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## Federal Circuit Patent Bulletin: *Ineos USA LLC v. Berry Plastics Corp.*

April 16, 2015

*"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."*

On April 16, 2015, in *Ineos USA LLC v. Berry Plastics Corp.*, the U.S. Court of Appeals for the Federal Circuit (Dyk, Moore,\* O'Malley) affirmed the district court's summary judgment that U.S. Patent No. 6,846,863, which related to polyethylene-based compositions used to form shaped products such as screw caps for bottles, was invalid as anticipated under 35 U.S.C. § 102. The Federal Circuit stated:

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." [T]he 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. 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.

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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. 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. "[T]he disclosure of a range . . . does not constitute a specific disclosure of the endpoints of that range." 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. . . . [We have] explained the importance of establishing the criticality of a claimed range to the claimed invention in order to avoid anticipation by a prior art reference disclosing a broader, overlapping range. . . . We have, however, reversed a grant of summary judgment of anticipation where the patentee raised a genuine dispute of material fact concerning the criticality of a claimed range. . . . We emphasized that "how one of ordinary skill in the art would understand the relative size of a genus or species in a particular technology is of critical importance."  
. . .

The court's conclusion that limitation 2 was met by the '846 patent was correct because Ineos did not raise a genuine question of fact about whether the range recited in limitation 2 is critical to the invention. The '863 patent specification indicates that the lubricants included in the invention function to improve the caps' slip properties and ability to be unscrewed from a bottle. It then describes the novelty of the invention as eliminating the odor and taste problems associated with prior art bottle caps while still maintaining good slip properties. Ineos has not established that any of these properties would differ if the range from the prior art '846 patent is substituted for the range of limitation 2.

Ineos relies on the testimony of one of the inventors of the '863 patent stating that the range claimed in limitation 2 is critical to avoid unnecessary manufacturing costs and the appearance of undesirable blemishes on the bottle caps. But even if true, this has nothing to do with the operability or functionality of the claimed invention. Ineos has not established any relationship between avoided cost and prevention of undesirable blemishes, and the claimed invention's slip properties or elimination of odor and taste problems. Ineos does not suggest that the claimed invention's slip properties or improved odor and taste properties would not have been expected based on the prior art. While we do not rule out the possibility that testimony concerning

reduced manufacturing costs could be relevant where a method of manufacture claim is at issue, this is not the case before us. . . .

Claim 3, which depends from claim 1, specifies that the primary lubricant is the saturated fatty acid amide behenamide. The court found that because behenamide is one of a few common saturated fatty acid amide lubricating agents, the '846 patent's disclosure of the genus of saturated fatty acid amides anticipates claim 3. . . . We affirm the court's conclusion that claim 3 is anticipated. . . . Verbatim disclosure of a particular species is not required in every case for anticipation because disclosure of a small genus can be a disclosure of each species within the genus. Ineos does not dispute that behenamide falls within the narrow genus of saturated fatty acid amides having 12 to 35 carbon atoms. And Ineos provided no detailed information on how large this genus is to support its contention that this genus does not disclose behenamide. Ineos's inventor declaration does not state that behenamide is not a common lubricant within this species. We conclude that Ineos did not raise a genuine dispute of material fact with respect to claim 3.