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

Darlene N. JONES,
Plaintiff.
v.
ARGEE CORPORATION,
Defendant.

Sept. 24, 1998.

MEMORANDUM OPINION AND ORDER

ANN CLAIRE WILLIAMS**, Judge.**

In Plaintiff Darlene Jones' complaint, she brings a claim of patent infringement against Defendant Argee Corporation. Defendant moves the court to grant summary judgment on its behalf pursuant to Rule 56 of the Federal Rules of Civil Procedure. For the reasons set forth below, the court grants defendant's motion for summary judgment.

BACKGROUND

A. ***The Patent In Suit***

On December 29, 1997, Plaintiff Darlene Jones ("Jones"), an independent inventor, obtained U.S. Patent 4,715,963 ("the '963 patent") for developing a method of dewatering food items such as washed salad greens. (Def. Exhibit A, Column 1.) Specifically, Jones' dewatering method consists of a plastic bag which is divided into two compartments. The first compartment receives the washed food items and has a throat adjacent to the bottom. The throat, which opens into the second compartment, is sized such that it allows the passage of water into the second compartment while preventing the passage of the food items. Upon manually twirling the bag, water is centrifugally forced off of the food items, travels through the throat, and then collects in the second compartment. Finally, the dewatered food items are removed from the first compartment, and the plastic bag with the water stored in the second compartment can be discarded. (Def. Exhibit A, Column 1.)

B. Patent '963'***s Prosecution History***

Prior to obtaining the '963 patent, classified as a *method patent,* Jones had filed an application with the Patent and Trade Office ("PTO") on November 18, 1985, seeking an *apparatus patent* . The claims contained in this predecessor application were directed to the actual dewatering bag as opposed to the dewatering method. (Pl.'s Resp. at 2.) Jones described the bag as having two compartments separated by a weld containing a throat. She further specified that the throat is a "single discontinuity" in the weld which "was located at the centerline" of the bag. (Def. Exhibit B, p. 9.)

On July 2, 1986, the PTO rejected all of the claims in Jones' patent application under 35 U.S.C. s. 103, stating that the subject matter of Jones' claims was obvious in view of the Smith patent (U.S. Patent No. 2,800,269). FN1 The Smith plastic bag, designed to mix water with dry cake mix, was also comprised of a first compartment separated from a second compartment by a weld with a single throat. (Def. Exhibit B, p. 18.)

FN1. The following excerpt from 35 U.S.C. s. 103 provides the basis for the PTO's obviousness rejection:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art to which the said subject matter pertains. 35 U.S.C. s. 103.
Jones responded to this rejection by amending her application to the PTO in order to distinguish her dewatering bag from prior art. (Def. Exhibit B, p. 51.) First, she added two claims to her original submission, claims 9 and 10, that were directed to the twirling method of dewatering food items with her bag. Secondly, in the remarks accompanying the amendments, Jones referred to the Tocker patent (U.S. Patent 3,159,096), which she contended was perhaps more relevant than the Smith patent, but still patently distinguishable from her dewatering device.FN2 According to Jones, her patent is distinguishable from the Tocker because

FN2. The Tocker, designed to separate juice from citrus fruits, consists of a plastic bag in which two compartments are separated by multiple openings in the dividing weld. By pressing the citrus fruit in the first compartment, the juice passes through the multiple openings, but the fruit and seeds do not. (Def. Exhibit B, p. 56.)

the spaced heat seals defining the compartments in the Tocker patent provide ***multiple openings*** between the first and second compartment, across the entire width of the bag. Claim 1 [in Jones' application] calls for ***a throat*** at the lowest part of the first compartment and substantially at the center of line of the compartment. The throat permits water to readily flow through the throat, but minimizes back flow through the throat into the main compartment. The Tocker bag, on the other hand, having multiple openings across the entire width of the bag, would readily permit back flow into the main compartment, defeating the entire purpose of the present invention.
(Def. Exhibit B, p. 56) (emphasis added).
Once again, the PTO rejected Jones' amended application under 35 U.S.C. s. 103, holding that claims 1 through 8, describing the dewatering device, were still unpatentable in view of the Smith patent. Additionally, the PTO examiner refused to consider method claims 9 and 10 because the apparatus application was restricted to only apparatus claims. (Def. Exhibit B, p. 61-62.) The examiner did acknowledge, however, that the dewatering process embodied in claims 9 and 10 could constitute a patentable invention, stating:

Newly submitted claims 9-10 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The dewatering device and the twirling dewatering process are distinct because apparatus as claimed can be used to practice another and materially different process such as compressive dewatering, or gravity filtration.

(Def. Exhibit B, p. 61.)

Accordingly, Jones filed a second patent application on March 30, 1997, that was directed solely to the aforementioned method claims. In patent parlance, the new application is called the "divisional application", while the original application is called the "parent application." (Def. Mem. at 9.) In the divisional application, Jones brought forth the following two claims:

1. A method for dewatering food items comprising the steps of: placing food items in a compartment formed from flexible thinwall sheet material, said compartment having an open top and an opening opposite the open top sized to permit passage of liquid but substantially to prevent passage of the food items therethrough; and twirling the compartment by its open top to cause water from the food items to be expelled through the opening by centrifugal force.

2. The method of Claim 1 wherein water expelled through the opening in a second compartment surrounding the opening.

(Def. Exhibit C, p. 10.) On June 17, 1987, the PTO issued a Notice Of Allowability, which led to the issuance of the '963 patent on December 29, 1997. (Def. Exhibit C.) The examiner, in her Statement of Reasons for Allowance, explained that

the closest art of record, namely references Smith ... and Tocker ... both failed to make obvious the method of dewatering a food product by centrifugal force in a sheet material with a first opening for food placement and a second opening, opposite said first, for water passage.

(Def. Exhibit C, p. 21.)

C. ***Argee Corporation's Spin'n Store Bag***

On January 10, 1995, Defendant Argee Corporation ("Argee") obtained an apparatus patent (U.S. Patent 5,380,093) for its "Spin'n Store Bag." (Def. Exhibit E, Column 1). The claims in Argee's patent describe a plastic bag that consists of a main storage compartment, with an opening at the top through which wet food items are placed. Adjacent to the main compartment is a reservoir for collecting water that is removed from the food items. The reservoir is separated from the main chamber by multiple openings which are sized to allow the passage of fluids but not the food items. When the user revolves the bag, excess water is removed from the food items, driven through the openings, and collects in the reservoir. Once the fluid is contained in the reservoir, it can be drained from the reservoir through a channel extending up the side of the bag; finally, the user can collapse the bag around the food items and use the bag as a storage container for the dewatered food items. (Def. Exhibit E, Columns 3-4.)

D. ***The Patent Infringement Suit***

On August 5, 1997, Jones filed a complaint, alleging that the Argee patent infringes her '963 patent. Specifically, Jones contends that Argee has been and is actively inducing others to infringe and contributing to the infringement of the '963 patent, by selling the Spin'n Store Bag, and by instructing consumers on how to use them. (Def.12(M) para. 1.) On December 22, 1997, Argee filed a motion for summary judgment, on the ground of noninfringement.

ANALYSIS

The court will render summary judgment only if the factual record shows "that there is no genuine issue as

to any material fact and that the moving party is entitled to a judgment as a matter of law." Bratton v. Roadway Package Sys., Inc., 77 F.3d 168, 173 (7th Cir.1996) (quoting Fed.R.Civ.P. 56(c)). The court will not render summary judgment if a "reasonable jury could return a verdict for the nonmoving party." Sullivan v. Cox, 78 F.3d 168, 173 (7th Cir.1996) (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986)). In ruling on a motion for summary judgment, the court views the facts in the light most favorable to the nonmoving party. Bratton, 77 F.3d at 171 (citation omitted); *Sullivan,* 78 F.3d at 325 (citation omitted).

On a motion for summary judgment, the moving party "bears the initial burden of showing that no genuine issue of material fact exists." Hudson Ins. Co. v. City of Chicago Heights, 48 F.3d 234, 237 (7th Cir.1995) (citing Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986)). Then the burden shifts to the nonmoving party, which "must set forth specific facts showing that there is genuine issue for trial." Fed R. Civ. P. 56(e); *accord* NLFC, Inc. v. Devcom Mid-America, Inc., 45 F.3d 231, 234 (7th Cir.1995) (citations omitted), *cert. denied,* 115 S.Ct. 2249 (1995). Whether a disputed fact is material depends on the relevant substantive law. Anderson, 477 U.S. at 248; *Sullivan,* 78 F.3d at 325.

In determining if a patent claim has been infringed, the court must engage in a two-step process: (1) claim construction to determine what the claim covers, i.e. its scope, followed by (2) determination of whether the properly construed claim encompasses the accused device or process. Cole v. Kimberly-Clark Corp., 102 F.3d 524, 528 (Fed.Cir.1996). *cert. denied,* 118 S.Ct. 56 (1997). Courts consider several factors when construing claims, including the claim language, the specification, and the prosecution history. Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370(1996).

The court begins the process of claim construction by looking to the language of the patent claims themselves. North American Vaccine v. American Cynamid Co., 7 F.3d 1571, 1575 (Fed.Cir.1993). Unless a patentee indicates any intention to deviate from [the] ordinary meanings of the claim terms, then the patentee's "claim terms take on their ordinary meaning." Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1423 (Fed.Cir.1997). The claims in the ' 963 patent state as follows:

1. A method for dewatering food items comprising the steps of: placing food items in a compartment formed from flexible thinwall sheet material, said compartment having an open top and ***an opening*** opposite the open top sized to permit passage of liquid but substantially to prevent passage of the food items therethrough; and twirling the compartment nearby its open top to cause water from the food items to be expelled through the opening by centrifugal force.

2. The method of Claim 1 wherein water expelled through ***the opening*** in a second compartment surrounding ***the opening.***

(Def. Exhibit A, Col. 4, Ins. 22-35) (emphasis added). Upon considering the highlighted language, the court finds that Jones' invention comprises a dual compartment bag that is separated by a single throat. The Federal Circuit Court has even noted that the article "an" ordinarily has a singular meaning. North American, 7 F.3d at 1575-76. Additionally, an examination of the ' 963 patent specifications, especially Figures 1, 3, and 4, clearly depict a dewatering bag with a single opening separating the two compartments. (Def. Exhibit A.)

In determining the claim construction of the '963 patent, the court also examines its prosecution history. Because claims cannot encompass specifications that were surrendered during the prosecution of the patent, an examination of the prosecution history provides limits to the interpretation of the claim terms. *See*

Southwall Tech., Inc. v. Cardinal Ig Co., 54 F.3d 1570, 1576 (Fed.Cir.1995). The rationale behind this limit is to prevent inventors from "constru[ing] claims one way in order to obtain allowance and in a different way against accused infringers." *Id*. In this case, the prosecution history includes the parent application, which led to the issuance of the divisional '963 patent. *See* Mark I Mkt. Corp. v. R.R. Donnelly & Sons Co., 66 F .3d 285, 291 (Fed.Cir.1995).

During prosecution, the PTO rejected Jones' parent application due to obviousness in view of prior art in the field. However, in an effort to amend the parent application, Jones argued that her bag was distinct because it contained a throat which allowed the passage of water but minimized the back flow of the water into the food items. She even pointed out that the Tocker bag, with its multiple openings across the width of the weld, would easily allow back flow of water into the main compartment, which would defeat the purpose of her invention. (Def. Exhibit B, p. 56.) The function of the single throat is even reflected in the '963 patent specification, in which the dewatering bag is described as substantially preventing water from returning to food items. (Def. Exhibit A, Col. 1, Ins. 45-47.) When Jones distinguished her single opening bag from the Tocker bag with multiple openings, she limited her claims to encompass only a two compartment bag separated by a single throat. *See* Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 452 (Fed.Cir.1985).

Upon properly construing the '963 patent as a two compartment bag with a single throat, the court must determine if a reasonable fact finder could determine that Argee committed infringement. Literal infringement of a claim exists when every element in the claim is found in the accused device or process, i.e., when "the properly construed claim reads on the accused device [or process] exactly." Cole, 102 F.3d at 532. In the instant case, Argee's dewatering bag does not literally meet all of the '963 patent limitations. The court construed the single throat of the '963 patent to be an indisputable element of Jones' invention, whereas the Argee bag, with its multiple openings, does not contain the single throat element. Argee, therefore, did not literally infringe the claims in the '963 patent.

Even if a device or process does not literally infringe a patent claim, it "may nonetheless infringe under the doctrine of equivalents if every element in the claim is literally or equivalently present in the accused device." Sage, 126 F.3d at 1423. The court should grant summary judgment if the evidence is such that no reasonable jury could determine two elements to be substantially equivalent. *Id*. "The doctrine of equivalents prevents an accused infringer from avoiding infringement by changing only minor or insubstantial details of a claimed invention while retaining their essential functionality." *Id*. at 1424. However, the doctrine cannot be used to recapture material that was surrendered during the prosecution of the patent. This rule, called prosecution history estoppel, serves to protect competitors who review the prosecution history of a patent to reasonably determine what elements the inventor relinquished in order to achieve procurement of the patent. *See* Mark, 66 F.3d at 292.

Jones surrendered multiple openings when she contended that her single throated bag was distinct from the Tocker bag with multiple openings. She deliberately and expressly argued that the single throat feature was essential to the proper functioning of her dewatering bag. Upon reviewing the prosecution history of the '963 patent, Argee was therefore justified in concluding that developing a bag with multiple openings between the two compartments constituted a substantial difference from Jones' bag with a single throat. Specifically, Argee reasonably determined that even though the Argee and Jones' devices achieve substantially the same result, the difference between Argee's multiple openings and Jones' single throat feature caused the bags to function in substantially different ways.

As such, Argee did not infringe the '963 patent under the doctrine of equivalents. "To hold otherwise would be to frustrate the important definitional and functional public-notice requirements of the statutory claiming requirement." Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 117 S.Ct. 1040, 1049 (1997).

CONCLUSION

For the reasons set forth above, the court grants defendant's motion for summary judgment.

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