United States District Court,
D. Delaware.

ONDEO NALCO COMPANY, a Delaware Corporation,
Plaintiff.
v.
EKA CHEMICALS, INC., a Delaware Corporation,
Defendant.

No. Civ.A. 01-537-SLR

March 21, 2003.

MEMORANDUM ORDER

ROBINSON**, J.**

At Wilmington this 21st day of March, 2003, having heard oral argument and having reviewed papers submitted in connection therewith;

IT IS ORDERED that the disputed claim language in United States Patent Nos. 4,388,150 and 5,603,805, as identified by the above referenced parties, shall be construed as follows, consistent with the tenets of claim construction set forth by the United States Court of Appeals for the Federal Circuit:

A. The '150 Patent

1. "Silica particles." Consistent with the ordinary meaning and the intrinsic evidence of the '150 patent, the term "silica particles" shall mean "particles of SiO_2, which may include other elements, compounds or substances picked up as impurities during the synthesis of silica sols, but not including any elements, compounds or substances that are intentionally added during the synthesis process." FN1

FN1. The court finds the above construction consistent with the Federal Circuit's recent decision in Texas Digital Systems, Inc. v.. Telegenix, Inc., 308 F.3d 1193 (Fed.Cir.2002). Pursuant to the directive in *Texas Digital,* this court must "give a claim term the full range of its ordinary meaning as understood by persons skilled in the relevant art," unless compelled otherwise. *Id.* at 1202. The plain meaning of silica particles is undisputed, particles consisting of SiO_2. However, both parties acknowledge that in the papermaking field, persons of ordinary skill in the art recognize that silica particles may include other elements, compounds or substances as impurities that are unintentionally picked up during the process of synthesizing silica sols. The court thus concludes that this is the ordinary meaning of the term "silica particles" to a person skilled in the art.

Eka asks the court to depart from this ordinary meaning and include intentionally added elements in the definition of silica particles. As the Federal Circuit has stated in *Texas Digital,* once an ordinary meaning is

established, a district court must then turn to the intrinsic record to determine whether the "presumption of ordinary and customary meaning is rebutted." *Id*. at 1204. In this case, Eka points to no evidence in the intrinsic record warranting deviation from the ordinary meaning. Because neither the specification nor the claims of the '150 patent mention intentional modifications to the silica particles, the court declines to broaden the scope of the claim by embracing Eka's construction.
2. "Colloidal silicic acid." Consistent with the plain meaning of the terms and the intrinsic evidence, the term "colloidal silicic acid" shall mean "a dispersion of silica particles, as defined above, or polysilicic acid in liquid."

3. "Colloidal silica sol." Consistent with the plain meaning of the terms and the intrinsic evidence, the term "colloidal silica sol" shall mean "a dispersion of silica particles, as defined above, in a liquid."

B. The '805 Patent

1. "Silica particles." Consistent with the intrinsic evidence of the '805 patent, the term "silica particles" shall mean "particles of SiO_2, which may include other elements, compounds or substances as well." FN2

FN2. Claim 1 of the '805 patent claims:
1. Silica sols having an S-value within the range from 15 to 40 percent comprising anionic silica particles, said silica particles being non-aluminum modified, and having a specific surface area within the range of from 300 to 700 m^2/g. (emphasis added)

Eka argues, and the court agrees, that the term "silica particles" as used in the '805 patent may include silica particles that have been intentionally modified. The specification discusses the intentional modification of silica particles. The fact that the language of claim 1 expressly states that the silica particles are non-aluminum modified does not preclude intentional modification with other elements.

Nalco argues that when turning to the prosecution history of the '805 patent, as instructed in *Texas Digital,* it is clear that Eka surrendered the subject matter of this proposed claim interpretation. During prosecution, the patentee presented amended claims 1 and 4 to the examiner. The amended claims read as follows:
1. (Amended) Silica sols having an S-value within the range from 15 to 40 percent comprising *anionic* silica particles, [which can be aluminum modified of] *said silica particles being* non-aluminum modified, *and* having a specific surface area within the range of from 300 to 700 m^2/g.

4. (Amended) The silica sols of claim 1, wherein the silica particles are [non-aluminum modified] *unmodified silica particles*.

During an examiner interview, the examiner stated that "claim 4 is redundant [because] claim 1 was already directed to an unmodified silica." The patentee then agreed to cancel claim 4 and claim 1 was allowed.

The court concludes, however, that the patentee's agreement to cancel claim 4 in order to allow claim 1 to issue was not an express disavowal of the claim scope sought by Eka now. There is no written correspondence between the patentee and the examiner illustrating the patentee's reason for cancelling claim 4, rather, there is only a one-line statement written by the examiner in the interview summary record stating "[the patentee] agreed to cancel claim 4." Therefore, the court concludes that the prosecution history of the '805 patent does not "evince a clear and unmistakable surrender of subject matter" required to invoke prosecution history estoppel. *See* Pharmacia & Upjohn Co. v. Mylan Pharms., Inc., 170 F.3d 1373, 1377 (Fed.Cir.1999).

Furthermore, if the court concluded that the silica particles could not be modified in any way, then the "non-aluminum modified" limitation following "said silica particles being" would be meaningless. It is well-established Federal Circuit precedent that such a construction should be avoided. *See* Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 296 F.3d 1106, 1115 (Fed.Cir.2002); KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351, 1358 (Fed.Cir.2000).

2. "Silica sol." Consistent with the plain meaning of the terms and the intrinsic evidence, the term "silica sol" shall mean "a dispersion of silica particles, as defined above, in a liquid."

3. "Non-aluminum modified." Consistent with the plain meaning and intrinsic evidence, the term "non-aluminum modified" shall mean silica particles that have "not been surface modified with aluminum."

D.Del.,2003.
Ondeo Nalco Co. v. EKA Chemicals, Inc.

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