

United States District Court,
E.D. Pennsylvania.

DESIGN BY U.S. COMPANY,
Plaintiff.

v.

BEST FOODS, INC. and Sherri Cup, Inc,
Defendants.

No. 98-736

Aug. 1, 2000.

MEMORANDUM

BUCKWALTER.

Both plaintiff and defendants have submitted briefs requesting that this court, pursuant to *Markman v. Westview, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995), determine the meaning of the term "recyclable adhesive" as used in certain claims of U.S. Patent No. 5,205,473 ("the '473 patent").

The patent, in simple terms, is for an external wrap of corrugated paper that is placed over a standard paper cup so that, if the cup contains hot beverages or food items, it can comfortably be held despite the hot contents.

Claim 10, for purposes of the present *Markman* hearing, is the only one that the parties agree, the court need construe. Claim 10 claims the invention of:

An insulating beverage container, comprising a cellulosil corrugated tubular member consisting essentially of recyclable material, said container including a first opening and an internal cavity for containing a hot or cold medium, said container including fluting means adhesively attached with a *recyclable adhesive* to a liner for containing insulated air.

Plaintiff contends that the term "recyclable adhesive" means an adhesive that does not interfere with recycling paper.

Defendants contend that the term "recyclable adhesive" means an adhesive that, after use, can be recovered, processed and reused in some form as an adhesive.

Defendants list four reasons why its definition should be adopted by the court:

First, the term "recycle" has a commonly understood meaning, supported by definitions contained in ordinary dictionaries, trade literature and statute law, which requires both collection and reuse of the product

at issue.

Second, nothing in the '473 patent claims, specification or prosecution history indicates that the patentee, in using the term "recyclable," intended to give some unique or novel meaning to the term "recyclable adhesive." To the contrary, the limited evidence in the prosecution history demonstrates that DBU was embracing the ordinary meaning, rather than some novel meaning.

Third, both the inventor and the prosecuting attorney testified that they did not have (or could not recall) any novel definition of "recyclable adhesive" in mind when they filed and prosecuted the patent application.

Fourth, as DBU's professed expert himself has admitted, the proffered evidence with respect to the definition a paper recycler might give to the term "recyclable adhesive" is wholly irrelevant to a patent in the field of paper cup manufacturing. The expert has admitted his lack of any pertinent expertise and, even in his narrow area of non-pertinent expertise, has admitted that his proffered definition is an inaccurate one.

Plaintiff makes four arguments as to why the court should accept its definition. They are:

First, extrinsic evidence must be used to interpret "recyclable adhesive" because the term is not defined by the claims, specification or prosecution history.

Second, the *Dictionary of Paper* supports the ordinary meaning of "recyclable adhesive" understood by one skilled in the art that the adhesive does not interfere with recycling paper.

Third, the parties' respective experts agree that in the paper recycling industry, a "recyclable adhesive" is one that does not interfere with recycling paper.

Fourth, plaintiff's definition of "recyclable adhesive" upholds the validity of the claims of the '473 patent and claims should be construed to sustain their validity.

Because, on balance, I feel that plaintiff's arguments are more persuasive both legally and logically, I find that "recyclable adhesive" as used in the claims of the '473 patent means an adhesive that does not interfere with recycling paper. To find otherwise is to suggest that the adhesive would likely be recovered, collected, processed or reused by a recycler, a result that defendants' own witness decries. *See* Declaration of James A. Gatcomb.

Moreover, while defendants argue that the word "recycle" has a commonly understood meaning, those meanings do not necessarily attach to the word "recyclable", the connotation of which certainly includes a product or substance that does not impede the recyclability of another product to which it may be attached or applied.

In this case, the adhesive material is applied between the fluting material and the liner board. The adhesive is not stripped from the corrugated paper product prior to the recycling because it does not interfere with recycling the paper product.

As to defendants' second reason, plaintiff agrees that the '473 patent and file history does not impart a novel or special definition to the term in issue. In fact, the term "recyclable adhesive" is not defined anywhere. In brief, the file history, in my judgment, is of arguable help to both sides regarding the definition of the term.

It certainly is not conclusive as to either position.

As to defendants' third reason, it seems that neither the inventor nor the prosecuting attorney had, what I would characterize as, a fixed definition of the term in question. That is, both sides can point to deposition testimony favoring its position. Thus, I find defendants' argument in this regard to be unpersuasive.

Most important to my analysis, I do not believe that plaintiff's proffered expert is irrelevant. Dr. Ling testified as an expert in paper recycling and his testimony, referred to in plaintiff's brief, is:

... when we say adhesive is recyclable, basically the adhesive has to be repulpable or dispersable during pulping.

In the context of what this patent is all about, the external wrap over a paper cup, the definition plaintiff urges upon us is the one with which I agree.

An order follows.

ORDER

AND NOW, this 1st day of August, 2000, upon consideration of the *Markman* Briefing papers submitted by Plaintiff and Defendants, it is hereby ORDERED that the Court adopts Plaintiff's definition of the term "recyclable adhesive" in U.S. Patent No. 5,205,473 ("the '473 patent").

IT IS FURTHER ORDERED that the term "recyclable adhesive" in the claims of the '473 patent means an adhesive that does not interfere with recycling paper.

E.D.Pa.,2000.

Design By Us Company v. Best Foods, Inc.

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