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

Marvellous Day Electric (S.Z.) Co., Ltd.,

Plaintiff(s),

v.

Holiday Bright Lights, Inc., et al,

Defendant(s).

Case No. 11-cv-8768
Judge John J. Tharp

ORDER

For the reasons set forth in the Statement below, the Defendants' motion for summary judgment [123] on Count I of the Plaintiff's First Amended Complaint [56] is granted. All other claims having previously been dismissed with prejudice, judgment is entered in favor of the Defendants and the case is terminated. Enter Judgment Order.

STATEMENT

Defendants Holiday Bright Lights, Inc., and Richard Martini (collectively, "Defendants") have moved under Fed. R. Civ. P. 56 for summary judgment on Plaintiff Marvellous Day's ("MD") claim for design patent infringement (Count I of the First Amended Complaint). On December 9, 2011, MD sued Defendants for, among other things, infringement of U.S. Design Patent No. D627,494 ("the '494 Patent"). On December 16, 2011, HBL requested ex parte reexamination in the PTO. The United States Patent and Trademark Office ("PTO") granted the reexamination on February 27, 2012, and on October 2, 2012, this Court stayed further proceedings on Count I pending the PTO's reexamination.

The PTO issued non-final rejections on June 29, 2012, and March 14, 2013, followed by a final rejection on May 22, 2014. MD did not appeal this determination and has advised the Court that it does not wish to respond to the Defendants' summary judgment motion. (Indeed, MD moved orally to dismiss the case, but the Defendants objected to a voluntary dismissal under Rule 41 out of concern that it would not have the preclusive effect a judgment would afford).

The only patent alleged to have been infringed by the Defendants having been found invalid by the PTO, summary judgment in favor of the Defendants is required. "It is axiomatic that one cannot infringe an invalid patent." Commil USA, LLC v. Cisco Systems, Inc., 720 F.3d 1361, 1368 (Fed. Cir. 2013) (citing Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1580 (Fed. Cir. 1983) ("The claim being invalid there is nothing to be infringed.")). The legal conclusion is the same regardless of whether a court or the PTO declares the claim invalid. Indeed, one of the purposes of patent reexamination is to "eliminate trial of [claim validity when] the claim is canceled." Gould v. Control Laser Corp., 705 F.2d 1340, 1342 (Fed. Cir. 1983). When a patent suit is stayed pending reexamination and the PTO cancels the alleged claim, "the patentee loses

any cause of action based on that claim, and any pending litigation in which the claims are asserted becomes moot." Id.

Accordingly, the Court enters summary judgment on Count I in favor of the defendants.

Date: 8/20/2014

/s/ John J. Tharp, Jr.
United States District Court Judge