' and (4) 'an injunction is in the public interest.'" *BlephEx, LLC v. Myco Indus., Inc.*, 24 F.4th 1391, 1398 (Fed. Cir. 2022).

Here, the asserted patent claims an ornamental design for a pillow. At a hearing on the plaintiff's motion for a TRO, the Court asked the plaintiff to address whether the claimed ornamental features of the pillow were dictated by its function. The plaintiff's response relied primarily on the patent's presumption of validity. "But if the accused infringer presents a substantial question of validity, 'i.e., asserts an invalidity defense that the patentee cannot prove 'lacks substantial merit,' the preliminary injunction should not issue.'" *BlephEx, LLC*, 24 F.4th at 1399.

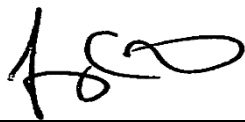
At this point, the accused infringer does not know about the lawsuit and cannot present a substantial question of validity. That does not relieve the Court of its obligation to determine whether the plaintiff has met its burden of showing it is likely to succeed on the merits. And it does not relieve the plaintiff of answering questions raised by the Court concerning the merits of the plaintiff's motion. It only seems fitting that one seeking extraordinary relief be held to its burden. To that end, the Court asked questions about functionality and the plaintiff asked for time to file a supplemental brief addressing functionality. That deadline came and went without the plaintiff filing anything.

With that record, the plaintiff has not met its burden of showing a likelihood of success on the merits. "Valid design patents cannot be directed to designs that are primarily functional, as opposed to ornamental." *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 80 F.4th 1363, 1380 (Fed. Cir. 2023), cert. denied, 144 S. Ct. 2563 (2024). "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 the patent." *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016)(citation omitted). Here is what the asserted patent shows:



The dominant feature of this design is the raised, broad, flattened area shaped like a whale's tail. That appears to be where one would lay one's head, with the curve helping one stay positioned on that raised area. Where one positions one's head on a pillow and that pillow's ability to maintain that position seems inherently functional, or at least raises a substantial question of functionality that, despite an invitation and the time to do so, the plaintiff failed to address. Therefore, the Court finds that the plaintiff has not shown a likelihood of success on the merits because it failed to address functionality, which precludes the issuance of a TRO.

Date: November 19, 2024


 JEREMY C. DANIEL
 United States District Judge