

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF WISCONSIN

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MANDY N. HABERMAN,

Plaintiff,

v.

GERBER PRODUCTS COMPANY,

Defendant.

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MEMORANDUM AND ORDER  
05-C-224-S

Plaintiff Mandy N. Haberman commenced this patent infringement action alleging that defendant Gerber Products Company manufactures and sells non-spill cups and replacement valves which infringe her United States Patents Nos. 6,102,245 and 6,116,457. At the conclusion of trial the jury returned a verdict finding that defendant's products do not infringe either patent and that the '457 patent is invalid as anticipated. The matter is presently before the Court on plaintiff's renewed motion for judgment as a matter of law, or alternatively for a new trial, on the issues of infringement and anticipation of the '457 patent. Also before the Court is defendants' motion for an award of attorney's fees pursuant to 35 U.S.C. § 285.

## BACKGROUND

Defendant Gerber manufactures and sells a line of spill-proof cups and replacement valves. The valves in its cups are curved inwardly such that they are convex to the interior of the cup and the direction of flow of the liquid.

The '457 patent was issued on September 12, 2000. It includes a single independent claim.

1. An article through which or from which a drinking liquid is taken by a consumer, the article having a spout provided with a valve comprising a membrane of resiliently flexible material, said membrane being provided with at least one split adapted such that the liquid may be drawn from or through said article by the sole application of a predetermined level of suction in the region of said valve, characterized in that the membrane has a normal condition in which it is dished inwardly of the article, opposite the direction through which the drinking liquid is taken in use of the article and is adapted to close up by returning to the normal inwardly dished condition under its own resilience when such suction is removed.

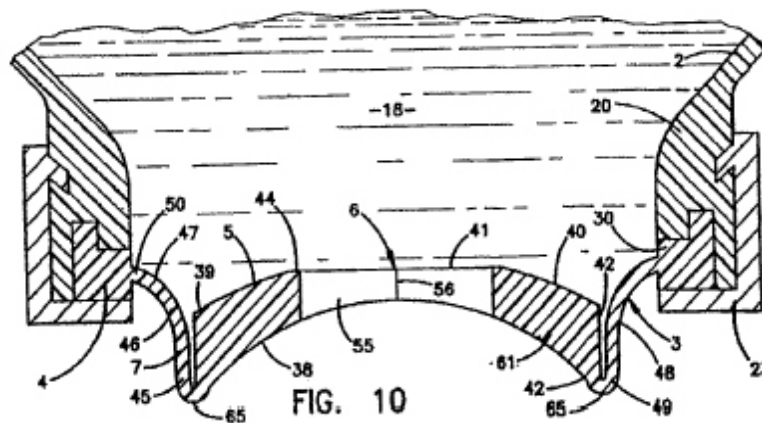
The claims submitted in the application that ultimately led to the granting of the '457 patent ("'457 application") contained no reference to operation by the sole application of suction. The original claims were rejected on the basis of anticipation and obviousness. Plaintiff added the language related to operation by the sole application of suction in an effort to overcome the prior art, particularly the Coy patent.

United States Patent No. 5,213,236 to Brown ("Brown patent") is prior art to the '457 patent. The Brown patent relates to a

dispensing package for fluid products such as liquid soaps and particularly to a valve in such a product.

The valve includes a marginal flange, a valve head with a discharge orifice therein, and a connector sleeve having one end connected to the valve flange and the opposite end connects with the valve head adjacent a marginal end thereof. The connector sleeve has a resiliently flexible construction, such that when pressure within the container raises above a predetermined amount, the valve head shifts outwardly in a manner which causes the connector sleeve to double over and extend rollingly.

Brown patent abstract. Figure 10 depicts a preferred embodiment of the Brown valve.



**FIG. 3**



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disclosed in Lampe. The Court subsequently construed this element and instructed the jury as follows:

As used in claim 1 of the '457 patent the phrase "adapted such that liquid may be drawn from or through said article by sole application of suction" means that it is possible for the user to draw the drink from the vessel using only suction.

The undisputed evidence at trial was that defendant's accused products use the Brown/Lampe valve and that user of defendant's products can draw the drink from them using only suction.

The jury returned a verdict finding that defendant's products do not infringe the '457 patent and finding that the '457 patent was anticipated by a single prior art reference.

#### MEMORANDUM

\_\_\_\_\_Plaintiff now renews its motion for judgment as a matter of law that defendant's accused device infringes the '457 patent and that the patent is not anticipated. Alternatively, plaintiff argues that the jury's verdict on the issues of infringement and validity of the '457 patent is irreconcilably inconsistent, so that if the issue cannot be resolved as a matter of law a new trial is compelled. Defendant takes the position that the verdict can be reconciled and is supported by the evidence at trial.

In considering a motion for judgment as a matter of law pursuant to Rule 50(b) the court determines whether the evidence presented, viewed in the light most favorable to the prevailing party and combined with all reasonable inferences that may be drawn

in favor of the prevailing party, is sufficient to support the verdict. Tennes v. Massachusetts Dept. Of Revenue, 944 F.2d 372, 377 (7th Cir. 1991). The Court does not reevaluate the credibility of witnesses nor otherwise weigh the evidence. Id. A new trial may be granted pursuant to Rule 59 if the verdict is against the weight of the evidence or for some other reason the trial was not fair to the moving party. Forrester v. White, 846 F.2d 29, 31 (7th Cir. 1988).

The Court now concludes that while the verdict is facially inconsistent, the aspect of the verdict that produces the inconsistency can be resolved as a matter of law, and that the balance of the verdict is amply supported by the evidence. The evidence at trial relevant to non-infringement of the '457 patent concerned elements of the valve in defendant's accused products. Particularly, defendant contended that its valve lacked a "membrane" that it was not "dished inwardly" and that it did not return to its normal condition "under its own resilience." In order to find that the defendant's cups did not infringe the jury necessarily found that at least one of these elements was absent from the defendant's valve. However, the evidence was undisputed that the allegedly anticipating prior art, Lampe, taught only to use a valve identical to defendant's valve. Accordingly, a finding of anticipation by Lampe required the jury to reach the contradictory conclusion that defendant's valve disclosed all the

elements of the patent. Since anticipation and infringement analysis are identical in this respect, the result is logically impossible. Upsher-Smith Laboratories, Inc. v. Pamlab, L.L.C., 412 F.3d 1319, 1322 (Fed. Cir. 2005) (affirming the axiom, "that which infringes if later, anticipates if earlier").

Defendant makes two arguments in an effort to harmonize the inconsistent answers. First, it suggests that the jury might have found the '457 patent anticipated by the '245 patent. The Court rejected this possibility as a matter of law on summary judgment.

A relatively broader patent does not estop a later improvement patent, nor does the failure of the broader patent's prosecution history to mention the specific improvement suggest that the original patent does not encompass it. Integra Lifesciences I, Ltd. v. Merck KGAA, 331 F.3d 860, 869 (Fed. Cir. 2003). In this case the '245 claims read on, but the patent specification does not disclose, valves comprising a dome-shaped region convex to the direction of flow....

Certainly, a broader patent does not anticipate improvement patents where the improvement was not disclosed in the specification of the broader claims. The fact that earlier patent claims may read on later patent claims which are an improvement on the first invention, does not mean that the latter claims are anticipated by the former.

Memorandum and Order on Summary Judgment at 18, 21.

Plaintiff's second argument is that the jury might have found that Lampe disclosed other valves because of its general reference that any suitable self sealing valve could be used. Plaintiff suggests that the jury could have looked to other prior art valve

patents before it to find anticipation. Lampe does not sufficiently disclose any other valve. Furthermore, plaintiff's suggestion that the jury might have considered the teachings of other prior art patents before it in connection with Lampe might be appropriate if a finding of obviousness were under consideration, but other prior art cannot be combined with the single reference to sustain an anticipation finding.

Although the jury's verdict is inconsistent with respect to whether all '457 elements relating to the valve are present in the Brown/Lampe also used by defendant, the issue presents solely questions of law which can be resolved by the Court. The evidence at trial concerning the structure and operation of defendant's valve was entirely consistent and undisputed. The points of disagreement were whether the valve has a "membrane" which is "dished inwardly" and which is adapted to return to the inwardly dished condition "under its own resilience." Neither party sought Court construction of these terms prior to trial either on summary judgment or in connection with proposed jury instructions. Nevertheless, under circumstances where there is no dispute concerning the structure or operation of the accused device the issue of whether the claims language reads on the device is purely one of claim construction properly resolved by the Court. Athletic Alternatives, Inc. v. Prince Mfg. Inc., 73 F.3d 1573, 1578 (Fed. Cir. 1996). Defendant correctly notes that its expert at trial



was not providing fact testimony but was merely offering his opinion as to what the claim terms meant. A role not properly performed by the expert or the jury.

As a matter of law defendant's device has a "membrane," that it is "inwardly dished" and returns to its condition "under its own resilience." The term "membrane" generally means a relatively thin sheet of material. This is repeatedly confirmed in the '457 specification where sheet and membrane are used interchangeably (see col. 3). The patentee also refers to the foil covering a drinking carton as a membrane. Nothing in the ordinary meaning of the term membrane or in the patentee use of the term in the specification suggests that a membrane cannot have variance in thickness. Defendant's suggestion of this additional limitation is nothing but the addition of a limitation not present in the patent claims or even suggested in the specification.

There is no reasonable argument that the valve is "inwardly dished" as that term is used in the patent. Defendant's experts suggestions that it is not inwardly dished because it is top hat shaped is nothing more than baseless opinion. Finally, it is undeniable that the valve returns to its original shape by its own resiliency. Defendant's suggestion that there is a distinction between returning to its original shape based on "energy stored in the valve" and "resilience" is nonsense.

Accordingly, the defendant's device infringes as a matter of law, the jury's verdict in that regard was wrong as a matter of law and plaintiff is entitled to a determination of infringement.

However, the issue of anticipation was properly resolved by the jury as a question of fact and its determination was amply supported by the facts at trial. Having already concluded that the the Lampe valve discloses every valve element of claim 1, the sole issue is whether Lampe teaches that the claim 1 element that the valve membrane be "provided with at least one slit adapted such that the liquid may be drawn from or through such article by the sole application of a predetermined level of suction..." The Court has already concluded on summary judgment that Lampe does not teach this element expressly. Accordingly, the issue at trial was whether Lampe inherently taught the element.

The legal underpinnings for this determination are without dispute. First, the parties agree that the Court's construction of the element, as presented to the jury, is proper:

As used in claim 1 of the '457 patent the phrase "adapted such that the liquid may be drawn from or through said article by the sole application of a predetermined level of suction" means that it is possible for the user to draw the drink from the vessel using only suction.

Second, the parties do not dispute the appropriateness of the instruction to the jury concerning when an element is inherently disclosed in the prior art:

To prove that an element is inherent in the piece of prior art defendants must prove that the missing element would necessarily be recognized by persons of ordinary skill in the art reviewing the piece of prior art.

Combining these two principles with the Rule 50 standard, the issue presently before the Court is whether a reasonable jury could have found by clear and convincing evidence that one of ordinary skill in the art reviewing Lampe would necessarily know that liquid in the Lampe vessel could be withdrawn solely by application of suction.

Reviewing the testimony at trial, the evidence was sufficient to sustain this finding. The testimony of the witnesses with skill in the art - Weiss, Socier and Stull - was remarkably consistent on the issue of whether one of skill in the art would have known that Lampe could be operated solely by suction. Weiss first testified that the valve was designed to function when a predetermined pressure differential, greater inside the cup than outside, exists across the valve. Transcript 1-133. He further testified that defendant's product would infringe even if it included a squeezable container, which clearly implies that Lampe anticipated the claim. Transcript p. 1-152. Finally, Weiss conceded, in a moment of candor, mistake or both, that Lampe disclosed a valve which would open under a predetermined level of suction. Transcript 1-174. The jury may have concluded it was candor.

Socier may have provided the most persuasive testimony on the topic:

The valve functions based on differential pressure on one side of the valve to another. If you think about a squeeze bottle, a bottle of Heinz ketchup, for example, and the consumer is going to squeeze the container. They're squeezing the bottle which is creating a higher pressure on the inside of the bottle and as a result there's a lower pressure, atmospheric pressure is lower and so product is going to flow through the valve. On the same measure if you think of a child's sippy cup, they are sucking on the outside. The inside of the container is at atmospheric pressure and the vacuum is a lower pressure so basically that lower pressure is going to draw the product through the valve. Basic physics.

Transcript 1-250-51.

Stull's testimony echoed the principle:

It's a valve that happens to go - it happens to separate liquid from the inside of something to the outside to - to the air or to dispense it and it doesn't know where it is. It really only understands one thing and that is a differential in pressure and that could be created in any number of ways .... Squeezing, shaking, sucking, pushing....

Transcript 1-277.

This testimony amply supports the factual conclusion that a person of ordinary skill viewing Lampe would necessarily know that it was possible to draw the drink from the Lampe vessel using only suction. The testimony made it clear that it was a matter of basic physics, which those of skill in the art would know, that sucking and squeezing would have equivalent effects on the Lampe valve.

Even though Lampe emphasized squeezing, the element that it be possible to withdraw the liquid solely by sucking is inherently taught to one skilled in the art. The jury's determination that the '457 patent is anticipated is amply supported by the evidence at trial.

Although plaintiff is correct that defendant's product infringes the '457 patent as a matter of law, because the jury's determination of invalidity is supported by the evidence, plaintiff is entitled to no relief from the previous judgment dismissing its claims with prejudice and declaring claim 1 of the '457 patent invalid.

#### Attorney's Fees

Pursuant to § 285 "[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party." Whether a case is exceptional is a factual question defendants must prove by clear and convincing evidence. See Interspiro USA, Inc. V. Figgie Intern. Inc., 18 F.3d 927, 933 (Fed. Cir. 1994). Among the grounds for finding a case exceptional are litigation misconduct and vexatious, unjustified or otherwise bad faith litigation. Epcon Gas Systems, Inc. v. Bauer Compressors, Inc., 279 F.3d 1022, 1034 (Fed. Cir. 2002).

This case is not exceptional. It is a typical hard fought patent infringement case. The substantive merit of the claims is

amply demonstrated by plaintiff's success in defeating defendant's motion for summary judgment and its present success on its renewed motion for judgment as a matter of law of infringement of the '457 patent. The fact that plaintiff did not ultimately prevail on all of its positions falls far short of making this case exceptional. Plaintiff's infringement position did not evidence a lack of appropriate pretrial investigation, especially given the relatively simple nature of the patented technology and the readily apparent features of the accused devices. Finally, there was nothing exceptional about the way discovery was conducted plaintiff apparently acting in good faith throughout the process.

ORDER

IT IS ORDERED that plaintiff's motion for judgment as a matter of law or for a new trial is DENIED.

IT IS FURTHER ORDERED that defendant's motion for attorney's fees pursuant to 35 U.S.C. § 285 is DENIED.

Entered this 24th day of May, 2006.

BY THE COURT:

s/

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JOHN C. SHABAZ  
District Judge