

United States District Court,
E.D. New York.

VAN BLARCOM CLOSURES, INC,
Plaintiff.

v.

OWENS-ILLINOIS, INC,
Defendant.

No. 04-CV-1993 (RJD)(SMG)

Dec. 27, 2005.

Jeremy A. Kaufman, Martin B. Pavane, Lisa Ferrari, Roger Sherman Thompson, Cohen, Pontani, Lieberman & Pavane, New York, NY, for Plaintiff.

Douglas A. Freedman, Kevin C. May, Tigran Vardanian, Latham & Watkins, LLP, Chicago, IL, for Defendant.

SUPPLEMENT TO REPORT AND RECOMMENDATION

GOLD, S., United States Magistrate Judge:

Introduction

Plaintiff, Van Blarcom Closures, Inc. ("VBC"), brings this action against defendant, Owens-Illinois, Inc. ("OI"), for infringement of U.S. Patent No. 5,579,934. The '4 patent describes a convertible child resistant container cap. Depending upon how it is set, the cap may operate either in a child-resistant mode, in which the cap is difficult for a child but not an adult to open, or in a non-child-resistant mode, in which the cap is easy for all to open. *See* Pl's Opening Brief at 1; Ex. A to Pl's Opening Br. at 8. The invention's most practical application is as a closure for a bottle or other container holding drugs or other items unsafe for children to handle without adult supervision.

On July 29, 2005, I issued a report and recommendation addressed to a dispute between the parties over how three of the terms used in the patent claims should be construed. Docket Entry 31. First, I recommended that plaintiff's proposed construction of the term "cover wall" as the "top wall of the cap" be approved. Second, with respect to the term "second circumferential side wall," I recommended that plaintiff's proposal that a side wall may include a radially inwardly extending portion be accepted, but with the addition that the portions of the outer cap which engage with the inner cap, in either the child-resistant or non-child-resistant position, may not be located on the radially inwardly extending portion. Finally, I recommended construing the claims so that "[t]he angular abutments of the outer cap must be located on the inner surface of the side wall."

The definition of the term "second circumferential side wall" which I recommended was not proposed by either party, but was instead one I fashioned while drafting my report and recommendation. Because the parties had not otherwise been afforded an opportunity to comment on my recommended definition, I invited a motion for reconsideration. Report and Recommendation at 10-11. The parties accepted my invitation and filed cross-motions for reconsideration. Although both sides accept my ruling that "[t]he angular abutments of the outer cap must be located on the inner surface of the side wall," they take issue with my recommended construction of the claim terms "cover wall" and "second circumferential side wall."

Discussion

A. Cover Wall

My original report recommended adopting plaintiff's proposed construction of the term cover wall as the top wall of the cap. Because defendant had already been fully heard in response to plaintiff's proposal, I did not invite the parties to seek reconsideration of this aspect of my report. Defendant nevertheless urges me to reconsider my recommended construction.

Defendant argues that the term "cover wall" indicates a top wall which extends to the outer perimeter of an object. I have already considered and rejected that argument, and I find nothing in defendant's motion for reconsideration that I overlooked. It seems to me entirely consistent with the term "cover wall" to imagine a top wall which extends over some, but not all, of an object. For example, a top wall of an otherwise outdoor stadium or picnic area, supported by a stand or several columns rising up from in or around of the center of the stadium or picnic area, and which covers some but not all of the seating-like an umbrella which does not extend to the perimeter of a table or patio-might be described as a cover wall. Similarly, one may imagine a container which, while otherwise similar to a typical pill bottle, is designed to hold items which the user wishes to store exposed to the air. A column rising from the center of such a container, or arms extending from its side walls, might support a "cover wall" which extends close enough to the perimeter of the bottle to prevent the items from falling out, but not so far as to meet the side wall and thereby seal the container from exposure to the air. Another example which illustrates this point would be a mug designed to hold hot liquids which is covered by a lid which extends to most of the mug's perimeter, but leaves a small portion uncovered, thereby allowing the user to drink the contents with the lid in place.

For these reasons and those stated in my original report, I reiterate my recommendation that the term cover wall be defined as the top wall of the cap.

B. Second Circumferential Side Wall

In their original briefs, plaintiff proposed that the term "circumferential side wall" be construed as "[a] side wall which defines a circumference of the outer cap, and which may include a radially inwardly extending portion," and defendant argued that the term should be construed as "[t]he wall of the cap that hangs down from the cover wall." After considering the parties' arguments, I reasoned that the ordinary meaning of the phrase "side wall" describes a wall which forms the side of an object, and would not ordinarily suggest a "radially inwardly extending portion." I therefore concluded that the plain meaning of the claim language describes a wall which comprises the side of a closure by extending in a perpendicular direction from the cover wall, and not one with "a radially inwardly extending portion." I found further support for this construction in the text of the patent specification and in a technical dictionary. Report and Recommendation at 7-8.

However, I then noted what I described as a dilemma: if the cover wall need not extend to the point where it covers the perimeter of the outer cap, and the side wall may not have a radially inwardly extending portion, it is possible that the cover wall and side wall will not meet. To resolve the problem I identified, I recommended that plaintiff's proposal that a side wall may include a radially inwardly extending portion be accepted, but with the addition that the portions of the outer cap which engage with the inner cap, in either the child-resistant or non-child-resistant position, may not be located on the radially inwardly extending portion.

I am now convinced that this aspect of my report and recommendation was error. As defendant points out, the Federal Circuit "repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity." *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed.Cir.2004) (collecting cases). Accordingly, I must construe the claim terms according to their plain meaning and without considering any impact my construction might have upon the practicalities of making a device incorporating the claimed invention. Moreover, as indicated above in the discussion of the claim term "cover wall," a cap with a side wall and cover wall which do not meet would not necessarily be inoperable or problematic.

Defendant originally proposed that the second side wall be defined as "[t]he wall of the cap that hangs down from the cover wall." In its motion for reconsideration, defendant seeks to construe the side wall as "[a] wall which constitutes the side of the cap by extending in a perpendicular direction from the cover wall and which may not include a radially inwardly extending portion ." In its reply papers, defendant-presuming I decline to adopt its definition of cover wall-refines its proposed construction of the term side wall as "[a] wall which constitutes the side of the cap by extending in a perpendicular direction from the cover wall and which may not include a radially inwardly extending portion that extends over the top of the threaded portion of the container." The problem with these definitions is that they presume that the cover wall covers the perimeter of the cap and that the side wall extends from the cover wall.

Plaintiff, in its motion for reconsideration, submits that a side wall should be defined as one "which defines a circumference of the cap of which it is a part," and that the question of whether a side wall may include a "radially inwardly extending portion" should be deferred until the point in the litigation when infringement is considered. The problem with this approach is that it ignores the analysis in my original report rejecting plaintiff's argument that a side wall may include an inwardly extending portion. (I note plaintiff's argument, made in response to the recommendation in my original report, that a wall of a room which has molding or a baseboard suggests that a "side wall" may have a "radially inwardly extending portion." Pl. Brief in Opp. at 8. I do not find this argument persuasive, however, because I would not consider the baseboard or molding to be part of the side wall.)

I therefore conclude that defendant's proposed construction should be adopted, but with a minor change in language to allow for the possibility of a cover wall which does not extend to a cap's outer perimeter. Accordingly, I respectfully recommend that the claim term "side wall" be defined as "a wall which constitutes the side of the cap by extending in a direction that is perpendicular to that of the cover wall and which may not include a radially inwardly extending portion that extends over the top of the threaded portion of the container."

Conclusion

For the reasons stated above, I reiterate my original recommendations that the angular abutments of the

outer cap must be located on the inner surface of the side wall and that plaintiff's construction of the term "cover wall" as the "top wall of the cap" be approved. In addition, I grant defendant's motion for reconsideration to the extent that I withdraw my original recommendation with respect to the term "side wall" and now recommend that "side wall" be defined as "a wall which constitutes the side of the cap by extending in a direction that is perpendicular to that of the cover wall and which may not include a radially inwardly extending portion that extends over the top of the threaded portion of the container."

Any objections to the recommendations in this report must be filed with the Clerk of the Court and the Chambers of the Honorable Raymond J. Dearie within ten days of receiving this Report and Recommendation, and in any event, no later than January 17, 2006. Failure to file timely objections may waive the right to appeal the District Court's Order. *See* 28 U.S.C. s. 636(b)(2); Fed.R.Civ.P. 6(a), 6(e), 72; *Small v. Secretary of Health and Human Servs.*, 892 F.2d 15, 16 (2d Cir.1989).

E.D.N.Y., 2005.

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