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AMHIL ENTERPRISES LTD., Plaintiff, v. WAWA, INC., ET AL., Defendants.**Civil Action No. HAR 93-1349****UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MARYLAND***1995 U.S. Dist. LEXIS 3689; 34 U.S.P.Q.2D (BNA) 1645***February 21, 1995, Decided****February 21, 1995, filed****LexisNexis (TM) HEADNOTES- Core Concepts:**

COUNSEL: [*1] Attorney(s) for Plaintiff or Petitioner: Maurice U. Cahn, Richard G. Young, William F. Raucholz, Beveridge, Degrandi, et al., P.H., Washington, D.C.

JUDGES: John R. Hargrove, Senior United States District Judge

OPINIONBY: John R. Hargrove

OPINION:**MEMORANDUM OPINION**

The owner of United States Patent No. 4,421,244 (the '244 patent), Plaintiff Amhil Enterprises, Ltd. ("Amhil") filed suit against defendant M & N Plastics, Inc.'s (M & N's) for infringement. Presently before the Court are M & N's Motion for Summary Judgment of Non-infringement and Motion to Bifurcate. The issues have been fully briefed; no hearing is deemed necessary. Local Rule 105.6 (D. Md. 1994). Having reviewed the parties' memoranda and attached exhibits, the Court will grant summary judgment.

BACKGROUND

Originally issued to Hubert Van Melle and later assigned to Amhil, the '244 patent describes a thermoformed, polystyrene, disposable plastic lid for containers. Claim 1, the only independent claim of the '244 patent, discloses:

1. A lid for containers, made of thin, flexible plastic, for mounting on and receiving the bead of a container, comprising:

a central panel;
a cavity extending around the periphery of [*2] the lid and

opening downwardly and inwardly to receive the bead of a container to which said lid is fitted;

means connecting said cavity to said central panel;

a skirt portion extending downwardly from said cavity;

said skirt portion having a plurality of outwardly extending projections, each having a substantially vertical face with substantially vertical side edges, and substantially vertical side walls extending inwardly from said face;

the portions of said skirt that are between said outwardly extending projections extending inwardly to a waist portion having [sic] a plurality of interruptions, one at each projection, and forming an undercut defining said cavity in said waist portion;

said outwardly extending projections and said waist portion all terminating in their lower extremities at a downwardly and outwardly sloped lower band portion;

and said outwardly extending projections terminating in their upper extremities at a respective upper, band portion extending inwardly and upwardly from the upper edge of each said respective vertical face and terminating at said cavity in an upper undercut which is higher and

less inwardly extending than the undercut of said waist portion, [*3] and which defines the peripheral cavity over said outwardly extending projections.

Amhil alleges that M & N infringed on its patent by manufacturing its own plastic lids for containers embodying the patented invention, and distributing and selling the infringing lids. M & N has moved for summary-judgment, contending that the '244 patent does not cover their product because the accused lids do not have a cavity which opens "downwardly and inwardly" or "outwardly extending projections" with a "substantially vertical face with substantially vertical side edges and substantially vertical side walls."

DISCUSSION

Summary judgment will be granted when no genuine dispute of material fact exists and the moving party is entitled to judgment as a matter of law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986). In considering M & M's motion, the Court views the underlying facts and all reasonable inferences drawn therefrom in the light most favorable to Amhil, the party opposing summary judgment. *Matsushita Electrical Industrial Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 89 L. Ed. 2d 538, 106 S. Ct. 1348 (1986).

An analysis of [*4] patent infringement involves a two-step process. The first step is to interpret the patent claim, a question of law. Reference to the actual language of the claims, the specification, the prior art, and the prosecution history of the patent in the Patent Office helps determine the meaning of the patent claim. *SRI International v. Matsushita Electric Corp.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985). The second step asks whether the claims cover the accused device, an issue of fact. To establish infringement, Amhil must show that the accused lid encompasses every limitation of the claim, or its equivalent. "Each element of a claim is material and essential, and . . . in order for a court to find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device." *Lemelson v. United States*, 752 F.2d 1538, 1551 (Fed. Cir. 1985). Although the patent-in-suit includes eight claims, the parties have focused solely on the elements contained in claim 1, the only independent claim. "It is axiomatic that dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed." *Wahpeton [*5] Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989).

Both parties focus their arguments on the factual issue of infringement, apparently agreeing that the scope

of the claim is clear. In support of their respective positions, the parties dispute whether the accused product contains a "cavity" opening "downwardly and inwardly," and "outwardly extending projections" with "substantially vertical" faces, side edges, and side walls. Inherent in the issue of infringement, however, is the appropriate interpretation of these phrases, a legal question of claim construction that may in turn affect the application of the terms to the accused product.

The specification provides the primary basis for construing the claim. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). 35 U.S.C. § 112 requires that a specification contain a written description of the invention, its manufacture and use, and the best mode for carrying out the invention, concluding with one or more claims. *Id.* "The descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based upon the description." [*6] *Id.*

Regarding the claimed element of a cavity "opening downwardly and inwardly," the patent specification clearly discloses a peripheral cavity of the cup lid with an outer wall which forms the outer skirt and inwardly extending wall or inner skirt which extends toward the central panel of the lid. The cavity opens downwardly and inwardly to receive the bead of the cup, which the outer skirt grasps. Because the inner skirt extends towards the central panel of the lid, the cavity is bound only by the curvature of the outer skirt, thus allowing the lid to accommodate a wide range of bead sizes and cup mouth diameters of containers of a given nominal size. Defendant's Exhibit 1, col. 3, lines 16-19; col. 4, lines 60-70.

Since the ultimate determination of infringement is a fact issue, "a motion for summary judgment on that issue should be approached with great care by the district court." *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985). Nevertheless, summary judgment may be warranted where no genuine issue of material fact exists. In the absence of any need for expert evidence to explain the nature of the patented invention or the accused product, or to assist in [*7] their comparison, the question of infringement becomes one of law. See, e.g., *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 74 L. Ed. 147, 50 S. Ct. 9 (1929); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275, 48 L. Ed. 437, 24 S. Ct. 291 (1904).

With respect to the peripheral cavity in the accused lid, Amhil's entire argument is that the presence of an "undercut" in the accused lid indicates that the cavity must open inwardly; not just downwardly as M & N contends. Plaintiff's Opposition, p. 15. Even assuming that the accused lid does contain a peripheral cavity with an outer

skirt that extends downwardly and inwardly to receive the bead of the cup, it differs from the patented product by containing an inner skirt that extends downwardly to form an inner wall that rests against the inside cup rim. Amhil's lid, in contrast, contains an inner skirt that simply extends laterally towards the central panel of the lid. Both an outer and inner wall, between which the rim of the cup sits, thus restricts the peripheral cavity of M & N's lid. Although the outer skirt of the accused lid also contains intermittent projections and alternating indentations that form a waist to [*8] grasp the outside of the cup rim, the placement of the inner wall of the peripheral cavity against the inside of the cup rim improves the seal that the accused lid provides over that which the patented lid offers.

The presence of an inelastic descending inner skirt in the peripheral cavity also restricts the variance of bead sizes and mouth diameters of containers of any given size for which the accused lid is capable of accepting. This limitation directly contrasts with the patent specification, which advises that the cavity may accommodate a wide tolerance of bead sizes and mouth diameters of different sized containers that have a given nominal size. Defendant's Exhibit 1, col. 3, lines 13-19; col. 4, lines 60-70; col 6, lines 11-23. Given the lid material's lack of flexibility, the design of the inner skirt extending inwardly towards the central panel in the patented lid, instead of downwardly in the accused lid, allows for this wider tolerance since the interrupted undercut on the outer skirt is the only part of the lid that must grasp the cup bead, creating a flexible "garter-spring" configuration. Defendant's Exhibit 1, col. 1, lines 21-28. Therefore, the accused lid does not [*9] literally infringe on the patent-in-suit.

Even where literal infringement does not exist, the Court must consider whether infringement under the doctrine of equivalents has occurred. For infringement under this equitable doctrine to result, the accused product must "perform[] substantially the same function in substantially the same way to obtain the same result." *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608, 94 L. Ed. 1097, 70 S. Ct. 854 (1950) (internal quotation marks and citations omitted). "To be a 'substantial equivalent,' the element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed." *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1533 (Fed. Cir. 1987). Although infringement under the doctrine of equivalents is normally a factual inquiry, *Graver*, 339 U.S. at 609, the evidence is undisputed that the accused lid fastens onto the entire rim in a different manner from the patented lid. Furthermore, although the specification describes the invention as "applicable for use

with containers designed [*10] for holding hot beverages or cold beverages," it clearly emphasizes that the lid "is more particularly intended for use with cold beverages." Defendant's Exhibit 1, col. 1, lines 7-10. In contrast, "inside fit" lids are generally better suited to cover containers holding hot beverages. See, e.g., Affidavit of Fred Wiechec, Defendant's Exhibit 5, P 7. The accused product thus does not "perform substantially the same function in substantially the same way to achieve the same result." Claim 1 of the patent-in-suit therefore does not read on the accused lid under a theory of either literal infringement or the doctrine of equivalents as a matter of law; summary judgment of non-infringement is warranted.

Even if claim 1 of the patent-in-suit did encompass the plugfit construction of the accused lid, summary judgment is still proper because the "outwardly extending projections" on the accused lids slope upwardly and inwardly towards the peripheral cavity. Claim 1 of the patent-in-suit calls for the skirt portion of the patented lid to form a number of outwardly extending projections, each of which has a "substantially vertical face with substantially vertical side edges, and substantially [*11] vertical side walls."

The specification and prosecution history help interpret the meaning of "substantially" and the literal coverage of the claim. See *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1056 (Fed. Cir. 1988), cert. den., 488 U.S. 825, 102 L. Ed. 2d 51, 109 S. Ct. 75 (1988). The specification depicts the projections as having "a substantially rectangular front face," Defendant's Exhibit 1, col. 4, line 25, and describes the side edges and side walls both as "vertical," Defendant's Exhibit 1, Abstract, lines 7-8; col. 4, lines 26-27, and "substantially vertical," Defendant's Exhibit 1, col 2, lines 55-56. The apparent interchangeability of the terms "vertical" and "substantially vertical" throughout the patent-in-suit indicates that the latter term is a close approximation of the former. While a "substantially vertical" edge or side wall could also be described as "sloped," Amhil's proposition that anything that is more vertical than horizontal is "substantially vertical" must be rejected as overly broad.

M & N resorts to the prosecution history of the patent-in-suit to define "substantially vertical." The prosecution history (or file wrapper) of the patent [*12] chronicles the entire record of proceedings in the Patent and Trademark Office ("PTO") and restricts the interpretation of claims to the representations that an applicant makes to induce a patent grant. *Standard Oil*, 774 F.2d at 452. The words of a claim generally convey their ordinary meaning to one of skill in the art, unless the patent or file history reveals that the inventor used them differently. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed. Cir. 1992).

A conflict between extrinsic evidence that the inventor may have subjectively intended a different meaning and the ordinary meaning that one of skill in the art would attach from the patent and its history does not preclude summary judgment. *Id.* "In such instance, there is no genuine dispute respecting a material fact." *Id.* (emphasis in original).

The file wrapper reveals that the Patent Examiner initially rejected all claims that the patentee submitted, explaining:

Claims 1-9 are rejected under 35 U.S.C. 103 as being unpatentable over Zabner et al in view of Davis ('708) . . . the differences between the subject matter sought to be patented and the prior art are such that [*13] the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. To modify Zabner et al by providing portion 44 as discontinuous portions with a substantially vertical face, side edges and side walls would be obvious in view of Davis.

Defendant's Exhibit 8, p. 33. Claim 1 of the Zabner patent discloses a downwardly extending peripheral skirt containing "a plurality of peripherally spaced inwardly directed generally U-shaped detents . . ." Defendant's Exhibit 9, col. 4, lines 12-17. In challenging the rejection, the patentee argued that the "substantially vertical" outer faces and side edges of the projections distinguish his invention from the Zabner lid by allowing his lid to be easily stripped from the mold "while still providing the much deeper undercut that gives the lid of the present invention a much greater advantage over the Zabner lid." Exhibit 8, p. 41. By emphasizing this distinction between and advantage of his lid over the prior art, the patentee established that the "substantially vertical" faces, side walls and side edges of the projections on his invention [*14] excluded ones "inwardly directed," or sloped, such as those referenced in the Zabner patent. Amhil may not now attempt to recapture that element which it specifically and intentionally excluded in order to obtain its patent. Patent claims must be construed the same way for both patentability and infringement. See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988); *W.L. Gore & Associates, Inc. v. Garlock Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988).

Applying the claim language to the accused lid reveals that literal infringement has not occurred. Each projection on the M & N lid contains a face that slopes upwardly and inwardly towards the peripheral cavity. The edges and side walls of the projections extend downwardly and laterally outwardly to form a sloped facade with a trapezoidal appearance, thereby distinguishing the projections from those described in the patent-in-suit.

The accused lid does not infringe on Amhil's patent under the doctrine of equivalents either. As discussed above, the doctrine of file wrapper estoppel precludes Amhil from expanding the claims in its patent to include any projections which lack "substantially [*15] vertical" faces, side walls, and side edges. The sloped segments of the projections on M & N's lid place it outside the reach of the patent-in-suit, requiring a conclusion of non-infringement as a matter of law.

CONCLUSION

For the reasons stated above, the Court concludes that the patent-in-suit does not read on M & N's plastic lid, either literally or by creating an equivalent. Consequently, summary judgment of non-infringement is warranted. It will be so ordered.

2/21/95

Date

John R. Hargrove

Senior United States District Judge

ORDER

For the reasons set forth in the attached Memorandum Opinion, IT IS this 21st day of February, 1995, by the United States District Court for the District of Maryland, hereby ORDERED:

1. That M & N's Motion for Summary Judgment of Non-infringement BE, and the same hereby IS, GRANTED.
2. That M & M's Motion to Bifurcate BE, and the same hereby IS, DENIED AS MOOT.
3. That the Clerk of the Court CLOSE this case.
4. That the Clerk of the Court mail copies of this Memorandum Opinion and Order to all parties of record.

John R. Hargrove

Senior United States District Judge