

2018-1904

---

---

**United States Court of Appeals  
for the Federal Circuit**

---

HAFCO FOUNDRY AND MACHINE COMPANY, INCORPORATED,

*Plaintiff-Appellee,*

– v. –

GMS MINE REPAIR AND MAINTENANCE, INC.,

*Defendant-Appellant.*

---

---

*On Appeal from the United States District Court for the Southern  
District of West Virginia in Case No. 1:15-cv-16143  
The Honorable David A. Faber*

---

---

**COMBINED PETITION FOR PANEL REHEARING AND FOR  
REHEARING *EN BANC* BY APPELLANT GMS MINE  
REPAIR AND MAINTENANCE, INC.**

JAMES R. LAWRENCE, III  
ANTHONY J. BILLER  
MICHAEL BEST AND FRIEDRICH LLP  
2501 Blue Ridge Road, Suite 390  
Raleigh, NC 27607  
(984) 220-8750  
jrlawrence@michaelbest.com  
ajbiller@michaelbest.com

*Counsel for Defendant-Appellant*

APRIL 15, 2020

## CERTIFICATE OF INTEREST

Counsel for Appellant, James R. Lawrence, III, certifies the following:

1. The full name of every party or amicus represented by me is:

GMS Mine Repair and Maintenance, Inc.

2. The name of the real party in interest represented by me is:

GMS Mine Repair and Maintenance, Inc.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae presented by me are:

None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

MICHAEL BEST AND FRIEDRICH LLP (on appeal)

Anthony J. Biller (principal counsel)

James R. Lawrence, III (co-counsel)

GMS MINE REPAIR AND MAINTENANCE, INC.

William C. Means (in-house counsel appeared in the trial court *pro se*)

Andrew J. Ellis (in-house counsel appeared in the trial court *pro se*)

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. See Fed. Cir. R. 47.4(a)(5) and 47.5(b).

None.

Appellant is aware of no other case that will be directly affected by this Court's decision in this case.

April 15, 2020

/s/ Anthony J. Biller  
Anthony J. Biller

## TABLE OF CONTENTS

CERTIFICATE OF INTEREST .....	i
TABLE OF AUTHORITIES .....	iii
TABLE OF ABBREVIATIONS .....	v
I. COUNSEL’S STATEMENTS IN ACCORDANCE WITH FED. R. APP. P. 35(B)(2) .....	1
II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE COURT .....	3
III. THE ARGUMENT IN SUPPORT OF A PANEL REHEARING .....	3
A. The Panel Erroneously Concluded That GMS Did Not Preserve Functionality As A Claim Construction Argument At The Trial Court. ....	4
B. In Addressing Whether The Trial Court Erred In Denying GMS’ JNOV Motion Of Noninfringement, The Panel Erred By Failing To Conduct Any Infringement Analysis.....	7
IV. THE ARGUMENT IN SUPPORT OF A REHEARING EN BANC .....	15
A. <i>Egyptian Goddess’</i> Claim Construction Framework Is At Odds With Supreme Court Precedent And Produces Inconsistent Results. This Case Provides An Ideal Vehicle For Recalibrating The Analysis. ....	15
V. CONCLUSION AND RELIEF SOUGHT .....	22
ADDENDUM	
CERTIFICATE OF FILING AND SERVICE	
CERTIFICATE OF COMPLIANCE	

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>Cases</b>	
<i>Apple Inc. v. Samsung Electronics Co.</i> , 786 F.3d 983 (Fed. Cir. 2015) .....	18
<i>Contessa Food Prods. v. Conagra, Inc.</i> , 282 F.3d 1370 (Fed. Cir. 2002) .....	1, 7
<i>Egyptian Goddess, Inc. v. Swisa, Inc.</i> , 543 F.3d 665 (Fed. Cir. 2008) .....	1, 3, 15, 16, 18
<i>Ethicon Endo-Surgery, Inc. v. Covidien, Inc.</i> , 796 F.3d 1312 (Fed. Cir. 2015) .....	1, 8
<i>Gorham Co. v. White</i> , 81 U.S. 511 (1872).....	1, 20
<i>Hafco Foundry and Machine Co., Inc. v. GMS Mine Repair and Maintenance, Inc.</i> , No. 1:15-cv-16143 (S.D. W. Va. May 16, 2017), ECF No. 78 .....	5, 6
<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996).....	1, 16, 17
<i>Merrill v. Yeomans</i> , 94 U. S. 568 (1877).....	17
<i>Oddzon Prods., Inc. v. Just Toys, Inc.</i> , 122 F.3d 1396 (Fed. Cir. 1997) .....	1, 5
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc) .....	1, 17
<i>Richardson v. Stanley Works, Inc.</i> , 597 F.3d 1288 (Fed. Cir. 2010) .....	1, 18
<i>Sport Dimension v. Coleman Co.</i> , 820 F.3d 1320 (Fed. Cir. 2016) .....	1

*White v. Dunbar*,  
119 U.S. 47 (1886).....17

**Statutes**

Patent Act.....1, 20

**Other Authorities**

Christopher V. Carani, *Design Patent Functionality: A Sensible  
Solution* .....19

Christopher Buccafusco, Mark A. Lemley, & Jonathan S. Masur,  
*Intelligent Design*, 68 Duke L.J. 75, 126 (2018) .....19

FED. R. APP. P. 35(B)(2).....1

Michael J. Risch, *Functionality and Graphical User Interface Design  
Patents*.....19

## TABLE OF ABBREVIATIONS

### Parties

GMS	Defendant-Appellant GMS Mine Repair and Maintenance, Inc.
Hafco	Plaintiff-Appellee Hafco Foundry and Machine Company, Incorporated

### Patent-in-Suit

the '684 patent	U.S. Patent No. D681,684S
-----------------	---------------------------

### Defined Terms

Court	United States Court of Appeals for the Federal Circuit
district court	United States District Court for the Southern District of West Virginia, the Honorable David A. Faber presiding
Panel	Panel of the United States Court of Appeals for the Federal Circuit which issued the attached Opinion

**I. COUNSEL’S STATEMENTS IN ACCORDANCE WITH FED. R. APP. P. 35(B)(2)**

A. Based on my professional judgment, I believe the Panel decision is contrary to the following decisions of the Supreme Court of the United States and precedents of this Court:

*Gorham Co. v. White*, 81 U.S. 511 (1872)

*Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996);

*Contessa Food Prods. v. Conagra, Inc.*, 282 F.3d 1370, 1380 (Fed. Cir. 2002);

*Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312 (Fed. Cir. 2015);

*OddzOn Prods v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997);

*Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc);

*Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010);

*Sport Dimension v. Coleman Co.*, 820 F.3d 1320 (Fed. Cir. 2016).

B. Based on my professional judgment, I believe this appeal requires an answer to the following question of exceptional importance:

Whether granting trial courts broad discretion to do design patent claim construction in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008), is consistent with the Patent Act, *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), and other precedents of this Court.

/s/ Anthony J. Biller

Anthony J. Biller  
Principal Counsel

/s/ James R. Lawrence, III

James R. Lawrence, III  
Co-counsel

MICHAEL BEST & FRIEDRICH, LLP  
2501 Blue Ridge Road, Suite 390  
Raleigh, NC 27607  
Telephone: (984) 220-8750  
ajbiller@michaelbest.com  
jrlawrence@michaelbest.com



## **II. POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE COURT**

A. The Panel erroneously concluded that GMS did not preserve functionality as a claim construction argument at the trial court.

B. In addressing whether the trial court erred in denying GMS' motion for judgment as a matter of law of noninfringement, the Panel erred by failing to conduct any infringement analysis.

## **III. THE ARGUMENT IN SUPPORT OF A PANEL REHEARING**

The Panel held that GMS could not contest on appeal whether or to what extent functionality cabins the claim scope of the '684 patent because the issue was not raised at trial and preserved for appeal. Hafco did not raise this argument at all in its appellee brief, and for good reason. Nonetheless, since the argument was not raised, GMS did not address it in its brief nor did GMS compile the record accordingly. In fact, the argument was pursued at the district court, but the district court refused to enter a claim construction order that addressed the functional elements of the '684 patent. As addressed below, the district court's failure to explicate the functional limitations of patent's claim scope appears permissible under this Court's holding in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc), but the issue was preserved and fairly presented for the Panel's resolution. Finally, the Panel's analysis fails to resolve the question of infringement. If the Panel's analysis is correct, and the district court's claim

construction remains, the noninfringement analysis should still lead to the same noninfringement result.

**A. The Panel Erroneously Concluded That GMS Did Not Preserve Functionality As A Claim Construction Argument At The Trial Court.**

GMS argued at length in its appellate brief that the trial court erred by failing to take functionality or prior art into consideration when trying the issue of infringement. It was and remains GMS' conviction that the GMS device does not infringe the '684 patent as a matter of law. This of course presumes the patent is properly construed or not applied too broadly in the infringement analysis. It is undisputed that beyond having an industrial drum as the body, with a lid and a frustoconical legged stand, every detail between the GMS' accused device and the design claimed in the '684 patent is different.

The Panel sidestepped the infringement analysis, stating GMS did not argue at the district court that functional aspects should have been excluded from the infringement analysis and that GMS did not challenge the district court's claim construction ruling on appeal. In the Panel's words, "[b]ecause GMS never made this non-infringement argument at the district court, nor presented relevant evidence on the functional aspects of the '684 patent to the jury, GMS has not preserved this argument for appeal." (Opinion at 6-7.)

The Panel’s analysis is factually and legally inaccurate. Prior to trial, GMS moved the district court, *inter alia*, to construe the ’684 patent to take into account the functionality of the ’684 patent design. GMS specifically argued that, in construing the claims, the court was required to “*distinguish[] 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) . . . .*” (Appx160 (emphasis in original).)

The district court denied the motion for a claim construction that took the functional elements into consideration, ruling “the court construes the claim as follows: ‘The ornamental design for a rock dust blower, as shown and described in Figures 1-5.’ ” (Appx323.) Thereafter, the district court granted a motion by Hafco *prohibiting* GMS from introducing evidence of functionality for purposes of explicating the scope of the ’684 patent. The district court explained that claim construction was the province of the court, not the jury. *Hafco Foundry and Machine Co., Inc. v. GMS Mine Repair and Maintenance, Inc.*, No. 1:15-cv-16143 (S.D. W. Va. May 16, 2017), ECF No. 78 at 1-2 (Appx1200 -1201 (Supp).)<sup>1</sup> Critical to the Panel’s ruling that GMS failed to introduce evidence of functionality

---

<sup>1</sup> Citations to Appx1200 – 1218 (Supp) are found in GMS’s motion filed herewith to supplement the joint appendix. These district court filings were not filed with the original appendix because neither party cited to them. Neither party cited to them because the issue of whether GMS failed to reserve or otherwise waived the functionality of the ’684 Patent claims was not argued by the parties in their briefing.

for the jury's consideration is the fact GMS was *prohibited* from presenting argument or such evidence to the jury regarding the functionality of the rock dust blower shown in '684 patent. In its motion for judgment as a matter of law, GMS reminded the district court again that infringement must be based on ornamental and not functional similarities. *Hafco Foundry and Machine Co., Inc. v. GMS Mine Repair and Maintenance, Inc.*, No. 1:15-cv-16143 (S.D. W. Va. June 14, 2017), ECF No. 94, ¶ 12 (Appx1206 -1207 (Supp.)) GMS also pointed out that it was greatly prejudiced by the court's order precluding GMS from presenting evidence about functionality for purposes of infringement. (*Id.*)

GMS appealed the issue of whether GMS was entitled to judgment as a matter of law on the issue of infringement. GMS argued fairly extensively regarding proper construction of the '684 patent that should take place as part of the infringement analysis and that every detail between the patented and accused designs differ. (GMS Br. at 14-30.) In its response brief Hafco did not argue that these arguments were not made at the district court and did not claim the issue was waived or otherwise not preserved.<sup>2</sup>

Finally, the Panel's analysis does not avoid the necessity of identifying the protectable elements of the '684 patent design. The district court held that the

---

<sup>2</sup> At oral argument, the Panel inquired about whether GMS presented functionality arguments to the jury. However, since Hafco never claimed that GMS waived such arguments, GMS did not include the aforementioned motion in limine and related order in the record and was unprepared to cite to the same.

patent covered the ornamental design shown in the drawings. This claim construction leads to the same analysis GMS offered—an identification of ornamental versus functional elements. GMS believes this should have been provided to the jury. Even here, the ornamental elements must be identified, even under the district court’s claim construction. This Court should address the substance of GMS’ appeal, and find that GMS’ device does not infringe the ‘684 patent as a matter of law.

**B. In Addressing Whether The Trial Court Erred In Denying GMS’ JNOV Motion Of Noninfringement, The Panel Erred By Failing To Conduct Any Infringement Analysis.**

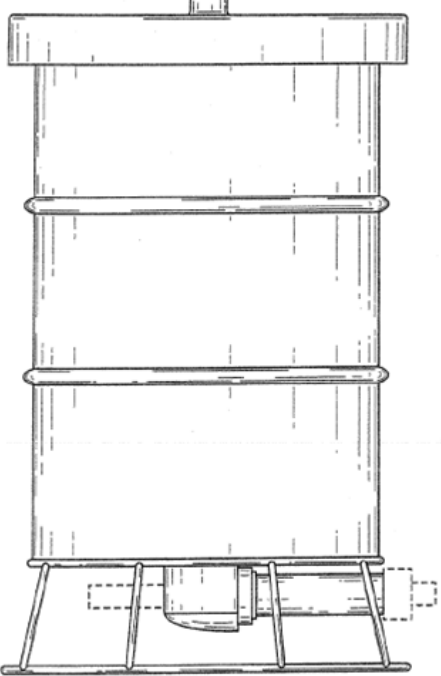

GMS appealed whether it was entitled to judgment as a matter of law on the issue of infringement. The Panel held that GMS had not properly preserved arguments about how the ‘684 patent ought to be construed as part of that analysis. Even assuming *arguendo* this was true, the issue remains whether GMS was entitled to judgment as a matter of law on the issue of infringement. The Panel’s precedent regarding the appropriate analysis is clear, “the comparison must extend to all ornamental features visible during normal use of the product.” *Contessa Food Prods. v. Conagra, Inc.*, 282 F.3d 1370, 1380 (Fed. Cir. 2002). In this case, all of the ornamental features were not compared. Indeed, the Court did not analyze any of the features. Notwithstanding GMS’s argument above that it had made and preserved its claim construction arguments, at the very least, the Court

should apply the district court's claim construction and analyze the issue of infringement. "[T]he court construe[d] the claim as follows: 'The ornamental design for a rock dust blower, as shown and described in Figures 1-5.'" (Appx323.) This Court should at the very least apply that claim construction against the GMS device by comparing the ornamental designs *as shown and described in Figures 1-5* against GMS' device.

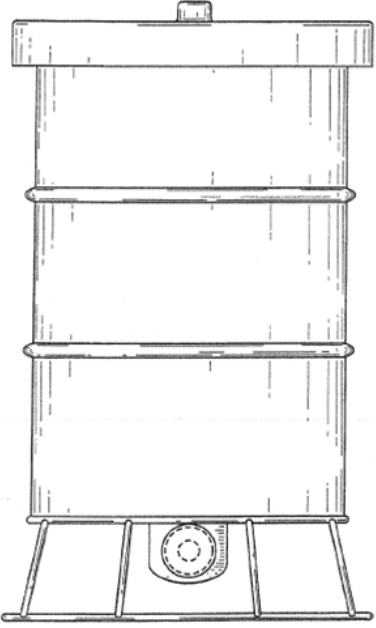

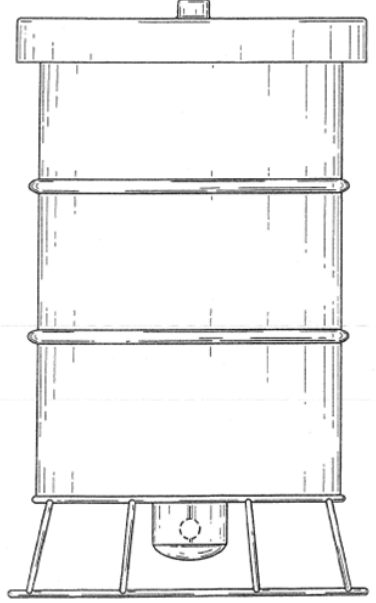

As previously explained, Hafco's design and the GMS product are plainly dissimilar when the "ornamental designs" are compared. At first glance, at a general conceptual level, there are similarities between the '684 patent and GMS' rock dust blower. As this Court previously explained, however, conceptual similarity is insufficient for design patent infringement. *Ethicon Endo-Surgery Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1336 (Fed. Cir. 2015). Here, when comparing the ornamental designs of the '684 patent, as a whole, against the GMS design, the designs are plainly dissimilar from every vantage point.

The '684 patent extends protection to ornamental aspects of Hafco's 55-gallon drum. Unfortunately for Hafco, none of Hafco's ornamental design features are found in GMS' device. Each and every ornamental element is different.

Hafco's patented design and GMS' accused product are shown below from the left, front, and rear elevations views, respectively.<sup>3</sup>

The '684 patent	GMS' Accused Rock Dust Blower
 <p data-bbox="462 1123 544 1155">FIG. 1</p>	

<sup>3</sup> At trial, GMS' accused rock dust blower was admitted into evidence. (Appx400.) The appellate record here contains pictures of the device admitted into evidence. (Appx1150-1154.)

The '684 patent	GMS' Accused Rock Dust Blower
 <p data-bbox="451 892 522 934">FIG. 2</p>	
 <p data-bbox="451 1606 522 1648">FIG. 3</p>	

(Appx90-92, Appx1150-1152.) Starting at the top, each design includes a lid. As Hafco explained in its concomitant utility patent, the purpose of the lid is “to



prevent the admission of unwanted debris.” (Appx173, col. 3, ll. 33-35.) Thus, the concept of a lid is functional and not protectable, while ornamental, non-functional aspects of the lids may be. Here, the lids are ornamentally different. Hafco’s lid has a small circular piece that sticks up in the center. The lid sits atop the 55-gallon drum. Its diameter is wider than the diameter of the 55-gallon drum. The edge features a thick, flat lip. The GMS lid, meanwhile, is a standard 55-gallon drum lid. The edge of the GMS lid is not squared. It does not have the larger diameter or the center-positioned circular element shown in the Hafco lid. The edge is narrow and curved.

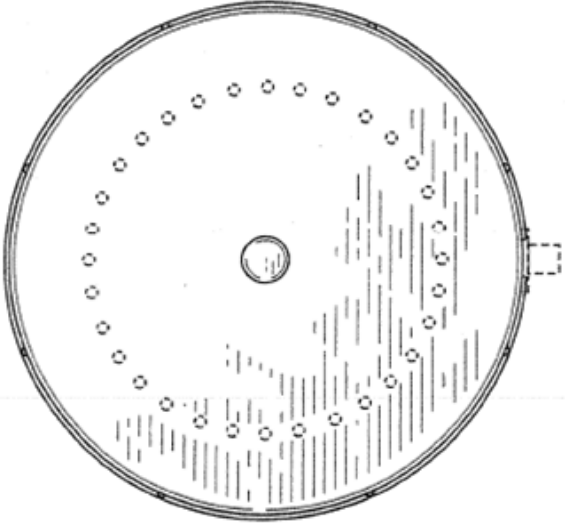

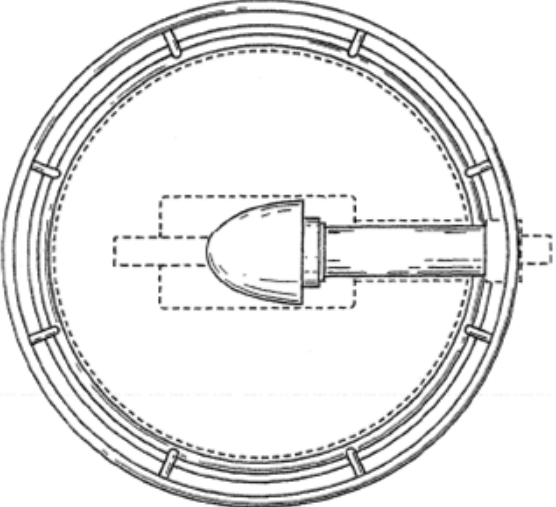

The design elements of the drums differ. Each drum includes ribs. The designs, however, use a different number of ribs. Hafco’s design uses two ribs. GMS’ design includes three ribs. Because of the difference in the number of ribs, the spacing of the ribs along the length of the drum is also noticeably different between the designs. GMS’ drum also features two fluorescent strips running parallel to two of the drum’s ribs. That ornamental feature is entirely absent from the ’684 patent. The GMS device features a prominent box element integral to and extending prominently from the side of the drum. The Hafco design has no such element.

Moving to the elements attached to the drums, both designs have stands that hold the drums. Hafco’s design utilizes a stand with an eight-leg design. GMS’

design, in contrast, uses six legs. Due to the different number of legs, the spacing between legs is also different. The circular base that makes contact with the ground is rounded in the '684 patent. GMS' circular base is flat. The legs in the '684 patent attach at the outer edge of the circular, rounded base. The legs on GMS' product attach on the top surface of the circular, flat base.

Each design includes piping for compressed air intake and rock dust output. The designs, however, place the pipes differently. All of Hafco's piping sits underneath the 55-gallon drum. By contrast, GMS' design includes piping that makes a 90 degree turn from the bottom of the 55-gallon drum, runs along the side of the drum to a position above the first rib, and then makes a second 90 degree turn. GMS' piping is further connected to a square housing integral to the drum, placed slightly over the first rib from the bottom. The '684 patent claims no such housing.

Additional visual differences between the '684 patent and GMS' rock dust blower are apparent from the top and bottom plan views of the two designs, which are shown below.

The '684 patent	GMS' Accused Rock Dust Blower
 <p data-bbox="451 856 540 909">FIG. 4</p>	
 <p data-bbox="418 1528 508 1581">FIG. 5</p>	

(Appx93-94, Appx1153-1154.) Beginning with the top view, the lid in the Hafco design contains a single circular element in the center of the lid. The top surface of the circular element in the '684 patent is flat. By contrast, GMS' lid contains two circular elements, each with different diameters. Those elements are not centered,

but rather spaced across from one another near the edge of the lid. Further, the top surfaces of both elements are uneven and sunken within the outer circumference of both elements. The surface of the claimed Hafco lid is flat. GMS' lid has a raised, rounded ridge spaced within the inner circumference of the lid. GMS' lid also features a clamp integral to the edge of the lid. The Hafco design contains no such integral clamp.

The bottom view presents other visual differences. Again, the difference between the eight legs in the '684 patent and the six legs in the GMS design is visible. The distribution of the legs along the circumference is also different in the two designs. The legs on the GMS product protrude further outside the circumference of the drum and attach to a flat base. The Hafco legs are noticeably shorter and approach perpendicular to the barrel and attach to a tubular base.

The '684 patent shows a half-egg shape that is centered on the bottom of the drum with a coupler. The coupler, which is squared, attaches to a straight pipe protruding along an axis extending to and terminating at the edge of the drum. The GMS design, by contrast, features a single sloping pipe which extends beyond the edge of the drum and terminates outside the edge of the circular base.

These differences must be viewed together, and in totality, they compel a finding of noninfringement. The district court held that the s684 patent claimed the ornamental features of the claimed duster. Even should this Court refuse to

articulate what is functional versus ornamental in the ‘684 patent design, it should still address the issue appealed—whether these substantial differences between the claimed design and GMS’s product compel a finding of noninfringement as a matter of law.

#### IV. THE ARGUMENT IN SUPPORT OF A REHEARING EN BANC

##### A. *Egyptian Goddess*’ Claim Construction Framework Is At Odds With Supreme Court Precedent And Produces Inconsistent Results. This Case Provides An Ideal Vehicle For Recalibrating The Analysis.

More than a decade ago, in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008), this Court considered en banc the question of “whether trial courts should conduct claim construction in design patent cases.” *Id.* at 679. This Court first noted that it “ha[d] not prescribed any particular form that the claim construction must take” before observing that “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.* While it is not “reversible error” for a district court “to issue a relatively detailed claim construction” like the one in *Egyptian Goddess*,<sup>4</sup> a district court “is not obligated to

---

<sup>4</sup> This Court “found no inaccuracy in the [district] court’s description” in *Egyptian Goddess*, *id.* at 680, a case where the district court offered a claim construction complete with a quantitative proportionality analysis of the nail buffer design at issue, *id.* at 668 (describing the design as, among other things, “[a] hollow tubular frame . . . with sides of length S,” a “length of approximately 3S,” and “a thickness of approximately  $T = 0.1S$ ”).

issue a detailed verbal description of the design.” *Id.*

This Court went on to provide examples of situations where written descriptions of patented designs might be helpful to a jury. Citing *Oddzon Products Inc., Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997), and quoting with apparent approval language from that case that “the scope of the claim must be construed in order to identify the non-functional aspects of the design,” this Court said it would be appropriate for a district court to “distinguish between those features of the claimed design that are ornamental and those that are purely functional.” *Id.* at 680. Ultimately though, this Court punted the “question of verbal characterization of the claimed designs to the discretion of trial judges, with the proviso that as a general matter, those courts should not treat the process of claim construction as requiring a detailed claim construction.” *Id.*

Supreme Court precedent requires district courts to construe patents. In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), the Supreme Court held that patent claim construction is a legal question for a judge, not a jury. *Id.* at 391. In reaching that conclusion, the Supreme Court emphasized “the importance of uniformity in the treatment of a given patent” that judge-led claim construction facilitates. *Markman*, 517 U.S. at 390. Without uniformity, “a zone of uncertainty” from “the risk of infringement claims would discourage invention.” *Id.* (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228, 236 (1942)).

At the same time, the public would lose “rights supposed to belong to it, without being clearly told what it is that limits these rights.” *Id.* (quoting *Merrill v. Yeomans*, 94 U. S. 568, 573 (1877)). This Court and the Supreme Court have made very clear in the utility patent context that patent claims “are ‘of primary importance, in the effort to ascertain precisely what it is that is patented.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (quoting *Merrill*, 94 U. S. at 570). It is “unjust” and “an evasion of the law” to give a patent a scope broader than the plain meaning of its claims. *Id.* (quoting *White v. Dunbar*, 119 U.S. 47, 52 (1886)). This Court has worked arduously to define the proper protocols for district courts to ascertain and articulate the proper meaning and scope for utility patents. In comparison, design patent claim construction more resembles the fabled Wild West, with each district court judge playing the role of the frontier sheriff.

*Egyptian Goddess*’ approach to design patent claim construction is at odds with *Markman*, *Merrill* and *Dunbar*. Though *Markman* involved a utility patent, this Court post-*Markman* recognized “trial courts have a duty to conduct claim construction in design patent cases, as in utility patent cases.” *Egyptian Goddess*, 543 F.3d at 679. To the extent *Egyptian Goddess* provides trial courts claim construction guidance, claim construction duties appear optional. *Egyptian Goddess* told lower courts “not to treat the process of claim construction as

requiring a detailed verbal description of the claimed design,” *id.* at 680, and that refusal “to issue a relatively detailed claim construction will not be reversible error,” *id.* at 679. Against this backdrop, it is understandable why a trial court would hesitate to construe a design patent claim. *Egyptian Goddess* offers trial courts far too much discretion in construing design patent claims and only downside for engaging in such an exercise—the potential downside of being reversed on appeal.

The claim construction approach outlined in *Egyptian Goddess* undermines *Markman*’s goal of uniform enforcement and determining appropriate claim scope. Accused infringers hope for a trial court to “factor out” functional aspects of a design like the district court did *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288 (Fed. Cir. 2010), or to otherwise describe the patented design in exacting detail like the trial court in *Egyptian Goddess* did. By contrast, patentees hope for a trial court like the one in *Apple Inc. v. Samsung Electronics Co.*, 786 F.3d 983, 999 (Fed. Cir. 2015), which declined to factor functional elements out of the patented design. Despite the conflict, this Court affirmed these opposing approaches on appeal.

Design patent claim construction remains unclear. Accused infringers and patentees alike lack certainty as to whether trial courts will engage in claim construction or simply tell a jury to look at the figures for a given design. At the



same time, appellate courts are left to speculate as to whether jury verdicts are based on a given design's patented ornamentation or unprotected functional features. One commentator explained the result this way:

The great irony of *Egyptian Goddess* is that it disapproves of written claim constructions layered on the drawings themselves; the court makes clear that the drawings should speak for themselves if they can. This rule—when rigidly applied—leads to the very thing the case disapproves: infringement rulings based not on the drawings, but based on the ideas and functions in the drawings.

Michael J. Risch, *Functionality and Graphical User Interface Design Patents*, 17 Stan. Tech. L. Rev. 53, 102-103 (2013). Unsurprisingly, prominent members of the intellectual property bar have called for Supreme Court review. Christopher Buccafusco, Mark A. Lemley, & Jonathan S. Masur, *Intelligent Design*, 68 Duke L.J. 75, 126 (2018) (raising the possibility of Supreme Court review). Others assert that “there is currently great confusion in the jurisprudence on claim construction functionality” and that the doctrine is “lost at sea” and “needs desperate attention.” Christopher V. Carani, *Design Patent Functionality: A Sensible Solution*, *Landslide*, Nov./Dec. 2014, at 20, 23.

This case presents an opportunity to provide needed guidance on design patent claim construction. Here, at the trial court, GMS proffered a claim construction that took into account the functional aspects of the device claimed in the '684 patent. (Appx164.) The district court in this case directed the jury to the figures with no guidance on distinguishing between functional and ornamental

aspects of the design at issue. As set out in detail above, all the ornamental features between the '684 patent and GMS' accused rock dust blower are different. The unavoidable conclusion here is that the jury found infringement based on conceptual and functional similarities between how the device in the patented design and GMS' accused products work.

Design patent law is not supposed to work this way. Congress created a design patent system "to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them." *Gorham Co. v. White*, 81 U.S. 511, 525 (1872). Section 171 of the Patent Act, 35 U.S.C. § 171, provides that design patent protection is available to "[w]hoever invents any new, original and ornamental design[s] for an article of manufacture." The monopoly granted the owner of a design patent does not provide protection for the functional aspects of a claimed design.

The infringement verdict in this case violates Congress' design. Neither GMS' thinner lid, nor its additional rib and differential spacing on the drum, nor its two additional legs on its frustoconical stand were sufficient to avoid infringement in this case. In effect, the jury expanded the scope of the '684 patent to include various alternative ways of designing a functional rock dust blower, transforming Hafco's design patent into a de facto utility patent.

This Court should not allow this verdict to stand. Instead, it should establish the following two principles for district courts to conduct design patent claim construction and infringement analyses. First, this Court should instruct trial courts that claim construction is not optional. If an accused infringer like GMS comes forward with evidence that aspects of a claimed design are functional, this Court should require trial courts to take that information into account, address functionality in its claim construction ruling, and provide juries with appropriate guidance. Second, to avoid the creation of de facto utility patents, this Court should hold that functional aspects of a claimed design have a narrow range of protection. Specifically, functional design elements should be limited in claim scope to exactly the design shown in the drawing.

Under this standard, no reasonable juror could find that GMS' accused product infringes the '684 patent. The Panel decision should be overturned and judgment as a matter of law of no infringement should be entered in favor of GMS.

**V. CONCLUSION AND RELIEF SOUGHT**

For the foregoing reasons, GMS prays the Court to grant its combined petition for panel rehearing and rehearing en banc.

Dated: April 15, 2020.

Respectfully submitted,

/s/ Anthony J. Biller

Anthony J. Biller

Principal Counsel

/s/ James R. Lawrence, III

James R. Lawrence, III

Co-counsel

MICHAEL BEST & FRIEDRICH, LLP

2501 Blue Ridge Road, Suite 390

Raleigh, NC 27607

Telephone: (984) 220-8750

ajbiller@michaelbest.com

jrlawrence@michaelbest.com

*Counsel for Appellant*

# **ADDENDUM**

**United States Court of Appeals  
for the Federal Circuit**

---

**HAFCO FOUNDRY AND MACHINE COMPANY,  
INCORPORATED,**  
*Plaintiff-Appellee*

v.

**GMS MINE REPAIR AND MAINTENANCE, INC.,**  
*Defendant-Appellant*

---

2018-1904

---

Appeal from the United States District Court for the Southern District of West Virginia in No. 1:15-cv-16143, Senior Judge David A. Faber.

---

Decided: March 16, 2020

---

ANDREW G. FUSCO, Bowles Rice, LLP, Morgantown, WV, argued for plaintiff-appellee. Also represented by JEFFREY A. RAY.

JAMES R. LAWRENCE, III, Michael Best & Friedrich, Raleigh, NC, argued for defendant-appellant. Also represented by ANTHONY J. BILLER.

---

Before NEWMAN, CHEN, and STOLL, *Circuit Judges*.

Opinion of the court filed PER CURIAM.

Opinion concurring in part, dissenting in part filed by  
*Circuit Judge* NEWMAN.

PER CURIAM.

Hafco Foundry and Machine Company, Inc. (“Hafco”) is the owner of United States Design Patent No. D681,684 (“the ’684 patent”), issued on May 7, 2013 for a “Rock Dust Blower.” This device is used to distribute rock dust in areas such as coal mines, where rock dust is applied to the mine’s interior surfaces, to control the explosive hazards of coal dust. Hafco developed and manufactured this device, and in April 2014 contracted with Pioneer Conveyor LLC, an affiliate of GMS Mine Repair and Maintenance, Inc. (together “GMS”), whereby GMS would serve as distributor of Hafco’s rock dust blower for sale to mining customers. In May 2015 Hafco terminated this arrangement, stating that performance was poor. GMS then produced a rock dust blower for sale to mining customers.

Hafco sued GMS for infringement of the ’684 patent. Trial was to a jury. GMS filed a pre-trial motion for patent invalidity, and the district court found that GMS had not presented any evidence that might establish invalidity. The jury then found GMS liable for willful infringement, and awarded damages of \$123,650. The district court entered judgment on the verdict.

Both parties filed post-trial motions. On Hafco’s motion the court entered a permanent injunction against infringement. On GMS’ motion the district court remitted the damages award to zero, as not in accordance with the law of patent damages. The court offered a new trial on damages, and stayed the new trial pending this appeal.<sup>1</sup>

---

<sup>1</sup> *Hafco Foundry & Mach. Co. v. GMS Mine Repair & Maint., Inc.*, Civ. No. 1:15-16143, 2018 WL 1582728, at

GMS raises two issues on appeal: whether it is entitled to judgment as a matter of law on the issue of infringement; and, in the alternative, whether it is entitled to a new trial on the issue of infringement due to errors of law in the jury instruction. Hafco did not cross appeal on any issue relating to damages.

We affirm the judgment of infringement and the district court's denial of GMS' request for a new trial, the only two issues raised by GMS on appeal. We remand to the district court for further proceedings consistent with this opinion, including any proceedings necessary for a final judgment on damages.

### Standards of Review

We review the denial of a motion for judgment as a matter of law ("JMOL") under the law of the regional circuit where the appeal from the district court would normally lie. *Orion IP, LLC v. Hyundai Motor Am.*, 605 F.3d 967, 973 (Fed. Cir. 2010). In the Fourth Circuit, the district court's ruling on a motion for JMOL receives plenary review. *Anderson v. G.D.C., Inc.*, 281 F.3d 452, 457 (4th Cir. 2002). The "decision to grant or deny a new trial is within the sound discretion of the district court, and we respect that determination absent an abuse of discretion." *Cline v. Wal-Mart Stores, Inc.*, 144 F.3d 294, 301 (4th Cir. 1998).

On review of the jury's factual findings, the evidence is viewed in the light most favorable to the jury's verdict. *Dotson v. Pfizer*, 558 F.3d 284, 292 (4th Cir. 2009). The

---

\*8–12 (S.D. W. Va. Mar. 30, 2018) ("Dist. Ct. Op."); *id.*, 2018 WL 1733986 (S.D. W. Va. Apr. 10, 2018) ("Dist. Ct. Order"); *id.*, 2018 WL 1786588 (S.D. W. Va. Apr. 12, 2018) ("Amended Order"); *id.*, 2018 WL 3150353 (S.D. W. Va. June 26, 2018) ("Recon. Op.").

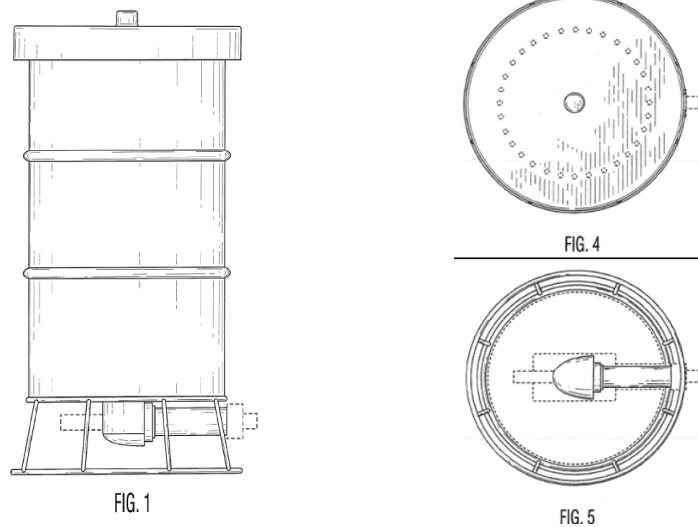


Fourth Circuit, in which this trial was held, “accord[s] the utmost respect to jury verdicts and tread[s] gingerly in reviewing them.” *Lack v. Wal-Mart Stores, Inc.*, 240 F.3d 255, 259 (4th Cir. 2001); *Price v. City of Charlotte*, 93 F.3d 1241, 1250 (4th Cir. 1996). See *United States v. Foster*, 507 F.3d 233, 244 (4th Cir. 2007) (“A jury’s verdict must be upheld on appeal if there is substantial evidence in the record to support it.”).

## I

### THE '684 PATENT

The '684 patent claims a design for a rock dust blower, as shown in the drawings: Figure 1 is a side view of the device, Figure 4 is a top view of the lid, and Figure 5 is a bottom view of the connector and stand:



GMS filed a pre-trial motion challenging patent validity on the ground that the '684 patent is not a proper design patent because all the elements of the device are functional. GMS alternatively argued that the claim of the '684 patent should be construed to exclude all functional

elements of the claimed design. The district court denied the motion.

In its proposed jury instructions, GMS included an instruction that stated “[w]here a design contains both functional and non-functional elements, a design patent protects only the non-functional aspects of the design as shown in the patent drawings, if there are any such non-functional aspects.” This instruction was not included in the final jury instructions, and GMS neither objected to the jury instructions nor presented evidence on the functional aspects of the ’684 patent at trial.

In its post-trial motion, GMS argued that the design of its rock dust blower is plainly dissimilar to the claimed design, that there were errors of law in the jury instructions, and that it was unfairly prejudiced by its inability to introduce evidence of invalidity at trial. The district court ruled that substantial evidence supported the jury verdict of infringement, that the jury instructions were proper, and that it had not in fact precluded GMS from arguing invalidity at trial. Specifically, the district court stated that “If GMS wanted to argue the invalidity of the patent to the jury, it needed to offer evidence on this point. The court did not prohibit GMS from doing so.” Dist. Ct. Op. at 21. GMS did not argue that the functional aspects of the claimed design should have been excluded from the infringement analysis, or that it was prevented from making this argument at trial.

On appeal, GMS argues for the first time that, when certain functional and prior art aspects of the ’684 patent are excluded, the design of its rock dust blower does not infringe the claimed design of the ’684 patent as a matter of law. GMS does not challenge on appeal the district court’s invalidity or claim construction rulings. Because GMS never made this non-infringement argument at the district court, nor presented relevant evidence on the

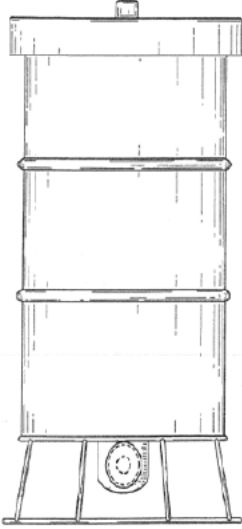

functional or prior art aspects of the '684 patent to the jury, GMS has not preserved this argument for appeal.

GMS also argues that the jury instructions adopted by the district court were plainly erroneous, warranting a new trial. We address these arguments below.

II

**JURY INSTRUCTIONS**

A model of the accused GMS blower was provided at trial, and GMS presents pictures comparing the Figures in the '684 patent with photographs of the GMS rock dust blower; including:

The '684 Patent	GMS' Accused Rock Dust Blower
 <p data-bbox="581 1444 625 1476">FIG. 2</p>	

GMS Br. 21; J.A. 1151 (photograph of GMS rock dust blower exhibited at trial).

The jury was instructed on the criteria for infringement, including the following instructions:

### Infringement - Generally

Patent law gives the owner of a valid patent the right to exclude others from making, using, offering to sell or selling the patented design within the United States during the term of the patent. Any person or business entity that has engaged in any of those acts without the patent owner's permission infringes the patent. Here, Hafco alleges that GMS' rock dust blower infringes the '684 design patent.

You have heard evidence about both Hafco's commercial rock dust blower and GMS' accused rock dust blower. However, in deciding the issue of infringement, you may not compare GMS' rock dust blower to Hafco's commercial rock dust blower. Rather, you must only compare GMS' accused rock dust blower to the '684 design patent when making your decision regarding infringement.

### Direct Infringement

To determine infringement, you must compare the overall appearances of GMS' accused design to the design claimed in the Hafco '684 Patent. If you find that, by a preponderance of evidence, the overall appearance of GMS' accused rock dust blower is substantially the same as the overall appearance of Hafco's claimed design, then you must find that the accused design infringes the Hafco '684 design patent.

Two designs are substantially the same if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the resemblance between the two designs is such as to deceive such an observer, inducing him to purchase one supposing it to be the other. An ordinary observer is a person who buys and uses the product at issue. You do not

need, however, to find that any purchasers actually were deceived or confused by the appearance of the GMS rock dust blower.

In conducting this analysis, keep in mind that minor differences between the patented and accused designs should not prevent a finding of infringement. In weighing your decision, you should consider any perceived similarities or differences.

When evaluating designs, be it the claimed design, accused design, or prior art designs, you should always focus on the overall appearance of the design, and not individual features.

While these guidelines may be helpful to your analysis, please keep in mind that the sole test for infringement is whether you believe that the overall appearance of the accused GMS rock dust blower design is substantially the same as the overall appearance of Hafco's '684 design patent. If you find by a preponderance of the evidence that GMS' accused rock dust blower is substantially the same as the '684 design patent, then you must find that the accused GMS product infringes the Hafco '684 design patent.

Jury instructions, J.A. 484–88. GMS states that the jury instructions are flawed in two respects: first, that the instructions “incompletely and prejudicially abridg[ed] the *Gorham* test,” referring to *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). Dist. Ct. Op. at 19 (quoting GMS' Motion for JMOL). Second, GMS states that the jury should have been instructed “that the hypothetical ordinary purchaser is to view the patented and accused designs ‘in the context of the prior art.’” GMS Br. 32.

To challenge a jury instruction, it must be established that “(1) the district court erred; (2) the error is plain; (3) the error affects substantial rights; and (4) . . . the error

seriously affects the fairness, integrity or public reputation of judicial proceedings.” *United States ex rel. Oberg v. Pa. Higher Educ. Assistance Agency*, 912 F.3d 731, 738 (4th Cir. 2019) (citing *Gregg v. Ham*, 678 F.3d 333, 338 (4th Cir. 2012)). Objection to the presence or absence of an instruction must be timely raised during the trial proceeding, and the correct instruction offered and rejected. The Federal Rules of Civil Procedure provide:

Rule 51(d)(1). A party may assign as error: (A) an error in an instruction actually given, if that party properly objected; or (B) a failure to give an instruction, if that party properly requested it and—unless the court rejected the request in a definitive ruling on the record—also properly objected.

See *Bunn v. Oldendorff Carriers GmbH & Co. KG*, 723 F.3d 454, 468–69 (4th Cir. 2013) (A party “fail[s] to preserve a challenge to the jury instructions” when it “has provided no record of an objection to the district court”). The Rules also provide that a court may consider a plain error in the instructions that has not been preserved if the error affects substantial rights. Fed. R. Civ. P. 51(d)(2).

GMS concedes that it “does not contend it made a proper objection to the district court’s jury instructions at trial.” *GMS Br.* 30. However, *GMS* states that since the instructions were incorrect in law, *GMS* is entitled to a new trial, citing Rule 51(d)(2). The Fourth Circuit explained in *Bunn* that “[e]ven if a jury was erroneously instructed, however, we will not set aside a resulting verdict unless the erroneous instruction *seriously* prejudiced the challenging party’s case.” *Bunn*, 723 F.3d at 468 (emphasis in original) (citing *Coll. Loan Corp. v. SLM Corp.*, 396 F.3d 588, 595 (4th Cir. 2005)).

*GMS* first assigns error to the jury instructions on the “ordinary observer”:

### 1. *The Ordinary Observer*

Infringement of a design patent is determined from the viewpoint of the ordinary observer, comparing the patented design with the article's overall appearance. *Gorham*, 81 U.S. at 528 (“[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”).

The jury instructions define the ordinary observer as “a person who buys and uses the product at issue.” J.A. 485. GMS made no objection to this definition. Although GMS now argues that “GMS’ rights were substantially affected by the district court’s failure to include a complete description of the ordinary purchaser,” GMS Br. 33, we are not directed to any request for such instruction or any explanation of the purported flaw.

GMS also states that the jury should have been instructed that “small differences between the accused and the claimed design” will avoid infringement. GMS Br. 32–33. Such an instruction was not requested at the trial. Nor would it have been correct, for the patented and accused designs need not be identical in order for design patent infringement to be found. *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820 (Fed. Cir. 1992). The controlling inquiry is how the ordinary observer would perceive the article. *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997); *see also Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1377 (Fed. Cir. 2002) *abrogated on other grounds by Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (competing designs can be substantially similar despite minor differences).

The jury was correctly instructed that the question is how the ordinary observer would view the article as a whole. See *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1335 (Fed. Cir. 2015) (“Differences [between the claimed design and accused design] must be evaluated in the context of the claimed design as a whole, and not in the context of separate elements in isolation.”); *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006) (an element-by-element comparison, without consideration of the ordinary observer inquiry to the overall design, is procedural error). GMS has failed to establish that there was any error in the jury instructions on the “ordinary observer,” much less plain error warranting a new trial.

## ***2. Differences From the Prior Art***

GMS states that the jury should have been instructed to “familiarize yourself with each of the prior art designs that have been brought to your attention,” citing the IPO Model Design Patent Jury Instructions at 25 (2010). GMS Br. 35–36. Hafco responds that GMS presented “not . . . even a scintilla” of prior art to the jury. Hafco Br. 3. GMS does not state otherwise, arguing only that a 55-gallon drum is a standard size.

Although GMS states that “[a] properly instructed jury would have been drawn to the same things an ordinary observer would be drawn to—namely the ‘aspects of the claimed design that differ from the prior art,’” GMS Br. 18 (citing *Egyptian Goddess*, 543 F.3d at 676), the record shows no presentation of prior art, and Hafco states that GMS “never submitted a jury instruction regarding same.” Hafco Br. 3. GMS does not state otherwise.

Given that there was no prior art introduced at trial, no attempt by GMS to introduce the prior art, and no proposed jury instruction on this issue, the purported exclusion of this instruction cannot be error. Accordingly, GMS has not demonstrated that a new trial is warranted.



12 HAFCO FOUNDRY AND MACHINE CO. v. GMS MINE REPAIR

CONCLUSION

The district court's judgment is affirmed.

**AFFIRMED AND REMANDED**

**United States Court of Appeals  
for the Federal Circuit**

---

**HAFCO FOUNDRY AND MACHINE COMPANY,  
INCORPORATED,**  
*Plaintiff-Appellee*

v.

**GMS MINE REPAIR AND MAINTENANCE, INC.,**  
*Defendant-Appellant*

---

2018-1904

---

Appeal from the United States District Court for the Southern District of West Virginia in No. 1:15-cv-16143, Senior Judge David A. Faber.

---

NEWMAN, *Circuit Judge*, concurring in part, dissenting in part.

I concur in the court's decision. I write separately because I would resolve the matter of damages, for when the facts are not disputed the jury's application of incorrect law is subject to correction by the court, particularly when such correction implements the jury's intent. I would accept Hafco's proposed remittitur to \$110,000, on undisputed application of the correct law.

***The measure of damages***

The jury awarded damages of \$123,650, measured by GMS's infringing sales. Hafco's lost profits were \$110,000.

These facts were attested at the trial, and are not disputed. The jury was correctly instructed on the law of patent damages; the instructions included:

A plaintiff in a design patent case can elect to prove either actual damages, known as compensatory damages, or it may elect to prove the amount of defendant's profits from the sale of the infringing product as its measure of recovery. With respect to actual damages, if you believe GMS infringed the '684 Patent, Hafco is entitled to receive damages adequate to compensate it for infringement beginning on April 20, 2015 to the present. Those damages can be in the form of lost profits or a reasonable royalty. The term lost profits means any and all actual reduction in business profits Hafco suffered as the result of GMS' infringement of the '684 Patent. . . .

In this case, Hafco seeks to recover lost profits resulting from GMS' infringement of the '684 Patent. If you conclude that Hafco has proved that it lost profits because of GMS' infringement, the lost profits you award should be the amount that Hafco would have made on any sales that Hafco lost because of the infringement.

J.A. 487–489. These instructions were not challenged at trial, and are not challenged on appeal.

The district court agreed with GMS, on post-trial motion, that the \$123,650 jury damages award does not “under any conceivable view of the evidence” represent Hafco's lost profits. *Hafco Foundry & Mach. Co. v. GMS Mine Repair & Maint., Inc.*, Civ. No. 1:15 -16143, 2018 WL 1582728, at \*8 (S.D. W.Va. Mar. 30, 2018) (“Dist. Ct. Op.”). All parties agree that the correct standard is Hafco's lost profits. The district court remitted the damages to zero, and offered a new trial on damages. Hafco argues that “any

remittitur of the damage award should have been to an amount no less than \$110,000.00,” Hafco Br. 1–2.

Jury damages awards, unless clearly unreasonable or based on error in the jury instructions, are not readily modified. *See Fox v. Gen. Motors Corp.*, 247 F.3d 169, 180 (4th Cir. 2001) (“A jury’s award of damages stands unless it is grossly excessive or shocking to the conscience.”) (quotation omitted). Hafco offers some theories why the jury could have measured damages by GMS’ sales, for the jury was not told that this evidence was irrelevant.

Hafco acknowledges that the jury instructions limited damages to Hafco’s lost profits. The district court correctly so observed. However, Hafco suggests that remittitur to Hafco’s lost profits of \$110,000 would be a more reasonable action than remittitur to zero, for \$110,000 reasonably implements the jury’s verdict and intent. *See Minks v. Polaris Indus., Inc.*, 546 F.3d 1364, 1371 (Fed. Cir. 2008) (“[W]here a portion of a verdict is for an identifiable amount that is not permitted by law, the court may simply modify the jury’s verdict to that extent and enter judgment for the correct amount.” (quoting *Johansen v. Combustion Eng’g, Inc.*, 170 F.3d 1320, 1330 (11th Cir. 1999) (citing *N.Y., L.E. & W.R. Co. v. Estill*, 147 U.S. 591 (1893)))).

I would simply correct the district court’s judgment, and remit the damages award to the undisputed amount of \$110,000. A new trial, on undisputed facts, is not needed to serve the purposes of the jury verdict.

### ***Post-Trial Motions***

In view of this expected appeal, the district court denied without prejudice Hafco’s motions for enhanced damages, attorney fees, and interest. Enhanced damages and attorney fees now await resolution on remand. However, Federal Rule of Appellate Procedure 37(b) requires the appellate tribunal to determine post-judgment interest. *See Tronzo v. Biomet, Inc.*, 318 F.3d 1378, 1381 (Fed. Cir. 2003)

4 HAFCO FOUNDRY AND MACHINE CO. v. GMS MINE REPAIR

("[T]he responsibility and authority for [determining whether a party to an appeal is entitled to post-judgment interest] is assigned to the appellate tribunal."). On the remittitur that I recommend, this aspect would require our attention.

## CERTIFICATE OF FILING AND SERVICE

I hereby certify that on this the 15th day of April, 2020, I caused this Petition for Rehearing En Banc by Appellant to be filed electronically with the Clerk of the Court using the CM/ECF System, which will send notice of such filing to the following registered CM/ECF users:

Andrew G. Fusco  
Jeffrey A. Ray  
Bowles Rice LLP  
7000 Hampton Center  
Morgantown, WV 26505  
(304) 554-2601  
**afusco@bowlesrice.com**  
jray@bowlesrice.com

*Counsel for Appellee*

/s/ Anthony J. Biller  
Anthony J. Biller  
*Attorney for Appellant*

### CERTIFICATE OF COMPLIANCE

1. This petition complies with the type-volume limitation of Fed. R. App. P. 28.1(e)(2) or 32(a)(7)(B) because:

this petition contains 3977 words, excluding the parts of the petition exempted by Fed. R. App. P. 32(a)(7)(B)(iii), or

this petition uses a monospaced typeface and contains [*state the number of lines of*] text, excluding the parts of the petition exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

2. This petition complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because:

this petition has been prepared in a proportionally spaced typeface using [*Microsoft Word 2010*] in [*14pt Times New Roman*]; or

this petition has been prepared in a monospaced typeface using [*state name and version of word processing program*] with [*state number of characters per inch and name of type style*]

Dated: April 15, 2020

/s/ Anthony J. Biller  
Anthony J. Biller  
*Attorney for Appellant*