

United States District Court,  
N.D. Illinois, Eastern Division.

**BLISTEX INC., an Illinois corporation,**  
Plaintiff.

v.  
**CIRCLE LABORATORIES, INC., a Florida corporation,**  
Defendant.

**April 12, 2001.**

John C. Brezina, Burton S. Ehrlich, Brezina and Ehrlich, Chicago, IL, for Plaintiff.

Jack Edward Dominik, Dominik, Knechtel, Demeur & Samlan, Chicago, IL, for Defendant.

Charles Lincoln Philbrick, John T. Hunnington, McBride, Baker & Coles, Chicago, IL, for Plaintiff.

Jack E Dominik, Dominik, Knechtel, Demeur & Samlan, Miami Lakes, FL, for Defendant.

### ***MEMORANDUM ORDER***

**BOBRICK, Magistrate J.**

Before the court are the following motions: the motion of plaintiff Blistex, Inc., for summary judgment on the issue of non-infringement on the patent of defendant Circle Laboratories, Inc. ; plaintiff's motion for summary judgment of patent invalidity on issues other than obviousness; and defendant's motion for summary judgment with regards to its counterclaim of patent infringement.

This is the second time the parties have filed these three motions and their accompanying memoranda. All three motions were initially denied by Judge Conlon as inadequately prepared and supported. ( *Minute Order of Nov. 28, 2000*). Ordinarily, the district court may, in its discretion, allow a party to renew a previously denied summary judgment motion or file successive motions, particularly if good reasons exist. *Whitford v. Boglino*, 63 F.3d 527, 530 (7<sup>th</sup> Cir.1995). A renewed or successive summary judgment motion is appropriate especially if one of the following grounds exists: "(1) an intervening change in controlling law; (2) the availability of new evidence or an expanded factual record; and (3) need to correct a clear error or prevent manifest injustice." *Id.* Neither party addresses these issues in any of their submissions. Because this is a relatively simple case, however, we will ignore these deficiencies.

The motions before the court are couched in terms of infringement, patent validity, and non-infringement, but it appears that the parties' actual dispute is over the meaning of the claims of the patent-at-issue. Thus, both sides are actually seeking a *Markman* ruling, in which the court interprets the patent's claims. According to the parties' submissions, in so doing, the court will resolve the question of infringement.

This case is essentially about the size of a square of material soaked in a water and alcohol solution that contained other ingredients. Both the plaintiff and the defendant produce such products, and market them as acne pads. The defendant owns the patent-in-suit, U.S. Patent No. 5,879,693. The claims of the 693 patent are as follows:

1. An individually packaged disposable single acne pad formed from a square of non-bordered, non-woven synthetic waffle material substrate impregnated with an active anti-acne composition folded twice to form a package of four layers, each of which has a fold-line shared with an adjacent layer; wherein

said single acne pad has an area of less than 10 square inches;

said single acne pad being secured inside a non-resealable moisture pocket; and

said active anti-acne by percentage of weight the following ingredients of composition comprising as: De-ionized water (74.888); SD Alcohol (24.000); Salicylic Acid (0.550); Fragrance (0.200); Citric Acid (0.200); Sodium Carbonate (0.150); Menthol (0.002); Simethicone (0.010).

2. An individually packaged disposable single acne pad formed from a square of non-bordered, non-woven synthetic waffle material substrate impregnated with an active anti-acne composition folded twice to form a package of four layers, each of which has a fold-line shared with an adjacent layer; wherein

said single acne pad has an area of less than 10 square inches;

said single acne pad being secured inside a non-resealable moisture pocket; and

said active anti-acne composition comprising de-ionized water; SD Alcohol 40; salicylic acid; fragrance; citric acid; sodium carbonate; menthol; and simethicone.

The plaintiff's pad is four inches by four inches-sixteen square inches-when unfolded; it is two inches by two inches-four square inches-when folded twice for packaging. According to the parties, if the size of ten square inches in the claims refers to a folded square, the plaintiff's product infringes on the defendant's patent; if the size refers to an unfolded square, there is no infringement. We turn now to interpret the claims at issue.

"When the meaning or scope of a patent claim is in dispute, the court construes the claim as a matter of law." *Vivid Technologies, Inc. v. American Science & Engineering, Inc.*, 200 F.3d 795, 804 (Fed.Cir.1999) ( *citing* *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, (1996)). "[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy." *Id.* at 803. In determining the proper construction of a claim, the court has numerous sources that it may properly utilize for guidance, including both intrinsic evidence (e.g., the patent specification and file history) and extrinsic evidence (e.g., expert testimony). *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996).

It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record: the patent itself, including the claims, the specification and, if in evidence, the prosecution history. *Id.* First, the court looks to the words of the claims themselves to define the scope of the patented invention. *Id.* The words in a claim are generally given their ordinary and customary meaning, but a patentee may

choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history. *Id.* at 1563.

Second-and as a result-it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. *Markman*, 52 F.3d at 979. Thus, the specification is always highly relevant to the claim construction analysis; it acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. *Id.*

Third, the court may also consider the prosecution history of the patent, if in evidence. *Id.* at 980; *Graham v. John Deere*, 383 U.S. 1, 33, 86 S.Ct. 684, 701-02 (1966). This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution. As such, the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims. *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed.Cir.1995); *see Markman*, 52 F.3d at 980. In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence. *See, e.g., Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed.Cir.1995) ("In construing the claims we look to the language of the claims, the specification, and the prosecution history. Extrinsic evidence may also be considered, if needed to assist in determining the meaning or scope of technical terms in the claims.") In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. *Markman*, 52 F.3d at 978-79. This is just such a case.

We begin with an examination of the claims themselves. Our interpretation is that a "pad" is formed from a "square" of material, which is then folded to form a "package." This suggests that the "pad" is an unfolded "square" that is folded into a "package." As defendant notes, the use of different terms-such as "pad" and "package" here-connotes different meanings. *CAE Screenplates v. Heinrich Fiedler GmbH*, 224 F.3d 1308, 1317 (Fed.Cir.2000). Thus, there would seem to be a pad, and a folded pad which would appear to be a package. The phrase "an area of less than 10 square inches" then, as it does not refer to the "package" but to the "pad," must refer to the size of an *unfolded* pad.

Defendant's submissions focus on the fact that the pad must be folded in order to be packaged. Indeed, according to the defendant:

The fact that it is the folded pad that is packaged as opposed to the unfolded item is supported by the figures of the patent as well as the extrinsic evidence that the packaged pad has to be folded. The practicalities of the manufacturing process require that only a folded pad can be inserted into the packet.

( *Defendant's Memorandum of Law in Support of Motion for Summary Judgment*, at 4). This argument does not support defendant's interpretation, but highlights the fact that the "pad" can be found in several states: folded, unfolded, packaged. Indeed, throughout its submissions, defendant repeatedly refers to a "folded pad," suggesting that the pad can be folded or unfolded. ( *Defendant's Motion for Summary Judgment*, at 4-5; *Defendant's Response Memorandum*, at 2-3). The fact that the pad is described as "folded" means that "pad" and "folded pad" cannot have the same meaning. Thus, in order for defendant's interpretation to hold sway, the disputed claim would had to have read that "a single *folded* acne pad has an area of less than 10

square inches." But that is not the language defendant chose.

Consideration of the patent specification does not counsel a different result. The abstract states that the patent discloses a method of packaging an acne packet, "which packet will hold just one three-inch by three-inch square acne pad." According to the abstract, three inches by three inches is the size of the *pad* before it is folded. Thus the folding is not necessary to form a pad-it is merely necessary to insert a pad into a packet. So, again, when the claim talks about the size of a pad, it is perfectly consistent to assume that the reference is to an unfolded pad.

The drawings take us in a similar direction. Throughout the depictions, the "pad"-identified by the number ten-is shown in both folded and unfolded states. Nowhere in these drawings is it suggested that the item at issue must first be folded to become a "pad." It remains identified as a "pad" throughout, folded or unfolded. Curiously, defendant claims that Figure 3 in the drawings "shows the 'square' which is folded twice to form a 'pad.'" ( *Defendant's Motion for Summary Judgment*, at 4-5). This description cannot be found anywhere in the text accompanying drawings:

FIG. 3 is a diagrammatic flow sheet of the packaging of the acne pads by means of a Bartelt machine ...

or in the description of the preferred embodiment:

Turning now to the drawings, and FIGS. 1 and 2, it will be seen that the packaged acne pads 10 are formed on an endless string of adjacent packets 11 joined by a living hinge 13, and ideally in a quantity of twenty-two. After the acne pads 10 are folded, they go into a small box ... Once the acne pad 10 has been impregnated, it is ready to be encapsulated to form a packet 11. The acne pads are three inch squares, folded twice to form a one and a half inch pad for encapsulating in the packet.

\* \* \*

Once again, there is nothing to suggest that, by definition, the term "pad" refers only to the folded item. Indeed, and on the contrary, whenever the term "pad" is used without adjective or description, the clear reference is to a pad in an *unfolded* state. Whenever the text means to refer to the folded "pad," the word "folded" is employed. The word "folded" is conspicuously absent from the claim at issue: "said single acne pad has an area of less than 10 square inches." That phrase, whether in ordinary English or within the context of the entire text of the patent, demands an interpretation that the reference is to an unfolded pad.

The point of all this analysis, after two rounds of summary judgment motions and nine memoranda of law is essentially this: if one were handed a piece of standard typing paper that had been folded twice and were asked what the size of the paper was, in all likelihood the answer would be: "8 1/2 by 11 inches." The court sincerely doubts that the response would ever be: "4 1/4 by 5 1/2 inches." That is what, in the end, is meant by the patent law boilerplate, recited in case after case, that "words in a claim are generally given their ordinary and customary meaning." The issue here is whether ten square inches refers to the size of a folded, or unfolded, pad. In the same manner as the hypothetical typing paper, "ordinary and customary meaning" would dictate that the size in the claims at issue refers to an unfolded pad. Accordingly, we find that the claims are limited to pads that are no more than ten inches square in their unfolded state.

As the parties contend, this finding disposes of the three motions before the court. Defendant's motion for

summary judgement is based entirely on its argument that the patent claims cover pads of up to ten square inches in their folded state. ( *Defendant's Statement of Material Facts*, para. 4-6). It contends that because plaintiff's product is four square inches when folded, it comes within the claims of the patent-in-issue. ( *Defendant's Memorandum of Law in Support of Motion for Summary Judgment*, at 5-6). Because we have found that the claims at issue are limited to products of up to ten square inches in their unfolded states, and as plaintiff's product is sixteen square inches, defendant's motion must be denied. Consequently, plaintiff's motion for summary judgment on the issue of non-infringement must be granted, and its motion on the issue of patent invalidity is moot. FN1

FN1. The court admits to some confusion over whether the doctrine of equivalents has been fully joined as an issue in this case in any of the parties' nine submissions. Defendant states that although it has not raised the doctrine, it does not intend to waive it. ( *Defendant's Reply Memorandum to Plaintiff's Response*, at 4).

Yet, the failure to raise such an argument in a memorandum supporting a motion for summary judgment is itself a waiver of the *argument*. *United States v. Magana*, 118 F.3d 1173, 1198 n.15 (7<sup>th</sup> Cir.1997); *RIV VIL, Inc. v. Tucker*, 979 F.Supp 645, 653 (N.D.Ill.1997). We also note that defendant has failed to respond to that portion of plaintiff's statement of facts detailing defendant's surrender of claims covering pad dimension greater than ten square inches. ( *Plaintiff's Consolidated Rule 56.1(a) Statement*, para. 78-79). Accordingly, these facts are deemed admitted. *Bordelon v. Chicago School Reform Bd. of Trustees*, 233 F.3d 524, 527 (7<sup>th</sup> Cir.2000). By surrendering these claims, defendant is barred from raising the doctrine of equivalents as a result of prosecution history estoppel. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki*, 234 F.3d 558, 566-569 (Fed.Cir.2000)

### **CONCLUSION**

For the foregoing reasons, the plaintiff's motion for summary judgment on the issue of non-infringement is hereby GRANTED; the defendant's motion for summary judgment on the issue of infringement is hereby DENIED; the plaintiff's motion for summary judgment on the issue of patent invalidity is hereby DENIED as moot.

N.D.Ill.,2001.

*Blistix, Inc. v. Circle Laboratories, Inc.*

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