

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

GORGE DESIGN GROUP LLC, *et al*,

Plaintiffs,

v.

SYARME, *et al*,

Defendants.

Civil Action No. 2:20-cv-1384

Hon. William S. Stickman IV

MEMORANDUM ORDER

WILLIAM S. STICKMAN IV, District Judge

On September 15, 2020, Plaintiffs filed a Complaint (ECF No. 2) and Motion for Temporary Restraining Order (“TRO”) (ECF No. 5) against several defendants, including Defendant Neomagic Corporation, d/b/a www.mercadomagico.com (“Neomagic”). The Complaint and the motion asserted that Plaintiffs were owners of the intellectual property in a product called the “Ultimate Ground Anchor,” which is, essentially, an anchor peg with a screw-shaped ground spike. The Complaint and the motion alleged that Defendants were online storefronts which advertised and sold counterfeit products that, *inter alia*, violated Plaintiffs’ intellectual property and engaged in other actionable conduct. The Complaint asserted claims of Federal Unfair Competition (15 U.S.C. § 1125(a)), Patent Infringement (35 U.S.C. § 271(a)), Common Law Unfair Competition, and Common Law Trademark Infringement. The Motion for TRO asserted that Defendants’ conduct constituted ongoing, immediate and irreparable harm. The Court granted the requested TRO and issued an order to show cause why a preliminary injunction should not issue on September 21, 2020. (ECF No. 18).

Neomagic entered its appearance and filed a Motion to Dismiss, an Omnibus Motion to Dissolve TRO and supporting briefs. (ECF Nos. 23, 24, 27, 28). The Court held a hearing on the show cause order on October 5, 2020. (ECF No. 29). Counsel for Neomagic and Plaintiff informed the Court that they had reached an agreement in principle whereby Neomagic would be dismissed from the case, while retaining the right to file a motion seeking reimbursement of attorney fees. Plaintiffs filed a Notice of Voluntary Dismissal of Neomagic on October 6, 2020. (ECF No. 31). On October 20, 2020, Neomagic filed the instant Motion for Attorney Fees. (ECF No. 42). Briefing is now complete, and the motion is ripe for adjudication by the Court.

Neomagic argues that fees are warranted based on a multitude of authorities including state and federal statutes, the Pennsylvania Rules of Professional Conduct and the common law—Federal Rule of Civil Procedure 54, 35 U.S.C. § 285, 15 U.S.C. § 1117, 17 U.S.C. § 505, Federal Rule of Civil Procedure Rule 11, the Court’s inherent power, 28 U.S.C. § 1927, 42 Pa.C.S.A. § 2503, and Pennsylvania Rule of Professional Conduct 3.3. Neomagic has taken the “kitchen sink” approach, but all of the authorities it cites in support of a fee award miss the mark.

Awards of attorney fees are the exception, rather than the rule, in our legal system. As the Supreme Court has explained:

Our basic point of reference when considering the award of attorney’s fees is the bedrock principle known as the American Rule: Each litigant pays his own attorney’s fees, win or lose, unless a statute or contract provides otherwise. The American Rule has roots in our common law reaching back to at least the 18th Century, and statutes which invade the common law are to be read with a presumption favoring the retention of long-established and familiar legal principles. We consequently will not deviate from the American Rule absent explicit statutory authority.

Baker Botts L.L.P. v. ASARCO LLC, 576 U.S. 121, 126 (2015) (internal citations and quotations omitted). Further, the Supreme Court noted that “[w]e have recognized departures from the American Rule only in ‘specific and explicit provisions for the allowance of attorneys’ fees

under selected statutes.” *Id.* (citation omitted). Neomagic has not made a compelling argument that the long-established and deeply entrenched American Rule should be abandoned. While it cites to numerous bases for the Court to award fees, none are applicable, much less convincing.

Neomagic argues that it should be awarded attorney fees because Plaintiffs’ action against it (and others) “was brought unreasonably, vexatiously, in bad faith and without evidentiary support.” (ECF No. 43, p. 4). Plaintiffs respond by showing that Neomagic has advertised and sold a product that is nearly, if not completely, identical in form and that it did so by using photos of their product (some of which were taken by Plaintiff Erdely). This is not, however, the forum to adjudicate claims against Neomagic on their merits. Those claims have been dismissed. Plaintiffs’ claims, their allegations and the material they offered in opposition to the Motion for Attorney Fees are relevant only to determine whether Neomagic has made a facial showing that would allow an award of fees (if otherwise applicable) under the authorities that it cites to get around the American Rule. With this in mind, the Court will address each alleged basis proffered by Neomagic in support of a fee award.

A) Fed. R. Civ. P. 54

Contrary to Neomagic’s assertion, there is no basis for an award of fees under Fed. R. Civ. P. 54(d). As an initial matter, Rule 54 addresses the award of costs and, in limited circumstances, attorney fees to a prevailing party. In the context of this matter, Neomagic cannot be considered a prevailing party. “Unilateral, voluntary, and non-final action does not meet the prevailing party’ standard. *Buckhannon Bd. And Care Home, Inc. v. West Virginia Dept. of Health and Human Resources*, 532 U.S. 598 (2001) (under Fair Housing Amendments Act and Americans with Disabilities Act); *RFR Industries, Inc. v. Century Steps, Inc.*, 477 F.3d 1348 (Fed.Cir.2007) (under Patent Act); *Oscar v. Alaska Dept. of Ed. And Early Development*, 541

F.3d 978 (9th Cir. 2008) (under Individuals with Disabilities in Education Act); *Evans v. Chichester School Dist.*, 2008 WL 4610240 (E.D.Pa. Oct.15, 2008) (under 42 U.S.C. § 1988 and Rehabilitation Act).” *Hammill v. Bank of Am., N.A.*, 2013 WL 4648317, at *3 (W.D. Pa. Aug. 29, 2013), *aff'd*, 569 F. App'x 133 (3d Cir. 2014). *See also Rousseau v. Echosphere Corp.*, 2005 WL 2176839, at *5 (W.D.Pa. Aug. 30, 2005) (collecting cases and rejecting request for fee award under Rule 54 after voluntary dismissal). Thus, the voluntary dismissal of Neomagic does not render it a prevailing party and Rule 54 is facially inapplicable.

B) 35 U.S.C. § 285; 15 U.S.C. § 1117; 17 U.S.C. § 505

Neomagic also seeks a fee award under a number of federal statutes specifically governing intellectual property—35 U.S.C. § 285 (Patents); 15 U.S.C. § 1117 (Trademarks); and 17 U.S.C. §505 (Copyright). The statutes provide:

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

35 U.S.C. § 285.

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

15 U.S.C. § 1117(a) (in relevant part).

In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the prevailing party as part of the costs.

17 U.S.C. § 505.

Curiously, the Complaint does not assert any claims relating to copyrights. For that reason alone, 17 U.S.C. § 505, part of the statutory regimen governing copyrights, is facially inapplicable and cannot serve as a foundation for a fee award.

The two remaining statutes require as a threshold consideration that fees may only be awarded to a “prevailing party” and only in “exceptional cases.” As explained above, Neomagic cannot meet the first prong. It is not a prevailing party and, therefore, cannot seek a fee award under 35 U.S.C. § 285 or 15 U.S.C. §1117.

Nor can Neomagic establish that this is an “exceptional case,” as required by both statutes. The determination of whether a case is sufficiently “exceptional” as to warrant a fee award is left to the sound discretion of the district court. *See ADM Corp. v. Speedmaster Packaging Corp.* 525 F.2d 662, 664 (3d Cir. 1975). “An exceptional case is one that stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.” *Spineology, Inc. v. Wright Medical Tech. Inc.*, 910 F.3d 1227, 1229 (Fed. Cir. 2018) (citing *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545 (2014)). “District courts may determine whether a case is exceptional in a case-by-case exercise of their discretion, considering the totality of the circumstances.” *Spineology*, 910 F.3d at 1229.

The Court holds that there is nothing exceptional about this case. In fact, this case has followed the same trajectory of many other cases in this District and in districts throughout the country in instances where a plaintiff discovers that its intellectual property has likely been pirated and identical or substantially similar knock-off products are being offered for sale from on-line platforms. To hold that this case is exceptional would topsy-turvy that term—elevating what is ordinary to extraordinary. It would erect an unwarranted barrier to plausible claims by legitimately injured Plaintiffs.

On a more granular level, there is nothing exceptional about this case, as asserted against Neomagic. First, the case is still in its infancy. Plaintiffs filed a Complaint that complies with

the requirements of the federal rules and appears to assert a facially plausible claim against Neomagic. Neomagic can argue (or could have argued if it was not voluntarily dismissed) that the product it was selling and the advertising for that product did not violate the patent at issue and did not infringe upon Plaintiffs' trademark, but the fact remains that Neomagic sold a product that appears to be identical to the Plaintiffs' and used photographs depicting the product that were plausibly claimed to have been identical to those used by Plaintiffs (and actually taken by one of the Plaintiffs). Whether, if the case would have proceeded to a determination on the merits, Plaintiffs would have ultimately prevailed against Neomagic is immaterial. Neither they nor any plaintiff is required to prove their case in their Complaint. The question here is whether—in the context of the litigation against Neomagic from inception to conclusion—there was something that rendered it exceptional. There was not. No fee is warranted under either 35 U.S.C. § 285 or 15 U.S.C. § 1117.

C. 28 U.S.C. § 1927

Neomagic next argues that fees are warranted under 28 U.S.C. § 1927, which provides:

Any attorney or other person admitted to conduct cases in any court of the United States or any Territory thereof who so multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys' fees reasonably incurred because of such conduct.

Again, Neomagic is attempting to fit a square peg into a round hole. This statute is inapplicable.

§ 1927 requires that the offending attorney be found to “multipl[y] the proceedings in any case unreasonably and vexatiously.” Courts have held that the purpose of § 1927 is to deter unnecessary delays and abusive conduct in the course of ongoing litigation. The Supreme Court observed: “[b]ut § 1927 does not distinguish between winners and losers, or between plaintiffs and defendants. The statute is indifferent to the equities of a dispute and to the values advanced

by the substantive law. It is concerned only with limiting the abuse of court processes.” *Roadway Exp., Inc. v. Piper*, 447 U.S. 752, 762 (1980). The body of caselaw interpreting § 1927 reveals that courts give full effect to the statutory language addressing the multiplication of proceedings “*in any case.*” In other words, § 1927 focuses on unreasonable vexatious conduct in the course of a case that is dilatory or incurs unreasonable expense or inconvenience. The statute does not apply to the initiation of a case. *See Gurman v. Metro Housing and Redevelopment Auth.*, 884 F.Supp.2d 895 (D. Minn. 2012) (“the Court notes that an attorney cannot be sanctioned under § 1927 for simply commencing a frivolous lawsuit. *See, e.g., Jensen v. Phillips Screw Co.*, 546 F.3d 59, 65 (1st Cir. 2008) (“[W]e join an unbroken band of cases across the courts of appeals holding that a lawyer cannot violate section 1927 in the course of commencing an action.”); *In re Keegan Mgmt. Co., Sec. Litig.*, 78 F.3d 431, 435 (9th Cir.1996) (“The filing of a complaint may be sanctioned pursuant to Rule 11 or a court's inherent power, but it may not be sanctioned pursuant to § 1927.”).

§ 1927 is inapplicable to the case at bar. Plaintiffs did not engage in the type of misconduct addressed by the statute. They did nothing to vexatiously delay or prolong the litigation. They filed a Complaint and Motion for a TRO and, shortly thereafter, agreed to voluntarily dismiss the claims against Neomagic. The Court holds that there is no basis for fees under 28 U.S.C. § 1927.

D. 42 Pa.C.S.A. § 2503

In addition to the federal statutes discussed above, Neomagic claims it is entitled to a fee award under Section 2503 of the Pennsylvania Judicial Code, 42 Pa.C.S.A. § 2503, which provides:

The following participants shall be entitled to a reasonable counsel fee as part of the taxable costs of the matter:

- (1) The holder of bonds of a private corporation who successfully recovers due and unpaid interest, the liability for the payment of which was denied by the corporation.
- (2) A garnishee who enters an appearance in a matter which is discontinued prior to answer filed.
- (3) A garnishee who is found to have in his possession or control no indebtedness due to or other property of the debtor except such, if any, as has been admitted by answer filed.
- (4) A possessor of property claimed by two or more other persons, if the possessor interpleads the rival claimants, disclaims all interest in the property and disposes of the property as the court may direct.
- (5) The prevailing party in an interpleader proceeding in connection with execution upon a judgment.
- (6) Any participant who is awarded counsel fees as a sanction against another participant for violation of any general rule which expressly prescribes the award of counsel fees as a sanction for dilatory, obdurate or vexatious conduct during the pendency of any matter.
- (7) Any participant who is awarded counsel fees as a sanction against another participant for dilatory, obdurate or vexatious conduct during the pendency of a matter.
- (8) Any participant who is awarded counsel fees out of a fund within the jurisdiction of the court pursuant to any general rule relating to an award of counsel fees from a fund within the jurisdiction of the court.
- (9) Any participant who is awarded counsel fees because the conduct of another party in commencing the matter or otherwise was arbitrary, vexatious or in bad faith.
- (10) Any other participant in such circumstances as may be specified by statute heretofore or hereafter enacted.

42 Pa.C.S.A. § 2503. This statute may apply in federal court in diversity cases where state law applies. *See Transit Cas. Ins. Co. v. Nationwide Mutual Ins. Co.*, 537 F.Supp. 65, 71 (E.D.Pa. 1982). Although this case arises before the Court on federal question jurisdiction, Plaintiffs have asserted two supplemental common law claims. While the Court has not decided which state's law will apply to those claims, it will assume, without deciding, that Pennsylvania law should apply. That being said, § 2503 does not support a fee award.

§ 2503 will only permit an award of fees where a litigant “can establish that an action was brought arbitrarily, vexatiously, or in bad faith.” *P. Liedtka Trucking, Inc. v. James H.*

Hartman and Sons, Inc., 537 F.Supp. 381, 382 (E.D.Pa. 1982). The Pennsylvania Supreme Court explained the contours of § 2503:

An opponent's conduct has been deemed to be “arbitrary” within the meaning of the statute if such conduct is based on random or convenient selection or choice rather than on reason or nature. *Bucks County Board of Supervisors v. Gonzales*, 158 Pa. Commw. 664, 670–71, 632 A.2d 1353, 1356 (1993), *appeal denied*, 538 Pa. 618, 645 A.2d 1321 (1994). *Accord Black's Law Dictionary* 104 (6th ed., reprinted 1993). An opponent also can be deemed to have brought suit “vexatiously” if he filed the suit without sufficient grounds in either law or in fact and if the suit served the sole purpose of causing annoyance. *Id.*; *Black's Law Dictionary, supra*, at 1565. Finally, an opponent can be charged with filing a lawsuit in “bad faith” if he filed the suit for purposes of fraud, dishonesty, or corruption. *Frick v. McClelland*, 384 Pa. 597, 600, 122 A.2d 43, 45 (1956) (*quoting McNair's Petition*, 324 Pa. 48, 187 A. 498 (1936) *Bucks County Board of Supervisors, supra*, 158 Pa. Commw. at 670–71, 632 A.2d at 1356; *Black's Law Dictionary, supra*, at 139).

By imposing these strict definitional guidelines, the statute serves not to punish all those who initiate legal actions which are not ultimately successful or which may seek to develop novel theories in the law. Such a rule would have an unnecessarily chilling effect on the right to bring suit for real legal harms suffered. *Dooley v. Rubin*, 422 Pa.Super. 57, 64, 618 A.2d 1014, 1018 (1993) (citation omitted). Rather, the statute focuses attention on the conduct of the party from whom attorney's fees are sought and on the relative merits of that party's claims. *See, e.g., Bykowski v. Chesed, Co.*, 425 Pa.Super. 595, 600, 625 A.2d 1256, 1259 (1993) (counsel fees appropriate where counsel for alleged slip-and-fall victims received seven requests for dismissal from purported owners of property and responded to none of them, and counsel failed to respond to purported owners' motion for judgment on the pleadings); *J.H. France Refractories Co. v. Allstate Insurance Co.*, 534 Pa. 29, 44, 626 A.2d 502, 510 (1993) (no counsel fees awarded against insurers in contesting their obligations to defend and indemnify when excessive pluralism and disparity existed in the decisions of the many courts which have entertained similar litigation).

Thunberg v. Strause, 682 A.2d 295, 299–300 (1996). As explained above, the Court holds that Plaintiffs did not bring their case against Neomagic in an arbitrary, vexatious, fraudulent, bad faith or corrupt manner. The Court holds that the claims brought against Neomagic were not asserted for purposes of annoyance or harassment. Rather, the limited record shows that Plaintiffs had a legitimate purpose in bringing their case. Whether they ultimately could have

prevailed on their claims is not before the Court. What is before the Court is that Neomagic sold a substantially similar product as Plaintiffs and did so using some of the same photographs as Plaintiffs. Plaintiffs had a good faith basis to pursue their claims. Moreover, the manner in which Plaintiffs pursued their case is substantially similar to a multitude of cases in this District and throughout the federal system where intellectual property holders attempt to protect their assets from alleged counterfeits being sold online. No fees are warranted under the Pennsylvania statute.

E. Fed. R. Civ. P. 11

Neomagic seeks sanctions under Fed. R. Civ. P. 11, but has not complied with the explicit procedures for pursuing such a sanction. Plaintiffs argue that Neomagic never provided them with the required 21 day safe-harbor notice, and Neomagic does not refute this point. The 21 day safe-harbor is required by Rule 11 and is non-negotiable. *See In re Schaefer Salt Recovery, Inc.*, 542 F.3d 90, 99 (3d. Cir. 2008). Moreover, Rule 11(c)(2) expressly requires that a motion for sanctions under Rule 11 “must be filed separately from any other motion.” Fed. R. Civ. P. 11(c)(2). Neomagic presented its purported Rule 11 motion for sanctions alongside a multitude of other grounds for relief. The Court holds that Neomagic has failed to present a cognizable request for sanctions under Rule 11.

F. Pennsylvania Rule of Professional Conduct 3.3

Neomagic also seeks fees under Pennsylvania Rule of Professional Conduct 3.3. This argument is meritless and, indeed, borders on frivolous. The very rules cited by Neomagic unequivocally provide:

[19] Violation of a Rule should not itself give rise to a cause of action against a lawyer nor should it create any presumption in such a case that a legal duty has been breached. In addition, violation of a Rule does not necessarily warrant any other nondisciplinary remedy, such as disqualification of a lawyer in pending

litigation. ***The Rules are designed to provide guidance to lawyers and to provide a structure for regulating conduct through disciplinary agencies. They are not designed to be a basis for civil liability.*** Furthermore, the purpose of the Rules can be subverted when they are invoked by opposing parties as procedural weapons. The fact that a Rule is a just basis for a lawyer's self-assessment, or for sanctioning a lawyer under the administration of a disciplinary authority, does not imply that an antagonist in a collateral proceeding or transaction has standing to seek enforcement of the Rule. ***Accordingly, nothing in the Rules should be deemed to augment any substantive legal duty of lawyers or the extra disciplinary consequences of violating such a duty.***

Pa St. RPC Preamble and Scope [19] (emphasis added). Neomagic's argument under Rule 3.3 is without merit and warrants no further discussion by the Court.


G. The Court's inherent power.

In the event that none of the many alleged grounds for a fee award should apply, Neomagic asks the Court to use its inherent authority to award fees. In *Chambers v. Nasco*, 501 U.S. 32, 45-46 (1991), the Supreme Court stated that a court has the inherent authority to impose sanctions when an attorney has acted "in bad faith, vexatiously, wantonly, or for oppressive reasons." The Supreme Court explained that "the imposition of sanctions in this instance transcends a court's equitable power concerning relations between the parties and reaches a court's inherent power to police itself, thus serving the dual purpose of vindicating judicial authority without resort to the more drastic sanctions available for contempt of court and making the prevailing party whole for expenses caused by his opponent's obstinacy." *Id.* at 46. The Third Circuit has recognized that the use of the Court's inherent power should be rare and subordinate to sanctions set forth by statute or rule. *In re Prudential Ins. Co. Sales Practice Litigation Agent Actions*, 278 F.3d 175, 189 (3d Cir. 2002) ("generally, a court's inherent power should be reserved for those cases in which the conduct of a party or an attorney is egregious and no other basis for sanction exist." (citation omitted)).

Here, as previously explained, none of the statutory, rule-based or other authorities cited by Neomagic provide a basis for a fee award. The Court will not exercise its extraordinary inherent powers. It does not find that Plaintiffs engaged in bad faith, vexatious or wanton conduct.¹

AND NOW, this 3rd day of December 2020, IT IS HEREBY ORDERED that Neomagic's Motion for Attorney Fees (ECF No. 42) is DENIED.

BY THE COURT:



WILLIAM S. STICKMAN IV
UNITED STATES DISTRICT JUDGE

¹ Perhaps Neomagic, itself, has approached or crossed that line in its zeal to obtain fees. It has, for example, cited to a statute governing copyrights where no claim under copyright statutes was asserted in the Complaint. It sought fees under Rule 11, despite failing to comply with the minimal procedures required to do so. It pointed to a Rule of Professional Conduct as a basis for fees, despite established authority (and the plain language of the Rules themselves) precluding the Rules to be used in that manner.

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

GORGE DESIGN GROUP LLC, *et al*,

Plaintiffs,

v.

SYARME, *et al*,

Defendants.

Civil Action No. 2:20-cv-1384

Hon. William S. Stickman IV

ORDER OF COURT

AND NOW, this 9th day of April 2021, the Court hereby GRANTS Defendant NeoMagic Corporation’s (doing business as *www.mercadomagic.com*) Motion for Entry of Final Judgment Pursuant to Federal Rule of Civil Procedure 54(b).¹ (ECF No. 105). Plaintiffs’ Notice of Voluntary Dismissal of Defendant MERCADOMAGICO pursuant to Fed. R. Civ. P. 41(a)(1)(A)(i) (ECF No. 31), is hereby CERTIFIED AS A FINAL JUDGMENT pursuant to Fed. R. Civ. P. 54(b).

Plaintiffs voluntarily dismissed its claims against NeoMagic and in so doing removed all causes of action against NeoMagic from the case. No allegation exists that NeoMagic has any relationship with any of the other remaining defendants in this case, including the only Defendant who remains active – Meaning Xuansheng. (ECF No. 31).

¹ The Defendant was identified as Mercadomagico in Plaintiff’s Complaint. (ECF No. 2). However, the Defendant refers to itself in its pleading as NeoMagic Corporation (doing business as *www.mercadomagic.com*). Since the Defendant wishes to be referred to as NeoMagic, the Court will do so with the understanding that it is named as Mercadomagico on the docket.

There is no just reason to delay NeoMagic's appeal of the Court's December 4, 2020 denial of its motion for attorney fees and costs.² (ECF No. 76). The claims that remain in this case – i.e., Federal Unfair Competition, Patent Infringement, Common Law Unfair Competition and Common Law Trademark Infringement - are separate and distinct from the claims that NeoMagic wishes to appeal. Nothing that would occur in the pending case has any bearing on NeoMagic's appeal of the Court's denial of its motion for attorney fees and costs. In the eyes of the Court, delaying NeoMagic's appeal on such a discrete issue indefinitely to await final judgment as to completely unrelated issues and parties is unnecessarily prejudicial.

BY THE COURT:



WILLIAM S. STICKMAN IV
UNITED STATES DISTRICT JUDGE

² NeoMagic appealed the Court's denial of its claims for attorneys' fees to United States Court of Appeals for the Third Circuit, and that appeal was docketed at No. 21-1074. It was then apparently transferred to the Federal Circuit. The Court is cognizant of its jurisdictional limitations under Federal Rule of Appellate Procedure 4. Due to the fact that the issue on appeal deals with attorney fees and costs and the Third Circuit has already noted that the order "appealed does not appear to dismiss all claims as to all parties, has not been certified under Fed. R. Civ. P. 54(b), and does not appear to be otherwise appealable," (ECF No. 105-2) the Court offers this order as a means of judicial efficiency and clarity. Had it been requested prior to the filing of the appeal the Court most certainly would have issued the exact same order.



US007309198B1

(12) **United States Patent**
Brown

(10) **Patent No.:** **US 7,309,198 B1**
(45) **Date of Patent:** **Dec. 18, 2007**

(54) **REUSABLE THREADED TIE DOWN**

D347,980 S * 6/1994 Butch D8/1
D381,892 S 8/1997 Porter et al.
D398,363 S * 9/1998 LoBue D21/840
D492,586 S 7/2004 Rimer, Jr.

(76) Inventor: **David J. Brown**, 145 Rue Cezzan,
Lavonia, GA (US) 30553

(*) Notice: Subject to any disclaimer, the term of this
patent is extended or adjusted under 35
U.S.C. 154(b) by 94 days.

* cited by examiner

(21) Appl. No.: **11/287,877**

Primary Examiner—H Gutman
(74) *Attorney, Agent, or Firm*—J. Bennett Mullinax, LLC

(22) Filed: **Nov. 28, 2005**

(57) **ABSTRACT**

(51) **Int. Cl.**
B61D 45/00 (2006.01)

(52) **U.S. Cl.** **410/101**

(58) **Field of Classification Search** **410/101,**
410/96

See application file for complete search history.

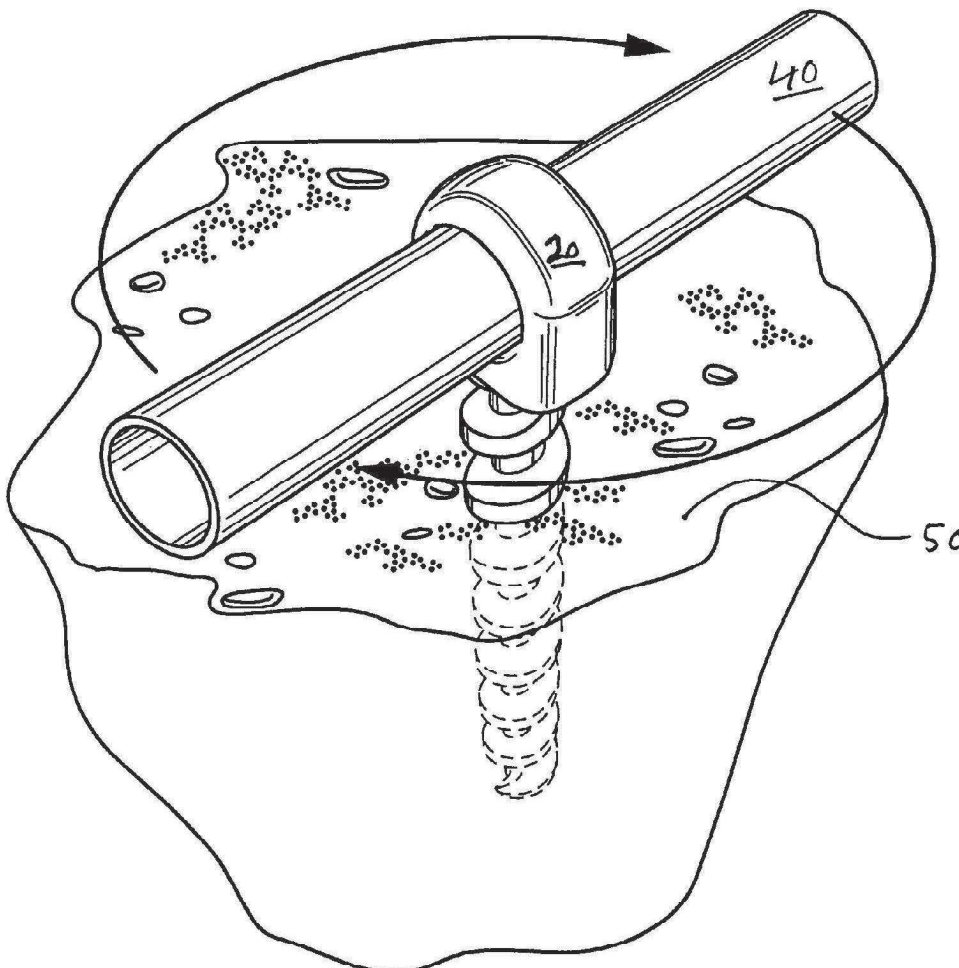
A reusable tie down is provided having a threaded portion for insertion in soil along with an arcuate head defining an aperture for securing a rope or line to the tie down. The tie down is constructed of a high impact, high tensile strength polycarbonate which may be deformed under a heavy load and then returned to a normal shape by the application of heat.

(56) **References Cited**

U.S. PATENT DOCUMENTS

4,717,147 A * 1/1988 Rochelle 482/93

5 Claims, 3 Drawing Sheets



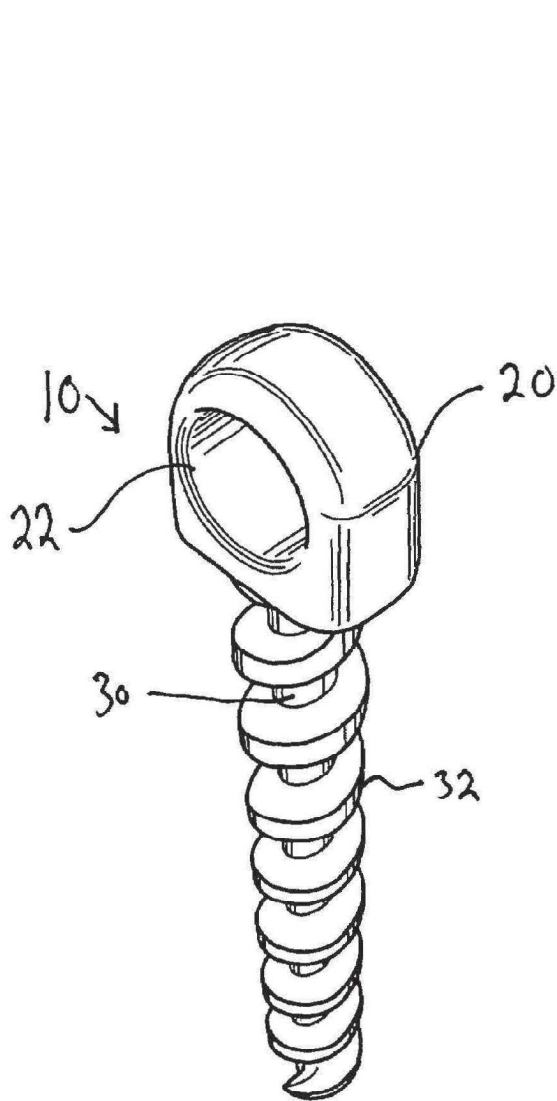


FIG. 1

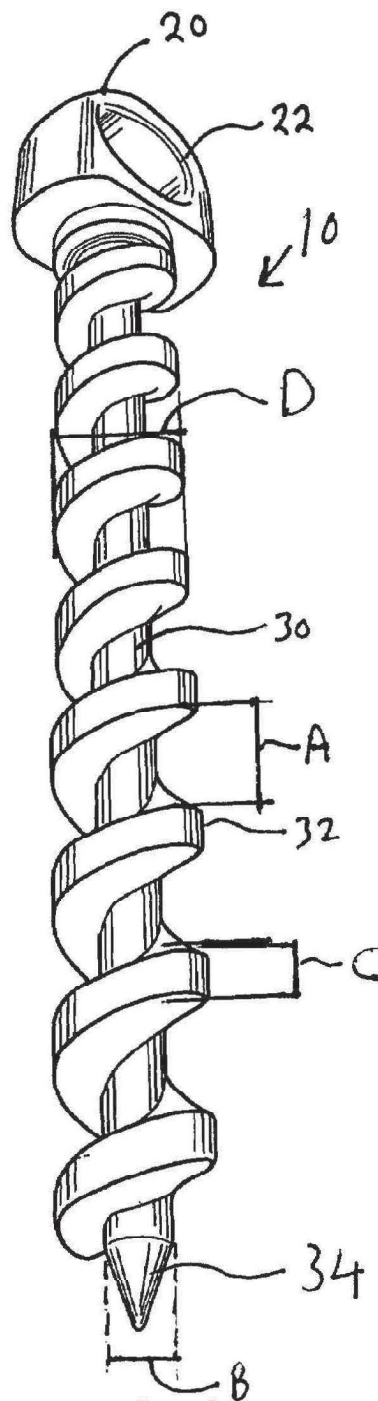


FIG. 2

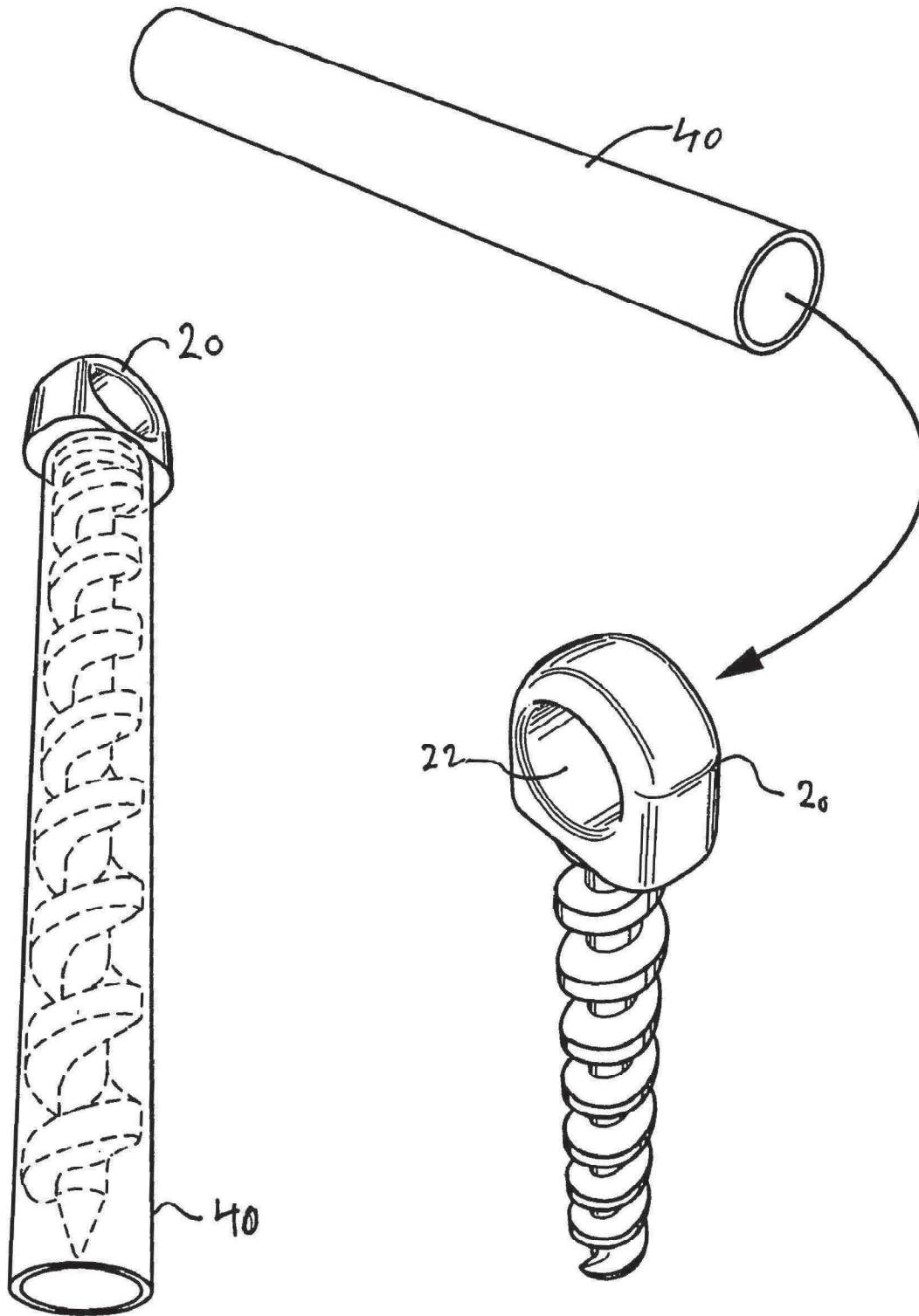


FIG. 3

FIG. 4

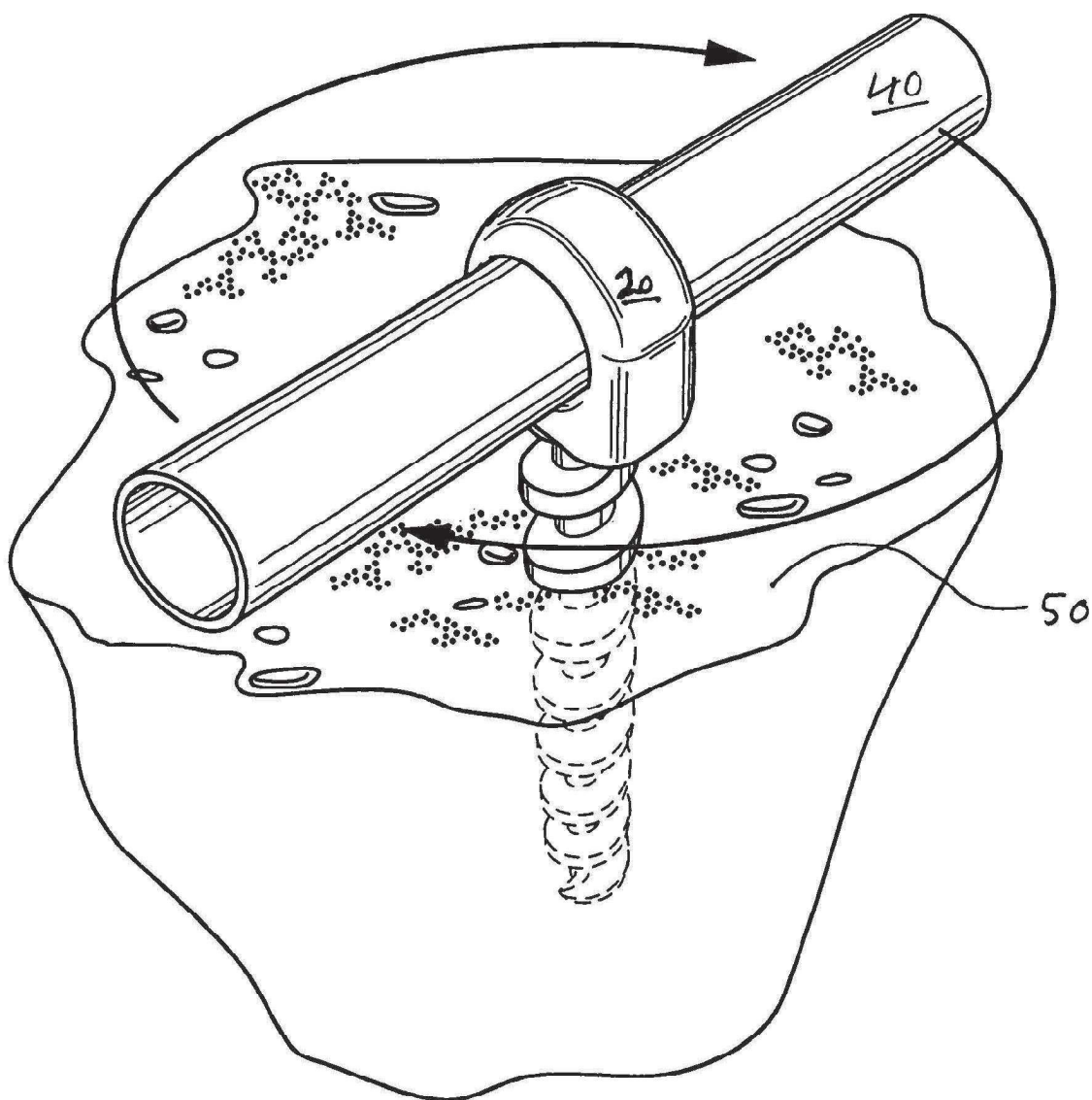


FIG. 5

US 7,309,198 B1

1

REUSABLE THREADED TIE DOWN

FIELD OF THE INVENTION

This invention is directed towards a reusable threaded tie down. The tie down includes a protective sheath which can be used as a handle for insertion and removal of the tie down into sand, soil, gravel, and similar materials. The tie down is suitable for a variety of uses including tethers, beach umbrellas, tent stakes, support stakes for new trees and shrubs, and pet tie downs.

BACKGROUND OF THE INVENTION

This invention relates to threaded or helical tie downs for use in soil, lawns, campgrounds, and beaches. As seen in reference to U.S. Pat. Nos. D381892 and D492586, the specifications of which are incorporated herein by reference, it is known to provide a threaded structure which includes a bracket or similar structure through which a rope, wire, or similar line may be attached.

Many of the threaded tie downs in the prior art are provided by metal or rigid plastics which are subject to rust, breakage, or permanent deformation if bent. Further, the cleat, head, or other attachment point of the tie down frequently has either a shape, contour, or outer dimensions which render it unsuitable for certain applications. For instance, animal tie downs are often used in association with a length of chain. The chain will frequently entangle around the attachment head of the tie down, interfering with the animal's range of movement. Further, many tie downs have an attachment head which is easily damaged if accidentally struck, while other designs pose an injury risk because of the shape of the head should one trip and/or land on an installed tie down.

Accordingly, there remains room for improvement and variation within the art.

SUMMARY OF THE INVENTION

It is one aspect of at least one of the present embodiments to provide for a threaded tie down which can be manually inserted and removed in a variety of soil types.

It is yet another aspect of at least one of the present embodiments to provide for a helical tie down which has a protective sheath surrounding the threaded portion of the tie down, the sheath further providing a handle for insertion through the head of the tie down to facilitate the installation and removal of the tie down from a substrate.

It is a further aspect of at least one embodiment of the present invention to provide for a helical tie down molded from a high impact polycarbonate plastic and having a tensile strength in excess of 22,000 pounds.

It is yet a further aspect of at least one embodiment of the present invention to provide for a helical tie down having a threaded portion attached to a head portion, the head portion containing an opening therethrough for securing a line, rope, or similar structure, the tie down head having a smooth, curved exterior surface.

It is a further aspect of at least one embodiment of the present invention to provide for a helical tie down which is provided from a high impact elastic polycarbonate which allows the tie down to be bent at an angle in excess of 30° and which can be restored to the original shape once the load is removed.

2

These and other features, aspects, and advantages of the present invention will become better understood with reference to the following description and appended claims.

BRIEF DESCRIPTION OF THE DRAWINGS

A fully enabling disclosure of the present invention, including the best mode thereof to one of ordinary skill in the art, is set forth more particularly in the remainder of the specification, including reference to the accompanying drawings.

FIG. 1 is an upper perspective view of a helical anchor of the present invention.

FIG. 2 is an elevational view of a helical anchor as seen in FIG. 1.

FIG. 3 illustrates the helical anchor with a protective sheath in place surrounding the threaded portions of the helical anchor.

FIGS. 4 and 5 illustrate placement of the protective sheath through the head of the helical anchor to facilitate the insertion and removal of the helical anchor into the soil.

DESCRIPTION OF THE PREFERRED EMBODIMENT

Reference will now be made in detail to the embodiments of the invention, one or more examples of which are set forth below. Each example is provided by way of explanation of the invention, not limitation of the invention. In fact, it will be apparent to those skilled in the art that various modifications and variations can be made in the present invention without departing from the scope or spirit of the invention. For instance, features illustrated or described as part of one embodiment can be used on another embodiment to yield a still further embodiment. Thus, it is intended that the present invention cover such modifications and variations as come within the scope of the appended claims and their equivalents. Other objects, features, and aspects of the present invention are disclosed in the following detailed description. It is to be understood by one of ordinary skill in the art that the present discussion is a description of exemplary embodiments only and is not intended as limiting the broader aspects of the present invention, which broader aspects are embodied in the exemplary constructions.

In describing the various figures herein, the same reference numbers are used throughout to describe the same material, apparatus, or process pathway. To avoid redundancy, detailed descriptions of much of the apparatus once described in relation to a figure is not repeated in the descriptions of subsequent figures, although such apparatus or process is labeled with the same reference numbers.

As best seen in reference to FIGS. 1 and 2, a threaded tie down 10 is provided having a head portion 20 and a shaft 30. The head 20 has a width which is approximately twice its thickness. Further, the width of the head defines a generally arcuate exterior surface which is devoid of any sharp angles or other surface features. An aperture 22 is defined through the length of the head 20, aperture 22 providing a location for a thread, rope, or other similar article to be attached to the tie down 10. As further seen in reference to FIGS. 1 and 2, the shaft 30 further defines helical threads 32 which extend from a position adjacent a tapered point 34 to where shaft 30 meets with head 20. As seen in reference to FIG. 2, the helical threads 32 are positioned approximately $\frac{1}{32}$ of an inch from the adjacent winding as indicated by reference line "A". Further, threads 32 define smooth, exterior edge wall surfaces which increase the strength and durability of the helical threads 32.

US 7,309,198 B1

3

As seen in reference to FIG. 2, the helical threads 32 have a thickness "C" which is about 0.5 inch. The helical threads have a pitch of about 9 windings per foot and are wound at an approximate 45° angle relative to an axis of shaft 30. As also seen in reference to FIG. 2, the thickness "C" of the helical windings, in combination with the distance "A" between the adjacent helices, are such that a significant portion of at least about 50% of the shaft 30 is not covered with the helical threads 32. The combination of the relative thickness between the diameter of shaft 30, the outer diameter of threads 32, the smooth edge wall surfaces, and the at least about 50% of the gap distance "A" represents a useful balance of dimensions that facilitates the insertion of the threaded tie down into a variety of substrates while giving the threaded tie down the flexibility to bend under heavy loads without permanent deformation or damage to the helical tie down.

The shaft 30, as seen by reference line "B" in FIG. 2 has a diameter of approximately 1/2" while the outer diameter of the shaft 30 including the helical threads 32 has a thickness of approximately 1 1/8" as seen by reference line "D". The outer diameter of helical threads 32 gradually increases such that the outer diameter "D" when measured below the head 20 is approximately 1/32" of an inch greater than the diameter when measured near the tip. The slight taper of the threads facilitates the insertion and provides for an enhanced anchoring force of the tie down 10 when inserted into a soil substrate.

As seen in reference to FIG. 3, a sheath 40 is provided which may function as both a storage tube and a handle. In FIG. 3, the shaft 30 may be inserted into the hollow sheath 40, a portion of sheath 40 extending past the tip 34 positioned over the threaded portion of the tie down 10.

The sheath 40 may be provided by a length of hollow PVC pipe. Preferably, the inner diameter of the PVC pipe is slightly greater than the outer diameter of the shaft 30 and helical threads 32 such that when the tie down 10 is inserted into the length of sheath 40, a tight friction fit is provided which keeps the respective components in place until withdrawn by the user.

As seen in reference to FIG. 4, when the sheath 40 is removed from the shaft 30, the sheath 40 may be inserted through aperture 22 so as to provide a handle useful for the insertion and removal of the tie down 10 relative to a soil substrate. As seen in reference to FIG. 5, the sheath 40 allows for greater leverage to be applied for insertion (and removal) of the tie down 10 into the soil.

The tie down 10 may be used in a variety of soil types and fulfill a number of different functions. The tie down 10 is preferably made of a high impact polycarbonate which may be used to injection mold the tie down 10. Suitable polycarbonates include high flow polycarbonates available from DuPont. Other resins which are believed useful include high impact acrylonitrile butadiene styrene (ABS) resins and high density polyethylene resins.

In one embodiment of tie down 10 formed from a high impact polycarbonate, the overall length of the tie down is approximately 13" having a threaded outer diameter of approximately 1 1/8". The embodiment described above exhibits a tensile strength of over 22,000 lbs. In addition, a 4,000 lb. force may be applied at a 30° angle without breaking the helical tie down. When subjected to strong forces, the helical tie down may bend in response to the forces. However, upon removal of the force, subsequent warming of the tie down to a temperature of about 100° F. will restore the tie down 10 to its original shape.

4

The tie down 10 is able to function in a wide variety of substrates. The tie down 10 can easily be inserted into a sandy beach where it can be used to tether a beach umbrella, shade canopies, or other articles which require a tether to prevent being blown in the wind. The tie down 10 is also useful as a tool for anchoring tents and other camping equipment. Many commercial campgrounds place tent pads on a gravel bed. The tie down 10 is able to be inserted into the gravel substrate without bending or breaking, unlike conventional metal pins, metal stakes, and/or plastic pegs.

The sheath 40 provides a protective sheath which allows the safe transport and handling of the tie down 10 while also providing a useful handle for the insertion and removal of the tie down. The sheath 40 supplies sufficient torque that installation and removal of the tie down can be accomplished without resorting to hammering or side-to-side "rocking" of the tie down in order to remove it.

The arcuate, rounded shaped head 20 provides for a smooth attachment point which does not fray or abrade ropes or other materials used to fasten an object to the tie down 10. The large, rounded shape head is also less likely to cause injury if stepped upon.

The arcuate shape of head 20 has additional advantages when tie down 10 is used as a tether for an animal. The smooth exterior shape of head 20 prevents the cord, chain, or other tether from binding or being wrapped around the head 20. As a result, the movement of the animal is not unduly restricted by having the tether bound or wrapped around a tie down. The shape of the head 20 allows use of the tie down 10 as a tether without the necessity of a swivel which is often required in other prior art designs to prevent entanglement between the tether and the tie down 10.

As is readily appreciated by one having ordinary skill in the art, the size and dimensions of the illustrated embodiment can be varied for various needs. For instance, smaller diameter and smaller height tie downs may be used for recreational tent camping. Larger tie downs, such as the described embodiment, are useful as a tether in sandy soils, having sufficient height and width to tightly adhere to the loose soil.

Tie downs 10 may be used as a bank or beach cleat to attach or stabilize a boat. Further uses include use as landscaping tethers for positioning new trees and shrubs. The tie down 10 may also be used as temporary markers for fence and post layouts, measurement of property lines, construction wall layouts, and establishing plant bed boundaries. Since the tie downs 10 are not driven by a hammer, the use of tie downs significantly reduces the hazard of puncturing a below ground cable or pipe.

Tie downs 10 may also be used as a convenient way of staking out a volley ball or badminton net as well as providing visible markers for various construction purposes, such as marking utility lines, boundary lines, and other semi-permanent marking systems.

Although preferred embodiments of the invention have been described using specific terms, devices, and methods, such description is for illustrative purposes only. The words used are words of description rather than of limitation. It is to be understood that changes and variations may be made by those of ordinary skill in the art without departing from the spirit or the scope of the present invention which is set forth in the following claims. In addition, it should be understood that aspects of the various embodiments may be interchanged, both in whole, or in part. Therefore, the spirit and scope of the appended claims should not be limited to the description of the preferred versions contained therein.

US 7,309,198 B1

5

What is claimed is:

- 1. A tie down comprising:
 - a shaft;
 - a plurality of threads operatively disposed on an exterior of said shaft;
 - a head, said head defining an arcuate exterior surface, said head further defining a bore therethrough extending through a width of the head; and,
 - a sleeve positionable between a first position as a sheath engaging an exterior of the shaft and a second position wherein said sleeve is inserted through said bore.
- 2. The tie down according to claim 1 wherein said tie down is injection molded from a material selected from the group consisting of high flow polycarbonates, high impact, acrylonitrile butadiene styrene and high density polyethylene.
- 3. The tie down according to claim 1 wherein said plurality of threads have a pitch of approximately 1 winding per about 1.25 inches.

6

- 4. The tie down according to claim 1 wherein said threads are wound about said shaft at an angle of approximately 45°.
- 5. A tie down comprising:
 - a shaft;
 - a plurality of threads having a wind angle relative to said shaft of about 45° and operatively disposed on an exterior of said shaft, said threads having a thickness of about 0.5 inches and providing an outer diameter of said threads and said shaft of substantially about 1.2 inches;
 - a head defining an arcuate exterior surface, said head further defining a bore therethrough extending through a width of the head; and,
 - a sleeve positionable between a first position as a sheath engaging an exterior of the shaft and a second position wherein said sleeve is inserted through said bore.

* * * * *

Certificate of Compliance

The undersigned certifies under Fed. R. App. P. 32(a) and Federal Circuit Rule 32(a) that this brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B)(i) as modified by Federal Circuit Rule 32(a).

Exclusive of the Fed. R. App. p. 32(f) and Federal Circuit Rule 32(b) exempted portions of the brief—*i.e.*, cover page, certificate of interest, table of contents, table of citations, statement of related cases, statement regarding oral argument, signature bloc, addendum in initial appellant or petitioner brief with corresponding appendix pagination (judgment, order or decision in question, opinion, memorandum, or findings and conclusions support it and patents-in-suit), certificates of counsel, and proof of service —this brief contains 13,988 words, which is less than the 14,000 words for opening briefs and 7,000 words for reply briefs under Federal Circuit Rule 32(a).

The brief was prepared in proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font. The undersigned relied on the word count feature of this word processing system as the basis for this certificate as permitted by Fed. R. App. P. 32(g)(1).

Dated: October 25, 2021

/s/ Andrew T. Oliver
Andrew T. Oliver
Attorney for Appellant
NeoMagic Corporation

Certificate of Service

I certify that, on October 25, 2021, I electronically filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit using the CM/ECF System and served on all counsel of record via electronic mail.

Dated: October 25, 2021

/s/ Andrew T. Oliver
Andrew T. Oliver
Attorney for Appellant
NeoMagic Corporation