United States District Court,
S.D. Texas, Houston Division.

PENRECO,
Plaintiff.
v.
HANNA'S CANDLE COMPANY,
Defendant.

Nov. 26, 2003.

Sharon Audrey Israel, Mayer Brown et al, Houston, TX, for Plaintiff.

Thomas Christopher Trent, Johnson Spalding et al, Houston, TX, John M. Scott, Keisling Pieper & Scott PLC, Trent C. Keisling, Attorney at Law, Fayetteville, AR, for Defendants.

MEMORANDUM AND ORDER

EWING WERLEIN, JR.**, District Judge.**

Plaintiff Penreco ("Penreco") alleges that Defendant Hanna's Candle Company ("Hanna's") infringed claim 1 of United States Patent No. 5,879,694 (the "'694 Patent") and claim 1 of United States Patent No. 6,066,329 (the "'329 Patent"), by making, selling, and offering to sell transparent gel candles containing a stabilizer as an ingredient and having ornamental insoluble objects embedded in the gel. The '694 Patent, consisting of 10 claims, was issued on March 9, 1999, and is entitled "Transparent Gel Candles." The '329 Patent, consisting of 20 claims, was issued on May 23, 2000, and is a continuation of the '694 Patent. The parties seek construction of (i) one claim term contained in claim 1 of the '694 Patent, and (ii) one claim term contained in a phrase in claim 1 of the '329 Patent.

On November 5, 2003, the Court conducted a *Markman* hearing during which the parties presented evidence and arguments in support of their proposed claim constructions. FN1 The parties also submitted briefs on construction of the claims. After carefully considering the parties' submissions, the ' 694 Patent, the ' 329 Patent, and those portions of the prosecution history of the '694 and ' 329 Patents submitted by the parties, the Court concludes as follows:

FN1. Also pending-but not argued at the *Markman* hearing-are Penreco's Motion for Partial Summary Judgment of Infringement (Document No. 44), Penreco's Motion for Partial Summary Judgment of No Breach of Contract by Penreco (Document No. 45), Penreco's Motion for Partial Summary Judgment of Validity (Document No. 47), Hanna's Motion for Partial Summary Judgment of Invalidity (Document No. 56), and Hanna's Motion for Partial Summary Judgment of Non-Infringement (Document No. 57). The Court assumes for the purposes of claim construction that the patents-in-suit are valid and enforceable, although that issue remains to be decided.

I. *Law Governing Claim Construction*

Claim construction is strictly a legal question for the court. Markman v. Westview Instruments, Inc., 52 F.3d 967, 983-84 (Fed.Cir.1995), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). "When construing a claim, a court should look first to the intrinsic evidence, i.e., the claims themselves, the written description portion of the specification, and the prosecution history." Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys., 132 F.3d 701, 705 (Fed.Cir.1997); *see also* Markman, 52 F.3d at 979. "Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used." Markman, 52 F.3d at 979 (internal citations omitted). Expert testimony that is inconsistent with unambiguous intrinsic evidence, however, should be accorded no weight. Bell & Howell Document Mgmt. Prods. Co., 132 F.3d at 706; Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 (Fed.Cir.1996); Markman, 52 F.3d at 981 (stating that extrinsic evidence can be used only for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims).

"[A]s a general rule, all terms in a patent claim are to be given their plain, ordinary and accustomed meaning to one of ordinary skill in the relevant art." Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed.Cir.2001); *see also* Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1299 (Fed.Cir.1999) ("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."). A court must give a claim term "the full range of its ordinary meaning as understood by an artisan of ordinary skill." Rexnord, 274 F.3d at 1342 (citing Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed.Cir.1999)).

A court may refer to dictionaries to determine the proper definition of claim terms including technical dictionaries, encyclopedias, and treatises that establish specialized meanings in particular fields of art. Inverness Med. Switzerland v. Princeton Biomeditech Corp., 309 F.3d 1365, 1369 (Fed.Cir.2002). When a claim term does not have a specialized meaning, however, "standard dictionaries of the English language are the proper source of ordinary meaning for the [term]." *Id*. If a claim term has multiple meanings, the court must interpret the term to encompass all consistent meanings, based on the intrinsic evidence. Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1203 (Fed.Cir.2002).

II. *Discussion*

A. *The* '694 Patent

The '694 Patent, which consists of 10 claims, nine of which are dependent, discloses a transparent stiff gel candle comprising a hydrocarbon oil, a wick, and one or more triblock, radial block or multiblock copolymer of a thermoplastic rubber, and optionally a diblock copolymer. As the specification of the '694 Patent discloses, the candle is formed by blending the polymers and oil and heating the mixture to dissolve the copolymer or copolymer blend in the oil. A wick is then added, and, on cooling, a stiff clear gel forms. The specification also teaches that the candles of this invention may also contain one or more conventionally employed additives such as stabilizers, anti-oxidants, colorants, fragrances, and the like to an extent not affecting or decreasing the desired properties of the candle.

B. *Claim Construction*

Penreco alleges that Defendant infringed independent claim 1 of the '694 Patent by making, selling, and offering to sell gel candles containing a stabilizer. The parties seek construction of the claim term

"stabilizer." Both parties agree that the claim terms should be afforded their ordinary and customary meaning. Further, the parties agree that the Court may use dictionary, textbook, and/or treatise definitions for the terms.

For ease of comprehension, each claim has been reproduced, with the disputed terms underlined.

Claim 1 of the '694 Patent, with disputed terms underlined recites:

1. An article of manufacture comprising a candle, said candle consisting essentially of a gel consisting essentially of from about 70% to about 98% by weight of a hydrocarbon oil, and from about 2% to about 30% by weight of a triblock copolymer, and having a wick in said gel, and said candle optionally containing one or more additives selected from the group consisting of an antioxidant, *stabilizer,* fragrance, colorant, insect repellant, and flame retardant.

Penreco argues for the following construction of the term "stabilizer" in claim 1: "any substance that tends to keep another from changing its physical form or chemical nature." Hanna's seeks to limit this definition to "a chemical preservative, specifically not including any physical stabilizer or gelling agent." Hanna's argues that "stabilizer" should not include a "physical stabilizer or gelling agent" because to do so would conflict with the prosecution history of the '694 Patent.

THE OXFORD ENGLISH DICTIONARY (2d ed.1989) defines "stabilizer" as "2. [A]n additive which inhibits chemical or physical change in a substance, esp. one used to prevent the breaking of an emulsion." Likewise, HAWLEY'S CONDENSED CHEMICAL DICTIONARY (13th ed.1997) defines "stabilizer" as "Any substance that tends to keep a compound, mixture, or solution from changing its form or chemical nature." Hanna's argues that these definitions of the term "stabilizer" are too broad in the context of claim 1 because they include subject matter expressly disclaimed in light of relevant prior art during the prosecution history of the '694 Patent. That prior art, specifically United States Patent No. 5,578,089 (the "Elsamoloty Patent"), teaches a candle made from a gel which contains mineral oils and blends of triblock and diblock copolymers. According to Hanna's, Penreco's attorneys argued during the prosecution of the '694 Patent that the claimed invention "expressly excluded gel candles that used more than one gelling agent" and that the attorneys "expressly disavowed any intent to cover the two gelling agent candle of the [Elsamoloty] Patent." *See* Document No. 62, at 3; Document No. 87, at 12.

Nothing in the prosecution history, however, makes mention of the terms "gelling agent" or "stabilizer." Instead, the "express disavowal" made by Penreco's attorneys in light of the Elsamoloty Patent during the prosecution history of the '694 Patent involved revision of the independent claim language to exclude the presence of diblock copolymer, so that the claim "directed to candles made from gels formed only from triblock copolymers." *Amendment,* Document No. 69 ex. 15, at PEN00112. An entry in the file wrapper for the '694 Patent states:

In the Official Action, the Examiner has held that Applicants' claims are broader than the Declaration and that Applicants' claims are open ended and are still potentially readable on the Elsamoloty reference. In response to this objection, Applicants have revised main independent claim 19 to indicate the gel is one "consisting essentially of" the hydrocarbon oil and triblock copolymer. It is believed that this language is sufficient to exclude the presence of a diblock copolymer and places the claim in a form which is not open-ended with respect to the gel from which the candle is made.

Amendment Under 37 C.F.R. s. 1.116, id., at PEN 000128-000129. There is no support in the prosecution history for Hanna's contention that by excluding diblock copolymers from the ingredients that make up the gel, Penreco surrendered the inclusion of *all substances* that perform the function of a diblock copolymer, that is, substances that control the physical characteristics of the gel. The definition of stabilizer, therefore, should not be limited to those substances that inhibit only chemical, as opposed to chemical *and* physical, change. Based on the foregoing, the Court agrees with Penreco's construction of the claim term "stabilizer" to mean "any substance that tends to keep a compound, mixture, or solution from changing its physical form or chemical nature." Nothing in the prosecution history suggests a construction to the contrary.

C. *The* '329 Patent

The '329 Patent, which consists of 20 claims, 19 of which are dependent, discloses transparent stiff gel candles comprising a hydrocarbon oil, a wick, and one or more triblock, radial block or multiblock copolymer of a thermoplastic rubber, and optionally a diblock copolymer. As the specification of the '329 Patent discloses, the candle is formed by blending the polymers and oil and heating the mixture to dissolve the copolymer or copolymer blend in the oil. A wick is then added, and, on cooling, a stiff clear gel forms. The specification also teaches that a candle of this invention may also have the "decorative benefit" of ornamental features embedded within the candle body. United States Patent No. 6,066,329, Document No. 88 ex. 2, col. 8, ll. 7.

D. *Claim Construction*

Penreco alleges that Defendant infringed independent claim 1 of the '329 Patent by making, selling, and offering to sell gel candles containing ornamental insoluble objects embedded therein. Specifically, the parties seek construction of the claim term "insoluble" as used in the phrase "one or more ornamental insoluble objects embedded in said gel."

Claim 1 of the '329 Patent, with disputed terms underlined and agreed construction in brackets, recites:

1. A stiff heterophase naturally transparent gel candle, said candle comprising a transparent gel made of from about 70% to about 98% by weight of a hydrocarbon oil, and up to about 30% by weight of a copolymer selected from the group consisting of a triblock, radial block, and multiblock copolymer, and optionally from 0 to about 10% by weight of a diblock copolymer, a wick contained in said gel; and *one or more ornamental insoluble objects embedded in said gel;* wherein said candle additionally comprises at least one additive selected from the group consisting of an anti-oxidant, stabilizer, fragrance, colorant, insect repellant, and flame retardant.

Penreco argues for the following construction of the term "insoluble" as used in the phrase "one or more ornamental insoluble objects embedded in said gel" in claim 1: "one or more ornamental objects *not uniformly blended* in said gel." This construction, Penreco argues, requires use of a visual test to determine whether an embedded object is insoluble. According to Penreco, a visual test comports with the claim language of the '329 Patent-specifically that of dependent claim 9, which provides specific examples of insoluble ornamental objects-including "stars, glitter, sparkles, ribbons, swirls or layers of colorant or combination of shaped objects." United States Patent No. 6,066,329, Document No. 88, ex. 2, at col. 11, ll. 19-20. Penreco argues, moreover, that a visual test is appropriate and necessary in light of the purpose or function of having an ornamental object embedded in the gel, namely, to improve the aesthetic or decorative properties of the candle.

Hanna's criticizes Penreco's contention that "insoluble" means "not uniformly blended," by arguing that Penreco's definition eliminates restrictions that the word "insoluble" imparts on the word "objects." In other words, according to Hanna's, if the ornamental objects are blended uniformly into the gel, then there are no ornamental "objects." Likewise, if there *are* ornamental objects in the gel, then necessarily they are not uniformly blended into the gel. Hence, the word "insoluble" is meaningless as a modifier of the word "objects" in claim 1. Hanna's points out that this criticism is bolstered by the written description of the '329 Patent, in which the inventors contemplated that the embedded ornamental features "may be either *insoluble or soluble* in the gel composition of the candle, as desired." U.S. Patent No. 6,066,329, Doc. No. 88, ex. 2, at col. 8, 11. 9-11 (emphasis added). Claim 1, however, covers only "one or more ornamental *insoluble* objects embedded in said gel." (Emphasis added.) Hanna's correctly observes that Penreco's construction cannot be correct because it would eviscerate the inventors' belief that both *soluble* ornamental features and *insoluble* ornamental features can be embedded in the gel candle. If the *insoluble* ornamental objects include everything that is "not uniformly blended" into the gel, however, no conceptual room is left for any distinction to be made between soluble and insoluble ornamental objects. Again, the word "insoluble" is rendered meaningless.

Hanna's, on the other hand, proposes to construe the phrase as "one or more ornamental objects *incapable of dissolving under any condition during the life of the candle* embedded in said gel." Hanna's construction is derived from several dictionaries and chemistry treatises, which define "insoluble" as "1. That cannot be dissolved: *insoluble matter,*" THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed., 2000), Document No. 87 ex. 2, at 907, and "That the solubility is less than about .1 g per 100 ml (roughly 0.01 *M*)," LINUS PAULING, GENERAL CHEMISTRY (1970), id. ex. 3, at s. 13-4. Dr. Eric Wigg, a chemist designated by Hanna's as its expert witness, defines insoluble as "a negligible quantity of the compound dissolves." Document No. 87 ex. 7, at 150:5-7. FN2

FN2. Dr. Wigg states in his deposition that his proffered definition is taken from the Chemical Rubber Publishing Co.'s Handbook of Chemistry and Physics (1963), which states that "[t]he term insoluble (i.) must be interpreted to mean that a negligible quantity of the compound dissolves." *See* HANDBOOK OF CHEMISTRY AND PHYSICS (Chemical Rubber Publishing Co., 1963), Document No. 88 ex. 10, at 763.

Hanna's rigid definition of insoluble, which is rooted in the science of chemistry, would not seem to apply in the context of purely decorative objects embedded in gel candles to serve an ornamental or aesthetic purpose. In fact, neither of the parties' proposed constructions fully considers the function of the insoluble objects embedded in the gel as indicated by the written description of the '329 Patent-namely, that the objects are ornamental or decorative features. A claim term must be interpreted in light of the teachings of the written description and purpose of the invention described therein. Apple Computer, Inc. v. Articulate Sys., Inc., 234 F.3d 14, 25 (Fed.Cir.2000). *See also* Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc., 222 F.3d 951, 956 (Fed.Cir.2000); Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1479 (Fed.Cir.1998) (relying, in part, on the stated purpose of the invention in construing the claims); Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed.Cir.1998) ("Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim.").

WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY (1990), which was in popular use in the few years immediately preceding this patent application, defines "insoluble" as "soluble only with difficulty or to a slight degree." This definition provides a sensible and commonplace understanding of the word when

applied to an ornamental object placed in a transparent gel candle for aesthetic purposes. If the ornamental object is soluble only with difficulty or to a slight degree when embedded in a gel candle, it fulfills the ornamental purpose of the invention. This does not require chemical or scientific analysis of the embedded ornamental object(s), but only a visual test. Therefore, and taking into account the purpose of the invention, the claim term "insoluble" in "one or more ornamental insoluble objects embedded in said gel" is construed to mean "soluble only with difficulty or to a slight degree, so that the object(s) when embedded in the gel retains its intended ornamental feature."

III. *Order*

Based on the foregoing, it is hereby

ORDERED that the disputed terms of the '694 Patent are construed as follows:

CONSTRUCTION OF CLAIM

United States Patent No. 5,879,694

1. As used in claim 1 of the '694 Patent, the term **"stabilizer"** means any substance that tends to keep a compound, mixture, or solution from changing its physical form or chemical nature.

CONSTRUCTION OF CLAIM

United States Patent No. 6,066,329

1. As used in claim 1 of the '329 Patent, the term **"insoluble"** means soluble only with difficulty or to a slight degree, so that the object(s) when embedded in the gel retains its intended ornamental feature.

The Clerk will enter this Order and send a copy to all counsel of record.

S.D.Tex.,2003.
Penreco v. Hanna's Candle Co.

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