--- F.3d ----, 2015 WL 1727013 (C.A.Fed. (Tex.))
(Cite as: 2015 WL 1727013 (C.A.Fed. (Tex.)))

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Only the Westlaw citation is currently available.

United States Court of Appeals,
Federal Circuit.
INEOS USA LLC, Plaintiff–Appellant
v.
BERRY PLASTICS CORPORATION, Defendant–Appellee.

No. 2014–1540.
April 16, 2015.

Background: Owner of patent for polyethylene-based compositions used to form shaped products filed infringement action against competitor. The United States District Court for the Southern District of Texas, Gregg Costa, J., 2014 WL 1493852, entered summary judgment of invalidity, and patentee appealed.

Holdings: The Court of Appeals, Moore, Circuit Judge, held that:
(1) claim requiring that composition be comprised 0.05 to 0.5% by weight of at least one saturated fatty acid amide was anticipated by prior art;
(2) prior art's disclosure of optional subsidiary lubricant and optional additive satisfied patent's limitations; and
(3) prior art anticipated specification for saturated fatty acid amide behenamide as primary lubricant.

Affirmed.

West Headnotes

[1] Patents 291 ⚿487(2)

291 Patents
291II Patentability and Validity
291II(C) Novelty; Anticipation
291II(C)1 In General
291k483 Prior Art and Relation of Claimed Invention Thereto
291k487 Contents and Sufficiency of Prior Art in General
291k487(2) k. Enablement. Most Cited Cases

Patents 291 ⚿489(2)

291 Patents
291II Patentability and Validity
291II(C) Novelty; Anticipation
291II(C)1 In General
291k483 Prior Art and Relation of Claimed Invention Thereto
291k489 Number of Prior Art References; Combinations
291k489(2) k. Single Reference Disclosing Every Element or Limitation of Claim. Most Cited Cases

To anticipate patent claim, reference must describe each and every claim limitation and enable one of skill in art to practice embodiment of claimed invention without undue experimentation. 35 U.S.C.A. § 102.

[2] Patents 291 ⚿524

291 Patents
291II Patentability and Validity
291II(C) Novelty; Anticipation
291II(C)2 Particular Fields of Invention
291k523 Chemicals
291k524 k. In General. Most Cited Cases

Claim in patent for polyethylene-based compositions used to form shaped products, which required that composition be comprised 0.05 to 0.5% by weight of at least one saturated fatty acid amide, was anticipated by prior art that disclosed lubricant, which could be stearamide, in amounts from 0.1 to 5 parts by weight, where patent specification indicated that lubricants included in invention functioned to improve plastic caps' slip properties and ability to be unscrewed from bottle and described invention's novelty as eliminating odor and taste problems associated with prior art bottle caps while

still maintaining good slip properties, and patentee failed to established that any of those properties would differ if range from prior art patent was substituted for range of limitation. 35 U.S.C.A. § 102.

[3] Patents 291 ⚿488

291 Patents
291II Patentability and Validity
291II(C) Novelty; Anticipation
291II(C)1 In General
291k483 Prior Art and Relation of Claimed Invention Thereto
291k488 k. Extent of Similarity or Difference Between Prior Art and Claimed Invention in General. Most Cited Cases

When patent claims range, that range is anticipated by prior art reference if reference discloses point within range. 35 U.S.C.A. § 102.

[4] Patents 291 ⚿488

291 Patents
291II Patentability and Validity
291II(C) Novelty; Anticipation
291II(C)1 In General
291k483 Prior Art and Relation of Claimed Invention Thereto
291k488 k. Extent of Similarity or Difference Between Prior Art and Claimed Invention in General. Most Cited Cases

If prior art discloses its own range, rather than specific point, then prior art is only anticipatory if it describes claimed range with sufficient specificity such that reasonable fact finder could conclude that there is no reasonable difference in how invention operates over ranges. 35 U.S.C.A. § 102.

[5] Patents 291 ⚿524

291 Patents
291II Patentability and Validity
291II(C) Novelty; Anticipation
291II(C)2 Particular Fields of Invention
291k523 Chemicals
291k524 k. In General. Most Cited Cases

Limitations in claim for patent for polyethylene-based compositions used to form shaped products, which described composition comprising 0 to 0.15% by weight of subsidiary lubricant and 0 to 5% by weight of one or more additives, were optional in claimed composition, and thus prior art's disclosure of optional subsidiary lubricant and optional additive satisfied limitations. 35 U.S.C.A. § 102.

[6] Patents 291 ⚿524

291 Patents
291II Patentability and Validity
291II(C) Novelty; Anticipation
291II(C)2 Particular Fields of Invention
291k523 Chemicals
291k524 k. In General. Most Cited Cases

Prior art patent for polyethylene-based compositions disclosing genus of saturated fatty acid amides and stating that good results were achieved with narrower genus of saturated fatty acid amides having 12 to 35 carbon atoms anticipated specification in patent for polyethylene-based compositions used to form shaped products specifying that primary lubricant was saturated fatty acid amide behenamide, which had 22 carbon atoms. 35 U.S.C.A. § 102.

Patents 291 ⚿2091

291 Patents
291X Patents Enumerated
291k2091 k. In General; Utility. Most Cited Cases

Patents 291 ⚿2091

291 Patents
291X Patents Enumerated
291k2091 k. In General; Utility. Most Cited Cases

Patents 291 ⚿2091

291 Patents
291X Patents Enumerated
291k2091 k. In General; Utility. Most Cited Cases
5,900,514. Cited.

5,948,846. Cited as Prior Art.

6,846,863. Invalid.

Donald Robert Dunner, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC, argued for plaintiff-appellant. Also represented by Allen Marcel Sokal.

Deborah Pollack–Milgate, Barnes & Thornburg LLP, Indianapolis, IN, argued for defendant-appellee. Also represented by Jessica M. Lindemann.

Before DYK, MOORE, and O'MALLEY, Circuit Judges.

MOORE, Circuit Judge.

***1** Ineos USA LLC accused Berry Plastics Corporation of infringing U.S. Patent No. 6,846,863. Ineos appeals from the district court's summary judgment that the '863 patent is invalid as anticipated under 35 U.S.C. § 102 (2006). We *affirm.*

BACKGROUND

The '863 patent is directed to polyethylene-based compositions which can be used to form shaped products, such as screw caps for bottles. ' 863 patent col. 1 ll. 5–8. Prior art polyethylene bottle caps incorporated a lubricant to optimize the cap's slip properties and to facilitate unscrewing of the cap. *Id.* col. 1 ll. 9–14. However, these compositions suffered the disadvantage of imparting bad odor and flavor to food products stored in contact with the compositions. *Id.* col. 1 ll. 15–17. The '863 patent explains that its compositions having specific amounts of polyethylene, lubricants, and additives solve this problem. *Id.* col. 1 ll. 24–35. Claim 1 is the only independent claim and is illustrative:

1. Composition comprising at least [1] 94.5% by weight of a polyethylene with a standard density of more than 940 kg/m3,

[2] 0.05 to 0.5% by weight of at least one saturated fatty acid amide represented by CH3(CH2)nCONH2 in which n ranges from 6 to 28[,]

[3] 0 to 0.15% by weight of a subsidiary lubricant selected from fatty acids, fatty acid esters, fatty acid salts, mono-unsaturated fatty acid amides, polyols containing at least 4 carbon atoms, mono- or poly-alcohol monoethers, glycerol esters, paraffins, polysiloxanes, fluoropolymers and mixtures thereof, and

[4] 0 to 5% by weight of one or more additives selected from antioxidants, antacids, UV stabilizers, colorants and antistatic agents.

For ease of reference, we refer to the various limitations by the respective bracketed numbers inserted into the claim.

Ineos alleged that Berry Plastics infringes claims 1–7 and 9–11 of the '863 patent. Berry Plastics moved for summary judgment that the asserted claims are anticipated independently by various prior art references, including U.S. Patent No. 5,948,846. The parties do not dispute that the '846 patent discloses 94.5% by weight of a polyethylene with a standard density of more than 940 kg/m3 as described in limitation 1 of claim 1 of the '863 patent. *Ineos USA LLC v. Berry Plastics Corp.,* No. 13–cv–0017, slip op. at 11 (S.D. Tex. Apr. 15, 2014), ECF No. 101 (*Summary Judgment Order*). Likewise, there is no dispute that stearamide, disclosed in the '846 patent, is a compound within the class of saturated fatty acid amides represented by CH3(CH2)nCONH2 in which n ranges from 6 to 28 ("primary lubricant") described in limitation 2. The court found that the '846 patent's disclosure of a lubricant, which could be stearamide, in amounts from 0.1 to 5 parts by weight,[FN1] and more specifically of "at least 0.1 part by weight per 100

parts by weight of polyolefin, in particular of at least 0.2 parts by weight, quantities of at least 0.4 parts by weight being the most common ones" describes specific values (e.g., 0.1 part by weight) along with the broader disclosure of the full range (0.1 to 5 parts by weight). *Id.* at 13–14. It therefore concluded that the '846 patent's disclosure of stearamide in these amounts met limitation 2. *Id.* at 11–14. It then determined that the subsidiary lubricant of limitation 3 and the additive of limitation 4 are optional in the claimed composition because limitations 3 and 4 set forth ranges beginning with 0%. *Id.* at 14–16. It therefore found that the '846 patent's disclosure of an optional subsidiary lubricant and an optional additive satisfied limitations 3 and 4. *Id.* The court concluded that the '846 patent anticipates the asserted claims. Ineos appeals. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

DISCUSSION

***2** [1] We review the grant of summary judgment under the law of the relevant regional circuit. *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1340 (Fed.Cir.2013). The Fifth Circuit reviews grants of summary judgment de novo. *Triple Tee Golf, Inc. v. Nike, Inc.*, 485 F.3d 253, 261 (5th Cir.2007). Summary judgment is appropriate 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(a). To anticipate a patent claim under 35 U.S.C. § 102, "a reference must describe ... each and every claim limitation and enable one of skill in the art to practice an embodiment of the claimed invention without undue experimentation." *Am. Calcar, Inc. v. Am. Honda Motor Corp.*, 651 F.3d 1318, 1341 (Fed.Cir.2011) (citing *In re Gleave*, 560 F.3d 1331, 1334 (Fed.Cir.2009)).

I. Independent Claim 1

Ineos argues that the court erred in finding claim 1 of the '863 patent anticipated by the '846 patent and in concluding that Ineos failed to raise a genuine dispute of material fact in opposing summary judgment. Ineos asserts that the '846 patent discloses no single species within the genus of claim 1. It asserts that although the '846 patent discloses stearamide—one of the primary lubricants of limitation 2—the '846 patent does not disclose or suggest that stearamide or any other primary lubricant "should be included as a lubricant in an amount between 0.05 and 0.5% by weight while entirely excluding or severely limiting any other lubricant to no more than 0.15% by weight." Appellant's Br. 28. Ineos argues that, contrary to the court's conclusion, the '846 patent discloses ranges for amounts of lubricants, not particular individual point values. Relying on *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991 (Fed.Cir.2006), Ineos argues that because the ranges concerning the amounts of lubricants disclosed in the '846 patent only slightly overlap with the ranges of limitations 2 and 3 in claim 1 of the '863 patent, the ' 846 patent does not disclose these limitations. Appellant's Br. 28–32. Ineos contends that, at the very least, under *OSRAM Sylvania, Inc. v. American Induction Technologies, Inc.*, 701 F.3d 698, 706 (Fed.Cir.2012), the court should not have granted summary judgment in light of Ineos's proffered testimony that the ranges claimed in the '863 patent are critical. Appellant's Br. 33–35.

Berry Plastics responds that the court properly granted summary judgment. It argues that the description in the '846 patent of stearamide in amounts of "at least 0.1 part by weight per 100 parts by weight of polyolefin, in particular at least 0.2 parts by weight, quantities of at least 0.4 parts by weight being the most common ones" discloses particular points (i.e., 0.1, 0.2, and 0.4 parts by weight) within the range claimed in limitation 2 of claim 1 of the '863 patent (i.e., 0.05 to 0.5% by weight). Similarly, Berry Plastics argues that the court correctly concluded that because the compositions of the '846 patent contain "one or more lubricating agents," the '846 patent discloses that a subsidiary lubricant is optional. Berry Plastics asserts that the court therefore correctly found that the '846 patent met limitation 3 of claim 1 of the '863 patent.

Finally, Berry Plastics asserts that the court did not err in declining to consider the purported criticality of the claimed ranges in limitations 2 and 3 because such inquiry is not necessary where, as here, the prior art discloses particular points within the later claimed range.

***3** [2][3][4] We hold that the district court correctly granted summary judgment of anticipation. When a patent claims a range, as in this case, that range is anticipated by a prior art reference if the reference discloses a point within the range. *Titanium Metals Corp. v. Banner,* 778 F.2d 775, 782 (Fed.Cir.1985). If the prior art discloses its own range, rather than a specific point, then the prior art is only anticipatory if it describes the claimed range with sufficient specificity such that a reasonable fact finder could conclude that there is no reasonable difference in how the invention operates over the ranges. *Atofina,* 441 F.3d at 999; *ClearValue, Inc. v. Pearl River Polymers, Inc.,* 668 F.3d 1340, 1345 (Fed.Cir.2012). Limitation 2 is met by the disclosure of the '846 patent. The '846 patent specification states:

> The composition according to the invention includes the lubricating agent in a total quantity of *at least* 0.1 part by weight per 100 parts by weight of polyolefin, in particular of at least 0.2 parts by weight, quantities of at least 0.4 parts by weight being the most common ones; *the total quantity of lubricating agents does not exceed* 5 parts by weight, more especially 2 parts by weight, *maximum values* of 1 part by weight per 100 parts by weight of polyolefin being recommended.

'846 patent col. 2 l. 66–col. 3 l. 7 (emphasis added). The phrases "at least" and "does not exceed" set forth corresponding minimum and maximum amounts for the primary lubricant. This portion of the specification clearly discloses ranges, not particular individual values. As we stated in *Atofina,* "the disclosure of a range ... does not constitute a specific disclosure of the endpoints of that range." 441 F.3d at 1000. The court therefore erred in concluding that the '846 patent discloses particular points within the range recited in limitation 2.

This conclusion is not fatal to Berry Plastics' case, however, because Ineos failed to raise a genuine question of fact about whether the range claimed is critical to the operability of the invention. Ineos has not demonstrated that *Atofina* or *OSRAM* requires reversal in this case.

In *Atofina,* we reversed the district court's finding of anticipation where the patent-in-suit claimed a temperature range that was critical to the operability of the invention and the range disclosed in the prior art was substantially different. *Atofina* involved a patent claiming a method of synthesizing difluoromethane at a temperature between 330–450 °C. *Atofina,* 441 F.3d at 993; U.S. Patent No. 5,900,514 col. 3 ll. 61–62. Atofina's patent and its prosecution history described the claimed temperature range as critical to the invention, and stated that the synthesis reaction would not operate as claimed at a temperature outside the claimed range. *See Atofina,* J.A. 1304, 1306, 1311–12; '514 patent col. 3 ll. 61–65; *see also ClearValue,* 668 F.3d at 1344–45. The prior art at issue in *Atofina* disclosed a broad temperature range of 100–500 °C. *Atofina,* 441 F.3d at 999. The patent-in-suit was not anticipated because there was a "considerable difference" between the prior art's broad disclosure and the claimed "critical" temperature range, such that "no reasonable fact finder could conclude that the prior art describes the claimed range with sufficient specificity to anticipate this limitation of the claim." *Id.* at 999; *see also ClearValue,* 668 F.3d at 1345. Key to this conclusion was the fact that the evidence showed that a person of ordinary skill in the art would have expected the synthesis reaction to operate differently, or not all, outside of the temperature range claimed in the patent-in-suit. *Atofina,* 441 F.3d at 999; *see also ClearValue,* 668 F.3d at 1345.

***4** In *ClearValue,* we further explained the importance of establishing the criticality of a claimed range to the claimed invention in order to avoid an-

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