



UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

PRIORITY
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CIVIL MINUTES -- GENERAL

Case No. SACV 03-655-JVS(Ex)

Dated: November 26, 2003

Title: NINI POLICAPPELLI v. HEINEKEN USA INC.

PRESENT: HONORABLE JAMES V. SELNA, UNITED STATES DISTRICT JUDGE

Karla J. Tunis
Courtroom Deputy

Not Present
Court Reporter

ATTORNEYS PRESENT FOR PLAINTIFFS:

ATTORNEYS PRESENT FOR DEFENDANTS:

Not Present

Not Present

PROCEEDINGS(IN CHAMBERS):

**Order Granting First Motion of Defendant for Summary
Judgment of Claim Construction**

In this action for patent infringement instituted by Plaintiff Nini Policappelli ("Policappelli") against Defendant Heineken U.S.A, Inc. ("Heineken"), Policappelli alleges that Heineken's "keg-shaped" beer cans (the "Heineken Keg Cans") infringe a number of patent claims contained in four of Policappelli's patents. (Compl., ¶¶ 19-24.) The matter is currently before the Court on Heineken's Motion for summary judgment regarding the legal construction of four patent claim terms found in the patents-in-suit: "protrusions," "indentations," "profile," and "stamping." (Mot. for Summ. J. of Claim Construction, p. 17.) Policappelli opposes Heineken's Motion on the ground that there are genuine issues of material fact regarding each of these terms.¹ (Opp'n to Mot. for Summ. J. of Claim Construction, p. 1.) The Court disagrees. It is well settled that "construction of a patent, including terms of art within its claim, is exclusively within the province of the court." Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996). Heineken's Motion is accordingly granted. Fed. R. Civ. P. 56. The claim terms at issue are construed in the manner set forth in Part II below.²

¹Policappelli also makes several general objections to the Motion. First, he argues that it is inappropriate in light Judge Walter's earlier rulings. (Opp'n to Mot. for Summ. J. of Claim Construction, p. 1.) Policappelli overlooks the fact that the Court is required to address claim construction issues before dealing with Heineken's separate motions for invalidity and non-infringement. In re Cruciferous Sprout Litigation, 301 F.3d 1343, 1349 (Fed. Cir. 2002); Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed. Cir. 1995), aff'd, 517 U.S. 370 (1996). The manner in which Heineken has packaged its motions does not affect the Court's duties.

Second, Policappelli complains that Heineken has tendered only certain claims for construction. (Id.) Obviously, Policappelli is entitled to tender other claims which he believes require claim construction.

² The Court notes that, in construing the terms tendered for construction, it has not resorted to extrinsic evidence. (See Opp'n to Mot. for Summ. J. of Claim Construction, p. 10.)

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I. Background.

Beginning in March 1993, Policappelli filed a series of related patent applications with the United States Patent and Trademark Office (the “PTO”) that spanned a nine-year period of pendency before the PTO. These applications, six in total, ultimately resulted in the four patents that are at issue in this case. Policappelli’s first application, Patent Application Serial Number 029,791 for a “Partially Collapsible Container With Drinking Straw or Pour Spout,” was filed on March 11, 1993 and eventually abandoned. (See Def.’s Exhs., Exh. 4, pp. 427, 452.) Most relevant to the Motion at hand, the application states that the exterior of the container “may” contain “various protrusions” that are “raised with respect to the side surface” of the container and “stamped outward” using a “stamping process which pushes the protrusions . . . outward on one side and creates indentations on the other side.” (Exh. 4, pp. 433, 442, 443.) Per the application, the purpose of these protrusions is to “increase the volume of the container” (*id.* at p. 433), “enhance the ability of the user to grasp the container” (*id.* at p. 442), reduce conductivity between a user’s hand and the container (*id.* at p. 434), “convey any message to consumers” (*id.* at p. 444), and “provide additional strength to the container” (*id.*).

In 1995, Policappelli abandoned his first application in favor of a second: Patent Application Serial Number 378,461. (See Def.’s Exhs., Exh. 9.) This second application, filed on January 26, 1995, describes a “Container for Dispensing Liquids.” A continuation in part (“CIP”) of the first application, it incorporates all of the contents of the former application, including the subject matter regarding “protrusions,” “indentations,” and “stamping” discussed above.³ On December 24, 1996, the application was granted and Patent 5,586,681 (the “681 Patent”) was issued and assigned to Policappelli. (See Def.’s Exhs., Exh. 6.)

Policappelli’s third application, Patent Application Serial Number 542,089 for a “Laminated Container,” was filed on September 7, 1995 as a CIP of his second application. (See Def.’s Exhs., Exh. 16.) This third application, which incorporates the terms of both the first and second applications,⁴ is significant in two respects for purposes of the Motion before the Court. First, it uses the term “profile” to describe the shape of the disclosed container’s body for the first time in a Policappelli application. (*Id.* at pp. 739–40; see also Exhs. 11–14.) Second, it provides insight into Policappelli’s use of the term “protrusions.” When the PTO rejected certain claims pertaining to “protrusions” during the prosecution of the third application, Policappelli defended the claims against double-patenting and prior-art rejections by explaining, in part,

The protrusions are area [*sic*] in a plane which is different to the general planar area of the can. The protrusions, with the printing over the protrusions, can be *directed outwardly or inwardly* relative to this general planar surface, which thereby provides a three dimensional printed structure for the surface.

(Exh. 16, p. 917; emphasis supplied.) As Heineken points out in its moving papers, this definition of the word “protrusions” can be characterized as somewhat of a departure from Policappelli’s prior disclosures

³ The second application also adds subject matter pertaining to printed “ornamental representation” on the outside surface of the container. (Exh. 9, p. 282.) During the application’s prosecution, the PTO narrowed the scope of the proposed patent by amending the claims to include: (1) an express limitation requiring “printed lettering” as part of the ornamental representation (*id.* at pp. 359); and (2) an express limitation requiring the ornamental representation to extend over the protrusions (*id.* at pp. 380).

⁴ All of the CIP applications referenced herein incorporate the contents of their parent applications.

concerning the term. (Mot. for Summ. J. of Claim Construction, p. 32.) The prior disclosures in the first, second, and third applications describe “protrusions” using language such as “stamped outward” (Exh. 6, p. 262, col. 2, line 15), “project[ing] outward” (Exh. 4, p. 442; Exh. 6, p. 265, col. 8, line 49; Exh. 16, p. 731), “raised with respect to the side surface” (Exh. 4, p. 442; Exh. 6, p. 265, col. 8, lines 32–33), and “extending outwardly to increase the volume of the container” (Exh. 6, p. 267, col. 11, lines 26–27). Nowhere do these prior applications state or suggest that “protrusions” might be “directed outwardly or inwardly” with respect to the surface of the container described.⁵

Policappelli’s third application issued as Patent 5,762,230 (the “‘230 Patent”) on June 9, 1998. (See Def.’s Exhs., Exh. 10.) His fourth application, a CIP of the third, is not relevant to the Motion before the Court and was ultimately abandoned in favor of Policappelli’s fifth application, which was filed on November 24, 1997. (See Def.’s Exhs., Exh. 20.) Entitled “Top for Container,” Patent Application Serial Number 977,348 is a CIP of Policappelli’s abandoned fourth application. It issued on March 12, 2002 as Patent 6,354,458 (the “‘458 Patent”). (See Def.’s Exhs., Exh. 18.) The ‘458 Patent has only one independent claim, which describes a metal container that includes, among other things, a “profile pattern” formed by a “stamping process” and “ornamental representation . . . extending over the profile pattern of the can.” (Exh. 18, p. 903, col. 10, lines 27, 35, 45–46, 55–56.) None of the ‘458 Patent’s claims use the term “protrusions.” However, the term is found elsewhere in the specification. (See, e.g., Exh. 18, pp. 901–02.)

Finally, Policappelli filed his sixth application, Patent Application Serial Number 391,642, on September 7, 1999. (See Def.’s Exhs., Exh. 22.) This application, for a “Laminated Container,” was a CIP of Policappelli’s fifth application and issued as Patent 6,311,861 (the “‘861 Patent”) on November 6, 2001. (See Def.’s Exhs., Exh. 21.) Significantly, the claims of the ‘861 Patent abandon the use of the term “profile,” reverting to use of the term “protrusions” instead. (Exh. 21, pp. 1198–99, cols. 10–12.) Also important for the matter at hand, Claim 1 teaches a beverage can with a “body portion having . . . a pattern of protrusions . . . and . . . further having indentations relative to the curved wall” (Exh. 21, p. 1198, col. 10, lines 48–60; emphasis supplied.) The prosecution history of the patent reveals that Policappelli narrowed his application claims to require the claimed container to have “indentations” separate from “protrusions” following a PTO Office Action dated September 14, 2000.⁶ (See Def.’s Exhs., Exh. 22, pp. 280–82, 316).

On August 28, 2002, Policappelli filed suit against Heineken, alleging that the Heineken Keg Cans infringe the ‘681 Patent, the ‘230 Patent, the ‘458 Patent, and the ‘861 Patent.⁷ (Compl., ¶¶ 19–24.) Specifically, Policappelli asserts that the Heineken Keg Cans infringe Claims 1 through 5 of the ‘681 Patent, Claims 11 through 18 of the ‘230 Patent, Claims 1 through 5 of the ‘458 Patent, and Claims 1 through 6 of the ‘861 Patent. (See Pl.’s Supplemental Responses to Def.’s First Set of Interrogatories, attached as Exh. 138 to Def.’s Exhs.) On October 22, 2003, Heineken filed three Motions for Summary Judgment. The first of

⁵ In fact, the possibility that “protrusions” might include areas “directed . . . inwardly” relative to the surface of the container contradicts some of the stated purposes of the “protrusions,” including increasing the volume of the container and improving a user’s ability to grip the container.

⁶ In this regard, Policappelli wrote, “[C]hanges have been made to the independent claims to define more precisely the protrusions. Claim 21 is defined as having protrusions and also indentations relative to the curved wall.” (Def.’s Exhs., Exh. 22, p. 316.)

⁷ Policappelli also alleged a cause of action for misappropriation of trade secrets. This second claim was dismissed by the Court, pursuant to Heineken’s Motion to Dismiss, on December 4, 2002. (Dec. 4, 2002 Minute Order.)

these requests summary judgment in Heineken's favor on claim construction; the second asserts invalidity of the asserted claims; the third argues non-infringement. Only the first Motion is presently before the Court. (See Nov. 4, 2003 Minute Order.)

II. Discussion.

Claim construction "begins and ends" with the claim language itself. Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323, 1331 (Fed. Cir. 2001). In construing the language of a patent claim for purposes of claim construction, the patent and its prosecution history are of paramount importance. Burke, Inc. v. Bruno Ind. Living Aids, Inc., 183 F.3d 1334, 1340 (Fed. Cir. 1999). Evidence extrinsic to this public record may only be consulted "if needed to assist in determining the meaning of scope of technical terms in the claims." Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1216 (Fed. Cir. 1995); accord Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed. Cir. 1996). The Court's starting point in determining the meaning of the terms at issue in this Motion is therefore the intrinsic evidence: the claim language, specification, and prosecution history of the relevant patents.

Where the intrinsic evidence of a patent reveals that a patentee has acted as lexicographer with respect to a particular claim term—by creating a new word or assigning a new or different meaning to an existing word, for example—"the definition selected by the patent applicant controls" and the term's special meaning is given full force. Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1249 (Fed. Cir. 1998). The lexicography must "appear with reasonable clarity, deliberateness, and precision before it can affect the claim," however. Id. (internal citations omitted). The test for whether a special meaning is reasonably clear is whether the patent or its prosecution history "put a reasonable competitor or one reasonably skilled in the art on notice" that the patentee intended to redefine the claim language at issue in the manner asserted. Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357 (Fed. Cir. 1999), cert. denied, 529 U.S. 1037 (2000).

Where, on the other hand, the patent applicant is not deemed a lexicographer, there is a "heavy presumption" that the words in the claims have their full ordinary or accustomed meaning. Johnson Worldwide Assocs. v. Zebco Corp., 175 F.3d 985, 989 (Fed. Cir. 1999). As the Federal Circuit recently noted, "dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms." Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed. Cir. 2002). If a particular claim term has both an ordinary meaning and a customary meaning known to one ordinarily skilled in the art, and these meanings conflict, the latter meaning prevails. Karlin Tech v. Surgical Dynamics, 177 F.3d 968, 971 (Fed. Cir. 1999).

With these principles in mind, Heineken argues that: (1) The term "protrusions" must be defined, pursuant to the prosecution histories of the patents-in-suit, "in the particular manner that Policappelli himself chose"; and (2) The ordinary and customary meaning of "indentations," "profile," and "stamping" can be discerned from dictionary and treatise definitions, "since those definitions are consistent with the intrinsic evidence and the usage made by Policappelli of the terms in the specifications of his patents . . ." (Mot. for Summ. J. of Claim Construction, p. 20.) Heineken urges the Court to construe the terms at issue as follows:

- Protrusions: More than one area in a plane which is different to the general planar area of a container
- Indentations: More than one dent or hollow that is separate from a protrusion
- Profile: A contour or outline of a surface in a plane at an angle to the surface
- Stamping: To impress something with a device by means of a die and blow or mechanical pressure

(Id.)

In opposition to the Motion, Policappelli asserts that: (1) He did not intend to be his own lexicographer with respect to the term “protrusions” (Opp’n to Mot. for Summ. J. of Claim Construction, p. 2.); and (2) He did intend to be his own lexicographer with respect to the term “indentations,” because the relevant patent prosecutions clearly and expressly redefine the term outside of its customary meaning (id. at p. 16). Relying on his own dictionaries, encyclopedias, and treatises, Policappelli requests that the Court construe the claim terms at issue in the following manner:

- Protrusions: Those that jut inwardly or outwardly beyond the surrounding surface or content
- Indentations: Dents or hollows inside the surface of the can and the local deformations of the surface outward from that perspective
- Profile: Outline of an object⁸
- Stamping: To shape or cut out with a mold, form, or die

(Id. at p. 20.)

A. Protrusions

All of the asserted claims in the ‘681 Patent (Claims 1 through 5) and the ‘861 Patent (Claims 1 through 6) use the term “protrusions.” In addition, Claims 11, 12, 13, 14, 17, and 18 of the ‘230 Patent use the term.

The Court finds that Policappelli did not act as lexicographer with respect to the term “protrusions.” Heineken makes much of Policappelli’s statements to the PTO, during the prosecution of the ‘230 Patent, that “[t]he protrusions . . . can be directed outwardly or inwardly” and “protrusions are area[s] in a plane which [are] different to the general planar area of the can.” (Exh. 16, p. 917.) Based on these isolated statements, Heineken argues that the broader definition of “protrusions” given by Policappelli should govern the construction of the term. The Court disagrees, given the overwhelming weight of the remaining intrinsic evidence. First, the statements referenced by Heineken do not evince a deliberate and reasonably clear special meaning, such that one reasonably skilled in the art would be put on notice of the meaning advocated by Heineken.⁹ Process Control Corp., 190 F.3d at 1357. In order for a patentee to be deemed a

⁸ In its Reply, Heineken advises the Court that, while it maintains that its definition of “profile” is more appropriate, it “has no objection” to Policappelli’s construction of the term. (Reply, p. 10.)

⁹ A close look at the context in which the statements were made suggests that Policappelli may have been using the term “protrusions” broadly, to encompass both “protrusions” and “profile,” based on the PTO examiner’s own conflation of these terms rather than his own intent to redefine “protrusions.” The examiner had rejected Claims 46 through 48 “on the basis that there was no disclosure of a radially inwardly extending protrusion.” (Exh. 16, p. 914.) In defending the claim, Policappelli pointed to figures 20A–20C and 21, all of whose “body portion is curved inwardly in the center to form a waistline,” or profile. Policappelli went on to correct the examiner’s use of the term “protrusions,” pointing out that “radially inwardly extending protrusions” were not the words used in the referenced claims. The actual language of the proposed claims describes a container with a “body portion” whose “profile extend[s] relatively inwardly relative to the same container.” (Id. at pp. 889–90.) Given this context, the

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