United States District Court,
C.D. California.

CLASSIFIED COSMETICS, INC,
Plaintiff.
v.
DEL LABORATORIES, INC,
Defendant.

No. CV 03-4818 AHM (PLAx)

June 14, 2004.

Gary A. Hecker, James M. Slominski, Hecker Law Group, Los Angeles, CA, for Plaintiff.

Richard A. Wallen, Christie Parker and Hale, Pasadena, CA, for Defendant.

***MARKMAN* ORDER CONSTRUING DISPUTED CLAIM TERMS IN** PATENT NO. 6,589,541

A. HOWARD MATZ**, District Judge.**

This claim construction Order follows the June 3, 2004 *Markman* hearing regarding the definition of nine disputed terms in claims 1 and 12 of Plaintiff's patent (Patent No. 6,589,541). Pl .'s Exh. A. The parties are familiar with the various arguments and colloquies made at the hearing and in the briefs and the Court does not need to restate them.

While there is a heavy presumption that all terms carry their ordinary meaning to one skilled in the art, that heavy presumption is rebutted "if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention." Phillips v.. AWH Corp., 363 F.3d 1207, 1213 (Fed.Cir.2004) (internal citations and quotations omitted).

1. "Skin"

The word "skin" appears several times in claims 1 and 12. Pl.'s Exh. A, 8:28, 8:31, 8:54, 8:56, 9:8, 9:27, 10:8, 10:10, 10:12. "Skin" means "the area of skin to which the cosmetic composition is to be applied."

Defendant's strongest support for a definition of skin that contains a so-called "direct spraying" limitation is in Plaintiff's October 3, 2003 Response to Office Action and Amendment. Def.'s Exh. 19. In that document, Plaintiff explains how its invention is different from the prior art because it "may be applied in a manner which does not involve some manual touching, or rubbing, of the skin by the user. Such rubbing is inconsistent with the present invention." *Id*. at 5; *see also id*. at 4, 7. After a careful review of the arguments, to the extent that the references to direct spraying in Exhibit 19 were meant by Plaintiff to limit or clarify

the claims, the references applied only to users with scarred, damaged, or delicate skin. Those users are only a subset of the entire pool of intended consumers.

Plaintiff states in Exhibit 19 that it "amended independent claim 1 to more clearly point out that the method of the present invention *may* be accomplished without rubbing by the user" (emphasis added). The resulting amendment substituted "consisting essentially of" in place of the open transitional phrase "comprising the steps of:"

A method of concealing imperfections and accentuating a person's natural features, the method *consisting essentially* of: pointing a nozzle of a pressurized container towards an area of skin to be coated, wherein the pressurized container holds a cosmetic composition capable of forming a thin, water-resistant coating of generally uniform thickness on the skin that tapers in thickness during application towards the periphery of the area sprayed ... and spraying the cosmetic composition on skin such that a uniform, thin coating which blends with the surrounding skin is formed on the surface of the skin.

Id. at 9-10 (amendment underlined). The phrase "consisting essentially of" limits the scope of the claim to the steps listed-basically (1) pointing a nozzle and (2) spraying-and only those other steps that "do not *materially* affect the *basic* and *novel* characteristics of the claimed invention." Pl.'s Exh. E (Manual of Patent Examining Procedures, s. 2111.03) (emphasis added); *see also* Section 6 and 8, *infra*. The claim as amended does not contain a direct spraying limitation. It would be the role of the jury to determine whether the additional steps of rubbing and/or blending "materially affect the basic and novel characteristics of the invention." *See* PPG Indus. v. Guardian Indus. Corp., 156 F.3d 1351, 1354-55 (Fed.Cir.1998). Thus, Plaintiff's statements in Exhibit 19 did not result in a process claim requiring direct spraying.

The reason the Patent Examiner ultimately allowed the patent over the prior art was because the prior art "fail[ed] to teach the claimed micronized titanium dioxide and the synergistic film-forming effect produced by synthetic wax and the micronized titanium dioxide," not because of a direct spraying limitation. Def.'s Exh. 20 (Jan. 13, 2003 Interview Summary and Examiner's Amendment). As the Federal Circuit held in 3M Innovative Properties Co. v. Avery Dennison Corp., 350 F.3d 1365 (Fed.Cir.2003), "when ... remarks made to distinguish claims from the prior art are broader than necessary to distinguish the prior art, the full breadth of the remark is not a clear and unambiguous disavowal of claim scope as required to depart from the meaning of the term provided in the written description." Id. at 1373. In essence, Plaintiff is correct that representations in the specification and prosecution history that Plaintiff's invention "may be," is "capable of," or "allows" direct spraying without any rubbing or blending by hand do not create a limitation. *See, e.g.,* Pl.'s Exh. A., 2:63-65, 3:35-47, 3:67-4:2. Plaintiff has not deviated from the ordinary meaning of skin and imported a direct spraying limitation because it has not used "words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Superguide Corp. v. Directv Enter., Inc.,* 358, F.3d 879, 875 (Fed.Cir.2004) (quoting Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1327 (Fed.Cir.2002)).

2. "Micronized titanium dioxide-containing compound"

This phrase appears in the claims 1 and 12 at column 8, lines 43 through 44 and column 9, lines 39 through 40. The crux of the dispute centers on the word "micronized" and whether the definition contains a particle size restriction. By Defendant's expert's own account, "one who is skilled in the art would understand that the term 'micronized' does not give any precise information about the actual particle size." Decl. of Dr. Joel L. Zatz, para. 11. Since the claim language clearly does not contain an express particle size limitation,

Defendant cites portions of the specification and prosecution history as the basis for reading such a limitation into the claim.

The section of the specification that Defendant focuses on states:

Titanium dioxide is a white opaque pigment that provides coverage and color to the composition. The typical particle size of the titanium dioxide, which has a platelet shape, is typically larger than one micron, and usually in the range of 5-15 microns. Micronized titanium dioxide, in contrast, has a typical size of between 0.15 and 0.3 angstroms. This significant change in size does not change the shape of the titanium dioxide.

Id. at 6:66-7:6.

Plaintiff argues that this language about particle size is a mistake and points out that it would be impossible to have a particle of micronized titanium dioxide between 0.15 and 0.3 angstroms since a single molecule of titanium by itself is 2.9 angstroms in diameter. Pl.'s Request for Judicial Notice; Pl.'s Exh. P (Periodic Table of the Elements, Atomic Radius). FN1 Although in Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371 (Fed.Cir.2004), the Federal Circuit did construe a claim to contain a "nonsensical" limitation, that limitation was clearly expressed in the claim language itself. As the court explained:

FN1. 1 micron = 1,000 nanometers (nm) = 10,000 angstroms. Def.'s Brief, at 6 n. 23; Pl.'s Request for Judicial Notice, para. 2; Pl.'s Exh. O.

... courts may not redraft claims, whether to make them operable or to sustain their validity. Even "a nonsensical result does not require the court to redraft the claims of the ... patent. Rather, where as here, claims are susceptible to only one reasonable interpretation and that interpretation results in a nonsensical construction of the claims as a whole, the claim must be invalidated." *Process Control Corp.,* 190 F.3d at 1357. "Where, as here, the claim is susceptible to only one reasonable construction, the canons of claim construction cited by [Chef America] are inapposite, and we must construe the claims based on the patentee's version of the claim as he himself drafted it." *Id*.
Chef America, 358 F.3d at 1374. *Chef America* is clearly distinguishable from the case before the Court: the mistake here, a nonsensical passage regarding particle size, is not part of the claim language, but rather a portion of the specification. The claim itself does not contain any particle size limitation and the Court will not read one into the claim based on a nonsensical sentence in the specification.
Next, looking to the prosecution history, the claims were never amended to add a particle size restriction. In a January 13, 2003 telephone interview, the Patent Examiner amended the claims and explained that she would allow them over the prior art because the prior art "fails to teach the claimed micronized titanium dioxide and the synergistic film-forming effect produced by synthetic wax and the micronized titanium dioxide." Def.'s Exh. 20. The Examiner amended claims 1 and 12 to add the following: " *wherein the synthetic wax and the micronized titanium dioxide-containing compound exhibit a synergistic film-forming effect*." *Id*. (emphasis added). The telephone interview did not trigger any amendment based on a required particle size for the micronized titanium dioxide, and it is not even clear that in the telephone conversation Plaintiff's representative actually made any such representation about particle size. Whatever happened during the prosecution history was not essential to traverse the prior art and thus is not a clear disavowal of claim scope. *See* 3M Innovative, 350 F.3d at 1373.

Defendant argues that there must be a particle size limitation because the patent would be invalid if the "synergistic effect" were the only point of novelty, because such an effect is inherently anticipated by the prior art, citing Toro Co. v. Deere & Co., 355 F.3d 1313, 1320-21 (Fed.Cir.2004). Although validity ordinarily is not at issue during the claim construction phase, there is an axiom that claims should be construed, if possible, to sustain validity. But that axiom does not apply "if the only claim construction that is consistent with the claim's language and the written description renders the claim invalid." *See* Rhine v. Casio, Inc., 183 F.3d 1342, 1345 (Fed.Cir.1999). Nothing in the intrinsic record creates a particle size limitation. To the contrary, the specification reflects Plaintiff's intent to use any of a variety of commercially-available micronized titanium dioxides in the patented cosmetic composition, as opposed to some smaller and novel form of micronized titanium dioxide:

The micronized titanium dioxide-containing compound *may be any as is known in the art including, but not limited to:* a C12-15Alkyl Benzoate and titanium dioxide compound or composition; a cyclomethicone and micronized titanium dioxide compound or composition; a water and micronized titanium dioxide compound or composition; a ethyl hexyl palmitate and micronized titanium dioxide compound or composition; a caprilic/capric triglyceride and mineral oil and micronized titanium dioxide compound or composition; and/or a caprilic/capric triglyceride and micronized titanium dioxide composition.

Pl.'s Exh. A, 6:30-34 (emphasis added); *see also* Pl.'s Exhs. F, I (examples of commercially-available micronized titanium dioxide). Thus, "micronized titanium dioxide-containing compound" means "a mixture of two or more components, one of which is a micronized form of titanium dioxide." The Court refuses to read a particle size restriction into the claim because the intrinsic record does not clearly create any such limitation.

3. "Exhibit a synergistic film-forming effect"

This phrase appears in claims 1 and 12 at column 8, lines 46 though 48 and column 9, line 41 through column 10, line 2. The root word of "synergistic" is "synergism," which both the common dictionary and the chemical dictionary define as involving an effect that is greater than the effect of each component alone. Pl.'s Exh. C (Merriam Webster's Collegiate Dictionary, 10th ed.); Def.'s Exh. 15 (American Heritage College Dictionary, 3d ed.); Def.'s Exh. 14 (Hawley's Condensed Chemical Dictionary, 13th ed.). "Exhibit a synergistic film-forming effect" means "a film-forming effect produced by the interaction of two components that is greater than the sum of the film-forming effect produced by each component in the absence of the other."

4. "Does not dry damaged skin"

Claims 1 and 12 contain this language at column 8, lines 53 through 54 and column 10, line 8. "Does not dry damaged skin" means "does not make damaged skin free of moisture." The Court will not read quantitative restrictions or objective testing procedure limitations into the definition since there are none in the intrinsic evidence. *See* Invitrogen Corp. v. Biocrest Manuf., L.P., 327 F.3d 1364, 1370-71 (Fed.Cir.2003); Applera Corp. v. MJ Research Inc., 292 F.Supp.2d 348, 368-69 (D.Conn.2003).

5. "Water-resistant"

The term "water-resistant" appears in claims 1 and 12 at column 8, line 30 and column 10, line 10. The definition Defendant offers is more akin to water- *proof* than *water-resistant*. Plaintiff's proposed definition is correct; "water-resistant" means "resistant but not impervious to penetration by water."

6. "Composed of"

Claim 12 uses the phrase "composed of" at column 9, lines 28 through 29. "Composed of" is a transitional phrase that, depending on context, can either be a closed transitional phrase, like "consisting of," or it can be somewhere between that phrase and the closed transitional phrase "consisting essentially of." AFG Indus., Inc. v. Cardinal IG Co., Inc., 239 F.3d 1239, 1244-45 (Fed.Cir.2001); *see also* Pl.'s Eh. H (Manual of Patent Examining Procedures, s. 2111.03). In the context of Plaintiff's patent, "composed of" is akin to "consisting essentially of" because there is no language in the claims or in the specification suggesting that the cosmetic composition must consist *only* of the elements enumerated in claim 12. Thus, "composed of" means "consisting of only the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention."

7. "Will adhere to laser-treated skin"

This phrase appears in claims 1 and 12 at column 8, line 55 and column 10, lines 9 through 10. There is nothing in the intrinsic record to rebut the presumption that this phrase carries its ordinary meaning and there is no basis to read a quantitative limitation or testing procedure into the claims. *See* Invitrogen, 327 F.3d at 1370-71; Applera, 292 F.Supp.2d at 368-69. "Will adhere to laser-treated skin" means "will stick to laser-treated skin."

8. "Consisting essentially of"

This transitional phrase appears in claim 1 at column 8, lines 25 through 26. "Consisting essentially of" means "consisting of only the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention."

9. "Percent by weight"

These words appear several times throughout both claims 1 and 12 at;r column 8, lines 34 through 51 and column 9, line 30 through column 10, line 5. There is no real disagreement about the meaning of this term. "Percent by weight" means "the ratio, expressed as a percentage, of the weight of an individual ingredient to the total weight of the cosmetic composition."

CONCLUSION

For all of the foregoing reasons, and for good cause appearing therefor, the Court construes the disputed terms as described in the foregoing Order.

IT IS SO ORDERED.

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