United States District Court,
N.D. Illinois, Eastern Division.

ABBOTT LABORATORIES,
Plaintiff.
v.
MEAD JOHNSON & COMPANY,
Defendant.

June 13, 1996.

MEMORANDUM OPINION AND ORDER

ZAGEL**, District Judge.**

Abbott Laboratories (Abbott) has sued Mead Johnson & Company (Mead Johnson) for infringement of claims 1, 3-6, 8-11 and 13 of United States Patent No. 4,934,545 (the " '545 Patent") and infringement of United States Patent No. 330,332 (the " '332 Design Patent"). At issue are cross-motions for summary judgment for infringement of the '545 Patent, Mead Johnson's motion for summary judgment of the '332 Design Patent, and Mead Johnson's motion for attorneys' fees incurred in responding to the claim of infringement of the '332 Design Patent.

Background

The patented and accused devices are closures for plastic ready-to-hang enteral nutritional formula containers. Enteral nutritional formulas are nutritionally complete liquid products that are consumable by mouth or via a feeding tube. Many individuals in health care facilities are chronically unable to ingest enough food to meet their nutritional needs. For these patients, intravenous feeding is not feasible on a long-term, sustained basis. In response to this problem, liquid foods have been developed for enteral feeding.

Early enteral nutritional product containers were empty, sterilized pouches. Health care providers opened the enteral nutritional formulas and poured them into the pouches for administration to the patient. The filled pouch was spiked with a cannula (the insertion of a hollow needle) to allow the flow of the liquid product into the feeding tube. This type of packaging had shortcomings, such as potential product contamination and extensive set-up time.

Ready-to-hang containers are pre-filled with enteral nutritional formula ready for administration to the patient. These containers reduce the time and labor costs involved in administering the formula and maintain sterility. To function properly, the ready-to-hang system requires the introduction of air into the container during patient feeding to prevent the formation of a vacuum within the container. The prior state of the art provided for the introduction of air into the container through the use of a closure for the ready-to-hang container with a stainless steel ball, check valve system and external microbial filter. The purpose of the filter is to prevent contamination of the liquid product in the container by microbes over the relatively long period that the container is in use in feeding the patient.

Enteral feeding products contain minerals and other solids tending to form a sediment which settles to the bottom of the inverted container during feeding. Because of the physical composition of the enteral nutritional products used in the ready-to-hang system, the traditional steel ball, check valve system

frequently became clogged, causing bottle collapse and system failure. This type of closure was relatively expensive and somewhat complicated.

The '545 Patent

The '545 Patent is directed to a new closure for a ready-to-hang container which permits less costly and more efficient production of closures while ensuring proper microbial filtration. The '545 Patent places the microbial filter in direct contact with the food product during usage and thus contains an internalized microbial filter. As long as the filter is wet, it permits the introduction of air into the container as the feeding process continues, without contamination of the product. This direct contact of the filter with the liquid is critical to the invention because, if the product is allowed to dry on the filter, the dried product tends to clog the filter and thereby restricts the necessary flow of air into the container. In order to maintain direct contact with the liquid, the filter is secured to the bottom surface of the closure. The "Best Mode" described in the patent specifications to secure the filter is to fuse the heat staked material of the filter to the bottom surface of the closure. Heat staking occurs when two materials are brought together in the presence of sufficient heat and pressure so as to form one material. In prior art devices, the presence of the ball tended to preclude direct contact between the food product and the filter. The '545 Patent eliminates the need for the ball and external filter.

Another aspect of the invention is to have a means to limit air flow to the filter, to prevent drying of the liquid product on the filter and resultant clogging of the filter which would impede or halt air flow into the container. The specifications to the '545 Patent disclose the means to limit atmospheric air access as an air grate with several small holes into which air may pass prior to interaction with the filter. The air grate is stretched across the opening of a channel in the second projection on the closure. The channel allows air access to the filter.

The accused device is also a closure for ready-to-hang enteral nutritional formula containers. The two devices are very similar, however, in the accused device the filter is mounted in and supported by a cylindrical filter housing. The filter housing is pressed onto a matting and secured to the closure by the use of the filter housing. Also, the air passageway in the accused device is a tubular shape in the second projection, and it does not have an air grate to limit air access.

The '332 Design Patent

The '332 Design Patent is directed to the ornamental design for a combined bottle cap and dust cover. The title of the design patent is "Combined Bottle Cap and Dust Cover." During prosecution of the patent the Examiner required this designation and the claim was amended to read this way.

DISCUSSION

Summary judgment should be granted when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c); Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986). Summary judgment is as appropriate in a patent case as in any other. Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd., 731 F.2d 831, 835 (Fed.Cir.1984). This is true especially with respect to issues regarding the proper scope of patent claims because "the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court." Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71 (Fed.Cir.1995), *aff'd* 116 S.Ct. 1384 (1996).

'545 Patent

I. ***Legal Standard***

To determine whether a patent claim has been infringed the claim must first be properly construed to determine its scope and meaning. Then, the claim as properly construed must be compared to the accused device or process. Carroll Touch, Inc. v. Electro Mechanical Systems, Inc., 15 F.3d 1573, 1576 (Fed.Cir.1993). Patent infringement is found if the accused device embodies every limitation of the claim, either literally or by an equivalent. *Id*.

(A) Claim Construction

The first step, claim construction, involves ascertaining the true meaning and scope of each claim. Markman v. Westview Instruments, Inc., 116 S.Ct. 1384, 1387 (1996). Claims must be interpreted in light of the claim language and specification, the prosecution history, the other claims in the patent, the prior art, and the interpretation which those skilled in the art would give the claim. Carroll Touch, 15 F.3d at 1577; SRI Intern. v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1118 (Fed.Cir.1985). Courts cannot narrow or broaden the scope of a claim to give the patentee something different than what he has set forth. E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed.Cir.), *cert. denied,* 488 U.S. 986 (1988).

i. Specifications

Claims are read in light of the specifications. SRI Intern., 775 F.2d at 1122. However, courts cannot read into a claim a limitation that appears only in the specifications since the claim measures the invention, not the specifications. SRI Intern., 775 F.2d at 1122.

ii. Prosecution history

Claims are also read in light of the prosecution history. The prosecution history of the patent consists of the entire record of proceedings in the Patent and Trademark Office. The prosecution history limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance. This is the doctrine of prosecution history estoppel or file wrapper estoppel. Standard Oil Co. v. American Cyanimid Co., 774 F.2d 448, 452 (Fed.Cir.1985). The legal standard for determining what subject matter was relinquished is an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history, that the applicant gave up to procure issuance of the patent. Hogonas AB v. Dresser Industries, Inc., 9 F.3d 948, 952 (Fed.Cir.1993), *reh'g denied*. *See also* Bayer Aktiengesellschaft v. Duphar Intern. Research B.V., 738 F.2d 1237, 1243 (Fed.Cir.1984).

iii. Means-Plus-Function

A means-plus-function limitation permits a patentee to express an element in a combination claim as a means for performing a function, without reciting a structure, material, or act which performs the specified function. Valmont Industries, Inc. v. Reinke Mfg. Co., Inc., 983 F.2d 1039, 1042 (Fed.Cir.1993). 35 U.S.C. s. 112, para. 6 of the Patent Act provides explicit guidance for interpretation of claim elements expressed in means-plus-function terms. Valmont, 983 F.2d at 1041.

In addition to reciting the means for performing a function in the patent claim, a patentee must describe in the patent specifications some structure which performs the specified function. Valmont, 983 F.2d at 1042. However, there is no requirement that patentees describe or predict every possible means of accomplishing that function. D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1574 (Fed.Cir.1985). A court must then construe the functional claim language "to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. s. 112, para. 6.

(B) Infringement

The second step analyzes whether a claim covers an accused device; this is a question of fact. Baxter Healthcare Corp. v. Spectramed, Inc., 49 F.3d 1575, 1582 (Fed.Cir.), *cert. denied,* 116 S.Ct. 272 (1995). Infringement, literal or by equivalence, is determined by comparing an accused product with the properly and previously construed claims. SRI, 775 F.2d at 1121.

i. Literal Infringement

(a) Literal infringement is found when every limitation of a claim reads on, that is, is found in the accused structure. Baxter, 49 F.3d at 1582. Each limitation of the claim must be met by the accused device exactly, any deviation from the claim precludes a finding of infringement. Lantech Inc. v. Keip Mach. Co., 32 F.3d 542, 547 (Fed.Cir.1994).

(b) Literal infringement of a means-plus-function claim exists only when the accused device performs the identical function claimed in the patent and incorporates the structure disclosed in the specification or its substantial equivalent, as the means for performing that function. Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388-89 (Fed.Cir.1992). An equivalent results under section 112 from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification. *Id.* If the required function is not performed exactly in the accused device or the accused structure is not equivalent to the disclosed structure, then section 112 equivalency is not involved. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (FedCir.1987), *cert. denied,* 485 U.S. 961 (1988).

ii. Doctrine of Equivalents

When no literal infringement is found, infringement may still be found with the application of the doctrine of equivalents if the accused devise performs substantially the same function in substantially the same way to obtain the same result. Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed.Cir.), *cert. denied,* 116 S.Ct. 515 (1995) (internal quotations omitted). This is known as the function-way-result test. For a process to work in substantially the same way, all of the limitations of the claim must be satisfied at least equivalently. Becton Dickinson and Co. v. C.R. Bard, Inc., 922 F.2d 792, 798 (Fed.Cir.1990).

One-to-one correspondence between components of the accused device and the claimed invention are not necessary, yet the accused device must contain *every* limitation or its equivalent. Dolly, Inc. v. Spalding & Evenflo Companies, Inc., 16 F.3d 394, 398 (Fed.Cir.1994). To be a substantial equivalent, the substituted element must not substantially change the way in which the function of the claimed invention is performed. Pennwalt, 833 F.2d at 935, quoting, Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532-33 (Fed.Cir.1987).

II. *Claim Construction and Infringement Analysis*

The claims at issue in the '545 Patent are claims 1, 3-6, 8-11 and 13. The parties agree that only two limitations to the claims are at issue. The first limitation is *said bottom surface having a filter secured thereto*. The second limitation is *means to limit atmospheric air access to said filter*. FN1 However, the parties dispute the meaning of these claim limitations and whether they are infringed.

FN1. Mead Johnson admits that its closures contain all but these two elements.

(A) Said bottom surface having a filter secured thereto

Mead Johnson contends that this claim limitation, "said bottom surface having a filter secured thereto" requires the filter be secured directly to the bottom surface without any filter housing or other similar intervening support structure in a manner that eliminates the need for a filter housing. Mead Johnson further claims that securing the filter to the bottom surface obviates the need for the ball and housing of the

conventional filter means. Mead Johnson bases its reasoning on the patent specifications. The specifications clearly state that the closure "eliminates the need for the housing associated with filter means 30." The specifications further state under the "Best Mode" that "the closure of this invention may be fabricated by molding the actual cap and then fusing the heat staked material of the filter to the bottom surface of this closure thereby obviating the need for the ball and the housing of the conventional filter means."

Abbott contends that Mead Johnson reads limitations into the claim which do not exist. Abbott asserts the claim requires that the filter must somehow be fastened or attached to the bottom surface of the closure, but that the filter need not be directly attached to the bottom surface without any intervening support structure. Abbott's argument is based on a plain language reading of the term "secure."

I reject Mead Johnson's interpretation of the claim. Mead Johnson urges this Court to read into the claim, limitations found only in the specifications.

First, Mead Johnson asks this Court to interpret all of the claims of the patent to require the filter be secured directly to the bottom surface without an intervening structure. Neither the claims nor the specifications place this limitation. Claim two of the '545 Patent, which is not claimed to be infringed, does specify how the filter is to be secured to the bottom surface. It reads: "said filter is heat staked material which is fused to said bottom surface." However, the limitation in claim two is a dependent claim FN2 and is not contained in any other claim. Therefore, it cannot be read or implied into any other claim. C & F Packing Co., Inc. v. IBP, Inc., 916 F.Supp. 735, 742-43 (N.D.Ill.1995), citing, D.M.I., Inc., v. Deere & Co., 755 F.2d 1570 (Fed.Cir.1985). The "Best Mode" of the specifications also indicates a method to secure the filter. It reads: "this invention may be fabricated by molding the actual cap and then fusing the heat staked material of the filter to the bottom surface of this closure thereby obviating the need for the ball and the housing of the conventional filter means." However, the specifications clearly state that the invention "may" be constructed this way, but that "the invention is not limited to this precise form of apparatus or method." Furthermore, it is clear that the "Best Mode" embodiment of the invention does not restrict the claim. SRI, 775 F.2d at 1122.

FN2. There are two types of claims in a patent: independent and dependent claims. An independent claim stands on its own and does not refer to any other claim in the patent, thus it must be read separately from the other claims when determining its scope. A dependent claim includes a reference to at least one other claim in the patent and incorporates all of the elements of the claim to which it refers. C & F Packing Co., Inc. v. IBP, Inc., 916 F.Supp. 735, 742-43 (N.D.Ill.1995), citing, D.M.I., Inc., v. Deere & Co., 755 F.2d 1570 (Fed.Cir.1985). The additional limitations of a dependent claim must not be read or implied into an independent claim if said independent claim does not contain the same limitation. C & F Packing Co., 916 F.Supp. at 743 (N.D.Ill.1995), D.M.I., 755 F.2d 1570.

Next, Mead Johnson asks this Court to find that the claims preclude the use of a filter housing unit. Again, neither the claims nor the specifications place this limitation. To the extent the specifications describe the claimed invention as eliminating or obviating the need for a filter housing, they clearly state the invention closure "eliminates the need for the housing associated with filter means 30" with the possible exception of aesthetic purposes. Filter means 30 is an "external filter" as described in the specifications. Thus, assuming the specification language can be read to limit the claims, the '545 Patent would be read to eliminate the external filter, not an internal filter secured to the inside of the closure as in the patented and accused products.

Finally, the specifications describe the "Best Mode" of the invention as eliminating the need for the filter housing. However, since the invention is not limited to the precise form described in the specifications and the claims themselves do not limit the invention in this way, the '545 Patent cannot be read to eliminate the filter housing.

The claim limitation "said bottom surface having a filter secured thereto" turns on the meaning of the word "secure." The words of a claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the prosecution history that they were used differently by the inventor. Carroll Touch, 15 F.3d at 1577. According to Webster's dictionary, the word "secure" means "well-fastened," "to make tight or firm: fasten," "not likely to fail or give way: stable." Webster's II New Riverside University Dictionary pp. 1055. The Oxford English Dictionary defines "secure" as "firmly fastened." The Oxford English Dictionary, 2nd Edition, XIV, pp. 853. The word "fasten" means "to attach firmly to: join," to close, as by fixing firmly in place," "to cling fast," Webster's at pp. 466, "to attach together," Oxford, V, pp. 750. I read this claim to mean that the filter must be firmly attached to the bottom surface in some way, but does not require direct contact between the filter and the bottom surface, nor does it require the elimination of the filter housing.

(B) Literal Infringement

Mead Johnson admits the filter in the accused device is mounted in a cylindrical filter housing which is pressed onto a matting projection located in a recess in the inside of the closure. The cylindrical filter housing is fitted over a projection to secure it in place. Mead Johnson further admits that the filter in the '545 Patent is also placed on the inside of the closure. It is thus clear that the filter in the accused device is firmly attached to the inside of the closure by means of the filter housing. Because the claim does not eliminate the filter housing and does not require direct contact between the filter and the bottom surface, I find the claim "said bottom surface having a filter secured thereto" to be literally infringed by the accused device. Summary judgment is granted in favor of Abbott on this issue.

i. Means to limit atmospheric air access to said filter

(a) Construction

Both parties agree that this limitation, "means to limit atmospheric air access to said filter" is a "means plus function" limitation. The specifications disclose the structure which performs this function as "air grate 55 which has several small holes into which air may pass prior to interaction with the surface of the filter 52."

Mead Johnson asserts this claim limitation should be read in its entirety as follows: "said second projection associated with said means to limit atmospheric air access to said filter." Thus, according to Mead Johnson, the limitation requires the "means to limit atmospheric air access to said filter" and the "second projection" to be two distinct limitations that cannot be merged into one. Mead Johnson bases its interpretation on the language of the claim limitations and the prosecution history.

Mead Johnson asserts that referring to two elements of the claimed invention and reciting the particular relationship they have to one another, "associated with," creates two separate and specific limitations that cannot be reduced to a single limitation. Mead Johnson relies upon Dolly, Inc. v. Spalding & Evenflo Co., Inc., 16 F.3d 394 (Fed.Cir.1994) to support this position. *Dolly* dealt with a portable adjustable child's chair. At issue was whether the claim language required the chair's body support to be provided by a seat and back panel in addition to a separate stable rigid frame or whether the body support could be provided by a stable rigid frame that includes the seat and back panels. The court concluded that the claim language required the stable rigid frame to be formed independent of the seat and back panels because of the specific relationship recited between the rigid stable frame and the seat and back panels.FN3 *Id*. at 397.

FN3. The claim language in question in *Dolly* read: "a stable rigid frame which is formed *in part* from said side panels, and which *along with* said seat panel and said back panel provides a body supporting feature." Dolly, 16 F.3d at 396 (emphasis added).

Mead Johnson is correct to point out the court's reliance on the language of relationship between claims to

determine claim construction. However, the language of relationship in the present case does not support Mead Johnson's theory. The claims at issue do not require the "means to limit air access" be independent of the "second projection." Rather, the claim specifically states that the means to limit air access be "associated with" the second projection.

The claim limitation thus turns on the meaning of "associated with." The words are given their ordinary meaning unless it appears from the specifications or prosecution history they were used differently by the inventor. Carroll Touch, 15 F.3d at 1577. Mead Johnson would have this Court read these words to mean "in addition to." However, Webster's dictionary defines "associated" as "to unite in a relationship" or "to connect or join together," Webster's II New Riverside University Dictionary pp. 132, and the Oxford English Dictionary defines it as "joined in companionship," "united in action or purpose," The Oxford English Dictionary, 2nd Edition, I, pp. 718. I read this claim to mean that both limitations, the second projection and means to limit air access, must exist, but they may be joined together and need not exist as separate structures. This interpretation is supported by the fact that under the doctrine of equivalents, infringement may still be found when separate claim limitations are combined into a single component of the accused device. Dolly, 16 F.3d at 398.

Mead Johnson argues the prosecution history establishes the "second projection" and "means to limit air access" as separate requirements. The prosecution history establishes the following. Original claim 1 did not require either a second projection or a means to limit air access. Original claim 3, which was dependent on claim 1, recited a means to limit atmospheric air access to the filter, but did not mention the second projection. Both claims were rejected. However, original claim 4, which was dependent on claim 3, did recite that the closure included a second projection, being associated with the means to limit air access. Claim 4 was not rejected, rather it was cancelled by Abbott and included in amended claim 1. Mead Johnson concludes from this history that Abbott is estopped from presenting a claim interpretation which would effectively eliminate the separate requirements of a means to limit air access and a second projection as was formerly present in original and cancelled claims 1 and 3. Further, Mead Johnson argues that to permit Abbott to merge the means to limit air access and second projection into a single limitation would permit recapture of the scope of protection that was surrendered with the cancellation of original claim 3.

Mead Johnson misreads the prosecution history. Abbott claims nothing different than what was originally present in claim 4, the claim that was not rejected. Abbott does notin attempt to merge the means to limit air access and second projection into a single limitation, and I do not read the claims this way. As already stated, I find both limitations must exist, but they may be joined together.

(b) Literal Infringement

In order to find literal infringement of the "means to limit atmospheric air access to said filter" claim limitation, the accused device must also limit air access to the filter and incorporate the air grate disclosed in the specifications as the means to perform this function or incorporate its substantial equivalent. Intellicall, 952 F.2d at 1388-89.

Abbott asserts the second projection on the Mead Johnson closure has a reduced diameter opening over the filter such that it limits air access to the filter and thus performs the same function as the patented device. Mead Johnson disputes this assertion and argues the second projection does not limit air access to the filter. Assuming the second projection in the accused device does limit air access as Abbott claims, to find literal infringement the accused device must still incorporate the structure disclosed in the specifications, the air grate, or its substantial equivalent. Abbott contends the second projection in the accused device is substantially equivalent to the air grate described in the specifications. Abbott is mistaken. While the accused device's second projection may have a reduced opening to limit air access, it is not substantially equivalent to the air grate described in the specifications. The specifications describe the air grate as a structure with several small holes into which air may pass. There is no air grate in the accused device and

the air passageway is unobstructed. Although both structures may limit air access to the filter, the means by which air passes through the accused structure is not substantially equivalent to the way air passes through an air grate. Regardless of whether the accused structure serves the same function as the patented structure, the accused device does not literally infringe the means to limit air access claim limitation since the structures are not substantially equivalent. Thus, summary judgment is granted in favor of Mead Johnson on this issue.

(c) Doctrine of Equivalents

Abbott next argues that the second projection infringes the '545 Patent under the doctrine of equivalents. In applying this doctrine, I must determine whether the second projection performs substantially the same function of limiting air access in substantially the same way to obtain the same result. Southwall Technologies Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed.Cir.1995). The first prong of the test is in dispute. Abbott asserts the second projection in the accused device has a reduced inner diameter which limits air access to the filter. Mead Johnson agrees that its second projection has a reduced diameter passageway. However, Mead Johnson claims all such passageways would have a reduced diameter and denies that its second projection limits air access. A material issue of fact exists as to whether the second projection limits air access to the filter, thereby performing substantially the same function as the patented device. Summary judgment is therefore denied as to both parties on this issue under the doctrine of equivalents.

'332 Design Patent

I. ***Legal Standard***

A design patent protects the nonfunctional aspects of an ornamental design as it is shown in the patent. Determining whether a design patent has been infringed involves the same two part test used above with utility patents. First, the claim must be properly construed to determine its meaning and scope. Second, the claim as properly construed must be compared to the accused design to determine whether there has been infringement. Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed.Cir.1995).

(A) Claim Construction

A design patent is limited to the ornamental design of the article and does not include claims to the structural or functional aspects of the article. Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1188 (Fed.Cir.1988). It is the non-functional design aspects that are pertinent to determinations of infringement and construing the claim. *Id*.

(B) Infringement

Infringement of a design patent requires a showing that the accused design is substantially the same as the claimed design. Payless Shoesource, Inc. v. Reebok Intern. Ltd., 998 F.2d 985, 990 (Fed.Cir.1993). The standard for design infringement was first set out by the Supreme Court in Gorham Mfg. Co. v. White, 81 U.S. (14 Wall.) 511 (1871) and continues to be used today. The *Gorham* test requires the comparison of the patented and accused designs for overall visual similarity as it states:

if, 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.

Gorham, 81 U.S. at 528.

Generally, the accused design is compared to the claimed design and not the commercial embodiment.

Payless Shoesource, Inc. v. Reebok Intern. Ltd., 998 F.2d 985, 990 (Fed.Cir.1993). However, when no significant distinction in design has been shown between the patent drawing and its physical embodiment, it is not error for the court to compare the embodiment of the patented design with the accused device. Lee, 838 F.2d at 1189; L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1125-26 (Fed.Cir.), *cert. denied,* 114 S.Ct. 291 (1993).

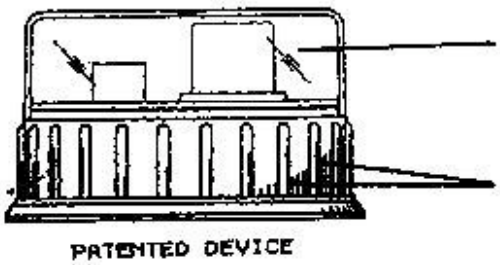
In conducting the infringement analysis, the patented design is viewed in its entirety, as it is claimed. The ultimate question requires determining whether the effect of the whole design is substantially the same. L.A. Gear, 988 F.2d at 1125; Payless, 998 F.2d at 990-91. Minor differences between a patented design and an accused article's design do not prevent a finding of infringement. Payless, 998 F.2d at 991. This is so because we are aware, as was the Supreme Court in Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., 339 U.S. 605, 607 (1950), that:

One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement.

Lee, 838 F.2d at 1190, quoting *Graver Tank*. Therefore, the focus is on the overall ornamental appearance of the claimed design and not merely selected ornamental features. Payless, 998 F.2d at 991; Elmer, 67 F.3d at 1578. Furthermore, infringement can be found for designs that are not identical to the patented design, so long as the designs are equivalent in their ornamental aspects. Lee, 838 F.2d at 1190. Nevertheless, the criterion for design patent infringement is deception of the ordinary observer, such that one design would be confused with the other. LA Gear, 988 F.2d at 1124.

II. ***Claim Construction and Infringement Analysis***

The '332 Design Patent claims an "ornamental design for a combined bottle cap and dust cover." The claim is construed to consist of both the cap and cover as viewed in combination and not as separate entities. Both parties admit there is no distinction between the embodiment of the claimed design, Abbott's third generation closure, and the drawings of the design patent and urge this Court to compare the embodiment of the claimed design with the accused device which I will do.





The parties disagree, however, about the nature of the differences between the two devices. Both parties itemize the similarities and differences as they see them. I find the design of the two devices to be virtually the same in their overall ornamental appearance except for two aspects of the devices. First, the patented device has a transparent dust cover which allows the two projections on the bottle cap to be visible through the cover. The accused device has a white opaque dust cover through which the features on the bottle cap

are not visible. Second, the patented device has ribs on the bottle cap, that do not extend to the cover. The ribs are many in number and are closely spaced together. The accused device also has ribs on the bottle cap, but they extend onto the cover. Furthermore, the ribs on the accused device are fewer in number and more widely spaced than in the patented device.

The overall appearance of the two devices is similar. When viewed in isolation these two differences are small and could even be claimed to be "minor variations to conceal and shelter the piracy." Graver Tank, 339 U.S. at 607. However, it is the effect of the whole design and whether an ordinary observer would be confused into believing the two designs are the same that is critical to our inquiry. LA Gear, 988 F.2d at 1124. I find the differences are more than insubstantial. When viewed in their entirety their overall appearance makes clear they are two devices that serve the same purpose, but the spacing of the ribs and the opaque cover insure that the accused device will not be confused with, or mistaken for, the patented device. When viewing the effect of the whole design, they are not substantially the same. Summary judgment is granted in favor of Mead Johnson on the motion for design patent infringement.

Attorney Fees

Mead Johnson seeks attorney fees under 35 U.S.C. s. 285 on the basis that Abbott's claim of willful infringement of the design patent lacked any merit whatsoever. Section 285 authorizes a court, in exceptional circumstances, to award reasonable attorney fees to the prevailing party. Bayer Aktiengesellschaft v. Duphar Intern. Research B.V., 738 F.2d 1237, 1242 (Fed.Cir.1984). The power to award fees is discretionary with the court. Yet, this discretion may only be exercised upon a specific finding of exceptional circumstances. *Id*. Exceptional circumstances include a frivolous infringement suit. *Id*. "A frivolous infringement suit is one which the patentee knew or, on reasonable investigation, should have known, was baseless." Haynes Intern., Inc. v. Jessop Steel Co., 8 F.3d 1573, 1579 (Fed.Cir.1993).

The party moving for attorney fees bears the burden to prove the exceptional nature of the case by clear and convincing evidence. Carroll Touch, 15 F.3d at 1584. Mead Johnson has failed to carry its burden. Mead Johnson claims Abbott's case is frivolous because the factual question of design patent infringement is not even close since the appearance of the claimed and accused designs are not in dispute and the test for design patent infringement is well established.

There is no evidence that Abbott pursued its design patent infringement claim without a reasonable belief in its merits. The patented and accused designs are in fact quite similar. While I have found the accused design does not infringe the patented design, I do not find Abbott's pursuit of the claim to be frivolous considering the overall similarities between the designs. This is certainly not an "exceptional case." The motion for attorney fees is denied.

Conclusion

Summary judgment is granted in favor of Abbott Laboratories for infringement of the '545 Patent "said bottom surface having a filter secured thereto" claim. Summary judgment is granted in favor of Mead Johnson on the issue of literal infringement of the '545 Patent "means to limit atmospheric air access to said filter" claim, but denied as to both parties under the doctrine of equivalents on the same claim. Summary judgment is also granted in favor of Mead Johnson on the motion for design patent infringement. The motion for attorney fees is denied.

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